

1 Robert F. McCauley (SBN 162056)
robert.mccauley@finnegan.com
2 Jacob A. Schroeder (SBN 264717)
jacob.schroeder@finnegan.com
3 FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP
4 3300 Hillview Avenue
Palo Alto, CA 94304-1203
5 Telephone: (650) 849-6600
Facsimile: (650) 849-6666

6 Gerald F. Ivey (*pro hac vice*)
7 Smith R. Brittingham IV (*pro hac vice*)
Elizabeth A. Niemeyer (*pro hac vice*)
8 John M. Williamson (*pro hac vice*)
Rajeev Gupta (*pro hac vice*)
9 Aidan C. Skoyles (*pro hac vice*)
FINNEGAN, HENDERSON, FARABOW,
10 GARRETT & DUNNER, LLP
901 New York Avenue, NW
11 Washington, DC 20001-4413
Telephone: (202) 408-4000
12 Facsimile: (202) 408-4400

13 Stephen E. Kabakoff (*pro hac vice*)
FINNEGAN, HENDERSON, FARABOW,
14 GARRETT & DUNNER, LLP
3500 SunTrust Plaza
15 303 Peachtree Street, N.E.
Atlanta, GA 30308-3263
16 Telephone: (404) 653- 6400
Facsimile: (404) 653-6444

17 *Attorneys for Plaintiffs*
18 *OpenTV, Inc., NagraVision S.A., and Nagra France S.A.S.*

19 UNITED STATES DISTRICT COURT
20 NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

21 OPENTV, INC. NAGRAVISION S.A., and
NAGRA FRANCE S.A.S.

22 Plaintiffs,

23 v.

24 APPLE INC.,

25 Defendant.

CASE NO. 5:15-cv-02008-EJD (NMC)

**PLAINTIFFS' OPPOSITION TO
DEFENDANT APPLE INC.'S MOTION
TO STAY PENDING COMPLETION OF
USPTO PROCEEDINGS**

Date: September 15, 2016
Time: 9:00 am
Judge: Hon. Edward J. Davila
Courtroom: 4, 5th Floor

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Cases

Adaptix, Inc. v. HTC Corp.,
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Affinity Labs of Tex. v. Apple Inc.,
No. 09-04436 CW, 2010 U.S. Dist. LEXIS 50974, (Apr. 29, 2010).....5

Affinity Labs of Texas, LLC v. Nike, Inc.,
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Alice Corp. PTY. Ltd., v. CLS Bank Int’l et al.,
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Aylus Networks, Inc. v. Apple Inc.,
No. C-13-4700 EMC, 2014 WL 5809053 (N.D. Cal. Nov. 6, 2014).....4

CANVS Corp. v. United States,
118 Fed. Cl. 587 (2014)8

Cypress Semiconductor Corp. v. GSI Tech., Inc.,
2014 U.S. Dist. LEXIS 142858 (N.D. Cal. Oct. 7, 2014).....11

Dell Inc. v. Disposition Services, LLC,
CBM2013-00040, Paper 9 (P.T.A.B. Feb. 12, 2014)10

DSS Tech. Mgmt., Inc. v. Apple Inc.,
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Enfish LLC v. Microsoft Corp.,
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Ethicon, Inc. v. Quigg,
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Kilopass Tech., Inc. v. Sidense Corp.,
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Loyalty Conversion Sys. Corp. v. American Airlines, Inc.,
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Network Appliance Inc. v. Sun Microsystems Inc.,
No. C-07-06053 EDL, 2008 WL 2168917 (N.D. Cal. May 23, 2008).....9

PersonalWeb Techs., LLC v. Facebook, Inc.,
Nos. 5:13-cv-01356-EJD, 01358-EJD, 01359-EJD, 2014 WL 116340 (N.D. Cal.
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1 *Pi-Net Int’l, Inc. v. Focus Bus. Bank*,
 No. C 12-4958 PSG, 2013 WL 4475940 (N.D. Cal. Aug. 16, 2013)4

2 *Redfin Corp. v. CoreLogic Solutions, LLC*,
 3 CBM2014-00027, Paper 14 (P.T.A.B. April 25, 2014)10

4 *Rensselaer Polytechnic Institute v. Apple Inc.*,
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6 *Robert Bosch Healthcare Sys., Inc. v. Cardiocom, LLC*,
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7 *Roy-G-Biv Corp. v. Fanuc Ltd.*,
 8 No. 2:07-CV-418 (DF), 2009 WL 1080854 (E.D. Tex. Apr. 14, 2009).....7

9 *TPK Touch Solutions, Inc. v. Wintek Electro-Optics Corp.*,
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11 *TPK Touch Solutions, Inc. v. Wintek Electro-Optics Corp.*,
 12 No. 13-cv-02218-JST, 2013 WL 6021324 (N.D. Cal. Nov. 13, 2013).....8, 12

13 *Verinata Health, Inc. v. Ariosa Diagnostics, Inc.*,
 No. C 12-05501 SI, 2014 WL 121640 (N.D. Cal. Jan. 13, 2014).....4, 5, 6, 9, 13

14 **Statutes**

15 28 U.S.C. § 1659(a)4

16 35 U.S.C. § 101 *passim*

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1 **I. INTRODUCTION**

2 This case should not be stayed pending completion of *inter partes* review (“IPR”) and
3 covered business method review (“CBM”) of the asserted OpenTV patents. Rather than promptly
4 filing IPR and CBM petitions with the U.S. Patent and Trademark Office (“PTO”) and seeking a stay
5 based on promptly-filed petitions, Apple waited until just before the statutory deadline to file its
6 petitions. Apple now seeks to continue its unwarranted, knowing infringement for another eighteen
7 months while the PTO’s Patent Trial and Appeal Board (“PTAB”) considers Apple’s petitions. If
8 this Court is inclined to grant Apple’s motion, however, this Court should also grant OpenTV’s
9 motion for Rule 54(b) certification (ECF No. 75), allowing review of all the patents at issue to
10 proceed in parallel.

11 Apple attempts to justify its extensive delay in seeking a stay by claiming it filed its petitions
12 within the one-year statutory deadline, suggesting that the existence of a deadline excuses its
13 decision to wait more than eleven months before filing its petitions. Complying with the statutory
14 deadline, however, does not equate with diligence; rather, it merely avoids the statutory bar.
15 Moreover, OpenTV would suffer significant prejudice if the Court grants Apple’s motion. The
16 parties and the Court have already expended substantial resources, and none of the requested IPRs or
17 CBM has been instituted. In the interim, Apple’s infringement continues.

18 Apple’s stall tactic of waiting until the statutory deadline to file an IPR or CBM—only to
19 seek a stay of a year-and-a-half of the litigation—severely prejudices OpenTV’s ability to enforce its
20 valid intellectual property rights. Apple argues this case should be stayed pending completion of not-
21 yet-instituted IPR and CBM proceedings because: (1) the case is in its early stages; (2) a stay will
22 simplify issues for trial; and (3) OpenTV will not suffer any tactical disadvantage or undue
23 prejudice. Apple is wrong on each count.

24 First, this case is not in its early stages. During the past year, the parties exchanged
25 infringement and invalidity contentions, served over 200 requests for production; produced over
26 100,000 pages of documents; inspected source code; briefed, argued, and received the Court’s order
27 invalidating two patents; and briefed and argued claim construction before the Court. Although a

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