

1 GEORGE A. RILEY (S.B. #118304)
griley@omm.com
2 LUANN L. SIMMONS (S.B. #203526)
lsimmons@omm.com
3 MELODY DRUMMOND HANSEN (S.B. #278786)
mdrummondhansen@omm.com
4 O'MELVENY & MYERS LLP
5 Two Embarcadero Center, 28th Floor
San Francisco, California 94111-3823
6 Telephone: (415) 984-8700
7 Facsimile: (415) 984-8701

8 RYAN K. YAGURA (S.B. #197619)
ryagura@omm.com
9 XIN-YI ZHOU (S.B. #251969)
vzhou@omm.com
10 BRIAN M. COOK (S.B. #266181)
bcook@omm.com
11 KEVIN MURRAY (S.B. #275186)
kmurray2@omm.com
12 O'MELVENY & MYERS LLP
13 400 South Hope Street
Los Angeles, California 90071-2899
14 Telephone: (213) 430-6000
15 Facsimile: (213) 430-6407

16 *Attorneys for Defendant Apple, Inc.*

17
18 **UNITED STATES DISTRICT COURT**
19 **NORTHERN DISTRICT OF CALIFORNIA**
20 **SAN JOSE**

21 OpenTV, Inc., NagraVision, SA, and Nagra
22 France S.A.S.,

23 *Plaintiffs,*

24 v.

25 Apple Inc.,

26 *Defendant.*

Case No. 5:15-CV-02008-EJD

**DEFENDANT'S MOTION TO
PRECLUDE RELIANCE ON CERTAIN
INVENTION DATES AND TO STRIKE
CERTAIN ALLEGATIONS**

Judge: Honorable Edward J. Davila
Hearing Time: 9:00 a.m.
Hearing Date: Thursday, Sept. 15, 2016
Courtroom: San Jose Courtroom 4

TABLE OF CONTENTS

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

Page

I. INTRODUCTION 2

II. LEGAL BACKGROUND ON PATENT PRIORITY DATES AND THE
NORTHERN DISTRICT OF CALIFORNIA’S REQUIREMENT THAT THEY
BE DISCLOSED EARLY IN LITIGATION 2

III. FACTUAL BACKGROUND 4

IV. THE COURT SHOULD PRECLUDE OPENTV FROM ASSERTING
INVENTION DATES EARLIER THAN THOSE DISCLOSED IN ITS PATENT
LOCAL RULE 3-1(f) DISCLOSURES AND STRIKE ALL LATE
DISCLOSURES OF EARLIER INVENTION DATES AND ALL QUALIFYING
LANGUAGE 6

 A. OpenTV seeks to flagrantly disregard its obligations under Patent Local
 Rules 3-1(f) and 3-2(b) 6

 B. Apple relied on OpenTV’s Local Rule 3-1(f) and 3-2(b) disclosures in
 formulating its invalidity defenses and would suffer significant prejudice if
 OpenTV were allowed to rely on priority dates other than those alleged in
 its October 15, 2015 disclosure 7

 C. The appropriate remedy is to preclude OpenTV from asserting invention
 dates earlier than those disclosed in its Patent Local Rule 3-1(f) disclosures 8

 D. OpenTV cannot demonstrate good cause pursuant to Patent L.R. 3-6 to
 amend its Patent L.R. 3-1(f) and 3-2(b) disclosures, and cannot
 demonstrate good cause pursuant to Fed. R. Civ. P. 16(b) to extend the
 deadline for compliance with Patent L.R. 3-1(f) and 3-2(b) disclosures 10

 E. OpenTV’s vague alleged June, 2001 conception date for the ’169 Patent
 should be limited to June 30, 2001 at the earliest 13

V. CONCLUSION 13

TABLE OF AUTHORITIES1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28**Page(s)****Cases**

<i>Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.</i> , 796 F.2d 443 (Fed. Cir. 1986).....	2
<i>BioGenex Labs. v. Ventana Med. Sys.</i> , 2005 U.S. Dist. LEXIS 45531 (N.D. Cal. Feb. 24, 2005).....	10
<i>Blue Spike, LLC v. Adobe Sys.</i> , No. 14-1647, 2015 U.S. Dist. LEXIS 8778 (N.D. Cal. Jan. 26, 2015).....	4, 10, 13
<i>Fleming v. Escort, Inc.</i> , 774 F.3d 1371 (Fed. Cir. 2014).....	2
<i>Harvatek Corp. v. Cree, Inc.</i> , No. 14-5353, 2015 U.S. Dist. LEXIS 93388 (N.D. Cal. July 17, 2015).....	3, 9
<i>Johnson v. Mammoth Recreations, Inc.</i> , 975 F.2d 604 (9th Cir. 1992).....	10, 11
<i>Mahurkar v. CR Bard, Inc.</i> , 79 F. 3d 1572 (Fed. Cir. 1996).....	3
<i>O2 Micro Int'l, Ltd. v. Monolithic Power Sys.</i> , 467 F.3d 1355 (Fed. Cir. 2006).....	8, 10, 11
<i>Singh v. Brake</i> , 222 F.3d 1362 (Fed. Cir. 2000).....	8
<i>Taurus IP, LLC v. DaimlerChrysler Corp.</i> , 726 F.3d 1306 (Fed. Cir. 2013).....	3, 7
<i>Thought, Inc. v. Oracle Corp.</i> , No. 12-5601, 2015 U.S. Dist. LEXIS 137113 (N.D. Cal. Oct. 7, 2015).....	<i>passim</i>

Statutes

35 U.S.C. § 102.....	2
35 U.S.C. § 103.....	2

Other Authorities

Fed. R. Civ. P. 16.....	2, 9, 10
-------------------------	----------

TABLE OF AUTHORITIES
(continued)

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

Page

Fed. R. Civ. P. 37	9
L.R. 3-1	<i>passim</i>
L.R. 3-2	<i>passim</i>
L.R. 3-6	10
L.R. 4.....	7

NOTICE OF MOTION

PLEASE TAKE NOTICE THAT on September 15, 2016 at 9:00 a.m. in Courtroom 4 before the Honorable Edward J. Davila, Defendant Apple, Inc. (“Apple”) requests the Court grant the following motion.

Apple moves to preclude OpenTV, Inc., Nagravision, SA, and Nagra France S.A.S. (collectively, “OpenTV”) from asserting conception and reduction to practice dates earlier than those identified in its Patent L.R. 3-1(f) and 3-2(b) disclosures, including striking all qualifying language from that disclosure (*e.g.*, “at least as early as”) and all interrogatory responses asserting such earlier invention dates. This motion relates to the three remaining patents-in-suit,¹ U.S. Patent Nos. 6,233,736 (“the ’736 Patent”), 7,055,169 (“the ’169 Patent”), and 7,725,740 (“the ’740 Patent”) (collectively, the “asserted patents”).

The Scheduling Order in this case directs that “any disputes with respect to discovery or disclosure are referred to the assigned Magistrate Judge. Any disputes regarding any party’s Patent Disclosures—including any request to amend pursuant to Patent L.R. 3-6—are likewise referred to the assigned Magistrate Judge.” Dkt. 58 at 1. This motion does not seek additional discovery or disclosures from OpenTV, and does not seek permission to amend pursuant to Patent L.R. 3-6, but rather seeks a preclusionary sanction under Fed. R. Civ. P. 16(f). *See, e.g.*, Order Re Defendant’s Discovery Letter, *Harvatek Corp. v. Cree, Inc.*, No. 14-5353, Dkt. 50 at 1 (N.D. Cal. June 9, 2015) (deeming discovery letter seeking order precluding patentee from asserting a certain conception date appropriate for resolution before the district judge rather than the magistrate), attached to the accompanying Declaration of Melody Drummond Hansen (“Drummond Hansen Decl.”) as Exhibit 9. If the Court deems this motion to be more appropriate for resolution before the Magistrate Judge, then Apple requests the Court refer the motion to the Magistrate Judge.

¹ The Court held two other patents-in-suit, U.S. Patent Nos. 6,148,081 and 7,644,429, invalid, and OpenTV has requested permission to pursue an interlocutory appeal. Dkt. 75 at 6. Apple reserves the right to bring this motion with respect to those patents as well, if the Court’s finding of invalidity is reversed on appeal.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.