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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

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

Plaintiffs,

v.

APPLE INC.,

Defendant.

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

**PLAINTIFFS' REPLY CLAIM CONSTRUCTION BRIEF**

**Date:** May 12, 2016
**Time:** 1:30 p.m.
**Judge:** Honorable Edward J. Davila
**Courtroom:** 4, 5th Floor

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## I. INTRODUCTION

The claims at issue in this case involve simple language for which OpenTV has proposed simple, easily-understood constructions. By contrast, Apple either offers no construction or ignores the plain language of the claims and intrinsic evidence. Apple contends that half of the claims are indefinite, essentially assuming that a person of skill in the art has, in fact, no skill at all and would be unable to understand or perform basic computer programming operations. For the remaining terms, Apple either improperly adds limitations from the specification, or stretches certain claim terms beyond their plain bounds. Rather than basing its constructions on the patent specifications and file histories as understood by a POSA as OpenTV did, Apple improperly bases its approach to claim construction on litigation-strategy. *See* Dkt. No. 85 at 8 ("Apple's agreed and disputed constructions are, in part, oriented toward clarifying whether the scope of the asserted claims extends to what is disclosed by the prior art."). This Court should adopt OpenTV's proposed claim constructions and reject Apple's.

## II. THE '736 PATENT

### A. "automatic and direct access" [Claims 1, 8, 9]

A POSA would be "reasonably certain" as to the meaning of the claim term "automatic and direct access." *See Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2129 (2014). And, indeed, the PTAB had no trouble understanding this very same term in its June 24, 2014 decision. *See* Ex. 15 at *4-5.[1] The PTAB's decision is intrinsic evidence that strongly supports OpenTV's position that "automatic and direct" is not indefinite. *See Phillips v. AWH Corp.*, 414 F.3d 1303, 1317 (Fed. Cir. 2005). Apple argues (1) that the "automatic and direct access" terms failed to add a limitation during prosecution, and (2) that the Applicant's explanation was inconsistent with the claims as amended. Even if this were true—which it is not—neither of these points establishes that a POSA would not be "reasonably certain" as to the meaning and scope of "automatic and direct

[1] Exhibits 1-15 refer to those attached to the March 29, 2016 Declaration of Rajeev Gupta in support of Plaintiff's Opening Claim Construction Brief. Dkt. No. 81. Exhibits 16-18 refer to those attached to the accompanying Declaration of Rajeev Gupta in support of Plaintiff's Reply Claim Construction Brief.

access" in the context of the '736 patent. Instead, "automatic and direct access" is a straightforward claim term that a POSA would easily understand (whether the term added a limitation during prosecution is irrelevant). Apple's indefiniteness argument should be rejected out of hand.

Apple's first argument, that the "automatic and direct access" language does not narrow the claims, is meritless. Indeed, the prosecution history establishes the opposite. Applicant added the "automatic and direct access" phrasing to overcome the examiner's rejection of the then-pending claims over Throckmorton. Ex. 4 at 1-4. In a summary following an examiner interview, the examiner stated:

> Applicant proposed adding language to the claims to indicate the 'automatic' electronic extraction of address data and the establishment of a 'direct link', initiated by the user, to an online information source. These features, if added to the claims, would likely render them allowable over Throckmorton et al alone.

Ex. 16. After the claims were amended to add the "automatic and direct access" limitation, the examiner quickly issued a notice of allowance. Ex. 17. Thus, because Throckmorton did *not* disclose at least "automatic and direct access" to information, the examiner allowed the amended claims. Apple's argument that "automatic and direct access" added nothing is inconsistent with the prosecution history. Rather, the prosecution history demonstrates that the Applicant, the examiner, and ultimately the PTAB, clearly understood the "automatic and direct access" limitation. Apple's argument that a POSA could not be "reasonably certain" as to the claim term's meaning is contradicted by the intrinsic record.

Apple nevertheless alleges that this newly added claim limitation "did not add limitations beyond what one of ordinary skill already understood to exist in claim 8" and that a POSA "would have understood that when a user clicked on a link, the user's computer would have 'automatically' made a 'direct' connection . . . ." Dkt. No. 82 at 3. Apple, however, provides no substantive support for this assertion and relies instead on an expert's *ipse dixit* declaration that merely parrots the same statement from Apple's brief. *See* Dkt. No. 82 at 3, l. 23, citing Dkt. No. 83, Ex. 5 at ¶¶ 20-23. But in the absence of the "automatic and direct" limitation, there is nothing to suggest that merely clicking on a link necessarily causes a computer to "automatically" make a "direct connection." Rather, after

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