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19 UNITED STATES DISTRICT COURT  
20 NORTHERN DISTRICT OF CALIFORNIA  
SAN FRANCISCO 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'S MOTION TO PRECLUDE  
RELIANCE ON CERTAIN INVENTION DATES  
AND TO STRIKE CERTAIN ALLEGATIONS**

Mag. Judge: Honorable Nathanael Cousins  
Hearing Time: 1:00 p.m.  
Hearing Date: June 1, 2016  
Courtroom: San Jose Courtroom 7

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28 **REDACTED VERSION FOR PUBLIC FILING**

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1 **I. INTRODUCTION**

2 Apple's motion is fundamentally flawed and should be denied. Apple's core dispute was  
3 considered and rejected a year ago by Judge Gilliam in *OpenTV, Inc. v. Apple Inc.*, No. C 14-1622-  
4 HSG. After reviewing the parties' briefs and hearing oral argument, Judge Gilliam held that Patent  
5 Local Rule 3-1(f) means what it says when it requires a party to state "priority dates," and it does not  
6 require a party to state "conception dates" as Apple argued then and now. Just as Judge Gilliam  
7 rejected Apple's position, this Court should do the same and deny Apple's motion.

8 In addition to being wrong on the basic premise of its motion, Apple raises two additional,  
9 equally faulty, and contrary, arguments. For two of the asserted patents, Apple argues OpenTV  
10 should not be able to rely on documents it *has not yet produced* to show a conception date earlier  
11 than that currently disclosed. And for the third asserted patent, Apple argues OpenTV should not be  
12 able to rely on documents it *has already produced* that show a conception date earlier than the  
13 priority date.

14 Apple's first argument is premature. OpenTV has repeatedly informed Apple that *if* OpenTV  
15 identifies and produces documents that disclose conception dates earlier than those disclosed by  
16 currently produced documents, OpenTV will file a motion seeking leave to supplement its Patent  
17 Local Rule production and explaining how good cause supports that motion. Apple would then have  
18 a full and fair opportunity to challenge that reliance and the issue would be ripe for the Court's  
19 review. Since none of this has yet occurred, Apple has jumped the gun with its current motion.

20 Apple's second argument seeks to penalize OpenTV for relying on an invention disclosure  
21 form to prove a conception date even though that form was (1) *filed* with the prosecution history of  
22 one of the asserted patents *and relied upon* during prosecution *to show a conception date* that  
23 antedated a reference cited by the Examiner, and (2) *timely produced* to Apple. Apple would have  
24 likely reviewed that prosecution history and invention disclosure form as part of its due diligence  
25 shortly after the complaint was filed. Apple cannot dispute it has been fully aware of the contents of  
26 the file history and their relevance to the conception of the claimed invention.

27 Apple also alleges it would suffer immeasurable prejudice if OpenTV is allowed to rely on  
28

1 identified as a possible conception date in response to Apple's query (for a third patent). Apple's  
2 hyperbole aside, there is no prejudice based on the existing facts.

## 3 **II. RELEVANT LEGAL AND FACTUAL BACKGROUND**

4 Although Apple spent two pages of its brief explaining the legal background of Patent L.R.  
5 3-1(f) and 3-2(b), Apple conspicuously omitted the fact that Apple raised and lost this issue a year  
6 ago in front of Judge Gilliam. A brief overview of the issues and facts from both cases is useful.

### 7 **A. The Patent Local Rules**

8 The Patent Local Rules require parties to disclose certain information on dates set forth in the  
9 procedural schedule. Patent L.R. 3-1(f) requires a patentee to disclose "For any patent that claims  
10 priority to an earlier application, the priority date to which each asserted claim allegedly is entitled."  
11 On the same date, Patent L.R. 3-2(b) requires the patentee to also produce "All documents  
12 evidencing the conception, reduction to practice, design, and development of each claimed  
13 invention, which were created on or before the date of application for the patent in suit or the priority  
14 date identified pursuant to Patent L.R. 3-1(f), whichever is earlier."

15 That is, under Patent L.R. 3-1(f), if a patentee relies on an earlier-filed application to  
16 establish a priority date, the patentee must identify its filing date. Under Patent L.R. 3-2(b), if a  
17 patentee has documents showing conception of the invention "created on or before . . . the priority  
18 date identified in Patent L.R. 3-1(f)," the patentee must produce those documents showing a  
19 conception date that pre-dates the priority date. Interpreting Patent L.R. 3-1(f) to require disclosure  
20 of conception dates would render the requirements of Patent L.R. 3-2(b) meaningless.

### 21 **B. Judge Gilliam's Prior Ruling**

22 On April 9, 2014, Plaintiffs OpenTV, Inc. and Nagravision S.A. filed a complaint for patent  
23 infringement against Apple Inc., which is captioned *OpenTV, Inc. v. Apple Inc.*, No. C 14-1622-HSG  
24 (N.D. Cal. 2014) (*Apple I*). *Apple I*, D.I. 1. That case is currently stayed.<sup>1</sup> *Apple I*, D.I. 222, Sept. 24,  
25 2015 Hearing Tr. at 16 (orally granting Apple's Motion to Stay (*see* D.I. 194, 207, 209)).

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28 <sup>1</sup> For purposes of simplicity, the plaintiffs in both actions against Apple (*Apple I* and this case) are referred to herein as "OpenTV."

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