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19 UNITED STATES DISTRICT COURT  
20 NORTHERN DISTRICT OF CALIFORNIA  
21 SAN FRANCISCO DIVISION

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

23 Plaintiffs,

24 v.

25 APPLE INC.,

26 Defendant.

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

**DECLARATION OF ELIZABETH A.  
NIEMEYER IN SUPPORT OF  
PLAINTIFFS' OPP. TO DEFENDANT'S  
MOT. TO PRECLUDE RELIANCE ON  
CERTAIN INVENTION DATES AND  
TO STRIKE CERTAIN ALLEGATIONS**

Mag. Judge: Nathanael Cousins  
Hearing Time: 1:00 p.m.  
Hearing Date: June 1, 2016

1 I, Elizabeth A. Niemeyer, declare as follows:

2 1. I am an attorney licensed to practice in the District of Columbia and admitted *pro hac*  
3 *vice* to practice before this Court. I am a partner with Finnegan, Henderson, Farabow, Garrett &  
4 Dunner, LLP, counsel of record for OpenTV, Inc., Nagravision S.A., and Nagra France S.A.S.  
5 (collectively “OpenTV”) in the above-entitled action. I have personal knowledge of the facts  
6 contained in this Declaration, and if called upon to do so, I could and would testify competently  
7 thereto.

8 2. I submit this Declaration in support of Plaintiffs’ Opposition to Defendant’s Motion  
9 to Preclude Reliance on Certain Invention Dates and to Strike Certain Allegations.

10 3. Attached as Exhibit 1 is a true and correct copy of pages 1 through 21 of the April 22,  
11 2015 hearing transcript from *OpenTV, Inc. v. Apple Inc.*, No. C 14-1622-HSG, D.I. No. 172.

12 4. Attached as Exhibit 2 is a true and correct copy of excerpts from the file history for  
13 U.S. Patent No. 6,233,736 corresponding to an affidavit and accompanying exhibits submitted by the  
14 applicant during the prosecution of that patent.

15 5. Attached as Exhibit 3 is a true and correct copy of the Contents page of the file  
16 history for U.S. Patent No. 6,233,736

17 6. Attached as Exhibit 4 is a true and correct copy of an email between counsel for  
18 OpenTV and Defendant Apple Inc., dated March 29, March 30, April 4, and April 5 2016 (submitted  
19 for partial filing under seal).

20 7. On April 9, 2014, Plaintiffs OpenTV, Inc. and Nagravision S.A. filed a complaint for  
21 patent infringement against Apple Inc., which is captioned *OpenTV, Inc. v. Apple Inc.*, No. C 14-  
22 1622-HSG (N.D. Cal. 2014) (*Apple I*). That case is currently stayed.

23 8. In accordance with the procedural schedule in in *Apple I* and the Patent Local Rules,  
24 OpenTV served its infringement contentions and accompanying document production, which  
25 included for each asserted patent (1) an identification of the priority date (*i.e.*, the earliest filing date)  
26 (Patent L.R. 3-1(f)), and (2) copies of all non-privileged documents evidencing a conception date  
27 earlier than the priority date (Patent L.R. 3-2(b)).

28

1           9.       Apple subsequently served its invalidity contentions and accompanying document  
2 production under Patent L.R. 3-3 and 3-4.

3           10.       After receiving Apple's invalidity contentions, OpenTV decided to waive privilege  
4 on certain invention disclosure documents that evidenced a conception date earlier than that  
5 disclosed in OpenTV's Patent L.R. 3-2(b) document production for one of the patents. OpenTV  
6 consequently filed a motion for leave to supplement its Patent L.R. 3-2(b) production with the  
7 invention disclosure documents. *Apple I*, D.I. 124.

8           11.       The day after OpenTV filed its motion, Apple served its first set of discovery  
9 requests, which included, *inter alia*, an interrogatory seeking "the circumstances surrounding the  
10 conception and reduction to practice of the claimed invention" for each asserted patent.

11           12.       Apple opposed OpenTV's motion to supplement its Patent L.R. 3-2(b) production,  
12 arguing that Patent L.R. 3-1(f)—which calls for an identification of a patent's "priority date"—  
13 required OpenTV to disclose any conception date, which is the same argument Apple makes in its  
14 motion before this Court. Apple also argued that Patent L.R. 3-2(b) required OpenTV to produce all  
15 conception documents, regardless of whether they were privileged.

16           13.       Judge Gilliam heard oral argument on OpenTV's motion to supplement its Patent  
17 L.R. 3-2(b) production on April 22, 2015, and granted OpenTV's motion. *Apple I*, D.I. 172.

18           14.       On May 5, 2015, Plaintiffs OpenTV, Inc., Nagra Vision S.A., and Nagra France S.A.S.  
19 filed the complaint in this action against Apple. For simplicity, the plaintiffs in *Apple I* and this  
20 action are each referred to collectively as "OpenTV."

21           15.       On October 15, 2015, OpenTV served its "Disclosure of Asserted Claims and  
22 Infringement Contentions" under Patent L.R. 3-1 and produced documents as required by Patent  
23 L.R. 3-2. In accordance with Patent L.R. 3-1(f), and consistent with Judge Gilliam's ruling in *Apple*  
24 *I*, OpenTV identified the priority date for each asserted patent. OpenTV also produced the  
25 documents required under Patent L.R. 3-2, including documents evidencing conception earlier than  
26 the priority dates identified under Patent L.R. 3-1(f) and the file histories for each asserted patent,  
27 including U.S. Patent No. 6,233,736 ("the '736 patent"). OpenTV also identified one subcategory of

28 Patent L.R. 3-2(a) which each produced document related OpenTV's Patent L.R. 3-2(b) submission

1 also stated, “Although not required by the Patent Local Rules but in the interest of providing notice  
2 to Apple, OpenTV claims a conception date for the ’169 patent of June 2001. OpenTV has not  
3 produced privileged documentation with this disclosure. *See OpenTV, Inc. v. Apple Inc.*, No. C 14-  
4 1622 HSG, Dkt. No. 172, April 22, 2015 Hearing Tr. at 4-21 (N.D. Cal. 2014).” D.I. 85-3, Ex. 1 at 8.

5 16. The complete file history for the ’736 patent (excluding cited references) is fewer  
6 than 200 pages. During prosecution, the Examiner twice rejected the application. In response to the  
7 first rejection over certain prior art, the applicant submitted an affidavit with an invention disclosure  
8 form and other supporting documents, totaling 22 pages, demonstrating that the inventor conceived  
9 of and diligently reduced to practice the claimed subject matter before the date of the prior art  
10 identified by the Examiner. Ex. 2. That invention disclosure form is dated September 14, 1995. The  
11 Contents page of the file history, which provides an overview of all documents submitted during  
12 prosecution of a patent application, clearly lists the applicant’s affidavit. Ex. 3.

13 17. On November 23, 2015—five weeks after receiving OpenTV’s Patent L.R. 3-1 and 3-  
14 2 disclosures—Apple served its first set of discovery requests on OpenTV, including Interrogatory  
15 No. 8 seeking, *inter alia*, “the circumstances surrounding the conception and reduction to practice of  
16 the claimed invention.” *See* D.I. 84-7, Ex. 8 at 1. Apple’s first set of discovery requests required a  
17 response 30 days later—December 23, 2015 (Fed. R. Civ. P. 33). Two weeks after serving its first  
18 discovery requests, on December 7, 2015, Apple served its invalidity contentions and accompanying  
19 document production as required by Patent L.R. 3-3 and 3-4. Two weeks after receiving Apple’s  
20 invalidity contentions and 30 days after receiving Apple’s first set of discovery requests, on  
21 December 23, 2015, OpenTV served its responses to Apple’s first set of discovery requests. For  
22 Interrogatory No. 8, which sought, *inter alia*, an identification of OpenTV’s claimed conception date  
23 for each asserted patent, OpenTV inadvertently identified an incomplete subset of the documents  
24 produced as part of Patent L.R. 3-2 production and inadvertently failed to list the invention  
25 disclosure form from the ’736 patent file history. D.I. 84-5, Ex. 2 at 12-14.

26 18. On February 2, 2016, more than one month after receiving OpenTV’s interrogatory  
27 responses, Apple asked OpenTV for the first time to confirm that the documents identified in

28

responses to Interrogatory No. 8 “represent a complete production of all evidence that OpenTV

1 intends to rely on to support the alleged conception dates of the OpenTV Asserted Patents.” D.I. 85-  
2 6, Ex. 4 at 2. Apple acknowledged that “OpenTV does not include any information about a  
3 conception date or actual reduction to practice” for the ’736 and ’740 patents and asked that OpenTV  
4 “[p]lease confirm that OpenTV does not allege any conception date for the ’736 patent earlier than  
5 February 8, 1996” or a “a conception date for the ’740 patent earlier than May 28, 2003.” *Id.* at 3.  
6 Apple also requested that OpenTV “identify by production number any documents OpenTV  
7 contends relate to conception or diligence for the claimed invention of the ’169 patent.” *Id.*

8 19. After receiving Apple’s inquiry and further consideration, OpenTV first realized it  
9 inadvertently failed to identify the invention disclosure form filed during the prosecution of the ’736  
10 patent application in response to Apple’s Interrogatory No. 8. OpenTV promptly notified Apple that  
11 it intends to rely on those invention disclosure documents and would supplement its interrogatory  
12 response to specifically identify them. D.I. 85-7, Ex. 5. OpenTV provided that supplemental  
13 response shortly thereafter. D.I. 84-7, Ex. 8 at 3.

14 20. Regarding the ’169 patent, during the parties’ meet-and-confer session, OpenTV  
15 confirmed that it has not produced privileged documents reflecting the June 2001 conception date  
16 and that it is considering whether or not to waive privilege and produce those privileged documents.  
17 OpenTV has not identified any non-privileged documents that reflect a June 2001 conception date  
18 for the ’169 patent. To date, OpenTV has not decided whether to waive privilege but has repeatedly  
19 informed Apple that, if it decides to do so, OpenTV will seek leave of court to supplement its Patent  
20 L.R. 3-2(b) production, just as it did in *Apple I*.

21 21. Regarding the ’740 patent, OpenTV has been diligently investigating whether it can  
22 assert a conception date earlier than the ’740 patent’s priority date. As part of that ongoing  
23 investigation, OpenTV determined that it may be able to support an earlier conception date. That  
24 investigation is still ongoing and OpenTV has not yet identified supporting documents. Nevertheless,  
25 after identifying a potentially earlier conception date, OpenTV quickly brought that information to  
26 Apple’s attention. D.I. 86-3, Ex. 7 at 1.

27 22. Apple asked OpenTV to further break down the documents identified in OpenTV’s  
28 response to Interrogatory No. 8 (OPENTV2008-00008615, OPENTV2008-00000148) requested

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