

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Apple Inc.,
Petitioner

v.

OpenTV, Inc.,
Patent Owner.

Case No. _____

**PETITION FOR COVERED BUSINESS METHOD PATENT REVIEW
OF U.S. PATENT NO. 7,055,169 CHALLENGING CLAIMS 1, 2, 12, 22,
AND 23 UNDER 35 U.S.C. § 321, 37 C.F.R. § 42.304**

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LIST OF EXHIBITS

Exhibit No.	Description
1001	U.S. Patent No. 7,055,169
1002	Prosecution File History of U.S. Patent No. 7,055,169
1003	U.S. Provisional application No. 60/373,883
1004	Declaration of Dr. Stephen Melvin
1005	Curriculum Vitae of Dr. Stephen Melvin
1006	<i>OpenTV, Inc., et al. v. Apple Inc.</i> , Case No. 5:15-CV-02008-EJD, Complaint, Dkt. No. 1 (N.D. Cal., filed May 5, 2015).
1007	The American Heritage College Dictionary (3d ed. 1993) (excerpt)
1008	The New Shorter Oxford English Dictionary (1993) (excerpt)
1009	Exhibit A to Joint Claim Construction and Prehearing Statement from <i>OpenTV, Inc., et al. v. Apple Inc.</i> , Case No. 5:15-CV-02008-EJD, Dkt. No. 74-1 (N.D. Cal., filed Feb. 12, 2016).
1010	<i>OpenTV, Inc. v. Apple Inc.</i> , No. 5:15-CV-02008-EJD, Dkt. No. 72 (N.D. Cal. Jan. 28, 2016).

I. INTRODUCTION

U.S. Patent No. 7,055,169 (“the ’169 Patent,” attached as Ex. 1001) relates to “interactive television systems” that provide services to subscribers “such as commerce via the television.” Ex. 1001 at 1:15-23. The claims of the ’169 Patent are directed to an abstract concept implemented using nothing more than conventional technology—the claims lack any technological innovation. *See, e.g., id.* at claim 1. Thus, the ’169 Patent falls within the type of business method patents Congress had in mind when it enacted legislation to provide a program for Covered Business Method (“CBM”) review. *See* 37 C.F.R. § 42.301.

Apple Inc. (“Petitioner”) hereby petitions the Patent Trial and Appeal Board of the United States Patent and Trademark Office (the “Board”) to institute a CBM review of claims 1, 2, 12, 22, and 23 of the ’169 Patent (the “Challenged Claims”) based on the following ground: The Challenged Claims are directed to an abstract idea—ensuring that necessary resources are available before commencing a presentation—and do not add any inventive concept, and are, therefore, invalid for claiming ineligible subject matter under 35 U.S.C. § 101. This ground is reasonably likely to prevail, and this Petition, accordingly, should be granted.

II. GROUNDS FOR STANDING, MANDATORY NOTICES, AND FEE AUTHORIZATION

A. The '169 Patent Is A Covered Business Method Patent

1. Covered Business Method Patents

A CBM patent, as defined by the Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, 125 Stat. 284, 331 (2011) is “a patent that claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions.” AIA § 18(d)(1); 37 C.F.R. § 42.301.

A patent is eligible for CBM review if it “claim[s] activities that are financial in nature, incidental to a financial activity or complementary to a financial activity.” 77 Fed. Reg. 48,734, 48,735 (Aug. 14, 2012) (citation omitted). The scope of CBM review “is not limited to products and services of only the financial industry, or to patents ... directly affecting the activities of financial institutions such as banks and brokerage houses.” *Versata Dev. Grp., Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1325 (2015). Rather, the term “‘financial product or service’ should be interpreted broadly.” 77 Fed. Reg. 48,734, 48,735; *see also*, *Liberty Mutual Ins. Co. v. Progressive Casualty Ins. Co.*, CBM2012-00002, Institution Decision, Paper 36 at 23, (P.T.A.B. Jan. 9, 2013) (finding that the word “financial” is “an adjective that simply means relating to monetary matters.”). For

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