UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.
Petitioner

v.

OPENTV, INC.
Patent Owner

Case IPR2015-01031
Patent 7,900,229

**Patent Owner's Response
to Petition for *Inter Partes* Review
of U.S. Patent No. 7,900,229**

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I.   PRELIMINARY STATEMENT

The Board instituted only one of the many grounds proposed in the Petition—anticipation based on Tomioka. Inst. Dec. 18. The Petition, however, fails to establish that Tomioka anticipates the claims because the Petition fails to address all of the claim requirements and therefore cannot prove that Tomioka discloses every claim element.

II.   ANTICIPATION IS A HIGH BAR

Anticipation is a high bar and, "with its strict identity requirement, [is] quite rare." *See, e.g., Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1297 (Fed. Cir. 2002). This is because a reference cannot anticipate "unless a reference discloses *within the four corners* of the document not only *all of the limitations* claimed but also *all of the limitations arranged or combined in the same way* as recited in the claim. . . ." *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008) (emphasis added). The "arranged or combined in the same way" requirement "applies to all claims and refers to the need for an anticipatory reference to show all of the limitations of the claims arranged or combined in the same way as recited in the claims, not merely in a particular order." *Id.* at 1370. Any "differences between the prior art reference and a claimed invention, *however slight*, invoke the question of obviousness, not anticipation." *Id.* at 1371 (emphasis added). "Thus, *it is not enough that the prior art reference discloses part of the*

claimed invention, which an ordinary artisan might supplement to make the whole, or that it includes multiple, distinct teachings that the artisan might somehow combine to achieve the claimed invention." *Id.* (emphasis added).

III. THE PETITION FAILS TO ESTABLISH ANTICIPATION OF THE INDEPENDENT CLAIMS

The instituted claims include two independent claims—claims 14 and 26. Claims 14 and 26 differ in scope but require similar functionality. *Compare* Ex. 1001, cl. 14 *with* cl. 26. The remaining challenged claims, claims 15, 16, 19, 21, 24, 28, 30, and 31, each depend from one of these independent claims. The Petition does not present separate arguments for claim 26's functionality, instead just pointing to its discussion of claim 14. Pet. 31-32.

Claims 14 and 26 require a combination of elements not disclosed by Tomioka. Specifically, Tomioka fails to disclose the combination of requirements of system claim 14:

> 14. An interactive television system comprising:
> a remote unit; a set-top box; and
> a broadcast station coupled to convey a programming
> signal to the set-top box;
> wherein the system is configured to:
> *update a user profile responsive to a first user*
> *activity, the first user activity being initiated via a first*
> *device corresponding to one of the remote unit and*
> *the set-top box;*

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