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

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

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I. INTRODUCTION

The Petition establishes that Tomioka anticipates Claims 14–16, 19, 21, 24, 26, 28, 30, and 31 (the "Challenged Claims") of U.S. Patent No. 7,900,229 ("the '229 Patent"). *See* Paper 1 ("Pet.") at 11–33. Patent Owner's Response provides no evidence to the contrary, and does not even mention Claims 15, 16, 19, 21, 28, and 30. *Id.* The Board should, therefore, cancel the Challenged Claims.

Patent Owner fails to explain how Tomioka differs from the Challenged Claims, instead vaguely complaining that the Petition cites too many paragraphs from Tomioka and implying that those citations correspond to multiple embodiments. Paper 14 ("Resp.") at 3–4, 9. But the Board already found that the Petition provided adequate explanation and argument regarding how the cited portions of Tomioka anticipate the claims, and also found that the cited portions of Tomioka relate to a single embodiment. Paper 10 ("Inst. Dec.") at 11–12.

II. PATENT OWNER'S RESPONSE TURNS ANTICIPATION INTO AN *IPSISSIMIS VERBIS* TEST THAT IGNORES THE UNDERSTANDING AND INFORMATION TOMIOKA PROVIDES TO ONE SKILLED IN THE ART

The Petition explained the direct correspondence between the teachings of Tomioka and each of the limitations of the Challenged Claims. Pet. 11–33. That showing of anticipation was supported by expert testimony demonstrating how one skilled in the art would understand Tomioka and the '229 Patent. *Id*. (citing Apple 1016). Patent Owner's Response ignores most of the showing in the Petition and

the teachings of Tomioka, instead making conclusory assertions that Tomioka does not contain the exact same words as the Challenged Claims. *See, e.g.*, Resp. 12 (alleging without explanation that the words of Tomioka differ from the Claim term "transmitting"). But anticipation "is not an *ipsissimis verbis* test." Inst. Dec. 7, citing *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990). "[I]t is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." Inst. Dec. 7–8, quoting *In re Preda*, 401 F.2d 825, 826 (CCPA 1968); *see also* Inst. Dec. 12, citing *Kennametal, Inc. v. Ingersoll Cutting Tool Co.*, 780 F.3d 1376, 1381 (Fed. Cir. 2015). By failing to consider the application of these cases, Patent Owner incorrectly ignores the teachings of Tomioka, in violation of *In re Bond*, and ignores the understanding of one of ordinary skill, in violation of *In re Preda* and *Kennametal*. Patent Owner's arguments were rejected by the Board in its Institution Decision (Inst. Dec. 10–12) and should be rejected again.

III. THE PETITION EXPLAINS HOW TOMIOKA ANTICIPATES CLAIMS 14 AND 26

Patent Owner's argument that the Petition generalizes Claims 14 and 26 by summarizing the prosecution history is wrong. *See* Resp. at 4–5. The Petition did not generalize the claims—the Petition explained how Tomioka discloses each limitation expressly and separately. *See* Pet. 11–33.

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