UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.
Petitioner

v.

OPENTV, INC.
Patent Owner

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Case IPR2015-01031
Patent 7,900,229

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

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I. PRELIMINARY STATEMENT

The petition asserts that seven different grounds independently render claims 14-16, 19, 21, 24, 26, 28, 30, and 31 of U.S. Patent No. 7,900,229 unpatentable, but never addresses the differences between each ground. Worse still, the presented grounds lack any particularity. For example, the anticipation grounds provide string citations to references but lack an explanation of whether or how the different citations combine to anticipate the claims. And the obviousness grounds generally assert that claims are obvious but lack an explanation of which reference is relied upon to teach which element of the claims. According to the well-established framework set forth in statute, rules, and the Board's representative orders, these deficiencies render Apple's petition incomplete and the proposed grounds should be denied.

II. THE PETITION ATTEMPTS TO RECAST THE REASONS FOR ALLOWANCE

In framing its proposed grounds, Apple attempts to recast the Board's prior review of the patent's claims as having determined whether the prior art discloses a common user profile. Pet. 7. That characterization, however, omits the reasons the Board found the prior art lacking during its last review of the '229 patent claims.

In its prior consideration of these claims, the Board's analysis focused on the interaction between the first user activity and the second user activity, not only a

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common user profile as Apple suggests. The relevant section of the Board's order

is copied below. Ex. 1002 at 12.

whereas, Appellant argues *inter alia* that

> The interaction between the disparate activities is clear from the claims – the first activity affects the content received by the user in response to the second activity. Ellis nowhere discloses such a common profile and interaction between these two different types of activities as recited.

(App. Br. 12).

Thus, we have to determine whether Ellis describes any interaction between the first user activity and the second user activity.

Although Ellis describes updating a user profile responsive to a first user activity related to television viewing via a first device (e.g., a remote) (¶¶ 0024, 0123-0126, 0160, 0161), and initiating a second user activity unrelated to television viewing by participating in a chat application via a second device (e.g., a set top box) that differs from the first device (¶¶ 0020, 0179), Ellis is completely silent as to accessing "the user profile in response to the second user activity" (i.e., chat application) as required by all of the claims on appeal. Ellis is equally silent as to whether the first user activity of updating a user profile "affects a content of" data transmitted to a user "responsive to the second user activity" (i.e., chat application) as required by all of the claims on appeal. Thus, Appellant correctly argued that Ellis lacks a description of any interaction between the first user activity and the second user activity.

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