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Paper 31
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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 B2

Before JAMES B. ARPIN, DAVID C. MCKONE, and SCOTT C. MOORE, *Administrative Patent Judges*.

ARPIN, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

A. Background

Apple Inc. ("Petitioner") filed a Petition (Paper 1, "Pet.") to institute an *inter partes* review of claims 14–16, 19, 21, 24, 26, 28, 30, and 31 of U.S. Patent No. 7,900,229 B2 (Ex. 1001, "the '229 patent"). OpenTV, Inc. ("Patent Owner") filed a Preliminary Response (Paper 6, "Prelim. Resp."). Pursuant to 35 U.S.C. § 314, in our Decision to Institute (Paper 10, "Dec."), we instituted this proceeding as to each of the challenged claims.

Petitioner relies upon the following reference and declaration in support of its grounds for challenging the identified claims of the '229 patent:

Exhibit No.	Reference and Declaration
1003	Patent Application Publication No. EP 1 100 268 A2 to Tomioka *et al.* ("Tomioka")
1016	Declaration of Charles D. Knutson, Ph.D.

Petitioner asserts that all of the challenged claims are unpatentable on the following ground (Pet. 2–3, 11–33):

Claims	Ground	Reference
14–16, 19, 21, 24, 26, 28, 30, and 31	35 U.S.C. § 102(a)	Tomioka

After institution, Patent Owner filed a Patent Owner Response (Paper 14, "PO Resp."), and Petitioner filed a Reply to the Patent Owner Response (Paper 15, "Reply"). A hearing was held on June 21, 2016, and a transcript of that hearing is part of this record. Paper 21 ("Tr.").

We have jurisdiction under 35 U.S.C. § 6(b). This decision is a Final Written Decision under 35 U.S.C. § 318(a) as to the patentability of the challenged claims. Based on the record before us, Petitioner has demonstrated, by a preponderance of the evidence, that challenged claims

14–16, 19, 21, 26, 28, and 30[1] of the '229 patent are unpatentable, but has not demonstrated, by a preponderance of the evidence, that challenged claims 24 and 31 of the '229 patent are unpatentable.

B. Related Matter

The parties indicate that the '229 patent is the subject of *OpenTV, Inc. v. Apple Inc.*, Civil Action No. 3:14-cv-01622-HSG (N.D. Cal. 2014). Pet. 1; Paper 5, 2. The parties identify additional cases involving the '229 patent, as well as other *inter partes* review proceedings involving the same parties, in their Joint Motion to Terminate. Paper 22, 3–4. Nevertheless, the parties indicate that the disputes in those additional cases have been settled and that the cases have been dismissed with prejudice. *Id.* at 3.

C. The '229 Patent

The '229 patent is directed to "[a] system and method for utilizing user profiles in an interactive television system." Ex. 1001, Abstract. The system can create or update a user profile, or both, based on a user's activity on a first device, and select data to transmit to a user on a second device based at least in part on the profile. *Id.*; *accord id.* at col. 6, l. 54–col. 7, l. 3. The Specification indicates that it was known in the art that interactive television systems could provide content other than television, and could allow for user input and personalization. *Id.* at col. 1, ll. 15–18, 30–45. It also was known that such systems frequently include "a set-top box connected to a television set and a recording device, but may consist of any number of suitable devices." *Id.* For example, an interactive television system may include a broadcast station, a set-top box, and a remote unit,

[1] *See infra* note 2.

such as a mobile or fixed unit. *See id.* at col. 2, ll. 11–58, Abstract.

The Specification of the '229 patent teaches systems and methods in which a "user may access the system through various means," and the system "creat[es] and maintain[s] a user profile which reflects activity of the user within the system." *Id.* at col. 1, l. 63–col. 2, l. 1. A user's activity "such as television viewing" may create or update "a user profile which reflects the user's viewing activities," and the user's profile may reflect other activities such as "cell phone or other mobile unit activities and communications." *Id.* at col. 2, ll. 1–6, col. 7, ll. 18–42; *see also id.* at col. 2, l. 59–col 3, l. 2 ("The user may also input information into the user profile."), col. 13, ll. 1–3 ("Web surfing"). Information is delivered to a user on a device based at least in part on a user profile available across devices. *See id.* at col. 6, l. 64–col. 7, l. 3, col. 10, ll. 47–60. For example, "a user's cell phone activity may affect the information the user receives at home on their television, and vice versa." *Id.* at col. 2, ll. 6–10.

D. Illustrative Claim

As noted above, Petitioner challenges claims 14–16, 19, 21, 24, 26, 28, 30, and 31 of the '229 patent. Claims 14 (an interactive television system) and 26 (a computer readable storage medium) are independent. Claims 15, 16, 19, 21, and 24 depend directly or indirectly from claim 14;

and claims 28, 30, and 31 depend directly or indirectly from claim 26.[2]

Claim 14 is illustrative and is reproduced below:

> 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;
>
> detect a second user activity, the second user activity being initiated via a second device corresponding to one of the

[2] Claim 21 depends from claim 14 via intervening claim 20, and claim 28 depends from claim 26 via intervening claim 27. Petitioner does not challenge claim 20 or 27 expressly. *See* Pet. 30, 53–54; Ex. 1016 ¶¶ 99. Because we did not institute review of claims 20 and 27, we do not now rule on the patentability of claims 20 and 27. Nevertheless, because we instituted on the asserted ground of anticipation by Tomioka, we necessarily consider the limitations of intervening claims 20 and 27 in our evaluation of claims 21 and 28, respectively. Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions, 77 Fed. Reg. 48612, 48619 (Aug. 14, 2012) ("To understand the scope of a dependent claim, the claims from which the dependent claim depends must be construed along with the dependent claim. Accordingly, for fee calculation purposes, each claim challenged will be counted as well as any claim from which a claim depends, unless the parent claim is also separately challenged."); *see Cuozzo Speed Techs. LLC v. Lee*, 136 S. Ct. 2131, 2154 (2016) (Alito, J., concurring in part and dissenting in part; "The problem for Cuozzo is that claim 17—*which the petition properly challenged*—incorporates all of the elements of claims 10 and 14. Accordingly, an assertion that claim 17 is unpatentable in light of certain prior art is necessarily an assertion that claims 10 and 14 are unpatentable as well." (emphasis added)).

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