

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.*

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

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 Patent No. US 7,900,229 B2 (Ex. 1001; “the ’229 patent”) pursuant to 35 U.S.C. §§ 311–319. Pet. 1. OpenTV, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 6; “Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314,¹ which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a).

Petitioner relies upon the following references, documents, and declaration in support of its grounds for challenging the identified claims of the ’229 patent:

Exhibit No.	References, Documents, and Declaration
1003	Patent Application Publication No. EP 1 100 268 A2 to Tomioka <i>et al.</i> (“Tomioka”)
1004	Excerpts from Jochen Schiller, <i>Mobile Communications</i> (2000) (“Schiller”)
1005	Unexamined Patent Application Publication No. JP H11-7453 A to Kotani, and Certified English Translation (“Kotani”)
1006	Patent No. US 7,305,691 B2 to Cristofalo (“Cristofalo”)
1007	Patent Application Publication No. US 2002/0111154 A1 to Eldering <i>et al.</i> (“Eldering”)
1016	Declaration of Charles A. Knutson

¹ See Section 6(a) of the Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 116 Stat. 284, 300 (2011).

Petitioner asserts that all of the challenged claims are unpatentable on any of the following grounds (Pet. 2–3, 11–60):

Claims	Grounds	Reference(s)
14–16, 19, 21, 24, 26, 28, 30, and 31	35 U.S.C. § 102(a)	Tomioka
14–16, 19, 21, 24, 26, 28, 30, and 31	35 U.S.C. § 103(a)	Tomioka
14–16, 19, 21, 24, 26, 28, 30, and 31	35 U.S.C. § 103(a)	Tomioka and Schiller
14–16, 19, 21, 24, 26, 28, 30, and 31	35 U.S.C. § 103(a)	Tomioka and Kotani
14–16, 19, 21, 24, 26, 28, 30, and 31	35 U.S.C. § 102(e)	Cristofalo
14–16, 19, 21, 24, 26, 28, 30, and 31	35 U.S.C. § 103(a)	Cristofalo
14–16, 19, 21, 24, 26, 28, 30, and 31	35 U.S.C. § 103(a)	Cristofalo and Eldering

For the reasons set forth below and on this record, we determine that Petitioner demonstrates a reasonable likelihood of prevailing in showing that claims 14–16, 19, 21, 24, 26, 28, 30, and 31 of the '229 patent are anticipated by Tomioka; but that Petitioner fails to demonstrate a reasonable likelihood of prevailing in showing the unpatentability of any of the other challenged claims on any other asserted ground. Accordingly, we *grant* institution of *inter partes* review as to claims 14–16, 19, 21, 24, 26, 28, 30, and 31 of the '229 patent.

B. Related Proceedings

The parties indicate that the '229 patent is the subject of *OpenTV, Inc. et al. v. Apple Inc.*, Civil Action No. 3:14-cv-01622-HSG (N.D. CA). Pet. 1; Paper 5, 2.

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 may 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. Interactive television systems were known for providing content besides television and for allowing user input and personalization. *Id.* at col. 1, ll. 15–18, 30–45. It was known that 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, such as a mobile or fixed unit. *See id.* at col. 2, ll. 11–58, Abstract.

In particular, the Specification of the '229 patent teaches a system and method 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

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 remote unit and the set-top box, the second device being different from the first device, *wherein either*

(i) the first user activity comprises an activity related to

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. Nevertheless, because we institute on the asserted ground of anticipation by Tomioka, we consider the limitations of claims 20 and 27 in our evaluation of claims 21 and 28, respectively.

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