

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 IPR2016-00992  
Patent 6,233,736 B1

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Before JAMESON LEE, SALLY C. MEDLEY, and  
MICHAEL R. ZECHER, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

ORDER  
Conduct of Proceedings  
*37 C.F.R. § 42.5*

On August 9, 2016, a telephone conference call was held. The participants were respective counsel for the parties and Judges Lee, Medley, and Zecher. The purpose of the call was to discuss the parties' Joint Motion to Terminate Proceeding (Paper 8).

1.

We noted that none of the settlement agreements filed in support of the Joint Motion to Terminate explicitly mention the Patent Owner, and asked the parties to review whether there is an understanding or agreement involving the Patent Owner in contemplation of termination of the proceeding. Counsel for the parties replied that there is such an understanding and expectation by “everyone.”<sup>1</sup> We directed the parties to comply with 37 C.F.R. § 42.74(b) with respect to that understanding.

2.

Because some of the settlement agreements filed in support of the Joint Motion to Terminate involve Kudelski S.A., the alleged “parent” of Patent Owner, we asked Patent Owner to update its Mandatory Notices, to indicate that Kudelski S.A. is its parent company. We also asked Patent Owner to review, while updating its Mandatory Notices, whether Kudelski S.A. should be identified as a real party in interest.

3.

We noted that Schedule A-1 to Exhibit 2001, which purports to list the licensed patents, appears to be missing an attachment and asked the parties to check in that regard. The same is true with respect to Schedule A-1 in Exhibit 2002. We, however, take this opportunity to remind the parties that Petitioner does not have access to Exhibit 2002. Thus, Patent Owner alone will perform that checking for Exhibit 2002.

Counsel for the parties inquired how they would correct a missing attachment in these exhibits, if any. We directed them to file a complete agreement under the same exhibit number, but also to ask for expungement

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<sup>1</sup> “Everyone” includes Petitioner and Patent Owner.

of the incomplete agreement. This may be done by contacting the Board administrative staff at [Trials@uspto.gov](mailto:Trials@uspto.gov) or 571-272-7822.

4.

The parties have filed Joint Motions for termination in other proceedings now pending before the Board. We inquired whether the parties intend that *all* proceedings are terminated *or none* is terminated, or that there is no such restrictive contingency requirement. Counsel for the parties replied that there is no such restrictive contingency.

5.

The parties intend that Petitioner does not have access to Exhibit 2002 and that Patent Owner does not have access to Exhibit 1017. For that reason, they have filed Exhibits 1017 and 2002 as “available only to Board.” We explained that the Board is not a party to such an agreement regarding restrictive access, and we simply authorize the filing of these two exhibits as “available only to Board.”

#### ORDER

It is

ORDERED that within one week of entry of this Order, Patent Owner shall file updated Mandatory Notices consistent with the above discussion;

FURTHER ORDERED that within one week of entry of this Order, the parties shall file replacement Exhibits 2001 and 2002, if any is necessary according to the above discussion; and

FURTHER ORDERED that within three weeks of entry of this Order, the Patent Owner shall file a true copy of a writing that reflects an agreement or understanding between Petitioner and Patent Owner made in connection

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with or in contemplation of termination of this proceeding.<sup>2</sup> *See* 37 C.F.R.  
§ 42.74(b).

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<sup>2</sup> During the conference call, we indicated that the agreement to be filed needs to involve Patent Owner, but not necessarily Petitioner. However, 37 C.F.R. § 42.74(b) refers to agreement or understanding between the parties. Accordingly, we now make this requirement for an agreement or understanding between Petitioner and Patent Owner. The existence of such an “understanding” was acknowledged by counsel for the parties during the conference call.