

Paper No. _____

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OPENTV, INC.
Petitioner

v.

Patent of CISCO SYSTEMS, INC., CISCO TECHNOLOGY INC., SCIENTIFIC-ATLANTA, LLC, SCIENTIFIC-ATLANTA, INC. AND NDS AMERICAS INC.
Patent Owner

Case IPR2013-00328
Patent 6,744,892

Title: METHOD AND APPARATUS FOR GEOGRAPHICALLY
LIMITING SERVICE IN A CONDITIONAL ACCESS SYSTEM

**PATENT OWNER'S PRELIMINARY RESPONSE
UNDER 37 C.F.R. §§ 42.107**

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I. INTRODUCTION

Patent Owner Cisco Systems, Inc., (“Cisco”) submits the following preliminary response to the Petition filed by OpenTV Inc., (“OpenTV”) on June 7, 2013, requesting inter partes review of claims 1-38 (all of the claims) of U.S. Patent No. 6,744,892 (OpenTV-1001, the “’892 Patent”). Cisco respectfully requests that the Board decline to institute *inter partes* review of the ’892 Patent because OpenTV has not adequately satisfied Office regulations: “[t]he petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon.” 37 C.F.R. § 42.104(b)(4).

Petitioner relies on two cumulative primary references as the basis for proposing redundant grounds of rejections asserting that the ’892 Patent claims are invalid: the Wasilewski ’92 article (OpenTV-1002) and the Sheldrick patent (OpenTV-1003, U.S. Patent No. 5,506,904). OpenTV’s anticipation positions are untenable, however, because both Wasilewski ’92 and Sheldrick fail to disclose the claimed “*secure element*” and an “*entitlement agent coupled to the plurality of receivers for providing the encrypted service instance and the entitlement information.*”¹ Therefore, Patent Owner requests that the Board decline to institute trial on any such claims of the ’892 Patent.

¹ For the sake of reference, the following paper will present claim language in italics and quotes.

If, nevertheless, a decision is ultimately made to proceed to trial, Patent Owner respectfully requests that the Board provide guidance on how the identified sections of the references apply to the subject matter as claimed in the '892 Patent.

II. OVERVIEW OF U.S. PATENT NO. 6,744,892²

The '892 Patent was filed on March 3, 2003,³ on a method and apparatus that geographically limits a digital home communications terminal ("DHCT") receiver's access to digital broadcast and interactive session service instances. (OpenTV-1001 at Title; Abstract; 4:22-24; 26:24-31.) In providing conditional access, the '892 Patent addresses the following items: (1) preventing customers from physically tampering with the receiver using cryptographic attacks to steal keys or to deceive the DHCT about the source of the messages it receives; and (2)

² Patent Owner notes that the related '964 Patent (IPR2013-00329) and the '892 Patent of the present IPR share a common specification. The Patent Owner's overview sections of the two IPRs are consistent, but are directed to different inventions as claimed. Also, claim terms will be briefly discussed in the present section, and a more detailed claim construction analysis is provided below in Section III, Claim Construction.

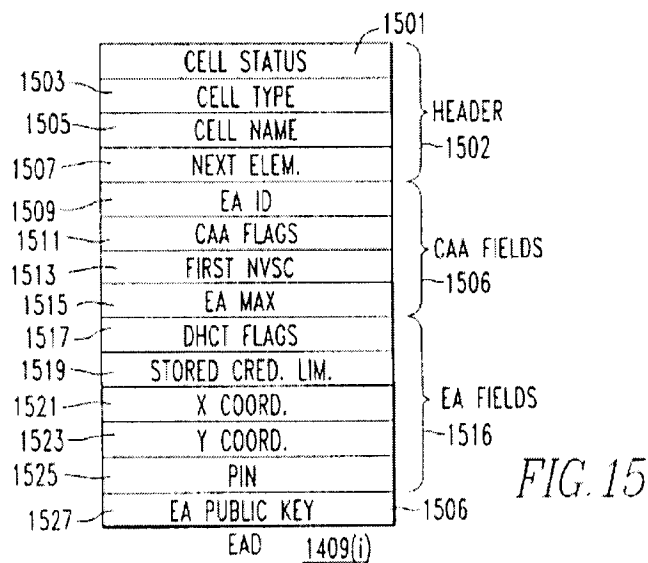
³ The '892 patent presents a listing of related U.S. applications to which it claims priority. However, since no intervening prior art has been presented, priority will not be further discussed. The Patent Owner reserves the right to address priority at a later time if it becomes appropriate, in this or other proceedings.

giving system providers greater control over service content providers, because the two entities do not necessarily have the same interests. (OpenTV-1001 at 6:5-19.)

To address these items, the '892 Patent discloses a system that uses a secure element, which is tamper-proof, to restrict access to received encrypted service instances. (OpenTV-1001 at 6:7-13; 21:11-24.) In addition to solving the original challenges, the conditional access apparatus provided other advantages. For example, it is flexible and permits multiple entitlement agents, provides dynamic addition and removal of entitlement agents, provides an easy way for permitting customers to change entitlement agents, and provides a reverse path for the DHCT to communicate with other entities. (OpenTV-1001 at 10: 41-59.)

In more detail, Fig. 3, a portion of Fig. 6, and Fig. 8 (combined, annotated, and reproduced below) illustrate a conditional access system that gives a DHCT 333 receiver access to digital broadcast and interactive session service instances provided by Entitlement Agents ("EAs") 2409. The DHCT receiver includes secure element ("DHCTSE") 627, which is tamper-proof and comprises a secure processor and secure memory. (OpenTV – 1001 at 21:11-24.) The DHCT receiver also includes service decrypt module 625 for decrypting encrypted service instances. (OpenTV – 1001 at 15:49-61).

The '892 Patent, in connection with the above figures and Fig. 15 (below), explains that the DHCTSE receives an entitlement management message ("EMM") that includes a geographic location indicator, e.g., in the form of X and Y coordinates which define the location of the receiver. (OpenTV-1001 at 26:21-31; Fig. 15 Y Cord. 1521 and X Cord.1523.) The geographic location indicator is stored in the memory of the tamper-proof DHCTSE. (OpenTV-1001 at 38:37-49.) The EMM message may be sent on an MPEG data stream or within IP packets. (OpenTV-1001 at 18:41-43.)



Further, the DHCTSE receives both encrypted service instance 329 and entitlement information contained in an entitlement control message ("ECM") 323 associated with the service instance from an Entitlement Agent 2409. (OpenTV-1001 at 13:27-35; 10:4-8.) The ECM may be transmitted on an MPEG transport stream. (OpenTV-1001 at 18:38-41.) The specification discloses, and illustrates in

Fig. 22 (reproduced below), that the entitlement information includes geographic reception information such as Blackout Radius 2237, X Centroid 2239, Y Centroid 2241, and Entitlement ID 2245. (OpenTV-1001 at 36:39-49.)

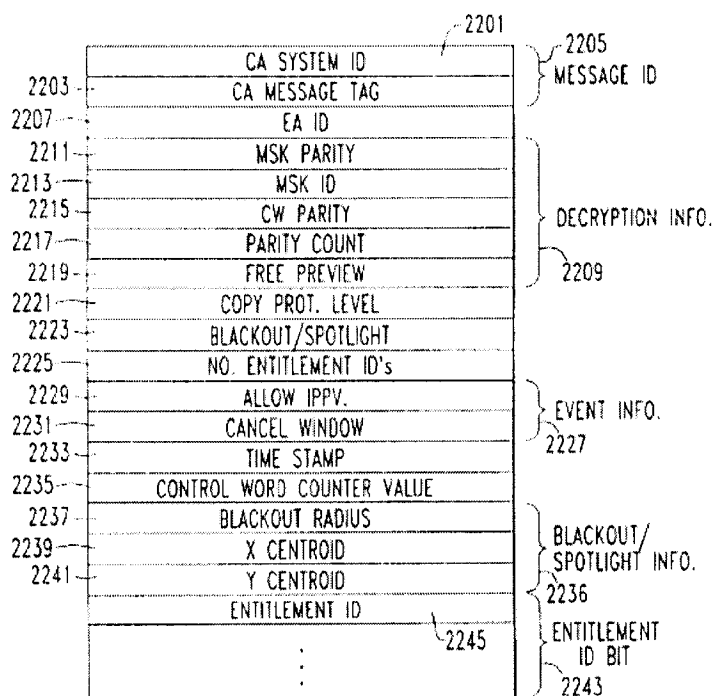


FIG. 22

The processor of the DHCTSE uses the geographic reception information and the geographic locator indicator to determine whether the receiver is entitled to the service instance. (OpenTV-1001 at 38:37-49.) If it is determined that the receiver is entitled to receive the service instance, the DHCTSE provides a control word 319 for decrypting the encrypted service instance to the service decrypt module 625 which uses the code word to decrypt and activate display of the service instance. (OpenTV-1001 at 38:37-49; Fig. 3 service decrypt 347, video data 325.)

The service instances include, among other things, digital broadcast and interactive services. Broadcast services include, for example, pay per view (“PPV”), impulse pay per view (“IPPV”), and near video-on-demand (“NVOD”). (OpenTV-1001 at 28:27-30; 30: 50-67; 32:37-39.) Interactive services include, for example, browsing the internet or playing video games. (OpenTV-1001 at 35:12-14.) Such interactive services may utilize a reverse channel for data sent from the DHCT. (OpenTV-1001 at 35:16-17.)

As will be discussed below, the cited references provided in OpenTV’s request for *inter partes* review do not describe anything similar to a “*secure element*” and an “*entitlement agent coupled to the plurality of receivers for providing the encrypted service instance and the entitlement information,*” as recited in the claims. This is clear from the face of the Petition. In other words, OpenTV has not carried its burden. *Cf.* 37 C.F.R. § 42.20(c). (“The moving party has the burden of proof to establish that it is entitled to the requested relief.”); *Scripps Research Institute v. Nemerson*, 72 USPQ2d 1122, 1123 (BPAI 2004) (“The responsibility for developing and explaining the record for an issue rests with the movant, not with the Board.”)

III. CLAIM CONSTRUCTION⁴

During *inter partes* review, the pending claims must be “given their broadest reasonable interpretation in light of the specification in which it appears.” (37 C.F.R. § 42.100(b); *see also*, *Phillips v. AWH Corp.*, 415 F.3d 1303, 1321 (Fed. Cir. 2005) (en banc).) Extrinsic evidence concerning relevant scientific principles, meaning of technical terms, and state of the art may also be relevant. (*Phillips* at 1314.)

A. “receiver”

All of the independent claims (and hence, all of the claims) refer to a “receiver.” Patent Owner submits that a “receiver” is a “digital communications terminal that can restrict and grant access to instances of service.” This construction is consistent with the specification of the ’892 Patent which notes that “[r]estricting access to broadcast information is even more important for digital information.” (OpenTV-1001 at 2:58-59, emphasis added.) Additionally, the receiver is disclosed as a “digital home communications terminal (DHCT).” (OpenTV-1001 at 7:40-41).

⁴ Patent Owner proposes construction of certain claim terms pursuant to the “broadest reasonable interpretation” standard. Patent Owner reserves the right to argue for a narrower or different construction of any term or claim in any pending or future litigation concerning this patent or any related patents.

Therefore, the broadest reasonable construction of the term “*receiver*” that is consistent with the specification is a “digital communications terminal that can restrict and grant access to instances of service.”

B. “*service instance*”

All of the independent claims (and hence, all of the claims) refer to a “*service instance*.” Patent Owner submits that a “*service instance*” is a “digital broadcast or interactive session.” This construction is consistent with the specification of the '892 Patent which specifically directed to providing conditional access to digital services:

Restricting access to broadcast information is even more important for digital information. One reason for this is that each copy is as good as the original; another is that digital information can be compressed, and consequently, a given amount of bandwidth carries much more information in digital form.

(OpenTV-1001 at 2:58-63.) The '892 Patent continues and describes that a service instance includes such things as a broadcast such as pay per view (“PPV”), impulse pay per view (“IPPV”), near video-on-demand (“NVOD”) (OpenTV-1001 at 28:27-30; 30: 50-67; 32:37-39), and real-time interactive sessions such as a browsing the Internet or playing video games (OpenTV-1001 at 35:16-17.)

Therefore, the broadest reasonable construction of the term “*service instance*” that is consistent with the specification is a “digital broadcast or interactive session.”

C. “*secure element*”

All of the independent claims (and hence, all of the claims) refer to a “*secure element*.” The proposed claim construction for “*secure element*” is “a single tamper-proof element comprising a secure processor and secure memory.”

The proposed construction for this term is consistent with the claims which explicitly recite that the secure element comprises a “*memory*” and “*microprocessor*.” Further, the disclosure in the specification of the '892 Patent supports the proposed construction, noting that the single tamper-proof digital home communications terminal secure element (“DHCTSE”) includes a secure processor and memory (OpenTV-1001 at 16:10-13; 47:40-42; 21:11-21.)

As to “tamper-proof,” Patent Owner submits that a device is “tamper-proof” if unauthorized attempts by users to gain access to its contents renders the device unusable and its contents unreadable. (OpenTV-1001 at 21:19-21.)

Therefore, the broadest reasonable construction of the term “*secure element*” is “a single tamper-proof element comprising a secure processor and secure memory.”

D. “*entitlement information*” and “*geographic reception information*”

All of the independent claims (and hence, all of the claims) refer to “*entitlement information*” and “*geographic reception information*.” Patent Owner submits that the term “*entitlement information*” is “authorization information for broadcast or interactive sessions received from an entitlement agent” and that “*geographic reception information*” is a specific type of entitlement information and should be construed as “geographic area authorization information for broadcast or interactive sessions received from an entitlement agent.”

The specification of the '892 Patent notes that the receiver obtains entitlements, from an entitlement agent. (*See e.g.*, OpenTV-1001 at 11:54-57; 21:3.) As to the types of entitlements, the specification notes:

There are two kinds of entitlement information: that for broadcast services and that for interactive services.

(OpenTV-1001 at 23:55-57, emphasis added.)

There are two broad families of entitlements: broadcast entitlements for non-interactive services and interactive entitlements for interactive sessions.

(OpenTV-1001 at 28:11-13, emphasis added.) As already noted the broadcasts are digital. (OpenTV-1001 at 2:46-47.)

Further, it is noted that the claim expressly recites and the '892 Patent discloses that entitlement information includes geographic area authorization information for accompanying service instances:

Blackout/spotlight information 2236 defines a geographic area which is to be blacked out or spotlighted by an instance of service. It does so by means of x centroid 2239 and y centroid 2241, the two of which define a point in a geographical coordinate system defined by the entitlement agent.

(OpenTV-1001 at 36:39-44, emphasis added; *see also* 38:37-49 and Fig. 22.)

Therefore, the broadest reasonable construction of the term “*entitlement information*” that is consistent with the specification is, “authorization information for digital broadcast or interactive sessions received from an entitlement agent” and the broadest reasonable construction of the term “*geographic reception information*” that is consistent with the specification is, “geographic area authorization information for digital broadcast or interactive sessions received from an entitlement agent.”

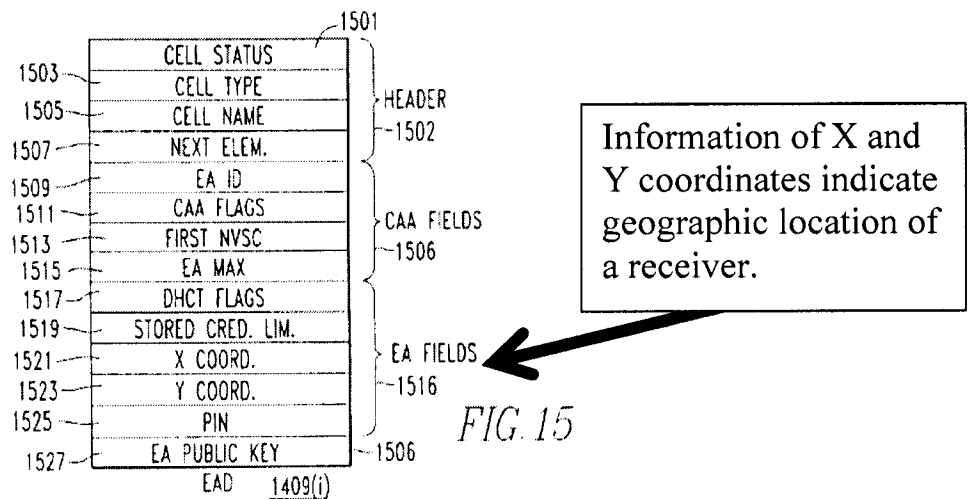
E. “*geographic location indicator*”

All of the independent claims (and hence, all of the claims) refer to a “*geographic location indicator*.” To the extent that construction of this term is necessary, Patent Owner notes that a “*geographic location indicator*” is “information that indicates geographic location of a receiver.”

This construction is consistent with other claim terms which note that the “*geographic location indicator*” is indicative of the geographic location of the receiver. Further, the specification in connection with Fig. 15 (reproduced below annotated) discloses information, such as X and Y coordinates, defining a location of a DHCT receiver:

X coordinate 1521 and Y coordinate 1523 define a location of DHCT 333 in a coordinate system (to be explained more fully later) established by the entitlement agent.

(OpenTV-1001 at 26:21-24.)



Therefore, the broadest reasonable construction of the term “*geographic location indicator*” that is consistent with the specification is, “information that indicates geographic location of a receiver.”

F. “*entitlement agent*”

Independent claims 12, 20, and 26 (and hence, all of their dependent claims) refer to an “*entitlement agent*.” Patent Owner submits that the term “*entitlement agent*” is “an entity that provides digital broadcast or interactive session entitlement information to receivers.” This construction is consistent with the specification of the '892 Patent which notes that the “*entitlement agent*” provides entitlement information for digital broadcast and interactive services to the receiver. (*See e.g.*, OpenTV-1001 at 11:54-57; 21:3; 23:55-57; 28:11-13.)

Patent Owner further notes that in the context of the claim, for any entity to be considered an “*entitlement agent*” that entity **must** provide both “*the encrypted service instance and the entitlement information*” and if fails to provide either one, it is not an entitlement agent. This is consistent with the specification which explicitly teaches that the encrypted service instance and the entitlement information are provided by the entitlement agent. For example, Fig. 3 illustrates that the entitlement agent provides the encrypted service instance (encrypted content 329) and the entitlement information (contained in ECM 323). (*See* Fig. 22, where the contents of ECM are illustrated as including entitlement information such as Blackout Radius 2237, Y Centroid 2239, Y Centroid 2241, Entitlement ID 2245, etc...)

The ability of the “*entitlement agent*” to provide both the “*encrypted service instance*” and the “*entitlement information*” by, for example, intermixing the two into an encrypted MPEG stream (OpenTV-1001 at 18:46-50; *see also* Fig. 7) is important because it allows the service providers to directly control the service instance and entitlement information while allowing the distribution operator to simply run as a distribution utility:

...

of the services; consequently, a CATV operator may simply run as a distribution utility.

(OpenTV-1001 at 10:37-49.)

As such, a service provider that only provides an “*encrypted service instance*” and fails to provide “*entitlement information*” would not be considered an “*entitlement agent*,” even if another entity provides entitlement information. However, a service provider or another entity that provides both the “*encrypted service instance*” and the “*entitlement information*” would be considered an “*entitlement agent*.”

OpenTV in the Petition asserts that an “*entitlement agent*” can be a “combination of, a program service provider, an entity or function that is located outside of the receiver...that provide the receiver access authorization.” (Petition at 10.) In other words, OpenTV is arguing that a service provider is an entitlement agent even if it provides no entitlements whatsoever, as long entitlements are provided by some other entity. Such a construction, however, would nullify the express limitation of the claim which requires that the “*entitlement agent*” provide both the “*encrypted service instance and the entitlement information.*” Because OpenTV’s proposed construction is contrary to other claim limitations and the specification it is unreasonably broad and does not assist the Board in evaluating the claims with respect to the prior art.

Therefore, the broadest reasonable construction of the term “*entitlement agent*” that is consistent with the specification is, “an entity that provides digital broadcast or interactive session entitlement information to receivers.”

G. Summary of Proposed Claim Constructions

For convenience, the claim terms and proposed constructions are set forth below:

Claim Term	Construction
<i>receiver</i>	A digital communications terminal that can restrict and grant access to instances of service.
<i>instance of service</i>	Digital broadcast or interactive sessions.
<i>secure element</i>	A single tamper-proof element comprising a secure processor and secure memory.
<i>entitlement information</i>	Authorization information for digital broadcast or interactive sessions received from an entitlement agent.
<i>geographic reception information</i>	Geographic area authorization information for digital broadcast or interactive sessions received from an entitlement agent.
<i>geographic location indicator</i>	Information that indicates geographic location of a receiver.
<i>entitlement agent</i>	An entity that provides digital broadcast or interactive session entitlement information to receivers.

IV. SPECIFIC REASONS WHY THE CITED REFERENCES DO NOT INVALIDATE THE CLAIMS, AND WHY *INTER PARTES* REVIEW SHOULD NOT BE INSTITUTED

The Board should not institute a trial because, for at least one element in each and every proposed challenge to the claims (*i.e.*, Grounds 1-5), OpenTV fails to satisfy the basic requirements for its *inter partes review* petition: “[t]he petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon.” 37 C.F.R. § 42.104(b)(4). Consequently, OpenTV fails to demonstrate “a reasonable likelihood that the petitioner would prevail with respect to at least one of the claims challenged in the petition.” 35 U.S.C. § 314(a).

A. No Trial Should Be Instituted for Grounds 1, 3, and 4

Ground 1 of OpenTV's Petition asserts that Claims 1-4, 7-9, 11-14, 16-18, 20, 22-23, 26-27, 30-31, 35 and 38 are anticipated by Wasilewski '92 under 35 U.S.C. §102(b). Ground 3 of OpenTV's Petition asserts that Claims 5-6, 10, 15, 19, 21, 24-25, 28-29, and 36-37 are rendered obvious by Wasilewski '92 in view of Sheldrick under 35 U.S.C. §103. Ground 4 of OpenTV's Petition asserts that Claims 32-34 are rendered obvious by Wasilewski '92 in view of Thibadeau under 35 U.S.C. §103.

A finding of invalidity under 35 U.S.C. §102 requires a showing that a single reference teaches every limitation of the claim. “A claim is anticipated only

if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” (M.P.E.P. § 2131, *quoting Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), emphasis added.) Further, “[t]he identical invention must be shown in as complete detail as is contained in the...claim.” (*Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Board should decline to institute *inter partes* review on this Ground because OpenTV's Petition fails to show that Wasilewski discloses all of the claim elements of the '892 Patent, either expressly or inherently. Consequently, OpenTV's has not presented a reasonable likelihood that it will prevail with respect to Grounds 1, 3, and 4.

1. Claims 1-38: Wasilewski fails to disclose “a secure element”

Wasilewski fails to disclose the “*secure element*,” recited in all of the independent claims (and thereby included in all of the dependent claims). As noted above in Section III.C, the “*secure element*” is “a single tamper-proof element comprising a secure processor and secure memory.” Further, the '892 Patent makes clear that a device is tamper-proof if “[a]ny attempt by a user to gain access by any of the parts of the [device] renders the [device] unusable and its contents unreadable.” (OpenTV-1001 at 21:19-21.) The tamper-proof aspect is a

key feature that makes the information of the receiver more secure in a hostile environment:

All of the forgoing considerations are influenced by the fact that the environment in which the conditional access system operates must be presumed to be hostile. Many customers of broadcast services see nothing wrong with cheating the service provider and have nothing against tampering physically with the portion of the conditional access system that is contained in the receiver.

(OpenTV-1001 at 6:5-11, emphasis added.)

Secure element (DHCTSE) 627 includes a microprocessor and memory that only the microprocessor may access. Both the memory and the microprocessor are contained in tamper-proof packaging.

(OpenTV-1001 at 16:10-13, emphasis added; *see also* 21:11-21.)

OpenTV argues “[t]he secure microprocessor and/or the secure memory in Wasilewski ’92 corresponds to the claimed ‘secure element.’” (Petition at 30.) OpenTV, however, fails to identify any portion of Wasilewski ’92 that discloses that either the microprocessor or the memory are contained in tamper-proof packaging as the “*secure element*,” of the claims at issue. Consequently, the microprocessor or the memory of Wasilewski ’92 cannot correspond to the claimed “*secure element*” because neither one is enclosed in tamper-proof packaging.

Because Wasilewski ’92 fails to disclose a “*secure element*,” it cannot anticipate Claims 1-4, 7-9, 11-14, 16-18, 20, 22-23, 26-27, 30-31, 35 and 38 of the

'892 Patent or render obvious dependent Claims 5-6, 8-10, 15, 19, 21, 24, 28-29, 32-34, and 36-37. Consequently, OpenTV has not carried its burden. *Cf.* 37 C.F.R. § 42.20(c). ("The moving party has the burden of proof to establish that it is entitled to the requested relief."); *Scripps Research Institute v. Nemerson*, 72 USPQ2d 1122, 1123 (BPAI 2004) ("The responsibility for developing and explaining the record for an issue rests with the movant, not with the Board.") Thus, OpenTV has not demonstrated a reasonable likely hood of prevailing with respect to Claims 1- 38 and no trial should be instituted as to this Ground.

2. Claims 12- 25: Wasilewski '92 fails to disclose "*an entitlement agent coupled to the plurality of receivers for providing the encrypted service instance and the entitlement information*" and "*receiving an encrypted service instance and entitlement information from the entitlement agent*"

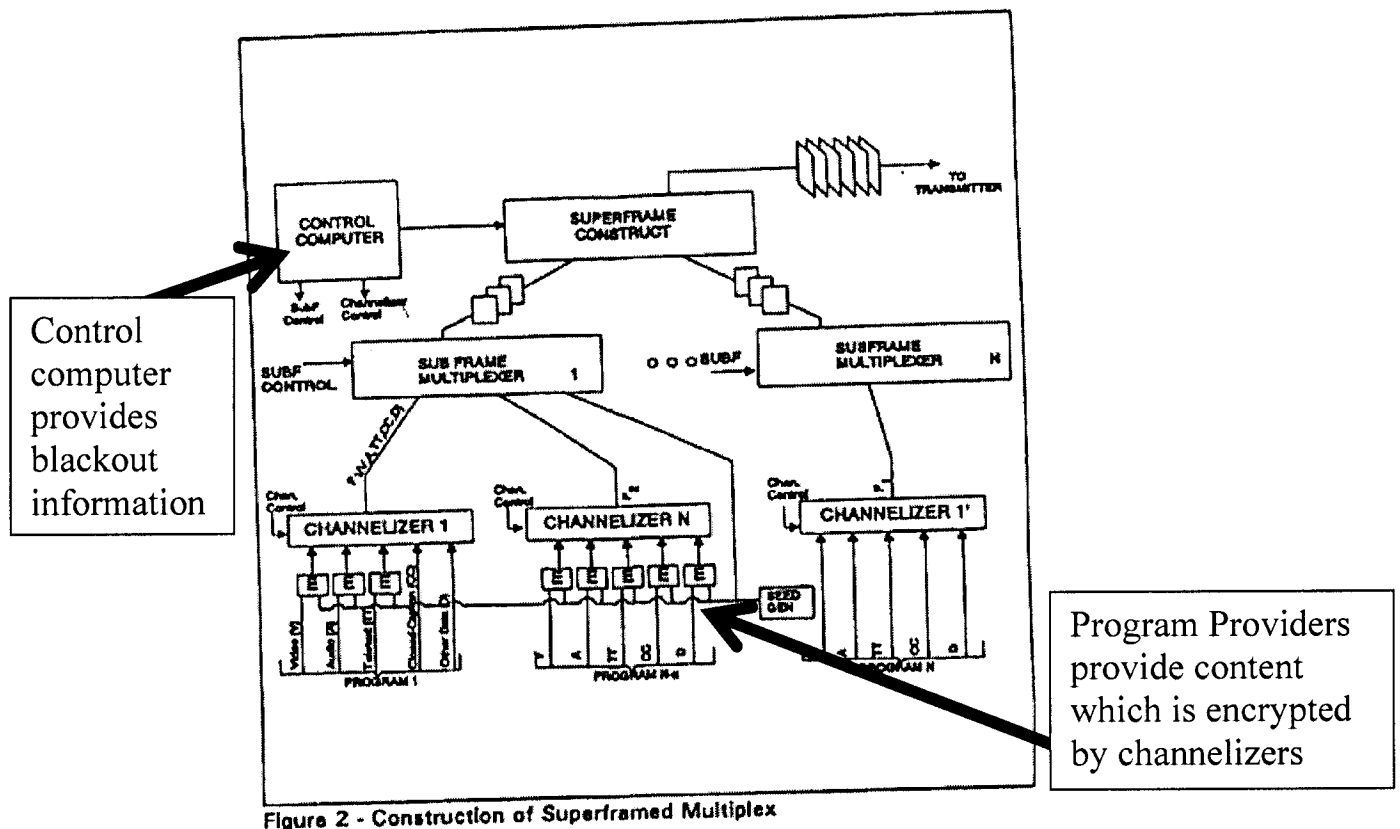
Independent Claims 12 and 20 (and thereby their dependent claims) recite the above features. In connection with these claim features, OpenTV first argues that "the blackout information described in Wasilewski '92 corresponds to the claimed 'entitlement information.'" (Petition at 29.) Further, OpenTV argues that because "[t]he received programs may have originated from dozens or more service providers" (Petition at 32) the above claim feature is disclosed by Wasilewski '92. This argument fails.

Patent Owner notes that Wasilewski '92 explicitly teaches that the **control computer provides the blackout information**. Specifically, Wasilewski '92 states:

The control computer still makes the blackout assignments, but assigns both a group blackout code and a geographic (x,y) coordinate blackout code to each decoder....

The control computer assigns blackout codes and coordinates to decoders via ADPs.

(OpenTV-1002 at section 6.7, emphasis added; *see also* Fig. 2 reproduced below annotated.)



Further, it is noted that Wasilewski '92 teaches that the program providers in combination with channelizers provide the encrypted content. (See e.g., Fig. 2.)

To clarify, Wasilewski '92 teaches that a first entity (*i.e.*, program

providers/channelizers) provides the encrypted content and that a second entity (*i.e.*, control computer) provides the blackout information.

OpenTV's above noted argument fails because it ignores other claim features which explicitly require that "*an entitlement agent*" provide both "*the encrypted service instance **and** the entitlement information.*" In other words, in the context of the claim, the entity that provides the encrypted service instance is the same entity that provides the entitlement information. As noted above, however, Wasilewski '92 explicitly teaches that a first entity (*i.e.*, program providers/channelizers) provides the encrypted content and that a second entity (*i.e.*, control computer) provides the blackout information. Thus, the two entities of Wasilewski '92 do not disclose the claimed "*entitlement agent*" that provides both "*the encrypted service instance and the entitlement information.*"⁵

Accordingly, because OpenTV fails to provide any credible explanation as to how Wasilewski '92 discloses an "*an entitlement agent coupled to the plurality of receivers for providing the encrypted service instance and the entitlement information,*" as recited in Claim 12 and "*receiving an encrypted service instance*

⁵ To the extent that OpenTV is arguing that these two separate entities can be combined, it is noted that the control computer cannot be combined with the service provider/channelizers because, for example, the control computer maintains a protected decoder SSN database. (OpenTV-1002 at section 5.9.2.)

and entitlement information from the entitlement agent,” as recited in Claim 20, OpenTV has not demonstrated a reasonable likely hood of prevailing with respect to Claims 12-25. Thus, no trial should be instituted for these claims as to Grounds 1, 3, and 4.

B. No Trial Should Be Instituted for Grounds 2 and 5

Ground 2 of OpenTV's Petition asserts that Claims 1-8, 12-31, and 35-38 are anticipated by Sheldrick under 35 U.S.C. §102(b). Ground 5 of OpenTV's Petition asserts that Claims 9-11 and 32-34 are rendered obvious by Sheldrick in view of Thibadeau under 35 U.S.C. §103.

Patent Owner provides the following analysis demonstrating that Sheldrick, which suffers from the same deficiencies as Wasilewski '92, does not disclose all of the claim elements of the '892 Patent. Thus, OpenTV's has not presented a reasonable likelihood that it will prevail with respect to Grounds 2 and 5.

1. Claims 1-38: Sheldrick fails to disclose “*a secure element*”

Sheldrick fails to disclose the “*secure element*,” recited in all of the independent claims (and thereby included in all of the dependent claims). As noted above in Section III.C, the “*secure element*” is “a single tamper-proof element comprising a secure processor and secure memory.”

In the Petition, OpenTV asserts that the “digital compression inboard security element (DISE) (157)” discloses a “*secure element*.” (Petition at 41.)

Notably, however, the Petition fails to make any showing that the DISE of Sheldrick is tamper-proof. Therefore, OpenTV has failed to demonstrate a reasonable likelihood that any claim is unpatentable over Sheldrick, and no trial should be ordered as to Grounds 2 and 5.

2. Claims 12- 25: Sheldrick fails to disclose “*an entitlement agent coupled to the plurality of receivers for providing the encrypted service instance and the entitlement information*” and “*receiving an encrypted service instance and entitlement information from the entitlement agent*”

Independent Claims 12 and 20 (and thereby their dependent claims) recite the above features. To allegedly meet these claim features, the Petition relies on Sheldrick's control computer to provide the Blackout information (Petition at 40) and the service programmers to provide encrypted service instance (Petition at 42). Such reliance, however, on the two separate entities of Sheldrick is misplaced.

As noted above, the claim language expressly requires that the “*entitlement agent*” provide both “*the encrypted service instance and the entitlement information.*” Here, neither the control computer nor the service programmers of Sheldrick provides both of these items. Rather, Sheldrick teaches explicitly that a data formatters 105 encrypt service data which is multiplexed with blackout information provided by control computer 120:

Also shown are inputs to a low speed data buffer 412 from low speed data formatters 105(1) to 105(n). Buffer 410 (audio/video) and buffer 412 for low speed data preferably signal a buffer

fullness condition to the next functional element, for example, encryption block 415, if encryption is desired.

(OpenTV-1003 at 10:24-29)

The control computer 120 supplies control information, preferably as data packets, to the multiplexer 110.

(OpenTV-1003 at 6:14-15)

[T]he control computer 120 must transmit the blackout codes.

(OpenTV-1003 at 18:1-2, emphasis added; *see also* Fig. 3A reproduced below annotated.)

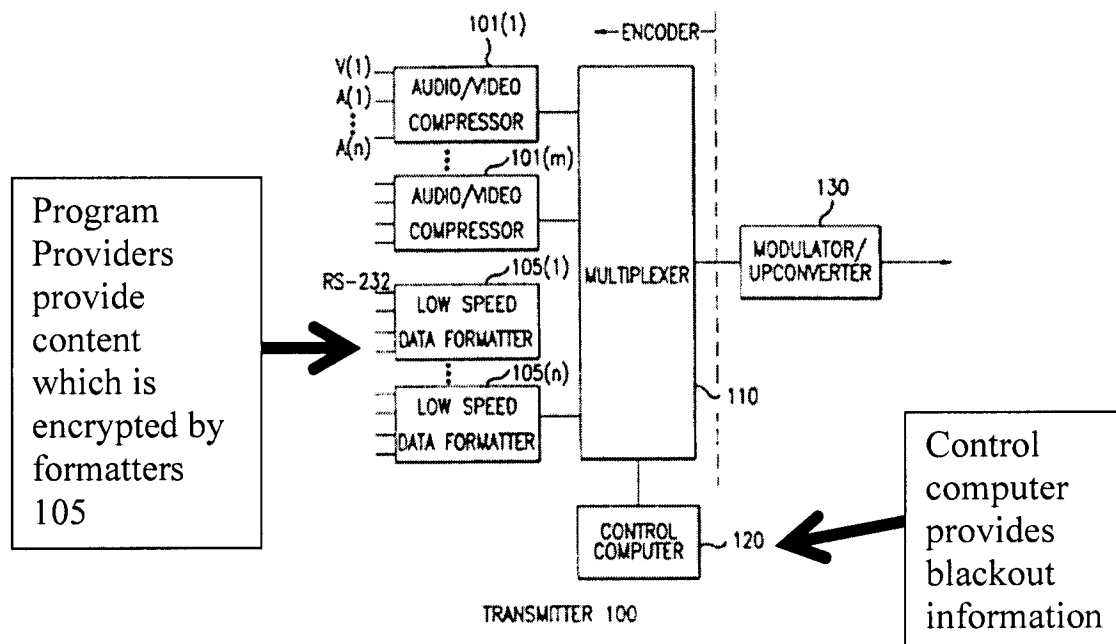


FIG.3A

Therefore, OpenTV's argument fails because it relies on two separate entities (*i.e.*, service programmers and control computer) and ignores claim features which

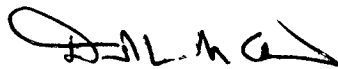
explicitly require that “*an entitlement agent*” provide both “*the encrypted service instance **and** the entitlement information.*”

Accordingly, because OpenTV fails to show that Sheldrick discloses an “*an entitlement agent coupled to the plurality of receivers for providing the encrypted service instance and the entitlement information,*” as recited in Claim 12 and “*receiving an encrypted service instance and entitlement information from the entitlement agent,*” as recited in Claim 20, OpenTV has not demonstrated a reasonable likely hood of prevailing with respect to Claims 12-25. Thus, no trial should be instituted for these claims as to Grounds 2 and 5.

V. CONCLUSION

Because the OpenTV has failed to meet its burden and the Petition fails to demonstrate a reasonable likelihood that OpenTV will prevail on any of the claims challenged in each and every Ground (Grounds 1-5), *inter partes* review of the '892 Patent should be denied and Claims 1-38 of the '892 Patent should be confirmed.

Respectfully submitted,



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Attorney Docket No.: 43614.193

Dated: September 3, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

OPENTV, INC.

Petitioner

v.

Patent of CISCO SYSTEMS, INC., CISCO TECHNOLOGY INC., SCIENTIFIC-
ATLANTA, LLC, SCIENTIFIC-ATLANTA, INC. AND NDS AMERICAS INC.
Patent Owner

Case IPR2013-00328

Patent 6,744,892

Title: METHOD AND APPARATUS FOR SERVICE IN A
CONDITIONAL ACCESS SYSTEM

CERTIFICATE OF SERVICE

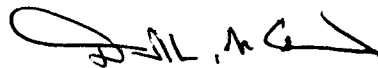
The undersigned certifies, in accordance with 37 C.F.R. § 42.205, that
service was made on the Petitioner as detailed below.

Date of service September 3, 2013

Manner of service Electronic Mail (opentv-cisco-ipr@perkinscoie.com)

Documents served Preliminary Patent Owner Response

Persons served Amy E. Simpson, Bing Ai, and Nicholas T. Bauz
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