

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

Before KALYAN K. DESHPANDE, JUSTIN T. ARBES, and

PATRICK M. BOUCHER, Administrative Patent Judges

**JOINT MOTION BY PETITIONER AND PATENT OWNER
TO TERMINATE PROCEEDING PURSUANT TO**

35 U.S.C. § 317 and 37 C.F.R. § 42.74

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Petitioner OpenTV Inc. (“OpenTV”) and Patent Owner Cisco Systems, Inc., Cisco Technology Inc., Scientific-Atlanta, LLC, Scientific-Atlanta, Inc. and NDS Americas Inc. (collectively, “Cisco”) jointly request termination of the *inter partes* review of U.S. Patent No. 6,744,892 Case No. IPR2013-00328.

I. Termination of Case No. IPR2013-00328 Would Be Appropriate.

Termination of Case No. IPR2013-00328 by the PTAB would be appropriate. This case is at a sufficiently early stage of the trial, and no motions or petitions are outstanding in this case.¹ Further, on January 29, 2014, the parties entered into a Settlement and License Agreement (attached hereto as Exhibit CISCO-2001). The Settlement and License Agreement requires both parties to terminate various disputes, including (i) Case No. IPR2013-00328, and (ii) Patent Owner Cisco’s Civil Action 5:13-cv-00282 against Petitioner OpenTV in the Northern District of California asserting U.S. Patent No. 6,744,892, in the instituted trial. Therefore, termination of Case No. IPR2013-00328 is appropriate because (i) the case is at a sufficiently early stage of the trial, (ii) the parties have settled their dispute, (iii) Patent Owner has agreed to dismiss the related District

¹ Patent Owner has not conducted discovery or filed a full response, and one is not due until March 3, 2014.

Court litigation, and (iv) the parties to this case agree that this *inter partes* review should be terminated.

As set forth in 35 U.S.C. § 317 and 37 C.F.R. § 42.74, the Settlement and License Agreement between OpenTV and Cisco has been made in writing, and a true and correct copy is being filed with the Patent Office as an exhibit to this Joint Motion. As stated in 35 U.S.C. § 317(a), because OpenTV and Cisco request this termination, no estoppel under 35 U.S.C. § 315(e) shall attach as to Petitioner OpenTV. Further, a joint request to treat the Settlement and License Agreement as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is filed concurrently herewith.

Therefore, OpenTV and Cisco respectfully request termination of the *inter partes* review of U.S. Patent No. 6,744,892, Case No. IPR2013-00328.

Dated: January 31, 2014

Respectfully submitted,

/David L. McCombs/

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IPR2013-00328

OPENTV, INC.

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

Cisco's Exhibit List

January 31, 2014

CISCO-2001 Settlement and License Agreement.

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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 January 31, 2014

Manner of service Federal Express

Documents served Joint Motion To Terminate Proceeding and Its Supporting
Exhibit(s) and Exhibit List

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