

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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**OPENTV, INC.**  
Petitioner

v.

**CISCO SYSTEMS, INC., *ET AL.***  
Patent Owner

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Case IPR2013-00328  
Patent No. 6,744,892 B2  
(PTAB Accorded Filing Date: June 4, 2013)

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Filing Date of This Paper: June 7, 2013

Before Administrative Patent Judge Justin T. Arbes  
(Amy Kattula, *Trial Paralegal*)

**PETITIONER’S RESPONSE TO “NOTICE OF FILING DATE  
ACCORDED TO PETITION AND TIME FOR FILING PATENT  
OWNER PRELIMINARY RESPONSE” OF JUNE 6, 2013**

In response to PTAB's "NOTICE OF FILING DATE ACCORDED TO PETITION AND TIME FOR FILING PATENT OWNER PRELIMINARY RESPONSE" of June 6, 2013 (Paper No. 5, "June 6 Notice"), Petitioner OpenTV hereby files this timely response on June 7, 2013, within the five businessday period as required by the PTAB in its June 6 Notice.

This response includes two documents:

- (1) this response explaining the background and Petitioner's corrective measure (7 pages including the cover page and certificate of service), and
- (2) a corrected 60-page petition removing all references to Ex. 1007 in the original 60-page petition.

## **1. Background**

Petitioner OpenTV filed a petition for *inter partes* review of Patent No. 6,744,892 B2 that includes a 60-page petition and eight (8) exhibits (labeled as Ex. 1001 to Ex. 1008) on June 4, 2013, which has been accorded by the PTAB the filing date of June 4, 2013 in the June 6 Notice.

Ex. 1007 is a 12-page document for "Claim Charts for Independent Claims 1, 12, 20 and 26" which provides references to specific locations of relevant support in the cited prior art for Claims 1, 12, 20 and 26. Ex. 1007

is provided solely for the convenience of the PTAB in checking the specific sections in the cited prior art in review of the petition. Due to the inclusion of Ex. 1007 in the original filing, PTAB issued the following notice in its June 6 Notice:

Administrative Patent Judge Justin T. Arbes has been designated to manage the proceeding. 37 C.F.R. § 42.5.

A review of the petition identified the following defect(s):

- A petition must be 60 pages or less, including statements of material fact and claim charts. The claim chart, which is 12 pages, was filed as a separate exhibit. The petition is 60 pages. Therefore, the page limit was exceeded. *See* 37 C.F.R. § 42.24.

Petitioner must correct the defect(s) within FIVE BUSINESS DAYS from this notice. Failure to correct the defect(s) may result in an order to show cause as to why the Board should institute the trial. No substantive changes (e.g., new grounds) may be made to the petition.

## **2. Request for Excluding and Not Considering Ex. 1007**

Petitioner OpenTV included Ex. 1007 in the initial filing on June 4, 2013 solely for the convenience of the PTAB in checking the specific sections in the cited prior art in review of the petition. The originally filed 60-page petition includes references to Ex. 1007 but its content is fully self-explanatory, independent of references to Ex. 1007.

Accordingly, in full compliance with the 60-page limit under 37 C.F.R. §42.24, Petitioner OpenTV requests the PTAB to exclude Ex. 1007

and not to consider Ex. 1007 in the *inter partes* review of Patent No. 6,744,892 B2.

### **3. Submission of Corrected Petition Removing References to Ex. 1007**

In this response, Petitioner OpenTV further submits a corrected petition to the PTAB for replacing and substituting the original 60-page petition. In this newly submitted corrected petition, all references to Ex. 1007 in the original 60-page petition filed on June 4, 2013 have been removed. Specifically, all references to Ex. 1007 in the original 60-page petition filed on June 4, 2013 have been removed at the following pages and line numbers: Page 32, lines 13-14; Page 34, lines 1-2 and 19-20; Page 42, lines 6-7 and 15-16; Page 43, lines 11-12; and Page 44, lines 6-7. No other changes have been made in the newly submitted corrected petition.

The newly submitted corrected petition references the following seven (7) exhibits as listed in the revised Exhibit List:

**Ex. 1001:** U.S. Patent No. 6,744,892 B2 to Akins, III et al. (“the 892 Patent”) (50 pages);

**Ex. 1002:** Wasilewski, A. J., “ISO/IEC JTC1/SC20/WG11, Requirements and Method for High-Level Multiplexing of MPEG and Other Digital Service Bitstreams with

Universal Transport Layer", Nov. 1992 ("Wasilewski '92") (29 pages);

**Ex. 1003:** U.S. Patent No. 5,506,904 to Sheldrick et al. ("Sheldrick") (24 pages);

**Ex. 1004:** U.S. Patent No. 5,432,542 to Thibadeau et al. ("Thibadeau") (17 pages);

**Ex. 1005:** Portions of the prosecution file history of related U.S. Patent No. 6,252,964 B1 (69 pages);

**Ex. 1006:** Declaration of Alan Young (92 pages); and

**Ex. 1008:** U.S. Patent No. 5,870,474 to Wasilewski et al. ("the 474 Patent") (34 pages).

Accordingly, in full compliance with the 60-page limit under 37 C.F.R. §42.24, the Petitioner OpenTV requests the PTAB to use the corrected petition in the *inter partes* review of Patent No. 6,744,892 B2.

#### **4. Conclusion**

Petitioner OpenTV respectfully submits that the above response and the newly submitted corrected petition have fully corrected the defect as stated in the PTAB's June 6 Notice. As such, this petition is now in full compliance with the 60-page limit under 37 C.F.R. §42.24.

This response also serves as a motion to the PTAB under 37 C.F.R.  
§42.20 to grant the requests and reliefs made in this response.

The PTAB or the Office is authorized to charge any applicable fees,  
or apply any credit in connection with this Petition, to the Deposit Account  
No. 50-5252

Dated: June 7, 2013

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Respectfully submitted,

/ Nicholas T. Bauz /

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Back-Up Counsel

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true copy of the foregoing  
PETITIONER’S RESPONSE TO “NOTICE OF FILING DATE  
ACCORDED TO PETITION AND TIME FOR FILING PATENT OWNER  
PRELIMINARY RESPONSE” OF JUNE 6, 2013 has been served in its  
entirety on this 7th day of June, 2013, by EXPRESS MAIL® on the Patent  
Owner at the official correspondence address for the attorney of record for  
the 892 Patent shown in USPTO PAIR and the attorneys of record for  
Plaintiff in the concurrent litigation matter:

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