

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 IPR2013-00330
Patent 7,505,592

Title: APPARATUS FOR ENTITLING AND TRANSMITTING SERVICE
INSTANCES TO REMOTE CLIENT DEVICES

**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 5, 2013, requesting inter partes review of Claims 1-20 of U.S. Patent No. 7,505,592 (the "'592 Patent"). Cisco respectfully requests that the Board decline to institute *inter partes* review of the '592 Patent because OpenTV has not 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).

The Board should not institute a trial because, for each ground of rejection, at least one claim element is missing and consequently OpenTV has not met the standard required by Patent Office regulations to demonstrate that there is a "reasonable likelihood that [it] would prevail with respect to at least [one] of the claims challenged in the petition." 35 U.S.C. § 314(a). For example, OpenTV's Petition fails to adequately specify where the relied-upon references show "*determining whether the remote client is entitled to receive the requested service instance*" and "*responsive to the determining the remote client is entitled to receive the requested service instance, transmitting the requested service instance,*" as

claimed in the '592 Patent.¹ Instead of meeting its burden, OpenTV's Petition provides an improper claim construction that effectively reads out these key claim limitations. Although the Board is required to give a claim "its broadest reasonable construction,"² a broad reasonable construction does not warrant turning a blind eye to express limitations in a claim as OpenTV urges.³

In accordance with established principles, it is not the job of the Board to fill in the blanks and correct inadequacies in an inter partes review petition. (*See, e.g.,* in the context of interference practice, S.O. ¶ 121.5.2 (which states that "[t]he Board will not take on the role of advocate for a party, trying to make out a case the party has not adequately stated"); *see also Spears v. Holland, Interf.* No. 104,681, Paper 30, p. 15 (BPAI 2002) ("It is not the role of this board to help party Spears articulate a difference between [claims]. That is the role of Spears' counsel as an advocate, not the role of the board as an unbiased and impartial decision maker. Taking sides to aid one party to the detriment of the other is not what we

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

² *See, Phillips v. AWH Corp.*, 415 F.3d 1303, 1321 (Fed. Cir. 2005) (en banc).

³ The present paper identifies some of the specific claim elements that are missing from the cited art, and therefore, why the Petition does not show a likelihood that it would prevail in an *inter partes* review. The Patent Owner reserves the right to present additional differences between the cited art and the claims at a later time in the proceeding.

do.”)). Accordingly, the duty to provide an adequate petition falls squarely on the petitioner OpenTV, and OpenTV has failed to perform its duty in a way that justifies proceeding to trial.

If, nevertheless, a decision is ultimately made to proceed to trial, Patent Owner respectfully requests as a matter of fundamental fairness that the Board provide guidance on how the identified sections of the references apply to the claim language, and in particular to “*determining whether the remote client is entitled to receive the requested service instance*” and “*responsive to the determining the remote client is entitled to receive the requested service instance, transmitting the requested service instance,*” as claimed in the ’592 Patent.

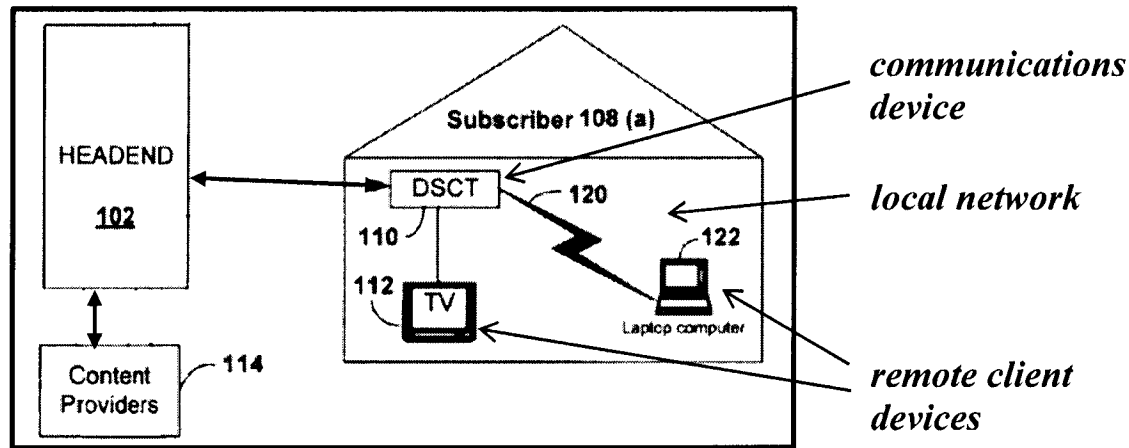
II. OVERVIEW OF U.S. PATENT NO. 7,505,592⁴

The ’592 Patent was filed on February 6, 2007, and describes and claims a new way to effectively provide services instances to entitled remote devices.⁵ (*See, e.g.,* OpenTV-1001 at Title; Abstract; 1:19-22.) A portion of Fig. 1 of the ’592 Patent is reproduced below, with annotations that correspond to elements of Claim 1 of the patent, also reproduced below. The figure and the claim describe sending

⁴ Claim terms will be briefly discussed in the present section, and a more complete claim construction of the claim terms is provided below in Section III, Claim Construction.

⁵ Patent Owner reserves the right to address the priority issue raised in the Petition at 5, as appropriate, in this or other proceedings.

a “*service instance*”, like a movie or real time interactive web browsing services, from a “*headend*” to a “*remote client device*,” like a TV and computer, at a “*subscriber*” premise, like a home.



'592 Patent, FIG. 1 (partial)

Claim 1 recites:

1. A method of transmitting service instances to a *remote client device* in a *local network*, including a *communications device* and one or more of said *remote client devices*, at a *subscriber premises*, comprising the steps of:

receiving a service instance at the *communications device* of the *subscriber premises* from a *headend*, wherein the service instance is stored in memory of the *communications device*;

receiving a request at the *communications device* for the stored service instance from the *remote client device*;

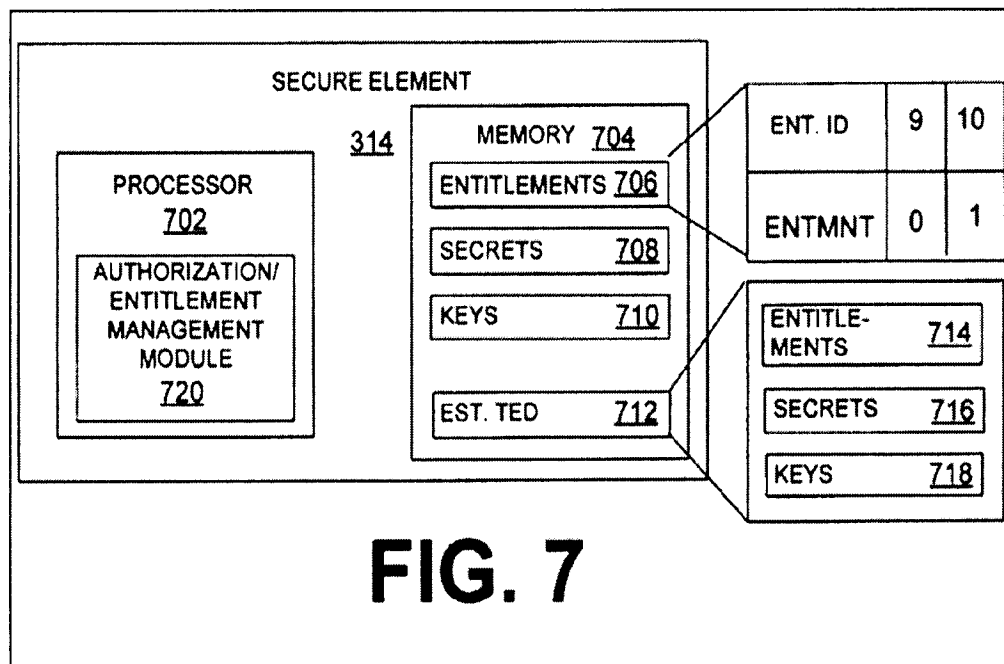
determining whether the *remote client device* is entitled to receive the requested stored service instance; and

responsive to determining the *remote client device* is entitled to receive the requested stored service instance, transmitting the requested service instance from the *communications device* to the *remote client device*.

Fig. 1 above shows two “*remote client devices*,” a TV 112 and a laptop computer 122 at the “*subscriber premise*” 108(a). Claim 1 recites that a determination is made, on a per-device basis, whether a specific “*remote client device*” is entitled to receive a specific service instance. The '592 Patent gives an example where one of the “*remote client devices*” (the laptop computer 122) is not allowed to receive a certain type of service instance: “DSCT 110 can act as a filter to prevent certain content such as sexually oriented content from being provided to the client-receiver 122.” (*See, e.g.,* OpenTV-1001 at 29:33-35, emphasis added.) In this way, one of the “*remote client devices*” at the “*subscriber premises*” can receive a specific service instance, while another “*remote client devices*” at the “*subscriber premises*” cannot.

To achieve this ability to individually decide which “*remote client device*” is or is not entitled to receive a specific service instance, the '592 Patent specification describes that the DSCT 110 (“*communications device*”) maintains an entitlement map 706 in secure element 314 (illustrated below in Fig. 7). (*See, e.g.,* OpenTV-1001 at 25:11-12.) The entitlement map 706 associates specific service instances with a specific client-receiver (“*remote client device*”). (*See, e.g.,* OpenTV-1001

at 25:13-15; 21:46-50.) For example, illustrated in Fig. 7, the entitlement map 706 indicates that the client-receiver 122 (the laptop computer in FIG. 1) is entitled to receive the service instance associated with ID 10 but not with ID 9. (*See, e.g.*, OpenTV-1001 at 25:15-19.) As such, DSCT 110 can determine whether the client-receiver 122 is entitled to receive the stored service instance.



'592 Patent, FIG. 7

If it is determined that the client-receiver 122 is entitled to receive the requested service instance, the DSCT 110 transmits the service instance either from its memory to the client-receiver 122 (*see, e.g.*, OpenTV-1001 at 3:29-32) or if the requested services instance is not within the memory of the DSCT 110, the DSCT sends a real-time request to the headend 102 for the requested service instance, which is subsequently sent to the client-receiver 122 (*see, e.g.*, OpenTV-

1001 at 21:61-63; 31:4-5). If the client-receiver 122 is not entitled to receive the service instance, the DSCT 110 sends a service denied message. (*See, e.g.*, OpenTV-1001 at 23:20-23.)

It is important to note that the disclosed communications system and methods of the '592 Patent go well-beyond simply encrypting communications, such as conditional access systems (CAS). Although the disclosed communications system and methods of the '592 Patent utilize encryption for granting/limiting access, additional security is provided by initially determining whether a client-receiver is **entitled to receive** a requested service instance before the requested service instance is transmitted to the client-receiver. This is important because the numbers of client receivers that are permitted to receive the service instance may be limited, even though the client receivers may have authority to access (*i.e.*, decrypt) the service instance.

The '592 Patent also teaches that the disclosed system and methods of initially determining whether a specific client-receiver is permitted to receive can be used to provide additional security and minimize theft of service instances by not transmitting the service instances to unauthorized persons outside the subscriber's premises :

However, local area networks introduce security and control concerns for the operators...due to theft of services...Thus, there exists a need for a system that addresses these concerns.

(See, e.g., OpenTV-1001 at 2:24-28, emphasis added.)

Likewise, using wireless communications may necessitate a tighter level of security because the transmissions might exit the premises and be received by an unauthorized person.

(See, e.g., OpenTV-1001 at 20:37-40, emphasis added.) Consequently, because in the system disclosed in the '592 Patent only entitled client-receivers will receive requested service instances, the disclosed system can filter content received by a client-receiver and provide a tighter level of security by limiting the receipt of service instances by unauthorized persons, thereby minimizing theft of services.

As will be discussed below, the cited references provided in OpenTV's requested *inter partes* review do not disclose "*determining whether the remote client is entitled to receive the requested service instance*" and "*responsive to the determining the remote client is entitled to receive the requested service instance, transmitting the requested service instance.*" This is clear from the face of the Petition which is based on a claim construction that effectively reads out and completely fails to address the above limitations. 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 CONSTRUCTION⁶

During patent examination, the pending claims must be “given their broadest reasonable interpretation consistent with the specification.” (*See, 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. (*Id.* at 1314.)

A. A “*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 “an audio/visual program or real-time interactive services.” This construction is consistent with the specification of the '592 Patent which describes that service instances include “audio/visual program” and real-time interactive services such as a “web-page displaying the infomercial typically includes a ‘Buy Now’ button, which the subscriber uses for purchasing at least one of the items included in the infomercial.” (*See, e.g.,* OpenTV-1001 at 4:37-44; 11:61-66).

⁶ Patent Owner proposes construction of certain claim terms pursuant to the broadest reasonable interpretation consistent with the specification 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.

In the Petition at 24 and 28, OpenTV suggests that “*services instances*” are necessarily stored by arguing that Claims 6 and 12 require “receiving a request for stored service instance from a remote device.” This is categorically incorrect as these claims are not limited to stored instances. In more detail, Claim 6 recites “*receiving a request at the communications device of the subscriber premises for a service instance from the remote client device*” and Claim 12 recites “*receiving a first request for a service instance at the communications device of the subscriber premises from a first remote client device...receiving a second request for the service instance at the communications device from a second remote client device in the local network.*” The language of Claims 6 and 12 never recites that the service instances are stored and therefore can include real-time interactive services. Further, because dependent Claim 7 explicitly recites “*storing the received service instance in memory of the communications device*” Claim 6 must necessarily be broader and not limited to stored instances. Thus, a “*service instance*” is not limited to stored instances but rather can include real-time interactive services.

Therefore, the broadest reasonable construction of the term “*service instance*” that is consistent with the specification is “audio/visual program or real-time interactive services.”

B. A “communications device”

All of the independent claims refer to a “*communications device*.” Patent Owner submits that a “*communications device*” is “a device that selectively provides service instances received from a headend to a requesting client device.”

This construction is consistent with other claimed features and the disclosure in the specification of the '592 Patent. For example, the specification describes a communications device (referred to as a digital subscriber communications terminal, DSCT) “receives services from the headend” and “selectively provide[s] the services received from the headend to the client-receivers.” (*See, e.g.,* OpenTV-1001 at 3:11-13, emphasis added). “The DSCT determines whether the client-receiver is entitled to the selected service, and if so, transmits the content to of the selected service...to the client-receiver.” (*See, e.g.,* OpenTV-1001 at 3:29-32).

In the Petition, Open TV proposes to construct the term a “*communications device*” as “a terminal for distributing service instances in a local network.” (*See* Petition at 10.) This construction, however, is unreasonably broad and fails to account for the necessary functions of the “*communications device*” as claimed and omits features expressly attributed to the communications device in the specification; namely, that the “*communications device*” “receives services from the headend” and “selectively provide[s] the services received from the headend to

the client-receivers.” (*See, e.g.*, OpenTV-1001 at 3:11-13; 3:29-32.) Thus, OpenTV’s proposed construction is unreasonably broad and does little to assist the Board in evaluating the claims with respect to the prior art.

Therefore, the broadest reasonable construction of the term “*communications device*” that is consistent with the specification is, “a device that selectively provides service instances received from a headend to a requesting client device.”

C. A “*remote client device*”

All of the independent claims refer to a “*remote client device*.” Patent Owner submits that a “*remote client device*” is a “device configured to request and receive service instances.” This construction is consistent with other claim features and the specification of the ’592 Patent which plainly discloses that the remote client device is a device that is capable of requesting and receiving service instances.

D. The remote client device being “*entitled to receive*”

All of the independent claims recite determining whether the remote client device is “*entitled to receive*” a service instance. Patent Owner submits that the term “*entitled to receive*” means “permitted to receive.” The specification of the ’592 Patent **explicitly** defines the claim term “*entitled to receive*” as “permitted to receive”:

Thus, the secure element 314 can readily determine whether the client receiver 122 is entitled to (or is not entitled to), i.e., it is permitted to (or not permitted to), receive a service instance merely by checking the entitlement map.

(See, e.g., OpenTV-1001 at 22:21-27, emphasis added.) Thus, in accordance with the specification the term “*entitled to receive*” should be construed as “permitted to receive.”

OpenTV improperly argues that “the term ‘entitled to receive’ [should be construed as] ‘has the authority to access.’” (Petition at 14). This improper construction is emblematic of the deficiencies of the primary references (*i.e.*, Payton and Hicks) and nothing more than a thinly veiled attempt to remedy these deficiencies by removing express claim limitations relating to “*determining whether the remote client is entitled to receive the requested service instance*” and *responsive to the determining the remote client is entitled to receive the requested service instance, transmitting the requested service instance.*” OpenTV is attempting to read out of the claim the “*receive*” limitation. Receiving an item, e.g., a letter, is different than accessing it (opening it and reading it). Under OpenTV’s construction, it does not matter whether the recipient “*receives*” it, only whether it accesses it – despite the plain claim language reciting “*receive*.” As noted above, although the Board is required to give a claim “its broadest

reasonable construction,” a broad reasonable construction does not warrant turning a blind eye to express limitations in a claim.

Not surprisingly, OpenTV's claim construction ignores and is completely inconsistent with express disclosures in the specification of the '592 Patent. In more detail, the specification of the '592 Patent makes plain that being “*entitled to receive*” is different from “having authority to access.” For example, the '592 Patent notes that the disclosed system selectively provides service instances to the requesting client-receivers:

“selectively provide[s] the services received from the headend to the client-receivers.”

(See, e.g., OpenTV-1001 at 3:11-13, emphasis added). The specification of the '592 Patent further describes that the DSCT can act as a filter and block service instances from being transmitted to client-receivers, even though the client-receivers have the appropriate decryption means to access the service instances:

... the DSCT 110 can act as a **filter to prevent** certain content such as sexually oriented content **from being provided to the client-receiver** 122. If the requested service instance is not **blocked**, the processor 702 grants entitlement for the selected service instance and updates entitlement 706.

(See, e.g., OpenTV-1001 at 29:33-37, emphasis added.)

The DSCT determines whether the client-receiver is entitled to the selected service, and if so, transmits the content to of the selected service...to the client-receiver.

(See, e.g., OpenTV-1001 at 3:29-32, emphasis added). Further, the '592

Patent plainly discloses that “receiving” is an event that occurs before the

“accessing” (i.e., decryption) of the received content:

The client-receiver 122 receives service instances from the DSCT 110...[w]hen the service instances are transmitted as cipher text, i.e., in encrypted form, the service instances are provided to the cryptographic device 912 for decryption.

(See, e.g., OpenTV-1001 at 31:4-11, emphasis added.) Thus, the above portions of the '592 Patent makes clear that a client-receiver 122 can actually have the proper means to access (*i.e.*, decrypt) but the service instance is not provided to the client-receiver because it is not “*entitled to receive*” the service instance. Preventing the client-receiver from receiving the content in the first place (by not sending it) provides an additional level of security over transmitting the content and then relying on the client-receiver not having the means to access (*i.e.*, decrypt) the content. Further, the above portions clearly distinguish between being “*entitled to receive*” and having “authority to access” because being “*entitled to receive*” the service instance comes before the subsequent accessing (*i.e.*, decrypting) the received service instance by the client-receiver.

In view of the above, OpenTV's suggestion that its proposed construction is supported by the specification of the '592 Patent is untenable. To the contrary, OpenTV's proposed claim construction effectively reads out of the claims express limitations and is inconsistent with the specification, and is thus unreasonably broad. Thus, OpenTV's proposed claim construction will not assist the Board and the parties in evaluating the claims relative to the prior art in this case.

Therefore, the broadest reasonable construction of the term "*entitled to receive*" should be construed as "permitted to receive."

E. A "*subscriber*" and a "*subscriber premises*"

All of the claims recite a "*subscriber premises*." The Patent Owner has proposed a claim construction for both "*subscriber*" and "*subscriber premises*." It is noted that the claims never use the term "*subscriber*" alone, only as part of the two-word term: "*subscriber premises*."

Subscriber: Patent Owner submits that the term "*subscriber*" should be construed as "a person that is permitted to receive the service instance."

The '592 Patent notes that a subscriber is a person that is entitled (*i.e.*, permitted) to receive a service instance and an unauthorized person does not have the right to receive the service instance:

In yet another embodiment, a subscriber accesses services provided by the STS using the subscriber's client receiver. The subscriber uses a web-based browser to display an index of

services. Typically, the index is in the form of an electronic program guide, and in the electronic program guide the services are displayed as hyperlinks. The subscriber selects a service by clicking on the hyperlink of the selected service, which causes a message to be transmitted to the DSCT. The DSCT determines whether the client-receiver is entitled to the selected service, and if so transmits the content of the selected service in a web-based format to the client receiver.

(See, e.g., OpenTV-1001 at 3:21-34, emphasis added.)

Likewise, using wireless communications may necessitate a tighter level of security because the transmissions might exit the premises and be received by an unauthorized person.

(See, e.g., OpenTV-1001 at 20:37-40, emphasis added.)

Therefore, the broadest reasonable construction of the term “*subscriber*” is, “a person that is permitted to receive the service instance.”

Subscriber Premises: Patent Owner submits that “*subscriber premises*” should be construed as “the location where the person that is permitted to receive the service instance resides.”

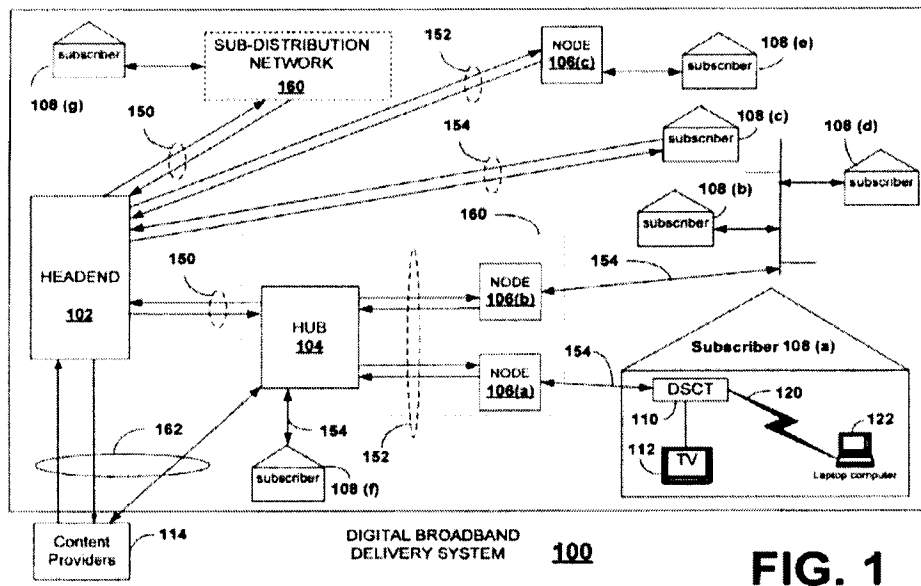
The proposed construction is consistent with the specification of the ’592 Patent, which interchanges the use of the words “premises” and “residence”:

Wired communication has the advantage of requiring that a wire extend from DSCT to the subscriber device, which is in an existing subscriber residence may entail retrofitting the residence, and that can be expensive.

(See, e.g., OpenTV-1001 at 1:66-2:3, emphasis added.)

In one preferred embodiment, a digital subscriber communication terminal (DSCT), which is located at a subscriber's premises, receives services from the headend of a subscriber television system (STS).

(See, e.g., OpenTV-1001 at 3:1-4, emphasis added.) Further Fig. 1 (reproduced below) plainly illustrates that the premises is the location where the subscriber resides (*i.e.*, homes 108).



Indeed, even OpenTV recognizes that the “*subscriber premises*” is described by the ’592 Patent as the location where the subscriber resides (*e.g.*, home).

It was only after the amendment to include multiple devices on a local network within the home that the Examiner was found the claims allowable.

(Petition at 8, emphasis added.)

The specification, however, does disclose a digital subscriber communications terminal (DSCT) that manages a home network and provides services to remote clients coupled to the home network.

(Petition at 10, emphasis added.)

In view of the above disclosure of the '592 Patent and OpenTV's recognition that the "*subscriber premises*" is the location where the subscriber resides (*e.g.*, home), OpenTV's argument in the Petition at 12 to construe "*subscriber premises*" as "the location of the subscriber" is unsupported.

After arguing for the above unreasonably broad construction, OpenTV relies on the construction and contends (in the Petition at 18 and 21) that a whole hotel and a whole apartment complex correspond to the "*subscriber premises*" because it is the location of the subscriber. This contention is baseless and without evidentiary support, for at least the reasons noted above.

It is important to recognize that Patent Owner's proposed construction does not limit the term "*subscriber premises*" to the "subscriber residence" but rather to "the location where the person that is permitted to receive the service instance (*i.e.*, subscriber) resides." Under Patent Owner's proposed construction, a single home within a neighborhood where the subscriber resides would be a "*subscriber premises*," but not the whole neighborhood. Similarly, a single apartment within

an apartment complex where a subscriber resides would be a “*subscriber premises*,” but not the whole apartment complex. Likewise, a single room within a hotel where the subscriber resides would be a “*subscriber premises*,” but not the whole hotel. Asserting that the whole hotel or whole apartment complex is the “*subscriber premises*,” as done by OpenTV, is analogous to asserting that the whole neighborhood is the “*subscriber premises*” and such an unreasonable broad interpretation is clearly not supported by the specification of the '592 Patent.

Therefore, the broadest reasonable construction of the term “*subscriber premises*” is, “the location where the person that is permitted to receive the service instance resides.”

F. A “*headend*”

Claims 1-11 and 16-20 recite that the communications device receives a service instance from a “*headend*.” Patent Owner submits that a “*headend*” is a term of art and in light of the disclosure of the '592 Patent at Figs. 1 and 2 and corresponding text at 10:21-15:29, “*headend*” should be construed as “a facility that receives service instances from content providers, and transmits the service instances including entitlement information to a subscribers premises.”

G. Summary of Proposed Claim Constructions

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

Claim term	Construction
<i>service instance</i>	An audio/visual program or real-time interactive services.
<i>communications device</i>	A device that selectively provides service instances received from a headend to a requesting client device.
<i>remote client device</i>	A device configured to request and receive service instances.
<i>entitled to receive</i>	Permitted to receive.
<i>subscriber</i>	A person that is permitted to receive the service instance.
<i>subscriber premises</i>	The location where the person that is permitted to receive the service instance resides.
<i>headend</i>	A facility that receives service instances from content providers, and transmits the service instances including entitlement information to a subscriber premises.

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 proposed challenge to the claims (*i.e.*, Grounds A1-2 and B1-3), 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 Ground A1

Ground A1 of OpenTV's Petition asserts that Claims 1-2, 6-8, 12-13, and 17-20 are anticipated by Payton under 35 U.S.C. §102. 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)). 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 Payton discloses all of the claim elements of the '592 Patent, either expressly or inherently. Consequently, OpenTV's has not presented a reasonable likelihood that it will prevail with respect to Ground A1.

**1. Claims 1-2, 6-8, 12-13, and 17-20: Payton fails to disclose
“*determining whether the remote client device is entitled to receive
the requested stored service instance*”**

OpenTV makes a thinly veiled attempt to read out of the claims the above limitation, in the claim construction section of the Petition, by purporting to construe the term “*entitled receive*” as “authority to access.” (See e.g., Petition at 11.)⁷ After OpenTV provides an improper claim construction that effectively reads out of the claim the above limitation, the Petition compounds the error by only purporting to show that Payton teaches determining whether the subscriber (using a local video server, which OpenTV compares to the claimed “communications device”) has made a payment, and altogether fails to address the real limitation of determining whether the remote client is “*entitled to receive*.” By not addressing the real limitation, 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.”).

Nevertheless, Patent Owner provides the following analysis clearly demonstrating that Payton does not teach the above claimed feature.

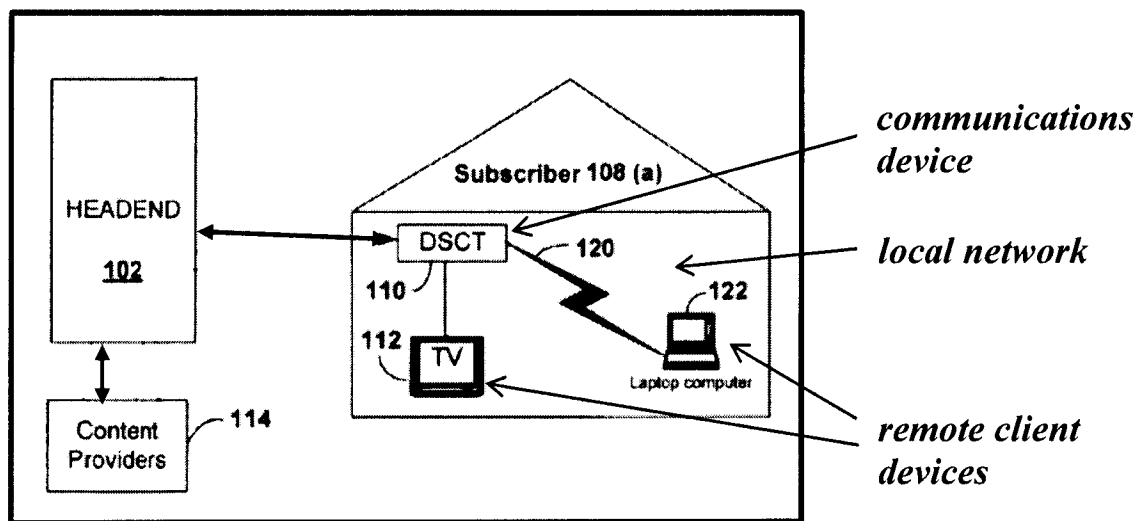
⁷ As noted above in Section III.D, however, the '592 Patent makes it clear that “*entitled to receive*” means “permitted to receive.”

**a) Checking for a payment is not the same as
“determining whether the remote client device is entitled to
receive the requested stored service instance”**

OpenTV makes the above argument because Payton, in connection with Fig. 2, states:

...the digital items are preferably encrypted so that downloaded items [on the local server 28] cannot be accessed without first being paid for.

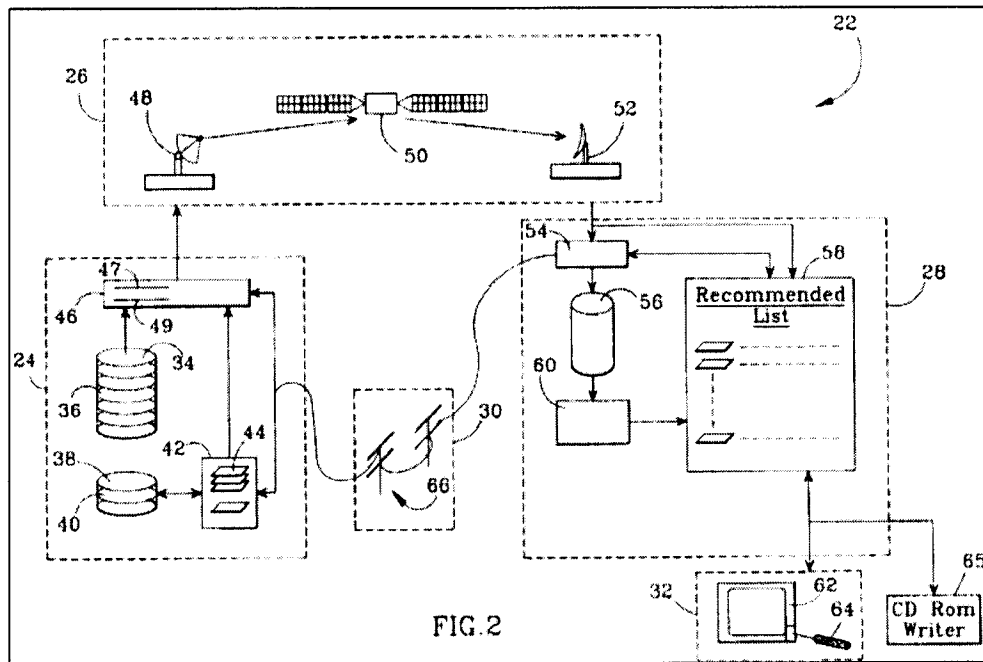
(See, e.g., OpenTV-1002 at 4:64-66, emphasis added.) OpenTV further states that “[o]ne of ordinary skill in the art would have understood that only subscribers would be able to access content from the local video server of a particular service provider.” (Petition at 20.) This argument fails for the following reasons.



'592 Patent, FIG. 1 (partial)

Referring again to the portion of FIG. 1 from the '592 Patent above, the claims of the '592 Patent separately identify a “subscriber premises” having a

“communications device” and “one or more of said remote client devices.” The claims further recite determining whether a specific “remote client device” is “*entitled to receive*” a specific service instance. That is, the determination is made for the *remote device*, not the *subscriber premises* or the *communications device*. Payton is different. Payton teaches checking whether the items on the local server 28 in FIG. 2 below, which OpenTV compares to the claimed “communications device,” have been paid for. (See quote above, OpenTV-1002 at 4:64-66.) The local server 28 is not the same as the playback device 32, which OpenTV compares to the claimed “remote device.”



Payton, FIG. 2

Notably, Payton never discloses restricting or blocking the transmission of the item to a requesting playback device because the device is not entitled to

receive the item. Instead, Payton always discloses that the local server 28 simply responds to a request by delivering the requested item to a playback device:

In response to a subscriber's request, the local server first polls the local storage to see if the requested item is stored locally...As soon as the item is received locally, it is sent to a local playback device.

(See, e.g., OpenTV-1002 at 3:25-32.)

In response to a subscriber's request, the delivery system 22 delivers the requested item to the subscriber's playback device 32 such as a television, audio system or computer.

(See, e.g., OpenTV-1002 at 4:51-54.)

Thus, checking for payment does not disclose the above feature. Further, Payton teaches that the delivery system simply responds by delivering the requested item to the requesting playback device, not determining whether the playback device is entitled to receive the requested item. This approach does not provide the additional layer of security as claimed and disclosed in the '592 Patent.

**b) Payton's Hotel and Apartment Complex
Embodiments are Inconsequential**

OpenTV further contends that “[a]dditional teachings by Payton regarding determining entitlement can also be found in Payton's embodiments describing use of the video server in a hotel or apartment complex environment.” (Petition at 21.) This argument is without merit.

It is noted that Payton provides limited disclosure with respect to the hotel and apartment complex embodiments. Regarding these embodiments, Payton merely states:

Video servers can also be used to deliver on-demand video to a large group of subscribers in a local area such as guests in a hotel...because the video server requires a dedicated cable network to deliver on-demand video it is limited to applications such as hotels where the total number of channels that must be allocated at any given time is not likely to exceed the capacity of the network.

(*See, e.g.*, OpenTV-1002 at 1:64-2:12.)

FIG. 8 illustrates an alternate embodiment of the invention where each local server [28] has been replaced by a video server 176 which serves a plurality of local subscribers. For example, a video server configuration may be used to service multiple televisions within a single home or to service all of the residence in an apartment complex.

(*See, e.g.*, OpenTV-1002 at 9:62-67.) Payton never teaches that a hotel guest or an apartment resident is not permitted to receive an item. To the contrary, Payton always discloses that video server 176 simply responds to a request by transmitting the item:

When one of the subscribers requests an item, the video server either retrieves it from the local storage or requests it from the central distribution server. Alternately, the subscriber may be

limited to only those selections stored on the local video server.

The video server then assigns the subscriber a dedicated channel and transmits the item to the requesting subscriber.

(See, e.g., OpenTV-1002 at 10:5-11.) Thus, it is clear that Payton does not determine whether the playback device 32 is entitled to receive the item before the item is transmitted.

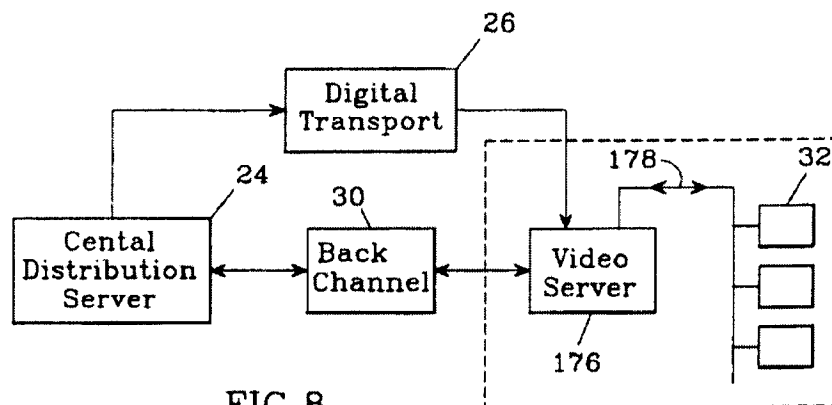


FIG. 8

Further, it is readily apparent that in the hotel and apartment complex embodiments, the video server 176 is not at the “*subscriber premises*” (i.e., the location where the subscriber resides). Specifically, Fig. 8 clearly illustrates that the video server 176 is not where the subscriber playback devices 32 resides. For example, in the hotel embodiment the subscriber including playback device 32 would reside in a hotel room while the video server 176 would reside in a different location, such as the hotel lobby/office. Likewise, in the apartment complex embodiment, the subscriber including playback device 32 would reside in an apartment of the apartment complex while the video server 176 would reside in a

different location, such as the apartment complex management office.

Consequently, the hotel and apartment complex embodiments also fail because the video server 176 is not located at the “*subscriber premises*.”

Further still, OpenTV's reliance on the sentence in Payton discussing checking whether the video server has made a payment suffers the same problems in the hotel and apartment complex scenarios as it does in the home. That is, checking whether the video server at the hotel or the apartment complex has made a payment is not the same as determining whether a playback device is entitled to receive. Thus, the hotel and apartment complex embodiments are unsupportable.

c) Payton does not inherently disclose “determining whether the remote client device is entitled to receive the requested stored service instance.”

To the extent that the OpenTV Petition, which proposes rejections under 35 U.S.C. §102, seeks to imply that this limitation is inherently disclosed, the Patent Owner notes that such characterization is improper.

As recognized, the moving party always bears the initial burden of developing reasons supporting a reliance on inherency. (*See e.g.*, M.P.E.P. § 2112(IV)) To satisfy this burden, OpenTV must identify some basis in fact or articulate some reasoning tending to show that the allegedly inherent subject matter necessarily (*i.e.*, inevitably) flows from the cited reference. (*See e.g.*, *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (To

establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is **necessarily** present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” emphasis added); *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic **necessarily** flows from the teachings of the applied prior art,” emphasis added.)

In the present case, OpenTV's Petition provides no evidence whatsoever that the system of Payton necessarily determines whether the playback device 32 (of Payton's Figs. 2 and 8) is entitled to receive the digital item from local server 28 or video server 176. Further, OpenTV expert witness Perkins fails to cure the deficiency.

As discussed above, in Payton, it is not necessary to determine whether the playback device 32 is “*entitled to receive*” the digital item. For example, in the hotel embodiment, the hotel can pay for the videos downloaded to video server 176 and provide these videos to all playback devices 32 (*i.e.*, televisions) in the rooms, obviating the need of determining whether a particular playback device 32 is

entitled to receive the digital item. If desired, the hotel can simply bill the hotel room for later payment. Similarly, in the apartment complex embodiment, the apartment complex can pay for the videos downloaded to video server 176 and provide these videos to all playback devices 32 in the apartments, obviating the need to determine whether a particular playback device 32 is entitled to receive the digital item. Likewise, in the home embodiment, the homeowner can pay for the downloaded movies and make the movies available to all playback devices 32 in the home, again obviating the need to determine whether a particular playback device 32 is entitled to receive the digital item. Thus, in Payton, it is not necessary to determine whether a playback device 32 is entitled to receive a digital item.

Accordingly, OpenTV fails to provide any credible explanation as to how Payton expressly or inherently discloses “*determining whether the remote client device is entitled to receive the requested stored service instance,*” as recited in the claims. Thus, OpenTV has not demonstrated a reasonable likely hood of prevailing with respect to independent Claims 1, 6, and 12 (along with all dependent claims) and no trial should be instituted as to Ground A1.

d) Not only does Payton fail to expressly or inherently disclose “*determining whether the remote client device is entitled to receive the requested stored service instance,*” Payton does not contain an enabling disclosure of such a feature

It is well established that in order for a reference to anticipate a claim under 35 U.S.C. § 102, the reference must provide an enabling disclosure of the claimed subject matter that it allegedly anticipates. (*See e.g., In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968), “In determining that quantum of prior art disclosure which is necessary to declare an applicant’s invention ‘not novel’ or ‘anticipated’ within section 102, the stated test is whether a reference contains an ‘enabling disclosure’... .”) A reference contains an “enabling disclosure” if the public was in possession of the claimed invention before the date of invention. (*See e.g., In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985), “Such possession is effected if one of ordinary skill in the art could have combined the publication’s description of the invention with his [or her] own knowledge to make the claimed invention.”) In other words, the 35 U.S.C. § 102 reference must describe the claimed subject matter that it allegedly anticipates in such detail as to enable one of ordinary skill in the art to make the claimed subject matter without undue experimentation.

In the present case, Payton fails to enable one of ordinary skill in the art to perform the method claimed in the ’592 Patent without undue experimentation.

Specifically, Payton fails to enable the step of “*determining whether the remote client device is entitled to receive the requested stored service instance*” as recited in the claims. As noted above, this claim feature is important because it allows for controlling specific content to specific client-receivers (*See, e.g.,* OpenTV-1001 at 29:29-40) and provides additional security beyond encryption by stopping theft of service by external client-receivers (*See, e.g.,* OpenTV-1001 at 2:24-28; 20:37-40.)

The '592 Patent goes to great lengths to enable this approach. For instance, the '592 Patent describes that in order to determine whether the client-receiver is entitled to receive the stored service instance, the DSCT maintains an entitlement map. (*See, e.g.,* OpenTV-1001 at 25:11-12.) The entitlement map indicates whether or not a specific client-receiver is entitled to receive a specific service instance. (*See, e.g.,* OpenTV-1001 at 25:13-15; 21:46-50.)

In contrast, Payton fails to provide any detail regarding how to manage entitlements in order to determine whether a playback device is entitled to receive would require undue experimentation. Specifically, Payton only describes a well-known approach of providing security by encrypting items before transmitting them to a local server. (*See, e.g.,* OpenTV-1002 at 4:64-66.) The local server decrypts the item and in response to a request for the item from a playback device, transmits the item to the playback device. (*See, e.g.,* OpenTV-1002 at 4:51-54.) Payton never determines whether the playback device is entitled to receive the

requested item and does not disclose any mechanism (e.g., entitlement map or alternate scheme) for doing so. Consequently, Payton never allows for controlling content or stopping theft of services by external playback devices. In view of the inadequate disclosure of Payton, a person of ordinary skill in the art would have to unduly experiment and devise/invent an entitlement scheme for determining whether the playback device is entitled to receive the requested item. Thus, Payton fails to enable one of ordinary skill in the art to perform the method claimed in the '592 Patent without undue experimentation.

Because Payton does not provide an enabling disclosure with respect to the claimed subject matter of the '592 Patent it cannot therefore be an anticipatory reference under 35 U.S.C. § 102. Accordingly, OpenTV has not demonstrated a reasonable likely hood of prevailing with respect to independent Claims 1, 6, and 12 (along with all dependent claims) and no trial should be instituted as to Ground A1.

**2. Claims 1-2, 6-8, 12-13, and 17-20: Payton fails to disclose
“responsive to determining the remote client device is entitled to
receive the requested stored instance...transmitting the requested
service instance”**

As an initial matter, it is noted that because Payton fails to perform the initial step of “determining whether the remote client device is entitled to receive the requested stored service instance,” as discussed above, Payton also fails to disclose “responsive to determining the remote client device is entitled to receive the

requested stored instance...transmitting the requested service instance,” as recited in Claims 1, 6, and 12 (and thereby included in all of the dependent claims).

Nevertheless, Patent Owner provides the following additional comments further demonstrating that OpenTV fails to meet its burden under 35 U.S.C. § 314(a) with respect to this claim limitation.

OpenTV in the Petition provides no evidence that Payton teaches the above limitation but rather cites to the declaration of its expert witness Perkins and asserts that “[o]ne of ordinary skill in the art would have understood that in Payton...transmission of content...would be in response to determining that the playback device has authority to access the content.” (Petition at 22).

The declaration of the OpenTV expert witness, however, provides no support for OpenTV’s conclusory statement. Specifically, the Perkins declaration (OpenTV-1007 at 70) merely asserts that the content is transmitted “responsive to the playback device obtaining authority to access the content, e.g., by the user agreeing to pay.” However, Perkins’ statement is based on a false premise – namely that the user agreed to pay. As noted above in Section IV.A.1.a, Payton is completely silent on the user of the playback device agreeing to pay. Indeed, as already discussed above, Payton discloses that local server 28 is the one paying for content. Consequently, OpenTV’s conclusory statement is based on a false premise and is therefore erroneous.

Thus, because Payton also fails to disclose this feature, no trial should be ordered as to Ground A1.

3. Claims 1-2, 6-8, and 18-20: Payton fails to disclose a “headend”

Payton fails to either expressly or inherently disclose a “headend.” Patent Owner agrees with OpenTV that Payton’s central distribution server 24 is not a “headend.” However, Patent Owner disagrees with OpenTV’s assertion that:

One of ordinary skill in the art would have understood that the central distribution server is located at the headend.

(Petition at 19, emphasis added.) Such a bare assertion, made with no adequate evidentiary support, leaves the reader at a loss with respect to how Payton is alleged to disclose that the distribution server 24 is located at a “headend.”

Moreover, this statement is wholly inconsistent with OpenTV’s statement in the Petition at 15 that “Payton discloses the use of a content server in a home served by a satellite broadcast network. As well known, a satellite broadcast network typically **lacked** a communication channel from a subscriber premise to the headend.”

For alleged support to its inconsistent position, the Petition cites the declaration of the OpenTV expert witness, but it fares no better because it too is merely conclusory. That is, the Perkins declaration (OpenTV-1007 at 24) merely asserts that “[o]ne of ordinary skill in the art understands that the central

distribution server in this diagram is located at the satellite system operator's headend" "because Payton states that the invention is 'for use with existing digital transport systems.'" This statement does not provide a credible explanation or reference to underlying evidence, contrary to 37 C.F.R. § 42.65(a) ("Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight."). Neither the Federal Rules of Evidence nor Federal Circuit case law require a fact finder to credit the unsupported assertions of an expert witness. *Rohm and Haas Co. v. Brotech Corp.*, 127 F.3d 1089, 1092, 44 USPQ2d 1459, 1462 (Fed. Cir. 1977). Consequently, the Perkins declaration should be accorded no weight on at least that portion of the opinion.

To the extent that OpenTV seeks to imply that Payton inherently teaches that the central distribution sever 24 is at a headend, Patent Owner submits that such characterization is improper. As noted above, to show inherency OpenTV must identify some basis in fact or articulate some reasoning tending to show that the allegedly inherent subject matter necessarily (*i.e.*, inevitably) flows from the cited reference. (*See e.g., In re Robertson* at 169 F.3d.) (To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference," emphasis added.)

In the present case, OpenTV's Petition provides no evidence whatsoever that the central distribution server 24 is necessarily at a headend – indeed the Petition at

15 makes the contrary assertion. Further, OpenTV expert witness Perkins' contention that the central distribution server is located at a headend "because Payton states that the invention is 'for use with existing digital transport systems' (Col. 2:63, and such systems include headends)" also fails to meet the above standard of making "clear that the missing descriptive matter is necessarily present in the thing described." (*See In re Robertson*, 169 F.3d at 745.)

As a practical matter, merely disclosing that a device is designed for use with existing digital transport systems does not provide evidence that the device is necessarily at a headend of such a system. For example, Payton also discloses that local server 28 and video server 176 are designed "for use with existing digital transport systems," but these devices are clearly not located at a headend. As another example, the computers or servers in the Patent Office are designed for use with existing digital transport systems (*e.g.*, existing satellite, cable, and internet systems), but these computers and servers are in the Patent Office and are not at a headend of such digital transport systems. Moreover, the fact that in Payton the local server 28 communicates directly with the video server 176 suggests that this is a separate network and that the video server 176 is not at a headend. As such, and contrary to OpenTV's expert witness Perkins' contention, disclosing that the central distribution server 24 is designed for use with existing digital transport

systems does not provide evidence that the distribution server 24 is necessarily at a headend of the digital transport system.

Thus, Payton does not disclose either expressly or inherently a “*headend*” as recited in Claims 1, 6, and 18. Therefore, OpenTV has not demonstrated a reasonable likely hood of prevailing with respect to these claims (or their dependent claims) and no trial should be instituted as to Ground A1.

In summary, because Payton fails to disclose a “*headend*,” “*determining whether the remote client device is entitled to receive the requested stored service instance*,” and “*responsive to determining the remote client device is entitled to receive the requested stored instance...transmitting the requested service instance*” it cannot anticipate Claims 1-2, 6-8, 12-13, and 17-20 of the '592 Patent (OpenTV has not asserted obviousness for any claim). Therefore, OpenTV has failed to demonstrate a reasonable likelihood that any claim is unpatentable over Payton. Accordingly, no trial should be ordered as to Ground A1.

B. No Trial Should Be Instituted for Grounds A2 and B1-3

Ground A2 of OpenTV's Petition contends that Claims 1-4, 6-10, 12-15, and 17-20 are anticipated by Hicks under 35 U.S.C. §102. Ground B1 of OpenTV's Petition contends that Claims 2, 8, and 13 are rendered obvious by Hicks in view of Egli under 35 U.S.C. §103. Ground B2 contends that Claims 3-5, 9-11, and 14-16 are rendered obvious by Hicks in view of Safadi under 35 U.S.C. §103. Ground

B3 contends that Claim 6 is rendered obvious by Hicks in view of Putterman under 35 U.S.C. §103.

OpenTV's reliance on Hicks is misplaced because Hicks also fails to disclose "*determining whether the remote client device is entitled to receive the requested stored service instance,*" and "*responsive to determining the remote client device is entitled to receive the requested stored instance...transmitting the requested service instance,*" as recited in independent Claims 1, 6, and 12 (and included in all of the dependent claims by virtue of their dependency). As such, OpenTV's Petition has not presented a reasonable likelihood that it will prevail with respect to Grounds A2 and B1-3.

1. Claims 1-20: Hicks fails to disclose "*determining whether the remote client device is entitled to receive the requested stored service instance*"

OpenTV asserts that independent Claims 1, 6, and 12, which recite the above limitation, are anticipated by Hicks under 35 U.S.C. §102. Under 35 U.S.C. §102, "[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." (*See e.g., Verdegaal Bros. at 631*, emphasis added.) As shown below, Hicks fails to expressly or inherently disclose the above limitation.

As already noted above, OpenTV effectively reads out of the claims the above limitation by purporting to construe the term "*entitled receive*" as "authority

to access.”⁸ OpenTV then compounds the error by only purporting to show that Payton teaches determining whether the remote client has “authority to access” and altogether fails to address the real limitation of determining whether the remote client is “*entitled to receive*” (*i.e.*, permitted to receive).

Hicks discloses that remote clients obtain authority to access requested multimedia in a number of ways. (*See e.g.*, Petition at 38, emphasis added.) By not addressing the real limitation of determining whether the remote client is “*entitled to receive*,” 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.”)

Nevertheless, Patent Owner provides the following analysis clearly demonstrating that Hicks does not teach the above claimed feature.

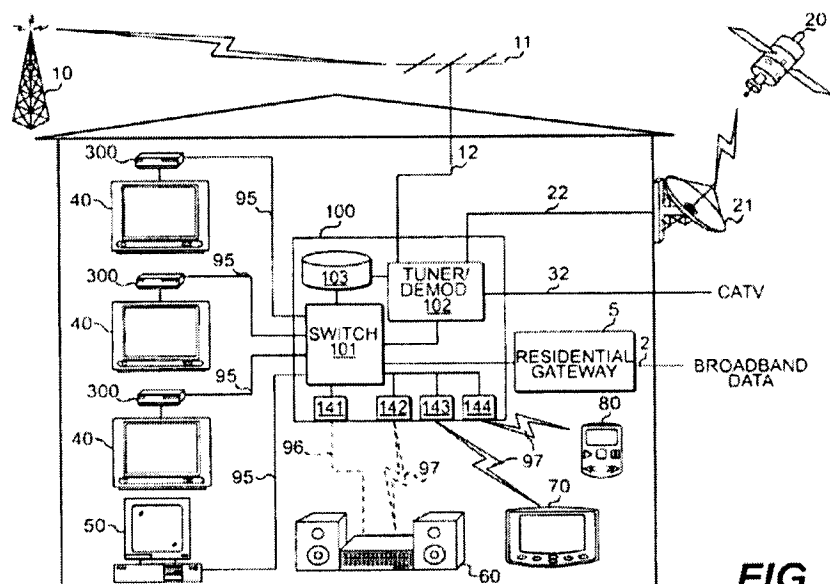
a) OpenTV has not shown that conditional access systems (CAS) and Digital Transmission Content Protection (DTCP) of Hicks perform the step of “*determining whether the remote client device is entitled to receive the requested stored service instance*”

In the Petition, OpenTV relies on the encryption of conventional conditional access systems (CAS) and Digital Transmission Content Protection (DTCP) noted within Hicks to disclose the above claim limitation. (Petition at 38-40.) This

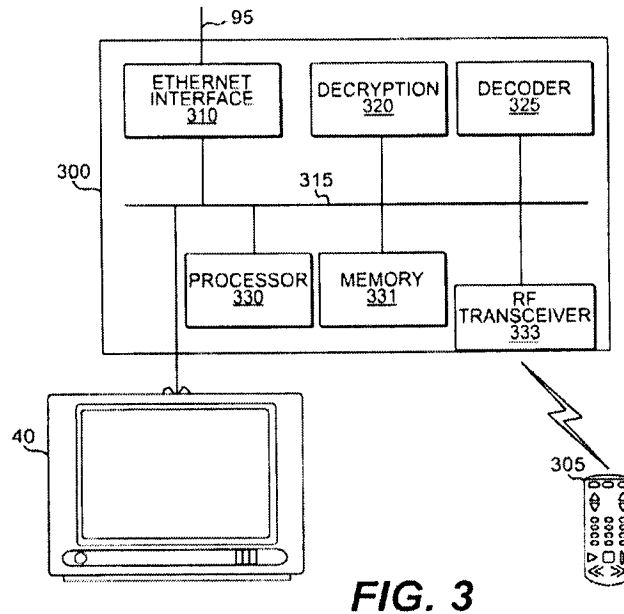
⁸ As noted in Section III.D, however, the ’592 Patent makes it clear that “*entitled to receive*” means “permitted to receive.”

reliance is misplaced because these encryption approaches do not apply to the above key features of the claimed invention.

The Hicks reference describes a multimedia on demand system that utilizes conventional encryption approaches to secure content. As illustrated below in Fig. 1, the system of Hicks comprises a broadband multimedia gateway (BMG) 100 that includes an I/O 137 that can include a CAS smart card reader/writer and cypher/decypher for encrypting/decrypting content according DTCP. (*See, e.g.,* OpenTV-1003 at 6:7-17; 9:13-36.) BMG 100 can receive multimedia content from terrestrial broadcast TV via transmitter 10 and from satellite 20. (*See, e.g.,* OpenTV-1003 at 6:18-33.) The received multimedia content can be stored in storage 103 or sent to switch 101 which routes the multimedia content to information appliances 300, 50, 60, and 70. (*See, e.g.,* OpenTV-1003 at 7:7-15; 7:40-53; 8:5-16.)



Appliances 300, illustrated below in Fig. 3 are able to access the received multimedia content (which may be encrypted) by utilizing decryption 320. (*See, e.g.,* OpenTV-1003 at 7:7-15; 7:40-53; 8:5-16.)



Importantly, nothing within Hicks discloses that the BMG 100 determines, before the content is transmitted, whether a specific appliance 300, 50, 60, and 70 is entitled (*i.e.*, permitted) to receive the specific multimedia content. Rather, Hicks relies solely on encryption to protect the multimedia content. That is, the appliances always **receive** the content, and Hicks relies completely on the appliances to allow or not allow access to the content.

In contrast, the '592 Patent describes and claims features beyond such conventional approaches of protecting content. Specifically, the system and methods of the '592 Patent selectively provide service instances to a requesting

client-receiver by determining whether the client-receiver is entitled (*i.e.*, permitted) to receive a service instance and if the client-receiver is permitted to receive the service instance is transmitted to that specific client-receiver.

Otherwise, a service denied message is transmitted.

The DSCT is adapted to, among other things, selectively provide the services received from the headend to the client-receivers.

(*See, e.g.*, OpenTV-1001 at 3:11-13, emphasis added).

The DSCT determines whether the client-receiver is entitled to the selected service, and if so, transmits the content to of the selected service...to the client-receiver.

(*See, e.g.*, OpenTV-1001 at 3:29-32, emphasis added).

...when the DSCT 110 or the headend 102 determines that the client-receiver 122 is not entitled to a requested service, the DSCT sends a service denied message.

(*See, e.g.*, OpenTV-1001 at 23:20-23, emphasis added). The ability to selectively provide service instances is important because it enables, for example, content filtering on a per service instance per client-receiver basis.

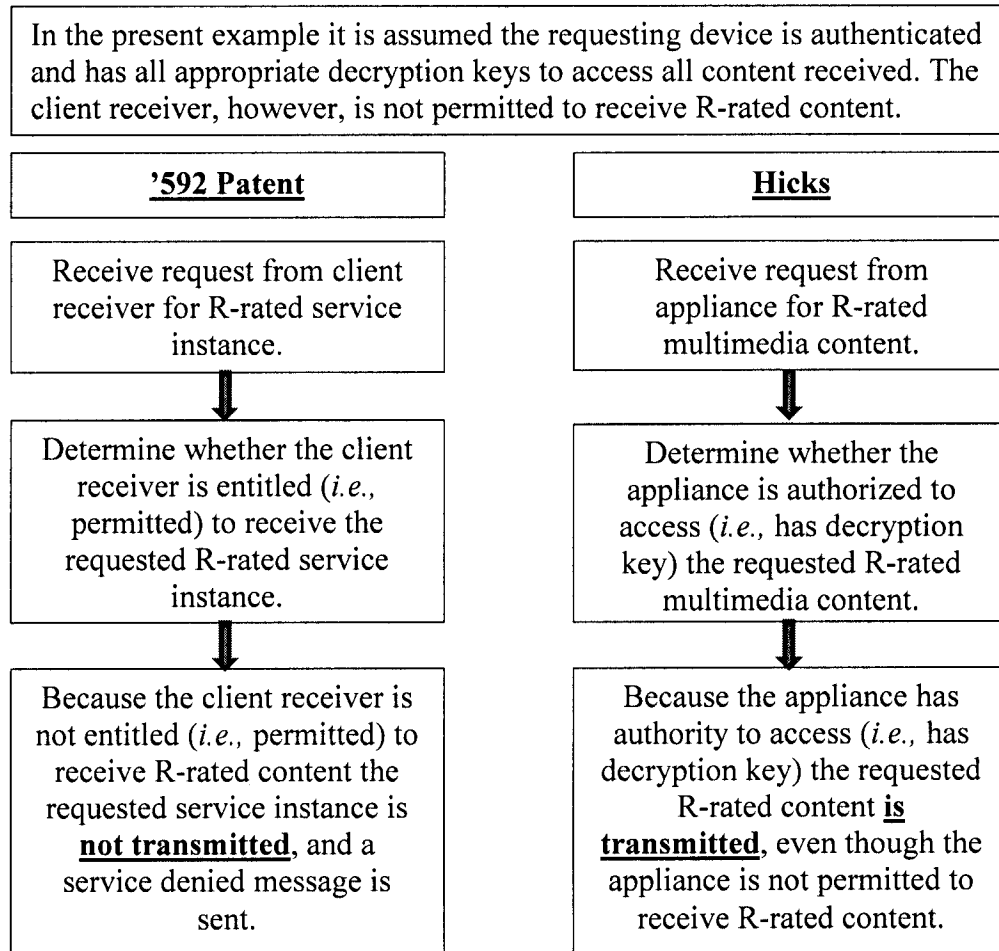
... the DSCT 110 can act as a filter to prevent certain content such as sexually oriented content from being provided to the client-receiver 122.

(*See, e.g.*, OpenTV-1001 at 29:32-35, emphasis added.) After a client-receiver receives the service instance, it is decrypted.

The client-receiver 122 receives service instances from the DSCT 110...In the preferred embodiment, the secure element 908 [of the client-receiver] provides control words to the cryptographic device 912 for decrypting the encrypted service instance.

(*See, e.g.*, OpenTV-1001 at 31:4-11, emphasis added.) The following example flowchart is provided to demonstrate that determining whether a client is authorized to access (*i.e.*, decrypt) is not the same as determining whether a client is entitled (*i.e.*, permitted) to receive:⁹

⁹ In the flowchart example, Patent Owner identifies features from Hicks that OpenTV characterizes as corresponding to features recited in the claims of the '592 Patent. Although Patent Owner provides the flowchart example in accordance to OpenTV's characterization, it should not be construed that Patent Owner agrees or concedes to any such characterization. In fact, Patent Owner expressly declines to subscribe to such characterizations.



As such, having “authority to access” is not the same as being “*entitled to receive*.” Consequently, the system of Hicks fails to disclose the step of “*determining whether the remote client device is entitled to receive the requested stored service instance*.” Therefore, OpenTV’s Petition has not presented a reasonable likelihood that it will prevail with respect to Grounds A2 and B1-3.

To the extent that the OpenTV Petition, which proposes rejections under 35 U.S.C. §102, seeks to imply that this limitation is inherently disclosed, Patent Owner notes that such characterization is improper. As noted above, to show

inherency OpenTV must identify some basis in fact or articulate some reasoning tending to show that the allegedly inherent subject matter necessarily (*i.e.*, inevitably) flows from the cited reference. (*See e.g., In re Robertson* at 169 F.3d.)

In the present case, OpenTV's Petition provides no evidence whatsoever that the system of Hicks necessarily determines whether appliances 300, 50, 60, and 70 are entitled (*i.e.*, permitted) to receive multimedia content from BMG 100. Further, OpenTV expert witness Perkins likewise fails. Thus, OpenTV has not demonstrated a reasonable likely hood of prevailing with respect to independent Claims 1, 6, and 12 (along with all dependent claims) and no trial should be instituted as to Grounds A2 and B1-3.

2. Claims 1-20: Hicks fails to disclose “*responsive to determining the remote client device is entitled to receive the requested stored instance...transmitting the requested service instance*”

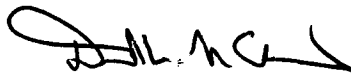
As analyzed above, Hicks fails to disclose “*determining whether the remote client device is entitled to receive the requested stored service instance.*” Because Hicks never performs the initial determining step, it cannot be argued that Hicks discloses that “*responsive to determining the remote client device is entitled to receive the requested stored instance...transmitting the requested service instance,*” as recited in independent Claims 1, 6, and 12 (and thereby included in all of the dependent claims). Thus, because Hicks also fails to disclose this feature, no trial should be ordered as to Grounds A2 and B1-3.

In summary, because Hicks fails to disclose “*determining whether the remote client device is entitled to receive the requested stored service instance,*” and “*responsive to determining the remote client device is entitled to receive the requested stored instance...transmitting the requested service instance*” it cannot anticipate Claims 1-4, 6-10, 12-15, and 17-20 or render obvious Claims 2-6, 8-11, and 13-16 (OpenTV has not asserted obviousness for any independent claim). Therefore, OpenTV has failed to demonstrate a reasonable likelihood that any claim is unpatentable over Hicks. Accordingly, no trial should be ordered as to Grounds A2 and B1-3.

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 A1-2 and B1-3), *inter partes* review of the '592 Patent should be denied and Claims 1-20 of the '592 Patent should be confirmed.

Respectfully submitted,



David L. McCombs
Registration No. 32,271

HAYNES AND BOONE, LLP
Customer No. 27683
Telephone: 214/651-5533
Facsimile: 214/200-0853
Attorney Docket No.: 43614.194

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 IPR2013-00330

Patent 7,505,592

Title: APPARATUS FOR ENTITLING AND TRANSMITTING SERVICE
INSTANCES TO REMOTE CLIENT DEVICES

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
Perkins Coie LLP
11988 El Camino Real, Suite 200
San Diego, CA 92130



David L. McCombs
Registration No. 32,271