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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE, INC.  
Petitioner

v.

OPENTV, INC.  
Patent Owner

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Case IPR2015-00969  
Patent 5,884,033

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**Patent Owner's Preliminary Response  
to Petition for *Inter Partes* Review  
of U.S. Patent No. 5,884,033**

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## **I. Preliminary Statement**

The '033 Patent, titled “Internet Filtering System for Filtering Data Transferred Over the Internet Utilizing Immediate and Deferred Filtering Actions,” was filed on May 15, 1996. At the time of '033 Patent, the Internet was still in a nascent stage, and Spyglass, Inc., the patent’s named assignee, created one of the first Internet web browsers called Mosaic. *See* Ex. 1001 at 2:63-66. Also around that time, Congress passed the Communications Decency Act (CDA) to prohibit dissemination of indecent material over the Internet. *Id.* at 1:12-20. Many viewed the CDA as censorship and believed that parents should be responsible for controlling their children’s activities on the Internet. *Id.* at 1:20-24. To address the problem of the accessibility of indecent material over the Internet, the inventors developed a system and method that allowed users, such as parents, to filter transmissions of such objectionable material. *Id.* at 1:27-29.

The patented system and method includes a database of filtering information that is used to determine whether to allow or block a data transmission. The database includes two types of filters: filters specifying immediate action (also referred to as direct action) and filters specifying deferred action. *Id.* at 4:12-15, 11:36-37. As the names indicate, immediate-action filters direct the system to immediately carry out an action of allowing or blocking the transmission. *Id.* at 4:15-20. In contrast, the deferred-action filters specify a deferred (as opposed to

immediate) filtering action and determine whether to allow or block the transmission based on conditions, such as an expected filter pattern (typically a string of characters) in the transmission. *Id.* at 6:19-42; Fig. 3, steps 104 and 116. By comparing information in a message to the immediate-action and/or deferred-action filters, the system determines whether to allow or block the transmission. *Id.* at 1:33-35.

Apple's petition for *inter partes* review of the '033 patent proposes anticipation and obviousness grounds based on combinations of four different primary references. In each one, however, Apple ignores the temporal distinction between immediate-action filters and deferred-action filters required by the plain language of the claims. It does so by proposing implausible claim constructions that replace this temporal limitation with an unrelated and unsupported limitation. This flaw infects each of the proposed grounds, so none should be instituted.

Moreover, at least three of the proposed grounds should not be instituted for additional reasons specific to each ground. For example, the petition fails to establish that Baker '645 is prior art to the '033 patent, and a more careful analysis demonstrates that Baker '645 is not prior art. The petition also fails to apply its own proposed construction of the deferred-action filters claim element to another reference, Baker '898. Similarly, the petition fails to show how a third reference, Schloss, discloses the claimed "message" recited in all independent claims, and

Apple's expert declaration actually demonstrates that Schloss does not disclose this element.

Finally, to the extent the Board decides to institute review of the '033 patent, Apple's multiple redundant proposed grounds should be pared down considerably. Apple does not offer any meaningful distinction among the various proposed grounds or explain the relative merits and downfalls of each, instead taking a scattershot approach that the Board has held is "contrary to the regulatory and statutory mandates." *Liberty Mutual Ins. Co. v. Progressive Cas. Ins. Co.*, No. CBM2012-00003, Paper No. 7, Order (Redundant Grounds) at 2 (PTAB Oct. 25, 2012). In fact, Apple touts the similarities among the four references and applies them to the claims in a nearly indistinguishable manner. In prior similar cases, the Board has instituted on one ground for each claim and denied the others. *See, e.g., Conopco, Inc. v. Proctor & Gamble Co.*, No. IPR2013-00505, Paper No. 9, Institution Decision, at 17-18 (PTAB Feb. 12, 2014) (instituting on a single ground and denying multiple other grounds as redundant); *Riverbed Tech., Inc. v. Parallel Networks, LLC*, No. IPR2014-01398, Paper No. 11, Institution Decision, at 16-17 (PTAB Feb. 27, 2015) (instituting on a single ground for each claim and denying a second ground as redundant); *see also ScentAir Techs., Inc. v. Prolitec, Inc.*, No. IPR2013-00179, Paper No. 18, Decision on Request for Rehearing, at 3-4 (PTAB Aug. 23, 2013); *id.*, Paper No. 13, Institution Decision, at 17 (PTAB Aug. 6, 2013)

(instituting on two grounds where the petition explained how the two grounds were different from each other, but declining to institute on all other grounds as being redundant). The petition should not be instituted at all, but if the Board decides to institute review of the '033 patent, it should do the same here and institute on only one ground.

## **II. The Petition Should Not Be Instituted Because Every Proposed Ground Ignores Entire Claim Elements Under the Guise of Implausible Claim Constructions**

Apple's petition proposes constructions of two claim elements—"filters specifying immediate action" and "filters specifying deferred action"—which completely eviscerate limitations imposed by the elements' plain language. It then hinges every proposed invalidity ground on these constructions, again ignoring the plain-language limitations. Proposing implausible constructions which eviscerate the plain language of the claims is tantamount to ignoring the claim elements altogether. The petition therefore should not be instituted because every proposed ground fails to "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); *see also* 35 U.S.C. § 312 (petition for *inter partes* review "may be considered only if . . . the petition identifies, in writing and with particularity, . . . the evidence that supports the grounds for the challenge to each claim.").



Each challenged claim requires maintaining a database including a table of two different types of filters: “(1) filters specifying *immediate* action; and (2) filters specifying *deferred* action.” Ex. 1001 claim 1 (emphases added); *see also id.* claims 15, 23. The plain language thus distinguishes between the two types of filters on a temporal basis, and any construction of these terms must account for the temporal limitation required by the plain language of the claims. *White v. Dunbar*, 119 U.S. 47, 52 (1886) (“[I]t is . . . an evasion of the law, to construe [a claim] in a manner different from the plain import of its terms.”); *Ethicon Endo-Surgery, Inc. v. United States Surgical Corp.*, 93 F.3d 1572, 1579 (Fed. Cir. 1996) (rejecting proposed construction because “the plain meaning of the claim [would] not bear [such] a reading.”). The specification likewise supports the temporal distinction between the two filters imposed by the claims. For example, it explains that immediate- or direct-action filters immediately determine whether to allow or block a transmission:

Direct actions indicate that the system should unconditionally allow or unconditionally block the transmission. When filter entries are retrieved, they are first scanned for entries that require direct action; if there are any, *these actions are carried out immediately*. . . . The retrieved filters are checked to determine if any require immediate action, i.e., if unconditional allowing or blocking is required.”

*Id.* at 4:15-20, 48-50 (emphasis added). In contrast, deferred-action filters defer allowing or blocking a transmission based on conditions. “The system can defer the decision whether to allow or block, and then monitor transmissions to search for a particular command and a particular filter pattern.” *Id.* at 1:45-47; *see also id.* at 5:8-29, 6:10-42, Fig. 4 (explaining that “deferred filters” have additional fields, so that a transmission can be conditionally allowed or blocked based on one or more conditions, such as when a particular pattern or string is detected). Thus, the plain language of the claims requires, and the specification supports, differentiating between filters that allow or block a transmission immediately via direct action and filters that defer allowing or blocking a transmission based on conditions.

Apple ignores this temporal limitation, and—under the guise of claim construction—replaces it with an unrelated limitation divorced from the claim language. Advancing a theory already rejected by the district court, Apple argues that “filters specifying immediate action” should be construed as filters that allow or block transmission “based on a port number or network address,” and “filters that specify deferred action” should be construed as filters that allow or block transmission “based on information in the message other than a port number or network address.” Pet. at 15-18. Apple thus inexplicably defines the word “immediate” as requiring a “port number or network address” and defines the word

“deferred,” as requiring “anything else.” Apple unreasonably removes the claims’ plain-language requirement—which defines *when or how* filtering occurs—and replaces it with an unrelated requirement of *what* the filters compare.

Apple argues that the preferred embodiment in the ’033 patent supports its proposed network address/port number distinction. Pet. at 15-16, 18-19. But even if Apple were correct—that the specification somehow requires immediate-action filters to compare a network address or port number—an additional content-based limitation allegedly imposed by the specification would not permit removing the temporal limitation imposed by the claim language. *See Telemac Cellular Corp. v. Topp Telecom, Inc.*, 247 F.3d 1316, 1324 (Fed. Cir. 2001) (“[A] construction that flies in the face of the express language of the claim is not preferred. Unless something in the written description suggests that the patentee intended the unambiguous language to be construed in a manner inconsistent with its ordinary meaning, we are bound by that language.”) (internal citations omitted). A simple example demonstrates the fault in Apple’s position. Consider a patent that claims a bicycle “comprising steel handle bars,” and discloses only embodiments where the handle bars are painted black. No one would argue that the proper construction of “steel handle bars” is “painted black handle bars” because of the disclosed embodiments. And even if the painted-black limitation were properly incorporated into the claim, it would not justify the removal of the “steel” limitation imposed by

the claim's plain language. Yet this is precisely what Apple attempts to do, ignoring the plain-language temporal limitation and adding an unrelated content-based limitation under the guise of claim construction. The effect is that Apple's subsequent invalidity analysis effectively ignores the two filter elements in the claims because it ignores the recited distinction between them, rendering all of the proposed grounds unconstitutionally.

Apple also argues that dependent claim 3, which further requires that filters specifying immediate action include fields for a port and IP address, supports its position. Pet. 16-17. Not so. In fact, claim 3 demonstrates that when the '033 patent inventors wanted to restrict immediate-action filters to *what* the filters compare (i.e., port numbers and IP addresses in claim 3) they knew precisely how to do so. But they did not so limit the independent claims. Instead, the independent claims temporally differentiate between two types of filters—immediate-action and deferred-action. Claim 3 shows that the content-based limitation of what the filters compare is different from, and additional to, the temporal limitation expressly required by the independent claims.

Indeed, when construing these two terms, the United States District Court for the Northern District of California held that a temporal distinction between the two filters was required “[b]ased on the ordinary meaning of the claim language.” Ex. 2001, Claim Construction Order at 4, *OpenTV, Inc. v. Apple, Inc.*, No. 14-cv-

01622-HSG (N.D. Cal. June 5, 2015), ECF No. 173. It also noted that Apple’s content-based description was not supported by the specification and was “not consistent with the other ’033 Patent claims.” *Id.* at 5, 7.

Apple’s entire invalidity analysis hinges on its unreasonable construction that ignores the temporal limitations expressly required by the plain claim language. Apple does not explain how any reference allegedly teaches both (1) filters specifying *immediate* action and (2) filters specifying *deferred* action, as claimed. It omits this temporal distinction from its analysis, focusing instead on how the references allegedly disclose filtering based on the unrelated—and unsupported—network address/port number distinction. Proposing an implausible construction that eviscerates plain-language limitations and then explaining how the claims are unpatentable under that construction is tantamount to ignoring those claim elements entirely.

Apple bears the burden of proving where each element of the claim is found in the prior art. 37 C.F.R. § 42.104(b)(4). The petition falls short of this burden because every proposed ground ignores an expressly recited claim element—the temporal distinction between immediate-action and deferred-action filters. For this reason, Apple’s petition should not be instituted.

**III. Additional Fatal Flaws Confirm that the Baker '645, Baker '898, and Schloss Grounds Should Not Be Instituted**

**A. The Baker '645 ground should not be instituted because Baker '645 is not prior art**

Baker '645 was filed after the application for the '033 patent, so it only qualifies as prior art against the '033 patent to the extent that the Baker provisional application provides written description support for the subject matter relied on in the petition. *In re Giacomini*, 612 F.3d 1380, 1383 (Fed. Cir. 2010); *VMware, Inc. v. Clouding Corp.*, No. IPR2014-01304, Paper No. 14, Decision Institution of *Inter Partes* Review, at 18 (PTAB Feb. 5, 2015) (“[A] prior art patent has a patent-defeating effect as of the filing date of the earlier-filed U.S. provisional . . . application, if the earlier-filed application has adequate written description support for the subject matter relied upon as prior art.”).

The Baker '645 ground (Ground A) should not be instituted because the Petition does not identify the specific portions of the Baker provisional that support the subject matter relied on in Baker '645, as required by the Rules and as required for Apple to meet its burden of establishing Baker '645 as prior art. The Baker '645 ground also should not be instituted because the Baker provisional does not, in fact, provide written description support for the relied-on subject matter in Baker '645, and thus Baker '645 does not qualify as prior art.

**1. The petition fails to identify where and how the Baker provisional supports the relied-on subject matter in Baker '645**

The petition must “specify where each element of the claim is found in the prior art patents or printed publications relied upon” and “identify[] specific portions of the evidence that support the challenge.” 37 C.F.R. §§ 42.104(b)(4), (5); *see also* 35 U.S.C. § 312(a)(1)(3). “When the qualification of a reference as prior art depends on the existence of adequate support in [the provisional application], this mandate requires that Petitioner explain where such support for its challenge can be found.” *Securus Techs., Inc. v. Global Tel\*Link Corp.*, No. IPR2015-00153, Paper No. 12, Decision Denying Institution of *Inter Partes* Review, at 8 (PTAB May 1, 2015).

The petition falls short of this burden because it never explains where or how the Baker provisional supports the relied-on portions of Baker '645. Instead, the petition quotes portions of Baker '645 that allegedly disclose each claim element, and then includes a “*see also*” citation to one or two pages of the Baker provisional without further explanation. *See* Pet. at 28-31. The petition does not explain how the cited Baker provisional pages support the subject matter quoted from Baker '645. *See id.*

The petition’s shortcomings are exacerbated by the fact that Baker '645 bears little resemblance to the Baker provisional, because it includes paragraphs,

claims, and a figure not present in the Baker provisional. In fact, the entire Baker '645 disclosure that Apple cites as allegedly disclosing each of claim elements 1(b), 1(b)(1), 1(b)(2), 1(c), and 1(d) (i.e., every claim element except for the preamble and claim element 1(a)) appears for the first time in Baker '645 and is not included in the Baker provisional. *Id.* at 28-29 (citing Ex. 1002 at 4:11-27 and claims 6-7 for these features—the paragraph and claims are not present in Ex. 1004). Apple offers no explanation for why or how this paragraph and these claims are supported by other portions of the Baker provisional.

Because Apple's petition does not explain how the Baker provisional application supports the relied-on portions of Baker '645, it has failed to demonstrate that Baker '645 qualifies as prior art under § 102(e), and it has failed to specify where each element of the claim is found in the prior art. The Baker '645 ground should therefore not be instituted.

**2. Baker '645 is not prior art because the Baker provisional does not support the relied-on portions of Baker '645**

The petition's failure to show required support in the Baker provisional is a symptom of a more fundamental flaw: the relied-on subject matter in Baker '645 is not, in fact, supported by the Baker provisional. Thus, Baker '645 is not prior art.

The petition alleges that Baker '645 discloses both “filters specifying immediate action” and “filters specifying deferred action.” Pet. at 21-29. It asserts that Baker '645 discloses “filters specifying immediate action” by comparing a



requested URL to a list of URLs that each user terminal has permission to access, *id.* at 23, 28, and discloses “filters specifying deferred action” by permitting or denying access based on “a list of ratings corresponding to the URLs” or based on “keywords” in resources, *id.* at 24-26, 28-29.

The Baker provisional, however, does not disclose the alleged filters specifying immediate action because it does not disclose a list of URLs that each user terminal has permission to access, let alone comparing a requested URL to such a list to determine whether to allow or block access to a resource. In fact, the entire disclosure in Baker ’645 that the petition relies on as allegedly teaching the immediate-action filters was added for the first time in Baker ’645—after the ’033 patent was filed—and does not exist in the provisional. *Compare* Ex. 1002 4:11-21 (paragraph relied on) *with* Ex. 1004 (Baker provisional lacks that paragraph).

While the Baker provisional need not be verbatim, it must provide written description support for the subject matter relied on in the petition in order for Baker ’645 to qualify as prior art. *In re Giacomini*, 612 F.3d 1380, 1383 (Fed. Cir. 2010); *VMware, Inc. v. Clouding Corp.*, No. IPR2014-01304, Paper No. 14, Decision Institution of *Inter Partes* Review, at 18 (PTAB Feb. 5, 2015). Here, the Baker provisional provides no support at all for the alleged filters specifying immediate action. Apple’s expert, Dr. Knutson, argues that one sentence in the Baker provisional provides the required support: “‘look[ing] up any or all of these

URLs in the database to determine whether to provide the final resource to the client.” Ex. 1010 ¶ 51 (quoting Ex. 1004 at 3). Dr. Knutson is wrong, and takes this quotation out of context. When read in context, this sentence discloses checking a URL against the *ratings* database (i.e., the alleged filter specifying *deferred* action and not the alleged filter specifying *immediate* action):

In particular, if the response is a redirection, the filter may choose to forward the redirection to the client, since it contains no forbidden material. The client can be expected to request the URL and in the course of processing the new request the new URL will be checked against *the ratings database*. Alternatively, upon receiving a redirection response, the filter may send a request for the redirected URL itself, and if necessary, make subsequent redirection requests as well, and look up any or all of these URLs in *the database* to determine whether to provide the final resource to the client.

Ex. 1004 at 3 (emphases added). Full context makes clear that “the database” in Dr. Knutson’s quoted excerpt refers to “the ratings database” discussed in the previous sentence, i.e., the alleged deferred-action filter. The Baker provisional does not disclose the list disclosed in Baker ’645 that Apple alleges is the immediate-action filter, a list of URLs that can or cannot be accessed by a particular user computer. Thus, Baker ’645 cannot be used as prior art against the

'033 patent because the Baker provisional does not provide written description support for the subject matter relied on by the petition. *In re Giacomini*, 612 F.3d 1380, 1383 (Fed. Cir. 2010); *VMware, Inc. v. Clouding Corp.*, No. IPR2014-01304, Paper No. 14, Decision Institution of *Inter Partes* Review, at 18 (PTAB Feb. 5, 2015). The Baker '645 ground therefore should not be instituted.

**B. The Baker '898 ground should not be instituted because Apple has failed to explain how the claims are unpatentable, even under its own construction**

The Baker '898 ground (Ground B) should not be instituted because the petition does not explain “[h]ow the construed claim is unpatentable” in view of Baker '898. 37 C.F.R. § 42.104(b)(4). Apple’s petition must explain “why the claims *as construed* are unpatentable under the identified grounds.” Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents, 77 Fed. Reg. 48680, 48688 (Aug. 14, 2012) (emphasis added). Apple’s Baker '898 ground ignores even its own proposed claim construction and therefore should not be instituted.

Apple construes “filters specifying immediate action” as “filters specifying whether transmission of the message should be allowed or blocked based on a port number or network address specified in the message.” Pet. at 15. Apple asserts that a URL is encompassed within the term “network address,” *id.* at 16, and that Baker '898 discloses “filters specifying immediate action” because Baker '898

discloses a list of URLs that a user can or cannot access, *id.* at 34, 36 (citing Ex. 1003 at 4:11-34).

Apple, however, fails to apply its own construction with regard to “filters specifying deferred action,” which it construes as “filters specifying whether transmission of the message should be allowed or blocked based on *information in the message other than a port number or network address.*” Pet. at 18 (emphasis added). Apple contends that Baker ’898 discloses this element “by configuring filters to match regular expressions within the messages.” *Id.* at 34-35, 36-37 (citing Ex. 1003 at 5:26-47). But matching regular expressions “within the messages” does not address Apple’s proposed construction of filtering “based on information in the message *other than the port number or network address,*” and Apple offers no further explanation. Moreover, in the portion of Baker ’898 that Apple cites, the information “within the message” being matched to the regular expression is the URL—i.e., the alleged network address—in direct contradiction to Apple’s proposed construction. *See* Ex. 1003 5:26-47 (“More generally, the URL [http://ourschool.edu/history/\\*](http://ourschool.edu/history/*) is a regular expression that specifies all resources within the directory . . . .”). In other words, the only part of the “message” for which Baker ’898 discloses regular expression matching is the alleged network address, the URL. Dr. Knutson’s declaration admits as much because he explains that the alleged filters “match particular patterns or keywords

*in a URL request,”* Ex. 1010 ¶ 73 (emphasis added), and “search for particular keywords or patterns, *in resource names* [i.e., in URLs],” *id.* ¶ 80 (emphasis added). Thus, the second alleged filter that Apple points to in Baker ’898 also filters based on what Apple identifies as the network address, despite Apple’s proposed construction of filtering “based on information in the message *other than the port number or network address.*”

Finally, both the petition and Dr. Knutson cite a portion of Baker ’898’s “Background of the Invention” describing—and recognizing the fallbacks of—a prior art filtering method that checks Internet “resource[s] for a list of disallowed words.” Pet. at 36 (citing Ex. 1003 2:34-38); Ex. 1010 ¶ 81 (citing Ex. 1003 2:33-37). Neither the petition nor Dr. Knutson explains how this disclosure meets Apple’s proposed construction for filters specifying deferred action. Moreover, Apple cannot properly rely on this disparate portion of Baker ’898 to support a proposed anticipation ground because Baker ’898’s description of the prior art is separate from the embodiments cited elsewhere by Apple and, even if relied on, it does not disclose “all of the limitations arranged or combined in the same way as recited in the claim.” *Net MoneyIN, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008).

Because Apple has not explained how Baker ’898 discloses filtering based on information in the message other than a port number or network address, it has

failed to explain how the claims are unpatentable even under its own construction.

The Baker '898 ground therefore should not be instituted.

**C. The Schloss ground should not be instituted because the petition fails to explain how Schloss discloses “the message” recited throughout the claims**

Claim 1 requires “(a) opening a data stream to send *a message* through an interface to an Internet server,” “(c) comparing information in *the message* to filtering information” and “(d) determining whether to prevent or allow the outgoing transmission of *the message* based on the comparison.” Antecedent basis requires “the message” in step (d) to be the same message as in steps (a) and (c). *See, e.g., Bicon, Inc. v. Straumann Co.*, 441 F.3d 945, 954 (Fed. Cir. 2006); *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1356-57 (Fed. Cir. 1999). The Schloss ground (Ground E) should not be instituted because the Petition does not “identify [the] specific portion[]” of Schloss that corresponds to the claimed message. 37 C.F.R. §§ 42.104(b)(4), (5). Instead, it quotes different portions of Schloss without identifying what element in the quoted portions corresponds to the message recited in claim elements (a), (c), and (d). Moreover, while Dr. Knutson attempts to identify the claimed message in Schloss, his analysis is flawed and demonstrates that Schloss does not disclose the claimed message.

## 1. Overview of Schloss

Schloss discloses a process that includes the following steps performed at a client computer in the following order:

(1) **Send a content request to a content server.** Ex. 1006 at 2:45-47, 5:27-29, Fig. 3A (step 205).

(2) **Receive, but do not load (i.e., display), the requested content data.** *Id.* at 2:47-50, 5:29-33, Fig. 3A (step 210); *see also id.* Abstract (“each time data (e.g., a web page) is downloaded from a content server to the client . . .”).

(3) **Send an “advisory request” that includes portions of the content request to an “advisory server.”** *Id.* at 2:51-56, 5:33-36, Fig. 3A (step 220).

(4) **Receive a “classification rating” (also referred to as “characterization data”) from the advisory server.** *Id.* at 2:62-64, 5:57-59, Fig. 3B (step 250).

(5) **Display or do not display the requested content based on the classification rating.** *Id.* at 2:65-67, 5:59-6:1, Fig. 3B (step 255); *see also id.* Abstract (“The client thereafter displays or does not display the web page according to the classification rating.”).

Thus, in Schloss the client first sends the “content request” to the content server and then receives the requested “content data” from the content server. After this exchange of content request and content data, the client sends a second

“advisory request” to a different server. In response to the advisory request, the client receives “characterization data,” which the client uses to determine whether to display the content data it has already received. *See* Ex. 1006 at Figs. 3A, 3B (reproduced in part below with annotations showing the steps discussed above).

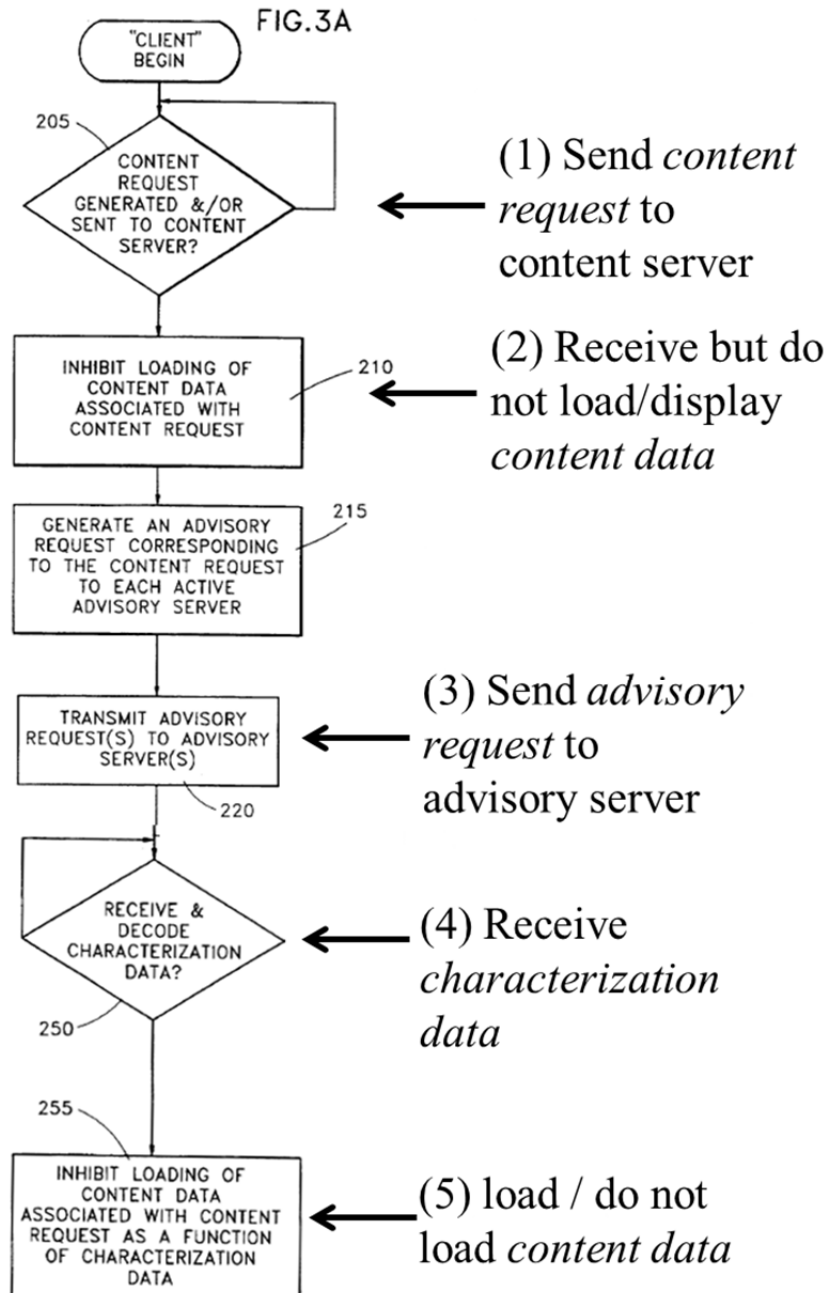


FIG. 3B



**2. The Petition does not identify what in Schloss allegedly discloses the claimed “message”**

The petition does not identify what element in Schloss discloses “the message” recited in steps (a), (b), and (d) of claim 1. The petition’s overview of Schloss does not state what in Schloss corresponds to the claimed message. *See* Pet. at 53-56. It quotes from portions of Schloss that disclose the content request, the content data, the advisory request, and the characterization data, but does not identify which, if any, of these correspond to the claimed “message.” *Id.* The claim chart in the petition is similarly flawed. It quotes portions of Schloss without explaining how the quoted portions map to the claims and, again, without identifying which element in Schloss corresponds to the claimed “message.” *Id.* at 56-58. The Schloss ground therefore should not be instituted for failing to “identify [the] specific portion[]” of Schloss that corresponds to the claimed message. 37 C.F.R. §§ 42.104(b)(4), (5).

**3. Moreover, Schloss does not disclose the claimed “message”**

Dr. Knutson’s declaration—while it cannot cure the deficiencies of the petition, which alone must comply with the Rules, 37 C.F.R. § 42.104 (“Content of petition”)—explains Apple’s position in more detail. Dr. Knutson interprets Schloss’s content request sent from the client to the content server as “the message” recited in the claim. Regarding the “message” in step (a), Dr. Knutson states that “Schloss ’507 discloses this limitation . . . because it discloses

*requesting web content* over TCP/IP sockets.” Ex. 1010 ¶ 126 (emphasis added). He draws the same connection between the content request and “the message” recited in step (c): “Schloss ’507 discloses that the *URL in the message requesting content* is compared with characterization information.” *Id.* ¶ 132 (emphasis added). And finally, with regard to step (d), which requires determining whether to prevent or allow transmission of the message, Dr. Knutson again equates “the message” with Schloss’s content request: “based on the comparison of the *requested URL* to URLs in the filter list . . . , the system can prevent or allow the *transmission requesting that resource.*” *Id.* ¶ 133 (emphases added).

Dr. Knutson’s position is flawed, however, because Schloss never determines whether to prevent or allow outgoing transmission of the content request. As discussed above, the client sends the content request to the content server independently of any filtering determination. Instead, Schloss discloses a system where the reply to that content request—the *content data*—is loaded or not loaded based on the characterization data. But the *content request* is always sent. As discussed above, the sending of the content request in Schloss is the first step in the whole process. Thus, contrary to Dr. Knutson’s contention, the content request cannot possibly satisfy the requirements of claim 1 because Schloss makes no determination to allow or prevent transmission of it, as required by step (d).

Dr. Knutson's reliance on the "content request" is directly contradicted by the portions of Schloss that he cites. In analyzing step (d), Dr. Knutson first cites the following two portions of Schloss:

(1) "The advisory server rates the page and sends a classification rating back to the client. The client thereafter *displays or does not display the webpage* according to the classification rating based on the client's selected preferences." Ex. 1010 ¶ 133 (quoting Ex. 1006 Abstract) (emphasis added).

(2) "[T]he client may *inhibit loading of or load the content data* associated the contour [sic] request as a function of the received characterization data." Ex. 1010 ¶ 133 (quoting Ex. 1006 at 5:60-63) (emphasis added).

In both quoted portions, Schloss discloses displaying or not displaying the *content data* that has already been received in response to the previously-transmitted *content request*. Yet, in the next sentence, Dr. Knutson concludes, "In other words, based on the comparison of the requested URL to URLs in the filter list . . . , the system can *prevent or allow the transmission requesting that resource*, based on the selected preferences of the client." Ex. 1010 ¶ 133 (emphasis added). Not so. Schloss discloses preventing or allowing display of the content data, not the transmission of the content request. Thus, even if Apple's faulty petition is interpreted in light of Dr. Knutson's declaration, the Schloss ground should not be

instituted because Dr. Knutson's analysis is flawed and because Schloss does not disclose the claimed message.

#### **4. Claims 15 and 23**

Apple does not offer any additional substantive analysis for how Schloss allegedly discloses "the message" recited in independent claims 15 and 23 beyond that already discussed with regard to claim 1. Independent claim 15 recites "filtering messages transmitted over the Internet," "comparing information in the message to filtering information," and "determining whether to prevent or allow transmission of the message in response to the comparison." Independent claim 23 recites "opening a data stream to receive a message," "comparing information in the message to filtering information," and "determining whether to prevent or allow the incoming transmission of the message based on the comparison." Thus for similar reasons discussed above with regard to claim 1, the Petition is also deficient with regard to claims 15 and 23.

There is no single element in Schloss that discloses "the message" recited in the claims, as required to support Apple's proposed ground. Instead of tackling this deficiency head on, Apple skirts the issue in the petition and relies on its expert's flawed analysis. The Schloss ground should not be instituted.

#### **IV. The Proposed Grounds Are Redundant**

Apple asserts at least four alternative grounds of invalidity for each challenged claim but does not distinguish between any of them. “[M]ultiple grounds, which are presented in a redundant manner by a petitioner who makes no meaningful distinction between them, are contrary to the regulatory and statutory mandates, and therefore are not all entitled to consideration.” *Liberty Mutual Ins. Co. v. Progressive Cas. Ins. Co.*, No. CBM2012-00003, Paper No. 7, Order (Redundant Grounds), at 2 (PTAB Oct. 25, 2012). If the Board institutes review, it should institute at most one of the proposed grounds because each is redundant of the others.

##### **A. The Baker ’645 (ground A), Baker ’898 (ground B), Pitcher (grounds C & D), and Schloss (ground E) grounds are horizontally redundant**

Prior art grounds are horizontally redundant when they apply similar references, not in combination to complement each other, but as distinct and separate alternatives. *Liberty Mutual Ins. Co. v. Progressive Cas. Ins. Co.*, No. CBM2012-00003, Paper No. 7, Order (Redundant Grounds), at 3 (PTAB Oct. 25, 2012). The Board has consistently declined to consider horizontally redundant prior art, particularly when the petitioner offers no meaningful distinction between the different prior art references. *See, e.g., Riverbed Tech., Inc. v. Parallel Networks, LLC*, No. IPR2014-01398, Paper No. 11, Institution Decision, at 16-17

(PTAB Feb. 27, 2015) (declining to institute on a particular ground when it was “provided without explanation as to why it is better than or different from the [other] asserted grounds”); *Conopco, Inc. v. Proctor & Gamble Co.*, No. IPR2013-00505, Paper No. 9, Institution Decision, at 17 (PTAB Feb. 12, 2014) (“Petitioner identifies no relative strengths or weaknesses in the prior art disclosure as they relate to the limitations of those claims.”); *Berk-Tek LLC v. Belden Techs. Inc.*, No. IPR2013-00057, Paper No. 21, Decision on Request for Rehearing, at 5 (PTAB May 14, 2013) (“[A]llowing multiple grounds without meaningful distinction by the petitioner is contrary to the legislative intent.”); *see also Google Inc. v. Intellectual Ventures II LLC*, No. IPR2014-00787, Paper No. 9, Institution Decision, at 21 (PTAB Nov. 24, 2014); *ScentAir Techs., Inc. v. Prolitec, Inc.*, No. IPR2013-00179, Paper No. 18, Decision on Request for Rehearing, at 3-4 (PTAB Aug. 23, 2013); *Liberty Mutual Ins. Co. v. Progressive Cas. Ins. Co.*, No. CBM2012-00003, Paper No. 7, Order (Redundant Grounds), at 6-11 (PTAB Oct. 25, 2012) (all providing similar reasoning).

In many of these cases, the Board has instituted review with regard to only one of the asserted grounds for each claim and denied all other redundant grounds. *Conopco, Inc. v. Proctor & Gamble Co.*, No. IPR2013-00505, Paper No. 9, Institution Decision, at 17-18 (PTAB Feb. 12, 2014) (instituting on a single ground and denying multiple other grounds as redundant); *Riverbed Tech., Inc. v. Parallel*

*Networks, LLC*, No. IPR2014-01398, Paper No. 11, Institution Decision, at 16-17 (PTAB Feb. 27, 2015) (instituting on a single ground for each claim and denying a second ground as redundant); *see also ScentAir Techs., Inc. v. Prolitec, Inc.*, No. IPR2013-00179, Paper No. 18, Decision on Request for Rehearing, at 3-4 (PTAB Aug. 23, 2013); *id.*, Paper No. 13, Institution Decision, at 17 (PTAB Aug. 6, 2013) (instituting on two grounds where the petition explained how the two grounds were different from each other, but declining to institute on all other grounds as being redundant).

Apple's petition does not distinguish between the four references and thus suffers from the same deficiency as the petitions in the cases cited above. Apple's petition summarily states that the grounds are "non-cumulative," Pet. at 1, 60, but never explains why. Instead, Apple touts the similarities between the references. For example, Apple asserts that Baker '645 and Baker '898 "share an inventor," "are directed to the identical problem," and that "Baker '645 even directs the reader to consider the specific embodiment disclosed in Baker '898." Pet. at 39-40. Apple's expert similarly touts the similarities between Baker '645 and the third reference, Pitcher, asserting that they "are directed to solving the same problem." Ex. 1010 ¶ 119.

Apple's application of the references to the '033 patent claims further demonstrates that the grounds are redundant. Not only does Apple omit any

“explanation as to why [one asserted ground] is better than or different from the [other] asserted grounds,” *Riverbed Tech., Inc. v. Parallel Networks, LLC*, No. IPR2014-01398, Paper No. 11, Institution Decision, at 16-17 (PTAB Feb. 27, 2015), it uses nearly identical reasoning for each reference. Using claim 1 as an example, Apple asserts that each reference, Baker ’645, Baker ’898, Pitcher, and Schloss, discloses claim element 1(a) for the same reason—that it is “inherently disclosed by any reference that contemplates sending and receiving TCP/IP messages.” Pet. at 27-28; *see also id.* at 36, 47, 56. In fact, Apple’s expert relies on his discussion of Baker ’645 when mapping each subsequent reference to this limitation. Ex. 1010 ¶¶ 76, 98, 126 (“As I explained in my discussion of the Baker ’645 reference . . .”).

The redundancy continues with claim element 1(b)—the limitation on which Apple’s petition focuses the vast majority of its analysis—and its recitation of “filters specifying immediate action” and “filters specifying deferred action.” For example, Apple points to similar alleged network address comparisons in each reference as disclosing immediate-action filters:

**Baker ’645:** “When a client sends an HTTP request for a specific URL, that *URL is compared to the list of URLs in the filter database* to determine whether the request will be sent . . . this is an ‘immediate action’ filter.” Pet. at 23 (emphasis added).



**Baker '898:** “Requests may be immediately and unconditionally allowed if they are directed to a *URL matching an allow filter.*” *Id.* at 33 (emphasis added).

**Pitcher:** “FLTR\_002 is a ‘immediate action’ filter . . . because it blocks or allows messages directed to a *particular network address, in this case a hardware MAC address.*” *Id.* at 46 (emphasis added).

**Schloss:** “An ‘*AdviseOnURL*’ filter simply blocks or allows access to [a particular page of content] and operates as an ‘immediate filter’ to control access based on the *network address.*” *Id.* at 54 (emphases added).

To the extent there are differences between the URLs relied on in Baker '645, Baker '898 and Schloss and the MAC addresses relied on in Pitcher, Apple's application of the references to the claims treats them as one, under the umbrella of what it terms a “network address.” *See, e.g., id.* at 17.

Apple's discussion of the alleged deferred-action filters in the references is similarly redundant. The petition points to substantively indistinguishable disclosures of keyword or pattern matching:

**Baker '645:** “Baker '645 can alternatively examine additional data, such as a content rating, and allow or deny access based on *matching that additional data,* thus implementing a ‘deferred action’ filter.” *Id.* at 24 (emphasis added). “Baker '645 discloses an alternative to content ratings that filters may be configured to

*match keywords in the message*; this is another method of performing ‘deferred’ filtering.” *Id.* at 26 (emphasis added).

**Baker ’898:** “Baker ’898 discloses that deferred filtering can be achieved by configuring filters to *match regular expressions within the messages*.” *Id.* at 34 (emphasis added).

**Pitcher:** “The system of Pitcher ’554 adds the additional capability of blocking or allowing messages based on *matching a pattern* other than a port or address within the message contents.” *Id.* at 44 (emphasis added). “The filter table also specifies ‘deferred’ filters, such as FLTR\_001, which . . . decide whether to block (drop) it or allow it to continue to its intended destination based on *matching keywords or patterns* in content.” *Id.* at 46 (emphasis added).

**Schloss:** “An ‘AdviseOnURLIncludingLinks’ filter *examines the content returned* by the original URL.” *Id.* at 54 (emphasis added).

“‘AdviseOnURLIncludingLinks’ filters search for and *match data in the content returned by the server* (such as embedded hypertext anchors).” Ex. 1010 ¶ 130 (emphasis added).

Apple’s failure to explain how the four asserted references differ in their application to the challenged claims is alone enough for the Board to conclude that the grounds are redundant. “To avoid a determination that a requested ground of review is redundant of another requested ground, a petitioner must articulate a

meaningful distinction in terms of relative strengths and weaknesses with respect to application of the prior art reference disclosures to one or more claim limitations.” *ScentAir Techs., Inc. v. Prolitec, Inc.*, No. IPR2013-00179, Paper No. 18, Decision on Request for Rehearing, at 3 (PTAB Aug. 23, 2013). Moreover, Apple’s parallel analysis for each reference supports paring down Apple’s scattershot attack to a single primary reference.

**B. Grounds B and D each include vertically redundant combinations**

Prior art grounds are vertically redundant when an additional prior art reference is asserted to support a second ground of unpatentability and the first ground already has been asserted against the same claim without the additional reference. *Liberty Mutual Ins. Co. v. Progressive Cas. Ins. Co.*, No. CBM2012-00003, Paper No. 7, Order (Redundant Grounds), at 12 (PTAB Oct. 25, 2012). In the case of vertical redundancy, “[o]nly if the Petitioner reasonably articulates why each ground has strength and weakness relative to the other should both grounds be asserted for consideration.” *Id.*

In ground B, Apple asserts that claims 9 and 23 are obvious in view of Baker ’898 alone or, alternatively, in view of the combination of Baker ’898 and Baker ’645. Pet. at 38-43. It similarly asserts in ground D that claim 9 is obvious in view of Pitcher alone or in view of Pitcher in combination with Baker ’645. *Id.* at 51-53. This is impermissible because in each ground Apple adds Baker ’645 after

asserting that the base reference renders obvious all elements of the claim, and does not explain the relative strengths and weaknesses between the single-reference position and the combination.

## V. Conclusion

For the foregoing reasons, OpenTV respectfully requests that the Board deny Apple's petition for *inter partes* review. To the extent the Board institutes review, OpenTV requests that it do so only under one of Apple's redundant proposed grounds.<sup>1</sup>

The undersigned welcomes a telephone call should the Office have any requests or questions. If there are any fees due in connection with the filing of this paper, please charge the required fees to our deposit account no. 06-0916.

Respectfully submitted,

Dated: July 1, 2015

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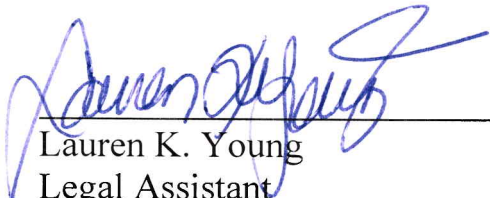
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<sup>1</sup> If trial is instituted, OpenTV reserves its rights to provide claim constructions and raise additional arguments as to why Apple has failed to carry its burden and why the claims should be confirmed.

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that copies of the foregoing Patent Owner's Preliminary Response to Petition for *Inter Partes* Review of U.S. Patent No. 5,884,033 and Exhibit 2001 were served on July 1, 2015 via FedEx and e-mail directed to counsel of record for the Petitioner at the following:

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