

Paper No. \_\_\_\_\_  
Filed: July 8, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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NETFLIX, INC.  
Petitioner

v.

OPENTV, INC.  
Patent Owner

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Case IPR2014-00252  
Patent 8,107,786

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**Patent Owner OpenTV, Inc.'s  
Request for Rehearing Under 37 C.F.R. § 42.71(c)**

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## I. Introduction and Statement of Relief Requested

Pursuant to 37 C.F.R. §§ 42.71(c)-(d), Patent Owner, OpenTV, Inc., requests rehearing of the Decision instituting *Inter Partes* Review of U.S. Patent No. 8,107,786 (Paper 13, the “Institution Decision”). The Institution Decision ordered review on two grounds of unpatentability: claims 1-6 as anticipated by Plotnick (U.S. Pat. Pub. No. 2005/0097599); and claim 7 as obvious over Plotnick in view of Eldering (U.S. Patent No. 6,820,277). OpenTV requests that the Board reconsider and reverse its decision to institute on both grounds because the Decision misapprehended the law governing when the Board is authorized to institute and prohibited from instituting review. Therefore, no trial should be instituted on the '786 patent.

## II. Legal Standards

“The Director **may not authorize** an inter partes **review** to be instituted **unless** the Director determines that **the information presented in the petition** filed under section 311 and any response filed under section 313 **shows** that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a) (emphasis added). Consistent with this statute, 35 U.S.C. § 312(a)(3) provides that “[a] petition under section 311 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.”

A request for rehearing “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” 37 C.F.R. § 42.71(d). “When rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” 37 C.F.R. § 42.71(c). “An abuse of discretion occurs where the decision (1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact findings; or (4) involves a record that contains no evidence on which the Board could rationally base its decision.” *Stevens v. Tamai*, 366 F.3d 1325, 1330 (Fed. Cir. 2004) (quoting *Eli Lilly & Co. v. Bd. of Regents of the Univ. of Wash.*, 334 F.3d 1264, 1266-67 (Fed. Cir. 2003)).

### **III. The Board Misapprehended, and Thus Failed to Adhere to, the Law Governing When Institution Is Permitted**

A petition for *inter partes* review may not be instituted unless the petition **itself** shows that there is a reasonable likelihood that at least one claim is unpatentable. 35 U.S.C. § 314(a). The Institution Decision violated this provision by instituting trial when the Petition did not present the necessary information. In particular, the anticipation ground proposed in the Petition could not be instituted because the Petition did not show how the disparate portions of Plotnick it relied

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