

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Netflix, Inc.,
Petitioner,

v.

OpenTV, Inc.
Patent Owner

PETITION FOR INTER PARTES REVIEW

OF

U.S. PATENT NO. 8,107,786

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I. Mandatory Notices

A. Real Party-in-Interest

The real party-in-interest is Netflix, Inc.

B. Related Matters

As of the filing date of this petition, the '786 Patent was asserted against the party-in-interest in *OpenTV Inc. v. Netflix, Inc.*, 1:12-cv-01733 (D. Del.).

C. Lead and Backup Counsel and Service Information

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II. Grounds for Standing

Petitioner certifies that it is not estopped or barred from requesting *inter partes* review of the '786 Patent. Petitioner was served with a complaint asserting infringement of the '786 Patent on December 19, 2012, which is less than one year before the filing of this Petition. Petitioner has not initiated a civil action challenging validity of any claim of the '786 Patent. Petitioner also certifies that the '786 Patent is eligible for *inter partes* review.

III. Relief Requested

Petitioner asks that the Board review the accompanying prior art and analysis, institute a trial for *inter partes* review of claims 1-7 (all claims) of the '786 Patent, and cancel those claims as invalid.

IV. The Reasons for the Requested Relief

The full statement of the reasons for the relief requested is as follows:

A. Summary of Reasons

The '786 Patent relates to a system, a method, and a tangible machine readable medium for modifying the playout or playback of audio/visual content. In general, the '786 Patent describes a system that delivers primary content, such as audio/visual content for display on an output device at a normal speed. The system also delivers secondary content that is not derived from the primary content. In response to a request to render the primary content at an accelerated rate, as may occur when the user attempts to fast forward the primary content, the system renders the secondary content to the output device.

These features were all well known in the prior art in 2006 when the application that issued as the '786 Patent was filed.

The references cited in this petition, alone or in combination, either anticipate or render obvious the claims of the '786 Patent. For example, U.S. Patent Publication 2005/0097599 to Plotnick, et al. discloses a system that renders primary content as an advertisement for display to a viewer, and in response to user

request to fast forward the primary content, displays an alternative advertisement in place of the default advertisement.

Consequently, this petition demonstrates that claims 1-7 simply claim features that were well known in the prior art and are therefore, either anticipated by or rendered obvious over the references presented in this petition.

B. The '786 Patent

1. Overview

The '786 Patent has three independent claims (claims 1, 4, and 7) and a total of 7 claims. Each of the independent claims is directed to rendering secondary non-derivative content at a receiving device in response to a request to render primary content at an accelerated speed.

The system, such as a video on demand system, includes a streaming server 28 having a request module 36 and a communication module 38. NTFX-1001, 6:42-43, Fig. 1.

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