

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETFLIX, INC.
Petitioner

v.

OPENTV, INC
Patent Owner

Case IPR2014-00267
Patent 7,409,437 B2

Before SALLY C. MEDLEY, JAMES T. MOORE, and JUSTIN BUSCH,
Administrative Patent Judges.

MOORE, *Administrative Patent Judge*

DECISION ON REQUEST FOR REHEARING
37 C.F.R. § 42.71

I. INTRODUCTION

Patent Owner OpenTV, Inc. has filed a timely Request for Rehearing (Paper 15, “Req. Reh’g.”) of our decision entered June 24, 2014 (Paper 13) instituting trial.

We deny the Request for Rehearing.

II. ANALYSIS

Patent Owner urges that we misapprehended the law governing institution of an *inter partes* review. Req. Reh’g 2. Patent owner urges that the Palmer grounds should not have been instituted because “the Petition did not even arguably present or contain the necessary information” to show that there is a reasonable likelihood that at least one claim is unpatentable. *Id.* at 2-3. A similar argument was made in the Patent Owner’s Preliminary Response (Paper 11) at pages 13-16. We disagree.

The appropriate standard for institution is set forth in 35 U.S.C.

§ 314(a):

THRESHOLD – 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.

Neither § 314 is to be read in a vacuum, nor is a Petition. Section 312 provides that a Petition shall identify each claim challenged and the grounds therefor. Notably, 35 U.S.C. § 312 (a)(3) also permits the submission of evidence such as copies of patents and printed publications, along with affidavits, declarations, and expert opinions. The Patent Owner is correct that the Petition must explain, adequately and with particularity, the nature of the prior art and its application to the challenged claims. Req. Reh’g. 3.

The question is whether the information presented in the petition shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least one of the claims challenged in the petition. The petition relies on a provisional application for the essential description of certain claimed features. The Patent Owner is correct that the Palmer Patent (Ex. 1007) is prior art only to the extent that the earlier provisional application (Ex. 1008) supports it. Req. Reh'g 4.

We turned to the specifically cited portions of the provisional application. *See especially* Pet. 37 (citing Ex. 1008, at pages 1, 3, 6, 9, 10, and Figure 1).

Each portion of the Palmer provisional which we quoted and discussed in the Decision on Institution came from each of these specifically cited pages; indeed, in most instances the entire page was pertinent. The only figure reproduced in the Decision on Institution was Figure 1. We disagree with the Patent Owner's position that the Petition did not present this information.

We also disagree with the assertion that the grounds were “cobble[d] together” or were based upon “the *Board's* showing.” Req. Reh'g 4. We read the reference as it was pointed out to us in several locations in the Petition. We did not undertake to fill gaps or holes. The petition and evidence of record in this instance support the determination to institute a trial.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Request for Rehearing is DENIED.

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