Paper No. _____
Filed: November 6, 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

_____

Case IPR2014-00267
Patent 7,409,437

_____

Patent Owner's Response
to Petition for *Inter Partes* Review
of U.S. Patent No. 7,409,437

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I. PRELIMINARY STATEMENT

The grounds proposed in the petition improperly rely on a document that is not prior art to the patent, so they cannot prove unpatentability of the '437 patent claims. In particular, the petition relies on the disclosure of U.S. Patent No. 5,905,865 to Palmer, which is dated almost 8 months *after* the filing date of the '437 patent. Petitioner attempts to transform the teachings of the Palmer patent into prior art by relying on the filing date of an earlier provisional application of Palmer, but the needed subject matter is not present in the Palmer provisional. Despite the Board's initial finding that the Palmer provisional inherently discloses the needed subject matter, a proper consideration of the references reveals that it does not. This might explain why Netflix's petition provided no arguments regarding inherency. When only the proper prior art is considered, the grounds proposed in the petition fail.

Furthermore, the petition's assertions regarding the obviousness of combining the internet technology of the prior art Palmer provisional with the television technology of either Romesburg or Batchelor fail to address the complexities such combinations would entail. The petition fails to provide any persuasive reason why one of ordinary skill in the art in the mid-1990's would have been motivated to combine the features of a television broadcast and an internet-based website into a single display based on these references.

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