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Paper No. 7
Entered: March 19, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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NFL ENTERPRISES LLC,
Petitioner,

v.

OPENTV, INC.,
Patent Owner.

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Case IPR2017-02092
Patent 6,233,736 B1

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Before JAMESON LEE, SALLY C. MEDLEY, and
MICHAEL R. ZECHER, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
*35 U.S.C. § 314(a) and 37 C.F.R. § 42.108*

# I. INTRODUCTION

NFL Enterprises LLC ("Petitioner")[1] filed a Petition for *inter partes* review of claims 1–3 and 8 of U.S. Patent No. 6,233,736 B1 (Ex. 1001, "the '736 patent"). Paper 1 ("Pet."). OpenTV, Inc. ("Patent Owner")[2] filed a Preliminary Response. Paper 6 ("Prelim. Resp."). Institution of an *inter partes* review is authorized by statute when "the information presented in the petition . . . and any response . . . 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); *see* 37 C.F.R. § 42.108. Upon consideration of the Petition and Preliminary Response, we conclude the information presented shows that there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of claims 1–3 and 8 of the '736 patent under 35 U.S.C. § 103(a).

## *A. Related Matters*

The parties indicate that the '736 patent is the subject of several court proceedings. Pet. 2; Paper 4, 2–3. The '736 patent also was the subject of Board proceeding IPR2014-00269 ("the 269 IPR"), terminated after institution, and IPR2016-00992 ("the 992 IPR"), terminated prior to institution.

## *B. The '736 Patent*

The specification of the '736 patent describes a method and system "for providing direct automated access to an online information services

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[1] Petitioner, NFL Enterprises LLC, identifies NFL Ventures, L.P. as a real party-in-interest. Pet. 2.

[2] Patent Owner, OpenTV, Inc., identifies Nagra USA, Inc. and Kudelski S.A. as real parties-in-interest. Paper 4, 2.

provider" by extracting an address that is embedded in a signal containing an audio or video program. Ex. 1001, [57]. The '736 patent explains that the address used to access online information is encoded either in the vertical blanking interval (VBI) of a video signal or some other portion of a signal that is not displayed so that the encoded address does not interfere with the program. *Id.* The system and method disclosed by the '736 patent can detect and decode an encoded address and alert the user that additional information is available. *Id.* In response to the indication that additional information is available, the user may opt to access the online information provider "by giving a simple command, e.g., pushing a special button on a remote control." *Id.* "The system then automatically establishes a direct digital communication link to the online information provider through the address." *Id.*

### *C. Illustrative Claims*

Petitioner challenges claims 1–3 and 8 of the '736 patent. Claims 1 and 8 are independent claims and claims 2 and 3 depend directly from claim 1. Claims 1 and 8 are reproduced below.

> 1. A method of providing to a user of online information services automatic and direct access to online information through an address associated with an online information source provided with a video program comprising:
>
> indicating to the user that an address has been provided with said video program; and
>
> electronically extracting said address and automatically establishing, in response to a user initiated command, a direct communication link with the online information source associated with said address so that the user has direct access to the online information.

*Id.* at 9:48–58.

> 8. A method of providing to a user of online information services automatic and direct access to online information through a link provided in a video program, comprising:
>
> indicating to the user that a link to online information services is available for receiving the online information; and
>
> automatically and directly electronically accessing said online information associated with said link in response to a user initiated command so that the user has direct access to the online information.

*Id.* at 10:43–52.

### *D. Asserted Grounds of Unpatentability*

Petitioner asserts that claims 1–3 and 8 are unpatentable based on the following grounds (Pet. 4):

| **Reference(s)** | **Basis** | **Challenged Claims** |
|---|---|---|
| Throckmorton[3] with or without Rhoads[4] | § 103(a) | 1–3 and 8 |
| Eisen[5] and Rhoads | § 103(a) | 1–3 and 8 |

## II. DISCUSSION

### *A. Claim Construction*

The '736 patent is expired. Ex. 1001; Pet. 13. For claims of an expired patent, our claim interpretation is similar to that of a district court. *See In re Rambus, Inc.*, 694 F.3d 42, 46 (Fed. Cir. 2012). "In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written

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[3] U.S. Patent No. 5,818,441, issued Oct. 6, 1998 (Ex. 1003, "Throckmorton").
[4] U.S. Patent No. 5,841,978, issued Nov. 24, 1998 (Ex. 1004, "Rhoads").
[5] U.S. Patent No. 5,440,678, issued Aug. 8, 1995 (Ex. 1005, "Eisen").

description, and the prosecution history, if in evidence." *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–17 (Fed. Cir. 2005) (en banc)). There is, however, a presumption that a claim term carries its ordinary and customary meaning. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002).

Petitioner proposes constructions for the following claim terms found in the challenged claims: "automatically establishing, in response to a user initiated command, a direct communication link with the online information source" (claim 1) and "so that the user has direct access to the online information" (claims 1 and 8). Pet. 13–15. Petitioner argues that the Board construed these two phrases in the 269 IPR Decision on Institution, and, although such constructions were made prior to the expiration of the patent, proposes the same constructions here. *Id.* Patent Owner does not oppose Petitioner's proposed constructions. *See generally* Prelim. Resp.

In the 269 IPR Decision to Institute, the phrase "automatically establishing, in response to a user initiated command, a direct communication link with the online information source" was construed to mean "in response to a command from a user, establishing, without further input from the user, a communication link directly between the user and the online information source." IPR2014-00269, Paper 13, 7–8. At the time of the construction, the '736 patent was unexpired. Nonetheless, Petitioner proposes the previous construction from the 269 IPR Decision on Institution applies here, because it is based on the ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. Pet. 14. We have reviewed Petitioner's proposed

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