

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEALS BOARD

NFL ENTERPRISES LLC,
Petitioner

v.

OPENTV, INC.
Patent Owner

Case No.: IPR2017-02092
Patent No. 6,233,736

**PATENT OWNER'S PRELIMINARY
RESPONSE**

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 A. Unlike the '736 patent, *Throckmorton* does not disclose displaying an object in video playback that provides an automatic and direct link to online information in response to a user command.....15

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I. INTRODUCTION

The petition challenges claims 1-3 and 8 of the '736 patent based on the combination of *Eisen* and *Rhoads* under 35 U.S.C. § 103, and based on either *Throckmorton* alone or in combination with *Rhoads* under 35 U.S.C. § 103. Pet. 4. Of these claims, only 1 and 8 are independent. Because the petition's grounds do not include a proper *Graham* analysis for the independent claims, the petition fails to establish a reasonable likelihood that the NFL will prevail on any of its grounds. See 35 U.S.C. § 314(a).

For the *Eisen/Rhoads* ground, the petition lacks the details necessary to make out a *prima facie* case of obviousness for three reasons. First, the petition does not address why a person of ordinary skill would have looked to *Rhoads* to solve a problem not present in *Eisen*. Second, the petition fails to explain how the steganographic program in *Rhoads* could have been added into the system in *Eisen*. Third, the petition fails to identify what gap in *Eisen* the NFL intends to fill with *Rhoads* for claim 8.

For the *Throckmorton/Rhoads* ground, the petition similarly fails to explain what gap in *Throckmorton* the NFL intends to fill with *Rhoads* for all claims. Finally, for the *Throckmorton* ground without *Rhoads*, the petition improperly uses the disclosure of the '736 patent, rather than the disclosure of the reference, as its roadmap. Accordingly, the Board should deny all of the NFL's grounds. *Id.*

II. THE BOARD SHOULD DENY THE *EISEN/RHOADS* GROUND BECAUSE THE PETITION'S PROPOSED MODIFICATION OF *EISEN* BASED ON *RHOADS* IS INCONSISTENT WITH HOW THE PETITION MAPPED *EISEN* TO THE CLAIMS.

A. Claims 1-3

The petition's combination of *Eisen* and *Rhoads* fails to address claim 1 as a whole. Independent claim 1 (with emphasis added) recites:

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.

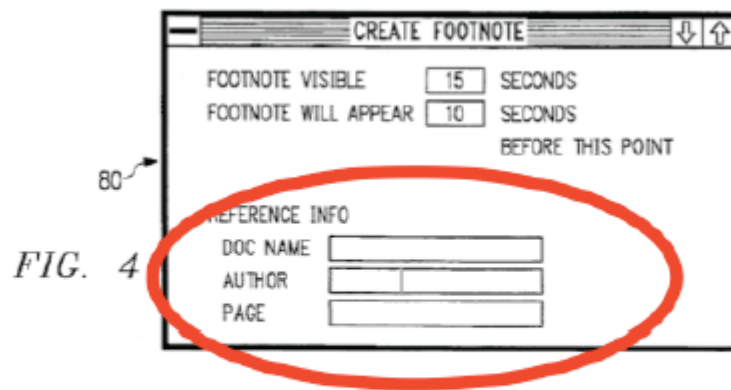
The petition relies on *Eisen* to disclose the majority of the claim and, through its expert declaration, appears to map the claimed "address" to *Eisen*'s page field entered when creating a footnote:

280. Eisen discloses an address associated with an online information source provided with a video program.

281. *See, e.g.*, Eisen discloses using a multi-media reference for the footnote material:

The create footnote window 80 may contain such information, for example, as the duration the footnote is to be available, when the footnote will appear, and multi-media reference information such as document name, author, page, and, etc. NFLE 1005 3:56-61.

282. Figure 4 shows the screen in which the multi-media reference information is entered:



NFLE 1005 Figure 4 (emphasis added).

Pet. 40 (citing Ex. 1006, ¶¶ 276-288).

The petition, however, admits that *Eisen* fails to disclose “electronically extracting said address.” Pet. 42-43. Instead of relying on *Eisen* for this element, the petition thus relies on the steganographic programs in *Rhoads. Id.* The petition explains that “Rhoads teaches the use of steganographic programs, which ‘allow computer users to hide their own messages inside digital image files and digital

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