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.

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IPR2014-00269
Patent 6,233,736

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

BUSCH, *Administrative Patent Judge.*

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I.   INTRODUCTION

A.   Background

Netflix, Inc. ("Petitioner") filed a Petition requesting an *inter partes* review of claims 1-12 of U.S. Patent No. 6,233,736 (Ex. 1001, "the '736 patent") on December 18, 2013. Paper 1 ("Pet."). OpenTV, Inc. ("Patent Owner") filed a Patent Owner Preliminary Response on March 27, 2014. Paper 11 ("Prelim. Resp."). We have jurisdiction under 35 U.S.C. §§ 6(b) and 314.

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which states:

> 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.

Inter partes review is instituted only if the petition supporting the ground demonstrates "that there is a reasonable likelihood that at least one of the claims challenged in the petition is unpatentable."
37 C.F.R. § 42.108(c).

Upon consideration of the Petition and the Patent Owner Preliminary Response, we conclude Petitioner has established a reasonable likelihood that it would prevail with respect to claims 1-12 of the '736 patent and, accordingly, we institute an *inter partes* review of claims 1-12.

B. Related Proceedings

Petitioner indicates that the '736 patent was asserted against Petitioner in *OpenTV, Inc. v. Netflix, Inc.*, No. 1:12-cv-01733 (D. Del.). Pet. 1. Petitioner also indicates that "a proceeding relating to European Patent EP 0 879 534, which claims priority to the parent of the '736 patent, arising out of request number KG RK 13-1834 is pending in The Hague District Court, The Netherlands." *Id.* The same parties and related patents are involved in the following petitions for *inter partes* review before this Board: *Netflix, Inc. v. OpenTV, Inc.*, Case IPR2014-00252 (Dec. 16, 2013); *Netflix, Inc. v. OpenTV, Inc.*, Case IPR2014-00267 (PTAB Dec. 17, 2013); and *Netflix, Inc. v. OpenTV, Inc.*, Case IPR2014-00274 (PTAB Dec. 19, 2013).

C. The '736 Patent (Ex. 1001)

The specification of the '736 patent describes a method and system "for providing direct automated access to an online information services provider" by extracting an address that is embedded in a signal containing an audio or video program. Ex. 1001, Abstract. 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

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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.* One described embodiment provides a system that generates a

secondary advertisement that is not derived from the primary advertisement

when a user elects to skip or fast forward through the primary advertisement.

Ex. 1001, 2:53-61.

Of the challenged claims, claims 1 and 6-9 are independent claims.

Claims 1 and 6-8 are directed to methods, and claim 9 is directed to a system

with means-plus-function limitations that provide similar function as the

method steps of claim 1. Illustrative claim 1 is reproduced as follows:

> 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.

D. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability under 35 U.S.C. § 103:

Reference[s]	Basis	Challenged Claims
Throckmorton[1]	§ 103	1-3 and 6-12
Throckmorton and Williams[2]	§ 103	4
Throckmorton and Kerman[3]	§ 103	5

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b). Under the broadest reasonable construction standard, claim terms are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Any special definition for a claim term must be set forth with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

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[1] Throckmorton et al. ("Throckmorton"), U.S. Patent No. 5,818,441, Oct. 6, 1998 (Ex. 1004).
[2] Williams et al. ("Williams"), U.S. Patent No. 5,701,161, Dec. 23, 1997 (Ex. 1005).
[3] Kerman, U.S. Patent No. 5,659,366, Aug. 19, 1997 (Ex. 1006).

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