

Netflix, Inc. v. OpenTV, Inc., Denying Request for Rehearing for Inter Partes Review IPR2014-00252

Article By:

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Takeaway: The Board, in its decision to institute, did not overstep its role as adjudicator when it cited to sections of the prior art not specifically relied-upon in the petition.

In its Decision, the Board denied Patent Owner's Request for Rehearing of the Board's previous Decision to Institute Inter Partes Review of certain claims of the '786 Patent. According to the Board, it had not misapprehended the pertinent law in instituting inter partes review.

Patent Owner had asserted that the Board had overstepped its role as adjudicator by providing its own analysis and by filling in evidentiary gaps in the Petition. In response, the Board noted that "the Petition is not to be read in a vacuum" and that while the Petition must adequately and particularly explain the prior art and how it is being applied to each of the challenged claims, "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 Board went on to note that the Petition identified portions of Plotnick that allegedly disclose each of the limitations in the challenged claims under 35 U.S.C. § 102, and that by citing to paragraphs of Plotnick not specifically relied-upon in the Petition, the Board was not "filling in evidentiary gaps of the Petition and taking it upon itself to establish that a reasonable likelihood of prevailing existed," as had been alleged by Patent Owner."

Instead, the Board indicated that the portions of Plotnick that it had cited serve to clarify the Board's reasons for concluding that Petitioner is reasonably likely to prevail with respect to at least one of the challenged claims. Other statements provided by the Board in connection with its explanation for why its Decision to Institute was appropriate included: "the Board does not read the petition without considering the underlying evidence submitted;" "the Board does not look to citations to a reference without considering the relevant context;" the "citations alleged to be beyond the scope of the petition are merely citations to portions of a prior art reference (Plotnick) that was submitted as part of the petition;" and "Petitioner cited to various paragraphs within the range of paragraphs cited by the Board that are alleged to be beyond the scope of the petition." For at least the aforementioned reasons, the Board disagreed with Patent Owner's contention that the Board's Decision on Institution had misapprehended the law, and thus denied Patent Owner's Request for Rehearing.

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Paper 16: Decision on Request for Rehearing

Dated: July 11, 2014

Patent: 8,107,786

Before: Sally C. Medley, James T. Moore, and Justin Busch

Written by: Busch

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