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Paper 16
Date Entered: January 28, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
SAMSUNG ELECTRONICS AMERICA, INC., and
SAMSUNG TELECOMMUNICATIONS AMERICA, LLC,
and
LG ELECTRONICS, INC., LG ELECTRONICS U.S.A., INC., and
LG ELECTRONICS MOBILECOMM U.S.A., INC.,
Petitioners,

v.

BLACK HILLS MEDIA, LLC,
Patent Owner.

Case IPR2014-00711
Case IPR2015-00338
Patent 8,320,099 B2

Before BRIAN J. McNAMARA, PETER P. CHEN, and
FRANCES L. IPPOLOTI, *Administrative Patent Judges*.

McNAMARA, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review and Grant of Motion for Joinder
37 C.F.R. § 42.108
37 C.F R § 42.122(b)

Introduction

LG Electronics, Inc., LG Electronics U.S.A., Inc., and LG Electronics MobileComm U.S.A., Inc. (collectively, "Petitioner LG") filed a Petition, Paper 2 ("Pet."), to institute an *inter partes* review of claims 1 and 10–12 (the "challenged claims") of U.S. Patent No. 8,320,099 B2 ("the '099 Patent"). 35 U.S.C. § 311. Petitioner LG has also moved to join this proceeding with *Samsung Electronics Co., Ltd. v. Black Hills Media, LLC,* IPR2014-00711 ("the Samsung IPR"). Paper 3 ("Motion for Joinder"). Black Hills Media, LLC ("Patent Owner") and Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC do not oppose Petitioner LG's Motion for Joinder.

For the reasons described below, we institute an *inter partes* review of all the challenged claims and grant Petitioner LG's Motion for Joinder.

Institution on the same grounds as those asserted in the Samsung IPR

The Petition in this proceeding asserts the same grounds as those asserted in the Samsung IPR. On November 4, 2014, we instituted a trial in the Samsung IPR on the following grounds[1]:

> Claims 10–12 of the '099 patent are unpatentable under 35 U.S.C. § 103 as obvious over U.S. Patent Appl. Publ. 2002/0087996 A1("Bi"), U.S. Patent Appl. Publ. 2002/0072817 A1("Champion"), and U.S. Patent No. 7,668,932 B2 ("Encarnacion"); and
>
> Claims 10–12 of the '099 patent are unpatentable under 35 U.S.C. § 102 as anticipated by Bi.

[1] Patent Owner disclaimed claim 1 in the Samsung IPR. *Samsung Electronics Co., Ltd. v. Black Hills Media, LLC*, Case IPR2014-00711 Ex. 2001

In view of the identity of the challenges in the instant Petition and those of the petition in the Samsung IPR, we institute an *inter partes* review in this proceeding on the same grounds as those on which we instituted the Samsung IPR. We do not institute *inter partes* review on any other grounds.

Joinder with the Samsung IPR

The Petition in this proceeding has been accorded a filing date of December 3, 2014, and therefore satisfies the joinder requirement of being filed within one month of our instituting a trial in the Samsung IPR. 37 C.F.R. § 42.122(b). In a teleconference on December 9, 2014, counsel for Petitioner LG represented that the only grounds Petitioner LG seeks to pursue in this proceeding are those on which we instituted the Samsung IPR. Counsel for Petitioner LG also agreed that all filings in the joined proceeding would be made by the petitioner in the Samsung IPR ("Petitioner Samsung") and that Petitioner LG would not seek discovery other than that sought by Petitioner Samsung. Petitioner Samsung and Petitioner LG further agreed to resolve any disputes between them concerning the conduct of the joined proceeding and to contact the Board if any such matters cannot be resolved. The parties agreed that no additional burdens would be placed on Patent Owner as a result of the joinder.

In consideration of the above, we institute an *inter partes* review in IPR2015-00338 and grant Petitioner LG's motion to join that proceeding to IPR2014-00711.

ORDER

In view of the foregoing, it is:

ORDERED that IPR2015-00338 is instituted and joined with IPR2014-00711;

FURTHER ORDERED that the grounds on which IPR2014-00711 was instituted are unchanged and no other grounds are instituted in the joined proceeding;

FURTHER ORDERED that the Scheduling Order in place for IPR2014-00711 (Paper 12) is unchanged and applies to the joined proceeding;

FURTHER ORDERED that throughout the joined proceeding, Petitioner Samsung will file all papers jointly on behalf of Petitioner Samsung and Petitioner LG;

FURTHER ORDERED that except as otherwise agreed by counsel, Petitioner Samsung will conduct cross-examination and other discovery on behalf of Petitioner Samsung and Petitioner LG and that Patent Owner is not required to provide separate discovery responses or additional deposition time as a result of the joinder;

FURTHER ORDERED that IPR2015-00338 is terminated under 37 C.F.R. § 42.72 and all further filings in the joined proceeding are to be made in IPR2014-00711; and

FURTHER ORDERED that the case caption in IPR2014-00711 shall be changed to reflect the joinder with this proceeding in accordance with the caption in this order.

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