

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

YAMAHA CORPORATION OF AMERICA, Petitioner,

v.

BLACK HILLS MEDIA, LLC, Patent Owner

Case IPR2013-00597

Patent 8,230,099

**PATENT OWNER'S MOTION TO AMEND U.S. PATENT NO. 8,230,099
UNDER 35 U.S.C. §316 AND 37 C.F.R. §42.121**

MOTION TO AMEND

Trial was instituted with respect to claims 1, 2, 6, 9, 10, 11, and 12 of U.S. Patent No. 8,230,099 (“the ‘099 patent”) (Ex. 1001). Pursuant to 37 C.F.R. §42.121, Patent Owner Black Hills Media, LLC (“Black Hills Media”) moves to amend the ‘099 patent by canceling claims 1 and 9. Black Hills Media has met its obligation to confer with the Board in accordance with 37 C.F.R. §42.121. The Board authorized the Patent Owner to file this Motion to Amend Claims via an email sent to Patent Owner’s representative on June 12, 2014. Below, Patent Owner provides a claim listing that includes the text of the challenged claims and the status of each of the challenged claims, labeling the canceled claims as “canceled” with strikethrough text and the non-amended claims as “original”.

I. CLAIMS

1. (Canceled) ~~A method comprising:~~

~~receiving, at a wireless handheld remote control, a playlist from a~~

~~remote source; and~~

~~presenting, at the wireless handheld remote control, the playlist to a~~

~~first user associated with the wireless handheld remote control such that the first~~

~~user is enabled to select at least one item from the playlist for playback by a media~~

~~player device which is associated with and separate from the wireless handheld~~

~~remote control.~~
2. (Original) The method of claim 1 wherein the playlist is further
communicated from the remote source to the media player device.
6. (Original) The method of claim 1 wherein the remote source is a
central server.
9. (Canceled) ~~The method of claim 1 wherein the remote source is the~~

~~media player device.~~
10. (Original) A wireless handheld remote control comprising:

a communication interface communicatively coupling the wireless handheld remote control to a remote source via a network; and

a control system associated with the communication interface and adapted to:

receive a playlist from the remote source; and

present the playlist to a first user associated with the wireless handheld remote control such that the first user is enabled to select at least one item from the playlist for playback by a media player device which is associated with and separate from the wireless handheld remote control.

11. (Original) A method comprising:

receiving, at a media player device, a playlist from a remote source; and

communicating the playlist from the media player device to a wireless handheld remote control associated with and separate from the media player device, wherein, at the wireless handheld remote control, the playlist is presented to a first user associated with the wireless handheld remote control and used by the first user to select at least one item from the playlist for playback by the media player device.

12. (Original) A media player device comprising:

a communication interface communicatively coupling the
media player device to a remote source via a network; and
a control system associated with the communication interface
and adapted to:
receive a playlist from the remote source; and
communicate the playlist from the media player device to
a wireless handheld remote control which is associated with and
separate from the media player device, wherein, at the wireless
handheld remote control, the playlist is presented to a first user
associated with the wireless handheld remote control and used by the
first user to select at least one item from the playlist for playback by
the media player device.

II. SUPPORT FOR AMENDMENTS

By this amendment, claims 1 and 9 have been canceled. Because claim language has not been amended and substitute claims have not been proposed, Patent Owner submits that a showing of support is unnecessary for the present Motion to Amend.

III. SCOPE OF AMENDMENTS

Patent Owner submits that the scope of the above amendments is appropriate for an *Inter Partes* Review proceeding. Specifically, the amendments respond to a ground of unpatentability by canceling claims and rendering grounds of unpatentability instituted for the canceled claims moot. In addition, the amendments do not seek to enlarge the scope of the claims of the patent or introduce new subject matter because the amendments merely cancel claims without adding any new claim language.

IV. CONCLUSION

For at least the reasons set forth above, Patent Owner submits that the amendments reflected in the above claim listing are appropriate for entry in an *Inter Partes* review proceeding. Accordingly, Patent Owner respectfully requests grant of the present Motion to Amend and cancellation of claims 1 and 9 from the '099 Patent.

Respectfully submitted,

Dated: June 13, 2014

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CERTIFICATE OF SERVICE

The undersigned hereby certifies the foregoing Patent Owner's Motion to Amend was served by e-mail on June 13, 2014 to the Petitioner's counsel of record upon the following:

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