Trials@uspto.gov
571-272-7822

Paper 7
Entered: November 4, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

BLACK HILLS MEDIA, LLC,
Patent Owner.

Case IPR2014-00711
Patent 8,230,099 B2

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

CHEN, *Administrative Patent Judge*.

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

I. INTRODUCTION

Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC (collectively, "Petitioner") filed a Petition requesting an *inter partes* review of claims 1 and 10–12 of U.S. Patent No. 8,230,099 B2 (Ex. 1001, "the '099 patent"). Paper 1 ("Pet."). Black Hills Media, LLC ("Patent Owner") filed a Preliminary Response (Paper 6 ("Prelim. Resp.")), including a disclaimer of claim 1 of the '099 patent. We have jurisdiction under 35 U.S.C. § 314.

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

> 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.

Upon consideration of the Petition and accompanying exhibits and the Preliminary Response and accompanying exhibits, we are persuaded the information presented by Petitioner has shown a reasonable likelihood it would prevail in showing the unpatentability of claims 10–12 of the '099 patent. Accordingly, we authorize institution of an *inter partes* review of these claims.

A. Related Proceedings

The Patent Owner has filed suit against Petitioner in the U.S. District Court for the Eastern District of Texas, alleging infringement of the '099 patent. *See*

Black Hills Media, LLC v. Samsung Elecs. Co., No. 2-13-cv-00379 (E.D. Tex). Pet. 1. The Patent Owner also has filed lawsuits alleging infringement of the '099 patent against other parties. *Id.*

The Patent Owner also initiated a Section 337 action in the U.S. International Trade Commission against Petitioner and other parties, alleging, *inter alia*, infringement of the '099 patent. Pet. 1. The ITC investigation was terminated as to the '099 patent before any decision was issued. *See Certain Digital Media Devices, Including Televisions, Blu-Ray Disc Players, Home Theater Systems, Tablets and Mobile Phones, Components Thereof and Associated Software*, Inv. No. 337-TA-882 (USITC) (the "882 ITC Investigation"). *Id.*

We instituted an *inter partes* review of claims 1, 2, 6, and 9–12 of the '099 patent, in *Yamaha Corporation of America v. Black Hills Media LLC*, Case IPR2013-00597 (PTAB March 20, 2014). The '099 Patent is a divisional of the application that issued as U.S. Pat. No. 8,028,323 ("the '323 patent"). The '323 patent is the subject of pending IPR2014-00709. U.S. Pat. No. 8,214,873 ("the '873 patent") issued from a continuation of the '323 patent. We instituted an *inter partes* review of claims 1, 2, 6–13, 15–31, 35–42, and 44–46 of the '873 patent, in *Yamaha Corporation of America v. Black Hills Media LLC*, Case IPR2013-00598 (PTAB Mar. 20, 2014). [1]

[1] The ITC issued an Initial Determination holding the '873 patent invalid under 35 U.S.C. § 112, ¶ 1. *Certain Digital Media Devices, Including Televisions, Blu-Ray Disc Players, Home Theater Systems, Tablets and Mobile Phones, Components Thereof and Associated Software*, Inv. No. 337-TA-882 (July 14, 2014) (Initial Determination).

B. Real Party-in-Interest

Patent Owner asserts that Petitioner fails to identify all real parties-in-interest and requests the Petition be dismissed for noncompliance with 35 U.S.C. § 312(a) and 37 C.F.R. § 42.8(b). Prelim. Resp. 2–8. In particular, Patent Owner argues that Google, Inc. ("Google") should have been identified in the Petition as a real party-in-interest. *Id.* at 3. Patent Owner first contends that a recently discovered agreement, titled Mobile Application Distribution Agreement ("MADA"), requires Google to "defend, or at its option settle, any third party lawsuit or proceeding brought against [Petitioner]" and arising out of any claim that Google products and services used in Petitioner's products infringe any patent. Prelim. Resp. 4. Patent Owner states that "under the MADA, Google has full control of the defense and settlement of any third-party infringement action implicating Google's products and services, including any proceeding, such as this Petition." *Id*. Although the Petition is not an infringement action, Patent Owner appears to argue that the Petition arose from the 882 ITC Investigation filed by Patent Owner against Petitioner.

Patent Owner next contends that Google sought to intervene in the 882 ITC Investigation, and that in its motion papers Google asserted "a compelling interest" in the investigation. Prelim. Resp. 6.

On this record, we are not persuaded Google is a real party-in-interest in this matter. A determination as to whether a non-party to an *inter partes* review is a real party-in-interest is a "highly fact-dependent question," based on whether the non-party "exercised or could have exercised control over a party's participation in

a proceeding" and the degree to which a non-party funds, directs, and controls the proceeding. Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,759–60 (Aug. 14, 2012). Thus, the issue is whether there is a non-party "at whose behest the petition has been filed" or a relationship "sufficient to justify applying conventional principles of estoppel and preclusion." *Id.*

The existence of the MADA and Google's motion to intervene in the 882 ITC Investigation, are not persuasive evidence that Google is in a position to exercise control over Petitioner's involvement in this proceeding. Google's indemnification of Petitioner for infringement claims brought by third parties, such as contemplated in the MADA does not, by itself, mean that Google may exercise control over Petitioner's actions in this proceeding. In addition, Google's expression of interest in the 882 ITC Investigation does not mean it has the same interests as those of Petitioner. We, therefore, do not deny the Petition for failure to comply with 35 U.S.C. § 312(a) and 37 C.F.R. § 42.8(b)(1).

The Patent Owner Preliminary Response includes an informal request for discovery concerning Google's role in this proceeding. Prelim. Resp. 8. The Preliminary Response is not a vehicle for requesting additional discovery. 37 C.F.R. § 42.107. *See* 37 C.F.R. § 42.51. In IPR2014-00717 (Paper 17) and IPR2014-00735 (Paper 17), we granted in part Patent Owner's authorized motion for additional discovery in those proceedings.

C. The ’099 Patent

The subject matter of the challenged claims of the ’099 patent relates generally to methods and devices for sharing playlists, and in particular, to a method for presenting a playlist on a wireless handheld remote control for selection for playback on a media player device associated with, but separate from, the remote control. Pet. 8; Ex. 1001, 1:25–29, 9:1–8.

Figure 2 of the ’099 patent is reproduced below.

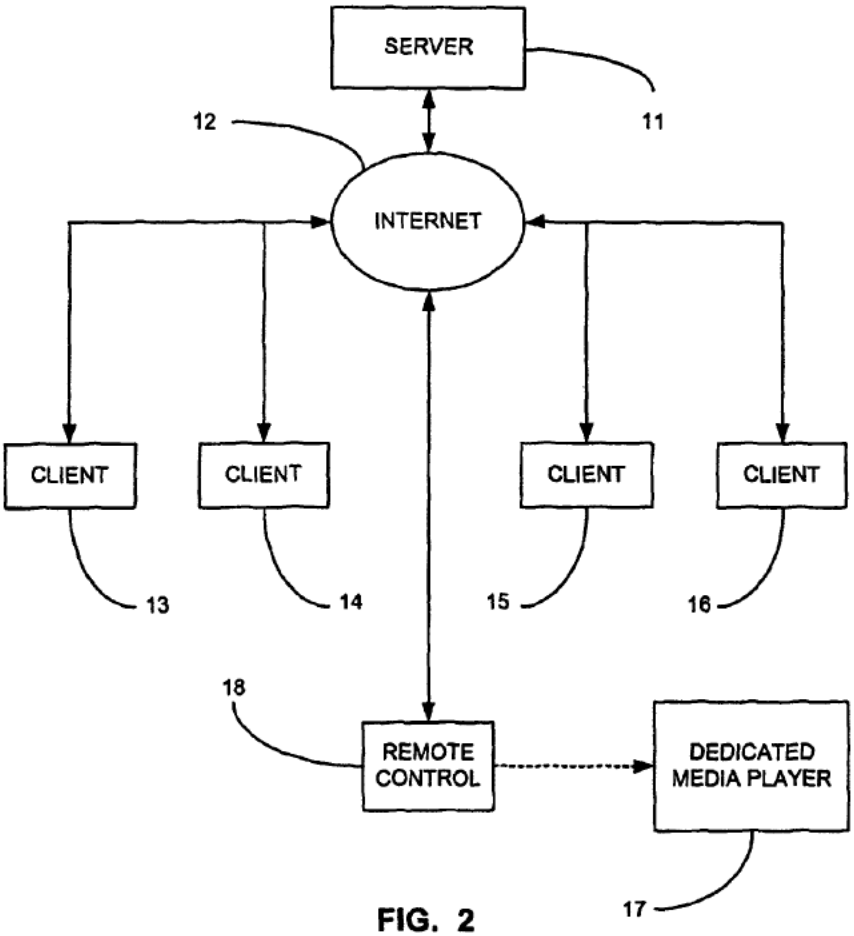

FIG. 2

Figure 2 depicts an embodiment of the invention with a playlist communicated from server 11 to remote control 18 via Internet 12. Ex. 1001, 9:1–23. After the playlist has been communicated to the remote control, the playlist may be displayed on the remote control and used to choose which selection is to be played by dedicated media player 17. *Id*. at 9:5–8. The playlist may be communicated further to media player 17. *Id*. at 9:9–23. "Thus, playlists may be stored in, displayed upon, and used to make selections from either dedicated media player 17, remote control 18, or both." *Id*. at 9:21–23. The display of the playlist on the remote control allows the user to select a song to be played on the media player without physically making a selection at the media player. *Id*. at 9:9–23.

D. Illustrative Claim

Pursuant to Patent Owner's filing of a statutory disclaimer as to claim 1, claims 10-12 are the subject of the Petition. All are independent claims. Independent claim 11 is reproduced as follows:

> 11. A method comprising:
> receiving, at a media player device, a playlist from a remote source; and
> communicating the play list 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.

Id. at 12:24-34.

E. Prior Art Relied Upon

Petitioner relies upon three prior art references.

Reference	**Title**	**Date**	**Ex. No.**
Bi	US 2002/0087996 A1	July 4, 2002	Ex. 1003
Champion	US 2002/0072817 A1	June 13, 2002	Ex. 1004
Encarnacion	US 7,668,939 B2	Feb. 23, 2010	Ex. 1005

F. The Asserted Grounds

Petitioner contends the challenged claims are unpatentable based on two grounds.

References	**Basis**	**Claims Challenged**
Bi, Champion, and Encarnacion	§ 103	10–12
Bi	§ 102	10–12

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); Office Patent Trial

Practice Guide, 77 Fed. Reg. at 48,766. There is a "heavy presumption" that a claim term carries its ordinary and customary meaning. *CCS Fitness, Inc. v. Brunswick Corp*., 288 F.3d 1359, 1366 (Fed. Cir. 2002). However, a "claim term will not receive its ordinary meaning if the patentee acted as his own lexicographer and clearly set forth a definition of the disputed claim term in either the specification or prosecution history." *Id*.

Both parties have proposed constructions for the claim term "playlist." Petitioner also proposes a construction for "media player device." Patent Owner also proposes a construction for "wireless handheld remote control which is associated with and separate from the media player device."

Petitioner proposes that "playlist" is "a list of media selections." Pet. 5–6. The Specification states, "[a] playlist is a list of a user's favorite selections." Ex. 1001, 1:33–34. Petitioner's description of a playlist was determined to be the broadest reasonable construction in *Yamaha Corporation of America v. Black Hills Media LLC*, Case IPR2013-00597, slip op. at 9 (PTAB Mar. 20, 2014) (Paper 15), also involving the '099 patent. Patent Owner relies upon the Declaration of Gareth Loy, Ex. 2007 ("Loy declaration")[2] in support of its proposal that a "playlist" is "a list referencing media items arranged to be played in a sequence." Prelim. Resp. 17–27. After review of the Loy declaration and the Preliminary Response, and as we determined in IPR2013-00597, we are persuaded that the construction proposed by Patent Owner is too narrow and would exclude the embodiment described in the

[2] The Loy declaration was previously filed in IPR2013-00597 as Ex. 2011.

Specification. For purposes of this Decision, we determine that the broadest reasonable interpretation of the term "playlist" consistent with the Specification is "a list of media selections."

Petitioner proposes that "media player device" be construed as "a device capable of playing audio or video or a combination of both." Pet. 6–7. The term "media player device" appears only in the claims of the '099 patent, where it is not defined. The term "media player" is used throughout the Specification, which states "examples of dedicated media players include music players such as MP3 players, video players such as set top boxes, video recording devices such as TiVo and game players." Ex. 1001, 8:52–55. Therefore, for purposes of this Decision, we determine the broadest reasonable construction of "media player device" is "a device capable of playing audio or video or a combination of both."

Finally, Patent Owner proposes that the term "wireless handheld remote control which is associated with and separate from the media player device" means that the remote control must function independently of the media player device. As Patent Owner acknowledges, however, its proposed construction is based only on "certain embodiments." Prelim. Resp. 28. For purposes of this Decision, we determine that this term requires no express construction.

B. Claims 10–12 – Obviousness Over Bi, Champion, and Encarnacion

Petitioner contends claims 10–12 are unpatentable under 35 U.S.C. § 103 as obvious over Bi, Champion, and Encarnacion. Pet. 20–52. Petitioner asserts this

combination has "more robust disclosure" of certain claim limitations than the other ground in its Petition, which is based on Bi alone. *Id.* at 19.

Bi (Exhibit 1003)

Bi is titled "Interactive Remote Control of Audio or Video Playback and Selections." Petitioner contends Bi discloses a system for an interactive remote control, which may be wireless, of a player application running on a personal computer or set-top box. Pet. 12. Figure 2 of Bi is reproduced below.

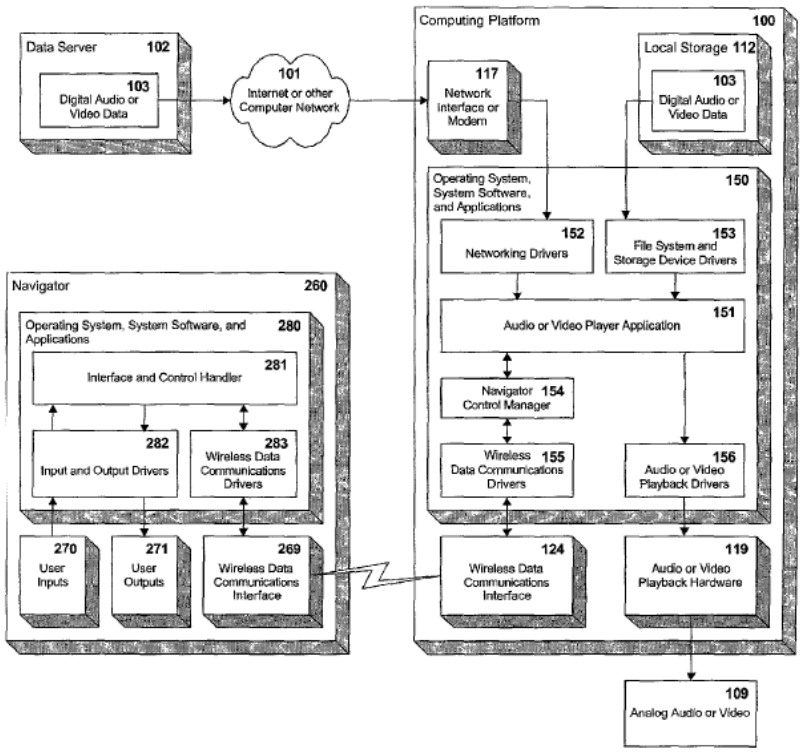

Figure 2

Figure 2 depicts data server 102 providing digital audio or video data via Internet or other network 101 to computing platform 100. Navigator 260 is an interactive remote control communicating with computing platform 100, including wirelessly, to control selection of audio or video data. Ex. 1003 ¶¶ 0018, 0020. The software flow in navigator control manager 154 includes steps relating to browsing and selecting music with the navigator, where "[t]ypically, a browse of music is based on such criteria as music track, album, artist, music genre, and playlists." *Id.* ¶ 0032, Fig. 7.

Champion (Exhibit 1004)

Champion is titled "System and Method for Request, Delivery and Use of Multimedia Files for Audiovisual Entertainment in the Home Environment." Champion discloses a system and method for using a remote control of audiovisual programming on a computer or set-top box. Pet. 15; Ex. 1004, Abstract. Figure 1 of Champion is reproduced below.

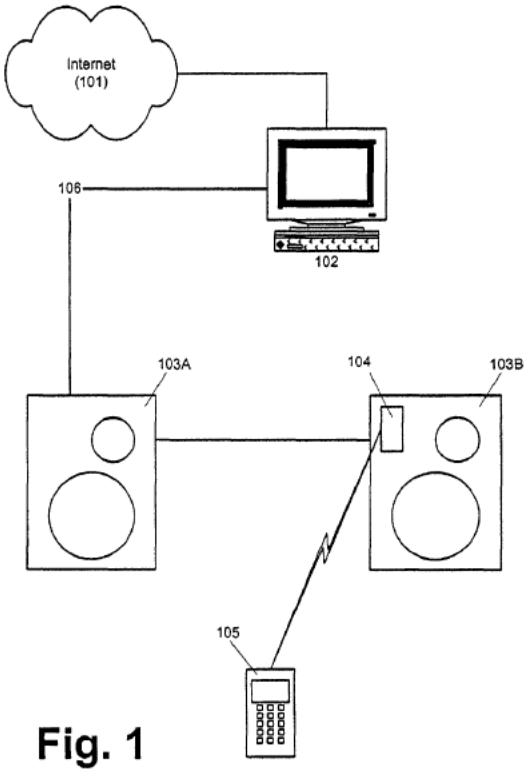

Fig. 1

Figure 1 depicts a system with computer 102 which accesses and downloads content via Internet 101, and can also supply audiovisual output. Ex. 1004 ¶¶ 0030, 0067. Remote control 105 communicates wirelessly with computer 102 and controls audiovisual programming output by computer 102 to speakers 103A and 103B or a monitor. *Id.* ¶¶ 0039–40. Figure 3 of Champion is reproduced below.

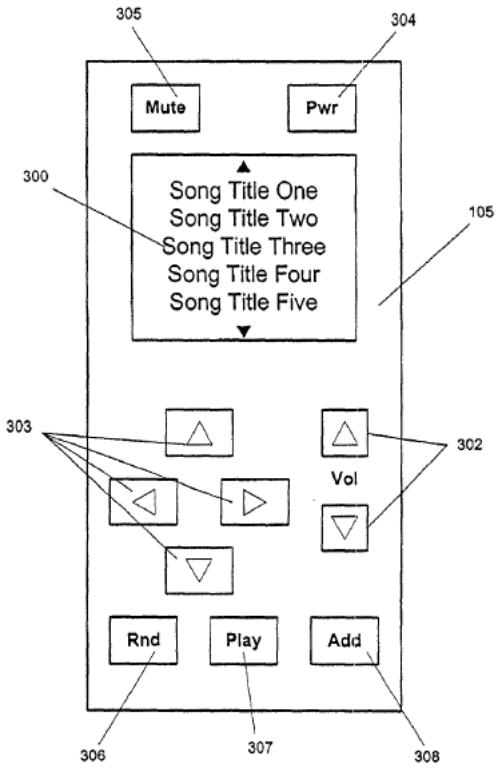

Fig. 3

Figure 3 depicts remote control 105 with display 300 that can show a list of available audio files (e.g., song titles). *Id.* ¶ 0042. Remote control 105 allows a user to select a file to be played. *Id.* ¶ 0043.

Encarnacion (Exhibit 1005)

Encarnacion is titled "Routing of Resource Information in a Network" and discloses a Universal Plug and Play network configured to allow media from a server to be played on a player device. Pet. 17; Ex. 1005, 1:20–24.

Figure 3 of Encarnacion is reproduced below.

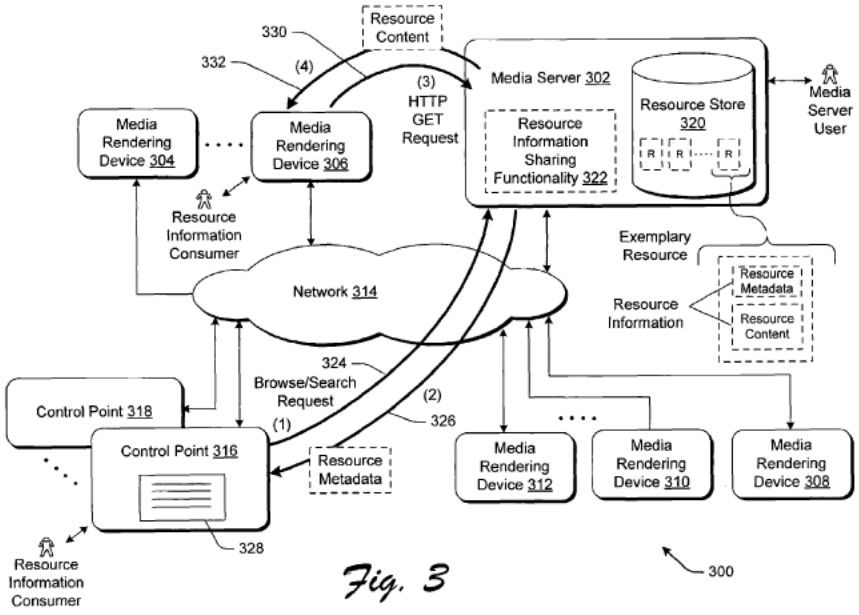

Fig. 3

Figure 3 depicts an exemplary UPnP network architecture 300 of Encarnacion. Ex. 1005, 7:65–8:67. Control point devices 316 and 318 control other devices on UPnP network 314. *Id*. at 8:14–28. Media rendering devices 304–312, such as computers, stereos, and televisions, play back media and media server 302, e.g., a personal computer, stores media for on-demand transmission to other devices. *Id.* at 3:9–13, 8:4–8. A user of control point device 316 can send a browse/search request 324 to media server 302 for available media resources. *Id*. at 8:55–62. Media server 302 returns resource metadata 326 to the user, identifying songs or other forms of available media. *Id*. at 14:8–30, 21:48–50. The user then selects a resource identifier, and control point 316 commands media

rendering device 306 to request the resource from media server 302, and server 302 presents the resource to media rendering device 306, which plays the media. *Id*. at 8:62–65, 14:31–55.

Analysis

Petitioner contends claims 10–12 are unpatentable under 35 U.S.C. § 103 as obvious over Bi, Champion, and Encarnacion. In support of this asserted ground of unpatentability, Petitioner provides detailed explanations as to how the subject matter of each claim is taught or suggested by the combination of Bi, Champion, and Encarnacion. Pet. 20–52. For example, for claim 11, Petitioner describes how the receipt at a media player device of a playlist from a remote source is taught or suggested by each of Bi ("Bi discloses that computing platform 100 (a media player device) receives a playlist from data server 102 (a remote source)."), Champion ("Champion discloses receiving a playlist at a computer" from an audiovisual server or the Internet.), and Encarnacion ("Encarnacion discloses a media rendering device . . . receiving a playlist from a media server."). Pet. 39–41. Petitioner further describes how the communication of the playlist from the media player device to the wireless handheld remote control is taught or suggested by Bi ("[C]omputing platform 100 . . . communicates a playlist to the navigator 260.") and Champion ("Champion discloses transmitting a playlist from a computer . . . to a remote control."). Pet. 41–42. Petitioner also describes how the presentation of the playlist to a user of a wireless handheld remote control, from which the user may select an item from the playlist for playback by the media player device, is

taught or suggested both by Bi ("Navigator 260 includes an LCD display screen 266 for displaying the playlist.") and Champion ("displaying a list of available audio programs on a remote control and enabling a user to select a program to be played"). Pet. 41–45, 53.

Patent Owner argues that the combination does not teach or suggest the limitation in claim 10 reciting the receipt by the wireless handheld remote control of a playlist from a remote source. Prelim. Resp. 48–50. We are persuaded by Petitioner's evidence that this limitation is taught or suggested by the references in the combination. In particular, Petitioner states that Bi discloses a navigator receiving the results of a browse command including playlists, from data server 102, Champion discloses a wireless handheld remote control receiving a playlist from the Internet, and Encarnacion discloses a control point receiving a playlist from a media server. *See* Pet. 34–36 (citing Ex. 1003 ¶ 0032; Ex. 1004 ¶¶ 12–13; Ex. 1005, 6:43–46, 25:13–43). As to the remaining limitations of the challenged claims, we have reviewed Petitioner's supporting evidence and the Preliminary Response and accompanying exhibits, and are persuaded Petitioner has made a sufficient showing, based on the record before us, that the references teach or suggest the claimed limitations.

Patent Owner also contends Petitioner has not articulated adequately why one of ordinary skill in the art would have combined Bi, Champion, and Encarnacion. Prelim. Resp. 41–48. At this stage of the proceeding, we determine that Petitioner has articulated reasons with rational underpinning for the

combination of Bi, Champion, and Encarnacion. For example, Petitioner states that:

> Bi, Champion and Encarnacion are all directed to using handheld devices to control the playing of remotely stored media items on media player devices . . . the navigator disclosed in Bi and the remote control in Champion could each be used as a control point in the Encarnacion system, and . . . the remote control in Champion could be used as the navigator in Bi . . .
>
> Similarly, one of skill in the art would also recognize that the protocols for communicating playlists . . . disclosed in Encarnacion could be used for the communication . . . in the Bi system, or . . . in the Champion system.

Pet. 20–22 (citing *Ex.* 1006 (Almeroth Declaration) ¶¶ 55–59).

On the present record, we are persuaded there is a reasonable likelihood of Petitioner prevailing in establishing the unpatentability of claims 10–12 of the ’099 patent as obvious over Bi, Champion, and Encarnacion.

C. Claims 10–12: Anticipation by Bi

In support of this asserted ground of unpatentability, Petitioner provides detailed explanations as to how the subject matter of each claim is disclosed by Bi. Pet. 52–60. For example, for claim 11, Petitioner’s claim chart cites to Bi’s disclosure of the claimed method where the media player device (computing platform 100 in Bi, Fig. 2) receives a playlist (as construed in section II.A. above) from a remote source (data server 102 in Bi, Fig. 2), communicates the playlist (the results of a music browse command, which includes playlists) to a wireless

handheld remote control (navigator 260 in Bi, Fig. 2) separate from the media player device, with the playlist being presented on the wireless handheld remote to a user who selects an item from the playlist for playback by the media player device. Pet. 57–58 (citing *inter alia*, Ex. 1003 ¶¶ 0018, 0020, 0028, 0031, 0032).

For claim 11 and the other challenged claims, Patent Owner contends Bi fails to disclose the claimed playlist. Prelim. Resp. 50, 53, 55. For example, Patent Owner argues that there is no indication in Bi that the "browse results" are arranged as a list referencing media items (e.g., songs) to be played in a sequence. *Id.* at 50. As described above in Section II.A., we have determined for purposes of this Decision that Patent Owner's proposed construction of playlist, which requires the songs be played in a sequence, is not the broadest reasonable construction, and that, for purposes of this Decision, a playlist is a list of media selections. On the record currently before us, we are persuaded that Bi discloses the "playlist" of the '099 patent.

Patent Owner also contends that Bi fails to disclose the remote control receiving a playlist from a remote source. Prelim. Resp. 50, 54–55. According to Petitioner, in Bi, a playlist is received by navigator 260 (a remote control) from computing platform 100, which is a remote source. Ex. 1003 ¶ 0032 (computing platform 100 sends the results of a local music browse, which can be based on playlists, to navigator 260). We are persuaded by Petitioner's argument. As to the remaining limitations of the three challenged claims, we have reviewed Petitioner's supporting evidence, and the Preliminary Response and accompanying exhibits, and determine that Petitioner has made an adequate showing under 35 U.S.C.

§ 314(a). Pet. 53–60 (citing *inter alia*, Ex. 1003, Figs. 1–5, 7–8, ¶¶ 0020–21, 0023, 0027–28, 0030, 0032–34, 0038).

On the present record, therefore, we are persuaded there is a reasonable likelihood of Petitioner prevailing in establishing the unpatentability of independent claims 10–12 of the '099 patent as anticipated by Bi.[3]

III. CONCLUSION

For the foregoing reasons, we are persuaded the information presented in the Petition establishes a reasonable likelihood that Petitioner would prevail in establishing unpatentability of claims 10–12 of the '099 patent as obvious over Bi, Champion, and Encarnacion, and as anticipated by Bi.

The Board has not made a final determination on the patentability of any challenged claim.

IV. ORDER

Accordingly, it is

ORDERED that pursuant to 35 U.S.C. § 314, an *inter partes* review is hereby instituted as to the following claims and grounds:

1. Claims 10–12 of the '099 patent are unpatentable under 35 U.S.C. § 103 as obvious over Bi, Champion, and Encarnacion; and

[3] In IPR2013-00597, we instituted an *inter partes* review on claims 10–12, and other claims, on the ground of anticipation by Bi. *Yamaha Corporation of America v. Black Hills Media LLC*, Case IPR2013-00597 (PTAB Mar. 20, 2014) (Paper 15).

2. Claims 10–12 of the ’099 patent are unpatentable under 35 U.S.C. § 102 as anticipated by Bi;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; the trial commences on the entry date of this decision; and

FURTHER ORDERED that an Initial Conference Call is scheduled for Thursday, November 20, 2014, at 4:00 p.m. Eastern time. The parties should be prepared to discuss whether and how to coordinate the final hearings, if necessary, for the *inter partes* review proceedings initiated by Petitioner against Patent Owner. After the Initial Conference Call, the Board will issue a Scheduling Order in due course.

PETITIONER:

Andrea Reister
areister@cov.com

Gregory Discher
gdischer@cov.com

PATENT OWNER:

Reza Mollaaghababa
mollaaghababar@pepperlaw.com

Thomas Engellenner
engellennert@pepperlaw.com

Christopher Horgan
chris.horgan@concerttechnology.com