

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 No. IPR2014-00711
U.S. Patent 8,230,099

**PATENT OWNER'S REQUEST FOR REHEARING ON THE
INSTITUTION DECISION PURSUANT TO 37 C.F.R. §42.71**

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TABLE OF EXHIBITS

Exhibit Description (Previously Submitted)	Exhibit #
Patent Owner's Statutory Disclaimer (August 7, 2014)	2001
Mobile Application Distribution Agreement between Samsung and Google, Trial Exhibit 2775 in the matter of <i>Oracle America, Inc. v. Google Inc.</i> , Case No. CV 10-03561 WHA (N.D. Ca)	2002
Relevant Pages from Joint Submission of Corrected Exhibit List, Doc. 293 filed on 4/15/2012, in the matter of <i>Oracle America, Inc. v. Google Inc.</i> , Case No. CV 10-03561 WHA (N.D. Ca)	2003
Google's Motion to Intervene filed in ITC Inv. No. 337-TA-882	2004
Initial Determination in ITC Inv. No. 337-TA-882, Order No. 17 (Aug. 19, 2013), Granting Google Inc.'s Motion to Intervene	2005
Patent Owner's claim charts from ITC Inv. No. 337-TA-882	2006
Declaration of Gareth Loy, D.M.A., Patent Owner's Response, Yamaha Corp. of Am. v. Black Hills Media LLC, IPR2013-00597, at Exhibit 2011 (June 13, 2014)	2007
Motion to Amend, Yamaha Corp. of Am. v. Black Hills Media LLC, IPR2013-00597, Paper 25 (June 13, 2014)	2008
"Microsoft Windows Media Player 7 Handbook," Microsoft Press, ISBN 0-7356-1 178-5, Copyright ©2000 (previously submitted with the Patent Owner's Response, Yamaha Corp. of Am. v. Black Hills Media LLC, IPR2013-00597, at Exhibit 2022 (June 13, 2014))	2009

Pursuant to 37 C.F.R. § 42.71(d), Black Hills Media, LLC (“Patent Owner”) hereby submits the following Request for Rehearing in response to the Decision, Institution of *Inter Partes* Review of U.S. Patent No. 8,230,099 (“Decision”) (Paper 7).

I. INTRODUCTION AND STATEMENT OF RELIEF REQUESTED

In the Decision, the Board granted review of claims 10–12 of the ’099 patent as obvious over the combination of Bi, Champion, and Encarnacion, and as anticipated by Bi based on the Board’s construction of the claim term “playlist.”

The Board construed the term “playlist” to mean “a list of media selections.” (Decision at 10) It is respectfully submitted that the Board overlooked the evidence of record on the ordinary and customary meaning of the term “playlist” as would be understood by one of ordinary skill in the art at the time of the invention. As a result, the Board reached an erroneous conclusion of law and issued a construction which is broader than the ordinary and customary meaning.

Patent Owner requests reconsideration of the Board’s Decision of the claim construction of the term “playlist” and resultant grant of review of claims 10–12 of the ’099 patent.

II. STANDARD OF REVIEW

Under 37 C.F.R. § 42.71(c), “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” “An abuse of discretion

occurs where the decision is based on an erroneous interpretation of the law, on factual findings that are not supported by substantial evidence, or represents an unreasonable judgment in weighing relevant factors.” *Gose v. United States Postal Service*, 451 F.3d 831, 836 (Fed. Cir. 2006) (internal quotations omitted); *see also O’Keefe v. U.S. Postal Service*, 318 F.3d 1310, 1314 (Fed. Cir. 2002) (“The Board necessarily abuses its discretion when it rests its decision on factual findings unsupported by substantial evidence.”) (internal quotations omitted).

III. BASIS FOR RELIEF REQUESTED

A. The Board Erred In The Application Of The Law Governing the Broadest Reasonable Interpretation

“In an *inter partes* review, the Board interprets claim terms in an unexpired patent according to the broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b). Under that standard, and absent any special definitions, we give claim terms their ordinary and customary meaning, as would be understood by one of ordinary skill in the art at the time of the invention.” *Endo Pharmaceuticals Inc. v. Depomed, Inc.*, IPR2014-00656 (Paper 12 at 6) (September 29, 2014) citing *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Under the broadest reasonable construction standard, there is “a ‘heavy presumption’ that a claim term carries its ordinary and customary meaning.” *Macronix International Co., Ltd., et al. v. Spansion LLC*,

IPR2014-00106 (Paper 13 at 6) (April 24, 2014), citing *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002). Patent Owner respectfully submits that the Board reached an erroneous conclusion of law when it overlooked the evidence of record on the ordinary and customary meaning of the term “playlist” and enlarged the scope of the term beyond the ordinary and customary meaning.

The Board’s construction of the term “playlist” to mean “a list of media selections” (Decision at 10) is in error because such construction is broader than the ordinary and customary meaning of the term. Petitioner submitted no evidence and did not otherwise endeavor to show the ordinary and customary meaning of this term. *See* Petition (Paper 1) at 5-6. As the Board explained in *American Express Company, et al. v. Metasearch Systems, LLC*, CBM2014-00001 (March 20, 2014):

To act as its own lexicographer, a patentee must “clearly set forth a definition of the disputed claim term” other than its plain and ordinary meaning. It is not enough for a patentee to simply disclose a single embodiment or use a word in the same manner in all embodiments, the patentee must “clearly express an intent” to redefine the term.

CBM2014-00001 (Paper 29 at 10) citing *Thorner v. Sony Computer Entm’t. Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir.2012) (citations omitted). It is undisputed that

the inventor of the '099 patent did not set forth any special definition for the term "playlist." Absent any special definition and consistent with the broadest reasonable construction standard, the term "playlist" should be given its ordinary and customary meaning, as would be understood by one of ordinary skill in the art at the time of the invention. *Endo Pharmaceuticals Inc.*, IPR2014-00656 (Paper 12 at 6).

Patent Owner submitted evidence from a related prior *inter partes* review proceeding (IPR2013-00597) involving the '099 patent in the form of an expert declaration (which relied on testimony of another petitioner's expert witness) and prior art, establishing that the ordinary and customary meaning of the term "playlist" is "a list referencing media items arranged to be played in a sequence" and not simply "a list of media selections." *See* Preliminary Response (Paper 6) at 9, 17-27; Ex. 2007 at ¶¶ 42, 44-46, 48, 54, 58; and Ex. 2009.

Based on the evidence submitted, the ordinary and customary meaning of the term playlist is "a list referencing media items arranged to be played in a sequence." The Board appears to have misapprehended the fact that the specification of the '099 patent is consistent with the ordinary and customary meaning of the term "playlist" as, according to the '099 patent, "[p]laylists also facilitate the playing of a plurality of selections in a particular order." Ex. 1001 at 1:48-50. To that end, the '099 specification references the Windows Media Player

as a media playing program that offers the capability for a user to compile a playlist. *See* Ex. 1001 at 1:33-42; Prelim. Response (Paper 6) at 18-19. The Patent Owner submitted evidence in the form of Ex. 2007 (Declaration by Dr. Loy) and Ex. 2009 (Windows Media Player 7 Handbook) that establish that the ordinary and customary meaning of the term “playlist” is a list of media items that are arranged to be played in a sequence. *See* Prelim. Response (Paper 6) at 18-20.

The ‘099 patent further describes that “the playlist may be compiled in an order in which the playing of selections therefrom is desired,” that the “selections may then be automatically played sequentially from the playlist,” or that “the selections may be played randomly from a playlist.” Ex. 1001 at 1:45-52, 1:54-56, 1:64-2:2, 10:61-63; *see also* Prelim. Response (Paper 6) at 23-26. The ability of a user to play selections from a playlist sequentially, in random order, or in any order desired as described in the ‘099 patent is consistent with the foundational principle of the playlist itself: namely, that *ab origine* the items in a playlist – including in the context of the ‘099 patent – are arranged in a certain order to be played in a sequence unless and until the user changes the order in which the original list of items is to be played. *See* Ex. 2006 at ¶¶ 42, 44, 46, 48, 54, 58; Ex. 2009 at 40. Thus, the construction proposed by Patent Owner is not too narrow and does not exclude any embodiment described in the ‘099 specification, but is consistent with the ordinary and customary meaning as supported by the evidence of record.

Given a proper construction of “playlist” consistent with its customary and ordinary meaning, neither Bi alone nor the combination of Bi, Champion, and Encarnacion render claims 10–12 of the ‘099 patent invalid at least because they fail to teach “playlists” as required by the challenged claims for the reasons set forth in detail in the Preliminary Response (Paper 6) at 43-55.

IV. CONCLUSION

For all the reasons stated above, Patent Owner respectfully requests that the Board construe “playlist” as “a list referencing media items arranged to be played in a sequence,” and to deny review of claims 10–12 of the ‘099 patent.

Dated: November 18, 2014

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on November 18, 2014, a true and accurate copy of this paper, PATENT OWNER'S REQUEST FOR REHEARING ON THE INSTITUTION DECISION PURSUANT TO 37 C.F.R. §42.71, was served on the following counsel for Petitioner via email:

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