

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,
Petitioner,

v.

BLACK HILLS MEDIA, LLC,
Patent Owner.

Case IPR2014-00718
Patent 7,835,689 B2

Before BRIAN J. McNAMARA, DAVID C. McKONE, and
TINA E. HULSE, *Administrative Patent Judges*.

HULSE, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

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 9 and 10 of U.S. Patent No. 7,835,689 B2 (Ex. 1001, “the ’689 patent”). Paper 1 (“Pet.”). Black Hills Media, LLC (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 7 (“Prelim. Resp.”). We granted the Petition as to claims 9 and 10 of the ’689 patent, and instituted trial on three asserted grounds of unpatentability. Paper 11 (“Dec. Inst.”), 18.

After institution of trial, Patent Owner filed a Motion to Amend, requesting the cancellation of all claims involved in this *inter partes* review proceeding (i.e., claims 9 and 10 of the ’689 patent). Paper 20, 1. Petitioner did not file an opposition to Patent Owner’s Motion to Amend.

The Board has jurisdiction under 35 U.S.C. § 6(c). This Decision is a final written decision under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

Patent Owner’s Motion to Amend requesting cancellation of claims 9 and 10 is *granted*.

A. *Related Proceedings*

Petitioner states that the ’689 patent is currently the subject of a copending district court case against Petitioner captioned, *Black Hills Media, LLC v. Samsung Electronics Co., Ltd.*, No. 2-13-cv-00379 (E.D. Tex.). Pet. 1; *see also* Paper 6, at 2.

Petitioner also filed a petition for *inter partes* review of certain claims of related U.S. Patent No. 7,917,082 B2. IPR2014-00721, Paper 1. We instituted trial in that proceeding. *Id.* (Paper 10). Patent Owner has filed a motion to amend canceling all involved claims in that proceeding, as well. *Id.* (Paper 19).

B. Grounds of Unpatentability Instituted for Trial

We instituted trial based on the following grounds of unpatentability:

References	Basis	Claims Challenged
Yeager ¹ and P2P Networking ²	§ 103	9 and 10
Busam ³ and Phillips ⁴	§ 103	9 and 10
Abecassis ⁵ and Ganesan ⁶	§ 103	9 and 10

II. MOTION TO AMEND

In its Motion to Amend, Patent Owner seeks to cancel both claims 9 and 10, which are the only claims subject to this proceeding.⁷ Paper 20, 1. Petitioner did not file an opposition to Patent Owner's Motion to Amend. Accordingly, Patent Owner's Motion to Amend canceling claims 9 and 10 of the '689 patent is *granted*.

¹ Yeager et al., US 7,383,433 B2, issued June 3, 2008 (Ex. 1003).

² Parameswaran et al., *P2P Networking: An Information-Sharing Alternative*, 34 COMPUTER 31–38 (July 2001) (Ex. 1005).

³ Busam et al., US 2002/0087887 A1, published July 4, 2002 (Ex. 1006).

⁴ Phillips et al., US 7,058,696 B1, issued June 6, 2006 (Ex. 1007).

⁵ Abecassis, US 6,192,340 B1, issued Feb. 20, 2001 (Ex. 1008).

⁶ Ganesan, US 5,535,276, issued July 9, 1996 (Ex. 1009).

⁷ We note that Patent Owner did not request a conference call with the Board before filing its Motion to Amend, as required by 37 C.F.R. § 42.121(a). Under the circumstances of this case, we exercise our discretion and determine that it is appropriate to waive the requirements of this rule. *See* 37 C.F.R. § 42.5(b).

Pursuant to 37 C.F.R. § 42.73(b), a party may request judgment against itself at any time during a proceeding. We construe the cancellation of claims such that the patent owner has no remaining claim in the trial to be a request for adverse judgment. *See* 37 C.F.R. § 42.73(b)(2). Here, Patent Owner requests cancellation of all claims of the '689 patent on which a trial was instituted, such that Patent Owner would have no remaining claim in the trial. Thus, it is appropriate to enter judgment at this time.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's Motion to Amend requesting cancellation of claims 9 and 10 of the '689 patent is treated as a request for adverse judgment and is *granted*;

FURTHER ORDERED that judgment is entered against Patent Owner with respect to claims 9 and 10 of the '689 patent; and

FURTHER ORDERED that because this is a Final Decision, parties to the proceeding seeking judicial review of the Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2014-00718
Patent 7,835,689 B2

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