

Filed on Behalf of Black Hills Media, LLC

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAMSUNG ELECTRONICS CO., LTD.;  
SAMSUNG ELECTRONICS AMERICA, INC.; and  
SAMSUNG TELECOMMUNICATIONS AMERICA, LLC

Petitioner

v.

BLACK HILLS MEDIA, LLC  
Patent Owner

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Case IPR2014-00718

Patent 7,835,689

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**PRELIMINARY RESPONSE BY  
PATENT OWNER UNDER 37 C.F.R. § 42.107**

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Pursuant to 37 C.F.R. § 42.107, Patent Owner Black Hills Media, LLC (hereinafter “Patent Owner”) hereby respectfully submits this Preliminary Response to the Petition (hereinafter “the Petition”) filed by Samsung Electronics Co. Ltd.; Samsung Electronics America, Inc.; and Samsung Telecommunications America, LLC (hereinafter “Petitioner”) for *inter partes* review of claims 9 and 10 of U.S. Patent No. 7,835,689 (hereinafter “the ’689 Patent”). This filing is timely under 35 U.S.C. § 313, and 37 C.F.R. § 42.107, as it is being filed within three months of the May 7, 2014 mailing date of the Notice granting the filing date of the Petition (Paper 4).

## **I. INTRODUCTION**

“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 . . . 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.” 35 U.S.C. § 314(a). Because a patent owner is precluded from filing new testimonial evidence to support a preliminary response to a petition for *inter partes* review, Patent Owner is unable to submit a declaration from an expert in the art to assist in the Board’s understanding of the ’689 Patent and the cited references. 37 CFR § 42.107(c). As such, Patent Owner declines to present through this

Preliminary Response substantive arguments regarding the technology of the '689 Patent and the disclosures of the cited references. If the Board does institute trial with respect to any claim challenged in the Petition, Patent Owner reserves the right to present any arguments through a Patent Owner response under 37 C.F.R. § 42.120 and to submit any admissible evidence in support thereof. Patent Owner's election to reserve its substantive arguments regarding the technology of the '689 Patent and the cited references should not lead to any adverse inferences by the Board.

## **II. GROUNDS II AND III ARE REDUNDANT OVER GROUND I**

The Board should not institute *inter partes* review for a ground that is redundant over another ground. *Liberty Mutual Insurance Co. v. Progressive Casualty Insurance Co.*, CBM2012-00003, Paper 7, at 2 (Oct. 25, 2012) (“[M]ultiple grounds, which are presented in a redundant manner by a petitioner who makes no meaningful distinction between them, are . . . not all entitled to consideration.”). When advancing alternative grounds, a petitioner should “articulate a meaningful distinction in terms of relative strengths and weaknesses with respect to application of the prior art disclosures to one or more claim limitations.” *Oracle Corp. v. Clouding IP, LLC*, IPR2013-00088, Paper 13, at 3 (June 13, 2013) (*emphasis added*).

In the present case, Petitioner alleges that claims 9 and 10 are invalid under three asserted grounds. However, the Petition is devoid of any explanation as to why three different grounds are warranted to challenge two claims of the '689 Patent. Petitioner provides no discussion of the weaknesses or even the strengths pertaining to each ground relative to the other grounds. Because Petitioner has failed to establish its burden of demonstrating why Grounds II and III are not redundant over Ground I, *inter partes* review of the '689 Patent should not be instituted on at least grounds II and III.

**III. PATENT OWNER RESERVES THE RIGHT TO SEEK  
ADDITIONAL DISCOVERY CONCERNING WHETHER  
PETITIONER FAILED TO IDENTIFY ALL PARTIES IN  
INTEREST**

Petitioner is challenging patents owned by Patent Owner through the following additional *inter partes* review proceedings: IPR2014-00709, IPR2014-00711, IPR2014-00717, IPR2014-00718, IPR2014-00721, IPR2014-00723, IPR2014-00735, IPR2014-00737, and IPR2014-00740. In several of these *inter partes* review proceedings, Patent Owner is seeking additional discovery concerning whether Petitioner should have identified Google, Inc. as a real party in interest in those proceedings. The additional discovery being sought relates to a recently discovered Mobile Application Distribution Agreement (MADA) between Google, Inc. and Petitioner. The MADA includes an indemnification provision

that explicitly states that Google, if notified of an indemnification provision claim covered by the MADA, will defend any third party claim that Google's applications infringe any intellectual property right. The MADA further states that Google has "full control and authority over the defense" as part of its obligations to defend Petitioner.

Patent Owner has previously made patent infringement claims with respect to several of the patents in the above-identified *inter partes* review proceedings that pertain to devices sold by Petitioner that include Google applications covered by the MADA during the effective period of the MADA. These patent infringement claims appear to enable Petitioner to invoke the indemnification provisions of the MADA, such that Google in addition to Petitioner is a party that desires review of at least some of the patents in the above-identified *inter partes* review proceedings.

If additional facts are discovered that show beyond speculation that Google or any other party should have been named as a real party in interest in this proceeding, Patent Owner reserves the right to seek additional discovery and to move to terminate this proceeding, if so warranted. *See* 35 U.S.C. § 312(a)(2) ("A petition filed under 311 may be considered only if . . . the petition identifies all real parties in interest.").

## **CERTIFICATE OF SERVICE**

In accordance with 37 C.F.R. §§ 42.6(e) and 42.107, the undersigned certifies that on the 7th day of August, 2014, a complete and entire copy of the PRELIMINARY RESPONSE BY PATENT OWNER UNDER 37 C.F.R. § 42.107 (“Preliminary Response”) including any exhibits relied upon were served on counsel of record for Petitioner at the correspondence address as follows,

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via Federal Express No. 8019-4601-2189, postage prepaid because this is likely to effect service.

**THOMAS | HORSTEMEYER, LLP**

/N. Andrew Crain/  
N. Andrew Crain (Reg. No. 45,442)  
Lead Counsel for Patent Owner

August 7, 2014

Date