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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 No. IPR2014-00740
Patent 8,045,952

PATENT OWNER'S REQUEST FOR REHEARING

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Mobile Application Distribution Agreement between Samsung and Google	2001
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)	2002
Google's Motion to Intervene filed in ITC Inv. No. 337-TA-882	2003
Initial Determination in ITC Inv. No. 337-TA-882, Order No. 17, Granting Google Inc.'s Motion to Intervene	2004
Claim Chart filed in ITC Inv. No. 337-TA-882 as Exhibit 97 to Original Complaint	2005
Redacted Claim Chart supplied in ITC Inv. No. 337-TA-882	2006
Declaration of Ivan Zatkovich (filed in IPR2013-00593 as Exhibit 2012)	2007
TerraTec M3PO High Quality Audio Decoder Manual (May 18, 2000)	2008
Siren Juken Operating Manual (2000)	2009
Microsoft Windows Media Player 7 Handbook, Ch. 2 (October 4, 2000)	2010
Public Version of Initial Determination in ITC Inv. No. 337-TA-882, issued July 7, 2014	2011
Declaration of Ivan Zatkovich (filed in ITC Proceeding 337-TA-882)	2012

PATENT OWNER REQUEST FOR REHEARING

Pursuant to 37 C.F.R. § 42.71(d), Black Hills Media, LLC (“Patent Owner”) hereby submits this Request for Rehearing in response to the Decision, Institution of *Inter Partes* Review of U.S. Patent No. 8,045,952 (Paper No. 7, “Decision”).

I. INTRODUCTION

In the Decision, the Board granted review of claims 1-3, 9, 10, and 14 of U.S. Patent No. 8,045,952 (the ’952 Patent) as being anticipated by or obvious over U.S. Patent No. 6,502,194 of Berman *et al.* (Ex. 1003, “Berman”) based on the Decision’s construction of the claim limitation “playlist.”

The Board construed the term “playlist” to mean “a list of audio files.” Paper 6 at 10. It is respectfully submitted that the Board reached an erroneous conclusion of law and overlooked the substantial evidence of record as to the ordinary and customary meaning of the term “playlist.” As a result, the Board issued a construction that is broader than the ordinary and customary meaning.

Patent Owner respectfully requests that the Board reconsider its decision with regard to claim construction and resultant grant of review of claims 1-3, 9, 10, and 14 of the ’952 Patent with respect to Berman.

II. LEGAL STANDARDS

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. ARGUMENT

Patent Owner respectfully submits that the Board applied an erroneous legal standard as to claim construction and overlooked substantial evidence of record as to the ordinary and customary meaning of the term “playlist” to enlarge the scope of the term beyond the ordinary and customary meaning. The Board improperly focused on the ’952 Patent’s description of one aspect of “playlist 1528” as providing a comprehensive definition of the term “playlist,” while substantially ignoring the extensive evidence proffered by Patent Owner as to the “ordinary and customary” meaning of the term to a person having ordinary skill in the art at the time of the invention. Moreover, the Board misapprehended Patent Owner’s arguments and improperly relied upon Patent Owner’s purported “acknowledgement” that the ’952 Patent describes an embodiment in which the playlist does not require that the items are arranged to be played in a sequence.

**A. Because Patentee Did Not Act As Its Own Lexicographer
“Playlist” Should Be Construed According To Its Ordinary
And Customary Meaning**

Though the Decision indicated that “[u]nder the broadest reasonable construction standard, claim terms are given their ordinary and customary meaning in light of the specification in which they appear,” Paper 7 at 8, this was not the standard applied by the Board in interpreting the meaning of the term “playlist.”

Despite Patent Owner’s arguments asserting that the plain and ordinary meaning should control (Paper 6 at pp. 17-28), the Board did not scrutinize the ordinary and customary meaning of the term as required under the applicable claim construction standard. Rather, the Board improperly focused on only *one aspect* of the playlists described in the ’952 Patent to provide a definition of the term. Indeed, the Board erroneously concluded that, other than construing the term to mean “a list of audio files” that “may or may not include URLs,” it was *not* required to address the full scope of the meaning of the term to a person having ordinary skill in the art: “[a]ny other aspects of ‘playlist’ need not be construed expressly for purposes of this decision.” Paper 7 at 10.

Absent a “special definition” provided by a patentee, limiting claim construction analysis to only certain “aspects” of a claim term described in the specification is erroneous as a matter of law. Indeed, the Board has previously held that “[t]here is a ‘heavy presumption’ that a claim term carries its ordinary

and customary meaning.” *Universal Remote Control, Inc. v. Universal Electronics, Inc.*, IPR2013-00152 (Paper 8, Aug. 19, 2013) (quoting *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366. (Fed. Cir. 2002)). “[T]here are only two exceptions to this general rule: 1) when a patentee sets out a definition and acts as his own lexicographer, or 2) when the patentee disavows the full scope of a claim term either in the specification or during prosecution.” *Thorner v. Sony Computer Entm’t Am., LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012). Moreover, “[a]ny special definitions for claim terms must be set forth with reasonable clarity, deliberateness, and precision.” *Endo Pharmaceutical, Inc. v. Depomed, Inc.*, IPR2014-00656 (Paper 12 at 6) (citing *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994)).

There is no indication in the Decision that the Board determined that the cited passage of the ’952 Patent defined the term “playlist” with sufficient “clarity, deliberateness, and precision” to overcome the heavy presumption that this term receive its ordinary and customary meaning. As such, the Board’s determination that its construction of “playlist” is “consistent with” certain aspects of the specification and that “[a]ny other aspects of ‘playlist’ need not be construed expressly for purposes of this decision” is based on an erroneous legal standard.

Rather, Patent Owner respectfully submits that the term “playlist” should be construed according to its ordinary and customary meaning to mean a list of media

items *arranged to be played in a sequence* (i.e., as a group, without having to select individual songs for playback), as supported by the substantial weight of the evidence of record.

B. The Board Overlooked Substantial Evidence Of Plain And Ordinary Meaning Of “Playlist”

“An abuse of discretion occurs where the decision is based on . . . factual findings that are not supported by substantial evidence” *Gose*, 451 F.3d at 836 (internal quotations omitted). *See also O’Keefe*, 318 F.3d at 1314.

In this proceeding, the Board erred in concluding that “[b]ased on the current record, we are not persuaded by Patent Owner’s argument that the broadest reasonable construction of ‘playlist’ requires arrangement of items ‘to be played in a sequence.’” Paper 6 at 9 (emphasis added). Patent Owner did not rely on attorney argument alone, but instead submitted expert testimony and contemporaneous publications that evidence the ordinary and customary meaning of the term “playlist” to a person having ordinary skill in the art. Accordingly, Patent Owner respectfully requests rehearing of the construction of “playlist” adopted in the Decision at least because the construction is contrary to the extensive evidence proffered by the Patent Owner.

Moreover, the Board’s construction of the term “playlist” is unsupported by any substantial evidence as to the “ordinary and customary” meaning of the term to a person having ordinary skill in the art. Indeed, the Board did not scrutinize the

ordinary and customary meaning and instead focused on only one aspect of the term as used in the '952 Patent to provide an allegedly comprehensive definition of the term "playlist." *See supra* III(A) and *infra* III(C). Petitioner provided no evidence as to the ordinary and customary meaning of the term "playlist." Simply, Patent Owner is the only party that has produced any substantial evidence as to the ordinary and customary meaning of "playlist."

As stated in Patent Owner's Preliminary Response (*see* Paper 6 at pp. 16-17), beyond the correction to the previous preliminary decision's choice of verb tense, neither the Petition nor the Petitioner's declarant provides any substantive analysis or evidence as to the ordinary and customary meaning of the term "playlist" to a person having ordinary skill in the art, let alone confirm or deny one whether Petitioner or Petitioner's declarant otherwise believes that the preliminary construction in IPR2013-00593 is correct. *See* Paper 6 at 17 ("Tellingly, the Petitioner's declarant avoids confirming his agreement with the Board's preliminary construction in IPR2013-00593, and also does not provide any analysis as to how a person of ordinary skill in the art would understand the term "playlist" based on the remainder of the specification of the '952 Patent."); *see also* Ex. 1011 at ¶29. Rather, Petitioner's proffered construction of the term "playlist" was based upon the preliminary findings by the Board in IPR2013-00593. Paper 1 at 5 ("Petitioner submits that, for the purposes of the present proceeding, these

constructions should apply to the meaning of these terms in the current Petition, as well including URLs of where the audio files *can be* retrieved from within the scope of the type of items in a ‘playlist.’” (emphasis original)).¹

Moreover, the preliminary construction of “playlist” in IPR2013-00593 was made without the benefit of any testimonial evidence presented on behalf of the Patent Owner. However, in the present proceeding, Patent Owner’s Preliminary Response and the exhibits cited therein provide substantial evidence on this issue. See Paper 6, pp. 17-28, the Zatkovich Declaration (Ex. 2007, *see e.g.*, ¶¶ 71-77), the *TerraTec M3PO High Quality Audio Decoder Manual* dated May 18, 2000 (Ex. 2008), the SIREN™ Jukebox operator’s manual published in 2000 (Ex. 2009), and the *Microsoft Windows Media™ Player 7 Handbook*, published October 4, 2000 (Ex. 2010), which all support the conclusion that a person of ordinary skill in the art at the time of the invention would have understood the plain and ordinary

¹ Even if the statement that “Petitioner submits that, for the purposes of the present proceeding, these constructions should apply to the meanings of these terms in the current Petition” could be interpreted as Petitioner’s assertion that the Board’s previous preliminary construction was correct, the rules of *inter partes* review prohibit Petitioner from incorporating by reference any of the reasoning provided in the previous decision. See 37 C.F.R. § 42.6(a)(3).

meaning of “playlist” to denote a *list referencing media items arranged to be played in a sequence*.

Although Petitioner’s declarant did not speak substantively as to the propriety of the Board’s preliminary construction in IPR2013-00593, Dr. Jeffay does provide testimony regarding the state of the art that fully supports Patent Owner’s contention that a person of ordinary skill in the art would have understood that items of a playlist are arranged to be played in a sequence (*i.e.*, as a group, without having to select individual songs for playback). For example, Dr. Jeffay cites to U.S. Patent No. 5,168,481 of Culbertson *et al.* (Ex. 1013) and notes:

For example, Exhibit 1013 shows that in the context of radio broadcast stations, it was known to compile a *scheduled* playlist from various music selections and pre-recorded materials having known durations or runtimes. *See, e.g.*, Ex. 1013, 1:15-18. Culbertson sought to provide “*an automated digital broadcast system which is capable of reliable operation for long periods of time without human assistance.*” *See, e.g., id.* 1:44-51. In one embodiment, Culbertson describes using compact disc players to “*sequentially play a predetermined list* of musical selections and commercial or informational messages.” *See, e.g., id.* 1:50-51... Culbertson further disclosed that *audio playback of the musical selections from the playlist could be started and stopped according to a schedule.* *See id.* 1:53-60.

Ex. 1011 at ¶19 (emphasis added).

That the passages of Ex. 1013 that are relied upon by Dr. Jeffay fully

support Patent Owner's construction is made clear when compared to the extensive evidence presented by the Patent Owner in its Preliminary Response (*see e.g.*, Paper 6 at 17-21(citing Ex. 2007 at ¶¶54-59,73; Ex. 2008 at pp. 10, 20; Ex. 2009 at pp. 41, 43, 45; Ex. 2010 at pp. 40,49). For example, in its Preliminary Response, Patent Owner cited to various portions of an exemplary contemporaneous publication (Ex. 2008), which describes a "playlist" in a nearly identical manner relative to the playlist described in Ex. 1013 that is cited by Dr. Jeffay:

Additionally, the *TerraTec M3PO High Quality Audio Decoder Manual* dated May 18, 2000 ("*TerraTec Manual*"), provides that "[t]he playlist is a pre-selected sequence of titles you wish the m3po to play." (Ex. 2008, p. 10). "In DJ mode, you can pre-select titles, which will then be played in the sequence you selected them, basically, it is a mini-playlist (up to 10 titles), i.e. in case you need to go and get some more drinks, or are involved in a chit-chat you wish would never end.... Playback of the selected song starts automatically after the current one." (Ex. 2008, p. 20 (emphasis added)).

Paper 6 at 18 (underlining added).

Thus, in one example, the passage of Ex. 1013 relied upon by Dr. Jeffay discloses an "automated digital broadcast system which is capable of reliable operation for long periods of time without human assistance," whereas Ex. 2008 indicates that pre-selected titles "will then be played in the sequence you selected

them, basically, it is a mini-playlist (up to 10 titles), i.e. in case you need to go and get some more drinks, or are involved in a chit-chat you wish would never end . . .”

Each of these references and the remainder of the evidence in this proceeding support the notion that items of a playlist are arranged to be played in a sequence (*i.e.*, sequentially as a group, one after another, without having to select individual songs for playback), with no argument or evidence from the Petitioner to the contrary. Accordingly, Patent Owner respectfully requests rehearing of the construction of “playlist” that was adopted in the Decision because the Board’s construction is both unsupported by substantial evidence, and contrary to the evidence before the Board.

C. Patent Owner Did Not Acknowledge That Playlist 1528 Is Not Arranged To Be Played In A Sequence

The Decision misapprehends Patent Owner’s argument with respect to playlist 1528. The Decision states:

Indeed, as Patent Owner acknowledges, the Specification describes the contents of playlist 1528, but does not disclose a sequence or arrangement of the playlist contents. Prelim. Resp. 26. Thus, we determine that the broadest reasonable construction of “playlist” does not require that the playlist items are arranged to be played in a sequence.

Paper 7 at 10 (emphasis added).

Patent Owner submits that any perceived “acknowledgement” of the notion

that playlist 1528 is not arranged to be played in a sequence is based on a misunderstanding of Patent Owner's argument. At pages 26-27 of the Preliminary Response (Paper 6, emphasis original), Patent Owner asserted:

The passage relied upon by the Board describes only a single aspect of one embodiment of a "playlist" in accordance with the '952 Patent. This particular passage, however, speaks to the *contents* of one particular playlist (i.e., playlist (1528)), and not to the *arrangement* of the contents of the playlist. Nor does the passage relied upon by the Board suggest any express intent by the inventor to diverge from the customary definition of playlist as being a list of media items "arranged to be played in a sequence." *See Teleflex, Inc. v. Ficosa North America Corp.*, 299 F. 3d 1313,1325 (Fed. Cir. 2002) ("In the absence of an express intent to impart a novel meaning to claim terms, an inventor's claim terms take on their ordinary meaning."). . . The '952 Patent uses the term "playlist" to refer to a list referencing media items *arranged to be played in a sequence* consistent with its plain and ordinary meaning.

The first and second sentences of the passage of the Preliminary Response reproduced above do not concede that playlist 1528 is not arranged to be played in a sequence. Rather, Patent Owner's unambiguous argument was that the passage of the '952 Patent relied upon by the Board in IPR2013-00593 describes only one aspect of the playlist 1528. That is, the cited passage of the '952 Patent does not attempt to provide a comprehensive definition of a playlist, and certainly does not *negate* the fundamental characteristic that playlist 1528 is arranged to be played in

a sequence. Indeed, the third and fourth sentences from the Patent Owner's Preliminary Response reproduced directly above (as well as the other evidence proffered by the Patent Owner) make clear that one of ordinary skill in the art would understand that a playlist is arranged to be played in a sequence.

Specifically, the '952 Patent states:

FIG. 17B illustrates the display of an audio player window 1792.... The user can click the shuffle button 1796 to "randomize" the playlist as opposed to playing the playlist in the same order. Further, the user can press the repeat button 1798 in order to have continuous play as opposed to the playlist stopping when it runs out of songs to play. The playlists will typically start from the beginning.

Ex. 1001, col. 24, lines 31-43.

The cited passage of the '952 Patent makes it clear that playlists will either stop when they run out of songs or continuously loop if "continuous play" is chosen. "That is, playing of items in a playlist occurs in a sequence and does not require a user to manually select the next song to play when the current song ends." Paper 6 at 27. Further, though playlists "typically start from the beginning," a "shuffle button" permits a user to "randomize" the playlist, and one having ordinary skill in the art would appreciate that these features would have no purpose unless the playlist has an original order of play. *See* Ex. 2007, ¶¶60-62.

Patent Owner additionally submits that the Board misapprehends Patent Owner's statements regarding the playlist being a list of media items "arranged to

be *played in a sequence*” in concluding that “we are not persuaded the description of audio player window 1792 requires the items in playlist 1528 are arranged to be played in a particular manner such as a sequence.” As made clear throughout the Preliminary Response, the phrase “played in a sequence” refers to the fundamental characteristic that items of a playlist are *played as a group* (i.e., in succession one after another). That this is both Patent Owner’s construction and the ordinary and customary meaning to a person having ordinary skill in the art is made clear in the Preliminary Response and the exhibits, including in Zatkovich Declaration originally submitted in IPR2013-00593 (Ex. 2007). *See, e.g.*, Paper 6 at 20 (“These exemplary publications also indicate that the term ‘playlist’ denotes that the media items (e.g., songs) are *arranged to be played in a sequence (i.e., as a group, without having to select individual songs for playback)*.” (italics original, underline added)); Paper 6 at 26 (Construction of “the term without any indication that the items are to be played sequentially...is inconsistent with the customary meaning of the term ‘playlist’ and with the specification of the ’952 Patent, as a whole.”); Ex. 2007 at ¶55 (“Based upon my relevant experience in industry, ‘playlist’ is a term that is generally recognized in the media file sharing arts to mean *a list* referencing media items that is arranged to be played in a sequence, i.e., a list of media items that has been created to be played sequentially, one after another” (underline added)); Ex. 2007 at ¶57 (“Moreover, each of the above

exemplary references is consistent with the understanding by a person having ordinary skill in the art in 2000 that the term ‘playlist’ denoted that the media items were to be played in a sequence one after another (i.e., as a group, without having to select individual songs for playback)” (underline added)); Ex. 2007 at ¶58 (“In common parlance at the time of the ‘952 Patent, the term ‘playlist’ denoted a list of media items (e.g., songs) to be played in a sequence, one after another as a group, without having to select individual songs for playback. Indeed, the two parts of the word itself make the meaning of the term self-evident: ‘play’ and ‘list.’ In all cases, the operative function is ‘play,’ which means the songs will be played as a group, not individually.” (underline added)).

Thus, far from acknowledging that playlists are merely “lists of audio files,” the specification itself, expert testimony, contemporaneous references, and the Patent Owner’s Preliminary Response all support the conclusion that the term “playlist” as used in the ’952 Patent had a plain and ordinary meaning, namely “a list of media files arranged to be *played in a sequence.*”

D. The Board’s Incorrect Construction Of “Playlist” Led The Board To Err In Its Decision To Institute

The Decision states at page 14:

As discussed above, the broadest reasonable construction of “playlist” consistent with the Specification of the ’952 patent is “a list of audio files.” *See supra* Claim Construction. For the purposes of this

decision, we determine Berman's song list satisfies this limitation. Moreover, we are not persuaded by Patent Owner's assertions that the songs in Berman's song list are not *played back* or played in a sequence. *See* Prelim. Resp. 37, 39. This position relies on Patent Owner's constructions of "playlist," which we have not adopted.

Under a proper construction of "playlist" as proposed herein and in the Preliminary Response, Berman does not anticipate claims 9, 10, or 14, and does not render obvious claims 1-3 at least because Berman's playback unit (100) cannot receive a "playlist" from the DUL server (107) because the DUL server (107) does not provide a "playlist." *See* Paper 6 at 36-44.

IV. CONCLUSION

For 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 deny of institution of claims 1-3, 9, 10, and 14 with respect to Berman.

Dated: November 18, 2014

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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, were served on the following counsel for Petitioner via email:

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