

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 IPR2014-00737
Patent 8,050,652 B2
Case IPR2014-00740
Patent 8,045,952 B2¹

Before BRIAN J. McNAMARA, FRANCES L. IPPOLITO, and
TINA E. HULSE, *Administrative Patent Judges*

McNAMARA, *Administrative Patent Judge*.

INITIAL CONFERENCE SUMMARY
Conduct of the Proceeding
37C.F.R. § 42.5

¹ This Order addresses issues that are identical in related cases. Therefore, we exercise our discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style heading in any subsequent papers.

A consolidated initial conference in the following nine related proceedings (the “Related Proceedings”) was conducted on November 20, 2014: IPR2014-00709, IPR2014-00711, IPR2014-00717, IPR2014-00718, IPR2014-00721, IPR2014-00723, IPR2014-00735, IPR2014-00737, IPR2014-00740. Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC (collectively, “Petitioner”) was represented by lead counsel, Andrea Reister, and back-up counsel, Gregory Discher. In IPR2014-00737 and IPR2014-00740 (the “Subject Proceedings”), Black Hills Media, LLC (“Patent Owner”) was represented by lead counsel, Thomas Engellenner, and back-up counsel, Reza Mollaaghababa. The following subjects were discussed during the conference:

Related Matters

Patent Owner advised that none of the patents that are the subject of the Related Proceedings is involved in a reexamination proceeding. The parties reported that all related litigation has been stayed.

Scheduling Order

We deferred issuing a Scheduling Order with the Decision to Institute in each of the Related Proceedings in order to provide the parties an opportunity to discuss with the Board how to coordinate oral hearings. Due to the extensive overlap of issues in the proceedings, the oral hearings in the Related Proceedings will be consolidated in the following manner: IPR2014-00709, -00711 and -00723 will be heard together; IPR2014-00737 and -00740 will be heard together; IPR2014-00718 and -00721 will be heard together; IPR2014-00717 and IPR-00735 will be heard separately. The above consolidation is subject to change as issues develop and the Board deems appropriate. During the conference call, the parties agreed that the oral hearings in these proceedings will be scheduled to take place

on July 27 and July 28, 2015. We will enter an appropriate Scheduling Order in each proceeding.

The parties are reminded that, without obtaining prior authorization from the Board, they may stipulate to different dates for DATES 1-5, as provided in the Scheduling Order, by filing an appropriate notice with the Board. The parties may not stipulate to any other changes to the Scheduling Order.

Protective Order

The parties have not discussed a protective order at this time. No protective order has been entered in this proceeding. The parties are reminded of the requirement for a protective order when filing a motion to seal. 37 C.F.R. § 42.54. If the parties have agreed to a proposed protective order, including the Standing Default Protective Order, 77 Fed. Reg. 48756, App. B (Aug 14, 2012), they should file a signed copy of the proposed protective order with the motion to seal. If the parties propose a protective order other than or departing from the default Standing Protective Order, Office Trial Practice Guide, *id.*, they must submit a joint, proposed protective order, accompanied by a red-lined version based on the default Standing Protective Order in Appendix B to the Board's Office Patent Trial Practice Guide. *See, id.* at 48769.

We also remind the parties of the expectation that confidential information relied upon or identified in a final written decision will be made public. *Id.* at 48760. Confidential information that is subject to a protective order ordinarily becomes public 45 days after denial of a petition to institute or 45 after final judgment in a trial. *Id.* at 48761. A party seeking to maintain the confidentiality of the information may file a motion to expunge the information from the record prior to the information becoming public. 37 C.F.R. § 42.56.

Initial Disclosures and Discovery

The parties have not stipulated to any initial disclosures at this time. The parties are reminded of the discovery provisions of 37 C.F.R. §§ 42.51-52 and Office Trial Practice Guide. *See* 77 Fed. Reg. at 48761-2. Discovery requests and objections are not to be filed with the Board without prior authorization. If the parties are unable to resolve discovery issues between them, the parties may request a conference with the Board. A motion to exclude, which does not require Board authorization, must be filed to preserve any objection. *See*, 37 C.F.R. § 37.64, Office Trial Practice Guide, 77 Fed. Reg. at 48767. There are no discovery issues pending at this time.

The parties are reminded of the provisions for taking testimony found at 37 C.F.R. § 42.53 and the Office Trial Practice Manual at 77 Fed. Reg. at 48772, App. D.

Motions

There are currently no motions to be addressed in this proceeding.

The parties are reminded that, except as otherwise provided in the Rules, Board authorization is required before filing a Motion. 37 C.F.R. § 42.20(b). A party seeking to file a motion should request a conference to obtain authorization to file the motion. No motions are authorized in this proceeding at this time.

Although Board authorization is not required for the Patent Owner to file one motion to amend a patent by cancelling or substituting claims, we remind Patent Owner of the requirement to request a conference with the Board before filing a motion to amend. 37 C.F.R. § 42.121(a). The conference should take place at least two weeks before filing the motion to amend. The Board takes this opportunity to remind the Patent Owner that a motion to amend must explain in detail how any proposed substitute claim obviates the grounds of unpatentability

IPR2014-00737; IPR2014-00740
Patent 8,050,652 B2; 8,045,952 B2

authorized in this proceeding, and clearly identify where the corresponding written description support in the original disclosure can be found for each claim added. If the motion to amend includes a proposed substitution of claims beyond a one-for-one substitution, the motion must explain why more than a one-for-one substitution of claims is necessary. For further guidance regarding these requirements, Patent Owner is directed to several decisions concerning motions to amend, including *Nichia Corporation v. Emcore Corporation*, IPR2012-00005, Paper No. 27 (June 3, 2013); *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027, Paper No. 26 (June 11, 2013), Paper No. 66 (January 7, 2014); *ZTE Corp. v. ContentGuard Holdings*, IPR2013-00136, Paper 33 (November 7, 2013); and *Invensense, Inc. v. STMicroelectronics, Inc.*, IPR2013-00241, Paper No. 21, (January 9, 2014); *Toyota Motor Corp. v. American Vehicular Sciences LLC*, IPR2013-00423, Paper No. 27 (March 7, 2014); *Corning Optical Communications RF, LLC v. PPC Broadband, Inc.*, IPR2014-00441, Paper 19 (Oct. 30, 2014).

Settlement

Counsel stated that, at this time, they are not aware of any settlement discussions that could impact these proceedings.

Other

A court reporter was present and the parties agreed to file a transcript of the proceedings.

IPR2014-00737; IPR2014-00740
Patent 8,050,652 B2; 8,045,952 B2

PETITIONER:

Andrea Reister
Gregory Discher
COVINGTON & BURLING LLP
areister@cov.com
gdischer@cov.com

PATENT OWNER:

Thomas Engellenner
Reza Mollaaghababa
PEPPER HAMILTON LLP
engellenert@pepperlaw.com
mollaaghababar@pepperlaw.com

Christopher Horgan
CONCERT TECHNOLOGY
chris.horgan@concerttechnology.com