

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 IPR2014-00740
Patent 8,045,952 B2

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

IPPOLITO, *Administrative Patent Judge*.

DECISION
On Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

On November 18, 2014, Samsung Electronics Co., Ltd. (“Petitioner”) filed a request for rehearing (Paper 8, “Req.”) of our decision (Paper 7, “Dec.”), dated November 4, 2014. Specifically, Petitioner seeks reconsideration of the decision to deny institution of *inter partes* review of claims 4, 11, and 12 of Black Hills Media, LLC’s (“Patent Owner”) U.S. Patent No. 8,045,952 (Ex. 1001, “the ’952 patent”) on the following grounds:

1. Claims 4, 11, and 12 as obvious under 35 U.S.C. § 103(a) over Berman¹ and Lau²; and
2. Claims 4 and 12 as obvious under 35 U.S.C. § 103(a) over Logan³ and Lau.

For the reasons set forth below, the request for rehearing is *denied*.

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 may be determined if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). The request must

¹ U.S. Patent No. 6,502,194 B1, issued Dec. 31, 2002, (Ex. 1003, “Berman”).

² U.S. Provisional Patent Application No. 60/233,741, filed Sept. 19, 2000 (Ex. 1005, “Lau”).

³ U.S. Patent No. 6,199,076 B1, issued Mar. 6, 2001 (Ex. 1004, “Logan”).

identify, with specificity, all matters that the moving party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d).

III. DISCUSSION

In the Petition, Petitioner presented two grounds of unpatentability based on Lau. Pet. 33–41, 54–60. Specifically, Petitioner argued that (1) Berman and Lau rendered claims 4, 11, and 12 obvious and (2) Logan and Lau rendered claims 4 and 12 obvious. *Id.* In its Request, Petitioner asserts that Lau, a provisional application filed on September 19, 2000, qualifies as prior art to the '952 patent under 35 U.S.C. § 102(e) because U.S. Patent No. 8,281,001 B2 (“Busam”) claims priority to Lau and incorporates Lau by reference. Req. 1–2.

In our decision, we considered Petitioner’s arguments on page 23 of the Petition. Dec. 22–23. However, we were unpersuaded by the arguments presented in the Petition that Lau qualifies as one of the two types of documents described in § 102(e) as prior art. Namely, we were not persuaded that Lau, a provisional application, is itself “(1) an application for patent, published under section 122(b)” or “(2) a patent granted on an application for patent” under 35 U.S.C. § 102(e). *Id.* at 22. Thus, we declined to institute trial on the grounds of unpatentability based on Lau.

In its Request for Rehearing, Petitioner asserts we overlooked the relationship between Lau and Busam because our decision did not mention Busam or Exhibit 1006. Req. 4–5. To the contrary, we considered the evidence and arguments presented on page 23 of the Petition, including Petitioner’s arguments based on Busam. Dec. 22 (citing Pet. 23). However, we found these arguments unpersuasive. Petitioner’s contention is merely a disagreement with the Board’s decision. Disagreement with the Board’s

decision is not a sufficient basis on which to request rehearing.

Next, Petitioner argues Lau is § 102(e) prior art under a “*Yamaguchi* principle” because Lau’s disclosure is incorporated by reference into the Busam *patent*, a § 102(e) prior art reference. Req. 8–11. First, we are not persuaded by these arguments because Petitioner did not make them in the Petition. Although we appreciate the Petition cited *Ex Parte Yamaguchi* on page 23, Petitioner did not present in its Petition, as it does now, a “*Yamaguchi* principle” that purportedly renders Lau prior art under § 102(e). Pet. 23–24, 33–41, 54–60. Rather, the Petition’s discussion of *Ex parte Yamaguchi* is limited to the single statement of “[a]s confirmed by the Board’s decision in *Ex parte Yamaguchi*, No. 2007-4412 (B.P.A.I. August 29, 2008), the disclosure in Lau qualifies as prior art to the ‘952 Patent under 35 U.S.C. § 102(e).” *Id.* at 23. Thus, we could not have misapprehended or overlooked an argument that was not made in the Petition.

Second, we are not persuaded *Ex parte Yamaguchi* established a bright-line rule by which a provisional application *itself* becomes § 102(e) prior art when incorporated by reference into a patent. In *Ex parte Yamaguchi*, the Board affirmed anticipation and obviousness rejections that were based on a *patent*, U.S. Patent No. 6,596,618 B1, as § 102(e) art. *Ex parte Yamaguchi*, 88 U.S.P.Q.2d at 1607, 1609, 1613–1615. Although the Board contemplated that some provisional applications may become published eventually, such as through a conversion process to a non-provisional patent application, the Board did not conclude this always to be the case or that a provisional application necessarily becomes § 102(e) art under such circumstances. *See id.* at 1611. Thus, the Petition, as filed, failed to explain sufficiently how Lau itself constitutes a patent or printed

publication required under 35 U.S.C. § 311(b) for an unpatentability challenge in an *inter partes* review. *See* 37 C.F.R. §§ 42.22(a)(2).

Accordingly, we are not persuaded that we abused our discretion on this basis.

IV. ORDER

Accordingly, it is hereby ORDERED that Petitioner's request for rehearing is *denied*.

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PETITIONER:

Andrea G. Reister
Gregory S. Discher
Covington & Burling LLP
areister@cov.com
gdischer@cov.com

Doris Johnson Hines
Jonathan R.K. Stroud
Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP
dori.hines@finnegan.com
jonathan.stroud@finnegan.com

PATENT OWNER:

Thomas Engellenner
Reza Mollaaghababa
Pepper Hamilton LLP
engellenner@pepperlaw.com
mollaaghababar@pepperlaw.com

Christopher Horgan
Concert Technology
chris.horgan@concerttechnology.com