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Paper 21
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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 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, Black Hills Media, LLC's ("Patent Owner") filed a Request for Rehearing (Paper 10, "Req.") of our Decision to Institute (Paper 7, "Dec."), dated November 4, 2014, which instituted *inter partes* review of claims 1–3, 9–11, and 14 of U.S. Patent No. 8,045,952 (Ex. 1001, "the '952 patent").

In its Request, Patent Owner argues the Board (1) applied an erroneous legal standard for the construction of the term "playlist" recited in the challenged claims, (2) overlooked Patent Owner's evidence on the ordinary and customary meaning of "playlist," and (3) misapprehended Patent Owner's argument regarding playlist 1528 disclosed in the '952 patent. Req. 2, 10. Patent Owner further contends under a proper construction of "playlist," Berman does not anticipate claims 9, 10, or 14, and does not render obvious claims 1–3 of the '952 patent. Req. 14–15.

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

III. DISCUSSION

For purposes of the Decision to Institute, we construed the term "playlist" as "a list of audio files." Dec. 9–10. As we explained, the Specification of the '952 patent describes a playlist as a list of audio files that may or may not include URLs. *Id.* In reaching this construction, we noted the Specification teaches playlist 1528 is "a list of audio files and associated URLs." We further discerned URLs may not be included in a "playlist" where, for example, "all the songs in the playlist are already on the first device." *See id.* (citing Ex. 1001, 28:9–43). Moreover, our decision referred to column 4, lines 50 through 67 of the '952 patent where the Specification describes a "playlist of songs" and downloading songs in the form of audio files for the playlist. *Id.* at 10. Further, we considered the two different proposed constructions and supporting evidence provided by the Petitioner and Patent Owner for "playlist." *Id.* Nonetheless, we did not adopt either proposed construction. With respect to Patent Owner's proposal, we were not persuaded that the broadest reasonable construction of "playlist" is "a list referencing media items arranged to be played in a sequence." *Id.*

Additionally, in the Decision to Institute, we provided the general principles governing our claim construction. Dec. 8. These general principles are that

(1) claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear (*id.*);

(2) claim terms are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure (*id.*); and

(3) any special definition for a claim term must be set forth with reasonable clarity (*id.*).

In its Request for Rehearing, Patent Owner asserts we did not apply the broadest reasonable construction standard because we improperly focused on one aspect of playlists described in the '952 patent. Req. 3. Patent Owner adds our decision did not address the full meaning of the "playlist" and, further, ascribes a "special definition" limiting the claim construction to certain aspects of the claim term. *Id.* at 3–4. Patent Owner contends the term "playlist" should be construed as "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)." *Id.* at 4–5.

As we wrote in the Decision to Institute, we reviewed more than one aspect of "playlist" described the '952 patent. As reflected in our decision, we considered Patent Owner's arguments based on the portion of the Specification describing audio player 1792, shuffle button 1796, and repeat button 1798. Dec. 9. We further considered several examples of playlists described in the '952 patent, including at least playlist 1528 and others described in column 4, lines 50 through 67 and column 28, lines 9 through 43. *Id.* Our Decision to Institute also did not adopt a "special definition." Rather, upon review of the Specification and evidence and arguments provided by both parties, we explained in the Decision to Institute that Patent Owner's position and proposal was not persuasive in light of the Specification. *Id.* We continue to be persuaded that, for the purposes of the Decision to Institute, "playlist" would have been understood as "a list of audio files."

Patent Owner further contends we overlooked the extrinsic evidence it

provided on the ordinary and customary meaning of "playlist. Req. 5–10. Patent Owner asserts the Petition did not include any substantive analysis or evidence on this issue and our Decision to Institute "focused on only *one aspect*" of "playlist." *Id.* at 5–6. Patent Owner maintains the testimony (Ex. 2007) of its declarant, Mr. Ivan Zatkovich, and contemporaneous publications (Exs. 2008–2010) evidence the ordinary and customary meaning of "playlist" as "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)." *See id.* at 5, 7–8, 10. Patent Owner also argues the testimony of Petitioner's declarant, Dr. Jeffay, supports Patent Owner's construction of "playlist." *Id.* at 8–10.

Again, we disagree the Decision to Institute was focused on only one aspect of playlist. As discussed above, we considered several examples and aspects of playlist described in the '952 patent, including those portions of the Specification cited by the Patent Owner. Dec. 9–10 (citing Ex. 1001, 4:50–67, 21:61–63, 24:31–43, 28:9–43). Additionally, we considered Patent Owner's extrinsic evidence. *Id.* at 10 (citing Exs. 2007–2010). Nevertheless, based on the current record, we were persuaded, and remain persuaded, that the Specification and claim language itself requires a broader construction than that espoused by Patent Owner's arguments and extrinsic evidence. Accordingly, we are not persuaded that we abused our discretion on this basis.

Additionally, Patent Owner asserts that the Decision to Institute erroneously misapprehends Patent Owner's argument regarding playlist 1528 because Patent Owner did not "acknowledge" the Specification discloses the contents of playlist 1528, but not a sequence or arrangement of

the contents. Req. 10–11. Patent Owner contends that it did not "concede that playlist 1528 is not arranged to be played in a sequence. Rather, Patent Owner contends that its "unambiguous argument was that the passage of the '952 Patent relied upon by the Board in IPR2013-00594 describes only one aspect of the playlist 1528." *Id.* at 11.

We are not persuaded we abused our discretion on this basis. In the Preliminary Response, Patent Owner refers to a passage in the Specification as "speak[ing] to the *contents* of one particular playlist (i.e., playlist (1528)), and not to the *arrangement* of the contents of the playlist." Prelim. Resp. 26; Req. 10. In the Decision to Institute, we referred to Patent Owner's statement as an acknowledgement that the Specification describes the contents of playlist 1528, but does not disclose a sequence or arrangement of the playlist contents. Dec. 10 (citing Prelim. Resp. 26). Regardless, we did not rely solely on Patent Owner's characterization of playlist 1528 for our construction of "playlist." As explained, we relied on the Specification's description of playlist 1528, which does not require playlist 1528 to be arranged to be played in a particular manner. Dec. 9.

Patent Owner further contends the Decision to Institute misapprehended Patent Owner's phrase "played in a sequence." Req. 12–13. Patent Owner argues 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)." *Id.* However, we did not misapprehend or overlook this argument. We considered all of Patent Owner's arguments and supporting evidence, including Patent Owner's assertion that "for purposes of this proceeding, the broadest reasonable interpretation of 'playlist' should include an indication that the list of media items are

'arranged to be played in a sequence.'" *See* Dec. 9. However, ultimately, we disagreed with Patent Owner's proposal and determined, for the purpose of the Decision to Institute, that "a list of audio files" provides the broadest reasonable construction of "playlist" consistent with the Specification.

Accordingly, we are not persuaded that we have misconstrued the term "playlist" as provided and used in the Decision to Institute. Additionally, Patent Owner's arguments that grounds based on Berman should have been denied (Req. 14–15) rely on the alternative construction of "playlist," which we are not persuaded should have been adopted. Thus, we are not persuaded these grounds should have been denied in the Decision to Institute.

For the foregoing reasons, Patent Owner has not shown that the Board abused its discretion in instituting the instant proceeding on the grounds specified in the Decision to Institute.

IV. ORDER

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

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