

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.
Petitioner

v.

BLACK HILLS MEDIA, LLC
Patent Owner

Case No. IPR2014-00723
U.S. Patent 8,214,873

**PATENT OWNER'S REQUEST FOR REHEARING ON THE
INSTITUTION DECISION PURSUANT TO 37 C.F.R. §42.71**

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TABLE OF EXHIBITS

Exhibit Description (Previously Submitted)	Exhibit #
Mobile Application Distribution Agreement between Samsung and Google, Trial Exhibit 2775 in the matter of <i>Oracle America, Inc. v. Google Inc.</i> , Case No. CV 10-03561 WHA (N.D. Ca)	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
Patent Owner's claim charts from ITC Inv. No. 337-TA-882	2005
Declaration of Gareth Loy and Exhibits A - N thereto (previously filed in IPR2013-00598 (U.S. Patent 8,214,873) as Ex. 2011)	2006
Deposition Transcript of Dr. Bove dated 5/29/2014 (previously filed in IPR2013-00598 (U.S. Patent 8,214,873) as Ex. 2012)	2007

Pursuant to 37 C.F.R. § 42.71(d), Black Hills Media, LLC (“Patent Owner”) hereby submits the following Request for Rehearing in response to the Decision, Institution of *Inter Partes* Review of U.S. Patent No. 8,214,873 (“Decision”) (Paper 7).

I. INTRODUCTION AND STATEMENT OF RELIEF REQUESTED

In the Decision, the Board granted review of claims 1, 2, 5–8, 15–19, 22, 23, 25–27, 30–31, 34–37, and 44–46 of the ’873 patent as obvious based on the combination of Weast and Encarnacion based on the Board’s construction of the claim term “playlist.”

The Board construed the term “playlist” to mean “a list of media selections.” (Decision at 10) It is respectfully submitted that the Board overlooked the evidence of record on the ordinary and customary meaning of the term “playlist” as would be understood by one of ordinary skill in the art at the time of the invention. As a result, the Board reached an erroneous conclusion of law and issued a construction which is broader than the ordinary and customary meaning.

Patent Owner requests reconsideration of the Board’s Decision of the claim construction of the term “playlist” and resultant grant of review of claims 1, 2, 5–8, 15–19, 22, 23, 25–27, 30–31, 34–37, and 44–46 of the ’873 patent.

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 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. BASIS FOR RELIEF REQUESTED

A. The Board Erred In The Application Of The Law Governing the Broadest Reasonable Interpretation

“In an *inter partes* review, the Board interprets claim terms in an unexpired patent according to the broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b). Under that standard, and absent any special definitions, we give claim terms their ordinary and customary meaning, as would be understood by one of ordinary skill in the art at the time of the invention.” *Endo Pharmaceuticals Inc. v. Depomed, Inc.*, IPR2014-00656 (Paper 12 at 6) (September 29, 2014) citing *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Under the broadest reasonable construction

standard, there is “a ‘heavy presumption’ that a claim term carries its ordinary and customary meaning.” *Macronix International Co., Ltd., et al. v. Spansion LLC*, IPR2014-00106 (Paper 13 at 6) (April 24, 2014), citing *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002). Patent Owner respectfully submits that the Board reached an erroneous conclusion of law when it overlooked the evidence of record on the ordinary and customary meaning of the term “playlist” and enlarged the scope of the term beyond the ordinary and customary meaning.

The Board’s construction of the term “playlist” to mean “a list of media selections” (Decision at 10) is in error because such construction is broader than the ordinary and customary meaning of the term. Petitioner submitted no evidence to show either the ordinary and customary meaning of this term or that the patentee acted as its own lexicographer. *See* Petition (Paper 1) at 4-6 (Petitioner relying solely on the ‘873 specification). As the Board explained in *American Express Company, et al. v. Metasearch Systems, LLC*, CBM2014-00001 (March 20, 2014):

To act as its own lexicographer, a patentee must “clearly set forth a definition of the disputed claim term” other than its plain and ordinary meaning. It is not enough for a patentee to simply disclose a single embodiment or use a word in the same manner in all embodiments, the patentee must “clearly express an intent” to redefine the term.

CBM2014-00001 (Paper 29 at 10) citing *Thorner v. Sony Computer Entm't. Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir.2012) (citations omitted). It is undisputed that the inventor of the '873 patent did not set forth any special definition for the term "playlist." Absent any special definition and consistent with the broadest reasonable construction standard, the term "playlist" should be given its ordinary and customary meaning, as would be understood by one of ordinary skill in the art at the time of the invention. *Endo Pharmaceuticals Inc.*, IPR2014-00656 (Paper 12 at 6).

Patent Owner submitted evidence from a prior *inter partes* review proceeding involving the '873 patent (IPR2013-00598) in the form of (1) an expert declaration, (2) prior art, and (3) testimony of another petitioner's expert, establishing that the ordinary and customary meaning of the term "playlist" is "a list referencing media items arranged to be played in a sequence" and not simply "a list of media selections." See Preliminary Response (Paper 6) at 20-24; Ex. 2006 at ¶¶ 46, 48, 50, 51; and Ex. 2007 at 294:2-25; 295:1-10; 221:14-21; 215:1-4; 215:20-216:2; 216:23-217:7, 217:21-218:4.

Based on the evidence submitted, the ordinary and customary meaning of the term playlist is "a list referencing media items arranged to be played in a sequence." The Board appears to have misapprehended the fact that the specification of the '873 patent is consistent with the ordinary and customary

meaning of the term “playlist.” The ‘873 specification describes that a playlist can be manipulated by a user in many different ways, including selecting songs to be played “in the order selected, in random order, or in any other order. The order can preferably be changed at any time.” Ex. 1001, 3:23-24, 11:42-44; Decision at 9.

That the ‘873 patent specifies that the order in a playlist can be changed at any time does not negate the foundational principle of the playlist itself: namely, that *ab origine* the items in a playlist – including in the context of the ‘873 patent – are arranged in a certain order to be played in a sequence unless and until the user changes the order in which the original list of items is to be played. *See* Ex. 2006 at ¶¶ 50-51 (citing Ex. 2007 at 216:23-217:7, 217:21-218:4). Thus, the construction proposed by Patent Owner is not too narrow and does not exclude any embodiment described in the ‘873 specification, but is consistent with the ordinary and customary meaning as supported by the evidence of record.

Given a proper construction of “playlist” consistent with its customary and ordinary meaning, the combination of Weast and Encarnacion does not render the claims 1, 2, 5–8, 15–19, 22, 23, 25–27, 30–31, 34–37, and 44–46 of the ‘873 patent invalid because Weast in combination with Encarnacion fail to teach “playlists,” “receiving, on the first device, a playlist, the received playlist comprising a plurality of media item identifiers,” “selecting at least one media item identifier from the received playlist,” or “receiving user second input selecting at least one

media item identifier from the received playlist” as required by the challenged claims for the reasons set forth in detail in the Preliminary Response (Paper 6) at 37-43.

IV. CONCLUSION

For all 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 to deny review of claims 1, 2, 5–8, 15–19, 22, 23, 25–27, 30–31, 34–37, and 44–46 of the ’873 patent.

Dated: November 18, 2014

Respectfully submitted,

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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 ON THE INSTITUTION DECISION PURSUANT TO 37 C.F.R. §42.71, was served on the following counsel for Petitioner via email:

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