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IPR2013-00593 Paper 45
IPR2013-00594 Paper 38
IPR2013-00597 Paper 37
IPR2013-00598 Paper 42
Date Entered: September 26, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

YAMAHA CORPORATION OF AMERICA,
Petitioner,
v.
BLACK HILLS MEDIA, LLC,
Patent Owner.

Case IPR2013-00593
Patent 8,045,952
Case IPR2013-00594
Patent 8,050,652
Case IPR2013-00597
Patent 8,230,099
Case IPR2013-00598
Patent 8,214,873[1]

Before BRIAN J. McNAMARA, STACEY G. WHITE, and
PETER P. CHEN, *Administrative Patent Judges*

ORDER DENYING AUTHORIZATION FOR PATENT OWNER
TO FILE MOTION TO STRIKE
Conduct of the Proceeding
37C.F.R. § 42.5

[1] This Order addresses an issue that is identical in the listed cases. We exercise our discretion to issue a single paper to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

On September 10, 2014, we conducted a teleconference to address Patent Owner's request for authorization to file a motion to strike Petitioner's Reply to the Patent Owner Response in each of the subject proceedings. Black Hills Media LLC ("Patent Owner") was represented by Lana Gladstein. Yamaha Corporation of America ("Petitioner") was represented by David Fehrman. Judges McNamara, White, and Chen participated in the conference. A court reporter transcribed the conference.

Patent Owner contends that motions to strike in each of the subject proceedings should be authorized because Petitioner's replies and new evidence presented with them are not responsive to the respective Patent Owner's Response.

During the conference, Patent Owner first argued that in IPR2013-00593 and IPR2013-00594, Petitioner's replies (Papers 38 and 31, respectively) propose a new claim construction theory not advanced by Petitioner in its Petitions. Papers 41 and 34, respectively ("Tr.") 3–4.

For convenience, we address the issues concerning IPR2013-00593 and IPR2013-00594 in the context of IPR2013-00593.[2] In IPR2013–00593, instead of the term "playlist," Petitioner proposed that the term "playlist assigned to the electronic device" be construed to mean "a list of songs that is to be transferred to a particular device selected by the user." Pet. 8–9. The Patent Owner Preliminary Response proposed that the term "playlist" be construed separately to mean "a list referencing media items arranged to be played in a sequence." Prelim. Resp. 17. In our Decision to Institute, we construed "playlist assigned to the electronic device" to mean "a list of audio files or URLs of where the audio files were retrieved from directed to a particular device selected by a user." Dec. to Inst. 12-13. The Patent Owner Response extensively addresses the construction of the term

[2] Unless otherwise indicated, references are to papers in IPR2013-00593.

"playlist" by proposing a narrower construction and urging the Board to reconsider its construction in light of evidence submitted with the Patent Owner Response concerning the plain and ordinary meaning of the term. PO Resp. 12–24.

Petitioner's Reply (Paper 38) was its first opportunity to respond to the arguments raised in the Patent Owner Response. In that Reply, Petitioner responded directly to Patent Owner's proposed construction of "playlist" by proposing an alternative construction. Pet. Reply 4. Petitioner notes that in arriving at our construction of the term "playlist assigned to the electronic device," we considered the description of playlist in the patent specification. *Id.*, *citing* our Dec. to Inst. at 10-11. Petitioner's Reply does not raise a new issue. In this case, the original Petition proposed a construction for a term that includes the word, i.e., playlist, that Patent Owner proposes to construe separately. The construction of "playlist" is likely to be significant to the outcome of this proceeding. Thus, Petitioner's Reply was a proper rebuttal to Patent Owner's claim construction position and therefore, we do not authorize Patent Owner's filing of a motion to strike Petitioner's Reply in either IPR2013-00593 or IPR2013-00594.

Patent Owner also seeks authorization to move to strike exhibits cited in the Petitioner Reply in IPR2013-00593 and IPR2013-00594. Tr. 5. Patent Owner contends that the Exhibits are extrinsic evidence not supported by an expert declaration and that the Patent Owner has no opportunity to cross examine Petitioner's expert witness as to the exhibits. *Id.* at 6-7. The exhibits are in support of the Petitioner's Reply and are responsive to the Patent Owner Response. Patent Owner also has filed a Motion to Exclude these exhibits as irrelevant, lacking foundation and prejudicial. (Papers 42 and 35, respectively). We will address those issues in due course. Therefore, we do not authorize a separate motion to strike these exhibits.

The issues in IPR2013-00597 and IPR2013-00598 are similar and also concern the construction of "playlist." Tr. 12-13. For the reasons discussed above, we do not authorize Patent Owner to file a motion to strike the Petitioner's reply in either IPR2013-00597 or IPR2013-00598. In IPR2013-00598 Patent Owner also objects to Exhibit 1022 and Petitioner's related argument concerning the implications of the Bi reference. Tr. 14-19. However, Patent Owner already has moved to exclude this evidence in IPR2013-00598 (Paper 39). In IPR2013-00597, Patent Owner also has filed a motion to exclude. (Paper 34). As discussed above, these exhibits are in support of Petitioner's Reply to the Patent Owner Response. We will address the motions to exclude in due course. Therefore, we do not authorize a motion to strike the exhibits in either IPR2013-00597 or IPR2013-00598.

In consideration of the above, Patent Owner's requests for authorization to file motions to strike in IPR2013-00593, IPR2013-00594, IPR2013-00597, and IPR2013-00598 are DENIED.

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