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IPR2013-00593, Paper 29
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IPR2013-00597, Paper 20
IPR2013-00598, Paper 26
Entered April 23, 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 B2

Case IPR2013-00594

Patent 8,050,652 B2

Case IPR2013-00597

Patent 8,230,099 B2

Case IPR2013-00598

Patent 8,214,873 B2¹

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

McNAMARA, *Administrative Patent Judge*.

INITIAL CONFERENCE SUMMARY

Conduct of the Proceeding

37C.F.R. § 42.5

¹ This summary 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.

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An initial conference in the subject proceedings was held on April 22, 2014. Yamaha Corporation of America (“Petitioner”) was represented by David Fehrman and Mehran Arjomand. Black Hills Media, LLC (“Patent Owner”) was represented by, Thomas Engellenner, and Lana Gladstein. The following subjects were discussed during the conference:

Related Matters

Patent Owner advised that there are no reexamination or reissue proceedings concerning the patents which are challenged in the subject proceedings.

The parties advised that in the action identified in the Petition and Mandatory Notices as pending at the International Trade Commission, the hearing has occurred and the Initial Determination is pending. The parties also advised that cases pending in the district courts for the Eastern District of Texas and the District of Delaware are stayed pending a decision in the case before the International Trade Commission. The parties also advised that cases pending in the Central District of California are the subject of a Motion to Stay, which has not yet been decided.

Scheduling Order

The parties advised that they are consulting about adjusting DATES 1-3 of the Scheduling Order and requested authorization to file a Motion to Amend the Scheduling Order. The parties are reminded that, without obtaining prior authorization from the Board, they may stipulate to different dates for DATES 1-3, 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. If the parties wish to propose any other changes to the Scheduling Order, they must request a conference with the Board.

Protective Order

The parties have not discussed a protective order for this proceeding. No protective order has been entered. 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 Board's default protective order, 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, 77 Fed. Reg. 48,756, App. B (Aug. 14, 2012), they must submit a joint, proposed protective order, accompanied by a red-lined version based on the default protective order in Appendix B to the Board's Office Patent Trial Practice Guide. *See id.* at 48,769.

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 48,761-2. 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 48,767. There are no discovery issues pending at this time.

Each party expects to depose experts and affiants supporting the opposing party. The parties are reminded of the provisions for taking testimony found at 37

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C.F.R. § 42.53 and the Office Trial Practice Guide at 77 Fed. Reg. at 48,772, App. D.

Motions

Prior to the initial conference, the parties indicated that at this time they do not anticipate filing motions, other than those listed in the Scheduling Order. There are currently no motions to be addressed by the Board.

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 prior Board authorization is not required for the Patent Owner to file one motion to amend the 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 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

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(June 11, 2013), Paper No. 66 (January 7, 2014); *ZTE Corp. v. ContentGuard Holdings*, IPR2013-00136, Paper 33 (November 7, 2013); *Invensense, Inc. v. STMicroelectronics, Inc.*, IPR2013-00241, Paper No. 21, (January 9, 2014); and *Toyota Motor Corp. v. American Vehicular Sciences LLC*, IPR2013-00423, Paper No. 27 (March 7, 2014).

Settlement

The parties stated that there are no immediate settlement prospects that would affect these proceedings.

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