

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 IPR2014-00717
Patent 6,108,686

Before BRIAN J. McNAMARA, DAVID C. McKONE, FRANCES L. IPPOLITO,
Administrative Patent Judges.

McNAMARA, *Administrative Patent Judge.*

AUTHORIZATION FOR PATENT OWNER TO FILE MOTION FOR
ADDITIONAL DISCOVERY
37 C.F.R. § 42.51

On June 25, 2014, the Board received e-mail correspondence from Vivek Ganti, counsel for Black Hills Media LLC (“Patent Owner”), requesting a teleconference to discuss authorization to file a motion for additional discovery concerning whether Samsung Electronics Co., Ltd.; Samsung Electronics America, Inc.; and Samsung Telecommunications America, LLC (collectively, “Petitioner”) should have identified Google, Inc. (“Google”), as a real party in interest in IPR2014-00717 and IPR2014-00735 (“the subject proceedings”). During a teleconference on June 30, 2014, Andrew Crain, counsel for Patent Owner, argued that a recently discovered mobile application distribution agreement (MADA) between Google and at least one of the Petitioner entities constitutes circumstantial evidence that Google, Inc., is a real party-in-interest in the subject proceedings. According to Patent Owner, the MADA contains provisions in which Google indemnifies Samsung and in which Google maintains full control of related litigation. In its Mandatory Disclosures (IPR2014-00717, Paper 5, and IPR2014-00735, Paper 7), Patent Owner has identified a lawsuit involving one of the Petitioner entities, i.e., *Black Hills Media, LLC v. Samsung Elecs. Co., Ltd., et al.*, No. 2:13-cv-00379 (E.D. Tex.).

During the conference, counsel for Petitioner responded that the MADA applies to claims resulting from allegations against Samsung products and is not related to actions, such as *inter partes* reviews, in the United States Patent and Trademark Office. Counsel for Petitioner also stated that Google has not exercised control over the petitions in the subject proceedings.

A party that funds or directly controls an IPR or PGR petition or proceeding constitutes a real party-in-interest. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,760 (Aug. 14, 2012). In view of the existence of this lawsuit and the alleged indemnification requirement in the MADA, Patent Owner argues that it

should be permitted to discover information concerning the scope of Google's involvement in the subject proceedings.

In view of the circumstances, we authorize Patent Owner to file a Motion for Additional Discovery. Patent Owner's Motion for Additional Discovery may not exceed ten pages of argument and must be filed by August 22, 2014. Patent Owner's Motion for Additional Discovery should explain why granting the motion is in the interest of justice. *See* 37 C.F.R. § 42. 51(b)(2)(i). Patent Owner's Motion for Additional Discovery should identify with particularity the specific discovery being sought and should address each of the Garmin factors. *See Garmin International, Inc. et. al. v. Cuozzo Speed Technologies LLC*, IPR2012-00001, Paper 26 (PTAB Mar. 5, 2013). In particular, Petitioner's Motion for Additional Discovery should explain what evidence Petitioner has, tending to show beyond speculation that something useful will be discovered (including, but not limited to, the MADA), how Patent Owner's discovery requests are tailored to produce specific information that is not otherwise available concerning Google's involvement in the subject proceedings, and why the discovery being sought is not unduly burdensome on Petitioner.

Petitioner may file an Opposition to Patent Owner's Motion for Additional Discovery. Petitioner's Opposition may not exceed ten pages of argument and must be filed by September 5, 2014. We do not authorize Patent Owner to file a Reply to Petitioner's Opposition.

In consideration of the above, it is,

ORDERED that Patent Owner is authorized to file a Motion for Additional Discovery, not exceeding 10 pages of argument, by August 22, 2014;

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FURTHER ORDERED that Petitioner is authorized to a file an Opposition to Patent Owner's Motion for Additional Discovery, not exceeding 10 pages of argument, by September 5, 2014; and

FURTHER ORDERED that no reply to Petitioner's Opposition is authorized.

PETITIONER

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