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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 IPR2014-00717

U.S. Patent 6,108,686

**PRELIMINARY RESPONSE BY
PATENT OWNER UNDER 37 C.F.R. § 42.107**

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Pursuant to 37 C.F.R. § 42.107, Patent Owner Black Hills Media, LLC (hereinafter “Patent Owner”) hereby respectfully submits this Preliminary Response to the Petition (hereinafter “the Petition”) filed by Samsung Electronics Co. Ltd.; Samsung Electronics America, Inc.; and Samsung Telecommunications America, LLC (hereinafter “Petitioner”) for *inter partes* review of claims 1, 2, 20, 23, 29, and 30 of U.S. Patent No. 6,108,686 (hereinafter “the ’686 Patent”). This filing is timely under 35 U.S.C. § 313, and 37 C.F.R. § 42.107, as it is being filed within three months of the May 7, 2014 mailing date of the Notice granting the filing date of the Petition (“Paper 3”).

I. INTRODUCTION

“The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). A trial should not be instituted in this matter as none of the references relied upon by Petitioner in its Petition gives rise to a reasonable likelihood of Petitioner prevailing with respect to any challenged claim of the ’686 Patent, either alone or in any combination with each other.

Because a patent owner is precluded from filing new testimonial evidence to support a preliminary response to a petition for *inter partes* review, Patent Owner is unable to submit a declaration from an expert in the art to assist in the Board's understanding of the '686 Patent and the cited references. 37 CFR § 42.107(c). As such, Patent Owner declines to present through this Preliminary Response substantive arguments regarding the technology of the '686 Patent and the disclosures of the cited references. Despite not filing substantive technical arguments in this Preliminary Response, Patent Owner nevertheless submits that the bases presented herein support the denial of Petitioner's Petition. But if the Board does institute trial with respect to any claim challenged in the Petition, Patent Owner reserves the right to present any arguments through a Patent Owner response under 37 C.F.R. § 42.120 and to submit any admissible evidence in support thereof. Patent Owner's election to reserve its substantive arguments regarding the technology of the '686 Patent and the cited references should not lead to any adverse inferences by the Board.

II. THE ASSERTED GROUNDS OF UNPATENTABILITY

Petitioner asserts that claims 1, 2, 20, 23, 29, and 30 are unpatentable under the following two grounds:

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