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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAMSUNG ELECTRONICS CO., LTD.;  
SAMSUNG ELECTRONICS AMERICA, INC.; and  
SAMSUNG TELECOMMUNICATIONS AMERICA, LLC

Petitioner,

v.

BLACK HILLS MEDIA, LLC,

Patent Owner

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Case IPR2014-00717

U.S. Patent 6,108,686

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**SUBSTITUTE MOTION FOR ADDITIONAL DISCOVERY BY PATENT  
OWNER\***

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\* This Substitute Motion is submitted to correct and clarify Footnote No. 2.

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**OTHER AUTHORITIES**

Office Patent Trial Practice Guide, 77 Fed. Reg. 48756 (Aug. 14, 2012).. 4, 6, 7, 10

**EXHIBIT LIST**

<b>EXHIBIT NO.</b>	<b>EXHIBIT DESCRIPTION</b>
BHM Ex. 2001	Proposed Discovery Request
BHM Ex. 2002	Mobile Application Distribution Agreement
BHM Ex. 2003	Complaint in <i>Black Hills Media, LLC v. Samsung Elecs. Co., Ltd., et al.</i> , No. 2:13-cv-00379 (E.D. Tex.).
BHM Ex. 2004	Claim Charts Illustrating Infringement of U.S. Patent 6,108,686 in <i>Black Hills Media, LLC v. Samsung Elecs. Co., Ltd., et al.</i> , No. 2:13-cv-00379 (E.D. Tex.), served on August 22, 2013 (hereinafter “686 Infringement Claim Charts”).
BHM Ex. 2005	Transcript of Proceedings before the Hon. Lucy H. Koh for <i>Apple, Inc. v. Samsung Elecs. Co., Ltd.</i> , No. 12-cv-00630 (N.D. Ca. June 18, 2014), ECF No. 1926. (hereinafter “Apple v. Samsung Tr.”)
BHM Ex. 2006	Transcript of Deposition of Justin Denison (Plaintiff’s Exhibit No. 3001) for <i>Apple, Inc. v. Samsung Elecs. Co., Ltd.</i> , No. 12-cv-00630 (N.D. Ca. June 16, 2014), ECF No. 1920 (hereinafter “Denison Dep. Tr.”).
BHM Ex. 2007	Select Internet Web Pages from en.wikipedia.org.
BHM Ex. 2008	Select Internet Web Pages from samsung.com

**I. BACKGROUND**

On August 7, 2014, the Board authorized Patent Owner's prior request to file a Motion for Additional Discovery. Paper 8, p. 3. As shown below, the discovery sought is necessary in the interest of justice, and the Board should grant the requested additional discovery that is set out in Ex. 2001.

**II. ADDITIONAL DISCOVERY CONCERNING THE IDENTITY OF ALL REAL PARTIES IN INTEREST IS NECESSARY IN THE INTEREST OF JUSTICE**

A party is entitled to additional discovery under 37 C.F.R. § 42.51(a)(2) if the party shows that such additional discovery is "in the interest of justice." 35 U.S.C. § 316(a)(5). *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26, pp. 6-7 (PTAB March 5, 2013) set forth five factors to be considered when determining if a party has satisfied the "necessary in the interest of justice" standard under 35 U.S.C. § 316(a)(5). Each factor is addressed below.

**A. Patent Owner Is in Possession of Evidence that Shows Beyond Speculation that Something Useful Will Be Uncovered (*Garmin* Factor 1)**

The first *Garmin* factor asks whether the party requesting discovery is "in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered." *Garmin Int'l*, IPR2012-00001, Paper 26 at p. 6. In the context of the first *Garmin* factor, "useful" means "favorable in substantive value to a contention of the party moving for discovery." *Id.* at p. 7.

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