IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. Petitioner,

 \mathbf{v}_{ullet}

BLACK HILLS MEDIA, LLC Patent Owner.

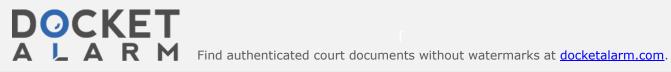
Case IPR2014-00717 Patent No. 6,108,686

PETITIONER'S OPPOSITION TO SUBSTITUTE MOTION FOR ADDITIONAL DISCOVERY BY PATENT OWNER



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LIST OF EXHIBITS

Exhibit	Description
Ex. 1001	U.S. Patent No. 6,108,686 ("the '686 Patent")
Ex. 1002	File History for U.S. Patent No. 6,108,686
Ex. 1003	U.S. Patent No. 5,740,549 ("the Reilly patent" or "Reilly")
Ex. 1004	Weiss, "New Places to Go Online," 14(8) Technology &
	Learning 109-115 (1994) ("the Technology & Learning Article")
Ex. 1005	Declaration of Kevin C. Almeroth, Ph.D. ("Almeroth Dec.")
Ex. 1006	Curriculum vitae of Kevin C. Almeroth, Ph.D.
Ex. 1007	Motion to Intervene in Investigation and Supporting
	Memorandum of Google Inc., International Trade Commission
	Investigation No. 337-TA-882 (ITC Jul. 26, 2013).
Ex. 1008	Notice of Filing of Requests for Inter Partes Review of the
	Patents-in-Suit, filed in the Eastern District of Texas for Case
	2:13-cv-00379-JRG on May 21, 2014.
Ex. 1009	Declaration of Mr. Sungil Cho
Ex. 1010	Black Hills Media, LLC's Opposition To Google Inc.'s Motion
	to Intervene (Inv. No. 337-TA-882)
Ex. 1011	Order No. 17: INITIAL DETERMINATION Granting Google
	Inc.'s Motion to Intervene (Inv. No. 337-TA-882)
Ex. 1012	Final Initial Determination Distribution List (Inv. No. 337-TA-
	882)



I. INTRODUCTION

Black Hills Media's ("BHM's") Substitute Motion for Additional Discovery (Paper 15, "Motion") from Samsung Electronics Co., Ltd, Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC ("Samsung") should be denied because Google, Inc. ("Google") is not a real party-in-interest ("RPI") in this proceeding, and because BHM has not demonstrated that its requested additional discovery is "necessary in the interest of justice." 35 U.S.C. § 316(a)(5); 37 C.F.R. § 42.51(b)(2)(i).

Discovery in *inter partes* review ("IPR") is "less than what is normally available in district court patent litigation" because "Congress intended *inter partes* review to be a quick and cost effective alternative to litigation." IPR2013-00080, Paper 18 at 3. The Board must therefore be "conservative in authorizing additional discovery." *Id.* Additional discovery—like that requested in BHM's Motion—should only be permitted where such discovery is "in the interests of justice." *Id.* at 4. And the requested discovery must be more than a speculation or "mere possibility." *Id.* There must be "factual evidence or support" underlying a request for additional discovery that demonstrates that "something useful [to the proceeding] will be found." *Id.*

In support of its request, BHM invokes an expired Mobile Application Distribution Agreement ("MADA") (Ex. 2002) that BHM admits was not in effect at



the time the disputes between BHM and Samsung arose. Paper 15, p. 3; Ex. 2002, p. 1; Ex. 2003, p. 1; Ex. 1007, p. 2. Moreover, BHM has provided no explanation for why section 11 of the MADA, which states that it applies to "any third party lawsuit or proceeding brought *against* [Samsung]," should apply to the present IPR proceeding brought *by* Samsung. Ex. 2002, p. 11, § 11.1 (emphasis added). Accordingly, BHM's discovery request is based on erroneous speculation, not facts. Because BHM has not proffered evidence tending to show beyond speculation that something useful will be discovered, BHM's Motion should be denied. Paper 8, p. 3.

In addition, as noted in the Order Authorizing Motion for Additional Discovery ("Order"; Paper 8), "[c]ounsel for Petitioner [] stated that Google has not exercised control over the petitions in the subject proceedings [IPR2014-00717 and IPR2014-00735]." Paper 8, p. 2. The accompanying Declaration of Mr. Sungil

In the Order Authorizing Motion for Additional Discovery, the Board noted that "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." Paper 8, p. 2 (emphasis added). BHM's motion, which by its own admission is premised on "circumstantial evidence," is precisely the type of "fishing expedition" the Board has cautioned against. IPR2013-00566, Paper 20, p. 5.



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