

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.
Petitioner,

v.

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**

TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION.....	1
II. BHM’S SPECULATION THAT GOOGLE HAS “CONTROL AND AUTHORITY” OVER SAMSUNG’S DEFENSE IS NOT SUPPORTED BY THE FACTS	3
A. Samsung Maintained and Maintains “Control and Authority” Over Its Defense in the International Trade Commission Litigation	4
B. Samsung Maintained and Maintains “Control and Authority” Over Its Defense in the Eastern District of Texas Litigation	5
III. LEAPING FROM THE MADA TO CONTROL OVER THE IPR IS PURE SPECULATION	7
IV. THE REQUESTED DISCOVERY IS UNNECESSARY IN LIGHT OF THE CHO DECLARATION AND DOES NOT SATISFY THE GARMIN FACTORS.....	8
V. CONCLUSION.....	10

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, “ <i>New Places to Go Online</i> ,” 14(8) Technology & Learning 109-115 (1994) (“the Technology & Learning Article”)
Ex. 1005	Declaration of Kevin C. Almeroth, Ph.D. (“Almeroth Dec.”)
Ex. 1006	<i>Curriculum vitae</i> 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.¹ 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

¹ 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.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.