

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,

Petitioners,

v.

BLACK HILLS MEDIA, LLC,

Patent Owner.

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Case IPR2014-00735

Patent 6,618,593 B1

Case IPR2014-00717

Patent 6,108,686

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Before BRIAN J. McNAMARA, DAVID C. McKONE,  
PETER P. CHEN, and FRANCES L. IPPOLITO, *Administrative Patent Judges*.

McNAMARA, *Administrative Patent Judge*.

ORDER GRANTING-IN-PART MOTION FOR ADDITIONAL DISCOVERY

*37C.F.R. § 42.51(b)(2)*

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Patent 6,618,593 B1; 6,101,686

In Paper 10 in IPR2014-00735, which concerns U.S. Patent No. 6,618,593 B1 (“the ’593 Patent”) and Paper 8 in IPR2014-00717, which concerns U.S. Patent No. 6,101,686 (“the ’686 Patent”), we authorized Black Hills Media LLC (“Patent Owner”) to move for additional discovery concerning whether Google, Inc. (“Google”) is a real party-in-interest in these proceedings. In each proceeding, Patent Owner filed its Motion for Additional Discovery on August 22, 2014. IPR2014-00735, Paper 12; IPR2014-00717 Paper 15<sup>1</sup> (“Mot.”). Samsung Electronics Co., Ltd. (“Petitioner”) opposed Patent Owner’s Motion for Additional Discovery on September 5, 2014. Paper 16 in each proceeding (“Opp.”). Although not listed on the cover page of the oppositions, Samsung Electronics America, Inc. and Samsung Telecommunications America, LLC, also appear to oppose Patent Owner’s Motion for Additional Discovery. Opp. 1. Therefore, in this order, we refer to the Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC collectively as Petitioner.

We grant the motion in part.

Patent Owner seeks additional discovery to determine whether Petitioner complied with the requirement to identify each real party-in-interest. *See* 37 C.F.R. § 42.8(b)(1). A party that funds, directs, or controls an IPR petition or proceeding constitutes a real party-in-interest. *See* Office Trial Practice Guide, 77 Fed. Reg. 48,756, 48,760 (Aug. 12, 2014). Thus, the requested discovery must be directed to this issue. Patent Owner must demonstrate that the additional discovery sought is in the interests of justice. *See* 37 C.F.R. § 42.51(b)(2). In deciding whether granting Patent Owner’s motion for additional discovery is in the

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<sup>1</sup> Paper 15 in IPR2014-00717 is Patent Owner’s Corrected Motion for Additional Discovery

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interests of justice, we consider whether Patent Owner is already in possession of evidence tending to show beyond speculation that something useful will be discovered in determining whether Google is a real party-in-interest or privy, i.e., whether Google funds, directs, or controls the Petitions. *See, Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26, pp. 6–7 (PTAB March 5, 2013) (Informative).

Patent Owner has become aware of an expired Mobile Application Distribution Agreement (MADA) between Petitioner and Google. Mot. 2. Paragraph 2.1 of the MADA grants petitioner entity Samsung Electronics Co. Ltd. and its affiliates a license to distribute Google Applications, defined in para. 1.12, when the Google Applications are pre-loaded onto a Device, as defined in para. 1.9 of the MADA. IPR2014-00735, Ex. 2003; IPR2014-00717, Ex. 2002. The MADA also includes an indemnification provision under which Google, if properly notified, has full control and authority over the defense of an infringement claim against Petitioner. *Id.* at ¶ 11, Mot. 2.

With its Opposition to Patent Owner's Motion, Petitioner submitted the declaration of Mr. Sunghil Cho. Ex. 1009 in both proceedings. ("Cho Decl."). Mr. Cho's declaration states that he is employed as a director of Samsung Electronics, Ltd., that he is responsible for coordinating and supervising the filing of petitions for *inter partes* review of third party patents, and that he coordinated the review of petitions challenging patents asserted by Patent Owner in these proceedings. Cho Decl. ¶1–2. Mr. Cho also states that the Petitioner entities (referred in Mr. Cho's declaration as "Samsung") did not engage, coordinate with, or communicate with outside counsel or representatives other than Covington & Burling LLP ("Covington") in connection with the preparation, review and filing of the Petitions, did not send any drafts of the Petitions to Google, did not

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authorize Covington to send any drafts to Google, did not receive any input from Google or its counsel and that the Samsung has paid and is paying all legal fees with respect to these proceedings without funding or contributions from Google or any counsel or representatives of Google. *Id.* at ¶¶ 3–8. Petitioner further argues that Samsung and Google are represented by different counsel in an ITC investigation of the '593 Patent and that any inference of Google's involvement in an Eastern District of Texas litigation concerning the '686 Patent is speculation. *Opp.* 4–7.

Patent Owner notes that, in another lawsuit (“the Apple suit”), in response to an interrogatory, Petitioner denied it was seeking indemnification under the same MADA, but Google later revealed during a deposition that it had been indemnifying Petitioner. *Mot.* 3–4, citing IPR2014-00717, Exs. 2005 and 2006; IPR2014-00735, Exs. 2009 and 2010. Petitioner responds that Patent Owner fails to recognize that the present circumstances are different from those in the Apple suit, where Patent Owner was not a party. *Opp.* 3–6. However, Petitioner does not elaborate on these differences, other than to say that Samsung maintains full control and authority of its defenses in the ITC, where Google has intervened, and the Eastern District of Texas, where Google is not a party. *Id.*

Although Patent Owner was not a party to the Apple suit, the circumstances in that case suggest that Patent Owner is entitled to inquire about whether Google has any involvement in the present proceeding and whether any of Petitioner's entities are acting on behalf of Google in any way. Patent Owner is also entitled to corroboration of the assertions in Mr. Cho's declaration and to cross-examine Mr. Cho. However, Mr. Cho's declaration does not state whether he is located in

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the United States and it is not possible for us to determine if Mr. Cho is available for cross-examination.<sup>2</sup>

Patent Owner argues that, pursuant to the terms of the MADA, Google has intervened and taken an active role in proceedings before the United States District Court for the Eastern District of Texas and the United States International Trade Commission (ITC) where Patent Owner asserted that Petitioner infringes the patent that is the subject of IPR2014-00735 (“the ’593 Patent”). Mot. 2–3. *See also* Ex. 2004, 17–19; Ex. 2005.<sup>3</sup> In the case of the ’593 Patent, Patent Owner specifically cites to arguments advanced by Google before the ITC that Google believes Patent Owner’s case against Petitioner’s products centers on Google’s apps. IPR2014-00735, Mot. 3–4. *See also* IPR2014-00735, Ex. 2007, 6.

Petitioner contends that the MADA invoked by Patent Owner was not in effect at the time the disputes arose between Petitioner and Patent Owner. Opp. 1–2. The first page of the MADA states that its term began on the Effective Date (January 1, 2011) and continued through December 31, 2012. Consistent with this information, the MADA states that it was in effect for a non-renewing term of two years after its January 1, 2011, Effective Date, Ex. 2003 ¶ 6. Thus, the MADA expired on December 31, 2012. The district court suit alleging Petitioner infringes the ’593 Patent was filed on May 6, 2013. Ex. 2004, 17–19. Court records indicate that a summons issued on May 7, 2013, and that Petitioners were served shortly thereafter. The ITC complaint is dated May 13, 2013. The Petition in this proceeding was accorded a filing date of May 7, 2014. Thus, the filing dates of the lawsuits and the instant petition all occurred after the MADA expired. Petitioner

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<sup>2</sup> The Cho declaration also appears not to be in compliance with 28 U.S.C. § 1746.

<sup>3</sup> IPR2013-00717 concerns U.S. Patent No. 6,108,686 (the ’686 Patent), which has been asserted against Petitioner in the U.S. District Court for the Eastern District of Texas, but not in the ITC.

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