

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 IPR2014-00723
Patent 8,214,873 B2

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

CHEN, *Administrative Patent Judge*.

DECISION
On Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

On November 18, 2014, Black Hills Media, LLC's ("Patent Owner") filed a Request for Rehearing (Paper 9, "Req.") of our Decision to Institute (Paper 7, "Dec."), dated November 4, 2014, which instituted *inter partes* review of claims 1, 2, 5–8, 15–19, 22, 23, 25–27, 30, 31, 34–37, and 44–46 of U.S. Patent No. 8,214,873 B2 (Ex. 1001, "the '873 patent").

In its Request, Patent Owner argues that the Decision to Institute (1) applied an erroneous legal standard for the construction of the term "playlist" recited in the challenged claims and (2) overlooked Patent Owner's evidence on the ordinary and customary meaning of "playlist." Req. 1–2.

For the reasons set forth below, the request for rehearing is *denied*.

II. STANDARD OF REVIEW

Under 37 C.F.R. § 42.71(c), "[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion." An abuse of discretion may be determined if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *See Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P'ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). The request must identify, with specificity, all matters that the moving party believes the Board misapprehended or overlooked. *See* 37 C.F.R. § 42.71(d).

III. DISCUSSION

For purposes of the Decision to Institute, we construed the term “playlist” as “a list of media selections.” Dec. 8–10. As we explained, the Specification of the ’873 patent discloses that:

This play list is a list of songs containing at least one song that the listener would like to hear. The listener selects at least one song from the received playlist, as shown in block 35. Either a single song may be selected, or a plurality of songs may be selected.

Dec. 9 (citing Ex. 1001, 11:25–29). We also considered the two different proposed constructions and supporting evidence provided by the Petitioner and Patent Owner for “playlist.” *Id.* at 8–9. We did not adopt either proposed construction. With respect to Patent Owner’s proposal, we were not persuaded that the broadest reasonable construction of “playlist” is “a list referencing media items arranged to be played in a sequence.” *Id.* at 9–10.

Additionally, in the Decision to Institute, we provided the general principles governing our claim construction. Dec. 8–9. These general principles are that:

- (1) claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear (*id.*);
- (2) there is a heavy presumption that claim terms are given their ordinary and customary meaning (*id.*); and
- (3) a patentee can act as his own lexicographer and clearly set forth a definition for a claim term (*id.* at 9).

In its Request for Rehearing, Patent Owner argues that the Decision to Institute erred by not adopting Patent Owner’s proposed construction of “playlist” as “a list referencing media items arranged to be played in a sequence.” Req. 4. Patent Owner asserts that we did not apply the broadest

reasonable construction standard because we overlooked the evidence of record on the ordinary and customary meaning of “playlist” and enlarged the scope of the term beyond the ordinary and customary meaning. *Id.* at 3. Patent Owner also contends that “the items in a playlist – including in the context of the ‘873 patent – are arranged in a certain order to be played in a sequence unless and until the user changes the order.” *Id.* at 5 (citing Ex. 2006 at ¶¶ 50–51).

We determined that limiting the meaning of “playlist” to those examples that specify how the items of a playlist are played, such as the order or sequence of the items played, would exclude embodiments described in the Specification that are not limited in this manner. Dec. 9, citing Ex., 1001, 3:23–24, 11:42–44 (“selected songs may be played in the order selected, in random order, or in any other order. The order can preferably be changed at any time”). We continue to be persuaded that, for the purposes of the Decision to Institute, “playlist” would have been understood by one of ordinary skill in the art as “a list of media selections.”

We also disagree that the Decision to Institute overlooked any evidence provided by the Patent Owner. As discussed above, we considered the Preliminary Response and accompanying exhibits, including the declaration of Gareth Loy. Dec. 9. Based on the current record, we were persuaded, and remain persuaded, that the Specification and claim language itself requires a broader construction than that espoused by Patent Owner’s arguments and extrinsic evidence.

For the foregoing reasons, Patent Owner has not shown that the Board abused its discretion in instituting the instant proceeding on the grounds specified in the Decision to Institute.

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IV. ORDER

Accordingly, it is hereby ORDERED that Patent Owner's request for rehearing is *denied*.

PETITIONER:

Andrea Reister
areister@cov.com

Gregory Discher
gdischer@cov.com

PATENT OWNER:

Lana Gladstein
gladsteinl@pepperlaw.com

Thomas Engellenner
engellennert@pepperlaw.com

Christopher Horgan
chris.horgan@concerttechnology.com