

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,
and
LG ELECTRONICS, INC., LG ELECTRONICS U.S.A., INC., and
LG ELECTRONICS MOBILECOMM U.S.A., INC.,
Petitioners,

v.

BLACK HILLS MEDIA, LLC,
Patent Owner.

Case IPR2014-00723
Case IPR2015-00339
Patent 8,214,873 B2

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

CHEN, *Administrative Patent Judge*.

JUDGMENT
Termination of the Proceeding
37 C.F.R. § 42.73

IPR2014-00723
IPR2015-00339
Patent 8,214,873 B2

BACKGROUND

On May 1, 2014, Petitioner Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC (collectively, “Petitioner Samsung”) filed a Petition (Paper 1) seeking *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 (“the ’873 patent”). On November 4, 2014, we 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 in IPR2014-00723. Paper 7. On December 3, 2014, in IPR2015-00339, Petitioner LG Electronics, Inc., LG Electronics U.S.A., Inc., and LG Electronics MobileComm U.S.A., Inc. (collectively, “Petitioner LG”) filed a Petition for *inter partes* review of claims 1, 2, 5–8, 15–19, 22, 23, 25–27, 30, 31, 34–37, and 44–46 of the ’873 patent (Paper 2), and a Motion for Joinder to IPR2014-00723 (Paper 3).

On January 28, 2015, we instituted *inter partes* review of claims 1, 2, 5–8, 15–19, 22, 23, 25–27, 30, 31, 34–37, and 44–46 of the ’873 patent in IPR2015-00339 and granted Petitioner LG’s motion for joinder of IPR2015-00339 with previously instituted IPR2014-00723. IPR2014-00723, Paper 16, 3–4. In that Decision, the grounds on which IPR2014-00723 was instituted were unchanged, no other grounds were instituted in the joined proceeding, and the Scheduling Order in place for IPR2014-00723 (Paper 12) was unchanged and applied to the joined proceeding. IPR2014-00723, Paper 16 at 4. We also terminated the IPR2015-00339 proceeding. *Id.* at 4.

Pursuant to the Scheduling Order, on February 4, 2015, Patent Owner filed its Response. Paper 17. Patent Owner did not file a motion to amend.

IPR2014-00723
IPR2015-00339
Patent 8,214,873 B2

On April 3, 2015, Patent Owner filed a Request for Adverse Judgment, Paper 23, requesting adverse judgment pursuant to 37 C.F.R. § 42.73(b), with respect to the claims that are the subject of this joined proceeding:

Patent Owner . . . hereby requests that the Board cancel 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 (“the ‘873 Patent”). These claims are all claims for which the present *inter partes* review has been instituted. *See* Decision – Institution of *Inter Partes* Review, Paper 7, p. 19. *See also* Decision – Institution of *Inter Partes* Review and Grant of Motion for Joinder, Paper 16.

In view of the cancellation of all claims remaining in the trial, Patent Owner requests that the Board enter adverse judgment against Patent Owner in this proceeding pursuant to 37 C.F.R. §42.73(b)(2).

Paper 23, 1. Petitioner Samsung and Petitioner LG have not filed any reply to the Patent Owner’s Response.

DISCUSSION

A party may request entry of adverse judgment against itself at any time during a proceeding. *See* 37 C.F.R. § 42.73(b). Patent Owner has conceded that the requested judgment effectively will cancel the claims identified for trial and moot this proceeding. Paper 23, 1. There is no pending motion to amend claims. Patent Owner also has indicated by email to the Board that Petitioners have no objection to the Request for Adverse Judgment. Under these circumstances, the request for entry of adverse judgment is appropriate.

IPR2014-00723
IPR2015-00339
Patent 8,214,873 B2

ORDER

It is

ORDERED that Patent Owner's request for adverse judgment under 37 C.F.R. § 42.73(b) with respect to 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 is GRANTED; and,

FURTHER ORDERED that judgment is entered herein against Patent Owner with respect to 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. 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 are unpatentable, and shall be cancelled.

IPR2014-00723
IPR2015-00339
Patent 8,214,873 B2

PETITIONERS:

Andrea Reister
areister@cov.com

Gregory Discher
gdischer@cov.com

Doris Johnson Hines
dori.hines@finnegan.com

Jonathan Stroud
jonathan.stroud@finnegan.com

PATENT OWNER:

Lana Gladstein
gladsteinl@pepperlaw.com

Reza Mollaaghababa
mollaaghababar@pepperlaw.com

Thomas Engellenner
engellenert@pepperlaw.com

Christopher Horgan
chris.horgan@concerttechnology.com