By: Thomas Engellenner
Pepper Hamilton LLP
125 High Street
19<sup>th</sup> Floor, High Street Tower
Boston, MA 02110
(617) 204-5100 (telephone)
(617) 204-5150 (facsimile)

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 No. IPR2014-00737 Patent 8,050,652

PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR INTER PARTES REVIEW OF U.S. PATENT NO. 8,050,652



## TABLE OF CONTENTS

			<u>Page</u>				
Tabl	e of A	uthorities	iii				
Tabl	e of Ex	xhibits	V				
I.	INTI	INTRODUCTION1					
II.		THE PETITION FAILS TO IDENTIFY ALL REAL PARTIES IN NTEREST					
III.	BACKGROUND OF THE '652 PATENT						
	A.	Summary of the Claimed Subject Matter	11				
IV.	CLAIM CONSTRUCTION AND ORDINARY SKILL IN THE ART						
	A.	Legal Standard	14				
	B.	A Person Having Ordinary Skill In The Art					
	C.	Construction of "Playlist"	17				
		1. Plain and Ordinary Meaning of "Playlist" in the Media File Sharing Arts	18				
		2. The '652 Patent Uses "Playlist" Consistent with its Plain and Ordinary Meaning	21				
	D.	Construction of "Assigned to the Electronic Device"					
	E.	Construction of "Wherein Ones of the Plurality of Songs Are Not Stored On The Electronic Device"					
V.	THE PETITION DOES NOT SATISFY THE STATUTORY THRESHOLD FOR INSTITUTING <i>INTER PARTES</i> REVIEW						
	A.	A. There Is No Reasonable Likelihood That White Renders Obvious the Challenged Claims (Ground 1)					
		1. Summary of White	32				



			<u>]</u>	<u>Page</u>
		2.	White does not render obvious independent claims 1 and 42	37
	B.		e Is No Reasonable Likelihood That Logan and Lipscomb er Obvious The Challenged Claims (Ground 2)	46
		1.	Summary of Logan	47
		2.	Summary of Lipscomb	49
		3.	Summary of Petitioner's Arguments	50
		4.	Logan and Lipscomb do not render obvious independent claims 1 and 42	51
VI.			NT GROUNDS PRESENTED IN THE PETITION BE DISMISSED	59
VII	CON	CHIS	ION	60



#### **TABLE OF AUTHORITIES**

·	Page(s)
CASES	
ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc., 694 F.3d 1312 (Fed. Cir. 2012)	58
Anova Food, LLC v. Leo Sandau and William R. Kowalski, IPR2013-00114 (PTAB, June 25, 2013)	16, 47
Dominion Dealer Solutions, LLC v. AutoAlert, Inc., IPR2013-00223 (PTAB, Aug. 15, 2013)	56
Heart Failure Techs., LLC v. CardioKinetix, Inc., IPR2013-00183 (PTAB, July 31, 2013)	55
In re Cortright, 165 F.3d 1353 (Fed. Cir. 1999)	14
In re Suitco Surface, Inc., 603 F.3d 1255 (Fed. Cir. 2010)	14
In re Buszard, 504 F.3d 1364 (Fed. Cir. 2007)	14
KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398 (2007)55	5, 56, 57
Liberty Mutual Insurance Co. v. Progressive Casualty Insurance Co., CBM2012-00003 (PTAB, Oct. 25, 2012)	54, 59
On-Line Techs., Inc. v. Bodenseewerk Perkin-Elmer GmbH, 386 F.3d 1133 (Fed. Cir. 2004)	30
Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005)	25
RPX Corp. v. VirnetX, Inc., IPR2014-000171 (PTAB, February 20, 2014)	7
Superguide Corp., v. DirectTV Enters, 358 F.3d 870 (Fed. Cir. 2004)	30
Teleflex, Inc. v. Ficosa North America Corp., 299 F. 3d 1313 (Fed. Cir. 2002)	26



	<b>Pages</b>
STATUTES	<del></del>
35 U.S.C. § 312	1, 2, 60
35 U.S.C. § 313	1
35 U.S.C. § 314	31
35 U.S.C. § 316	31
OTHER AUTHORITIES	
37 C.F.R. § 42.1	59
37 C.F.R. § 42.8	1, 2
37 C.F.R. § 42.73	2
37 C.F.R. § 42.100	14
37 C.F.R. § 42.107	1, 16
77 Fed. Reg. 48612	2
77 Fed. Reg. 48756	5, 14
MPEP § 2111 (9th Ed., March 2014)	14, 25
MPEP 8 21/41	16



# DOCKET

# 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.

