

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

YAMAHA CORPORATION OF AMERICA,
Petitioner,

v.

BLACK HILLS MEDIA, LLC,
Patent Owner.

Case IPR2014-00766
Patent 8,214,873 B2

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

CHEN, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Yamaha Corporation of America (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 4, 5, 33, and 34 of U.S. Patent No. 8,214,873 B2 (Ex. 1001, “the ’873 patent”). Paper 1 (“Pet.”). Black Hills Media, LLC (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

Upon consideration of the Petition and the Preliminary Response and their accompanying exhibits, Petitioner has demonstrated a reasonable likelihood that it would prevail in showing the unpatentability of claims 4, 5, 33, and 34 of the ’873 patent. Accordingly, we institute an *inter partes* review of these claims.

A. Related Proceedings

On May 12, 2012, Patent Owner filed a Complaint against Petitioner in the U.S. District Court for the District of Delaware, alleging infringement of three patents. On September 12, 2012, Patent Owner filed a First Amended Complaint (“FAC”) against Petitioner, alleging for the first time, infringement of the ’873 patent. *See Black Hills Media, LLC v. Yamaha Corp. of America*, No. 1:12-cv-00635-RGA (D. Del.). The FAC was served on September 19, 2012. Pet. 7.

On August 5, 2013, the Delaware Court transferred the case to the Central District of California. *Id.* In November 2013, the Central District of California ordered Patent Owner to file evidence of the chain of title for the asserted patents. Ex. 1004, 3. In December 2013, Defendants moved to dismiss the FAC for lack of standing, on the basis that Patent Owner did not own the allegedly infringed patents when it filed the original complaint in Delaware in May 2012. *Id.* The Central District of California subsequently found that “Plaintiff did not in fact own all rights and interests in the First Asserted Patents on May 22, 2012, when it filed the cases (citations omitted). In fact, Plaintiff did not take ownership of the patents until July 23, 2012, more than two months after filing the Complaints (citation omitted). Plaintiff does not dispute these facts.” *Id.* at 2.

The court dismissed the FAC without prejudice and further ordered Patent Owner to file and serve “new complaints in the Central District of California” by January 21, 2014. Ex. 1004, 7. On January 21, 2014, Patent Owner filed and served a new complaint alleging infringement of the ’873 patent by Petitioner, No. 8:14-cv-00101. Pet. 8.

The Patent Owner also initiated an investigation, pursuant to 19 U.S.C. § 1337, in the U.S. International Trade Commission against LG, Sharp, Toshiba, Panasonic, and Samsung alleging, *inter alia*, infringement of the ’873 patent. *See Certain Digital Media Devices, Including Televisions, Blu-Ray Disc Players, Home Theater Systems, Tablets and Mobile Phones, Components Thereof and Associated Software*, Inv. No.

337-TA-882 (USITC).¹ Pet. 14.

We previously instituted an *inter partes* review of claims 1, 2, 6–12, 13, 15–31, 42, 44–46 of the '873 patent, in IPR 2013-00598, *Yamaha Corporation of America v. Black Hills Media LLC* (PTAB March 20, 2014) (Paper 19). In that proceeding, we denied institution as to claims 4, 5, 33, and 34. *Id.*²

B. The '873 Patent

The subject matter of the challenged claims of the '873 patent relates generally to a system and method for media sharing between electronic devices, by using a first device to provide remote control of playing of media items (e.g., songs or videos) on a second device such as a stereo or television. Ex. 1001, Abstract, 9:8–14. The first device receives a playlist and selects the second device, and a user selects the media items to be

¹ An Administrative Law Judge (“ALJ”) at the ITC has issued a Final Initial Determination, in which the ALJ determined that the '873 patent is invalid under 35 U.S.C. § 112, ¶ 1. *See Certain Digital Media Devices, Including Televisions, Blu-Ray Disc Players, Home Theater Systems, Tablets and Mobile Phones, Components Thereof and Associated Software*, Inv. No. 337-TA-882 (July 14, 2014) (Final Initial Determination). The ITC subsequently determined not to review this part of the ALJ’s final initial determination. *See* 79 Fed. Reg. 55,827–28 (Sept. 17, 2014).

² Patent Owner argues that the Petition should be rejected under 35 U.S.C. § 325(d). Prelim. Resp. 6–9. We have reviewed the Patent Owner’s arguments and cited authorities, and exercise our discretion to decline to reject the Petition under § 325(d). Petitioner’s prior art and arguments differ from those in IPR2013-00598.

played on the second device, without user input via the second device.

Pet. 2; Prelim. Resp. 6; Ex. 1001, Abstract; 2:28–40, 52–68.

Figure 1 of the '873 patent is reproduced below.

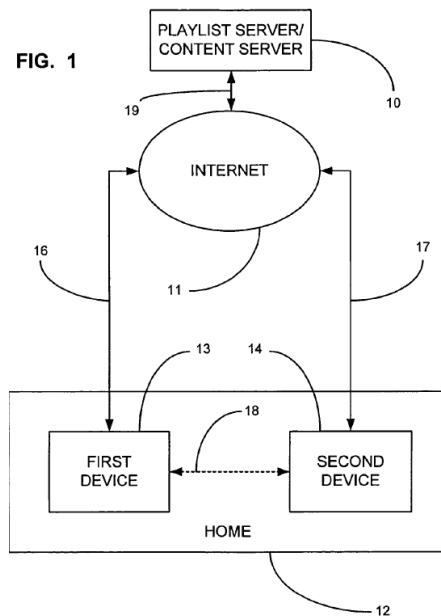


Figure 1 depicts an embodiment of the invention wherein a playlist is communicated from playlist server 11 via Internet 12 to first device 13 or second device 14. Ex. 1001, 8:51–56. First device 13 comprises a remote control for second device 14, which may comprise a music rendering device such as a stereo, television, or home computer. *Id.* at 9:27–32, 55–63.

C. Representative Claims

Dependent claims 4, 5, 33, and 34 are the subject of the petition. Claims 4 and 5 depend from claim 1, and claims 33 and 34 depend from claim 30. Independent claim 1 is reproduced as follows.

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