

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.,  
Petitioner,

v.

SUMMIT 6 LLC,  
Patent Owner.

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Case IPR2016-00029  
Patent 7,765,482 B2

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Before HOWARD B. BLANKENSHIP, GEORGIANNA W. BRADEN, and  
KERRY BEGLEY, *Administrative Patent Judges*.

BEGLEY, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review, Motion for Joinder  
35 U.S.C. § 315(c); 37 C.F.R. §§ 42.108, 42.122

Samsung Electronics Co. Ltd. (“Samsung”) filed a Petition requesting *inter partes* review of claims 12, 13, 16, 18, 19, 21–25, 35–38, 40–42, 44–46, and 49 (“the challenged claims”) of U.S. Patent No. 7,765,482 B2 (Ex. 1001, “the ’482 patent”). Paper 1 (“Pet.”). Along with the Petition, Samsung filed a motion for joinder with IPR2015-00806, *Google Inc. v. Summit 6 LLC*, a pending *inter partes* review involving the ’482 patent. Paper 3 (“Mot.”).

Summit 6 LLC (“Patent Owner”) filed a Response to Samsung’s Motion for Joinder, indicating that Patent Owner does not oppose Samsung’s Motion. Paper 7 (“Resp.”). Patent Owner did not file a Preliminary Response to the Petition.

For the reasons set forth below, we conclude Samsung has shown that the Petition warrants institution of *inter partes* review of claims 12, 13, 16, 18, 19, 21–25, 35–38, 40–42, 44–46, and 49 of the ’482 patent. In addition, we exercise our discretion to join Samsung as a petitioner in IPR2015-00806.

## I. BACKGROUND

### A. RELATED PROCEEDINGS

In IPR2015-00806, filed by Google Inc. (“Google”),<sup>1</sup> we instituted *inter partes* review of the challenged claims—claims 12, 13, 16, 18, 19, 21–25, 35–38, 40–42, 44–46, and 49—of the ’482 patent on the grounds of

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<sup>1</sup> HTC Corporation and HTC America, Inc. (collectively, “HTC”) also were petitioners in IPR2015-00806. IPR2015-00806, Paper 1 (“IPR2015-00806 Pet.”), 1 n.1. After filing the petition, however, HTC and Patent Owner filed a joint motion to terminate HTC’s participation in the case, which we granted. IPR2015-00806, Paper 9; IPR2015-00806, Paper 11.

unpatentability asserted in the present Petition. IPR2015-00806, *Google Inc. v. Summit 6 LLC*, Case IPR2015-00806 (Paper 19) (“IPR2015-00806 Inst. Dec.”). In addition, in IPR2015-00807, which also is pending before the Board, Google challenges a related patent, U.S. Patent No. 8,612,515 B2, which issued from a continuation of the application that issued as the ’482 patent. *See* IPR2015-00807, *Google Inc. v. Summit 6 LLC*, Case IPR2015-00807 (Paper 18); IPR2015-00807, Ex. 1001, [63].

Moreover, the ’482 patent is the subject of *Ex Parte* Reexamination Control No. 90/012,987 (“the Reexamination”), which was requested by Samsung. Pet. 2; Mot. 3–4; IPR2015-00806, Ex. 2040. The Office issued a Final Office Action finding claims 38, 40, 44–46, and 49 of the ’482 patent unpatentable, and Patent Owner appealed to the Board. IPR2015-00806, Ex. 2040; IPR2015-00806, Ex. 2041. After institution of *inter partes* review in IPR2015-00806, the Board, upon motion by Patent Owner, stayed the Reexamination pending the termination or completion of IPR2015-00806. IPR2015-00806, Paper 26.

The ’482 patent also has been asserted in multiple cases in the U.S. District Court for the Northern District of Texas, including *Summit 6 LLC v. Research in Motion Corp., et al.*, Civil Action No. 3:11-cv-00367-O in which Samsung was a defendant. *See* Pet. 2; Patent Owner’s Mandatory Notices per 37 C.F.R. § 42.8 (Paper 8). After a trial in that case, the jury returned a verdict finding that Samsung infringed the ’482 patent and had not shown the patent to be invalid, and awarded Patent Owner damages. *Summit 6, LLC v. Samsung Elecs. Co.*, 802 F.3d 1283, 1287 (Fed. Cir.

2015). On appeal, the U.S. Court of Appeals for the Federal Circuit affirmed. *Id.*

#### B. THE '482 PATENT

According to the '482 patent, at the time of the disclosed invention, sharing digital images over the Internet was complex and required “a level of sophistication . . . beyond that of the ordinary user.” Ex. 1001, 1:20–34. The patent purports to solve this problem with a “web-based media submission tool,” which “allows submission of media objects in a convenient, intuitive manner” that does not require the user to make any modifications to media objects before sending or uploading them. *Id.* at 1:45–48, 2:60–67.

The tool disclosed in the '482 patent allows a user to select media objects stored at a first location (e.g., a client). *Id.* at [57], 2:3–6, 2:44–47, 4:46–47. The media objects, for example, may be “pictures (images), movies, videos, graphics, [or] sound clips.” *Id.* at 2:47–48. The user selects the media objects through either a “drag and drop” or a file browsing functionality. *Id.* at 3:20–48. The tool then may allow the user to confirm the selected media objects with a visual representation, such as a thumbnail image. *Id.* at [57], 2:9–11, 3:65–4:3.

Next, the tool pre-processes the selected media objects, “automatically prepar[ing]” the objects “to meet the requirements of [a] second location” (e.g., a server or web site). *Id.* at [57], 2:14–17, 2:44–3:12, 5:1–4, 5:26–33. The media objects may be pre-processed in “any number of ways,” such as changing the file format or quality setting, cropping, adding text or annotations, and resizing, which includes “compression.” *Id.* at [57], 4:52–

4:67. After this pre-processing is complete, the tool transmits or uploads the media objects to the second location. *Id.* at [57], 3:17–19.

### C. ILLUSTRATIVE CLAIM

Challenged claims 12, 13, 24, 25, and 35–38 are independent claims. *See id.* at 10:40–14:41. Claim 12, reproduced below, is illustrative of the recited subject matter:

12. A computer implemented method of pre-processing media objects in a local device for subsequent transmission to a remote device, comprising:
- a. receiving pre-processing parameters from a remote device, said pre-processing parameters including a specification of an amount of media data;
  - b. receiving an identification of a group of one or more media objects for transmission, a collective media data of said group of one or more media objects being limited by said received pre-processing parameters;
  - c. pre-processing said identified group of one or more media objects using said received pre-processing parameters, wherein said pre-processing comprises encoding or otherwise converting said media object; and
  - d. transmitting said pre-processed group of one or more media objects to the remote device.

*Id.* at 10:40–55.

## II. PETITION FOR *INTER PARTES* REVIEW

We first consider the merits of the Petition.

### A. ASSERTED PRIOR ART

The Petition relies upon the following references, as well as the supporting Declaration of Paul Clark, D.Sc. (Ex. 1003):

U.S. Patent No. 6,018,774 (issued Jan. 25, 2000) (Ex. 1006, “Mayle”);

U.S. Patent No. 6,035,323 (issued Mar. 7, 2000) (Ex. 1007, “Narayan”);



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