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"),[1] 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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[1] 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, "Narayen");

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