

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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YAMAHA CORPORATION OF AMERICA,  
Petitioner,

v.

BLACK HILLS MEDIA, LLC,  
Patent Owner.

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Case IPR2013-00597  
Patent 8,230,099 B2

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Before BRIAN McNAMARA, STACEY G. WHITE, and PETER P. CHEN,  
*Administrative Patent Judges.*

CHEN, *Administrative Patent Judge.*

FINAL WRITTEN DECISION  
*35 U.S.C. § 318(a) and 37 C.F.R. § 42.73*

## I. INTRODUCTION

Yamaha Corporation of America (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1, 2, 6, and 9–12 of U.S. Patent No. 8,230,099 B2 (Ex. 1001, “the ’099 patent”). Paper 1 (“Pet.”). Black Hills Media, LLC (“Patent Owner”) filed a Preliminary Response on December 26, 2013. Paper 10 (“Prelim. Resp.”). On March 20, 2014, we instituted an *inter partes* review for all challenged claims on certain grounds of unpatentability alleged in the Petition. Paper 15 (“Dec. to Inst.”).

After institution of trial, Patent Owner filed a Motion to Amend, moving to cancel claims 1 and 9 (Paper 25, “Mot. to Amend”), and a Patent Owner Response (Paper 26, “PO Resp.”), to which Petitioner filed a Reply (Paper 30, “Pet. Reply”). In the Reply, Petitioner stated it does not oppose the Motion to Amend canceling claims 1 and 9. Pet. Reply 1. A consolidated oral hearing for IPR2013-00593, IPR2013-00594, IPR2013-00597, and IPR2013-00598, each involving the same Petitioner and the same Patent Owner, was held on October 20, 2014. The transcript of the consolidated hearing has been entered into the record. Paper 44 (“Tr.”).

The Board has jurisdiction under 35 U.S.C. § 6(c). In this Final Written Decision, issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73, we determine Petitioner has shown by a preponderance of the evidence that challenged claims 2, 6, and 10–12 are unpatentable. Patent Owner’s Motion to Amend is granted, and its Motion to Exclude is dismissed as moot.

*A. Related Proceedings*

Petitioner indicates that the '099 Patent is at issue in *Black Hills Media, LLC v. Yamaha Corp. of America*, No. 2:13-cv-006054 (C.D. Cal.). Pet. 2–3. In addition, Patent Owner has pending cases concerning the '099 Patent in the United States District Court for the District of Delaware and the Eastern District of Texas, and an investigation before the U.S. International Trade Commission, *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). Supplemental Mandatory Notice (Paper 45), 1–3. The '099 Patent is subject of two other petitions for *inter partes* review.<sup>1</sup> *Id.*

*B. The '099 Patent*

The subject matter of the challenged claims of the '099 patent relates generally to methods and devices for sharing playlists. Ex. 1001, Title. As stated in the specification:

Playlists for music and movies are well known . . . sharing of playlists is also known . . . such playlists and playlist sharing systems . . . possess inherent deficiencies . . . Therefore, it is desirable to provide a system and method for sharing playlists, wherein the playlists are communicated to, stored in, and displayed upon player devices other than general purpose computers.

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<sup>1</sup> Cases IPR2014-00711 and IPR2015-00338.

Ex. 1001, 1:33, 1:64, 2:3–5, 2:21–24. The '099 patent in particular describes a method for presenting a playlist on a wireless handheld remote control for selection for playback on a media player device associated with, but separate from, the remote control. Ex. 1001, 1:25–29, 9:1–8.

Figure 2 of the '099 patent is reproduced below.

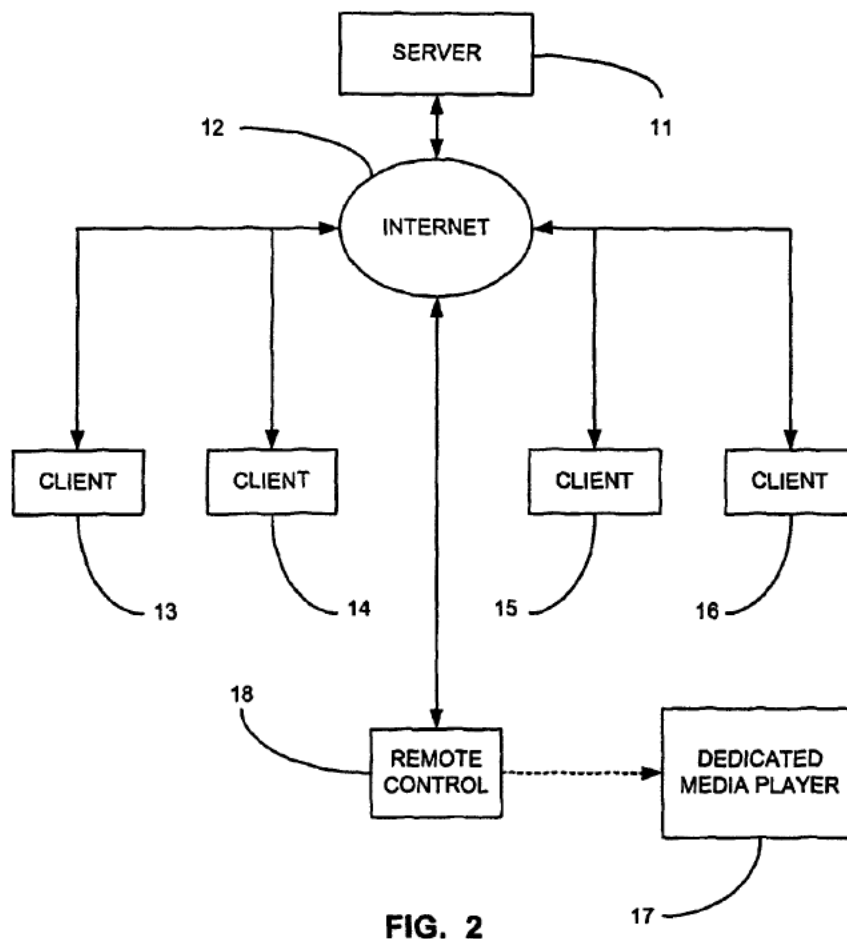


Figure 2 depicts an embodiment of the invention with a playlist communicated from server 11 to remote control 18 via Internet 12. Ex. 1001, 9:1–23. After the

playlist has been communicated to the remote control, the playlist may be displayed on the remote control and used to choose which selection is to be played by dedicated media player 17. *Id.* at 9:5–8. Playlists may be communicated from remote server 11 to the media player 17 and to remote control 18, either directly from the server (*id.* at 9:1–4) or indirectly, through media player 17 to remote control 18, or through remote control 18 to media player 17. *Id.* at 9:9–20. Thus, playlists may be stored in, displayed upon, and used to make selections from either dedicated media player 17, remote control 18, or both. *Id.* at 9:21–23; *see also id.* at 10:20–43 (communication of playlists in embodiment using peer-to-peer network). As summarized by Petitioner, the display of the playlist on the remote control allows the user to select a song to be played on the media player without physically making a selection at the media player. Pet. 5 (citing Ex. 1001, 9:9–23).

### *C. Illustrative Claims*

Claims 1, 2, 6, and 9–12 were the subject of the Petition. Independent claim 1 and dependent claim 9 are the subject of Patent Owner’s Motion to Amend canceling those claims. Of the remaining claims, claims 2 and 6 directly depend from claim 1, and claims 10–12 are independent claims. Independent claims 1 and 11 are reproduced as follows:

1. A method comprising:  
receiving, at a wireless handheld remote control, a playlist from a remote source; and  
presenting, at the wireless handheld remote control, the playlist to a first user associated with the wireless handheld remote control such that the first user is enabled to select

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