

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,
and
LG ELECTRONICS, INC., LG ELECTRONICS U.S.A., INC., and
LG ELECTRONICS MOBILECOMM U.S.A., INC.,
Petitioners,

v.

BLACK HILLS MEDIA, LLC,
Patent Owner.

Case IPR2014-00709
Case IPR2015-00337
Patent 8,028,323 B2

Before BRIAN J. McNAMARA, DAVID C. McKONE, and
FRANCES L. IPPOLITO *Administrative Patent Judges*.

McNAMARA, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review and Grant of Motion for Joinder
37 C.F.R. § 42.108
37 C.F.R. § 42.122(b)

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Introduction

LG Electronics, Inc., LG Electronics U.S.A., Inc., and LG Electronics MobileComm U.S.A., Inc. (collectively, “Petitioner LG”) filed a Petition, Paper 2 (“Pet.”), to institute an *inter partes* review of claims 1–5, 10, 11, 13, 14, and 16–18 (the “challenged claims”) of U.S. Patent No. 8,028,323 B2 (“the ’323 Patent”). 35 U.S.C. § 311. Petitioner LG has also moved to join this proceeding with *Samsung Electronics Co., Ltd. v. Black Hills Media, LLC*, IPR2014-00709 (“the Samsung IPR”). Paper 3 (“Motion for Joinder”). Black Hills Media, LLC (“Patent Owner”) and Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC do not oppose Petitioner LG’s Motion for Joinder.

For the reasons described below, we institute an *inter partes* review of all the challenged claims and grant Petitioner LG’s Motion for Joinder.

Institution on the same grounds as those asserted in the Samsung IPR

The Petition in this proceeding asserts the same grounds as those asserted in the Samsung IPR. On November 4, 2014, we instituted a trial in the Samsung IPR on the following ground:

Claims 1–5, 10, 11, 13, 14, and 16–18 of the ’323 patent are unpatentable under 35 U.S.C. § 103 over U.S. Patent No. 7,454,511 B2 (“Weast”) and U.S. Patent No. 7,668,939 B2 (“Encarnacion”).

In view of the identity of the challenges in the instant Petition and those of the petition in the Samsung IPR, we institute an *inter partes* review in this proceeding on the same ground as that on which we instituted the Samsung IPR. We do not institute *inter partes* review on any other grounds.

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Joinder with the Samsung IPR

The Petition in this proceeding has been accorded a filing date of December 3, 2014, and therefore satisfies the joinder requirement of being filed within one month of our instituting a trial in the Samsung IPR. 37 C.F.R. § 42.122(b). In a teleconference on December 9, 2014, counsel for Petitioner LG represented that the only grounds Petitioner LG seeks to pursue in this proceeding are those on which we instituted the Samsung IPR. Counsel for Petitioner LG also agreed that all filings in the joined proceeding would be made by the petitioner in the Samsung IPR (“Petitioner Samsung”) and that Petitioner LG would not seek discovery other than that sought by Petitioner Samsung. Petitioner Samsung and Petitioner LG further agreed to resolve any disputes between them concerning the conduct of the joined proceeding and to contact the Board if any such matters cannot be resolved. The parties agreed that no additional burdens would be placed on Patent Owner as a result of the joinder.

In consideration of the above, we institute an *inter partes* review in IPR2015-00337 and grant Petitioner LG’s motion to join that proceeding to IPR2014-00709.

ORDER

In view of the foregoing, it is:

ORDERED that IPR2015-00337 is instituted and joined with IPR2014-00709;

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FURTHER ORDERED that the ground on which IPR2014-00709 was instituted is unchanged and no other grounds are instituted in the joined proceeding;

FURTHER ORDERED that the Scheduling Order in place for IPR2014-00709 (Paper 12) is unchanged and applies to the joined proceeding;

FURTHER ORDERED that throughout the joined proceeding, Petitioner Samsung will file all papers jointly on behalf of Petitioner Samsung and Petitioner LG;

FURTHER ORDERED that except as otherwise agreed by counsel, Petitioner Samsung will conduct cross-examination and other discovery on behalf of Petitioner Samsung and Petitioner LG and that Patent Owner is not required to provide separate discovery responses or additional deposition time as a result of the joinder;

FURTHER ORDERED that IPR2015-00337 is terminated under 37 C.F.R. § 42.72 and all further filings in the joined proceeding are to be made in IPR2014-00709; and

FURTHER ORDERED that the case caption in IPR2014-00709 shall be changed to reflect joinder with this proceeding in accordance with the caption on this order.

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PETITIONER SAMSUNG:

Andrea Reister
Gregory Discher
Jay Alexander
COVINGTON & BURLING LLP
areister@cov.com
gdischer@cov.com
jalexander@cov.com

PETITIONER LG:

Dori Johnson Hines
Jonathan R. Stroud
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
dori.hines@finnegan.com
jonathan.stroud@finnegan.com

PATENT OWNER

Lana Gladstein
Thomas Engellenner
PEPPER HAMILTON LLP
gladsteinl@pepperlaw.com
engellenert@pepperlaw.com

Christopher Horgan
CONCERT TECHNOLOGY
chris.horgan@concerttechnology.com