

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,
Petitioner,

v.

BLACK HILLS MEDIA, LLC,
Patent Owner.

Case IPR2014-00711
Patent 8,230,099 B2

Before BRIAN J. McNAMARA, PETER P. CHEN, and
FRANCES L. IPPOLITO, *Administrative Patent Judges*.

CHEN, *Administrative Patent Judge*.

DECISION
On Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

On November 18, 2014, Black Hills Media, LLC's ("Patent Owner") filed a Request for Rehearing (Paper 9, "Req.") of our Decision to Institute (Paper 7, "Dec."), dated November 4, 2014, which instituted *inter partes* review of claims 10–12 of U.S. Patent No. 8,230,099 B2 (Ex. 1001, "the '099 patent").

In its Request, Patent Owner argues that the Decision to Institute (1) applied an erroneous legal standard for the construction of the term "playlist" recited in the challenged claims and (2) overlooked Patent Owner's evidence on the ordinary and customary meaning of "playlist." Req. 1–2.

For the reasons set forth below, the request for rehearing is *denied*.

II. STANDARD OF REVIEW

Under 37 C.F.R. § 42.71(c), "[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion." An abuse of discretion may be determined if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *See Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P'ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). The request must identify, with specificity, all matters that the moving party believes the Board misapprehended or overlooked. *See* 37 C.F.R. § 42.71(d).

III. DISCUSSION

For purposes of the Decision to Institute, we construed the term “playlist” as “a list of media selections.” Dec. 8–10. As we explained, the Specification of the ’099 patent discloses that a “playlist is a list of a user’s favorite selections.” Dec. 9 (citing Ex. 1001, 1:33–34). We also considered the different proposed constructions and supporting evidence provided by the Petitioner and Patent Owner for “playlist.” *Id.* at 9. In the Decision, we adopted Petitioner’s proposed construction, which we had determined to be the broadest reasonable construction in *Yamaha Corporation of America v. Black Hills Media LLC*, Case IPR2013-00597, slip op. at 9 (PTAB Mar. 20, 2014) (Paper 15), also involving the ’099 patent. With respect to Patent Owner’s proposal, we were not persuaded that the broadest reasonable construction of “playlist” is “a list referencing media items arranged to be played in a sequence.” Dec. 9–10.

Additionally, in the Decision to Institute, we provided the general principles governing our claim construction. Dec. 8–9. These general principles are that:

- (1) claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear (*id.* at 8);
- (2) there is a heavy presumption that claim terms are given their ordinary and customary meaning (*id.* at 9); and
- (3) a patentee can act as his own lexicographer and clearly set forth a definition for a claim term (*id.*).

In its Request for Rehearing, Patent Owner argues that the Decision to Institute erred by not adopting Patent Owner’s proposed construction of “playlist” as “a list referencing media items arranged to be played in a

sequence.” Req. 4. Patent Owner asserts that we did not apply the broadest reasonable construction standard because we overlooked the evidence of record on the ordinary and customary meaning of “playlist” and enlarged the scope of the term beyond the ordinary and customary meaning. *Id.* at 3. Patent Owner also contends that “the items in a playlist – including in the context of the ‘099 patent – are arranged in a certain order to be played in a sequence unless and until the user changes the order.” *Id.* at 5 (citing Ex. 2006 ¶¶ 42, 44, 46, 48, 54, 58).

We determined that limiting the meaning of “playlist” to those examples that specify how the items of a playlist are played, such as the order or sequence of the items played, would exclude an embodiment described in the Specification that is not limited in this manner. *See* Dec. 9. We continue to be persuaded that, for the purposes of the Decision to Institute, “playlist” would have been understood by one of ordinary skill in the art as “a list of media selections.”

We also disagree that the Decision to Institute overlooked any evidence provided by the Patent Owner. As discussed above, we considered the Preliminary Response and accompanying exhibits, including the declaration of Gareth Loy. *Id.* Based on the current record, we were persuaded, and remain persuaded, that the Specification and claim language itself requires a broader construction than that espoused by Patent Owner’s arguments and extrinsic evidence.

For the foregoing reasons, Patent Owner has not shown that the Board abused its discretion in instituting the instant proceeding on the grounds specified in the Decision to Institute.

IPR2014-00711
Patent 8,230,099 B2

IV. ORDER

Accordingly, it is hereby ORDERED that Patent Owner's request for rehearing is *denied*.

PETITIONER:

Andrea Reister
areister@cov.com

Gregory Discher
gdischer@cov.com

PATENT OWNER:

Reza Mollaaghababa
mollaaghababar@pepperlaw.com

Thomas Engellenner
engellennert@pepperlaw.com

Christopher Horgan
chris.horgan@concerttechnology.com