

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 IPR2014-00721
Patent 7,917,082 B2

Before BRIAN J. McNAMARA, DAVID C. McKONE, and
TINA E. HULSE, *Administrative Patent Judges*.

HULSE, *Administrative Patent Judge*.

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

I. INTRODUCTION

Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC (collectively “Petitioner”) filed a Petition requesting an *inter partes* review of claims 1 and 11 of U.S. Patent No. 7,917,082 B2 (Ex. 1001, “the ’082 patent”). Paper 1 (“Pet.”). Black Hills Media, LLC (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 6 (“Prelim. Resp.”). We granted the Petition as to claims 1 and 11 of the ’082 patent, and instituted trial on three asserted grounds of unpatentability. Paper 10 (“Dec. Inst.”), 16.

After institution of trial, Patent Owner filed a Motion to Amend, requesting the cancellation of all claims involved in this *inter partes* review proceeding (i.e., claims 1 and 11 of the ’082 patent). Paper 19, 1. Petitioner did not file an opposition to Patent Owner’s Motion to Amend.

The Board has jurisdiction under 35 U.S.C. § 6(c). This Decision is a final written decision under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

Patent Owner’s Motion to Amend requesting cancellation of claims 1 and 11 is *granted*.

A. Related Proceedings

Petitioner states that the ’082 patent is currently the subject of a copending district court case against Petitioner captioned, *Black Hills Media, LLC v. Samsung Electronics Co., Ltd.*, No. 2-13-cv-00379 (E.D. Tex.). Pet. 1; *see also* Paper 5, at 2.

Petitioner also filed a petition for *inter partes* review of certain claims of related U.S. Patent No. 7,835,689 B2. IPR2014-00718, Paper 1. We instituted trial in that proceeding. *Id.* (Paper 11). Patent Owner has filed a motion to amend canceling all involved claims in that proceeding, as well. *Id.* (Paper 20).

B. Grounds of Unpatentability Instituted for Trial

We instituted trial based on the following grounds of unpatentability:

Reference(s)	Basis	Claims Challenged
Hatlelid ¹ and Dwek ²	§ 103	1 and 11
Traversat ³	§ 103	1 and 11
Multicast Security ⁴	§ 103	1 and 11

II. MOTION TO AMEND

In its Motion to Amend, Patent Owner seeks to cancel both claims 1 and 11, which are the only claims subject to this proceeding.⁵ Paper 19, 1. Petitioner did not file an opposition to Patent Owner's Motion to Amend. Accordingly, Patent Owner's Motion to Amend canceling claims 1 and 11 of the '082 patent is *granted*.

Pursuant to 37 C.F.R. § 42.73(b), a party may request judgment against itself at any time during a proceeding. We construe the cancellation of claims such that the patent owner has no remaining claim in the trial to be

¹ Hatlelid et al., US 6,772,195 B1, issued Aug. 3, 2004 (Ex. 1003).

² Dwek, US 6,248,946 B1, issued June 19, 2001 (Ex. 1004).

³ Traversat et al., US 7,065,579 B2, issued June 20, 2006 (Ex. 1005).

⁴ Gong et al., *Multicast Security and Its Extension to a Mobile Environment*, 1 WIRELESS NETWORKS 281–95 (1995) (Ex. 1006).

⁵ We note that Patent Owner did not request a conference call with the Board before filing its Motion to Amend, as required by 37 C.F.R. § 42.121(a). Under the circumstances of this case, we exercise our discretion and determine that it is appropriate to waive the requirements of this rule. See 37 C.F.R. § 42.5(b).

a request for adverse judgment. *See* 37 C.F.R. § 42.73(b)(2). Here, Patent Owner requests cancellation of all claims of the '082 patent on which a trial was instituted, such that Patent Owner would have no remaining claim in the trial. Thus, it is appropriate to enter judgment at this time.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's Motion to Amend requesting cancellation of claims 1 and 11 of the '082 patent is treated as a request for adverse judgment and is *granted*;

FURTHER ORDERED that judgment is entered against Patent Owner with respect to claims 1 and 11 of the '082 patent; and

FURTHER ORDERED that because this is a Final Decision, parties to the proceeding seeking judicial review of the Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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