

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 IPR2014-00717
Patent 6,108,686
Case IPR2014-00735
Patent 6,618,593 B1¹

Before BRIAN J. McNAMARA, DAVID C. McKONE, STACEY G. WHITE,
PETER P. CHEN, FRANCES L. IPPOLITO, TINA A. HULSE, *Administrative
Patent Judges.*

McNAMARA, *Administrative Patent Judge.*

ORDER CONCERNING PATENT OWNER'S UNAUTHORIZED
SUBSTANTIVE E-MAIL
Conduct of the Proceeding
37C.F.R. § 42.5

¹ This Order addresses issues that are identical in related cases. Therefore, we exercise our discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style heading in any subsequent papers.

This paper concerns the impropriety of e-mail correspondence received by the Board from Andrew Crain, counsel for Black Hills Media, Inc. (“Patent Owner”) on July 9, 2014. The subject line of the e-mail identifies it as “Inquiry Following June 30 Conference re: IPR2014-00717 & 735.” As discussed further below, Mr. Crain’s e-mail is inappropriate. Any further such unauthorized correspondence with the Board will likely result in sanctions against Mr. Crain and Patent Owner.

On June 25, 2014, the Board received e-mail correspondence from Vivek Ganti, counsel for Patent Owner, requesting a teleconference to discuss additional discovery concerning whether Samsung Electronics Co., Ltd.; Samsung Electronics America, Inc.; and Samsung Telecommunications America, LLC (collectively, “Petitioner”) should have identified Google, Inc., as a real party in interest in this proceeding. Patent Owner requested that we conduct the call on either June 27, 2014, or June 30, 2014.

During a teleconference on June 30, 2014, Andrew Crain, counsel for Patent Owner, argued that a recently discovered mobile application distribution agreement constitutes circumstantial evidence that Google, Inc., is a real party in interest in this proceeding. After hearing arguments from both Patent Owner and Petitioner, we advised the parties that the panel would consider the matter and that we would notify them in due course whether Patent Owner would be authorized to file a motion for additional discovery. During the teleconference, we did not authorize Patent Owner to file such a motion. We do not address Patent Owner’s request for authorization to file such a motion in this paper.

Patent Owner’s July 9, 2014, e-mail correspondence, addressed to “Dear PTAB Staff” and signed by Mr. Crain, reiterates arguments Mr. Crain made to the panel during the June 30, 2014 teleconference and includes as an attachment the

alleged mobile application distribution agreement. This e-mail, for all practical purposes, constitutes an unauthorized, off-the-record brief in support of Patent Owner's request for additional discovery.

The submission of such unauthorized correspondence raises several issues. For example, the Board must respond to such unauthorized correspondence, distracting us from our mission to secure the just, speedy, and inexpensive resolution of every proceeding. *See* 37 C.F.R. §42.1 (b). In addition, the opposing party has no formal manner of response. Patent Owner's argument, presented in the form of an off-the-record e-mail, prejudices Petitioner, who has no mechanism to oppose on the record, and whose only alternative is to oppose by sending its own unauthorized off-the-record e-mail. We do not conduct off-the-record proceedings, and for this reason alone, the content of Mr. Crain's e-mail will not be considered.

Finally, such correspondence circumvents our rules prohibiting the filing of a motion without prior authorization. *See* 37 C.F.R. § 42.20(b). In this case, Mr. Crain participated in the June 30, 2014, conference call and was aware that we did not authorize the filing of a motion for additional discovery. The subsequent submission of arguments and documents supporting such a motion via e-mail is unacceptable.

As it was unauthorized, we will not consider any of the content in Mr. Crain's July 9, 2014 e-mail on behalf of the Patent Owner. Because we do not consider the content of the e-mail, we also do not authorize Petitioner to respond to it.

Finally, we remind the parties that any further such conduct will likely result in the imposition of sanctions against counsel and the party.

In consideration of the above, it is:

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ORDERED that the July 9, 2014, e-mail from Mr. Crain will not be considered by the Board;

FURTHER ORDERED that Petitioner is not authorized to respond to Mr. Crain's July 9, 2014, e-mail; and

FURTHER ORDERED that, except as otherwise authorized in the Rules of Practice in Patent Cases, 37 C.F.R. § 42 et. seq., no motions or other substantive correspondence may be filed in this proceeding without prior, express authorization.

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