

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

FACEBOOK, INC. and INSTAGRAM, LLC,  
Petitioner,

v.

SKKY, LLC,  
Patent Owner.

---

Case CBM2017-00003  
Patent 9,219,810 B2

---

Before KARL D. EASTHOM, WILLIAM V. SAINDON, and  
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

DECISION

*Denying Institution of Covered Business Method Patent Review*  
37 C.F.R. § 42.208

## I. INTRODUCTION

Petitioner, collectively Facebook, Inc. and Instagram, LLC, filed a Petition (Paper 2, “Pet.”) requesting covered business method (“CBM”) patent review of claims 1–7 of U.S. Patent No. 9,219,810 B2 (Ex. 1001, the “’810 patent”) under Section 18 of the Leahy-Smith America Invents Act, Pub. L. No. 112–29, 125 Stat. 284, 329 (2011) (“AIA”). Patent Owner, Skky, LLC, filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). With its Preliminary Response, Patent Owner provided evidence (Ex. 2001) that it filed with the Office a statutory disclaimer of claim 5 of the ’810 patent pursuant to 37 C.F.R. § 1.321(a). Prelim. Resp. 2 (citing Ex. 2001). After the Preliminary Response, Petitioner filed a Preliminary Reply to Patent Owner’s Preliminary Response, as authorized by the panel pursuant an e-mail request by Petitioner, to address the consequences of Patent Owner’s disclaimer of claim 5. Paper 7 (“Pet. Prelim. Reply”). In response to the Preliminary Reply, Patent Owner filed a Preliminary Sur-Reply, also as authorized by the panel. Paper 8 (“PO Sur-Reply”).

We have jurisdiction under 35 U.S.C. § 324(a).

Section 18(a)(1) of the AIA provides that a covered business method patent review “shall be regarded as, and shall employ the standards and procedures of, a post-grant review” with certain exceptions not relevant here. Under 35 U.S.C. § 324(a), a post-grant review cannot be “instituted unless the Director determines that the information presented in the petition . . . would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.”

Upon consideration of the record, we determine that the ’810 patent is not a covered business method patent and accordingly deny the Petition.

CBM2017-00003  
Patent 9,219,810 B2

*A. Related Matters*

Petitioner states that Patent Owner asserted the '810 patent against Petitioner in pending litigation, namely *Skky, LLC v. Facebook, Inc.*, No. 16:cv-00094 (D. Minn.) (filed Jan. 15, 2016). *See* Pet. 3. Petitioner lists related PTAB proceedings as follows: CBM2016-00091 (challenging U.S. Pat. No. 9,037,502, a continuation of the same application to which the '810 patent also claims priority); and IPR2014-01236 (challenging U.S. Patent No. 7,548,875, the grandparent to the '810 patent). In addition to CBM2016-00091, Patent Owner lists several related PTAB proceedings and other related matters. *See* Paper 4, 2–3. Listed PTAB proceedings involving the instant parties include the following: CBM2017-00002; CBM2017-00006; CBM2017-00007; IPR2017-00088; IPR2017-00089; and IPR2017-00092; IPR2017-00097. *Id.* at 2.

*B. The '801 Patent*

The '801 patent describes a method for delivering audio and/or visual media files, including recordings of songs, musical compositions, ringtones, video, films, television shows, and personal recordings, wirelessly or non-wirelessly to devices for playback of the content, with or without an Internet connection. Ex. 1001, Abstract, 1:19–21.

Figure 5 of the '801 patent follows:

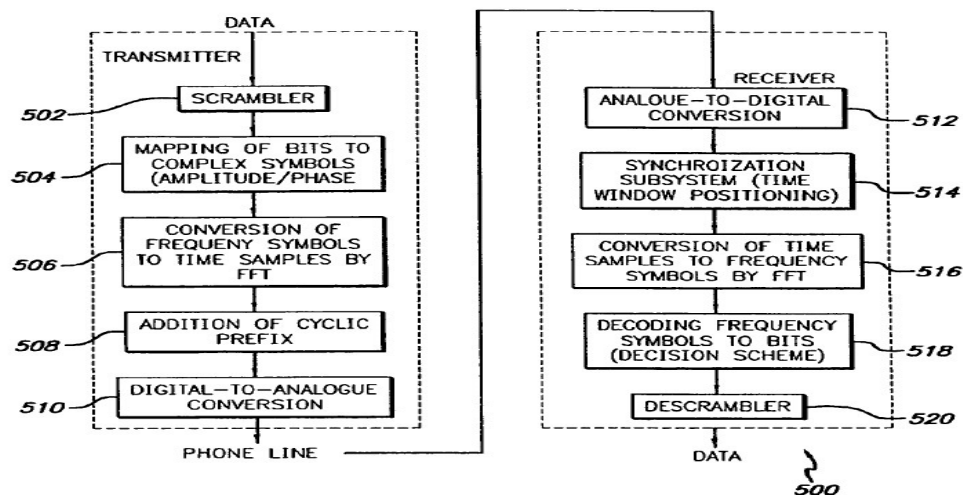


FIG. 5

According to the Specification, Figure 5 depicts a flow chart for delivering data content by transmitting data over an audio channel of a wireless telephone. *See* Ex. 1001, 16:29–34. Data transmission method 500 includes transferring data from a server by converting stored digital information to analog information (i.e., D/A conversion, step 510) wherein the server transmits the signal to a receiver using an orthogonal frequency-division multiplex scheme (OFDM). *See id.* at 16:29–17:46; Ex. 1002 ¶¶ 42–45, 93–95. Prior to the D/A conversion, the transmitter scrambles data representing a data file (502), maps that to complex frequency symbols (504), converts that to time samples using a Fast Fourier Transform (FFT) (506), and adds a cyclic prefix (508). Ex. 1001, 16:37–41. After the D/A conversion and OFDM modulation, a telephone receiver decodes the modulated symbols by a reverse conversion process (i.e., an analog to digital (A/D) conversion process) to recover the transmitted audio or video file to be stored as digital information (512–520). *See id.* at 16:41–46, 18:5–11.

*C. Challenged Claim 1*

Claim 1, the sole independent challenged claim of the '810 patent, follows:

1. A method of delivering a data file between one or more servers to a user's wireless device, the method comprising:
  - receiving the data file from the wireless device, the wireless device including a digital signal processor and a receiver configured for the handling of digital media transmitted by orthogonal frequency-division multiplex modulation, wherein the data file is routed through a cellular network;
  - storing the data file received from the wireless device in the user's virtual storage locker on the one or more servers;
  - receiving a request from the wireless device for the data file; and
  - providing for transmitting the data file to the wireless device using orthogonal frequency-division multiplex modulation based on the received request.

Ex. 1001, 32:63–33:11.

*D. The Alleged Grounds of Unpatentability*

The Petition asserts the unpatentability of claims 1–7 for failure to recite patent-eligible subject matter under 35 U.S.C. § 101, for failure to correspond in scope with that which the inventor regards as the invention under 35 U.S.C. § 112(b) (pre-AIA 35 U.S.C. § 112 ¶ 2), and for lack of written description under 35 U.S.C. § 112(a) (pre-AIA 35 U.S.C. § 112 ¶ 1). Pet. 30–31. Based on Patent Owner's disclaimer of claim 5, only challenges to claims 1–4, 6, and 7 remain. To support its challenges, Petitioner relies on the Declaration of William H. Beckmann, Ph.D. Ex. 1002.

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.