

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 CBM2017-00007
Patent 9,203,956 B2

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

PAULRAJ, *Administrative Patent Judge*.

DECISION

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

I. INTRODUCTION

Facebook, Inc. and Instagram, LLC (collectively, “Petitioner”) filed a Petition (Paper 1, “Pet.”), requesting institution of a covered business method patent review of claims 1–7 of U.S. Patent No. 9,203,956 B2 (Ex. 1001, “the ’956 patent”). Skky LLC. (“Patent Owner”) timely filed a Preliminary Response (Paper 8, “Prelim. Resp.”). With its Preliminary Response, Patent Owner provided evidence that it filed with the Office a statutory disclaimer of claims 1–7 of the ’956 patent pursuant to 37 C.F.R. § 1.321(a). Ex. 2001.

We have statutory authority under AIA § 18(a)(1) and 35 U.S.C. § 324(a). In view of Patent Owner’s disclaimer of all the challenged claims, we deny institution of a covered business method patent review of the ’956 patent.

II. DISCUSSION

In its Preliminary Response, Patent Owner contends that “[b]ecause each claim petitioned for review is now disclaimed, the Petition is now moot.” Prelim. Resp. 3.

A patentee may “make disclaimer of any complete claim Such disclaimer shall be in writing, and recorded in the Patent and Trademark Office; and it shall thereafter be considered as part of the original patent.” 35 U.S.C. § 253(a). When a patent owner files a statutory disclaimer with its preliminary response, “no post-grant review will be instituted based on disclaimed claims.” 37 C.F.R. § 42.207(e). As prior panels have held, and we agree, “the decision whether to institute a covered business method patent review is based on the ‘claims of the patent as they exist at the time of the decision,’ not as they may have existed at some previous time.” *Google*

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Inc. v. SimpleAir, Inc., Case CBM2015-00019, slip op. at 5 (PTAB Aug. 19, 2015); *see also Great West Cas. Co. v. Intellectual Ventures II LLC*, Case CBM2015-00171, slip op. at 7 (PTAB Feb. 9, 2016) (“[F]or the purposes of whether or not to institute a covered business method patent review, we treat [disclaimed] claims . . . as never having existed.”).

We have confirmed that Patent Owner has complied with the requirements for a statutory disclaimer of claims 1–7 of the ’956 patent. Accordingly, we decline to institute a covered business method review based on the Petition.

III. ORDER

In consideration of the foregoing, it is hereby
ORDERED that pursuant to 35 U.S.C. § 324(a), a covered business method patent review is not instituted as to any claim of the ’956 patent.

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