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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 IPR2017-00602
Patent 9,219,810 B2

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

EASTHOM, *Administrative Patent Judge*.

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

I. INTRODUCTION

Facebook, Inc. and Instagram LLC ("Petitioner") filed a Petition (Paper 2, "Pet.") requesting an *inter partes* review of claims 1–7 of U.S. Patent No. 9,219,810 B2 (Ex. 1001, "the '810 patent"). Skky, LLC ("Patent Owner") filed a Preliminary Response (Paper 6, "Prelim. Resp.") to the Petition.

In our Institution Decision (Paper 9, "Inst. Dec."), we instituted an *inter partes* review of claims 1–4, 6, and 7 of the '810 patent ("the challenged claims")[1] on alternative grounds of obviousness over 1) Yukie, Gatherer, Prust, and Frodigh (ground 1), and 2) Yukie, Gatherer, Prust, O'Hara, Tagg, and Pinard (ground 2). A table of references and evidence relied upon in the Petition follows:

Reference or Declaration	**Exhibit No.**
Declaration of Tal Lavian, Ph.D. ("Lavian Declaration")	Ex. 1002
Pinard et al., U.S. Patent No. 5,815,811 (filed Oct. 27, 1995, issued Sept. 29, 1998) ("Pinard")	Ex. 1003
Yukie et al., U.S. Patent No. 6,956,833 B1 (filed April 4, 2000, issued Oct. 18, 2005) ("Yukie")	Ex. 1004
Gatherer et al., *DSP-Based Architectures for Mobile Communications: Past, Present and Future*, 38:1 IEEE COMMUNICATIONS MAGAZINE 84–90 (2000) ("Gatherer")	Ex. 1005
Frodigh et al., U.S. Patent No. 5,726,978 (issued Mar. 10, 1998) ("Frodigh")	Ex. 1006
Prust, U.S. Patent No. 6,714,968 B1 (filed Feb. 9, 2000, issued Mar. 30, 2004) ("Prust")	Ex. 1013

[1] Prior to its Preliminary Response, Patent Owner filed a statutory disclaimer disclaiming claim 5 of the '810 patent. Prelim. Resp. 4. Accordingly, we did not institute on claim 5. *See* 37 C.F.R. § 42.107 ("No *inter partes* review will be instituted based on disclaimed claims."); Inst. Dec. 2.

Tagg, U.S. Patent No. 8,996,698 B1 (filed Nov. 3, 2000, issued Mar. 31, 2015) ("Tagg")	Ex. 1060
Bob O'Hara and Al Petrick, IEEE 802.11 HANDBOOK, A DESIGNER'S COMPANION (1999) ("O'Hara")	Ex. 1061

See Inst. Dec. 4; Pet. 3, 10–19.

After institution, Patent Owner filed a Response (Paper 12, "PO Resp."), and Petitioner filed a Reply (Paper 16, "Pet. Reply"). The parties waived their right to an oral hearing.

This Final Written Decision issues pursuant to 35 U.S.C. § 318(a). For the reasons set forth below, Petitioner has shown by a preponderance of the evidence that claims 1–4, 6, and 7 of the '810 patent are unpatentable.

A. Related Proceedings

The parties indicate that the following district court case involves the '810 patent: *Skky, LLC v. Facebook, Inc.*, No. 0:16-cv-00094 (D. Minn.). Pet. 1; Paper 4, 2. The following petitions for *inter partes* review or covered business method review relate to the instant proceeding:

Case No.	**Involved U.S. Patent No.**
IPR2014-01236	U.S. Patent No. 7,548,875
IPR2017-00088	U.S. Patent No. 9,124,718
IPR2017-00089	U.S. Patent No. 9,118,693
IPR2017-00092	U.S. Patent No. 9,124,717
IPR2017-00097	U.S. Patent No. 8,892,465
IPR2017-00550	U.S. Patent No. 9,037,502
IPR2017-00641	U.S. Patent No. 9,203,956
IPR2017-00685	U.S. Patent No. 9,203,870
IPR2017-00687	U.S. Patent No. 9,215,310
CBM2016-00091	U.S. Patent No. 9,037,502
CBM2017-00002	U.S. Patent No. 9,203,870
CBM2017-00003	U.S. Patent No. 9,219,810
CBM2017-00006	U.S. Patent No. 9,215,310
CBM2017-00007	U.S. Patent No. 9,203,956

Pet. 1–2; Paper 4, 2. The Board denied institution in each of the covered business method reviews after Patent Owner disclaimed claims having a financial component or disclaimed all claims. The Board also denied institution in IPR2017-00641 in view of Patent Owner's disclaimer of the challenged claims. The Board issued final written decisions in IPR2014-01236, IPR2017-00088, IPR2017-00089, IPR2017-00092, and IPR2017-00097.[2]

B. The '810 Patent

The '810 patent discloses delivering the audio or visual files, which may represent songs, films, or other recordings, from one or more servers to an electronic device. *Id.*, [57]. The system may transmit the files in a compressed format, and the electronic device receives and plays the files on demand by a user. *Id.* The system employs a transmitter and receiver that use an orthogonal frequency-division multiplex ("OFDM") modulation technique to transfer the files. *Id.* at 16:57–17:40, Fig. 5.

C. Illustrative Claim

Independent claim 1, from which claims 2–4, 6, and 7 depend, 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;

[2] The U.S. Court of Appeals for the Federal Circuit affirmed the Board's decision in IPR2014-01236, finding claims 1–3, 5, and 15–23 of U.S. Patent No. 7,548,875 B2 unpatentable. *Skky, Inc. v. MindGeek, s.a.r.l.*, 859 F.3d 1014, 1016 (Fed. Cir. 2017).

> storing the data file received from the wireless device in the user's virtual storage locker on the [sic] 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.

II. ANALYSIS

A. Level of Ordinary Skill in the Art

Petitioner's declarant, Tal Lavian, Ph.D., states that a person of ordinary skill in the art would have had "at least a bachelor's degree in computer science, computer engineering, or electrical engineering (or equivalent degree or experience) with at least four years of experience with wireless communications systems and at least two years of experience with the communication of digital media." Ex. 1002 ¶ 15. Patent Owner does not provide a definition of the level of ordinary skill in the art. Patent Owner also does not dispute Dr. Lavian's definition. Based on the evidence of record, including the types of problems and solutions described in the '810 patent and the asserted prior art, we agree with and adopt Dr. Lavian's definition of the level of ordinary skill in the art. *Id.* ¶¶ 15–17.

B. Claim Construction

The Board interprets claims of an unexpired patent using the broadest reasonable interpretation in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–45 (2016). "Under a broadest reasonable interpretation, words of the claim must be given their plain meaning, unless such meaning is inconsistent with the specification and prosecution history." *TriVascular*,

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