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Paper 9
Entered: July 13, 2017

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*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

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. Prior to its Preliminary response, Patent Owner filed a disclaimer disclaiming claim 5 of the '810 patent. *Id.* at 4. Pursuant to the disclaimer, claim 5 will not be considered in this proceeding. *See* 37 C.F.R. § 42.107 ("No *inter partes* review will be instituted based on disclaimed claims.").

An *inter partes* review may not be instituted "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a). For the reasons set forth below, Petitioner demonstrates a reasonable likelihood of prevailing in showing the unpatentability of claims 1–4, 6, and 7 of the '810 patent. Accordingly, we institute an *inter partes* review as to claims 1–4, 6, and 7 of the '810 patent on the grounds specified below.

A. Related Proceedings

The parties indicate that the assertion of the '810 patent in the following district court case: *Skky, LLC v. Facebook, Inc.*, No. 16-cv-00094 (D. Minn.) (filed Jan. 15, 2016). Pet. 1; Paper 4, 2. The parties also indicate that the several PTAB proceedings, including *inter partes* reviews and covered business method reviews, relate to the instant case. *See* Pet. 1–2; Paper 4, 2–3. Additionally, in *Skky, Inc. v. MindGeek, s.a.r.l.*, 859 F.3d 1014 (Fed. Cir. 2017), the Federal Circuit affirmed the Board's final written decision in IPR2014-01236 determining that certain claims of U.S. Patent

7,548,875, to which the'810 patent claims priority, were unpatentable as obvious.

B. The '810 Patent

The '810 patent describes delivering audio and/or visual files to an electronic device. Ex. 1001, Abstract, 1:19–21. Specifically, the '810 patent discloses delivering the audio or visual files, such as songs or films, from one or more servers to the electronic device. *Id.* at Abstract. The system transmits the files in a compressed format, and the electronic device receives and plays the files on demand by a user. *Id.* The system employs an orthogonal frequency-division multiplex ("OFDM") modulation technique to download the files. *Id.* at 16:57–17:40.

C. Illustrative Claim

Independent claim 1, from which claims 2–4, 6, and 7 depend, recites as 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 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.

D. Evidence of Record

Petitioner relies on the following references and declaration (Pet. 3):

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, U.S. Patent No. 6,956,833 B1 (filed April 4, 2000, issued Oct. 18, 2005) ("Yukie")	Ex. 1004
Alan 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
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

E. Asserted Grounds of Unpatentability

Petitioner asserts that claims 1–4, 6, and 7 are unpatentable under 35 U.S.C. § 103(a) based on the following alternative grounds: 1) Yukie, Gatherer, Prust, and Frodigh; and 2) Yukie, Gatherer, Prust, O'Hara, Tagg, and Pinard. Pet. 3.

II. ANALYSIS

A. 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. *See* 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–45 (2016). Petitioner submits constructions for two claim terms recited in claim 1, "cellular network" and "virtual storage

locker." Pet. 4. Patent Owner contends Petitioner's constructions are "unreasonably broad." Prelim. Resp. 6. Nevertheless, Patent Owner does not provide an express construction for the terms. *Id.* at 6–7.

On this record and for purposes of this decision, no claim terms require express construction to resolve the parties' disputes regarding the asserted grounds of unpatentability. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) ("[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.").

B. Asserted Grounds of Unpatentability

1. Obviousness of Claims 1–4, 6, and 7 over Yukie, Gatherer, Prust, and Frodigh

Petitioner argues that claims 1–4, 6, and 7 would have been obvious over Yukie, Gatherer, Prust, and Frodigh. Pet. 3. For the reasons discussed below, Petitioner demonstrates a reasonable likelihood of prevailing in showing that claims 1–4, 6, and 7 would have been obvious over Yukie, Gatherer, Prust, and Frodigh.

The preamble of claim 1 recites "[a] method of delivering a data file between one or more servers to a user's wireless device, the method comprising." Claim 1 also recites "receiving the data file from the wireless device." Petitioner relies on Yukie's disclosure of allowing a user to upload and retrieve data to and from a remote server wirelessly, using a device that may include a "cellular phone," or telephonically enabled personal digital assistant (PDA). Pet. 19 (citing Ex. 1004, 2:31–41, 3:42–48; 10:41–43; 16:64–17:6). Petitioner also relies on Yukie's disclosure of user wireless device 10 sending different types of data to data server 16 for storage and later access by user device 10. *Id.* at 20–21 (citing Ex. 1004, 2:31–41, 4:23–

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