

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 IPR2017-00641
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 *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Facebook, Inc. and Instagram, LLC (collectively, “Petitioner”) filed a Petition (Paper 2, “Pet.”), requesting institution of an *inter partes* review of claims 1–3 of U.S. Patent No. 9,203,956 B2 (Ex. 1001, “the ’956 patent”). Skky LLC. (“Patent Owner”) timely filed a Preliminary Response (Paper 6, “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 35 U.S.C. § 314(a). In view of Patent Owner’s disclaimer of all the challenged claims, we deny institution of an *inter partes* 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. 1.

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, “[n]o *inter partes* review will be instituted based on disclaimed claims.” 37 C.F.R. § 42.107(e).

As we previously indicated with respect to our denial of institution of a covered business method patent review in CBM2017-00007, which concerned the same patent, we have confirmed that Patent Owner has complied with the requirements for a statutory disclaimer of claims 1–7 of the ’956 patent. *See Facebook, Inc. v. Skky, LLC*, Case CBM2017-00007,

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Decision Denying Institution of Covered Business Method Patent Review (PTAB Apr. 10, 2017) (Paper 9), slip op. at 2–3. Accordingly, for the same reason, we decline to institute an *inter partes* review based on the current Petition.

III. ORDER

In consideration of the foregoing, it is hereby
ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes*
review is not instituted as to any claim of the '956 patent.

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