Trials@uspto.gov
Tel: 571-272-7822

Paper No. 22
Entered: July 11, 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 IPR2017-00685
Patent 9,203,870 B2

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

SAINDON, *Administrative Patent Judge*.

FINAL WRITTEN DECISION

Finding All Challenged Claims Unpatentable
35 U.S.C. § 318(a)
Dismissing Petitioner's Motion to Exclude
37 C.F.R. § 42.64(c)

I. INTRODUCTION

We have jurisdiction under 35 U.S.C. § 6. The evidentiary standard is a preponderance of the evidence. *See* 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). This Final Written Decision (hereinafter, "Decision") is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

Upon review of Petitioner's Petition (Paper 2, "Pet.") and Patent Owner's Preliminary Response (Paper 7), we instituted an *inter partes* review of claims 8 and 10–14 of U.S. Patent No. 9,203,870 B2 (Ex. 1001, "the '870 patent"). Paper 10 ("Dec. on Inst."). Patent Owner subsequently filed a Response to the Petition (Paper 13, "PO Resp."), to which Petitioner filed a Reply (Paper 18, "Pet. Reply"). The parties waived their right to an oral hearing. Upon consideration of the arguments and evidence before us, we determine that Petitioner has established by a preponderance of the evidence that claims 8 and 10–14 of the '870 patent are unpatentable.

In this Decision, we also dismiss Petitioner's Motion to Exclude (Paper 19).

A. Related Matters

The parties indicate that the '870 patent is at issue 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 this case. *See* Pet. 1; 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 '870 patent claims priority, were unpatentable as obvious.

B. The '870 Patent

The '870 patent describes delivering audio and/or visual files to an electronic device. Ex. 1001, Abstract, 1:19–21. Specifically, the '870 patent discloses delivering the audio or visual files, such as songs or films, from one or more servers to the electronic device. *Id.* at 1:63–2:2. The system employs an orthogonal frequency-division multiplex ("OFDM") modulation technique for data transmission. *Id.* at 16:57–17:39.

C. Challenged Claims

Petitioner challenges claims 8 and 10–14, of which claim 8 is independent. Claim 8 is reproduced below, with [a]–[e] designations added for ease of reference.

> 8. A method for distributing electronic content over a cellular network to a user operating a cellular phone, the method being executable by a computer system that includes server hardware and a database, the method comprising:
> [a.] providing for the transmission to the cellular phone by orthogonal frequency-division multiplex (OFDM) modulation of a database of electronically accessible data files, each data file being subject to a copyright owner;
> [b.] receiving, by the computer system, a selection from the cellular phone corresponding to at least one of the data files;
> [c.] providing for the transmission of, by the computer system and in response to the received selection, a portion of the selected data file to the cellular phone electronic device;
> [d.] receiving, by the computer system, a request for the data file for which the portion was provided to the cellular phone electronic device; and
> [e.] providing for the transmitting, by the computer system, of the requested data file to the cellular phone, said cellular

phone including a digital signal processor configured to receive the data file over a cellular network by orthogonal frequency-division multiplex (OFDM) modulation.

D. Prior Art and Asserted Grounds

Petitioner asserts that claims 8 and 10–14 of the '870 patent are unpatentable under 35 U.S.C. § 103 on the following grounds:

References	**Claims Challenged**
Rolf,[1] Fritsch,[2] and Gatherer,[3] Frodigh,[4] and Hacker[5]	8 and 12–14
Rolf, Fritsch, Gatherer, Frodigh, Hacker, and Bell[6]	10 and 11
Rolf, Fritsch, Gatherer, Hacker, O'Hara,[7] Tagg,[8] and Pinard[9]	8 and 12–14
Rolf, Fritsch, Gatherer, Hacker, Bell, O'Hara, Tagg, and Pinard	10 and 11

[1] U.S. Patent No. 7,065,342, issued June 20, 2006 (Ex. 1003).

[2] U.S. Patent No. 6,233,682, issued May 15, 2001 (Ex. 1004).

[3] Alan Gatherer et al., *DSP-Based Architectures for Mobile Communications: Past, Present and Future*, 38:1 IEEE Communications Magazine 84–90 (2000) (Ex. 1005).

[4] U.S. Patent No. 5,726,978, issued Mar. 10, 1998 (Ex. 1006).

[5] Scot Hacker, *MP3 The Definitive Guide* (O'Reilly & Assoc., pub., 2000) (Ex. 1062).

[6] U.S. Pat. App. Pub. No. 2002/0065826, published May 30, 2002 (Ex. 1068).

[7] Bob O'Hara and Al Petrick, *IEEE 802.11 Handbook, A Designer's Companion* (1999) (Ex. 1061).

[8] U.S. Patent No. 8,996,698 B1, filed Nov. 3, 2000, issued Mar. 31, 2015 (Ex. 1060).

[9] U.S. Patent No. 5,815,811, issued Sept. 29, 1998 (Ex. 1025).

Petitioner also relies on the declaration of Tal Lavian, who holds a Ph.D. in computer science, specializing in networking and communications (Ex. 1002 ¶ 1).

II. ANALYSIS

A. Claim Construction

We interpret the claims of an unexpired patent using the broadest reasonable interpretation in light of the specification of the patent. 37 C.F.R. § 42.100(b). Under that standard, a claim term generally is given its ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Although our claim interpretation cannot be divorced from the specification, *see Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1298 (Fed. Cir. 2015) (quoting *In re NTP, Inc.*, 654 F.3d 1279, 1288 (Fed. Cir. 2011)), we must be careful not to import limitations from the specification that are not part of the claim language, *see SuperGuide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004). Any special definition for a claim term must be set forth in the specification with reasonable clarity, deliberateness, and precision. *See In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

In its Petition, Petitioner proposed a construction for the term "cellular network" in claim 8: a "network in which wireless communications are provided through a series of 'cells,' each cell providing network access for a particular geographic area." Pet. 6–7.[10] In its Preliminary Response, Patent

[10] According to Petitioner, the construction of this term is only relevant to

DOCKET ALARM

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.