

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FACEBOOK, INC. and INSTAGRAM LLC,  
Petitioner,

v.

SKKY, LLC,  
Patent Owner.

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Case IPR2017-00687  
Patent 9,215,310 B2

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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 1–3 and 5–13 of U.S. Patent No. 9,215,310 B2 (Ex. 1001, “the ’310 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, 3, 5–10, 12, and 13 of the ’310 patent (“the challenged claims”) 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 3); and, claim 9 on alternative grounds based on each of those two grounds further in view of Chan (grounds 2 and 4). *See* Inst. Dec. 30.<sup>1</sup>

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, U.S. Patent No. 6,956,833 B1 (filed April 4, 2000, issued Oct. 18, 2005) (“Yukie”)	Ex. 1004
Alan Gatherer et al., <i>DSP-Based Architectures for Mobile Communications: Past, Present and Future</i> , 38:1 IEEE COMMUNICATIONS MAGAZINE 84–90 (2000) (“Gatherer”)	Ex. 1005

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<sup>1</sup> Prior to its Preliminary Response, Patent Owner filed a statutory disclaimer disclaiming claim 2 and 11 of the ’310 patent. Prelim. Resp. 6. Accordingly, we did not institute on claims 2 and 11. *See* 37 C.F.R. § 42.107 (“No *inter partes* review will be instituted based on disclaimed claims.”); Inst. Dec. 2.

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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
Terrence Chan, UNIX SYSTEM PROGRAMMING USING C++ (1997) (“Chan”)	Ex. 1069

See Inst. Dec. 4; Pet. 3, 9–15.

After institution, Patent Owner filed a Response (Paper 12, “PO Resp.”), and Petitioner filed a Reply (Paper 17, “Pet. Reply”). The parties did not request 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, 3, 5–10, 12, and 13 of the ’310 patent are unpatentable.

#### A. Related Proceedings

The parties indicate that the following district court case involves the ’310 patent: *Skky, LLC v. Facebook, Inc.*, No. 16-cv-00094 (D. Minn., filed Jan. 15, 2016). Pet. 1; Paper 3, 2–3. 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

IPR2017-00602	U.S. Patent No. 9,219,810
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

See Paper 3, 2–3. 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.<sup>2</sup>

#### *B. The ’310 Patent*

The ’310 patent discloses delivering audio or visual files, which may represent songs, films, or other recordings, from one or more servers wirelessly to an electronic device. Ex. 1001, [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.

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<sup>2</sup> 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).

*C. Illustrative Claims*

Independent challenged claim 1, from which challenged claims 3 and 5–9 depend, follows:

1. A method for wirelessly transmitting over a cellular network a data file between a cellular phone and a server, the server comprising a non-transitory virtual storage locker, the method comprising:

creating the virtual storage locker associated with the cellular phone;

receiving a data file from the cellular phone, said cellular phone including a receiver and a digital signal processor configured for receiving and processing data files transmitted by orthogonal frequency-division multiplex modulation;

storing, in the virtual storage locker, the data file received from the cellular phone;

receiving a request for the data file;

and providing for the transmission of the data file to the cellular phone using orthogonal frequency-division multiplex (OFDM) modulation in response to the received request from the cellular phone.

Ex. 1001, 32:62–33:12.

Independent challenged claim 10, from which challenged claims 12 and 13 depend, tracks claim 1 with similar limitations, as follows:

10. A system for wirelessly transmitting a digital data file to a cellular phone, the system comprising:

a server including a non-transitory virtual storage locker configured to store a plurality of data files; and

a cellular communication network operably coupling the server and the cellular phone, said cellular phone including a receiver and a digital signal processor configured for receiving and processing files transmitted by orthogonal frequency-division multiplex modulation wherein the server is configured to:

create the virtual storage locker associated with the cellular phone;

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