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571–272–7822

Paper 9
Entered: July 26, 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 IPR2017-00687
Patent 9,215,310 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 1–3 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. Prior to its Preliminary response, Patent Owner filed a disclaimer disclaiming claims 2 and 11 of the '310 patent. *Id.* at 6 (citing Ex. 2001). Pursuant to the disclaimer, originally challenged claims 2 and 11 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, 3, 5–10, 12, and 13 of the '310 patent. Accordingly, we institute an *inter partes* review as to claims 1, 3, 5–10, 12, and 13 of the '310 patent on the grounds specified below.

A. Related Proceedings

The parties indicate that the '310 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. 1–2; 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 '310 Patent

The '310 patent describes delivering audio and/or visual files to an electronic device. Ex. 1001, Abstract, 1:19–21. Specifically, the '310 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 16:57–17:39.

C. Illustrative Claim

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.

Independent challenged claim 10, from which challenged claims 12 and 13 depend, is similar in scope.

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

E. Asserted Grounds of Unpatentability

Petitioner asserts that claims 1, 3, 5–8, 10, 12, and 13 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. Petitioner asserts that claim 9 is unpatentable under 35 U.S.C. § 103(a) based on the following alternative grounds: 1) Yukie, Gatherer, Prust, Frodigh, and Chan; and 2) Yukie, Gatherer, Prust, O'Hara, Tagg, Pinard, and Chan. Pet. 3.

II. ANALYSIS

A. Claim Construction

The claims of an unexpired patent are interpreted 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 "cellular network" as recited in claim 1, "cellular communication network" as recited in similar claim 10, and "virtual storage locker" as recited in claims 1 and 10. Pet. 6–8. Patent Owner contends, *inter alia*, Petitioner's constructions are "unreasonably broad." Prelim. Resp. 6–7. 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, other than "cellular network" and "cellular communication network," 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.").

1. Cellular Network/Cellular Communication Network

Petitioner asserts that a "cellular network" and cellular communication network" each is 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. Effectively, Petitioner's proposed construction seeks "cellular network" to include its "colloquial[]" meaning (the networks provided by "large scale commercial

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