

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 IPR2017-00688 (Patent 9,124,717 B2)
Case IPR2017-00689 (Patent 9,124,718 B2)
Case IPR2017-00690 (Patent 9,118,693 B2)
Case IPR2017-00691 (Patent 8,892,465 B2)¹

Before JUSTIN T. ARBES, CARL M. DEFRANCO, and
ROBERT J. WEINSCHENK, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

DECISION
Petitioner's Requests for Rehearing
37 C.F.R. § 42.71

¹ This Decision addresses issues pertaining to all four cases. Therefore, we exercise our discretion to issue a single Decision to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

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Introduction

In each of the instant proceedings, Petitioner filed a Request for Rehearing of our Decision denying institution of an *inter partes* review.² The arguments made by the parties and the factual circumstances of each case are similar. For purposes of this Decision, we treat the Request for Rehearing in Case IPR2017-00690 as representative, and specifically discuss the circumstances of that request. The present Decision, however, applies equally to all four Requests for Rehearing. For the reasons stated below, Petitioner’s Requests for Rehearing are *denied*.

Analysis

In determining whether to institute an *inter partes* review, the Board may “deny some or all grounds for unpatentability for some or all of the challenged claims.” 37 C.F.R. § 42.108(b). When rehearing a decision on petition, the Board will review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). “An abuse of discretion occurs if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors.” *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004). The party requesting rehearing bears the burden of showing an abuse of discretion, and “[t]he request must specifically identify

² See IPR2017-00688, Papers 11, 12; IPR2017-00689, Papers 9, 10; IPR2017-00690, Papers 11 (“Decision” or “Dec.”), 12 (“Req. Reh’g”); IPR2017-00691, Papers 9, 10. Unless otherwise specified, we refer to papers filed in Case IPR2017-00690.

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all matters the party believes the Board misapprehended or overlooked.”

37 C.F.R. § 42.71(d).

Pursuant to 35 U.S.C. § 325(d), in determining whether to institute an *inter partes* review, “the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” Petitioner argues that we abused our discretion by rejecting the Petition under 35 U.S.C. § 325(d) for two reasons.

First, Petitioner contends that the Petition (Paper 2, “Pet.”) does not present the same or substantially the same prior art or arguments as the petition it filed in Case IPR2017-00089 (“the -89 Case”). Req. Reh’g 5–8; *see* IPR2017-00089, Paper 2 (“-89 Petition” or “-89 Pet.”). As explained in the Decision, Petitioner relied on the Rolf, Forta, Gatherer, and Frodigh references in the -89 Petition, and now relies on Rolf, Forta, Gatherer, O’Hara, and Tagg in the instant Petition. Dec. 5. Specifically, Petitioner relied on Frodigh for the limitations of the independent claims requiring “orthogonal frequency-division multiplex modulation” (OFDM modulation), but now relies on O’Hara and Tagg for those same limitations.³ *Id.* at 5–6. Petitioner argues that the Frodigh-based ground (relying on disclosure of a “cellular telephone network”) involves “different references and a fundamentally different obviousness theory” than the O’Hara/Tagg-based ground (relying on disclosure of “Wi-Fi”), and we failed to “articulate any

³ In some of the above-listed cases, Petitioner also relies on Pinard for the OFDM limitations. *See* IPR2017-00689, Paper 2, 39–41.

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finding” that the instant Petition presents “the same or substantially the same prior art or arguments” as the -89 Petition. Req. Reh’g 5–8.

We are not persuaded. As pointed out in the Decision, other than Petitioner’s analysis of the OFDM limitations of independent claims 1, 3, and 5, the petitions and supporting evidence appear to be identical. Dec. 5–6. Petitioner’s analysis of all other limitations of the independent claims and dependent claims 2, 4, and 6, as well as the corresponding portions of the declaration testimony of Tal Lavian, Ph.D., are the same. *Id.* As such, three of the four references (Rolf, Forta, and Gatherer) in the -89 Petition, roughly 25 out of 34 pages of substantive analysis of the claims in the -89 Petition, and roughly 55 out of 71 paragraphs of substantive analysis in Dr. Lavian’s declaration in the -89 Case are identical to what Petitioner presents in this proceeding. Again, the *only* difference is the analysis of one limitation of each independent claim. We are not persuaded that we abused our discretion in concluding that the instant Petition presents substantially the same prior art and arguments as what was presented previously in the -89 Case and that the Petition should be rejected under § 325(d).

Petitioner also contends that our Decision conflicts with (1) “longstanding precedent on § 325(d) issues,” in particular four previous cases where follow-on petitions were not rejected under § 325(d), and (2) four decisions of another panel in cases involving patents related to the patent at issue. Req. Reh’g 3, 6–7. We are not persuaded. None of the cases cited by Petitioner are precedential. Moreover, the factual circumstances of every case (e.g., the prior art and arguments presented) are different, such that every determination of whether a petition should be

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rejected under § 325(d) will depend on the particular facts of the case. As explained above and in the Decision, the petitions and supporting evidence here are identical but for the analysis as to one limitation of the independent claims.

Petitioner also misrepresents the cases involving related patents by stating that the panel “rejected Patent Owner’s arguments under § 325(d) and appreciated that each of the two OFDM grounds presents a different meritorious basis for IPR.” *See id.* at 3. Unlike the instant situation, where Petitioner asserted the Frodigh-based ground in one petition and then later filed its Petition asserting the O’Hara/Tagg-based ground, Petitioner in the cited cases asserted grounds based on both combinations in the same petition. *See, e.g.*, IPR2017-00550, Paper 11, 4. Section 325(d), however, requires that “the same or substantially the same prior art or arguments *previously* were presented to the Office” (emphasis added). The cited cases are inapposite because there was no *previous* petition asserting a Frodigh-based ground. Rather, the § 325(d) argument made by Patent Owner was that the petition should be rejected because certain other references were considered during prosecution. *See id.* at 14–15.

Second, Petitioner argues that by pointing out that Petitioner “should have” been aware of Tagg prior to filing the -89 Petition and “could have” presented its arguments regarding O’Hara and Tagg in the -89 Petition, we “exceeded [the Board’s] statutory authority by imposing a timeliness requirement contrary to the one-year statutory period for filing an IPR petition under 35 U.S.C. § 315(b).” Req. Reh’g 1, 8–12 (citing Dec. 6–7). We imposed no such requirement. The cited portion of the Decision

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