

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 IPR2017-00690  
Patent 9,118,693 B2

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

ARBES, *Administrative Patent Judge*.

DECISION  
Denying Institution of *Inter Partes* Review  
37 C.F.R. § 42.108

Facebook, Inc. and Instagram LLC (collectively, “Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–6 of U.S. Patent No. 9,118,693 B2 (Ex. 1001, “the ’693 patent”) pursuant to 35 U.S.C. § 311(a). Patent Owner Skky, LLC filed a Preliminary Response (Paper 8, “Prelim. Resp.”) pursuant to 35 U.S.C. § 313. For the reasons that follow, we have decided not to institute an *inter partes* review.

## I. BACKGROUND

### A. The ’693 Patent<sup>1</sup>

The ’693 patent discloses a “method of delivering an audio and/or visual media file . . . over the air wirelessly, from one or more servers to an electronic device,” such as a cell phone. Ex. 1001, Abstract. The electronic device can receive the file, in “compressed format,” and “playback said audio and/or visual content on demand by a user.” *Id.* The ’693 patent describes using an orthogonal frequency division multiplexing (OFDM) modulation scheme for transmitting the file. *Id.* at col. 16, l. 35–col. 17, l. 59, Fig. 5. The cell phone may include a digital signal processor (DSP), which “executes the device firmware, provides control for all other blocks and performs . . . computational tasks,” such as “reception of information from the computer through the computer digital interface, . . . reception of packed sound clips through the phone analogue or digital interface, [and]

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<sup>1</sup> Case IPR2017-00089 involves the same parties and the same patent. Cases IPR2017-00088, IPR2017-00092, IPR2017-00097, IPR2017-00550, IPR2017-00602, IPR2017-00641, IPR2017-00685, IPR2017-00687, IPR2017-00688, IPR2017-00689, and IPR2017-00691 involve the same parties and related patents. *See* Pet. 1–2; Paper 3.

unpacking and then playing back sound clips through a built-in speaker.” *Id.*  
at col. 14, l. 53–col. 15, l. 3.

### *B. Illustrative Claim*

Claim 1 of the ’693 patent recites:

1. A method of wirelessly delivering a compressed digital audio or audio-visual data file to a cell phone, the method comprising:

providing a website;

wherein the website provides a plurality of the compressed digital audio or audio-visual data files;

receiving a request from the cell phone for the compressed digital audio or audio-visual data file associated with the website, said cell phone including a receiver and digital signal processor configured for receiving and processing files transmitted by orthogonal frequency-division multiplex modulation; and

providing for the streaming of the requested compressed digital audio or audio-visual data file to the cell phone by orthogonal frequency-division multiplex modulation based on the received request.

### *C. The Prior Art*

Petitioner relies on the following prior art:

U.S. Patent No. 7,065,342 B1, filed Nov. 22, 2000, issued June 20, 2006 (Ex. 1003, “Rolf”);

U.S. Patent No. 8,996,698 B1, filed Nov. 3, 2000, issued Mar. 31, 2015 (Ex. 1058, “Tagg”);

Bob O’Hara & Al Petrick, IEEE 802.11 HANDBOOK: A DESIGNER’S COMPANION (1999) (Ex. 1059, “O’Hara”);

Ben Forta et al., WAP DEVELOPMENT WITH WML AND WMLSCRIPT: THE AUTHORITATIVE SOLUTION (Matt Purcell et al. eds., 2000) (Ex. 1004, “Forta”); and

Alan Gatherer et al., *DSP-Based Architectures for Mobile Communications: Past, Present and Future*, 38:1 IEEE COMMUNICATIONS MAGAZINE 84–90 (Jan. 2000) (Ex. 1005, “Gatherer”).

#### *D. The Asserted Ground*

Petitioner challenges claims 1–6 of the ’693 patent as unpatentable over Rolf, Forta, Gatherer, O’Hara, and Tagg under 35 U.S.C. § 103(a).<sup>2</sup>

## II. DISCUSSION

On October 14, 2016, Petitioner filed a petition in Case IPR2017-00089 (“the -89 Case”) requesting *inter partes* review of claims 1–6 of the ’693 patent as unpatentable over Rolf, Forta, Gatherer, and U.S. Patent No. 5,726,978 (Ex. 1006, “Frodigh”). See IPR2017-00089, Paper 2 (“-89 Petition” or “-89 Pet.”). Patent Owner subsequently filed a preliminary response on February 1, 2017, and we instituted an *inter partes* review based on the asserted ground on April 26, 2017. See IPR2017-00089, Paper 7 (“-89 Dec. on Inst.”). Petitioner filed its Petition in the instant proceeding on January 15, 2017.

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

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<sup>2</sup> The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. § 103. Because the challenged claims of the ’693 patent have an effective filing date before the effective date of the applicable AIA amendment, we refer to the pre-AIA version of 35 U.S.C. § 103.

the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” The statutory language gives the Director the authority not to institute review on the basis that the same or substantially the same prior art or arguments were presented previously to the Office, but does not require that result. Based on the parties’ arguments and particular facts of this proceeding, we conclude that it is appropriate to exercise our discretion to deny the Petition under 35 U.S.C. § 325(d).

Petitioner relies on substantially the same prior art in both the present Petition and the -89 Petition. *See* Prelim. Resp. 32–33. Three of the asserted prior art references are the same: Rolf, Forta, and Gatherer. *Compare* -89 Pet. 3 (asserted ground based on Rolf, Forta, Gatherer, and Frodigh), *with* Pet. 3 (asserted ground based on Rolf, Forta, Gatherer, O’Hara, and Tagg); *see also* Pet. 5 (acknowledging that the petitions “do cite some of the same prior art references”). Petitioner also presents substantially the same arguments. Petitioner’s discussion of Rolf, Forta, and Gatherer, the vast majority of Petitioner’s analysis of independent claims 1, 3, and 5, and Petitioner’s analysis of dependent claims 2, 4, and 6, as well as the corresponding declaration testimony of Tal Lavian, Ph.D. (Ex. 1002 in both the -89 Case and the present proceeding), appear to be identical between the two petitions. *Compare* -89 Pet. 4–10, 14–29, 38–47, *with* Pet. 8–14, 19–33, 47–56; *compare* IPR2017-00089, Ex. 1002 ¶¶ 41–62, 65–94, 112–135, *with* Ex. 1002 ¶¶ 41–62, 70–99, 125–141. The only substantive difference between the -89 Petition and the Petition in the present proceeding is Petitioner’s analysis of the claim limitations requiring “orthogonal frequency-division multiplex modulation.” *See* Pet. 5. Whereas

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