

**ALERT**

# Federal Circuit Patent Bulletin: *Skky Inc. v. MindGeek, s.a.r.l.*

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June 8, 2017

On June 7, 2017, in *Skky Inc. v. MindGeek, s.a.r.l.*, the U.S. Court of Appeals for the Federal Circuit (Lourie,\* Reyna, Wallach) affirmed the U.S. Patent and Trademark Office Patent Trial and Appeal Board inter partes review decision that certain claims of U.S. Patent No. 7,548,875, which related to a method for delivering audio and/or visual files to a wireless device, were unpatentable as obvious. The Federal Circuit stated:

In determining whether a claim term invokes § 112 ¶ 6, “the essential inquiry is not merely the presence or absence of the word ‘means’ but whether the words of the claim are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure.” To determine whether a claim recites sufficient structure, “it is sufficient if the claim term is used in common parlance or by persons of skill in the pertinent art to designate structure, even if the term covers a broad class of structures and even if the term identifies the structures by their function.”

Skky argues that the presence of “means” in “wireless device means” creates the presumption that § 112 ¶ 6 has been invoked, and that the function of the “wireless device means” is “to request, wirelessly receive, and process a compressed audio and/or visual file.” . . . We agree with MindGeek that “wireless device means” does not invoke § 112 ¶ 6 because its clause recites sufficient structure. Although the term uses the word “means” and so triggers a presumption, the full term recites structure, not functionality; the claims do not recite a function or functions for the wireless device means to perform, and “wireless device” is “used in common parlance . . . to designate structure.” Skky’s arguments to the contrary are, in effect, an attempt to improperly import limitations from the written description into the

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## Practice Areas

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claims. . . .

Skky argues that even if “wireless device means” does not invoke § 112 ¶ 6, the term still should be construed to require multiple processors, wherein one is a specialized processor primarily dedicated to processing compressed multimedia data. . . . MindGeek responds that Skky’s proposed construction is not the broadest reasonable construction because the written description includes the software embodiment, which uses a single processor, and that Skky’s proposed requirements import limitations into the claims from the written description and prosecution history. MindGeek further responds that the prosecution history actually supports the conclusion that the claims cover the software embodiment, as the Examiner cited the portion of the written description containing that embodiment in his notice of allowance.

We agree with MindGeek and the Board that the challenged claims do not require multiple processors. Although the written description contains embodiments where the wireless device contains multiple processors, it also includes the software embodiment, in which the wireless device contains a single processor. [T]he Board did not err in concluding that “wireless device means” does not invoke § 112 ¶ 6, and did not err in concluding that the claimed device does not require multiple processors or a specialized processor. . . .

Obviousness is a question of law based on subsidiary findings of fact relating to “the scope and content of the prior art, differences between the prior art and the claims at issue, the level of ordinary skill in the pertinent art, and any objective indicia of non-obviousness.” Whether there would have been a motivation to combine multiple references at the time of the invention is also a question of fact. Accordingly, we review these findings for substantial evidence. A finding is supported by substantial evidence if a reasonable mind might accept the evidence as sufficient to support the finding.

Skky first argues that the Board erred in its conclusion that the challenged claims are unpatentable as obvious because it considered no more than the references already considered by the Examiner. Skky also argues that the Board erred because Rolf does not disclose multiple processors or a specialized processor. MindGeek responds that the references disclose all required aspects of the claims under the correct constructions.

We agree with MindGeek that the Board did not err. . . . Skky has not cited any authority for the proposition that once an examiner concludes that claims are patentable over a reference, that reference may no longer be considered further in determining a claim’s validity; indeed, the Supreme Court has characterized the “congressional objective” of the IPR process as “giving the Patent Office significant power to revisit and revise earlier patent grants.” Accordingly, Skky’s general challenges to the Board’s obviousness analysis are not persuasive.

Skky next argues that the Board erred in concluding that claim 21 is unpatentable as obvious because Rolf only allows transmission of a full song, not a playable portion of a song as required by the claim. MindGeek responds that the Board properly determined that a song is a playable portion of a full album, and that the claim is not limited to transmitting a portion of a song. We agree with MindGeek that Skky’s argument relies on a less-than-complete reading of claim 21. In full, the claim is directed to the method of claim 1,

wherein the file “is a segment of a full song, musical composition or other audio recording or visual recordings.” Thus, the claim language is not limited to segments of full songs, but also reaches segments of other audio recordings and musical compositions. As the Board noted, a single full song is a segment of the album (musical composition or audio recording) on which it appears.

Skky next argues that the Board’s finding that a skilled artisan would have been motivated to combine Rolf, MP3 Guide, and OFDM/FM to arrive at the invention of claim 22 is not supported by substantial evidence because the combination would have produced an inoperable device. Specifically, Skky argues that Rolf and OFDM/FM disclose different protocols, and that the Board disregarded its evidence that a skilled artisan would not have expected success in combining them. Skky contends that the Board impermissibly shifted the burden to Skky to prove otherwise.

MindGeek responds that the Board’s finding of a motivation to combine is supported by substantial evidence. MindGeek contends that OFDM/FM specifically notes that it could be retrofitted into existing systems, so combination would have been within the abilities of a skilled artisan. We agree with MindGeek that the Board’s finding of a motivation to combine the three references is supported by substantial evidence. OFDM/FM specifically discloses, for example, that its protocol “is particularly attractive because it can be implemented simply and inexpensively by retrofitting existing FM communication systems.” Moreover, the Board was not required to credit Skky’s expert evidence simply because Skky offered it. The Board reviewed the evidence presented by the parties, and chose not to credit Skky’s expert testimony. “We may not reweigh this evidence on appeal.” Accordingly, we discern no reversible error in that choice.