

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

CANON INC.; CANON USA, INC.;  
CANON FINANCIAL SERVICES, INC.; FUJIFILM CORPORATION;  
FUJIFILM HOLDINGS AMERICA CORPORATION;  
FUJIFILM NORTH AMERICA CORPORATION; JVC KENWOOD  
CORPORATION; JVCKENWOOD USA CORPORATION;  
NIKON CORPORATION; NIKON INC.; OLYMPUS CORPORATION;  
OLYMPUS AMERICA INC.; PANASONIC CORPORATION;  
PANASONIC CORPORATION OF NORTH AMERICA;  
SAMSUNG ELECTRONICS CO., LTD. AND  
SAMSUNG ELECTRONICS AMERICA, INC.  
Petitioners,

v.

PAPST LICENSING GMBH & CO. KG  
Patent Owner.

---

Case IPR2016-01200  
Patent 8,504,746

---

**PAPST LICENSING GMBH & CO. KG'S  
PRELIMINARY RESPONSE**

Mail Stop PATENT BOARD  
Patent Trial and Appeal Board  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

## TABLE OF CONTENTS

	<u>Page</u>
I. Introduction .....	1
II. The Petition Fails To Meet The Requirements For Instituting An <i>Inter Partes</i> Review .....	4
A. The Petition Fails To Comply With 35 U.S.C. § 312(a)(3) And 37 C.F.R. §§ 42.22(a)(2) And 42.104(b)(4).....	4
B. The Board Should Not Institute Trial Based On The Petition’s Redundant Grounds .....	10
III. The Petition Advances Flawed Claim Constructions That Should Be Rejected .....	18
A. Overview Of The ’746 Patent .....	19
B. Level Of Ordinary Skill In The Art .....	21
C. Response to Petitioners’ Proposed Claim Constructions.....	22
1. “without requiring any end user to load any software onto the [first/second] computer at any time”, “without requiring any user-loaded file transfer enabling software to be loaded on or installed in the [computer/host device] at any time”, “whereby there is no requirement for any user-loaded file transfer enabling software to be loaded on or installed in the computer in addition to the operating system”, And “processor” Limitations .....	22
2. “End user” .....	22
IV. Petitioners Did Not Meet Their Burden To Show A Reasonable Likelihood Of Success On Their Ground Of Invalidity.....	25
A. Legal Standards .....	25

B.	Petitioners Fail To Demonstrate The Challenged Claims Are Obvious Over Aytac In View Of The SCSI Specification .....	30
1.	Petitioners Fail To Articulate A Proper Obviousness Ground.....	30
2.	U.S. Patent No. 5,758,081 To Aytac .....	32
3.	American National Standard For Information Systems – Small Computer System Interface-2 (“SCSI Specification”).....	36
4.	Aytac’s Source Code Is Not Part Of The Aytac Disclosure And Does Not Otherwise Qualify As Prior Art.....	36
5.	Aytac, Alone Or Combined With The SCSI Specification, Fails To Disclose Several Limitations Of The Independent Claims .....	40
	(i) Aytac In View Of The SCSI Specification Does Not Disclose The ’746 Patent’s Automatic File Transfer Process That Occurs Without Requiring Any User-loaded File Transfer Enabling Software To Be Loaded Or Installed In The Host Device .....	40
	(ii) Aytac In View Of The SCSI Specification Fail To Disclose A Processor That Implements A Data Generation Process As Claimed In Claims 1, 31, And 34.....	44
	(iii) The Petition Fails To Show That Aytac Or The SCSI Specification Disclose The Preamble Of Claim 1 .....	47
C.	Petitioners Fail To Demonstrate That The Challenged Dependent Claims Are Obvious Based On Aytac In View of The SCSI specification.....	48
V.	Conclusion .....	52

**TABLE OF AUTHORITIES**

	<u>Page</u>
<b>Cases</b>	
<i>Activevideo Networks, Inc. v. Verizon Commc'ns, Inc.</i> , 694 F.3d 1312 (Fed. Cir. 2012).....	26
<i>Arendi S.A.R.L. v. Apple Inc.</i> , 2016 U.S. App. LEXIS 14652 (Fed. Cir. Aug. 10, 2016).....	29
<i>Canon, Inc. v. Intellectual Ventures, LLC</i> , IPR2014-00535, Paper 9 (PTAB Sept. 24, 2014) .....	17
<i>Cisco Sys., Inc. v. C-Cation Techs., LLC</i> , IPR2014-00454, Paper 12 (PTAB Aug. 29, 2014) .....	7, 27, 28
<i>Conopco, Inc. v. Procter &amp; Gamble Co.</i> , IPR2013-00510, Paper 9 (PTAB Feb. 12, 2014) .....	7
<i>Cuozzo Speed Techs., LLC v. Lee</i> , No. 15-446, 136 S. Ct. 2131 (June 20, 2016).....	18
<i>Dell, Inc. v. Elecs. &amp; Telecommc'ns Res. Inst.</i> , IPR2014-00152, Paper 12 (PTAB May 16, 2014).....	28
<i>Dominion Dealer Sols., LLC v. Autoalert, Inc.</i> , IPR2013-00223, Paper 9 (PTAB Aug. 15, 2013) .....	29
<i>EMC Corp. v. PersonalWeb Techs., LLC</i> , IPR2013-00087, Paper 25 (June 5, 2013) .....	10
<i>Graham v. John Deere Co. of Kansas City</i> , 383 U.S. 1 (1966) .....	passim
<i>Idle Free Sys., Inc. v. Bergstrom, Inc.</i> , IPR2012-00027, Paper 26 (PTAB June 11, 2013).....	10
<i>In re Am. Acad. of Sci. Tech. Ctr.</i> , 367 F.3d 1359 (Fed. Cir. 2004).....	18
<i>In re Bass</i> , 314 F.3d 575 (Fed. Cir. 2002).....	18
<i>In re Cronyn</i> , 890 F.2d 1158 (Fed. Cir. 1989).....	39
<i>In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Patent Litig.</i> , 676 F.3d 1063 (Fed. Cir. 2012).....	28

<i>In re Fritch</i> , 972 F.2d 1260 (Fed. Cir. 1992).....	31, 48
<i>In re NTP, Inc.</i> , 654 F.3d 1279 (Fed. Cir. 2011).....	28
<i>In re Translogic Tech., Inc.</i> , 504 F.3d 1249 (Fed. Cir. 2007).....	18
<i>In re Zurko</i> , 258 F.3d 1379 (Fed. Cir. 2001).....	30
<i>Intel Corp. v. MicroUnity Systems</i> , Appeal No. 2010-008981 (BPAI Dec. 9. 2010).....	38
<i>Intri-Plex Techs., Inc. v. Saint-Gobain Performance Plastics Rencol Ltd.</i> , IPR2014-00309, Paper 83 (PTAB Mar. 23, 2014).....	26, 28
<i>K/S HIMPP v. Hear-Wear Techs., LLC</i> , 751 F.3d 1362 (Fed. Cir. 2014).....	5, 29, 30, 51
<i>KSR Int’l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007) .....	2, 25, 26
<i>Liberty Mut. Ins. Co. v. Progressive Cas. Ins. Co.</i> , CBM2012-00003, Paper 7 (PTAB Oct. 25, 2012).....	passim
<i>Medtronic, Inc. v. Robert Bosch Healthcare Sys., Inc.</i> , IPR2014-00436, Paper 17 (PTAB June 19, 2014).....	27
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005) (en banc).....	18
<i>SAS Inst. Inc. v. Complementsoft, LLC</i> , IPR2013-00581, Paper 15 (PTAB Dec. 30, 2013).....	16
<i>SAS Inst. Inc. v. Complementsoft, LLC</i> , IPR2013-00581, Paper 17 (PTAB Feb. 24, 2014) .....	16
<i>Solaia Tech. LLC v. Arvinmeritor Inc.</i> , 2003 U.S. Dist. LEXIS 16482 (N.D. Ill. Sept. 17, 2003) .....	38
<i>Southwest Software, Inc. v. Harlequin, Inc.</i> , 226 F.3d 1280 (Fed. Cir. 2000).....	38
<i>Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.</i> , 655 F.3d 1364 (Fed. Cir. 2011).....	28
<i>Symantec Corp. v. RPost Comms. Ltd.</i> , IPR2014-00353, Paper 15 (PTAB July 15, 2014).....	7, 45
<i>Travelocity.com L.P. et al. v. Cronos Techs., LLC</i> , CBM2014-00082, Paper 12 (PTAB Oct. 16, 2014).....	3, 9

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.