

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 IPR2016-01206
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 |
| 1. Horizontal Redundancies Across Related Petitions Merit Their Denial | 12 |
| 2. Vertical Redundancies Within This Petition Also Merit Its Denial | 16 |
| C. The Petition Fails To Comply With 35 U.S.C. § 325(d) | 18 |
| III. The Petitioners Advance Flawed Claim Constructions That Should Be Rejected | 23 |
| A. Overview Of The ’746 Patent | 24 |
| B. Level Of Ordinary Skill In The Art | 26 |
| C. Response to Petitioners’ Proposed Claim Constructions..... | 27 |
| “1. The “without requiring any end[-]user . . .,” And “processor” Limitations | 27 |
| 2. “End user” | 27 |
| IV. Petitioners Did Not Meet Their Burden To Show A Reasonable Likelihood Of Success On Their Grounds Of Invalidity..... | 36 |
| A. Legal Standards | 36 |

| | | |
|-------|--|----|
| B. | Petitioners Fail To Demonstrate The Challenged Claims Are Anticipated Based On Murata | 41 |
| 1. | As The USPTO Recognized, Murata Fails To Disclose Several Limitations Of The Independent Claims | 41 |
| (i) | Murata Fails To Disclose That The Computer “Automatically Activates A Device Driver ...” As Required By Claim 1 | 42 |
| (ii) | Murata Fails To Disclose That The Processor “Automatically Causes At Least One Parameter Indicative Of The Class Of Devices To Be Sent To The Computer ...” As Required By Claim 1 | 44 |
| (iii) | Murata Fails To Disclose That There Is “No Requirement For Any User-Loaded File Transfer Enabling Software To Be Loaded On Or Installed In The Computer” As Required By Claim 1..... | 47 |
| 2. | Murata Also Fails To Disclose The Limitations Of All Of The Challenged Dependent Claims..... | 49 |
| C. | Petitioners Fail To Demonstrate That The Challenged Claims Are Obvious Based On Murata In View Of The Secondary References..... | 49 |
| V. | Conclusion | 51 |

TABLE OF AUTHORITIES

| | <u>Page</u> |
|---|---------------|
| Cases | |
| <i>Activevideo Networks, Inc. v. Verizon Commc'ns, Inc.</i> , 694 F.3d 1312 (Fed. Cir. 2012)..... | 37 |
| <i>Am. Hoist & Derrick Co. v. Sowa & Sons</i> , 725 F.2d 1350 (Fed. Cir. 1984)..... | 22 |
| <i>Arendi S.A.R.L. v. Apple, Inc.</i> , 2016 U.S. App. LEXIS 14652 (Fed. Cir. Aug. 10, 2016)..... | 45 |
| <i>Bettcher Indus., Inc. v. Bunzl USA, Inc.</i> , 661 F.3d 629 (Fed. Cir. 2011)..... | 46 |
| <i>Canon, Inc. v. Intellectual Ventures, LLC</i> , IPR2014-00535, Paper 9 (PTAB Sept. 24, 2014) | 19 |
| <i>Cisco Sys., Inc. v. C-Cation Techs., LLC</i> , IPR2014-00454, Paper 12 (PTAB Aug. 29, 2014) | 38, 39 |
| <i>Cont'l Can Co., U.S.A. v. Monsanto Co.</i> , 948 F.2d 1264 (Fed. Cir. 1991)..... | 45, 46 |
| <i>Cuozzo Speed Techs., LLC v. Lee</i> , No. 15-446, 136 S. Ct. 2131 (June 20, 2016)..... | 23 |
| <i>Dell, Inc. v. Elecs. & Telecommc'ns Res. Inst.</i> , IPR2014-00152, Paper 12 (PTAB May 16, 2014)..... | 40 |
| <i>Dominion Dealer Sols., LLC v. Autoalert, Inc.</i> , IPR2013-00223, Paper 9 (PTAB Aug. 15, 2013) | 40 |
| <i>EMC Corp. v. PersonalWeb Techs., LLC</i> , IPR2013-00087, Paper 25 (PTAB June 5, 2013)..... | 10 |
| <i>Ericsson, Inc. v. D-Link Sys., Inc.</i> , 773 F.3d 1201 (Fed. Cir. 2014)..... | 36 |
| <i>FLIR Sys., Inc. v. Leak Surveys, Inc.</i> , IPR2014-00411, Paper 9 (PTAB Sept. 5, 2014) | 46, 47 |
| <i>Garmin Int'l, Inc. v. Cuozzo Techs. LLC</i> , IPR2012-00001, Paper 15 (PTAB Jan. 9, 2013)..... | 36 |
| <i>Graham v. John Deere Co. of Kansas City</i> , 383 U.S. 1 (1966) | 5, 36, 39, 50 |

| | |
|--|--------|
| <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)..... | 23 |
| <i>In re Bass</i> , 314 F.3d 575 (Fed. Cir. 2002)..... | 23 |
| <i>In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Patent Litig.</i> , 676 F.3d 1063 (Fed. Cir. 2012)..... | 39 |
| <i>In re Fritch</i> , 972 F.2d 1260 (Fed. Cir. 1992)..... | 49, 51 |
| <i>In re Montgomery</i> , 677 F.3d 1375 (Fed. Cir. 2012)..... | 46 |
| <i>In re NTP, Inc.</i> , 654 F.3d 1279 (Fed. Cir. 2011)..... | 39 |
| <i>In re Robertson</i> , 169 F.3d 743 (Fed. Cir. 1999)..... | 46 |
| <i>In re Translogic Tech., Inc.</i> , 504 F.3d 1249 (Fed. Cir. 2007)..... | 23 |
| <i>Intri-Plex Techs., Inc. v. Saint-Gobain Performance Plastics Rencol Ltd.</i> , IPR2014-00309, Paper 83 (PTAB Mar. 23, 2014)..... | 37, 39 |
| <i>K/S HIMPP v. Hear-Wear Techs., LLC</i> , 751 F.3d 1362 (Fed. Cir. 2014)..... | 45 |
| <i>KSR Int’l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007)..... | 36, 37 |
| <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)..... | 38 |
| <i>Neil Ziegman, N.P.Z., Inc. v. Stephens</i> , IPR2015-01860, Paper 11 (PTAB Feb. 24, 2016)..... | 22 |
| <i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005) (en banc)..... | 23 |
| <i>PowerOasis, Inc. v. T-Mobile U.S.A., Inc.</i> , 522 F.3d 1299 (Fed. Cir. 2008)..... | 22 |

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.