

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CANON INC., CANON U.S.A., 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.,
Petitioner,

v.

PAPST LICENSING GMBH & CO., KG,
Patent Owner.

Case IPR2016-01211¹
Patent 8,504,746 B2

Before JONI Y. CHANG, JENNIFER S. BISK, and MIRIAM L. QUINN,
Administrative Patent Judges.

QUINN, *Administrative Patent Judge.*

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

¹ Cases IPR2017-00678 and IPR2017-00710, filed by LG Electronics, Inc. and Huawei Device Co., Ltd., respectively, had been joined with this proceeding. Due to settlement, these entities are no longer part of this proceeding. Case IPR2017-1211, Papers 32, 38.

I. INTRODUCTION

In this *inter partes* review, instituted pursuant to 35 U.S.C. § 134, Petitioner, as listed in the caption above, challenged the patentability of claims 1–12, 14, 15, 17–21, 23–31, 34, and 35 of U.S. Patent No. 8,504,746 B2 (“the ’746 patent”), owned by Papst Licensing GMBH & Co. KG. We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed below, we determine that Petitioner has shown by a preponderance of the evidence that claims 1–9, 11, 12, 15, 17–21, 23–31, and 34 (“the challenged claims”) of the ’746 patent are unpatentable, but has not shown that claims 10 and 35 are unpatentable.

A. PROCEDURAL HISTORY

The Petitioner-captioned entities filed a Petition to institute *inter partes* review of claims 1–12, 14, 15, 17–21, 23–31, 34, and 35 of the ’746 patent. Paper 4 (“Pet.”). Patent Owner filed a Preliminary Response. Paper 10 (“Prelim. Resp.”). On December 15, 2016, we instituted *inter partes* review as to challenged claims 1–12, 15, 17–21, 23–31, 34, and 35. Paper 11 (“Institution Decision” or “Dec”). The Petition was denied as to claim 14. *Id.*

After institution, Patent Owner filed a Patent Owner Response. Paper 15 (“PO Resp.”). And Petitioner filed a Reply. Paper 23 (“Reply”). Patent Owner, upon authorization of the Board, filed an itemized listing of objectionable arguments and evidence filed in Petitioner’s Reply. Paper 27 (“PO Listing”). Petitioner responded by filing a Petitioner’s Response to the Itemized Listing. Paper 28 (“Pet. Response”). We heard oral arguments on

IPR2016-01211
Patent 8,504,746 B2

September 13, 2017. A transcript of the hearing has been entered into the record. Paper 34 (“Tr.”).

B. RELATED MATTERS

Petitioner identifies the patent-at-issue as the subject matter of many district court cases filed in the Northern District of California, Eastern District of Texas, District of D.C. and District of Delaware. Pet 64–66; PO Notice Paper 5 at 1–4.

The ’746 patent also has been the subject of multiple petitions for *inter partes* review filed by various Petitioners. Paper 5 at 4. A final written decision in each of the following proceedings is entered concurrently with this decision: IPR2016-01200 and IPR2016-01213.

C. JOINED PETITIONER AND REAL PARTIES-IN-INTEREST

Further, the Petition states that the following parties are real parties-in-interest: Canon Inc.; Canon U.S.A., Inc.; Canon Financial Services, Inc.; Fujifilm Corporation; Fujifilm Holdings America Corporation; Fujifilm North America Corporation; JVC Kenwood Corporation; JVC Kenwood 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. Pet. 63.

D. THE ’746 PATENT (EX. 1201)

The ’746 patent is titled, “Analog Data Generating and Processing Device for use With a Personal Computer.” It relates generally to the transfer of data, and, in particular, to interface devices for communication between a computer or host device and a data transmit/receive device from

which data is to be acquired or with which two-way communications is to take place. Ex. 1201, 1:20–24. Figure 1, reproduced below, illustrates a general block diagram of an interface device 10. *Id.* at 4:59–60.

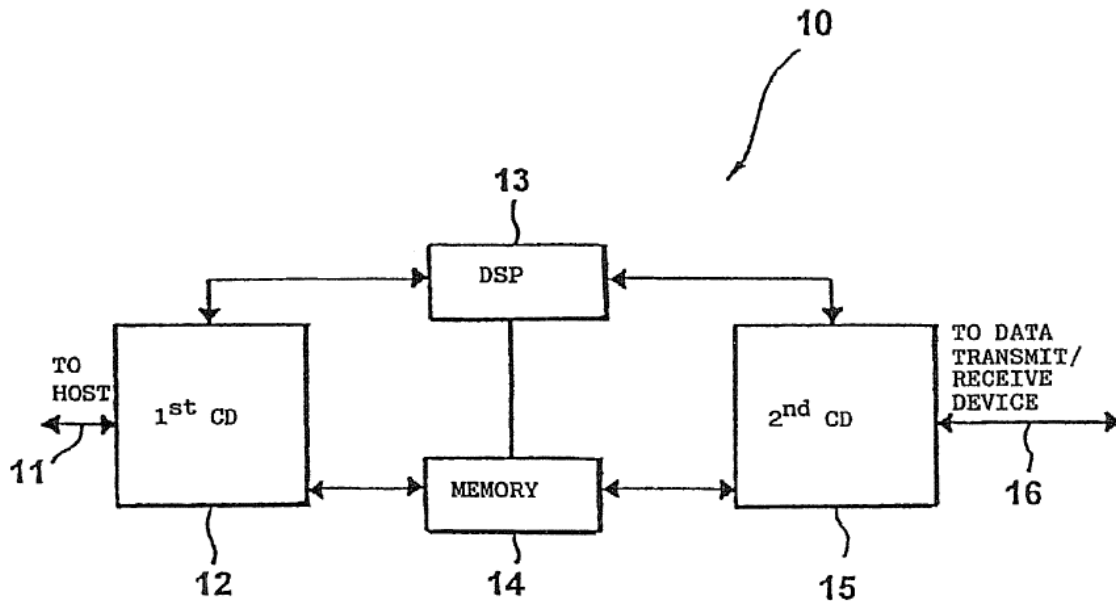


FIG. 1

According to Figure 1, first connecting device 12 is attached to a host device (not shown), to digital signal processor (DSP) 13 and memory means 14. *Id.* at 4:60–65. DSP 13 and memory means 14 are also connected to second connecting device 15. *Id.* at 4:64–67. The interface device “simulates a hard disk with a root directory whose entries are ‘virtual’ files which can be created for the most varied functions.” *Id.* at 5:11–14. “Regardless of which data transmit/receive device at the output line 16 is attached to the second connecting device, the digital signal processor 13 informs the host device that it is communicating with a hard disk drive.”

Id. at 5:31–34. In one embodiment, the interface device is automatically detected when the host system is “booted,” resulting in the user “no longer [being] responsible for installing the interface device 10 on the host device by means of specific drivers which must also be loaded.” *Id.* at 7:13–20.

E. REPRESENTATIVE CLAIM

There are three independent claims in the set of challenged claims (1, 31, 34). Claim 1 is reproduced below, and is illustrative of the subject matter claimed.

1. An analog data acquisition device operatively connect able to a computer through a multipurpose interface of the computer, the computer having an operating system programmed so that, when the computer receives a signal from the device through said multipurpose interface of the computer indicative of a class of devices, the computer automatically activates a device driver corresponding to the class of devices for allowing the transfer of data between the device and the operating system of the computer, the analog data acquisition device comprising:
 - a) a program memory;
 - b) an analog signal acquisition channel for receiving a signal from an analog source;
 - c) a processor operatively interfaced with the multipurpose interface of the computer, the program memory, and a data storage memory when the analog data acquisition device is operational;
 - d) wherein the processor is configured and programmed to implement a data generation process by which analog data is acquired from the analog signal acquisition channel, the analog data is processed and digitized, and the processed and digitized analog data is stored in a file system of the data storage memory as at least one file of digitized analog data;
 - e) wherein when the analog acquisition device is operatively interfaced with the multipurpose interface of the

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.