

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 IPR2016-01216
Patent 8,966,144 B2

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

PER CURIAM

Opinion concurring filed by *Administrative Patent Judge* CHANG.

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

I. INTRODUCTION

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. (collectively “Petitioner”) filed a corrected Petition requesting an *inter partes* review of claims 7, 9, 11, 12, 17–21, 23–26, 41, 50, 51, 56–58, 66–76, 78, and 79 (“the challenged claims”) of U.S. Patent No. 8,966,144 B2 (Ex. 1201, “the ’144 patent”). Paper 4 (“Pet.”). Patent Owner, Papst Licensing GmbH & Co., KG (“Patent Owner”), filed a Preliminary Response. Paper 11 (“Prelim. Resp.”).

Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless the information presented in the petition “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For the reasons that follow, we hereby institute an *inter partes* review as to the challenged claims.

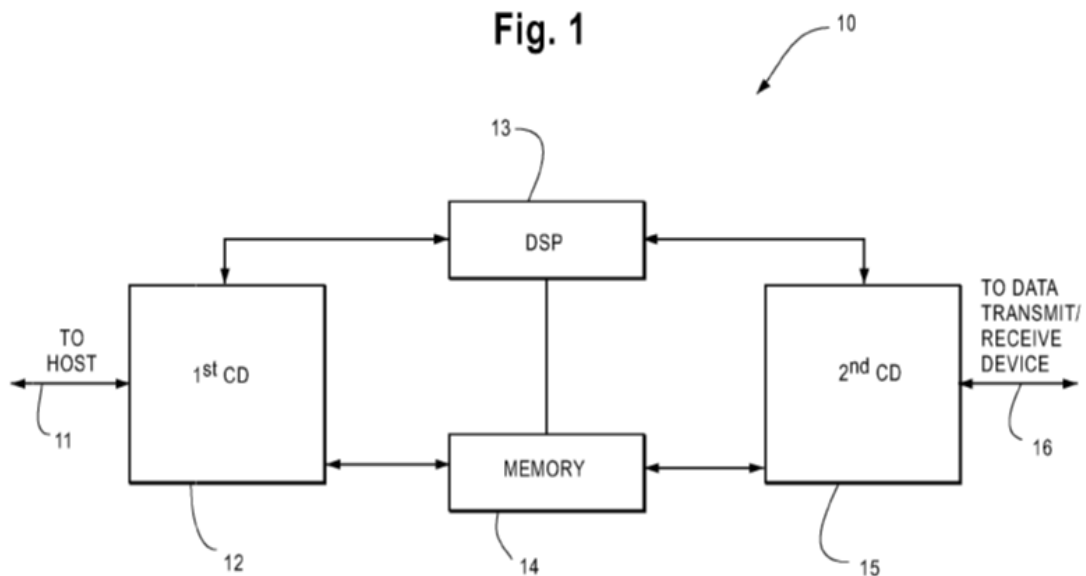
A. Related Matters

The parties indicate that the ’144 patent is involved in *Papst Licensing GmbH & Co. KG v. Canon Inc.*, Case No. 1:15-cv-01692 (D.D.C.) and other proceedings. Pet. 58–61; Paper 8, 1–3.

B. The '144 Patent

The '144 patent describes an interface device for communication between a computer host device and a data transmit/receive device (e.g., a multi-meter, transmitting measured data to a computer). Ex. 1201, 1:18–22, 1:54–57. According to the '144 patent, using a specific driver to match very closely to an individual host system would achieve high data transfer rates across the interface, but the specific driver cannot be used with other host systems. *Id.* at 2:4–19. Several solutions to this problem were known in the art. *Id.* at 2:20–3:25. For example, IOtech introduced an interface device for laptops, using a plug-in card for converting the personal computer memory card association (PCMCIA) interface into a known standard interface (IEEE 1284). *Id.* at 2:23–29. The plug-in card provided a printer interface for enhancing data transfer rates. *Id.* at 2:29–33. In another example, a floppy disk drive interface was used for connecting a host device to a peripheral device. *Id.* at 3:10–14. The interface emulated as a floppy disk drive to the host, allowing a floppy disk drive and another peripheral device to be connected to the host device. *Id.* at 3:17–19.

The '144 patent indicates that its “invention is based on the finding that both a high data transfer rate and host device-independent use can be achieved if a driver for an input/output device customary in a host device” is utilized. *Id.* at 3:32–37. Figure 1 of the '144 patent, reproduced below, illustrates a block diagram of an interface device.



As shown in Figure 1 above, interface device 10 connects to a host device via host line 11, and to a data transmit/receive device via output line 16. *Id.* at 4:62–5:10. Interface device 10 includes first connecting device 12, second connecting device 15, digital signal processor 13, and memory means 14. *Id.* In a preferred embodiment, the interface device is attached to a host device via a multi-purpose interface—e.g., a small computer systems interface (SCSI) interface—which includes both an interface card and the driver for the interface card. *Id.* at 3:51–57, 8:42–46. According to the '144 patent, SCSI interfaces were known to be present on most host devices or laptops. *Id.* at 8:42–46. By using a standard interface of a host device and by simulating an input/output device to the host device, the interface device “is automatically supported by all known host systems without any additional sophisticated driver software.” *Id.* at 11:38–44.

C. Illustrative Claims

None of the challenged claims in the instant proceeding is independent. Claims 7, 9, 11, 12, 17–21, 23–24, 41, 50, 51, 56, 57, 66–76, 78, and 79 depend ultimately from claim 1. Claims 1 and 17 are illustrative:

1. An analog data generating and processing device (ADGPD), comprising:

an input/output (i/o) port;

a program memory;

a data storage memory;

a sensor designed to transmit data;

a *processor* operatively interfaced with the i/o port, the program memory, the data storage memory and the sensor;

wherein the processor is adapted to be involved in a *data generation process* by which the sensor generates analog data, the analog data is processed, and the processed analog data is stored in the data storage memory as at least one file of digitized analog data;

wherein the processor also is adapted to be involved in an *automatic recognition process* in which, when the i/o port is operatively interfaced with a *multi-purpose interface* of a computer, the processor executes at least one instruction set stored in the program memory and thereby causes at least one parameter which provides identification information regarding the ADGPD to be automatically sent through the i/o port and to the multi-purpose interface of the computer

(a) without requiring any end user to load any software onto the computer at any time,

(b) without requiring any end user to interact with the computer to set up a file system in the ADGPD at any time,

(c) before a time when the computer is able to receive the

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