

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CANON INC., ET AL.  
Petitioner

v.

PAPST LICENSING GMBH & CO. KG,  
Patent Owner

Case IPR2016-01223  
Patent No. 8,504,746

**PETITIONERS' REQUEST FOR REHEARING**

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## Petitioners' Request for Rehearing

### I. INTRODUCTION

The Board denied institution of an *inter partes* review trial on all of the challenged claims (claims 1-25, 27-30, 33 and 35) of U.S. Patent No. 8,504,746 (“the ’746 Patent”). See Paper No. 10, entered December 15, 2016 (the “Decision”). The Board’s sole basis for denial was that Petitioners had not shown sufficiently that the prior art McNeill reference discloses or would have made obvious the claimed “analog signal acquisition channel.” *Id.* at 10-14. The Board, however, misapprehended Petitioners’ position regarding the disclosure of the claimed “analog signal acquisition channel.” In particular, the Board mistakenly believed that the Petition relied on the “communications channel” connecting the scanner and the target computer of the McNeill prior art as the “analog signal acquisition channel.” Decision at 10.

The Petition, however, actually relied on McNeill's disclosure of a scanner itself as disclosing an “analog signal acquisition channel.” As explained in the Petition and supporting expert declaration, McNeill’s scanner generates analog data and transmits such data along an “analog signal acquisition channel” to an analog to digital (A/D) converter. Petition at 34, 40-41; Ex. 1306, ¶¶ 98, 109. This disclosure of McNeill is confirmed by the Board’s grant of institution of an *inter partes* review of a related patent, U.S. Patent No. 8,966,144. IPR2016-01225, Paper 10, at 25-26. Accordingly, pursuant to 37 C.F.R. §42.71(d), Petitioners

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respectfully request reconsideration that Claims 1-12, 14-15, 17-21, 24-25, 27-30, 33 and 35 are anticipated under 35 U.S.C. § 102(b) by McNeill (Ground 1); that Claims 1-22, 24-25, 27-30, 33 and 35 are obvious under 35 U.S.C. § 103 in light of McNeill in view of the knowledge of a PHOSITA (Ground 2); that Claim 23 is obvious under 35 U.S.C. § 103 in light of McNeill in view of Muramatsu (Ground 3); and that Claims 13, 16, and 22 are obvious under 35 U.S.C. § 103 in light of McNeill in view of Admitted Prior Art (Ground 4).

## II. LEGAL STANDARD

A request for rehearing “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or reply.” 37 C.F.R. §42.71(d). “When rehearing a decision on petition, the panel will review the decision for an abuse of discretion.” 37 C.F.R. §42.71(c). “An abuse of discretion occurs where the decision (1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact findings; or (4) involves a record that contains no evidence on which the Board could rationally base its decision.” *Stevens v. Tamai*, 366 F.3d 1325, 1329 (Fed. Cir. 2004) (quoting *Eli Lilly & Co. v. Bd. of Regents of the Univ. of Wash.*, 334 F.3d 1264, 1266-67 (Fed. Cir. 2003)).

### III. ARGUMENT

#### A. The Board Misapprehended the Portion of the McNeill Reference to Which Petitioners Relied as Disclosing the Claimed “Analog Signal Acquisition Channel.”

The Board misapprehended Petitioners' position to be that the claimed “analog signal acquisition channel” is disclosed by the “communications channel” connecting the scanner and the target computer of the McNeill reference. Decision at 10. Referring to this “communications channel,” the Board determined that “[n]othing in this analysis, however, explains how the communications channel is an *analog* data acquisition channel.” *Id.* at 11 (emphasis in original). The Board further concluded that “[n]or does Petitioner point to anything else in McNeill that it is relying on for disclosure of such an analog data acquisition channel.” *Id.* As explained below, Petitioners did not rely on the “communications channel” as the claimed “analog signal acquisition channel.” Instead, Petitioners rely on the channel connecting the analog sensor (CCD sensor) to the A/D converter in the scanner disclosed in McNeill as the claimed “analog signal acquisition channel.”

Specifically, in their Petition and supporting expert declaration, Petitioners explained that McNeill discloses the use of numerous types of analog peripheral devices, including scanners:

McNeill states that his invention provides “access to a multiplicity of peripherals in a SCSI environment.” Col. 3:21-22. In the figure above,

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an example of a peripheral is the “mag disk” (16). *The '378 patent discloses attachment of multiple analog peripheral devices including scanners, CD-ROMs and communications devices, both SCSI and non-SCSI. Col. 3:17-21; Col. 2:14-15; Col. 8:24-29; Col. 4:44-53; Col. 7:37-8:6, 19-20; Fig. 2. Therefore, McNeill discloses an analog data acquisition device. Ex. 1306, ¶ 88.*

Petition at 31-32 (emphasis added); Ex. 1306, ¶ 88.

Petitioners and their expert explained that McNeill's disclosure of an analog scanner as a peripheral device necessarily requires an analog signal acquisition channel for transmitting the analog signal from the analog image sensing mechanism (CCD sensor) in the scanner to the analog-to-digital converter in the scanner:

McNeill discloses that the target system can emulate any type of peripheral, including analog devices. Col. 1:59-64. One of these devices is a scanner, which is an analog device. *It is implicit and inherent for a scanner to have an analog signal acquisition channel for receiving a signal from analog source. A typical scanner at the priority date of the '746 patent had a CCD and analog to digital circuitry to produce a digital representation of an image. This image would then be transmitted to an interface device (e.g. McNeill's target computer)*

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