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Paper 10
Entered: December 15, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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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 IPR2016-01224
Patent 8,504,746 B2

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

BISK, *Administrative Patent Judge.*

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

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I. INTRODUCTION

Petitioner, listed above, filed a Petition requesting *inter partes* review of claims 1, 19–21, 24, and 26–28 ("the challenged claims") of U.S. Patent No. 8,504,746 B2 (Ex. 1101, "the '746 patent"). Paper 1 ("Pet."). Patent Owner, Papst Licensing GmbH & Co., KG, filed a Preliminary Response. Paper 9 ("Prelim. Resp.").

For the reasons that follow, we do not institute an *inter partes* review as to any of the challenged claims.

A. Related Matters

The parties indicate that the '746 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. 9–12; Paper 5, 1–3. This patent has also been challenged in several other petitions for *inter partes* review. Pet. 12; Paper 5, 1.

B. The '746 Patent

The '746 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. 1101, 1:20–22, 1:56–59. According to the '746 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 2:6–21. Several solutions to this problem were known in the art. *Id*. at 2:22–3:24. 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

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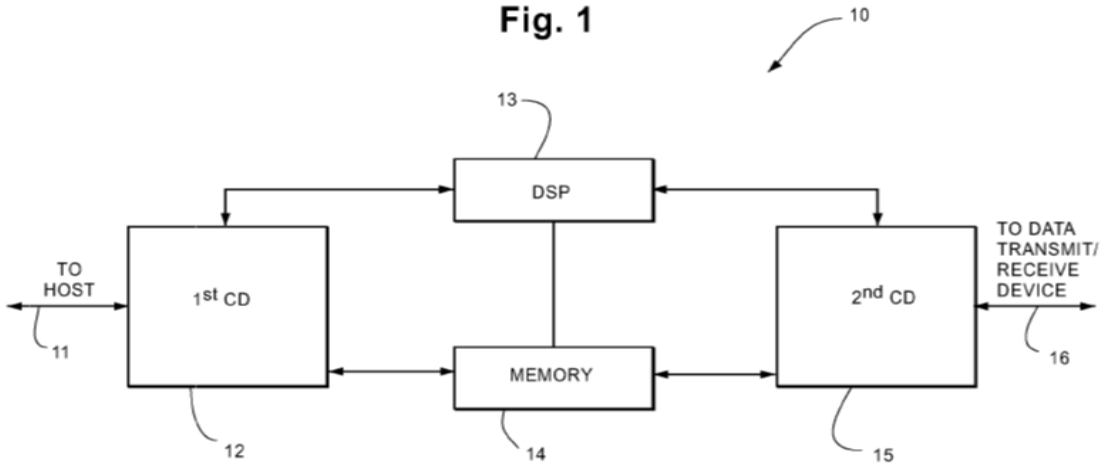
interface (IEEE 1284). *Id*. at 2:25–30. The plug-in card provided a printer interface for enhancing data transfer rates. *Id*. at 2:30–34. In another example, a floppy disk drive interface was used for connecting a host device to a peripheral device. *Id*. at 3:10–14. The interface appeared as a floppy 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 '746 patent indicates that the "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 3:33–37. Figure 1 of the '746 patent, reproduced below, illustrates a block diagram of an interface device.

Fig. 1



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 4:59–5:10. 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

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interface (SCSI) interface—which includes both an interface card and specific driver software for the interface card. *Id*. at 3:49–55, 8:37–41. According to the '746 patent, SCSI interfaces were known to be present on most host devices or laptops. *Id*. at 8:37–41. 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 11:29–35.

C. Prosecution History

The '746 patent issued from U.S. Application No. 12/891,443 ("the '443 Application"). Ex. 1101, [21]. The '443 Application itself is a continuation of US. Application No. 11/928,283, which in turn is a continuation of U.S. Application No. 11/467, 073 ("the '073 Application"), filed on August 24, 2006. The '443 Application was filed September 27, 2010, while the '073 application was still being prosecuted. Ex. 1101, [22]; Ex. 2006. Both applications were examined by the same Examiner. Ex. 1101; Ex. 2006.

On August 24, 2006, the same day the '073 Application was filed and several years before the '443 patent was filed, the applicant filed a preliminary amendment with remarks explicitly distinguishing the claims over Murata.[1] Ex. 2008. Specifically, the applicant explained that "[a]ll of the claims presented in this preliminary amendment generally require that the ADGPD send a response signal that allows a PC to *automatically and*

[1] US 5,508,821 (Ex. 1102).

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without user intervention recognize that it can communicate with the ADGPD as if it were a commercially available mass storage device." *Id.* at 12. The applicant added:

> As one example [Murata] does not teach or suggest, for example, the above-noted "automatic recognition" feature because, for example, the system disclosed therein is UNIX based. As readily apparent to one of ordinary skill in the relevant art, such UNIX based systems affirmatively require user intervention in order to operate and use the scanner disclosed in [Murata].

Id. at 13.

Murata was discussed at least two subsequent times in supplemental preliminary amendments dated July 17, 2007, and December 18, 2007—both before the filing of the '443 Application. Ex. 2009, 10 ("The scanner related references (e.g., [Murata]) also require user intervention of some sort to allow scanned images to be transferred over to a personal computer."); Ex. 2010, 8–9 ("Murata does not, for example, teach or suggest structure that corresponds to the above-described claim feature. In direct contrast to the claimed subject matter, all devices disclosed in the '821 patent affirmatively require user intervention in order to cause the PC to understand how to communicate with the scanner disclosed in the patent."). The remarks accompanying the December 18, 2007, amendment detailed the differences between Murata and the presented claims as follows:

> Column 4, lines 20–35 of [Murata] state that an "mkfs" or "newfs" UNIX command must be executed before the scanner can be recognized. These commands are operating system commands, and have to be entered by the user or be embedded in an application program running on a workstation to which the [Murata] scanner is connected. The commands require

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