

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 IPR2016-01225¹
Patent 8,966,144 B2

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

BISK, *Administrative Patent Judge*.

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

¹ Case IPR2017-00672, filed by LG Electronics, Inc. (“LG”), was joined with this proceeding. Paper 20. LG, however, was subsequently terminated from this proceeding. Paper 34.

INTRODUCTION

A. *Background*

Petitioner, listed above, filed a Petition requesting *inter partes* review of claims 1–36, 38–56, 58–65, 67–74, and 77–87 (the “challenged claims”) of U.S. Patent No. 8,966,144 B2 (Ex. 1301, “the ’144 patent”). Paper 1 (“Pet.”). Patent Owner, Papst Licensing GmbH & Co., KG, filed a Preliminary Response. Paper 9 (“Prelim. Resp.”). On December 15, 2016, we instituted trial on whether under § 103(a)² claims 1–36, 38–56, 58–65, 67–74, and 77–87 would have been obvious over McNeill,³ the SCSI Specification,⁴ and Admitted Prior Art.⁵ Paper 10 (“Institution Decision” or “Inst. Dec.”).

Following institution, Patent Owner filed a Response (Paper 14, “PO Resp.”)⁶, and Petitioner filed a Reply (Paper 21, “Reply”). Upon

² Because the claims at issue have a filing date prior to March 16, 2013, the effective date of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), we apply the pre-AIA version of 35 U.S.C. §§ 102 and 103 in this Decision.

³ U.S. Patent No. 5,499,378, issued March 12, 1996 (Ex. 1303) (“McNeill”).

⁴ AMERICAN NATIONAL STANDARDS INSTITUTE, INC., AMERICAN NATIONAL STANDARD FOR INFORMATION SYSTEMS – SMALL COMPUTER SYSTEM INTERFACE-2, ANSI X3.131-1994 (1994) (Ex. 1305) (“SCSI Specification”).

⁵ *See e.g.* Ex. 1301, 3:37–46, 4:20–22, 5:11–14, 5:21–23, 5:37–47, 8:45–50, 10:26–29. Although discussed in the Petitioner’s analysis, the SCSI Specification and the Admitted Prior Art were omitted inadvertently from the statement of the asserted ground. Therefore, we treated the statement as mere harmless error and presumed that Petitioner intended to assert that the challenged claims are unpatentable based, in part on the SCSI Specification and the Admitted Prior Art. Inst. Dec. 7, n.3.

⁶ Patent Owner proffers testimony, supporting its position, by Thomas A. Gafford. Ex. 2010.

authorization, Patent Owner filed objections to arguments and evidence filed with Petitioner's Reply (Paper 25) and Petitioner file a response to those objections (Paper 27). We held an oral hearing on September 13, 2017. Papers 30, 31 ("Tr.").⁷

This is a Final Written Decision pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons set forth the below, we conclude that Petitioner has shown by a preponderance of evidence that claims 1–36, 38–56, 58–65, 67–74, and 77–87 are unpatentable.

B. 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 district court proceedings. Pet. 3–6; Paper 5, 1–3. This patent has also been challenged in several other petitions for *inter partes* review. Pet. 6; Paper 5, 4–5. A final written decision in each of the following proceedings is entered concurrently with this decision: IPR2016-01199, IPR2016-01212, IPR2016-01214, and IPR2016-01216.

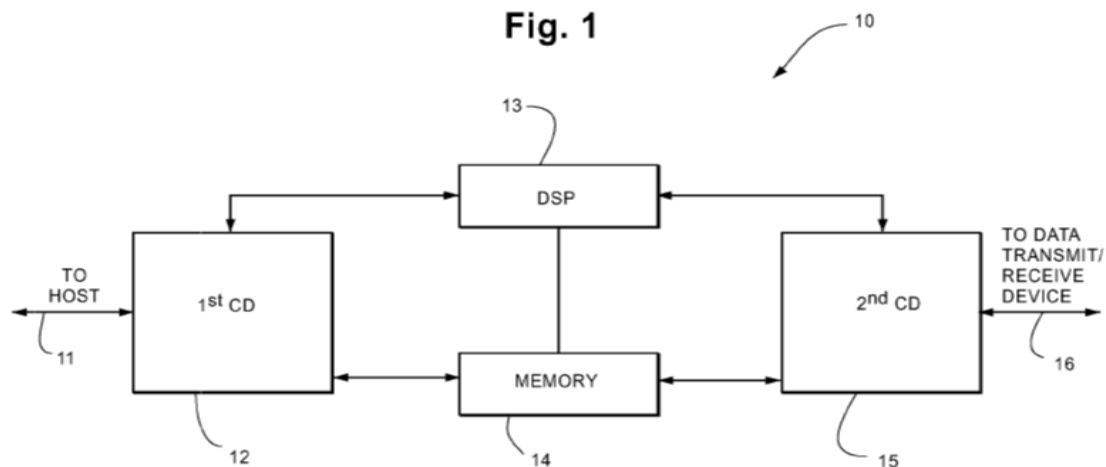
C. The '144 Patent

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. 1301, 1:18–22,

⁷ This was a consolidated hearing with related cases IPR2016-01211, IPR2016-01212, and IPR2016-01216. *See* Tr. In addition, on September 14, 2017, we held an oral hearing for several other related cases, IPR2016-01199, IPR2016-01200, IPR2016-01213, and IPR2016-01214. Because of the overlap in issues in all the related cases, the transcripts for the September 14, 2017 hearings are also entered into the record in this case. Papers 29, 30, and 31.

1:54–57. According to the '144 patent, using a specific driver for the data transmit/receive device that is customized to match very closely to an individual host system would achieve high data transfer rates across the interface, but such a 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 appeared as 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 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 used. *Id.* at 3:33–367. 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 specific driver software 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.

D. Challenged Claims

Of the challenged claims, claims 1, 84, and 86 are independent. Claims 2–36, 38–56, 58–65, 67–74, and 78–83 depend directly or indirectly from claim 1, claim 85 depends directly from independent claim 84, and

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