UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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APPLE INC.,
Petitioner,

v.

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

Case IPR2016-01839
Patent 6,470,399 B1
_____

Before JONI Y. CHANG, JAMES B. ARPIN, and
MIRIAM L. QUINN, *Administrative Patent Judges.*

CHANG, *Administrative Patent Judge.*

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

I.   INTRODUCTION

Apple Inc. ("Petitioner") filed a Petition requesting an *inter partes* review of claims 1, 3, 5, 11, and 14 ("the challenged claims") of U.S. Patent No. 6,470,399 B1 (Ex. 1001, "the '399 patent"). Paper 2 ("Pet."). Papst Licensing GmbH & Co., KG ("Patent Owner"), filed a Preliminary Response. Paper 12 ("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 determine that, on this record, Petitioner has established a reasonable likelihood that it would prevail with respect to the challenged claims. We hereby institute an *inter partes* review as to the challenged claims.

A. Related Matters

The parties indicate that the '399 patent is involved in *Papst Licensing GmbH & Co. KG v. Apple Inc.*, Case No. 6-15-cv-01095 (E.D. Tex.) and other proceedings. Pet. 2–3; Paper 11, 2–5.

B. The '399 Patent

The '399 patent describes interface devices 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, 1:9–13, 1:48–51. According to the '399 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

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systems. *Id.* at 1:65–2:12. Several solutions to this problem were known in the art. *Id.* at 2:16–3:21. 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 2:19–24. The plug-in card provided a printer interface for enhancing data transfer rates. *Id.* at 2:24–28. In another example, a floppy disk drive interface was used for connecting a host device to a peripheral device. *Id.* at 3:6–10. 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 3:13–15.

The '399 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 4:23–27. Figure 1 of the '399 patent, reproduced below, illustrates a block diagram of an interface device.

Fig. 1
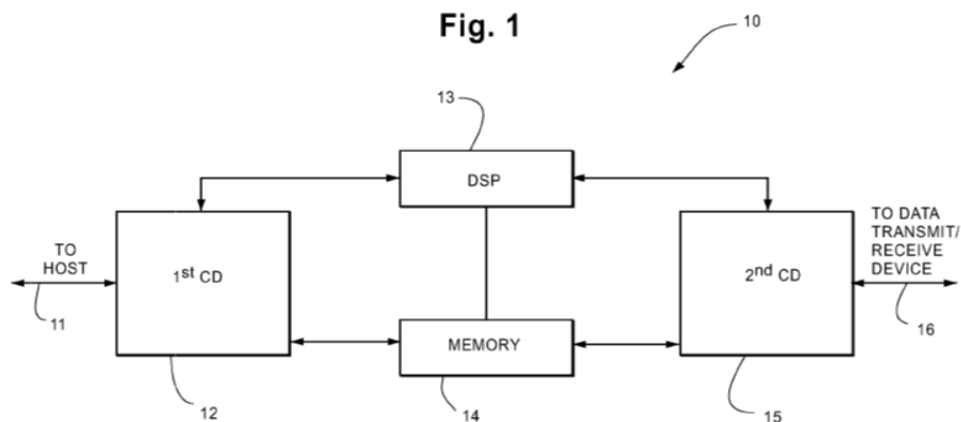
As shown in Figure 1 above, interface device 10 connects to a host device via host line 11, and to a data transmit/receive device via output line 16. *Id.* at 5:47–63. Interface device 10 includes first connecting

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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")—which includes both an interface card and the driver for the interface card. *Id.* at 4:40–46, 8:29–32. According to the '399 patent, SCSI interfaces were known to be present on most host devices or laptops. *Id.* at 8:29–32. 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 12:23–29.

C. Illustrative Claim

Of the challenged claims, claims 1, 11, and 14 are independent. Each of claims 3 and 5 depends directly from claim 1. Claim 1 is illustrative:

> 1. An interface device for communication between a host device, which comprises drivers for input/output devices customary in a host device and a multi-purpose interface, and a data transmit/receive device, the data transmit/receive device being arranged for providing analog data, comprising:
>
> a processor;
>
> a memory;
>
> a first connecting device for interfacing the host device with the interface device via the multi-purpose interface of the host device; and
>
> a second connecting device for interfacing the interface device with the data transmit/receive device, the second connecting device including a sampling circuit for sampling the analog data provided by the data transmit/receive device and an analog-to-digital converter for converting data sampled by the sampling

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circuit into digital data,

wherein the interface device is configured by the processor and the memory to include a first command interpreter and a second command interpreter,

wherein the first command interpreter is configured in such a way that the command interpreter, when receiving an inquiry from the host device as to a type of a device attached to the multi-purpose interface of the host device, sends a signal, regardless of the type of the data transmit/receive device attached to the second connecting device of the interface device, to the host device which signals to the host device that it is an input/output device customary in a host device, whereupon the host device communicates with the interface device by means of the driver for the input/output device customary in a host device, and

wherein the second command interpreter is configured to interpret a data request command from the host device to the type of input/output device signaled by the first command interpreter as a data transfer command for initiating a transfer of the digital data to the host device.

Ex. 1001, 12:42–13:12.

D. Prior Art Relied Upon

Petitioner relies upon the prior art references listed below.

| Kawaguchi | JP H4-15853 | Jan. 21, 1992 | (Ex. 1006)[1] |
| Murata | US 5,506,692 | Apr. 16, 1996 | (Ex. 1008) |

FRIEDHELM SCHMIDT, THE SCSI BUS AND IDE INTERFACE PROTOCOLS, APPLICATIONS AND PROGRAMMING, (J. Michael Schultz trans., Addison-Wesley Publishing Company 1995) (Ex. 1007, "Schmidt").

MICROSOFT COMPUTER DICTIONARY (3rd ed. 1997) (Ex. 1014).

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[1] Citations to Kawaguchi are to the English translation (Ex. 1005).

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