

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.

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Case IPR2016-01839  
Patent 6,470,399

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**PAPST LICENSING GMBH & CO., KG'S ITEMIZED LISTING OF  
OBJECTIONABLE ARGUMENTS AND EVIDENCE FILED WITH  
PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE**

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Pursuant to the Board's Order (Paper No. 27), Patent Owner submits the following listing of arguments/evidence submitted with Petitioner's Reply ("Reply") of October 18, 2017 (Paper 23) that are beyond the proper scope of a reply under 37 C.F.R. 42.23(b) and Office Trial Practice Guide, Section II(I), 77 Fed. Reg. 48756, 48767:

1. "Construing 'an input/output device' as 'one or more input/output devices' does not contradict the Federal Circuit or the District Court" and "For these reasons, the Board should construe the pronoun 'it' as the 'inquired device.'" Reply at p. 4, 6-7; p. 7, 3-4.
2. New Annotated Figures. Reply at p. 9 and bottom of p. 10.
3. "Thus, the SCSI device converter responds to the INQUIRY directed at the Data Reading Unit with INQUIRY data. . ." Reply at p. 16, 6-7.
4. "As described above in Section II.A, when the EWS inquires as to Kawaguchi's data reading unit 12, Kawaguchi's interface would respond that this unit has a type 00h, identifying itself as a disk drive. . ." Reply at p. 21, 13-15.
5. "In either case, the EWS will send a separate INQUIRY command to each unit, and the SCSI device converter will respond to each command with separate INQUIRY data identifying the inquired unit as a customary I/O device." Reply at p. 22, 10-13.
6. "In summary, a POSITA would understand the phrase, 'it is an input/output device' to mean 'the inquired device is one or more input and/or output devices.'" Exhibit 1032 at ¶22 (p. 15, 1-3).
7. "[A] POSITA would understand that Kawaguchi's Inquiry step comprises separate standard SCSI INQUIRY commands issued to each of Kawaguchi's respective units

regardless whether they have different SCSI IDs or are different LUNs associated with a given SCSI ID.” Exhibit 1032 at ¶31 (p. 20, 6-9).

8. “The resulting combination of Kawaguchi and Schmidt is operable and results in the outcome that Kawaguchi discloses: recognition of each unit as a disk drive.” Exhibit 1032 at ¶38 (p. 25, 12-14).

9. “For example, in the combined system of Kawaguchi and Schmidt, the EWS sends an INQUIRY command to the SCSI device converter, specifically relating to the data-reading unit...the data-reading unit is the inquired device because it the device on the SCSI bus that the INQUIRY is directed to.” Exhibit 1032 at ¶43 (p. 28, 6-10).

10. “As described above in Section IV.A, each of Kawaguchi’s four units will receive a separate INQUIRY command and will respond with its own INQUIRY data identifying the inquired unit (*e.g.* data read unit or data write unit), as a single customary I/O device...That is, the EWS sends four INQUIRY commands to the SCSI device converter—one for each unit—and in response, the SCSI device converter would provide distinct INQUIRY data responses separately identifying each unit as a member of the disk drive class. . .” Exhibit 1032 at ¶53 (p. 33, 17-20 and p. 34, 12-15).

11. “Thus, for each INQUIRY the SCSI device converter receives, it responds with INQUIRY data signaling that the inquired unit is a single hard disk which is consistent with the conventional routine for the SCSI Protocol.” Exhibit 1032 at ¶55 (p. 35, 7-9).

Date: December 5, 2017

Respectfully Submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 5<sup>th</sup> day of December 2017, a true and correct copy of the foregoing PAPST LICENSING GMBH & CO. KG'S ITEMIZED LISTING OF OBJECTIONABLE ARGUMENTS AND EVIDENCE FILED WITH PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE was served by electronic mail upon the following counsel of record for Apple, Inc.:

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