Filed on behalf of Apple Inc.
By: Lori A. Gordon
Sterne, Kessler, Goldstein & Fox PLLC
1100 New York Avenue, NW
Washington, D.C.
Tel: (202) 371-2600
Fax: (202) 371-2540

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 9,189,437

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

TABLE OF CONTENTS

I. Mandatory notices (37 C.F.R. § 42.8(a)(1)). 2
II. Grounds for standing (37 C.F.R. § 42.104(a)). 3
III. Identification of challenge (37 C.F.R. § 42.104(b)). 4
A. Citation of prior art. 4
B. Statutory grounds for the challenge. 5
IV. The '437 patent. 6
A. Overview. 6
B. Level of ordinary skill in the art. 8
C. Claim construction. 8
V. Ground 1: The combination of Murata, Salomon, and Schmidt renders claims 1, 5, 6, 9–12, 14–16, 30, 34, and 43 obvious. 11
A. The combination of Murata, Salomon, and Schmidt renders independent claim 1 obvious. 13
1. The combination of Murata, Salomon, and Schmidt discloses "*an analog data generating and processing device (ADGPD)*" [1P]. ..13
2. The combination of Murata, Salomon, and Schmidt discloses the ADGPD architecture elements. 14
a) The combination of Murata, Salomon, and Schmidt discloses "*an input/output (i/o) port*" [1A]. 15
b) The combination of Murata, Salomon, and Schmidt teaches or suggests "*a program memory*" [1B]. 15
c) The combination of Murata, Salomon, and Schmidt discloses "*a data storage memory*" [1C]. 16
d) The combination of Murata, Salomon, and Schmidt discloses "*a processor operatively interfaced with the i/o port, the program memory and the data storage memory*" [1D]. 16
3. The combination of Murata, Salomon, and Schmidt teaches or suggests the acquisition and processing limitations of independent claim 1. 18
a) Murata teaches or suggests the acquisition limitation [1E.1]..18
b) Murata teaches or suggests the processing limitation [1E.2]. .21

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

4. The combination of Murata, Salomon, and Schmidt teaches or suggests the automatic recognition limitation [1F].....23
   a) The combination of Murata, Salomon, and Schmidt discloses the claimed automatic recognition operation [1F.1].....24
   b) The combination of Murata, Salomon, and Schmidt teaches or suggests the end user requirements [1F.2]. 31
   c) The combination of Murata, Salomon, and Schmidt teaches the automatic recognition data element requirements [1F.3]. 33
5. The combination of Murata, Salomon, and Schmidt teaches or suggests the file transfer limitation of independent claim 1. 35
   a) Murata discloses the recited automatic file transfer process. ..36
   b) The combination of Murata, Salomon, and Schmidt discloses the emulation and user requirement component of the file transfer limitation.....38

B. The combination of Murata, Salomon, and Schmidt renders claim 5 obvious. 39

C. The combination of Murata, Salomon, and Schmidt renders claim 6 obvious. 40

D. The combination of Murata, Salomon, and Schmidt renders claim 9 obvious 40

E. The combination of Murata, Salomon, and Schmidt renders claim 10 obvious. 42

F. The combination of Murata, Salomon, and Schmidt renders claim 11 obvious. 43

G. The combination of Murata, Salomon, and Schmidt renders claim 12 obvious. 45

H. The combination of Murata, Salomon, and Schmidt renders claim 14 obvious. 46

I. The combination of Murata, Salomon, and Schmidt renders claim 15 obvious. 47

J. The combination of Murata, Salomon, and Schmidt renders claim 16 obvious. 47

K. The combination of Murata, Salomon, and Schmidt renders claim 30 obvious. 48

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

L. The combination of Murata, Salomon, and Schmidt renders claim 34 obvious. 49

M. The combination of Murata, Salomon, and Schmidt renders independent claim 43 obvious. 50

1. The combination of Murata, Salomon, and Schmidt discloses "[a]n analog data generating and processing method for acquiring analog data and for communicating with a host computer" [43P]. 50

2. The combination of Murata, Salomon, and Schmidt discloses the architecture elements of claim 43. 51

3. The combination of Murata, Salomon, and Schmidt teaches or suggests the acquisition and processing limitations [43B]. 52

a) Murata teaches or suggests the acquisition limitation of independent claim 43. 52

b) Murata teaches or suggests the processing limitation of independent claim 43. 53

4. The combination of Murata, Salomon, and Schmidt teaches or suggests the automatic recognition limitation of independent claim 43. 53

5. The combination of Murata, Salomon, and Schmidt teaches or suggests the transferring limitation of independent claim 43. 54

6. The combination of Murata, Salomon, and Schmidt teaches or suggests "wherein the identification parameter is consistent with the ADGPD being responsive to commands issued from a customary device driver." 56

VI. Ground 2: The combination of Murata, Salomon, Schmidt, and Araghi renders claim 4 obvious. 57

VII. Ground 3: The combination of Murata, Salomon Schmidt, and Compton renders claims 13, 18, and 45 obvious. 58

A. The combination of Murata, Salomon, and Schmidt and Compton renders claim 13 obvious. 58

B. The combination of Murata, Salomon, Schmidt, and Compton renders claims 18 and 45 obvious. 60

VIII. Ground 4: The combination of Murata, Salomon, Schmidt, and Reisch renders claim 32 obvious. 61

IX. Conclusion. 63

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

TABLE OF AUTHORITIES

Cases:

In re Papst Licensing Digital Camera Patent Litigation,
778 F.3d 1255 (Fed. Cir. 2015).....9, 11

Phillips v. AWH Corp.,
415 F.3d 1303 (Fed. Cir. 2005).....10

Statutes:

35 U.S.C. § 102(a) 4, 5
35 U.S.C. § 102(b) 4, 5
35 U.S.C. § 102(e) 4

Regulations:

37 C.F.R. § 42.8(a)(1).....2
37 C.F.R. § 42.8(b)(3).....3
37 C.F.R. § 42.10(a).....3
37 C.F.R. § 42.104(a).....3
37 C.F.R. § 42.104(b) 4

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.