

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 IPR2016-01844  
Patent 9,189,437

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**PATENT OWNER PAPST LICENSING GMBH & CO., KG'S  
PRELIMINARY RESPONSE UNDER 37 C.F.R. § 42.107**

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## TABLE OF CONTENTS

<b>I.</b>	STATEMENT OF MATERIAL FACTS IN DISPUTE.....	1
<b>II.</b>	INTRODUCTION .....	1
<b>A.</b>	STATEMENT OF RELIEF REQUESTED.....	1
<b>B.</b>	OVERVIEW OF THE '437 PATENT .....	2
<b>C.</b>	LEVEL OF ORDINARY SKILL IN THE ART.....	5
<b>D.</b>	CLAIM CONSTRUCTION.....	7
<b>E.</b>	SUMMARY OF PATENT OWNER'S ARGUMENTS .....	9
<b>III.</b>	THE PETITION FAILS TO MEET THE REQUIREMENTS FOR INSTITUTING AN <i>INTER PARTES</i> REVIEW .....	11
<b>A.</b>	THE BOARD SHOULD NOT INSTITUTE TRIAL BASED ON THE PETITION'S REDUNDANT GROUNDS .....	11
<b>B.</b>	THE BOARD SHOULD NOT INSTITUTE TRIAL BASED ON THE PETITION'S CONCLUSORY OBVIOUSNESS COMBINATIONS.....	15
<b>C.</b>	THE BOARD SHOULD NOT INSTITUTE TRIAL BECAUSE ART IS NOT PRIOR ART .....	19
<b>IV.</b>	CONCLUSION.....	27

## EXHIBIT LIST

### Currently Filed – Patent Owner

<b>Ex. No.</b>	<b>Description</b>
2001	Declaration of Dr. Kenneth Fernald
2002	<i>In re Papst Licensing GmbH &amp; Co. Litigation</i> , Case No. 7-cv-493 (D.D.C.), Order Regarding Claim Construction
2003	IEEE Standard Signaling Method for a Bidirectional Parallel Peripheral Interface for Personal Computers, IEEE Std 1284-1994

### Previously Filed – Petitioner

<b>Ex. No.</b>	<b>Description</b>
1001	U.S. Patent 9,189,437 to Tasler
1002	File History excerpts for U.S. Patent 9,189,437
1003	Declaration of Dr. Erez Zadok in Support of Petition for Inter Partes Review of U.S. Patent No. 9,189,437
1004	Curriculum Vitae of Dr. Erez Zadok
1005	<i>Intentionally left blank</i>
1006	<i>Intentionally left blank</i>
1007	<i>The SCSI Bus and IDE Interface Protocols, Applications and Programming</i> , by Schmidt, First Edition, Addison-Wesley, 1995
1008	<i>Intentionally left blank</i>
1009	U.S. Patent No. 4,727,512 to Birkner
1010	U.S. Patent No. 4,792,896 to Maclean
1011	International Publication Number WO 92/21224 to Jorgensen
1012	Small Computer System Interface-2 (SCSI-2), ANSI X3.131-1994, American National Standard for Information Systems (ANSI).
1013	<i>Operating System Concepts</i> , by Silberschatz <i>et al.</i> , Fourth Edition
1014	<i>Microsoft Computer Dictionary</i> , Third Edition, Microsoft Press, 1997
1015-1017	<i>Intentionally left blank</i>
1018	<i>The IEEE Standard Dictionary of Electrical and Electronics Terms</i> ,

	Sixth Edition, 1996
1019	<i>Intentionally left blank</i>
1020	<i>Papst Licensing GmbH &amp; Co., KG v. Apple Inc.</i> , Case No. 6-15-cv-01095 (E.D. Tex.), Complaint filed November 30, 2015
1021-1023	<i>Intentionally left blank</i>
1024	Declaration of Scott Bennett
1025	<i>Intentionally left blank</i>
1026	U.S. Patent No. 4,698,131 to Araghi <i>et al.</i>
1027	U.S. Patent No. 5,442,465 to Compton
1028	U.S. Patent No. 5,706,216 to Reisch
1029	U.S. Patent No. 4,430,673 to Salomon <i>et al.</i>
1030	Misc. Action No. 07-493 (RMC), MDL No. 1880, Order Regarding Claims Construction
1031	Plug-and-Play SCSI Specification, Version 1.0, dated March 30, 1994 (“PNP SCSI”)
1032-1036	<i>Intentionally left blank</i>
1037	U.S. Patent No. 6,111,831 to Alon <i>et al.</i>
1038-1045	<i>Intentionally left blank</i>
1046	U.S. Patent No. 5,915,106 to Ard
1047-1048	<i>Intentionally left blank</i>
1049	’144 German Application (DE 197 08 755)
1050	’144 German Application Translated (DE 197 08 755)
1051-1053	<i>Intentionally left blank</i>
1054	Livingston, Brian “Windows 3.1 Secrets”
1055	RFC 1314, “A File Format for the Exchange of Images in the Internet,” published April 1992, <a href="https://tools.ietf.org/pdf/rfc1314.pdf">https://tools.ietf.org/pdf/rfc1314.pdf</a> ,
1056	<i>Intentionally left blank</i>
1057	MacPaint Manual

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## **I. STATEMENT OF MATERIAL FACTS IN DISPUTE**

Petitioner Apple, Inc. (“Petitioner”) did not submit a statement of material facts in its Petition for *inter partes* review. Paper 2 (Petition). Accordingly, no response to a statement of material facts is due pursuant to 37 C.F.R. § 42.23(a), and no facts are admitted.

## **II. INTRODUCTION**

Patent Owner Papst Licensing GMBH & Co., KG (“Patent Owner”) respectfully submits this Patent Owner Preliminary Response under 35 U.S.C. § 313 and 37 C.F.R. § 42.107(a). It is being timely filed on or before February 1, 2017 pursuant to 37 C.F.R. § 42.107(b).

“The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 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.” 35 U.S.C. § 314(a). Here, institution should be denied because Petitioner has failed to establish that there is a reasonable likelihood that it will prevail on its propositions of unpatentability.

### **A. STATEMENT OF RELIEF REQUESTED**

Pursuant to 35 U.S.C. § 314(a), Patent Owner respectfully requests that the

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