

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.,
Petitioner,

v.

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

Case IPR2016-01862
Patent 8,504,746

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

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EXHIBIT LIST

Currently Filed – Patent Owner

| Ex. No. | Description |
|----------------|---|
| 2001 | Declaration of Dr. Kenneth Fernald |
| 2002 | <i>In re Papst Licensing GmbH & Co. Litigation</i> , Case No. 7-cv-493 (D.D.C.), Order Regarding Claim Construction |
| 2003 | Defendants' Responsive Claim Construction Brief in <i>Papst Licensing GmbH & Co., KG v. Apple, Inc.</i> (6:15-CV-01095-RWS) |
| 2004 | IEEE Standard Signaling Method for a Bidirectional Parallel Peripheral Interface for Personal Computers, IEEE Std 1284-1994 |

Previously Filed – Petitioner

| Ex. No. | Description |
|----------------|---|
| 1001 | U.S. Patent 8,504,746 to Tasler |
| 1002 | Excerpts of File History of U.S. Patent 8,504,746 to Tasler |
| 1003 | Declaration of Dr. Erez Zadok in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent No. 8,504,746 |
| 1004 | Curriculum Vitae of Dr. Erez Zadok |
| 1005-1006 | <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 | <i>Intentionally Left Blank</i> |
| 1016 | <i>In re Papst Licensing Digital Camera Patent Litigation</i> , 778 F.3d 1255 (Fed. Cir. 2015). |
| 1017-1018 | <i>Intentionally Left Blank</i> |

| | |
|-----------|---|
| 1019 | <i>Webster's Encyclopedic Unabridged Dictionary of the English Language</i> , Random House, 1996. |
| 1020 | <i>Papst Licensing GmbH & 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 | <i>Intentionally Left Blank</i> |
| 1028 | U.S. Patent No. 5,706,216 to Reisch |
| 1029-1030 | <i>Intentionally Left Blank</i> |
| 1031 | Plug-and-Play SCSI Specification, Version 1.0, dated March 30, 1994 ("PNP SCSI") |
| 1032 | <i>Intentionally Left Blank</i> |
| 1033 | U.S. Patent No. 4,970,605 to Fogaroli <i>et al.</i> |
| 1034 | U.S. Patent No. 5,623,556 to Murayama <i>et al.</i> |
| 1035 | U.S. Patent No. 5,196,946 to Balkanski <i>et al.</i> |
| 1036-1045 | <i>Intentionally Left Blank</i> |
| 1046 | U.S. Patent No. 5,915,106 to Ard |
| 1047 | <i>Intentionally Left Blank</i> |
| 1048 | U.S. Patent No. 5,489,772 to Webb <i>et al.</i> |
| 1049 | German Patent Application DE 197 08 755 A1 to Tasler |
| 1050 | German Patent Application DE 197 08 755 A1 to Tasler (English Translation) |
| 1051-1053 | <i>Intentionally Left Blank</i> |
| 1054 | Livingston, Brian "Windows 3.1 Secrets" (1992) |
| 1055 | RFC 1314, "A File Format for the Exchange of Images in the Internet," published April 1992, https://tools.ietf.org/pdf/rfc1314.pdf |
| 1056 | U.S. Patent No. 5,300,767 to Steinle <i>et al.</i> |
| 1057 | MacPaint Manual |

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 January 19, 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.

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