

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 B2

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

CHANG, *Administrative Patent Judge*.

DECISION
Denying 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, 4, 6–8, 10, 11, 14, 20, 21, 23, 30, 34, and 35 (“the challenged claims”) of U.S. Patent No. 8,504,746 B2 (Ex. 1001, “the ’746 patent”). Paper 2 (“Pet.”). Papst Licensing GmbH & Co., KG (“Patent Owner”), filed a Preliminary Response. Paper 9 (“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 set forth below, we determine that, on this record, Petitioner has not established a reasonable likelihood that it would prevail with respect to any of the challenged claims. We hereby decline to institute an *inter partes* review in this proceeding.

A. Related Matters

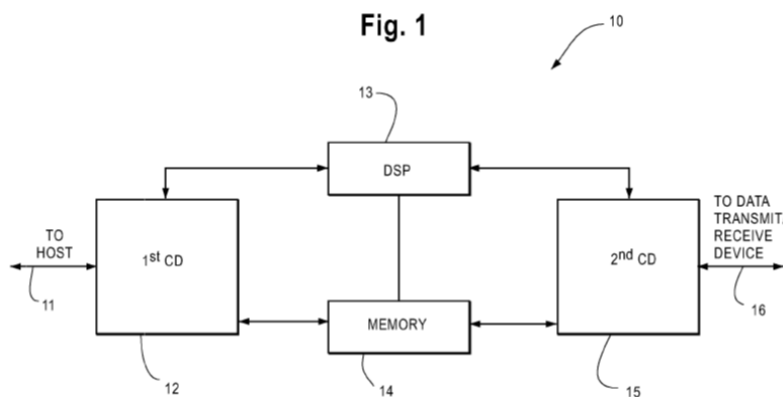
The parties indicate that the ’746 patent is involved in *Papst Licensing GmbH & Co. KG v. Apple, Inc.*, Case No. 6-15-cv-01095 (E.D. Tex.) and other proceedings. Pet. 2–3; Paper 8, 2–5.

B. The ’746 Patent

The ’746 patent describes an interface device 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. 1001, 1:20–24, 1:56–59. According to the ’746 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 systems. *Id.* at 2:6–21. Several solutions to this problem were known in the art. *Id.* at 2:22–3:24. 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 2:25–30. The plug-in card provided a printer interface for enhancing data transfer rates. *Id.* at 2:30–34. In another example, a floppy disk drive interface was used for connecting a host device to a peripheral device. *Id.* at 3:10–14. 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 3:10–19.

The '746 patent indicates that the “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 3:32–36. Figure 1 of the '746 patent, reproduced below, illustrates a block diagram of an interface device.



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 4:59–5:7. Interface device 10 includes first connecting 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 3:49–55, 8:37–41. According to the '746 patent, SCSI interfaces were known to be present on most host devices or laptops. *Id.* at 8:37–41. 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 11:29–35.

C. Illustrative Claim

Of the challenged claims, claims 1 and 34 are independent. Each of claims 4, 6–8, 10, 11, 14, 20, 21, 23, and 30 depends directly or indirectly from claim 1; claim 35 depends directly from claim 34.

Claim 1 is illustrative:

1. An analog data acquisition device operatively connectable to a computer through a multipurpose interface of the computer, the computer having an operating system programmed so that, when the computer receives a signal from the device through said multipurpose interface of the computer indicative of a class of devices, the computer automatically activates a device driver corresponding to the class of devices for allowing the transfer of data between the device and the operating system of the

computer, the analog data acquisition device comprising:

- a) a program memory;
- b) an analog signal acquisition channel for receiving a signal from an analog source;
- c) a processor operatively interfaced with the multipurpose interface of the computer, the program memory, and a data storage memory when the analog data acquisition device is operational;
- d) wherein the processor is configured and programmed to implement a data generation process by which analog data is acquired from the analog signal acquisition channel, the analog data is processed and digitized, and the processed and digitized analog data is stored in a file system of the data storage memory as at least one file of digitized analog data;
- e) wherein when the analog acquisition device is operatively interfaced with the multipurpose interface of the computer, the processor executes at least one instruction set stored in the program memory and thereby automatically causes at least one parameter indicative of the class of devices to be sent to the computer through the multipurpose interface of the computer, independent of the analog source, wherein the analog data acquisition device is not within the class of devices; and
- f) wherein the processor is further configured and programmed to execute at least one other instruction set stored in the program memory to thereby allow the at least one file of digitized analog data acquired from the analog signal acquisition channel to be transferred to the computer using the device driver corresponding to said class of devices so that the analog data acquisition device appears to the computer as if it were a device of the class of devices;

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