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 IPR2016-01863
Patent 8,504,746 B2

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

QUINN, *Administrative Patent Judge.*

DECISION
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.").

We have jurisdiction under 35 U.S.C. § 314. For the reasons that follow, we institute *inter partes* review of the claims challenged in the Petition.

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 is titled, "Analog Data Generating and Processing Device for use With a Personal Computer." It relates generally to the transfer of data, and, in particular, to interface devices for communication between a computer or host device and a data transmit/receive device from which data is to be acquired or with which two-way communications is to take place. Ex. 1001, 1:20–24. Figure 1, reproduced below, illustrates a general block diagram of an interface device 10. *Id.* at 4:59–60.
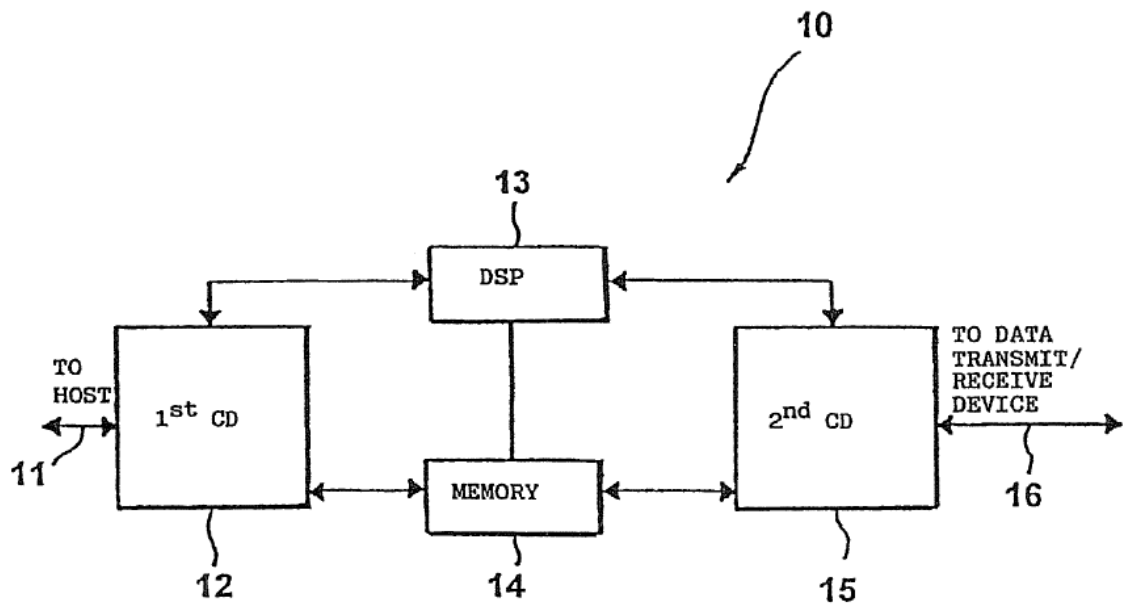
FIG.1

According to Figure 1, first connecting device 12 is attached to a host device (not shown), to digital signal processor ("DSP") 13 and memory means 14. *Id.* at 4:60–65. DSP 13 and memory means 14 also are connected to second connecting device 15. *Id.* at 4:64–67. The interface device "simulates a hard disk with a root directory whose entries are 'virtual' files which can be created for the most varied functions." *Id.* at 5:11–14. "Regardless of which data transmit/receive device at the output line 16 is attached to the second connecting device, the digital signal processor 13 informs the host device that it is communicating with a hard disk drive." *Id.* at 5:31–34. In one embodiment, the interface device is

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automatically detected when the host system is "booted," resulting in the user "no longer [being] responsible for installing the interface device 10 on the host device by means of specific drivers which must also be loaded." *Id.* at 7:13–20.

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; and claim 35 depends 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

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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;

whereby there is no requirement for any user-loaded file transfer enabling software to be loaded on or installed in the computer in addition to the operating system.

Ex. 1001, 11:48–12:26.

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