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 IPR2016-01863
Patent 8,504,746

PATENT OWNER PAPST LICENSING GMBH & CO., KG'S RESPONSE UNDER 37 C.F.R. § 42.120

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

TABLE OF CONTENTS

I. STATEMENT OF MATERIAL FACTS IN DISPUTE 1

II. INTRODUCTION 1

A. STATEMENT OF RELIEF REQUESTED 1

B. OVERVIEW OF THE '746 PATENT 2

C. LEVEL OF ORDINARY SKILL IN THE ART 5

D. CLAIM CONSTRUCTION 7

E. SUMMARY OF PATENT OWNER'S ARGUMENTS 9

III. PATENT OWNER'S RESPONSE TO PETITIONER'S GROUNDS OF REJECTION 12

A. PUCCI, SCHMIDT, KEPLEY, SHINOSKY AND WILSON DO NOT RENDER CLAIMS 1, 4, 6-8, 10, 11, 14, 20, 21, 23, 30, 34 AND 35 OBVIOUS 12

1. OVERVIEW OF PUCCI 12

2. OVERVIEW OF SCHMIDT 13

3. OVERVIEW OF KEPLEY 13

4. PUCCI, SCHMIDT, KEPLEY, SHINOSKY AND WILSON DO NOT DISCLOSE THE "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

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

SYSTEM OF THE DATA STORAGE MEMORY AS AT LEAST ONE FILE OF DIGITIZED ANALOG DATA" LIMITATION OF INDEPENDENT CLAIM 1 OF THE '746 PATENT 14

5. PUCCI, SCHMIDT, KEPLEY, SHINOSKY AND WILSON DO NOT DISCLOSE THE "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" LIMITATION OF INDEPENDENT CLAIM 1 OF THE '746 PATENT OR THE CORRESPONDING LIMITATION OF INDEPENDENT CLAIM 34 OF THE '746 PATENT 17

6. PUCCI, SCHMIDT, KEPLEY, SHINOSKY AND WILSON DO NOT DISCLOSE THE "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" LIMITATION OF INDEPENDENT CLAIM 1 OF THE '746 PATENT OR THE CORRESPONDING LIMITATION OF INDEPENDENT CLAIM 34 OF THE '746 PATENT.....24

7. PUCCI, SCHMIDT, KEPLEY, SHINOSKYAND WILSON DO NOT RENDER OBVIOUS DEPENDENT CLAIMS 4, 6-8, 10, 11, 14, 20, 21, 23, 30 AND 35 OF THE '746 PATENT 30

B. PUCCI AND SCHMIDT AND PUCCI AND KEPLEY WOULD NOT BE COMBINED BY ONE SKILLED IN THE ART.....30

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

C. *INTER PARTES* REVIEW IS UNCONSTITUTIONAL 35

IV. CONCLUSION 35

DOCKET ALARM

Find authenticated court documents without watermarks at docketalarm.com.

EXHIBIT LIST

Previously and Currently Filed – Patent Owner

Ex. No.	Description
2001	Defendants' Responsive Claim Construction Brief in *Papst Licensing GmbH & Co., KG v. Apple, Inc.* (6:15-CV-01095-RWS)
2002	United States Patent No. 5,508,821 to Murata
2003	August 24, 2006 Preliminary Amendment for U.S. Application No. 11/467,073 resulting in '144 Patent
2004	July 17, 2007 Preliminary Amendment for U.S. Application No. 11/467,073 resulting in '144 Patent
2005	December 18, 2007 Preliminary Amendment for U.S. Application No. 11/467,073 resulting in '144 Patent
2006	Declaration of Thomas A. Gafford in Support of Patent Owner Response ("Gafford Declaration")
2007	*Papst Licensing GmbH & Co., KG v. Apple Inc.*, Case No. 6-15-cv-01095 (E.D. Tex.), Claim Construction Memorandum and Order issued March 7, 2017

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 *Inter Partes* Review of U.S. Patent No. 8,504,746
1004	Curriculum Vitae of Dr. Erez Zadok
1005-1006	*Intentionally Left Blank*
1007	*The SCSI Bus and IDE Interface Protocols, Applications and Programming*, by Schmidt, First Edition, Addison-Wesley, 1995
1008	*Intentionally Left Blank*
1009	U.S. Patent No. 4,727,512 to Birkner
1010	U.S. Patent No. 4,792,896 to Maclean

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.