

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 IPR2016-01864
Patent 6,470,399

**PETITIONER APPLE INC.'S RESPONSE TO
PATENT OWNER'S MOTION FOR OBSERVATIONS
ON CROSS EXAMINATION**

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Petitioner provides the following responses to Patent Owner's observations.

Response to Observation #1

Dr. Zadok's testimony does not establish or suggest that user-loaded file transfer enabling software must be loaded on Pucci's workstation. In the following testimony, cited by Patent Owner, Dr. Zadok merely testified that software runs on a workstation and interfaces with a standard SCSI driver—not that a user must load software on the workstation or that the software constitutes file transfer enabling software. The full context of the cited testimony is as follows:

Q. Okay. And [Pucci] says, "The part of the A-to-D application that resides with an ION is structured around three cooperating tasks." Does this imply that part of the A-to-D application resides in the ION, while another part resides in the host workstation?

A. So I think what they imply here is that there is some application running on the workstation, and that interfaces with a SCSI driver or standard SCSI driver to the ION node itself, which then would accept these kinds of commands and process them, namely through these analog channels, reading data from them, digitizing them, and returning it back.

(Ex. 2004, Zadok Depo. Tr., 87:19–88:10.) This testimony is consistent with Dr. Zadok's declaration in support of the Petitioner's Reply, where he testified that Pucci operates similar to the '399 patent in that it does not require user-loaded

software because the file-transfer enabling SCSI driver would have been pre-installed on the workstation. (*See* Ex. 1054, Zadok Decl. II, ¶¶26–29.) This testimony is also consistent with Dr. Zadok’s declaration in support of the Petitioner’s Reply, where he agreed with Mr. Gafford’s deposition testimony that the ’399 patent, like Pucci, uses application software to gather hard disk parameters, such as the maximum block size. (*See* Zadok Decl. II, ¶¶28–29 (citing Ex. 1056, Gafford Depo. Tr. II).) Nevertheless, Observation #1 is irrelevant to this proceeding because the challenged ’399 claims do not forbid user-loaded file transfer enabling software.

Response to Observation #2

Dr. Zadok’s testimony does not suggest that user-loaded file transfer enabling software in addition to the operating system must be loaded on the workstation to permit data transfer. In the following testimony, cited by Patent Owner, Dr. Zadok merely testified that the software runs on a workstation and is separate from the file transfer enabling SCSI driver—not that a user must load software on the workstation or that the software is file transfer enabling software:

Q. Okay. But you would agree with me that there’s an application that’s running on the workstation that’s requesting the converted data that’s separate and apart from any driver, correct?

A. I would assume that this application is a user mode application that's separate from the standard SCSI driver that's usually part of the operating system where that SCSI driver is what enables the transfer of the data.

(Zadok Depo. Tr., 89:22–90:9.) This testimony is consistent with Dr. Zadok's declaration in support of the Petitioner's Reply, where he testified that Pucci operates similar to the '399 patent in that it does not require user-loaded software because the file-transfer enabling SCSI driver would have been pre-installed on the workstation. (*See* Zadok Decl. II, ¶¶26–29.)

Regarding whether a user needs to load software on the workstation, Dr. Zadok testified that “[a]s long as you comply with [the SCSI] specification, then you will be seen as a standard SCSI device and be able to use standard, traditional SCSI driver software, an operating system, for example.” (Zadok Depo. Tr., 82:1–5.) And Dr. Zadok testified that Pucci's ION system complies with the SCSI standard: “Q . . . Does Pucci's ION system comply with the SCSI standard? A. Yes. I believe it does.” (Zadok Depo. Tr., 100:13–101:7.) Dr. Zadok then explained that Pucci's system uses a standard SCSI driver, not specialized user-loaded software:

Q. So in a reference like Pucci, where you're installing software on the host device anyway, you could do something to avoid having a SCSI interface respond using the typical SCSI standard, correct?

[A.] Since Pucci mentions SCSI repeatedly and SCSI standards, and even says that they didn't have to change SCSI drivers, *there is no reason for me to believe that it used anything other than a standard SCSI driver*. I think they even said somewhere that they upgraded their workstation and didn't have to change the ION node or the SCSI drivers.

(Zadok Depo. Tr., 106:10–107:2 (emphasis added) (objections omitted).) This testimony is consistent with Dr. Zadok's declaration in support of the Petitioner's Reply, where he testified that the '399 patent, like Pucci, uses SCSI drivers. (*See* Zadok Decl. II, ¶¶28–29.) This testimony is also consistent with Dr. Zadok's declaration in support of the Petitioner's Reply, where he agreed with Mr. Gafford's deposition testimony that the '399 patent, like Pucci, uses application software to gather hard disk parameters, such as the maximum block size. (*See* Zadok Decl. II, ¶¶28–29 (citing Gafford Depo. Tr. II).) Nevertheless, Observation #1 is irrelevant to this proceeding because the challenged '399 claims do not forbid user-loaded file transfer enabling software.

Response to Observation #3

Dr. Zadok's testimony does not establish that the prior art fails to disclose the misidentification signaling required in the claims. Dr. Zadok testified that he did not recall "a specific word 'signal' or signaling" in Pucci. But Dr. Zadok further testified that the specific word is unnecessary because a POSA would have

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