

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 IPR2017-00156
Patent 9,189,437

**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	United States Patent No. 6,895,449, issued from August 15, 2002 U.S. Application No. 10/219,105

Previously Filed – Petitioner

Ex. No.	Description
1001	U.S. Patent No. 9,189,437 to Tasler
1002	File History excerpts for U.S. Patent No. 9,189,437
1003	Declaration of Dr. Erez Zadok in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent No. 9,189,437
1004	Curriculum Vitae of Dr. Erez Zadok
1005-1006	<i>Intentionally Left Blank</i>
1007	The SCSI Bus and IDE Interface Protocols, Applications and Programming, 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
1015-1017	<i>Intentionally Left Blank</i>
1018	<i>The IEEE Standard Dictionary of Electrical and Electronics Terms</i> , Sixth Edition, 1996
1019	<i>Intentionally Left Blank</i>
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

1025-1029	<i>Intentionally Left Blank</i>
1030	Misc. Action No. 07-493 (RMC), MDL No. 1880, Order Regarding Claims Construction
1031	Plug-and-Play SCSI Specification, Version 1.0, dated March 30, 1994 (“PNP SCSI”)
1032-1057	<i>Intentionally Left Blank</i>
1058	U.S. Patent No. 7,184,922 to Ousley <i>et al.</i>
1059	U.S. Patent No. 4,225,940 to Moriyasu <i>et al.</i>
1060	U.S. Patent No. 3,425,025 to Williams
1061	Abandoned U.S. Application No. 11/078,778, filed March 11, 2005
1062	Axelson, Jan, “USB Complete – Everything You Need to Develop Custom USB Peripherals,” 2nd Edition, Madison, WI: Lakeview Research LLC, 2001.
1063	Universal Serial Bus Specification, Revision 2.0, April 27, 2000.
1064	<i>Intentionally left blank</i>

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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 February 14, 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.

A. STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 314(a), Patent Owner respectfully requests that the Board deny institution of a trial with respect to all claims of the ‘437 Patent.

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