

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 IPR2017-00158  
Patent 8,504,746

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**PATENT OWNER PAPST LICENSING GMBH & CO., KG'S  
PRELIMINARY RESPONSE UNDER 37 C.F.R. § 42.107**

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## TABLE OF CONTENTS

<b>I.</b>	STATEMENT OF MATERIAL FACTS IN DISPUTE.....	1
<b>II.</b>	INTRODUCTION .....	1
<b>A.</b>	STATEMENT OF RELIEF REQUESTED.....	1
<b>B.</b>	OVERVIEW OF THE '746 PATENT .....	2
<b>C.</b>	LEVEL OF ORDINARY SKILL IN THE ART.....	5
<b>D.</b>	CLAIM CONSTRUCTION.....	7
<b>E.</b>	SUMMARY OF PATENT OWNER'S ARGUMENTS .....	10
<b>III.</b>	THE PETITION FAILS TO MEET THE REQUIREMENTS FOR INSTITUTING AN <i>INTER PARTES</i> REVIEW .....	13
<b>A.</b>	THE BOARD SHOULD NOT INSTITUTE TRIAL BASED ON THE PETITION'S REDUNDANT GROUNDS .....	13
<b>B.</b>	THE BOARD SHOULD NOT INSTITUTE TRIAL BASED ON THE PETITION'S CONCLUSORY OBVIOUSNESS COMBINATIONS.....	17
<b>C.</b>	THE BOARD SHOULD NOT INSTITUTE TRIAL BECAUSE OUSLEY AND STEGER ARE NOT PRIOR ART.....	21
<b>IV.</b>	CONCLUSION.....	27

## EXHIBIT LIST

### Currently Filed – Patent Owner

<b>Ex. No.</b>	<b>Description</b>
2001	Declaration of Dr. Kenneth Fernald
2002	Defendants' Responsive Claim Construction Brief in <i>Papst Licensing GmbH &amp; Co., KG v. Apple, Inc.</i> (6:15-CV-01095-RWS)
2003	U.S. Application No. 11/928,283, filed October 30, 2007

### Previously Filed – Petitioner

<b>Ex. No.</b>	<b>Description</b>
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 <i>Inter Partes</i> Review of U.S. Patent No. 8,504,746
1004	Curriculum Vitae of Dr. Erez Zadok
1005-1006	<i>Intentionally Left Blank</i>
1007	<i>The SCSI Bus and IDE Interface Protocols, Applications and Programming</i> , 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.
1014-1015	<i>Intentionally Left Blank</i>
1016	<i>In re Papst Licensing Digital Camera Patent Litigation</i> , 778 F.3d 1255 (Fed. Cir. 2015).
1017-1018	<i>Intentionally Left Blank</i>
1019	<i>Webster's Encyclopedic Unabridged Dictionary of the English</i>

	<i>Language</i> , Random House, 1996.
1020	<i>Papst Licensing GmbH &amp; 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	<i>Discrete-Time Signal Processing</i> , by Oppenheim <i>et al.</i> , First Edition, Prentice-Hall, 1989
1026-1030	<i>Intentionally Left Blank</i>
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>
1059-1060	<i>Intentionally Left Blank</i>
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>
1065	U.S. Patent No. 7,542,867 to Steger <i>et al.</i>
1066	U.S. Patent No. 6,377,617 to Nara
1067	U.S. Patent Application No. 11/928,283, filed October 30, 2007
1068	Preliminary Amendment filed in U.S. Pat. Appl. No. 11/928,283, February 9, 2009
1069	U.S. Provisional Patent Application No. 60/312,254, filed August 14, 2001
1070	U.S. Patent No. 7,149,093 to Conway
1071	<i>Microsoft Computer Dictionary</i> , Third Edition, Microsoft Press, 1997.
1072	<i>McGraw-Hill Dictionary of Scientific and Technical Terms</i> , Fifth Edition, McGraw-Hill, 1994

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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 10, 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 ‘746 Patent.

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