

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HUAWEI DEVICE CO., LTD., LG ELECTRONICS, INC., AND ZTE (USA) INC.,
Petitioners,

v.

PAPST LICENSING GMBH & CO., KG,
Patent Owner.

Case IPR2017-00443
United States Patent No. 6,470,399

**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 | Defendants’ Responsive Claim Construction Brief in <i>Papst Licensing GmbH & Co., KG v. Apple, Inc.</i> (6:15-CV-01095-RWS) |
| 2002 | <i>In re Papst Licensing Digital Camera Patent Litigation</i> , 778 F.3d 1255 (Fed. Cir. 2015) |
| 2003 | Definition of charge-coupled device, <i>Dictionary of Engineering</i> (2015) |
| 2004 | <i>Markman Order in Papst Licensing GmbH & Co., KG v. Apple Inc.</i> (6:15-CV-01095-RWS) |

Previously Filed – Petitioners

| Ex. No. | Description |
|----------------|---|
| 1001 | U.S. Patent No. 6,470,399 to Tasler |
| 1002 | File History for U.S. Patent No. 6,470,399 |
| 1003 | Declaration of Kevin C. Almeroth |
| 1004 | Curriculum Vitae of Kevin C. Almeroth |
| 1005 | U.S. Patent No. 5,508,821 to Murata |
| 1006 | Friedhelm Schmidt, <i>The SCSI Bus and IDE Interface</i> (1995) |
| 1007 | <i>The Microsoft Press Computer Dictionary</i> (2 nd ed. 1994) |
| 1008 | U.S. Patent No. 6,522,432 to Lin |
| 1009 | Papst’s Opening Claim Constr. Brief and Appendix 8 of Papst’s Opening Claim Constr. Brief, <i>Papst Licensing GmbH & Co., KG v. Apple, Inc., et al.</i> , No. 6:15-cv-01095-RWS (E.D. Tex. Nov. 22, 2016) |
| 1010 | Papst’s Opening Claim Constr. Brief and Decl. of Robert Zeidman, <i>In Re Papst Licensing Dig. Camera Pat. Litig.</i> , MDL No. 1880, 1:07-mc-00493, (D.D.C. June 3, 2016) |
| 1011 | Am. Nat’l Standards Inst., Inc., <i>Am. Nat’l Standard for Info. Sys’s Small Computer System Interface-2</i> , ANSI X3.131-1994 (1994) (“SCSI Specification”) |
| 1012 | <i>In re Papst Licensing Dig. Camera Pat. Litig.</i> , 778 F.3d 1255, 1265 |

| | |
|------|--|
| | (Fed. Cir. 2015) |
| 1013 | <i>The Microsoft Press Computer Dictionary</i> (2 nd ed. 1994) |
| 1014 | U.S. Patent No. 5,850,484 to Berretta <i>et al.</i> |
| 1015 | <i>Intentionally Left Blank</i> |
| 1016 | File History for U.S. Patent Application No. 08/411,369 |
| 1017 | Comparison of excerpts of File History for U.S. Patent Application No. 08/411,369 (Exhibit 1016) and U.S. Patent No. 5,850,484 to Beretta <i>et al.</i> (Ex. 1014) |
| 1018 | U.S. Patent No. 4,589,063 to Shah <i>et al.</i> |
| 1019 | U.S. Patent No. 5,038,320 to Heath <i>et al.</i> |
| 1020 | U.S. Patent No. 5,787,246 to Lichtman <i>et al.</i> |
| 1021 | <i>Intentionally Left Blank</i> |
| 1022 | Papst's Brief, <i>In re Papst Licensing Dig. Camera Pat. Litig.</i> , No 2014-1110 (Fed. Cir. February 20, 2014) |
| 1023 | Rufus P. Turner <i>et al.</i> , <i>The Illustrated Dictionary of Electronics</i> (1991) |

I. STATEMENT OF MATERIAL FACTS IN DISPUTE

Petitioners Huawei Device Co., Ltd, LG Electronics, Inc., and ZTE (USA) Inc. (“Petitioners”) did not submit a statement of material facts in their 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 April 4, 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 Petitioners have failed to establish that there is a reasonable likelihood that they will prevail on their propositions of unpatentability.

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