

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 IPR2017-00448
Patent 6,895,449

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

TABLE OF CONTENTS

| | | |
|------|---|----|
| I. | STATEMENT OF MATERIAL FACTS IN DISPUTE..... | 1 |
| II. | INTRODUCTION..... | 1 |
| A. | STATEMENT OF RELIEF REQUESTED..... | 2 |
| B. | OVERVIEW OF THE ‘449 PATENT..... | 2 |
| C. | LEVEL OF ORDINARY SKILL IN THE ART..... | 5 |
| D. | CLAIM CONSTRUCTION..... | 7 |
| E. | SUMMARY OF PATENT OWNER’S ARGUMENTS..... | 9 |
| III. | THE PETITION FAILS TO MEET THE REQUIREMENTS FOR INSTITUTING AN <i>INTER PARTES</i> REVIEW..... | 12 |
| A. | THE BOARD SHOULD NOT INSTITUTE TRIAL BASED ON THE PETITION’S REDUNDANT GROUNDS..... | 12 |
| B. | THE BOARD SHOULD NOT INSTITUTE TRIAL BASED ON THE PETITION’S CONCLUSORY OBVIOUSNESS COMBINATIONS..... | 15 |
| C. | THE BOARD SHOULD NOT INSTITUTE TRIAL BECAUSE ARD IS NOT PRIOR ART..... | 19 |
| IV. | CONCLUSION..... | 26 |

EXHIBIT LIST

Currently Filed – Patent Owner

| Ex. No. | Description |
|----------------|---|
| 2001 | Declaration of Dr. Kenneth Fernald |
| 2002 | Defendants' Responsive Claim Construction Brief |
| 2003 | <i>In re Papst Licensing GmbH & Co. Litigation</i> , Case No. 7-cv-493 (D.D.C.), Order Regarding Claim Construction |
| 2004 | IEEE Standard Signaling Method for a Bidirectional Parallel Peripheral Interface for Personal Computers, IEEE Std 1284-1994 |
| 2005 | Small Computer System Interface-2 (SCSI-2), ANSI X3.131-1994, American National Standard for Information Systems (ANSI). |
| 2006 | <i>Markman</i> Order in <i>Papst Licensing GmbH & Co., KG v. Apple Inc.</i> (6:15-CV-01095-RWS) |

Previously Filed – Petitioner

| Ex. No. | Description |
|----------------|---|
| 1101 | U.S. Patent 6,895,449 |
| 1102 | File History for U.S. Patent No. 6,895,449 |
| 1103 | Declaration of Kevin C. Almeroth |
| 1104 | Curriculum vitae of Kevin C. Almeroth |
| 1105 | U.S. Patent No. 5,508,821 to Murata |
| 1106 | U.S. Patent No. 5,915,106 to Ard |
| 1107 | U.S. Patent No. 5,850,484 to Beretta <i>et al.</i> |
| 1108 | European Patent Office Publication Number 0 685 799 A1 |
| 1109 | IBM Corp., <i>Communication Method between Devices Through FDD Interface</i> 38 IBM Technical Disclosure Bulletin 245 |
| 1110 | Ray Duncan, <i>The MS-DOS Encyclopedia</i> (1988) |
| 1111 | <i>In re Papst Licensing Dig. Camera Pat. Litig.</i> , 778 F.3d 1255, 1265 (Fed. Cir. 2015) |
| 1112 | 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) |
| 1113 | Papst's Opening Claim Constr. Brief and Decl. of Robert Zeidman, <i>In re Papst Licensing Dig. Camera Pat. Litig.</i> , MDL No. 1880, No. 1:07-mc-00493 (D.D.C. June 3, 2016) |

| | |
|------|---|
| 1114 | Am. Nat'l Standard Inst., Inc., <i>Am. Nat'l Standard for Info. Sys's, Small Computer System Interface-2</i> , ANSI X3.131-1994 (1994) ("SCSI Specification") |
| 1115 | US Patent No. 6,470,399 |
| 1116 | Patent Cooperation Treaty Patent Application PCT/EP98/01187 (published as PCT Pub. No. WO98/39710) |
| 1117 | As-Filed Filed German priority document Patent Application 197 08 755.8 |
| 1118 | File History for U.S. Patent No. 6,470,399 |
| 1119 | '399 German Application Publication (DE 197 08 755) |
| 1120 | Certified Translation of Published '399 German Application (DE 197 08 755) |
| 1121 | English Translation of PCT Application PCT/EP98/01187 (published as PCT Pub. No. WO98/39710) |
| 1122 | U.S. Patent No. 4,589,063 |
| 1123 | U.S. Patent No. 5,038,320 |
| 1124 | U.S. Patent No. 5,787,246 |
| 1125 | Comparison of excerpts of File History for U.S. Patent Application No. 08/411,369 and U.S. Patent No. 5,850,484 to Beretta <i>et al.</i> (Ex. 1107) |
| 1126 | File History for U.S. Patent Application No. 08/411,369 |
| 1127 | Vetterli & Nussbaumer, <i>Simple FFT and DCT Algorithms</i> , 6 <i>Signal Processing</i> 267-78 (1984) |
| 1128 | Papst's Brief, <i>In re Papst Licensing Dig. Camera Pat. Litig.</i> , No. 2014-1110 (Fed. Cir. February 20, 2014) |
| 1129 | Rufus P. Turner <i>et al.</i> , <i>The Illustrated Dictionary of Electronics</i> (1991) |
| 1130 | Friedhelm Schmidt, <i>The SCSI Bus and IDE Interface</i> (1995) |
| 1131 | Dave Williams, <i>The Programmer's Technical Reference: MSDOS, IBM PC & Compatibles</i> (1990) |

I. STATEMENT OF MATERIAL FACTS IN DISPUTE

Petitioners Huawei Device Co., Ltd., LG Electronics, Inc., and ZTE (USA) Inc. (collectively, “Petitioners”) did not submit a statement of material facts in their Petition for *inter partes* review. Paper 1 (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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