

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HUAWEI TECHNOLOGIES CO., LTD.,
Petitioner,

v.

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

Case IPR2017-00449
Patent 8,504,746

**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	USPTO Decision on Petition to Accept an Unintentionally Delayed Claim for the Benefit of Priority, dated February 9, 2017

Previously Filed – Petitioner

Ex. No.	Description
1001	U.S. Patent 8,504,746 to Tasler
1002	File History for U.S. Patent No. 8,504,746
1003	File History for Application Serial No. 11/078,778
1004	Certified English Translation of PCT No. WO 98/39710
1005	Patent Owner's Petition for Delayed Claim of Priority, November 10, 2016
1006	U.S. Patent Application Publication 2005/0160199 A1 to Tasler
1007	U.S. Patent No. 6,470,399 to Tasler
1008	PCT No. WO 98/39710
1009	U. S. Patent No. 6,305,963 to Felps
1010	Petition to Revive Unintentionally Abandoned Application Pursuant to 37 C.F.R. § 1.137(b) and (c), and Renewed Petition to Revive Unintentionally Abandoned Application Pursuant to 37 C.F.R. § 1.137(b) and (c)

I. STATEMENT OF MATERIAL FACTS IN DISPUTE

Petitioner Huawei Technologies Co., Ltd. (“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 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 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.

B. OVERVIEW OF THE '746 PATENT

The '746 Patent involves a unique method for achieving high data transfer rates for data acquisition systems (e.g., still pictures, videos, voice recordings) to a general-purpose computer, without requiring a user to purchase, install, and/or run specialized software for each system. Exhibit 1001 ('746 Patent) at 3:32-36. At the time of the invention, there were an increasing number and variety of data acquisition systems with the ability to capture high volumes of information. *Id.* at 1:44-62. As such, there was an increasing demand to transfer that information to commercially-available, general purpose computers. *Id.* at 1:31-43. But at that time—and today—performing that data transfer operation required either loading specialized, sophisticated software onto a general purpose computer, which increases the risk of error and the level of complexity for the operator, or specifically matching interface devices for a data acquisition system to a host system that may maximize data transfer rates but lacks the flexibility to operate with different devices. *Id.* at 1:26-3:24.

The '746 Patent recognizes that the existing options were wasteful and

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