

IN THE 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 No. To Be Assigned
Patent No. 8,504,746 B2

**PETITION FOR INTER PARTES REVIEW OF U.S. PATENT NO.
8,504,746 UNDER 35 U.S.C. §§ 311-319 AND 37 C.F.R. § 42.100 *et seq.***

LIST OF EXHIBITS

| Exhibit | Description |
|----------|--|
| Ex. 1001 | U.S. Patent No. 8,504,746 B2 to Tasler |
| Ex. 1002 | File History for U.S. Patent No. 8,504,746 |
| Ex. 1003 | File History for Application Serial No. 11/078,778 |
| Ex. 1004 | Certified English Translation of PCT No. WO 98/39710 |
| Ex. 1005 | Patent Owner's Petition for Delayed Claim of Priority, November 10, 2016 |
| Ex. 1006 | U.S. Patent Application Publication 2005/0160199 A1 to Tasler. |
| Ex. 1007 | U.S. Patent No. 6,470,399 to Tasler |
| Ex. 1008 | PCT No. WO 98/39710 |
| Ex. 1009 | U. S. Patent No. 6,305,963 to Felps |
| Ex. 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) |

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Huawei Technologies Co., Ltd. petitions for *inter partes* review seeking cancellation of claims 1, 4, 6-8, 10, 11, 14, 15, 17, 18, 20, 21, 23, 30, 31, 34, and 35 (“challenged claims”) of U.S. Patent No. 8,504,746 B2 (Ex. 1001, “’746 Patent”), assigned to Patent Owner Papst Licensing GmbH & Co. KG.

The ’746 Patent seeks to claim priority, through a long string of continuing applications, to a 1998 PCT application. But there is a critical break in the priority chain. An intervening U.S. patent application (on which the ’746 Patent seeks to rely, as a bridge to the PCT) failed to identify each of the earlier applications in the chain, as is required to perfect such a priority claim. Indeed, the Patent Owner has recently acknowledged this failure, in a recent petition “for a delayed claim of priority.” (Ex. 1005.) But the Patent Owner’s petition cannot remedy the issue, as the intervening application was abandoned expressly (nearly a decade ago), and cannot now be revived to retroactively fix this “administrative error.”

Thus, under 35 U.S.C. § 120, the ’746 Patent cannot claim priority back to the PCT. To the contrary, the PCT Publication (Exs. 1004, 1008) is prior art to the ’746 Patent, under the statutory bar of pre-AIA 35 U.S.C. § 102(b)—and it plainly anticipates the challenged claims. Accordingly, Petitioner respectfully requests that the Patent Trial and Appeal Board (“Board”) institute trial for *inter partes* review and cancel these claims.

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