

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZTE (USA) INC.
Petitioner,

v.

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

Case IPR2017-00712
Patent 9,189,437

**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 9,189,437 to Tasler
1002	<i>Intentionally Omitted</i>
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	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)
1010	Declaration of Kevin C. Almeroth, Ph.D.
1011	Curriculum vitae of Kevin C. Almeroth
1012	Waiver of Service of Summons

I. STATEMENT OF MATERIAL FACTS IN DISPUTE

Petitioner ZTE (USA) Inc. (“Petitioner”) did not submit a statement of material facts in its 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 May 1, 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 '437 Patent.

B. OVERVIEW OF THE '437 PATENT

The '437 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 ('437 Patent) at 3:33-37. 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 1:42-57. As such, there was an increasing demand to transfer that information to commercially-available, general purpose computers. *Id.* at 1:29-41. 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 1:26-3:25.

The '437 Patent recognizes that the existing options were wasteful and

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