UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CANON INC., CANON U.S.A., INC.,
CANON FINANCIAL SERVICES, INC., FUJIFILM CORPORATION,
FUJIFILM HOLDINGS AMERICA CORPORATION,
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CORPORATION, JVCKENWOOD USA CORPORATION,
NIKON CORPORATION, NIKON INC., OLYMPUS CORPORATION,
OLYMPUS AMERICA INC., PANASONIC CORPORATION,
PANASONIC CORPORATION OF NORTH AMERICA,
SAMSUNG ELECTRONICS CO., LTD., and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

PAPST LICENSING GMBH & CO. KG,
Patent Owner.

Case IPR2016-01199
Patent 8,966,144 B2

Before JONI Y. CHANG, JENNIFER S. BISK, and
MIRIAM L. QUINN, *Administrative Patent Judges.*

CHANG, *Administrative Patent Judge.*

FINAL WRITTEN DECISION
35 U.S.C. § 318 (a) and 37 C.F.R. § 42.73

I. INTRODUCTION

Petitioner, listed above, filed a Petition requesting an *inter partes* review of claims 1–8, 10, 14–20, 22, 26, 28, 29, 38, 52, 56, 57, 59–65, 67, 71–74, 77–80, 84, 86, and 87 of U.S. Patent No. 8,966,144 B2 (Ex. 1003, "the '144 patent") and a Declaration of Paul Reynolds, Ph.D. (Ex. 1001). Paper 1 ("Pet."). Patent Owner, Papst Licensing GmbH & Co., KG ("Patent Owner"), filed a Preliminary Response. Paper 7 ("Prelim. Resp."). We instituted the instant *inter partes* review as to claims 1–8, 10, 14–20, 22, 28, 29, 38, 52, 56, 57, 59–65, 67, 71–74, 77–80, 84, 86, and 87, but not with respect to claim 26. Paper 8 ("Dec.").

Subsequent to institution, Patent Owner filed a Patent Owner Response (Paper 12, "PO Resp.") and a Declaration of Mr. Thomas Gafford (Ex. 2005). Petitioner filed a Reply. Paper 14 ("Reply"). A transcript of the oral hearing held on September 14, 2017, has been entered into the record as Paper 17 ("Tr.").[1]

This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a). For the reasons that follow, Petitioner has demonstrated by a preponderance of the evidence that claims 1–8, 10, 14–20, 22, 28, 29, 38, 52, 56, 57, 59–65, 67, 71–74, 77–80, 84, 86, and 87 of the '144 patent are unpatentable.

[1] This was a consolidated hearing with related cases IPR2016-01200, IPR2016-01213, and IPR2016-001214. *See* Tr. In addition, on September 13, 2017, we held hearings for several other related cases IPR2016-01211, IPR2016-01212, IPR2016-01216, and IPR2016-01225. Because of the overlap in issues in all the related cases, the transcripts for those hearings are also entered into the record in this case. Papers 18−19.

A. Related Matters

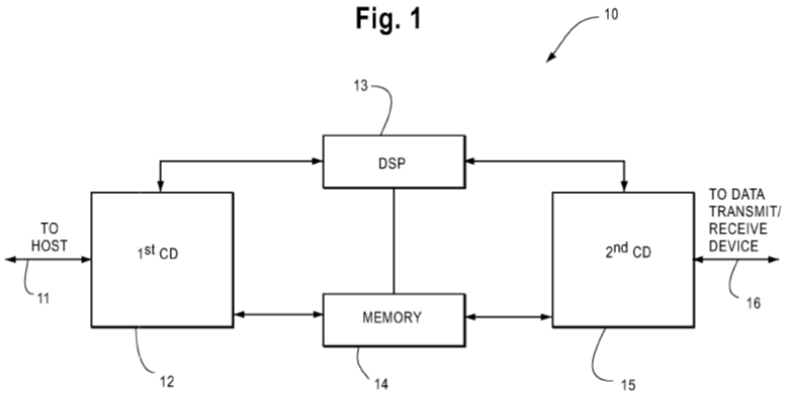
The parties indicate that the '144 patent is involved in *Papst Licensing GmbH & Co. KG v. Canon Inc.*, Case No. 1:15-cv-01692 (D.D.C.) and other proceedings. Pet. 4–6; Paper 5, 1–3. A final written decision in each of the following proceedings is entered concurrently with this decision: IPR2016-01212, IPR2016-01214, IPR2016-01216, and IPR2016-01225.

B. The '144 Patent

The '144 patent describes an interface device for communication between a computer host device and a data transmit/receive device (e.g., a multi-meter, transmitting measured data to a computer). Ex. 1003, 1:18–22, 1:54–57. According to the '144 patent, using a specific driver to match very closely to an individual host system would achieve high data transfer rates across the interface, but the specific driver cannot be used with other host systems. *Id*. at 2:4–19. Several solutions to this problem were known in the art. *Id*. at 2:20–3:25. For example, IOtech introduced an interface device for laptops, using a plug-in card for converting the personal computer memory card association (PCMCIA) interface into a known standard interface (IEEE 1284). *Id*. at 2:23–29. The plug-in card provided a printer interface for enhancing data transfer rates. *Id*. at 2:29–33. In another example, a floppy disk drive interface was used for connecting a host device to a peripheral device. *Id*. at 3:10–14. The interface appeared as a floppy disk drive to the host, allowing a floppy disk drive and another peripheral device to be connected to the host device. *Id*. at 3:17–19.

The ’144 patent indicates that the “invention is based on the finding that both a high data transfer rate and host device-independent use can be achieved if a driver for an input/output device customary in a host device” is utilized. *Id*. at 3:33–37. Figure 1 of the ’144 patent, reproduced below, illustrates a block diagram of an interface device.

Fig. 1



As shown in Figure 1 above, interface device 10 connects to a host device via host line 11, and to a data transmit/receive device via output line 16. *Id*. at 4:62–5:10. Interface device 10 includes first connecting device 12, second connecting device 15, digital signal processor 13, and memory means 14. *Id*. In a preferred embodiment, the interface device is attached to a host device via a multi-purpose interface—e.g., a small computer systems interface (SCSI)—which includes both an interface card and the driver for the interface card. *Id*. at 3:51–57, 8:42–46. According to the ’144 patent, SCSI interfaces were known to be present on most host devices or laptops. *Id*. at 8:42–46. By using a standard interface of a host device and by simulating an input/output device to the host device, the interface device “is automatically supported by all known host systems without any additional sophisticated driver software.” *Id*. at 11:38–44.

C. Illustrative Claim

Of the challenged claims, claims 1, 84, and 86 are independent. Claims 2–8, 10, 14–20, 22, 28–29, 38, 52, 56–57, 59–65, 67, 71–74, 77–80 depend ultimately from claim 1; claim 85 depends from claim 84; and claim 87 depends from claim 86. Claim 1 is illustrative:

> 1. An analog data generating and processing device (ADGPD), comprising:
>
> an input/output (i/o) port;
>
> a program memory;
>
> a data storage memory;
>
> a sensor designed to transmit data;
>
> a *processor* operatively interfaced with the i/o port, the program memory, the data storage memory and the sensor;
>
> wherein the processor is adapted to be involved in *a data generation process* by which the sensor generates analog data, the analog data is processed, and the processed analog data is stored in the data storage memory as at least one file of digitized analog data;
>
> wherein the processor also is adapted to be involved in *an automatic recognition process* in which, when the i/o port is operatively interfaced with a *multi-purpose interface* of a computer, the processor executes at least one instruction set stored in the program memory and thereby causes at least one parameter which provides identification information regarding the ADGPD to be automatically sent through the i/o port and to the multi-purpose interface of the computer
>
> (a) without requiring any end user to load any software onto the computer at any time,
>
> (b) without requiring any end user to interact with the computer to set up a file system in the ADGPD at any time,

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