

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

PAPST LICENSING GMBH & CO. KG,
Patent Owner.

Case IPR2016-01863
Patent 8,504,746 B2

Before JONI Y. CHANG, JAMES B. ARPIN, and MIRIAM L. QUINN,
Administrative Patent Judges.

QUINN, *Administrative Patent Judge.*

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

I. INTRODUCTION

In this *inter partes* review, instituted pursuant to 35 U.S.C. § 134, Apple Inc. (“Petitioner”) challenges the patentability of certain claims of U.S. Patent No. 8,504,746 B2 (Ex. 1001, “the ’746 patent”), owned by Papst Licensing GMBH & Co. KG (“Patent Owner”). We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed below, Petitioner has not shown by a preponderance of the evidence that claims 1, 4, 6–8, 10, 11, 14, 20, 21, 23, 30, 34, and 35 of the ’746 patent are unpatentable.

A. PROCEDURAL HISTORY

Petitioner filed a Petition to institute *inter partes* review of claims 1, 4, 6–8, 10, 11, 14, 20, 21, 23, 30, 34, and 35 of the ’746 patent (“challenged claims”). Paper 2 (“Pet.”). Patent Owner filed a Preliminary Response. Paper 9 (“Prelim. Resp.”). On April 17, 2017, we instituted *inter partes* review as to all the challenged claims. Paper 10 (“Institution Decision” or “Dec.”).

After institution, Patent Owner filed a Patent Owner Response. Paper 16 (“PO Resp.”). In addition, Petitioner filed a Reply. Paper 18 (“Reply”). We heard oral arguments on January 16, 2018. A transcript of the hearing has been entered into the record. Paper 30 (“Tr.”).

B. RELATED MATTERS

The parties indicate that the '746 patent is involved in *Papst Licensing GmbH & Co. KG v. Apple, Inc.*, Case No. 6-15-cv-01095 (E.D. Tex.) and other proceedings. Pet. 2–3; Paper 8, 2–5. The '746 patent has also been the subject of three concluded *inter partes* reviews, Cases IPR2016-01200, IPR2016-01211, and IPR2016-01213, all of which have issued to Final Written Decision.

C. REAL PARTIES-IN-INTEREST

Petitioner asserts that Apple Inc. is the only real party-in-interest. Pet. 2.

D. THE '746 PATENT (EX. 1001)

The '746 patent is titled, “Analog Data Generating and Processing Device for use With a Personal Computer.” Ex. 1001, (54). It relates generally to the transfer of data, and, in particular, to interface devices for communication between a computer or host device and a data transmit/receive device from which data is to be acquired or with which two-way communications is to take place. *Id.* at 1:20–24. Figure 1, reproduced below, illustrates a general block diagram of interface device 10. *Id.* at 4:59–60.

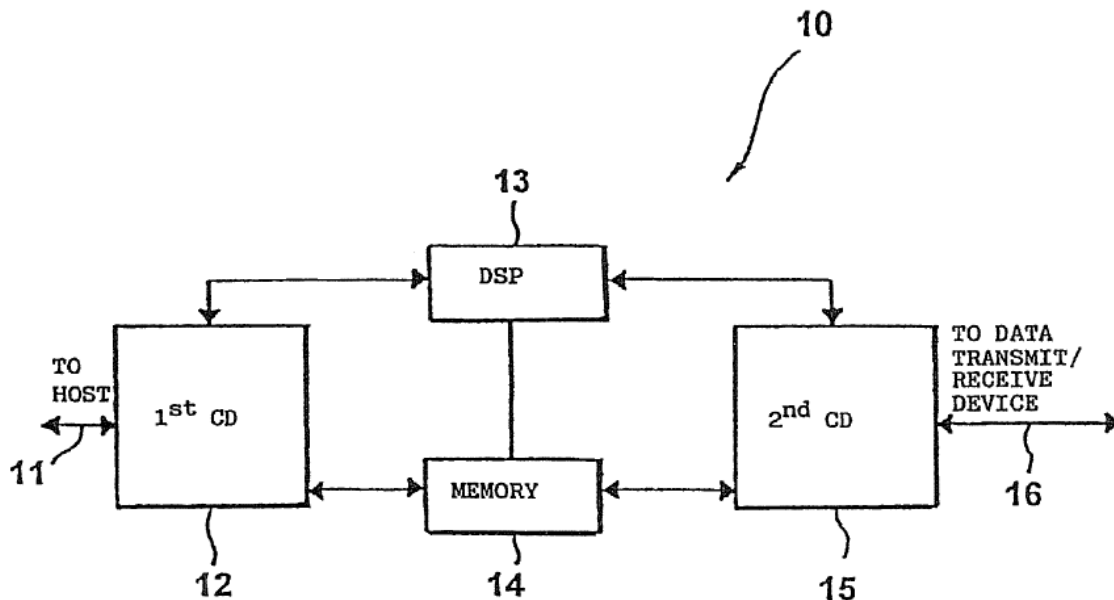


FIG. 1

According to Figure 1, first connecting device 12 is attached to a host device (not shown), to digital signal processor (DSP) 13 and memory means 14. *Id.* at 4:60–65. DSP 13 and memory means 14 are also connected to second connecting device 15. *Id.* at 4:64–67. The interface device “simulates a hard disk with a root directory whose entries are ‘virtual’ files which can be created for the most varied functions.” *Id.* at 5:11–14. “Regardless of which data transmit/receive device at the output line 16 is attached to the second connecting device, the digital signal processor 13 informs the host device that it is communicating with a hard disk drive.” *Id.* at 5:31–34. In one embodiment, the interface device is automatically detected when the host system is “booted,” resulting in the user “no longer

[being] responsible for installing the interface device 10 on the host device by means of specific drivers which must also be loaded.” *Id.* at 7:13–20.

E. REPRESENTATIVE CLAIM

There are two independent claims in the set of challenged claims (1 and 34). Claim 1 is reproduced below, and is representative of the subject matter claimed.

1. An analog data acquisition device operatively connectable to a computer through a multipurpose interface of the computer, the computer having an operating system programmed so that, when the computer receives a signal from the device through said multipurpose interface of the computer indicative of a class of devices, the computer automatically activates a device driver corresponding to the class of devices for allowing the transfer of data between the device and the operating system of the computer, the analog data acquisition device comprising:

- a) a program memory;
- b) an analog signal acquisition channel for receiving a signal from an analog source;
- c) a processor operatively interfaced with the multipurpose interface of the computer, the program memory, and a data storage memory when the analog data acquisition device is operational;
- d) wherein the processor is configured and programmed to implement a data generation process by which analog data is acquired from the analog signal acquisition channel, the analog data is processed and digitized, and the processed and digitized analog data is stored in a file system of the data storage memory as at least one file of digitized analog data;
- e) wherein when the analog acquisition device is operatively interfaced with the multipurpose interface of the computer, the processor executes at least one instruction set stored in the program memory and thereby automatically causes at least one parameter indicative of the class of devices to be sent to the computer through the multipurpose interface of the

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