

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FUJIFILM Corporation *et al.*

Petitioners

v.

Papst Licensing GmbH & Co., KG,

Patent Owner

CASE: Unassigned

Patent No. 8,504,746

**PETITION FOR *INTER PARTES* REVIEW
OF U.S. PATENT NO. 8,504,746**

PETITIONERS' EXHIBIT LIST

- Ex. 1001 Declaration of Dr. Paul F. Reynolds, Ph.D.
- Ex. 1002 Curriculum Vitae of Dr. Paul F. Reynolds, Ph.D.
- Ex. 1003 U.S. Patent No. 8,504,746 to Michael Tasler (“the ’746 Patent”).
- Ex. 1004 U.S. Patent No. 5,758,081 to Haluk M. Aytac (“Aytac” or “the ’081 Patent”).
- Ex. 1005 American National Standard for Information Systems, Small Computer System Interface-2, ANSI X3.131-1994 (1994) (“SCSI Specification”).
- Ex. 1006 Prosecution History of the ’081 Patent.
- Ex. 1007 Excerpts from the Prosecution History of the ’746 Patent.
- Ex. 1008 MPEP 6th ed., Rev. 1, Sept. 1, 1995, § 608.05.
- Ex. 1009 Patent Owner (“Papst”)’s Opening Claim Construction Brief and Declaration of Robert Zeidman, filed in related litigation in the District of Columbia. *In re: Papst Licensing Digital Camera Patent Litigation*, MDL No. 1880, Case No. 1:07-mc-00493, Dkt. Nos. 630, 630-12 (June 3, 2016).
- Ex. 1010 Ray Duncan, ed., “The MS-DOS Encyclopedia,” Microsoft Press (1988).
- Ex. 1011 Federal Circuit decision, *In re: Papst Licensing Digital Camera Patent Litigation*, No. 2014-1110 (Fed. Cir. Feb. 2, 2015).
- Ex. 1012 American National Standards Institute, Procedures for the Development and Coordination of American National Standards, Approved by the ANSI Board of Directors (Sept. 9, 1993).

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I. INTRODUCTION

Inter partes review is respectfully requested of claims 1, 6, 15, 17, 18, 31 and 34 (the “Challenged Claims”) of U.S. Patent No. 8,504,746 (“the ’746 Patent”) (Ex. 1003).

The ’746 Patent is part of a chain of applications dating back to 1997, which were acquired by Papst Licensing GmbH & Co., KG (“Papst” or the “Patent Owner”) in 2006. Papst has filed multiple patent infringement suits against Petitioners. During the past decade in which those patent infringement suits have been pending, Papst has continued to serially file continuation applications in an attempt to broaden the claims of its patents and capture Petitioners’ accused products.

But the patent family to which the ’746 Patent belongs does not cover the technology that Papst has accused of infringement. Thus, Papst presented claims to the Patent Office through numerous applications in the family, that are broad in scope, go beyond what is disclosed in its specification and read directly on the prior art. Because of this, it took over *fifteen years* to prosecute the many applications in the family, and during that time, Papst presented hundreds of different claims for consideration and submitted dozens of different amendments.

Papst primarily cited and focused solely on distinguishing digital camera prior art over the course of prosecution. This resulted in the Examiner citing digital camera prior art almost exclusively in his examination. Because of the focus on

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