

APPENDIX A-2

**United States Court of Appeals
for the Federal Circuit**

**IN RE PAPST LICENSING DIGITAL CAMERA
PATENT LITIGATION**

PAPST LICENSING GMBH & CO. KG,
Plaintiff-Appellant,

v.

**FUJIFILM CORPORATION, FUJIFILM NORTH
AMERICA CORPORATION (formerly known as
Fujifilm USA, Inc.), HEWLETT-PACKARD
COMPANY, JVC COMPANY OF AMERICA, NIKON
CORPORATION, NIKON, INC., OLYMPUS CORP.,
OLYMPUS IMAGING AMERICA INC., PANASONIC
CORPORATION (formerly known as Matsushita
Electric Industrial Co., LTD.), PANASONIC
CORPORATION OF NORTH AMERICA , SAMSUNG
OPTO-ELECTRONICS AMERICA, INC., SAMSUNG
TECHWIN CO., AND VICTOR COMPANY OF JAPAN,
LTD.,**
Defendants-Appellees.

2014-1110

Appeal from the United States District Court for the
District of Columbia in No. 1:07-mc-00493-RMC, Judge
Rosemary M. Collyer.

Decided: February 2, 2015

JOHN T. BATTAGLIA, Fisch Hoffman Sigler LLP, of Washington, DC, argued for plaintiff-appellant. With him on the brief were ALAN M. FISCH and ROY WILLIAM SIGLER.

RACHEL M. CAPOCCIA, Alston & Bird LLP, of Los Angeles, California, argued for defendants-appellees. With her on the brief for Panasonic Corporation, et al., was THOMAS W. DAVISON. On the brief for Fujifilm Corporation, et al., were STEVEN J. ROUTH, STEN A. JENSEN, JOHN R. INGE and T. VANN PEARCE, JR, Orrick, Herrington & Sutcliffe LLP, of Washington, DC. On the brief for Nikon Corporation, et al., were DAVID L. WITCOFF and MARC S. BLACKMAN, Jones Day, of Chicago, Illinois. Of counsel was MARRON ANN MAHONEY. On the brief for Olympus Corporation, et al., were RICHARD DE BODO and ANDREW V. DEVKAR, Bingham McCutchen LLP, of Santa Monica, California. Of counsel was SUSAN BAKER MANNING, Morgan, Lewis & Bockius LLP, of Washington, DC. On the brief for Samsung Techwin, Co., et al., was PATRICK J. KELLEHER, Drinker Biddle & Reath LLP, of Chicago, Illinois.

CHARLENE M. MORROW, Fenwick & West LLP, of Mountain View, California, argued for defendant-appellee Hewlett-Packard Company. With her on the brief were DAVID D. SCHUMANN and BRYAN A. KOHM, of San Francisco, CA.

Before TARANTO, SCHALL, and CHEN, *Circuit Judges*.

TARANTO, *Circuit Judge*.

Papst Licensing GmbH & Co. KG owns U.S. Patent Nos. 6,470,399 and 6,895,449. The written descriptions

are largely the same, the '449 patent having issued on a divisional application carved out of the application that became the '399 patent. The focus of both patents is an interface device for transferring data between an input/output data device and a host computer. The current appeal involves whether certain digital-camera manufacturers infringe Papst's patents. The district court, applying and elaborating on its constructions of various claim terms, entered summary judgment of non-infringement, concluding that none of the manufacturers' accused products at issue here come within any of the asserted claims. Papst appeals five claim constructions. We agree with Papst that the district court erred in the identified respects. We therefore vacate the summary judgment of non-infringement.

BACKGROUND

The '399 and '449 patents, both entitled "Flexible Interface for Communication Between a Host and an Analog I/O Device Connected to the Interface Regardless the Type of the I/O Device," disclose a device designed to facilitate the transfer of data between a host computer and another device on which data can be placed or from which data can be acquired. '399 patent, Title and Abstract.¹ The written description states that, while interface devices were known at the time of the invention, the existing devices had limitations, including that they tended to require disadvantageous sacrifices of data-transfer speed or of flexibility as to what host computers and data devices they would work with. '399 patent, col. 1, line 15, to col. 2, line 13. Thus, "standard interfaces"—those "which, with specific driver software, can be used

¹ Because the '399 and '449 patents have very similar written descriptions, we cite the '399 patent, and refer to a "written description" in the singular, except when there are important differences between the two.

with a variety of host systems”—“generally require very sophisticated drivers” to be downloaded onto the host computer, but such drivers “are prone to malfunction and . . . limit data transfer rates.” *Id.* at col. 1, lines 22–28. On the other hand, with interface devices that “specifically match the interface very closely to individual host systems or computer systems,” “high data transfer rates are possible,” but such interface devices “generally cannot be used with other host systems or their use is very ineffective.” *Id.* at col. 1, line 67, to col. 2, line 7. The fast, host-tailored interface also “must be installed inside the computer casing to achieve maximum data transfer rates,” which is a problem for laptops and other space-constrained host systems. *Id.* at col. 2, lines 8–13.

The patents describe an interface device intended to overcome those limitations. It is common ground between the parties that, when a host computer detects that a new device has been connected to it, a normal course of action is this: the host asks the new device what type of device it is; the connected device responds; the host determines whether it already possesses drivers for (instructions for communicating with) the identified type of device; and if it does not, the host must obtain device-specific drivers (from somewhere) before it can engage in the full intended communication with the new device. In the patents at issue, when the interface device of the invention is connected to a host, it responds to the host’s request for identification by stating that it is a type of device, such as a hard drive, for which the host system already has a working driver. By answering in that manner, the interface device induces the host to treat it—and, indirectly, data devices on the other side of the interface device, no matter what type of devices they are—like the device that is already familiar to the host. Thereafter, when the host communicates with the interface device to request data from or control the operation of the data device, the host uses its native device driver, and the interface device

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