

RESPONSE TO STATEMENT OF MATERIAL FACTS

1. Petitioner concurrently files this motion to join a petition for *inter partes* review and a motion to waive or suspend the rules governing the time limit for motions for joinder.

RESPONSE: Admitted.

2. As more fully described in the accompanying motion to waive or suspend the rules, the '449 patent is one of five patents (hereafter, the Tasler Patents) that Papst has been asserting against manufactures of digital cameras, mobile phones, and tablets—asserting them against the digital camera manufacturers for over a decade.

RESPONSE: Admitted that the '449 patent is one of the Tasler patents. Denied as to the other allegations in this paragraph.

3. In 2006, Papst acquired rights to the Tasler Patents, speculating that the Tasler Patents could be asserted against any electronic device that behaved as a generic storage device or hard drive when connected to a personal computer. The Tasler Patents have been the subject of continuous litigation ever since. *See In re Papst Licensing Digital Camera Patent Litig.*, 778 F.3d 1255, 1260 (Fed. Cir. 2015) (Ex.1011).

RESPONSE: Admitted that Papst acquired the Tasler patents, which have been the subject to litigation. Denied as to the allegation that the patents have

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been involved in “continuous” litigation and denied that Papst “speculat[ed] that the Tasler Patents could be asserted against any electronic device that behaved as a generic storage device or hard drive when connected to a personal computer.”

4. For example, in 2007, Papst sued several digital camera manufacturers for infringement of two of the Tasler Patents. *See id.* The cases against the digital camera manufacturers have been consolidated in *In re: Papst Licensing Digital Camera Patent Litigation - MDL 1880*, C.A. No. 1:07-493 (DCD) and the MDL was later expanded to include two additional Tasler Patents. *In re Papst Licensing GmbH & Co. KG Patent Litig.*, MDL No. 1880, Dkt. No. 22 (D.D.C. Nov. 5, 2007).

RESPONSE: Admitted.

5. In 2015, Papst sued manufacturers of mobile phones and tablet devices in the Eastern District of Texas, alleging infringement of all five of the Tasler Patents. *See Papst Licensing GmbH & Co. KG v. Apple*, No. 6:15-cv-01095, 2017 WL 897172, at *1 (E.D. Tex. Mar. 7, 2017). The cases against the mobile phone and tablet manufacturers have been consolidated for pre-trial activities in *Papst Licensing GmbH & Co. KG v. Apple Inc.*, Civil Action No. 6:15-cv-1095-RWS (E.D. Tex).

RESPONSE: Admitted

6. IPR2017-00415, concerning the '449 patent, was instituted on May 17, 2017 based on a petition filed by Huawei, LG, and ZTE, all manufacturers of mobile phones and tablets. On June 16, 2017, Camera manufacturer Olympus filed a motion to join that proceeding, and its motion was granted on October 17, 2017. *Olympus Corp. v. Papst Licensing GmbH & Co. KG*, IPR2017-01617, Paper 3 (PTAB June 16, 2017); *Olympus Corp. v. Papst Licensing GmbH & Co. KG*, IPR2017-01617, Paper 7 (PTAB Oct. 17, 2017). On August 23, 2017 and November 30, 2017, respectively, Huawei and LG were terminated from IPR2017-00415 due to settlement. Currently, Papst and ZTE have reached a settlement and are finalizing their settlement agreement. No Motion to Terminate has yet been filed in IPR2017-00415 as to ZTE.

RESPONSE: Admitted as to the institution date, Olympus motion to join and terminations of Huawei and LG regarding IPR2017-00415. However, Petitioner failed to mention that Olympus was also terminated on January 4, 2018 (IPR2017-00415, Paper 29). Denied as to the termination of ZTE. In fact, on January 8, 2018, a Motion to Terminate ZTE was filed (IPR2017-00415, Paper 30). On January 18, 2018, the PTAB dismissed ZTE and terminated IPR2017-00415 in its entirety (IPR2017-00415, Paper 32).

7. With Huawei, LG, and ZTE all settling or settled, that left only Olympus to

pursue IPR2017-00415. Further, with the Board having found all asserted claims of the related '144 and '746 patents unpatentable, and in light of the Board already having found in its Institution Decision a reasonable likelihood of unpatentability, there is a reasonable likelihood that all challenged claims of the '449 patent would be found unpatentable in IPR2017-00415.

RESPONSE: Denied. A motion to terminate Olympus was filed on December 27, 2017 (IPR2017-00415, Paper 27), two days before Petitioner in this proceeding filed their Motion for Joinder and twelve days before a motion to terminate ZTE was filed. Olympus was in fact terminated on January 4, 2018 (IPR2017-00415, Paper 29). Denied as to all other allegations.

8. Therefore, in an effort to derail IPR2017-00415 and thereby salvage the '449 patent, Papst made a “sweetheart deal” with Olympus.

RESPONSE: Admitted that Papst and Olympus reached a settlement. Denied that it was a “sweetheart deal”.

9. On December 19, 2017 and December 21, 2017, Papst filed notices with the District Courts in Texas and Washington, D.C. stating that Papst had reached a settlement with Olympus and, therefore, it anticipated that IPR2017-00415 would be terminated without a Final Written Decision.¹ *See In re Papst Licensing GmbH & Co. KG Patent Litig.*, MDL No. 1880, Dkt. No. 681 (D.D.C. Dec. 21, 2017);

¹ Papst also stated that it anticipates IPR2017-00713, also concerning the '449 patent, will be terminated. Movants do not seek to join that proceeding.

Papst Licensing GmbH & Co. KG v. Apple, No. 6:15-cv-01095, Dkt. No. 679 (E.D. Tex. Dec. 19, 2017).

RESPONSE: Admitted.

10. Although Movants have not seen the settlement agreement between Papst and Olympus, Movants suspect that the settlement involves a small payment by Olympus to entice Olympus to accept and thereby terminate IPR2017-00415. This Board will learn the details by examining the Olympus settlement agreement that Papst must submit to the Board with any motion to terminate.

RESPONSE: Denied.

11. Overall, the Board has now reached a Final Written Decision in eight of 18 instituted IPR proceedings against the Tasler Patents. In each of the eight Final Written Decisions, the Board found *every instituted claim* of U.S. Patent Nos. 8,504,746 and 8,966,144 (the '746 and '144 patents, respectively) unpatentable. *See* IPR2016-01199, -01200, -01211, -01212, -01213, -01214, -01216, -01225. The '746 and '144 patents are continuations of the '449 patent that is the subject of the Pending IPR.

RESPONSE: Denied.

12. The Instant Petition that accompanies the present Motion for Joinder and

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