

RESPONSE TO STATEMENT OF RELEVANT FACTS

A. Litigation History

1. The '449 patent is one of five Tasler Patents in a patent family that has been the subject of two separate litigation campaigns, one of which has been going on for more than a decade. The Tasler Patents were acquired by Papst Licensing GmbH & Co. KG (Papst) in 2006. Immediately after acquiring the Tasler Patents, Papst began accusing the world's leading digital camera manufacturers of infringement. *See In re Papst Licensing Digital Camera Patent Litig.*, 778 F. 3d 1255, 1260 (Fed. Cir. 2015) (Ex. 1011). Casio filed the first declaratory judgment action in October 2006 in Washington, D.C. *See id.* After the District Judge sanctioned Papst for violating her discovery orders, Papst embarked on a forum shopping campaign to manipulate the forums in which it enforced its patents and circumvent the venue where it was sanctioned for misconduct. *See id.*; *see also In re Papst Licensing GmbH & Co. KG Litig.*, 967 F. Supp. 2d 48, 61-62 (D.D.C. 2013) (“Through its experienced patent lawyers, Papst blatantly disregarded the Sixth PPO. The Court took Papst to task for obfuscating its infringement theories, finding that Papst had done so intentionally as part of its strategy to extend this litigation excessively, since Papst’s business is litigation.”). Papst commenced filing lawsuits across the country and then asked the Judicial Panel on Multidistrict Litigation (JPML) to geographically “centralize” all those cases. *In re Papst*

Papst Licensing GmbH & Co., KG.

Licensing GmbH & Co. KG Patent Litig., MDL No. 1880, Dkt. No. 22, 528 F. Supp. 2d 1357 (J.P.M.L. Nov. , 2007). The JPML then instituted MDL No. 1880, ordered that it remain in Washington, D.C., and assigned it to District Judge Rosemary Collyer. *Id.* Later “tag-along” actions were eventually added to the MDL as a “second wave.”

RESPONSE: Admitted that the '449 patent is one of five Tasler Patents, the subject of two litigation campaigns, and was acquired by Papst Licensing GmbH & Co. KG (Papst) in 2006. Admitted that Casio filed the first declaratory judgment action in October 2006 in Washington, D.C. Remaining statements are denied as untrue or on the basis that they are not facts, but rather presented as argument.

2. At that time, the MDL concerned only the '449 patent and the earlier-issued U.S. Patent No. 6,470,399 (the '399 patent). *See In re Papst*, 778 F. 3d at 1258. The MDL case proceeded through claim construction, with a *Markman* hearing held over three days, and Judge Collyer ultimately granted summary judgment of noninfringement on several grounds. *Id.* On appeal, the U.S. Court of Appeals for the Federal Circuit reversed Judge Collyer’s claim construction in several respects and vacated the judgment of noninfringement. *Id.* The MDL case is now on remand and has been re-assigned to the Hon. Randolph Moss. *In re Papst Licensing GmbH & Co. KG Patent Litig.*, Case No. 1:07-mc-00493-RDM, Dkt. No. 632 (July 21, 2016).

RESPONSE: Admitted.

3. Despite the MDL case pending in Washington, D.C., in July 2015, Papst filed seven new complaints in the U.S. District Court for the District of Delaware accusing several of the parties already in the MDL of infringing U.S. Patents Nos. 8,504,746 and 8,966,144 (the '746 and '144 patents, respectively). *In re: Papst Licensing Digital Camera Patent Litig.*, MDL No. 1880, Dkt. No 93 (JPML Oct. 13, 2015). Over Papst's objection, the JPML transferred six of those cases to the MDL case pending in Washington, D.C. *Id.*

RESPONSE: Admitted that Papst filed seven new complaints in the U.S. District Court for the District of Delaware accusing several of the parties already in the MDL of infringing U.S. Patents Nos. 8,504,746 and 8,966,144. Admitted that the JPML transferred six of those cases to the MDL case pending in Washington, D.C. Remaining statements are denied as untrue or on the basis that they are not facts, but rather presented as argument.

4. On November 30, 2015, Papst filed six new complaints in the Eastern District of Texas accusing manufacturers of mobile phones and tablets of infringing 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).

RESPONSE: Admitted.

B. Proceedings Before the Board

5. Papst's assertion of the '399 and '449 patents against the digital camera manufacturers started long before the America Invents Act was enacted. Although they did not have the ability to file petitions for *inter partes* review challenging the claims of the '399 and '449 patents because of the 35 U.S.C. §315(b) bar, many of the camera manufacturers filed petitions for *inter partes* review challenging the more recently asserted '746 and '144 patents. The Board instituted trials, and on December 11, 2017, entered eight Final Written Decisions finding that all instituted claims were unpatentable. *See* IPR2016-01199, -01200, -01211, -01212, -01213, -01214, -01216, -01225.

RESPONSE: Admitted that the Board instituted trials, and on December 11, 2017, entered eight Final Written Decisions finding that all instituted claims were unpatentable. Remaining statements are denied as untrue or on the basis that they are not facts, but rather presented as argument.

6. Commencing June 2016, the defendants in the Texas actions began filing petitions for *inter partes* review. In total, 45 petitions (nine of which were filed with joinder motions) for *inter partes* review have been filed challenging all five Tasler Patents. The Board instituted trials on all five patents. At present, there are ten pending IPRs that have not yet proceeded to Final Written Decision. Final Written Decisions are due in each of these proceedings between February and July of 2018.

RESPONSE: Admitted that commencing June 2016, the defendants in the Texas actions began filing petitions for *inter partes* review. Admitted that 45 petitions for *inter partes* review were filed and that the board instituted trials on all five patents. Denied that there are ten pending IPR's remaining and the dates in which final written decisions are expected. Remaining statements are denied as untrue or on the basis that they are not facts, but rather presented as argument.

7. IPR2017-00415, concerning the '449 patent, was instituted on May 17, 2017 based on a petition filed by Huawei, LG, and ZTE. On June 16, 2017, Camera manufacturer Olympus, who had been litigating the '449 patent since 2007 in the MDL action, filed a motion for joinder with IPR2017-00415. *Olympus Corp. v. Papst Licensing GmbH & Co. KG*, IPR2017-01617, Paper 3 (PTAB June 16, 2017). On October 17, 2017, Olympus' motion was granted. *Olympus Corp. v. Papst Licensing GmbH & Co. KG*, IPR2017-01617, Paper 7 (PTAB Oct. 17, 2017).

RESPONSE: Admitted.

8. Recently, Papst apparently reached settlements with Huawei, LG, and ZTE. The civil actions against Huawei and LG were dismissed on August 11, 2017 and November 27, 2017, respectively, *see Papst Licensing GmbH & Co. KG v. Apple*, No. 6:15-cv-01905, Dkt. Nos. 584, 674 (E.D. Tex.), and those two parties have been terminated from IPR2017-00415. Papst and ZTE informed the District Court

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