

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CANON INC.; CANON U.S.A., INC.; CANON FINANCIAL
SERVICES, INC.; NIKON CORPORATION; NIKON INC.;
SAMSUNG ELECTRONICS CO., LTD.; SAMSUNG
ELECTRONICS AMERICA, INC.; SANYO ELECTRIC CO., LTD.,

Petitioner,

v.

PAPST LICENSING GMBH & CO., KG,

Patent Owner.

CASE: IPR2018-00410

Patent No. 6,895,449 B2

**PETITIONER'S MOTION TO WAIVE OR SUSPEND
RULE 37 C.F.R. § 42.122**

CONTENTS

I. Relief Requested.....1
II. Summary of Argument1
III. Statement of Relevant Facts2
 A. Litigation History2
 B. Proceedings Before the Board.....4
IV. Argument6
V. Conclusion15

I. RELIEF REQUESTED

Movants request the Board exercise its discretion under 37 C.F.R. § 42.5(b) and § 42.5(c)(3) to waive or suspend the one-month-from-institution deadline for filing a motion for joinder in a pending *inter partes* review. Movants make this request so that the Board can consider their motion for joinder into IPR2017-00415 concerning U.S. Patent No. 6,895,449 (the '449 patent) before any request to terminate that *inter partes* review is acted upon. This relief is warranted because it will serve the interests of justice in the unique circumstances before the Board.

II. SUMMARY OF ARGUMENT

Movants respectfully request that the Board waive or suspend the customary one-month-from-institution deadline for filing a motion to join an *inter partes* review to combat the gamesmanship of Papst, the patent owner, and to conserve the scarce resources of the Federal Judiciary currently being expended in two separate district court campaigns. Suspension or waiver of the one-month-from institution rule will allow the Movants to join IPR2017-00415, which may otherwise be terminated. IPR2017-00415 will provide an efficient, administrative procedure to determine the patentability of the challenged claims of the '449 patent, as Congress intended.

Accordingly, good cause exists in this unique situation for the Board to waive or suspend the rules and to grant Petitioner's Motion for Joinder.

III. STATEMENT OF RELEVANT FACTS

A. Litigation History

The '449 patent is one of five Tasler Patents¹ 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

¹ The Tasler Patents are U.S. Patent Nos. 6,470,399; 6,895,449; 8,504,746; 8,966,144; and 9,189,437.

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 Licensing GmbH & Co. KG Patent Litig.*, MDL No. 1880, Dkt. No. 22, 528 F. Supp. 2d 1357 (J.P.M.L. Nov. 5, 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.”

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).

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

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.