

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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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.

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CASE: IPR2018-00409

Patent No. 6,895,449 B2

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

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**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 Patents<sup>1</sup> 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

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<sup>1</sup> 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

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