

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

PAPST LICENSING GmbH & CO. KG,

Plaintiff,

v.

NIKON CORPORATION, NIKON
AMERICAS INC., and NIKON INC.,

Defendants.

Civil Action No. _____

JURY TRIAL DEMANDED

COMPLAINT

Plaintiff Papst Licensing GmbH & Co. KG (“Papst”), for its Complaint against defendants Nikon Corporation (“Nikon Japan”), Nikon Americas, Inc. (“Nikon Americas”), and Nikon Inc. (collectively, “Nikon defendants”), hereby alleges as follows:

The Parties

1. Plaintiff Papst is a company organized under the laws of The Federal Republic of Germany with its principal place of business at Bahnhofstrasse 33, 78112, St. Georgen, Germany.

2. Nikon Japan is a Japanese corporation with its principal place of business at Fuji Building, 2-3 Marunouchi 3-chome, Chiyoda-ku, Tokyo 100-8331, Japan. Nikon Japan manufactures and sells a wide range of consumer electronics products, including digital cameras.

3. Nikon Americas is a Delaware corporation with its principal place of business at 1300 Walt Whitman Road, Melville, NY 11747. Nikon Americas imports and sells a wide range of consumer electronics products, including digital cameras.

4. Nikon Inc. is a New York corporation with its principal place of business at 1300 Walt Whitman Road, Melville, NY 11747. Nikon Inc. imports and sells a wide range of consumer electronics products, including digital cameras.

5. Nikon Americas is a wholly owned subsidiary of Nikon Japan.

6. Nikon Inc. is a wholly owned subsidiary of Nikon Americas.

Nature Of The Action

7. This is a civil action for infringement of U.S. Patent Nos. 8,504,746 (“the ’746 patent”) (attached as Exhibit A) and 8,966,144 (“the ’144 patent”) (attached as Exhibit B) (collectively, the “Patents-in-Suit”) under the patent laws of the United States, 35 U.S.C. § 1 *et seq.*

Jurisdiction And Venue

8. This Court has jurisdiction over the subject matter of this action pursuant to 28 U.S.C. §§ 1331 and 1338(a) because this action arises under the patents laws of the United States, including 35 U.S.C. § 271 *et seq.*

9. This Court has personal jurisdiction over the Nikon defendants because, among other things, the Nikon defendants have committed, aided, abetted, contributed to, and/or participated in the commission of patent infringement in violation of 35 U.S.C. § 271 in this judicial district and elsewhere that led to foreseeable harm and injury to Papst.

10. This Court also has personal jurisdiction over the Nikon defendants because, among other things, the Nikon defendants have established minimum contacts within the forum such that the exercise of jurisdiction over the Nikon defendants will not offend traditional notions of fair play and substantial justice. For example, the Nikon defendants have placed products that practice and/or embody the claimed inventions of the Patents-in-Suit into the

stream of commerce with the reasonable expectation and/or knowledge that purchasers and users of such products were located within this district. In addition, the Nikon defendants have sold, advertised, marketed, and distributed products in this district that practice the claimed inventions of the Patents-in-Suit. The Nikon defendants derive substantial revenue from the sale of infringing products distributed within the district, and/or expect or should reasonably expect their actions to have consequences within the district, and derive substantial revenue from interstate and international commerce. Additionally, defendant Nikon Americas is a Delaware corporate citizen and has willingly submitted to suit in this district. Further, the Nikon defendants have availed themselves of this Court in previous lawsuits.

11. In addition, the Nikon defendants knowingly, actively induced and continue to knowingly actively induce (or are willfully blind to the) infringement of one or more of the Patents-in-Suit within this district by making, using, offering for sale, and selling infringing products, as well as by contracting with others to use, market, sell, and offer to sell infringing products, all with knowledge of the asserted Patents-in-Suit, and their claims, with knowledge that their customers will use, market, sell, and offer to sell infringing products in this district and elsewhere in the United States, and with the knowledge and specific intent to encourage and facilitate infringing sales and use of the products by others within this district and the United States by creating and disseminating promotional and marketing materials, instructional materials, and product manuals, and technical materials related to the infringing products.

12. Moreover, the Nikon defendants knowingly contributed to the infringement of one or more of the Patents-in-Suit by others in this district, and continue to contribute to the infringement of one or more of the Patents-in-Suit by others in this district by selling or offering to sell components of infringing products in this district, which components constitute a material

part of the inventions of the Patents-in-Suit, knowing of the patents-in-suit and their claims, knowing those components to be especially made or especially adapted for use to infringe one or more of the Patents-in-Suit, and knowing that those components are not staple articles or commodities of commerce suitable for substantial non-infringing use.

13. Venue is proper in this district pursuant to 28 U.S.C. §§ 1391(b), 1391(c), and 1400(b), because the Nikon defendants are subject to personal jurisdiction in this district and have committed acts of infringement in this district.

The Patents-In-Suit

14. United States Patent No. 8,504,746 (“the ’746 patent”), titled “Analog Data Generating And Processing Device For Use With A Personal Computer,” was duly and lawfully issued by the U.S. Patent and Trademark Office on August 6, 2013. A copy of the ’746 patent is attached hereto as Exhibit A. Papst is the assignee of all rights, title, and interest in the ’746 patent, and it possesses all rights to sue and recover for any current or past infringement of the ’746 patent.

15. United States Patent No. 8,966,144 (“the ’144 patent”), titled “Analog Data Generating And Processing Device Having A Multi-Use Automatic Processor,” was duly and lawfully issued by the U.S. Patent and Trademark Office on February 24, 2015. A copy of the ’144 patent is attached hereto as Exhibit B. Papst is the assignee of all rights, title, and interest in the ’144 patent, and it possesses all rights to sue and recover for any current or past infringement of the ’144 patent.

16. The ’746 patent was published by the U.S. Patent and Trademark Office on June 2, 2011 (as US Patent Publication No. 2011/0131353) with claims substantially similar to the later issued claims of the ’746 patent.

17. The '746 patent issued from a continuation application to United States Patent Applications 10/219,105 and 09/331,002, which issued as United States Patent Nos. 6,895,449 and 6,470,399, respectively.

18. Papst and the Nikon defendants have been engaged in litigation regarding United States Patent Nos. 6,895,449 and 6,470,399 in the case entitled *Papst Licensing GmbH & Co. KG v. Nikon Corp. et al.*, 1:08-cv-2510 (N.D. Ill.) filed May 2, 2008 and consolidated in *In re Papst Licensing GmbH & Co. KG Litig.*, Misc. No. 07-493 (D.D.C.) on May 28, 2008 (the "DC action").

19. On information and belief, the Nikon defendants have monitored Papst's patent prosecution activities at least since entering litigation with Papst in 2008.

COUNT I

Infringement of U.S. Patent No. 8,504,746

20. Paragraphs 1 through 19 are incorporated by reference as if fully stated herein.

21. The '746 patent is valid and enforceable.

22. The Nikon defendants have infringed, and continue to infringe, one or more claims of the '746 patent under 35 U.S.C. § 271(a), either literally and/or under the doctrine of equivalents, by making, using, selling, and/or offering for sale in the United States, and/or importing into the United States, products encompassed by those claims, including for example, by making, using, selling, offering for sale, and/or importing into the United States Nikon digital cameras that are able to be accessed via the Mass Storage Device/Mass Storage Class ("MSD") protocol, including without limitation models COOLPIX S810c, COOLPIX S800c, D3X, and other models that use or are able to be accessed via MSD (collectively, "the '746 Infringing Products").

23. The Nikon defendants' customers (e.g., distributors, retailers, and online vendors) directly infringe one or more claims of the '746 patent under 35 U.S.C. § 271(a) by selling, offering to sell, or importing the '746 Infringing Products in the United States. The Nikon defendants have actively induced infringement of, and continue to actively induce infringement of, one or more claims of the '746 patent under 35 U.S.C. § 271(b), either literally and/or under the doctrine of equivalents, by selling, importing, and/or offering for sale the '746 Infringing Products to its customers with the knowledge of the '746 patent and its claims, with knowledge that its customers will sell, offer to sell, and/or import into the United States the '746 Infringing Products, and with knowledge and specific intent to encourage and facilitate those infringing sales of the '746 Infringing Products through distributing the products to retailers, distributors, and online vendors and creating and disseminating promotional and marketing materials, instructional manuals, product manuals and other technical materials related to the '746 Infringing Products.

24. The Nikon defendants have contributed to the infringement of, and continue to contribute to the infringement of, one or more claims of the '746 patent under 35 U.S.C. § 271(c) and/or 271(f), either literally and/or under the doctrine of equivalents, by selling, offering for sale, and/or importing into the United States, the '746 Infringing Products, knowing that those products constitute a material part of the inventions claimed in the '746 patent, knowing that those products are especially made or adapted to infringe the '746 patent, and knowing that those products are not staple articles or commodities of commerce suitable for non-infringing use; rather that the components are used for or in systems that infringe one or more claims of the '746 patent.

25. The Nikon defendants have had knowledge of the '746 patent since at least as early as April 28, 2015, when Papst informed Nikon and the other defendants in the DC action that the '746 and '144 patents had issued and proposed a scheduling order that would permit all parties to amend their complaints.

26. On information and belief, the Nikon defendants have had knowledge of the '746 patent since the time it published as US Patent Publication No. 2011/0131353 on June 2, 2011, as a result of monitoring Papst's patent prosecution activities.

27. The Nikon defendants have infringed, and continue to infringe, the '746 patent.

28. Papst has been and continues to be damaged by the Nikon defendants' infringement of the '746 patent.

29. The Nikon defendants have willfully infringed, and continue to willfully infringe, the '746 patent despite having knowledge of the '746 patent at least through Papst's April 28, 2015, correspondence concerning their infringement.

30. The Nikon defendants' conduct in infringing the '746 patent renders this case exceptional within the meaning of 35 U.S.C. § 285.

COUNT II

Infringement of U.S. Patent No. 8,966,144

31. Paragraphs 1 through 30 are incorporated by reference as if fully stated herein.

32. The '144 patent is valid and enforceable.

33. The Nikon defendants have infringed, and continue to infringe, one or more claims of the '144 patent under 35 U.S.C. § 271(a), either literally and/or under the doctrine of equivalents, by making, using, selling, and/or offering for sale in the United States, and/or importing into the United States, products encompassed by those claims, including for example,

by making, using, selling, offering for sale, and/or importing into the United States Nikon digital cameras that use or are able to be accessed via MSD, Media Transfer Protocol (“MTP”), or Picture Transfer Protocol (“PTP”) protocols, including without limitation models 1 AW1, 1 J4, D3X, COOLPIX A, COOLPIX P-Series (including but not limited to COOLPIXP7800, P7700, P900, P610, P600, P530, P520, P340, P330), COOLPIX S-series (including but not limited to COOLPIX S9900, S9900s, S9700, S9700s, S9600, S9500, S9400, S7000, S6900, S6800, S6700, S6600, S6500, S5300, S5200, S4400, S3700, S3600, S3500, S3400, S2800, S2750, S2700, S810c, S800c, S32, S31, S02), COOLPIX AW130, COOLPIX AW120, COOLPIX AW110, COOLPIX L-series (including but not limited to L840, L830, L820, L620, L330, L320, L32, L30, L29), and all other Nikon digital cameras that use or are able to be accessed via MSD, MTP, or PTP (collectively, “the ’144 Infringing Products”).

34. The Nikon defendants’ customers (e.g., distributors, retailers, and online vendors) directly infringe one or more claims of the ’144 patent under 35 U.S.C. § 271(a) by selling, offering to sell, or importing the ’144 Infringing Products in the United States. The Nikon defendants have actively induced infringement of, and continue to actively induce infringement of, one or more claims of the ’144 patent under 35 U.S.C. § 271(b), either literally and/or under the doctrine of equivalents, by selling, importing, and/or offering for sale the ’144 Infringing Products to its customers with the knowledge of the ’144 patent and its claims, with knowledge that its customers will sell, offer to sell, and/or import into the United States the ’144 Infringing Products, and with knowledge and specific intent to encourage and facilitate those infringing sales of the ’144 Infringing Products through distributing the products to retailers, distributors, and online vendors and creating and disseminating promotional and marketing materials,

instructional manuals, product manuals and other technical materials related to the '144 Infringing Products.

35. The Nikon defendants have contributed to the infringement of, and continue to contribute to the infringement of, one or more claims of the '144 patent under 35 U.S.C. § 271(c) and/or 271(f), either literally and/or under the doctrine of equivalents, by selling, offering for sale, and/or importing into the United States, the '144 Infringing Products, knowing that those products constitute a material part of the inventions claimed in the '144 patent, knowing that those products are especially made or adapted to infringe the '144 patent, and knowing that those products are not staple articles or commodities of commerce suitable for non-infringing use; rather that the components are used for or in systems that infringe one or more claims of the '144 patent.

36. The Nikon defendants have had knowledge of the '144 patent and their infringement of that patent since at least as early as March 13, 2015, through a letter sent by Papst concerning that infringement.

37. The Nikon defendants have infringed, and continue to infringe, the '144 patent.

38. Papst has been and continues to be damaged by the Nikon defendants' infringement of the '144 patent.

39. The Nikon defendants have willfully infringed, and continue to willfully infringe, the '144 patent despite having knowledge of the '144 patent at least through Papst's March 13, 2015, letter concerning their infringement.

40. The Nikon defendants' conduct in infringing the '144 patent renders this case exceptional within the meaning of 35 U.S.C. § 285.

Prayer For Relief

WHEREFORE, Papst prays for judgment as follows:

- A. That the Nikon defendants have directly and/or indirectly infringed each of the Patents-in-Suit;
- B. That the Nikon defendants have willfully infringed each of the Patents-in-Suit;
- C. That Papst be awarded all damages adequate to compensate it for the Nikon defendants' infringement of the Patents-in-Suit, including damages pursuant to 35 U.S.C. §284 and provisional damages pursuant to 35 U.S.C. § 154(d), such damages to be determined by a jury and, if necessary to adequately compensate Papst for the infringement, an accounting, and that such damages be trebled and awarded to Papst with pre-judgment and post-judgment interest;
- D. That this case be declared an exceptional case within the meaning of 35 U.S.C. § 285 and that Papst be awarded the attorney fees, costs, and expenses that it incurs prosecuting this action; and
- E. That Papst be awarded such other and further relief as this Court deems just and proper.

Demand For Jury Trial

Plaintiff Papst hereby demands a trial by jury on all issues so triable.

Dated: June 15, 2015

FARNAN LLP

Of Counsel:

John M. Desmarais
Jonas R. McDavit
Richard M. Cowell
DESMARAIS LLP
230 Park Avenue
New York, NY 10169
(212) 351-3400 (Telephone)
(212) 351-3401 (Facsimile)
jdesmarais@desmaraisllp.com
jmcdavit@desmaraisllp.com
rcowell@desmaraisllp.com

/s/ Brian E. Farnan

Brian E. Farnan (Bar No. 4089)
Michael J. Farnan (Bar No. 5165)
919 North Market Street
12th Floor
Wilmington, DE 19801
(302) 777-0300 (Telephone)
(302) 777-0301 (Facsimile)
bfarnan@farnanlaw.com
mfarnan@farnanlaw.com

Counsel for Plaintiff
Papst Licensing GmbH Co. KG