

IN THE UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF DELAWARE

OLYMPUS CORPORATION and )  
OLYMPUS AMERICA INC., )

Plaintiffs, )

v. )

MAXELL, LTD., )

Defendant. )

C.A. No. \_\_\_\_\_

**JURY TRIAL DEMANDED**

**COMPLAINT FOR DECLARATORY JUDGMENT**

Plaintiffs Olympus Corporation (“Olympus”) and Olympus America Inc. (“OAI,” and collectively, “Plaintiffs”) demand a trial by jury on all issues so triable and allege as follows:

**NATURE OF THE CASE**

1. Plaintiffs seek a declaratory judgment that certain products do not infringe U.S. Patent Nos. 6,765,616 (the “’616 Patent”); 7,199,821 (the “’821 Patent”); 7,551,209 (the “’209 Patent”); 8,130,284 (the “’284 Patent”); and 9,451,229 (the “’229 Patent,” and collectively, the “Maxell Patents”). True and correct copies of these patents are attached as Exhibits A–E, respectively.

2. The relief is necessary because Defendant Maxell, Ltd. (“Maxell”) has refused to continue licensing its patents to Plaintiffs on terms comparable to those in past licenses with Plaintiffs, has accused certain Olympus products of infringing *inter alia* the Maxell Patents and their foreign counterparts, and has sued other companies in this district and elsewhere for infringement of each of the Maxell Patents. Plaintiffs do not, however, infringe these patents. Therefore, a substantial, continuing, and justiciable controversy exists between Plaintiffs and Maxell.

**PARTIES**

3. Olympus Corporation is a Japanese corporation with a principal place of business at Shinjuku Monolith, 2-3-1 Nishi-Shinjuku, Shinjuku-ku, Tokyo 163-0914, Japan.

4. Olympus America Inc. is a New York corporation with its principal place of business at 3500 Corporate Parkway, Center Valley, Pennsylvania, 18034.

5. On information and belief, Maxell is a Japanese corporation with a registered place of business at 1 Koizumi, Oyamazaki, Oyamazaki-cho, Otokuni-gun, Kyoto, Japan. On information and belief, Maxell is successor to Hitachi Maxell, Ltd. in all rights, title, and interest in the Maxell Patents. On information and belief, Maxell has at least one wholly-owned subsidiary registered under Delaware law.

**VENUE AND JURISDICTION**

6. Venue is proper in this district pursuant to 28 U.S.C. § 1391(c) because Maxell is not resident in the United States.

7. This Court has subject matter jurisdiction over this action under 28 U.S.C. §§ 2201, 1331 and 1338(a) because this action arises under the laws of the United States, in particular the Patent Act of the United States, 35 U.S.C. § 101 *et seq.*, and seeks relief under the Federal Declaratory Judgment Act.

8. An actual controversy exists between Plaintiffs and Maxell through Maxell's threatened assertion of its patent rights against Plaintiffs and Maxell's assertion of its patent rights against others.

9. Plaintiffs were once licensed to a portfolio of patents held by Hitachi Ltd. (now held by its successor Maxell). After expiration of that license, Maxell proposed new license terms to Olympus that were far more favorable to Maxell than were the previous terms. In

subsequent negotiation, Maxell accused certain of Plaintiffs' products of infringing its patents including the Maxell Patents. Maxell has not yet offered Olympus a renewed license to its portfolio on reasonable terms. In fact, when Olympus recently suggested terms for a portfolio license, Maxell responded by identifying its lawsuits asserting its digital camera patents against others in the United States, and advised Olympus to "review" its litigated U.S. patents.

10. Since November of 2016, Maxell has initiated patent infringement suits against seven defendants across the United States. Two such suits—17-1446-JFB-SRF and 17-1447-JFB-SRF—were brought in this district on October 13, 2017. Those two suits assert infringement claims under *inter alia* the '616 Patent, the '821 and '284 Patents (to which the '209 Patent is related), and U.S. Patent No. 7,995,897 (not identified in this complaint, but to which the '229 Patent is related).

11. Plaintiffs contend that they have the right to make, use, sell, and/or offer to sell the following products in the United States, and import them into the United States, unhampered by Maxell: OM-D E-M1 Mark II, OM-D E-M5 Mark II, OM-D E-M10 Mark II, Pen-F, Pen E-PL8, Tough TG-4, Air A01 (together, the "Olympus Products").

12. Maxell's communications with Plaintiffs, its failure to offer comparable or reasonable terms for a renewed license, its statement that Olympus should consider Maxell's recent litigations and review the patents asserted therein, its litigation behavior against other defendants, and its other affirmative acts have thus created a substantial controversy between Plaintiffs and Maxell, having adverse legal interests, of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.

13. Plaintiffs possess additional evidence of a justiciable controversy between the parties, including a May 17, 2017 letter from Hitachi Maxell Ltd. to Olympus, which are

confidential to Maxell but can be produced under court order if Maxell contests this Court's exercise of subject matter jurisdiction.

14. This Court has personal jurisdiction over Maxell at least because Plaintiffs' action arises out of Maxell's prior actions enforcing each Maxell patent or a family member thereof in this district, and because Maxell's U.S. presence and assertion activities make this an appropriate and unburdensome forum to resolve the parties' dispute.

15. Plaintiffs possess additional evidence of actions subjecting Maxell to personal jurisdiction in this forum, including a May 17, 2017 letter from Hitachi Maxell Ltd. to Olympus, which are confidential to Maxell but can be produced under court order if Maxell contests this Court's exercise of personal jurisdiction.

**FIRST CLAIM FOR RELIEF**  
**(Declaratory Judgment of Non-Infringement of the '616 Patent)**

16. On information and belief, Maxell is the owner of the '616 Patent with all applicable rights to license and assert the '616 Patent.

17. As described in paragraphs 9 to 15, which Plaintiffs incorporate here, Maxell has accused Olympus (and by necessary implication its U.S. subsidiary OAI) of infringing the '616 Patent.

18. The Olympus Products, however, do not infringe and have not infringed, directly or indirectly, any claim of the '616 Patent, at least because the Olympus Products lack color filters to pass "colors respectively arranged to cyclically appear horizontally at [an] interval and to pass the same colors arranged vertically" as required by all claims of the '616 Patent.

19. Therefore, there is an actual, substantial, continuing, and justiciable controversy between Plaintiffs and Maxell regarding whether the Olympus Products infringe the '616 Patent.

20. Accordingly, Plaintiffs are entitled to a declaratory judgment that Plaintiffs do not infringe, directly or indirectly, any claim of the '616 Patent.

**SECOND CLAIM FOR RELIEF**  
**(Declaratory Judgment of Non-Infringement of the '821 Patent)**

21. On information and belief, Maxell is the owner of the '821 Patent with all applicable rights to license and assert the '821 Patent.

22. As described in paragraphs 9 to 15, which Plaintiffs incorporate here, Maxell has accused Olympus (and by necessary implication its U.S. subsidiary OAI) of infringing the '821 Patent.

23. The Olympus Products, however, do not infringe and have not infringed, directly or indirectly, any claim of the '821 Patent, at least because the Olympus Products lack white balance control means that use distance, zoom value, and brightness information, as required by all claims of the '821 Patent.

24. Therefore, there is an actual, substantial, continuing, and justiciable controversy between Plaintiffs and Maxell regarding whether the Olympus Products infringe the '821 Patent.

25. Accordingly, Plaintiffs are entitled to a declaratory judgment that Plaintiffs do not infringe, directly or indirectly, any claim of the '821 Patent.

**THIRD CLAIM FOR RELIEF**  
**(Declaratory Judgment of Non-Infringement of the '209 Patent)**

26. On information and belief, Maxell is the owner of the '209 Patent with all applicable rights to license and assert the '209 Patent.

27. As described in paragraphs 9 to 15, which Plaintiffs incorporate here, Maxell has accused Olympus (and by necessary implication its U.S. subsidiary OAI) of infringing the '209 Patent.

28. The Olympus Products, however, do not infringe and have not infringed, directly or indirectly, any claim of the '209 Patent, at least because the Olympus Products lack white balance controlling means that utilize object distance detection, zoom value, and object brightness information, as required by all claims of the '209 Patent.

29. Therefore, there is an actual, substantial, continuing, and justiciable controversy between Plaintiffs and Maxell regarding whether the Olympus Products infringe the '209 Patent.

30. Accordingly, Plaintiffs are entitled to a declaratory judgment that Plaintiffs do not infringe, directly or indirectly, any claim of the '209 Patent.

**FOURTH CLAIM FOR RELIEF**  
**(Declaratory Judgment of Non-Infringement of the '284 Patent)**

31. On information and belief, Maxell is the owner of the '284 Patent with all applicable rights to license and assert the '284 Patent.

32. As described in paragraphs 9 to 15, which Plaintiffs incorporate here, Maxell has accused Olympus (and by necessary implication its U.S. subsidiary OAI) of infringing the '284 Patent.

33. The Olympus Products, however, do not infringe and have not infringed, directly or indirectly, any claim of the '284 Patent, at least because the Olympus Products lack white balance controlling means that utilize object distance detection, zoom value, and object brightness information, as required by all claims of the '284 Patent.

34. Therefore, there is an actual, substantial, continuing, and justiciable controversy between Plaintiffs and Maxell regarding whether the Olympus Products infringe the '284 Patent.

35. Accordingly, Plaintiffs are entitled to a declaratory judgment that Plaintiffs do not infringe, directly or indirectly, any claim of the '284 Patent.

**FIFTH CLAIM FOR RELIEF**  
**(Declaratory Judgment of Non-Infringement of the '229 Patent)**

36. On information and belief, Maxell is the owner of the '229 Patent with all applicable rights to license and assert the '229 Patent.

37. As described in paragraphs 9 to 15, which Plaintiffs incorporate here, Maxell has accused Olympus (and by necessary implication its U.S. subsidiary OAI) of infringing the '229 Patent.

38. The Olympus Products, however, do not infringe and have not infringed, directly or indirectly, any claim of the '229 Patent, at least because the Olympus Products do not store a first thumbnail picture and a second thumbnail picture "in a same directory in which [a] moving picture and [a] still picture are not stored," as required by all claims of the '229 Patent.

39. Therefore, there is an actual, substantial, continuing, and justiciable controversy between Plaintiffs and Maxell regarding whether the Olympus Products infringe the '229 Patent.

40. Accordingly, Plaintiffs are entitled to a declaratory judgment that Plaintiffs do not infringe, directly or indirectly, any claim of the '229 Patent.

**REQUEST FOR RELIEF**

Plaintiffs respectfully request the Court to enter judgment in their favor and against Maxell as follows:

A. For judgment that Plaintiffs and their customers do not infringe any valid claim of the Maxell Patents;

B. For a preliminary and permanent injunction precluding Maxell, its officers, directors, employees, agents, and all other persons acting in concert or participation with them from suing for infringement or otherwise asserting infringement of any of the Maxell Patents against Plaintiffs;

- C. For costs and reasonable attorneys' fees incurred in connection with this action;
- D. For a finding that this case is exceptional; and
- E. For such other and further relief as the Court deems just and proper.

OF COUNSEL:

William J. McCabe  
Matthew J. Moffa  
Thomas Matthew  
PERKINS COIE LLP  
30 Rockefeller Plaza, 22nd Floor  
New York, New York 10112-0085  
(212) 262-6900

Dated: February 6, 2018

/s/ John W. Shaw

John W. Shaw (No. 3362)

Karen E. Keller (No. 4489)

Nathan R. Hoeschen (No. 6232)

SHAW KELLER LLP

I.M. Pei Building

1105 North Market Street, 12th Floor

Wilmington, DE 19801

(302) 298-0700

jshaw@shawkeller.com

kkeller@shawkeller.com

nhoeschen@shawkeller.com

*Attorneys for Plaintiffs Olympus Corporation and  
Olympus America Inc.*