

**UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MINNESOTA**

CANON INC.,

Plaintiff,

v.

KATUN CORPORATION and GENERAL
PLASTIC INDUSTRIAL CO. LTD.,

Defendants.

Case No. 22-cv-2057-JWB-JFD

**DEFENDANT KATUN CORPORATION'S
ANSWER, DEFENSES AND
COUNTERCLAIMS TO PLAINTIFF'S
COMPLAINT FOR PATENT
INFRINGEMENT**

Pursuant to Federal Rules of Civil Procedure 7 and 12, Defendant Katun Corp. ("Katun") hereby files this Answer, Defenses, and Counterclaims to Plaintiff Canon Inc.'s Complaint for Patent Infringement. Katun denies all allegations in the Complaint unless expressly admitted in the following numbered paragraphs, which correspond to the headings¹ and numbered paragraphs in the Complaint:

The Parties

1. Katun is without sufficient knowledge or information to admit or deny the allegations in paragraph 1 of the Complaint and therefore denies them.
2. Katun is without sufficient knowledge or information to admit or deny the allegations in paragraph 2 of the Complaint and therefore denies them.
3. Denied.
4. Admitted.
5. Admitted.
6. Denied.

¹ This Answer includes the headings as presented in the Plaintiff's Complaint for the convenience of the Court. Inclusion of such headings does not indicate that GPI agrees with the substance of such headings or admits to any factual allegations that may be contained therein.

Jurisdiction and Venue

7. Katun admits that the Complaint purports to state a claim for patent infringement of United States patents arising under Title 35 of the United States Code, but denies any such alleged patent infringement. Katun admits that this Court has subject matter jurisdiction of the action under 28 U.S.C. § 1331 and § 1338(a).

8. For purposes of this case only, Katun does not contest personal jurisdiction. Katun otherwise denies the allegations in paragraph 8 of the Complaint.

9. For purposes of this case only, Katun does not contest venue. Katun otherwise denies the allegations in paragraph 9 of the Complaint.

10. Katun is without sufficient knowledge or information to admit or deny the allegations in paragraph 10 of the Complaint and therefore denies them.

Canon's Patent-in-Suit

11. Katun admits that U.S. Pat. No. 11,392,056 (the “‘056 patent”) is entitled “Developer Supply Container and Developer Supplying System,” and that the cover page of the ‘056 patent indicates that it was issued on July 19, 2022 and lists Tsukasa Mine as the sole inventor and Canon Inc. as the assignee. Katun otherwise denies the allegations in paragraph 11 of the Complaint.

12. Katun is without sufficient knowledge or information to admit or deny the allegations in paragraph 12 of the Complaint and therefore denies them.

13. Denied.

Defendants' Infringing Activities

14. This paragraph contains legal conclusions to which no response is required. Katun admits that it provides toner supply containers for use in one or more Canon copying machines. Katun otherwise denies the allegations in paragraph 14 of the Complaint.

15. This paragraph contains legal conclusions to which no response is required. Katun admits that it purchases toner supply containers manufactured by GPI for use in one or more Canon copying machines. Katun lacks knowledge sufficient to admit or deny whether the Accused Products are imported into the United States and offered for sale and sold within the United States by any entity other than Katun. Katun otherwise denies the allegations in paragraph 15 of the Complaint.

16. This paragraph contains legal conclusions to which no response is required. Katun admits that it is the owner of katun.com. Katun otherwise denies the allegations in paragraph 16 of the Complaint.

First Cause of Action: Infringement of U.S. Patent No. 11,392,056

17. Katun repeats and incorporates by reference its responses to paragraphs 1-16, as though set forth here in their entirety.

18. This paragraph contains legal conclusions to which no response is required. Katun denies all other allegations and implications of paragraph 18.

19. This paragraph contains legal conclusions to which no response is required. Katun admits that it received a letter from Canon's counsel on July 21, 2022 purporting to allege infringement of claim 1 of the '056 patent. Katun denies all other allegations and implications of paragraph 19.

20. This paragraph contains legal conclusions to which no response is required. Katun denies all other allegations and implications of paragraph 20.

21. Denied.

22. Katun admits that the Court has not yet construed the meaning of any claims or terms in the '056 patent in this case. Katun lack knowledge sufficient to admit or deny the remaining allegations of paragraph 22, and on that basis denies them.

23. This paragraph contains legal conclusions to which no response is required. Katun denies all other allegations and implications of paragraph 23.

24. Katun admits that paragraph 24 purports to recite claim 1 of the '056 patent. Katun denies that claim 1 is infringed.

25. Denied.

26. Denied.

27. Denied.

28. Denied.

29. Denied.

30. Denied.

31. Denied.

32. Denied.

33. Denied.

34. Denied.

35. Denied.

36. Denied.

37. Denied.

38. Denied.

39. Katun admits that paragraph 39 purports to recite claim 14 of the '056 patent.

Katun denies that claim 14 of the '056 patent is infringed.

40. Denied.

41. Denied.

42. Denied.

43. Denied.

44. Denied.
45. Denied.
46. Denied.
47. Denied.
48. Denied.
49. Denied.
50. Denied.
51. Denied.
52. Denied.
53. Denied.
54. Katun admits that paragraph 54 purports to recite claim 27 of the '056 patent.

Katun denies that claim 27 of the '056 patent is infringed.

55. Denied.
56. Denied.
57. Denied.
58. Denied.
59. Denied.
60. Denied.
61. Denied.
62. Denied.
63. Denied.
64. Denied.
65. Denied.
66. Denied.

67. Denied.

68. Denied.

69. Denied.

70. Denied.

71. Denied.

72. Denied.

73. Denied.

74. Denied.

Prayer for Relief

Katun contends that Canon is not entitled to any of the relief it seeks.

AFFIRMATIVE DEFENSES

Without prejudice to the denials hereinabove set forth in the Answer, without admitting any of Katun's allegations not otherwise admitted, and without undertaking any of the burdens imposed by law on Plaintiff, Katun asserts the following defenses to the Complaint and expressly reserves the right to allege additional Affirmative Defenses as they become known during this litigation:

FIRST DEFENSE

The Complaint fails to state a claim upon which relief can be granted and/or fails to plead the allegations with sufficient particularity.

SECOND DEFENSE

Katun has not infringed, willfully or otherwise, directly or indirectly, contributed to the infringement of, or induced the infringement of any valid claim of the '056 patent (the "Asserted Patent"), literally or under the doctrine of equivalents.

THIRD DEFENSE

At least the claims of the Asserted Patent alleged to be infringed in the Complaint are invalid because they are anticipated and/or rendered obvious by the prior art or otherwise fail to comply with the requirements of 35 U.S.C. §§ 100 et seq., including, without limitation, one or more of the following: 35 U.S.C. §§ 101, 102, 103, and 112.

FOURTH DEFENSE

To the extent that Canon or Canon's licensees have failed to properly mark any of its relevant products as required by 35 U.S.C. § 287 or otherwise give proper notice that Canon's actions allegedly infringe the Asserted Patent, Katun is not liable to Canon for any acts alleged to have been performed before Katun received actual notice that it was alleged to have infringed the Asserted Patent.

FIFTH DEFENSE

Canon is not entitled to injunctive relief against Katun because any alleged injury to Canon as a result of Katun's alleged activities is not immediate or irreparable, and Canon has an adequate remedy at law.

SIXTH DEFENSE

Katun has engaged in all relevant activities in good faith, thereby precluding Canon, even if it prevails, from proving that this is an exceptional case justifying a recovery of its reasonable attorneys' fees and/or costs under 35 U.S.C. § 285.

SEVENTH DEFENSE

By reason of the prior art and/or statements and representations made to and by the U.S. Patent and Trademark Office during the prosecution of the application that led to issuance of the Asserted Patent, this patent is so limited that none of their claims can be properly construed as covering any activity of Katun. In other words, the claims of the Asserted Patent are limited by the text of the Asserted Patent, the prosecution history, including that of related patents, and/or the prior art such that Canon is estopped, or otherwise precluded, from asserting that any claim of the Asserted Patent is infringed by Katun, either literally or by equivalents.

EIGHTH DEFENSE

Canon's claims are barred in whole or in part by the equitable doctrines of unclean hands, inequitable conduct, estoppel, implied license, waiver, acquiescence, prosecution history estoppel, disclaimer, and/or other equitable doctrines.

NINTH DEFENSE

Canon cannot argue that the claims of the Asserted Patent are broad enough that an accused product would be found to infringe under the doctrine of equivalents because such a construction would render the claims invalid in view of the prior art.

TENTH DEFENSE

Canon's infringement claims are barred in whole or in part to the extent they have been exhausted and/or released by licenses or releases, implied or expressed, granted to other parties.

ELEVENTH DEFENSE

Canon is barred from seeking injunctive relief for its claims of infringement as to the '056 Patent because doing so improperly expands the term of the patent and amounts to patent misuse.

COUNTERCLAIMS

Pursuant to Federal Rule of Civil Procedure 13, Katun Corporation (“Katun”) hereby asserts the following Counterclaims against Canon Inc. (“Canon”) and alleges as follows:

PARTIES

1. Katun is a corporation organized and existing under the laws of the State of Minnesota, with its principal place of business located at 7760 France Ave South, Suite 340 Minneapolis, MN 55435-5800.
2. As alleged in paragraph 1 of the Complaint, Canon is a corporation organized and existing under the laws of Japan, having its principal place of business at 30-2, Shimomaruko 3-chome, Ohta-ku, Tokyo 146-8501, Japan.
3. By these Counterclaims, Katun seeks declarations of invalidity and non-infringement with respect to U.S. Patent No. 11,392,056 (the “‘056 patent”).
4. Jurisdiction is proper pursuant to the Federal Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202; as the Counterclaims arise under the Patent Code, 35 U.S.C. § 1 et seq., this Court also has jurisdiction pursuant to 28 U.S.C. §§ 1331 and 1338(a).
5. This Court has personal jurisdiction over Canon because Canon has consented to jurisdiction by having filed its Complaint in this district.
6. Canon has consented to venue in this jurisdiction through filing of its Complaint. To the extent venue is proper for Canon’s lawsuit, venue is proper for the Counterclaims.

GENERAL ALLEGATIONS

7. On August 22, 2022, Canon filed suit against Katun asserting infringement of the Asserted Patent.
8. Katun denies that it infringes, contributes to the infringement, or actively induces others to infringe any valid and unenforceable claims of the Asserted Patent. In addition, Katun

alleges that the Asserted Patent is invalid under one or more of 35 U.S.C. §§ 101, 102, 103, and 112.

FIRST COUNTERCLAIM
(Declaration of Invalidity of U.S. Patent No. 11,392,056)

9. Katun hereby restates and re-asserts its allegations set forth in the preceding paragraphs of its Counterclaims.

10. As a result of Canon's allegations of infringement against Katun, an actual, immediate, and justiciable controversy exists between the parties as to validity of the '056 Patent.

11. At least the asserted claims of the '056 Patent identified in the Complaint are invalid because they are anticipated and/or rendered obvious by the prior art or otherwise fail to comply with the requirements of 35 U.S.C. §§ 100 et seq., including, without limitation, one or more of the following: 35 U.S.C. §§ 101, 102, 103, and 112.

SECOND COUNTERCLAIM
(Declaration of Non-infringement of U.S. Patent No. 11,392,056)

12. Katun hereby restates and re-asserts its allegations set forth in the preceding paragraphs of its Counterclaims.

13. As a result of Canon's allegations of infringement against Katun, an actual, immediate, and justiciable controversy exists between the parties as to infringement of the '056 Patent.

14. Katun has not infringed any valid and enforceable claim of the '056 patent.

JURY DEMAND

Katun demands a trial by jury on all triable issues.

REQUEST FOR RELIEF

WHEREFORE, Defendant Katun respectfully requests that this Court enter a Judgment and Order in its favor and against Canon as follows:

- A. Dismissing with prejudice Plaintiff's Complaint and all claims asserted therein against Katun;
- B. Declaring that Katun's products do not and have not infringed, contributed to infringement of, or induced infringement of, directly or indirectly, any valid claim of the '056 patent;
- C. Declaring that the claims of the '056 patent are invalid and/or unenforceable;
- D. Entering an award to Katun of its attorney fees and expenses under 35 U.S.C. § 285;
- E. Entering an award to Katun of costs incurred;
- F. Granting to Katun such other and further relief as the Court may deem just, proper, and equitable under the circumstances.

Dated: January 30, 2023

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