

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION,
Petitioner,

v.

FUJIFILM CORPORATION,
Patent Owner.

Case IPR2017-00618
Patent 7,355,805 B2

Before JO-ANNE M. KOKOSKI, JEFFREY W. ABRAHAM, and
MICHELLE N. ANKENBRAND, *Administrative Patent Judges*.

KOKOSKI, *Administrative Patent Judge*.

MODIFIED SCHEDULING ORDER

On January 6, 2017, Sony Corporation (“Petitioner”) filed a Petition (“Pet.,” Paper 2) to institute an *inter partes* review of claims 1–3 and 10 of U.S. Patent No. 7,355,805 B2 (“the ’805 patent,” Ex. 1001) with respect to the following grounds:

Reference(s)	Basis	Challenged Claims
Hennecken	§ 102(e)	1–3, 10
Hennecken and Albrecht II, Basis 1	§ 103(a)	1–3, 10
Hennecken and Albrecht II, Basis 2	§ 103(a)	1–3, 10
Hennecken, Albrecht II, and Dugas, Basis 1	§ 103(a)	1–3, 10
Hennecken, Albrecht II, and Dugas, Basis 2	§ 103(a)	1–3, 10
Albrecht II and Hennecken	§ 103(a)	1–3, 10

Pet. 4. On July 24, 2017, we denied the Petition and did not institute an *inter partes* review of the ’805 patent. Paper 9. In response to Petitioner’s Request for Rehearing (Paper 10), on December 18, 2017 we instituted *inter partes* review on the following grounds:

Reference(s)	Basis	Challenged Claims
Hennecken	§ 102(e)	1–3, 10
Hennecken and Albrecht II, Basis 1	§ 103(a)	1–3, 10
Hennecken, Albrecht II, and Dugas, Basis 1	§ 103(a)	1–3, 10

Paper 11, 11. On April 27, 2018, we modified our institution decision to include review of “all of the grounds presented in the Petition.” Paper 15, 2.

On May 15, 2018, a conference call was held between respective counsel for the parties and Judges Kokoski, Abraham, and Ankenbrand,

during which the parties were directed to meet and confer, and then jointly propose a schedule regarding supplemental briefing to address the newly-instituted grounds. On May 23, 2018, the parties submitted their proposed schedule to the Board via email.

Upon consideration of the parties' proposed schedule, we modify the schedule in this proceeding as set forth in the Appendix to this Modified Scheduling Order. The due dates set forth in this Order cannot be changed without prior authorization from the Board. We note that this proceeding is in a relatively early stage (Patent Owner submitted its Patent Owner Response on March 27, 2018), the newly-instituted grounds include the same prior art and claims as the originally-instituted grounds, and there is no Motion to Amend pending.

The parties are reminded that the Testimony Guidelines appended to the Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,772 (Aug. 14, 2012) (Appendix D), apply to this proceeding. The Board may impose an appropriate sanction for failure to adhere to the Testimony Guidelines. 37 C.F.R. § 42.12. For example, reasonable expenses and attorney's fees incurred by any party may be levied on a person who impeded, delays, or frustrates the fair examination of a witness.

A. DUE DATES

1. DUE DATE 1A

The patent owner may file—

A supplemental response to the petition (37 C.F.R. § 42.120), limited to the merits of the previously non-instituted grounds.

The patent owner must file any such response by DUE DATE 1A, limited to 15 pages. If the patent owner elects not to file anything, the patent

owner must arrange a conference call with the parties and the Board. The patent owner is cautioned that any arguments for patentability not raised in the response will be deemed waived.

2. DUE DATE 2

The petitioner must file any reply to patent owner's response and supplemental response by DUE DATE 2.

3. DUE DATE 3

a. Each party must file any observations on the cross-examination testimony of a reply witness (*see* section C, below) by DUE DATE 3.

b. Each party must file any motion to exclude evidence (37 C.F.R. § 42.64(c)) by DUE DATE 3.

c. Each party must file any request for oral argument (37 C.F.R. § 42.70(a)) by DUE DATE 3.

4. DUE DATE 4

a. Each party must file any response to an observation on cross-examination testimony by DUE DATE 4.

b. Each party must file any opposition to a motion to exclude evidence by DUE DATE 4.

5. DUE DATE 5

Each party must file any reply for a motion to exclude evidence by DUE DATE 5.

6. DUE DATE 6

The oral argument (if requested by either party) is set for DUE DATE 6.

B. CROSS-EXAMINATION

Except as the parties might otherwise agree, for each due date—

1. Cross-examination begins after any supplemental evidence is due. 37 C.F.R. § 42.53(d)(2).
2. Cross-examination ends no later than a week before the filing date for any paper in which the cross-examination testimony is expected to be used. *Id.*

C. OBSERVATIONS ON CROSS-EXAMINATION

Observations on cross-examination provide the parties with a mechanism to draw the Board's attention to relevant cross-examination testimony of a reply witness because no further substantive paper is permitted after the reply. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,768 (Aug. 14, 2012). The observation must be a concise statement of the relevance of precisely identified testimony to a precisely identified argument or portion of an exhibit. Each observation should not exceed a single, short paragraph. The opposing party may respond to the observation. Any response must be equally concise and specific.



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.