

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 and JEFFREY W. ABRAHAM,
Administrative Patent Judges.

KOKOSKI, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

On August 15, 2018, a conference call was held between counsel for the parties and Judges Kokoski, Abraham, and Ankenbrand. A court reporter was on the line, and a copy of the transcript will be filed as an exhibit in the proceeding in due course.¹ Patent Owner requested the conference to seek authorization to file a motion to strike arguments in Petitioner’s Reply (Paper 22). In particular, Patent Owner argued that Petitioner’s Reply improperly includes new arguments and relies on new evidence that are outside the scope of what is permitted in a reply. Petitioner disagreed, arguing that the information included in the Reply was properly included to address arguments made in Patent Owner’s Response and/or Patent Owner’s Supplement Response (Papers 14, 17).

Our Rules explain that “[a] reply may only respond to arguments raised in the corresponding opposition . . . or patent owner response. 37 C.F.R. § 42.23(b). For example, our Trial Practice Guide explains that “[e]xamples of indications that a new issue has been raised in a reply include new evidence necessary to make out a *prima facie* case for the patentability or unpatentability of an original or proposed substitute claim, and new evidence that could have been presented in a prior filing.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012). The Trial Practice Guide also provides that “a reply that raises a new issue or belatedly presents evidence will not be considered and may be returned.” *Id.*

Upon consideration of the arguments and positions presented during the call, we are not persuaded that the requested motion to strike is warranted. To the extent that Petitioner’s Reply contains improper

¹ This Order summarizes the statements made during the conference call. A more detailed record may be found in the transcript.

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argument, the Board ordinarily is capable of determining at the close of evidence whether new arguments were raised and disregarding any improper reply evidence or arguments. In that regard, we note that the transcript of the call will reflect Patent Owner's identification of the arguments in Petitioner's Reply that it alleges are new and the reasons why Patent Owner contends they are improper, as well as Petitioner's arguments in response.

Accordingly, it is

ORDERED that Patent Owner's request for authorization to file a motion to strike is *denied*.

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