

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SONY CORPORATION,  
Petitioner,

v.

FUJIFILM CORPORATION  
Patent Owner.

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Case IPR2017-00618  
Patent 7,355,805 B2

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

KOKOSKI, *Administrative Patent Judge*.

FINAL WRITTEN DECISION  
*35 U.S.C. § 318(a) and 37 C.F.R. §42.73*

## I. INTRODUCTION

We have jurisdiction to conduct this *inter partes* review under 35 U.S.C. § 6, and this Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons that follow, we determine that Petitioner has not shown by a preponderance of the evidence that claims 1–3 and 10 of U.S. Patent No. 7,355,805 B2 (“the ’805 patent,” Ex. 1001) are unpatentable.

### A. *Procedural History*

Sony Corporation (“Petitioner”) filed a Petition (“Pet.,” Paper 2) to institute an *inter partes* review of claims 1–3 and 10 of the ’805 patent based on the following grounds: (1) whether claims 1–3 and 10 are unpatentable under 35 U.S.C. § 102<sup>1</sup> as being anticipated by Hennecken<sup>2</sup>; (2) whether claims 1–3 and 10 are unpatentable under 35 U.S.C. § 103 as being obvious over the combined teachings of Hennecken and Albrecht II<sup>3</sup> (according to Basis 1 and/or Basis 2); (3) whether claims 1–3 and 10 are unpatentable under 35 U.S.C. § 103 as being obvious over the combined teachings of Hennecken, Albrecht II, and Dugas<sup>4</sup> (according to Basis 1 and/or Basis 2); and (4) whether claims 1–3 and 10 are unpatentable under 35 U.S.C. § 103 as being obvious over the combined teachings of Albrecht II and Hennecken. Pet. 4. FUJIFILM Corporation (“Patent Owner”) filed a

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<sup>1</sup> The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended several provisions of 35 U.S.C., including §§ 102 and 103. Because the ’805 patent has an effective filing date prior to the effective date of the applicable AIA amendments, we refer herein to the pre-AIA versions of §§ 102 and 103.

<sup>2</sup> U.S. Patent No. 6,710,967 B2, issued March 23, 2004 (Ex. 1005).

<sup>3</sup> U.S. Patent No. 5,930,065, issued July 27, 1999 (Ex. 1003).

<sup>4</sup> U.S. Patent No. 6,496,328 B1, issued December 17, 2002 (Ex. 1006).

Preliminary Response. Paper 7. We denied the Petition and did not institute an *inter partes* review based on our determination that the information presented in the Petition did not demonstrate a reasonable likelihood that Petitioner would prevail on its challenge that claims 1–3 and 10 are unpatentable. Paper 9 (“Decision Denying Institution”), 1, 21.

Petitioner filed a Request for Rehearing of our Decision Denying Institution. Paper 10 (“Req. Reh’g). We granted Petitioner’s Request and instituted an *inter partes* review of claims 1–3 and 10 based on a subset of the asserted grounds. Paper 11 (“Dec. on Inst.” or “Institution Decision”), 11. We subsequently modified our Institution Decision to include review of “all of the grounds presented in the Petition.” Paper 15, 2.

After institution of trial, Patent Owner filed a Patent Owner Response (“PO Resp.,” Paper 14) and a Supplemental Patent Owner Response (“Supp. PO Resp.,” Paper 17), and Petitioner filed a Reply (“Pet. Reply,” Paper 22). Petitioner relies on the Declaration of Dr. Thomas R. Albrecht (“the Albrecht Declaration,” Ex. 1016). Patent Owner relies on the Declaration of Dr. William C. Messner (“the Messner Declaration,” Ex. 2003), the Supplemental Declaration of Dr. William C. Messner (“the Supplemental Messner Declaration,” Ex. 2008), and the Second Supplemental Declaration of Dr. William C. Messner (“the Second Supplemental Messner Declaration,” Ex. 2011).

An oral hearing was held on September 25, 2018, and a transcript is included in the record. Paper 31 (“Tr.”).

*B. Related Proceedings*

The parties identify *Certain Magnetic Data Storage Tapes and Cartridges Containing the Same* (ITC Investigation No. 337-TA-1012) as a

related matter. Pet. vi; Paper 4, 2. Petitioner also states that “[a] decision in this proceeding could affect or be affected by” *Sony Corp. v. Fujifilm Holdings Corp.*, Civil Action No. 1:16-cv-05988-PGG (S.D.N.Y). Pet. vi.

C. *The '805 Patent*

The '805 patent, titled “Magnetic Tape and Method of Manufacturing Magnetic Tape, Servo Writer, and Method of and Apparatus for Specifying Servo Band,” is directed to, *inter alia*, magnetic tape “wherein specifying a servo band where the magnetic head positions can be performed without comparing servo signals written on adjacent servo bands,” and a method of manufacturing such magnetic tape. Ex. 1001, 1:49–55. Figure 1 of the '805 patent is reproduced below.

FIG. 1

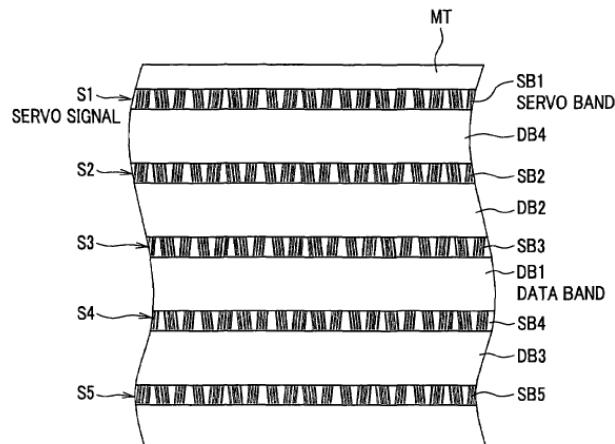


Figure 1 is a plan view illustrating a magnetic tape described in the '805 patent. *Id.* at 4:15–16. In Figure 1, magnetic tape MT includes five servo bands SB1–SB5 along the longitudinal direction of the tape. *Id.* at 4:45–47. Data bands DB1–DB4 are arranged between servo bands SB1–SB5, which are positioned at equally-spaced intervals along the width direction of

magnetic tape MT. *Id.* at 4:47–50. Predetermined servo signals S1–S5 are written on servo bands SB1–SB5 for tracking control of the magnetic head. *Id.* at 4:50–52.

Figure 2 of the '805 patent is reproduced below.

FIG. 2

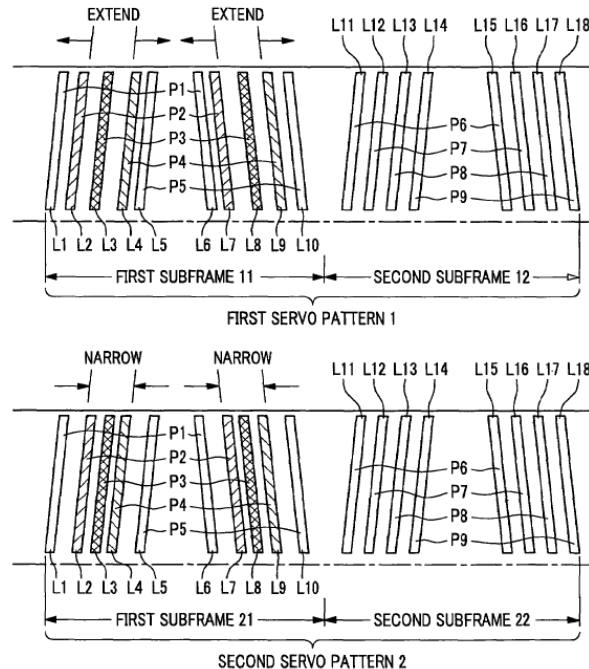


Figure 2 is an enlarged plan view of a servo signal of Figure 1. Ex. 1001, 4:17–18. Servo signals S1–S5 consist of first servo pattern 1 and second servo pattern 2 that are arranged arbitrarily for a plurality of sets along the longitudinal direction of the tape. *Id.* at 4:53–56. First servo pattern 1 includes first subframe 11 and second subframe 12 as nonparallel stripes, and second servo pattern 2 includes first subframe 21 and second subframe 22 as nonparallel stripes. *Id.* at 4:56–60.

First subframes 11 and 21 include five line patterns L1–L5 that incline against the longitudinal direction of the tape, and five line patterns L6–L10 that incline symmetrically to line patterns L1–L5. *Id.* at 4:61–65. Pairs of

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