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Paper 11
Entered: December 18, 2017

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.*

DECISION
Granting Petitioner's Request for Rehearing
Institution of *Inter Partes* Review
37 C.F.R. §§ 42.71(d) and 42.108

INTRODUCTION

On August 22, 2017, Sony Corporation ("Petitioner") filed a Request for Rehearing (Paper 10, "Rehearing Request" or "Req. Reh'g") of our Decision (Paper 9, "Decision" or "Dec.") denying institution of an *inter partes* review of claims 1–3 and 10 of U.S. Patent No. 7,355,805 B2 (Ex. 1001, "the '805 patent") on the following grounds:

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

According to Petitioner, the Decision misapprehended or overlooked evidence and arguments that claims 1–3 and 10 are unpatentable over the cited prior art. Req. Reh'g 1. We have reviewed Petitioner's Rehearing Request and carefully considered Petitioner's arguments. For the reasons discussed below, we grant Petitioner's Rehearing Request and institute an *inter partes* review of claims 1–3 and 10, as described herein.

[1] U.S. Patent No. 6,710,967 B2, issued March 23, 2004 (Ex. 1005).
[2] U.S. Patent No. 5,930,065, issued July 27, 1999 (Ex. 1003).
[3] U.S. Patent No. 6,496,328 B1, issued December 17, 2002 (Ex. 1006).

ANALYSIS

A request for rehearing must identify specifically all matters the party believes we misapprehended or overlooked, and the place where each matter was addressed previously in a motion, opposition, or reply. 37 C.F.R. § 42.71(d). Additionally, Petitioner, as the party challenging the Decision, has the burden of showing the Decision should be modified. *Id.*

When rehearing a decision on a petition, the Board will review the decision for an abuse of discretion. *See* 37 C.F.R. § 42.71(c). An abuse of discretion may be determined "if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors." *Arnold Partnership v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2002) (citing *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000)).

A. Anticipation by Hennecken

Petitioner argues that we misapprehended Petitioner's contention that Hennecken anticipates claims 1–3 and 10 as being based on inherency, and misapprehended or overlooked Petitioner's arguments and evidence that establishes that a person having ordinary skill in the art would have understood Hennecken "to disclose servo bands with servo band numbers that uniquely identify them." Req. Reh'g 1–13. Specifically, Petitioner argues that "[t]he Petition demonstrates that a [person having ordinary skill in the art] would have understood Hennecken to anticipate claims 1–3 and 10 because Hennecken ***discloses*** the disputed limitation to a [person having ordinary skill in the art], ***not*** because the disputed limitation is undisclosed but inherent in Hennecken." *Id.* at 2 (citing Pet. 23–30). According to Petitioner, because Hennecken teaches "that 'a servo stripe number may be

encoded in the servo track for coarse transverse location,' and establishes that 'servo track' and 'servo stripe'. . . are synonymous with 'servo band' in the '805 patent," a person having ordinary skill in the art ("POSA") "would understand that the 'servo stripe number' describes a number that identifies the respective servo track,' and that embedding a servo stripe number in each servo track means that each servo track will have 'a different servo pattern recorded thereon that specifies the respective servo track.'" *Id.* (quoting Pet. 16, 23–24).

Petitioner does not dispute that Hennecken does not expressly disclose in words "a plurality of servo bands on each of which is written a different servo signal for tracking control of a magnetic head" as recited in independent claim 1. *See* Req. Reh'g 8 (stating that the Petition alleges that this limitation "is met by the disclosure of Hennecken as understood by a POSA" (citing Pet. 24)). As Petitioner notes, Hennecken can be anticipating if a POSA would have understood Hennecken as disclosing the claimed plurality of servo bands, and could have combined Hennecken's disclosure with his own knowledge to make the claimed invention. *Id.* at 8–9; *see, e.g.*, *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 1347 (Fed. Cir. 2000).

We are persuaded that we misapprehended Petitioner's anticipation rationale set forth in the Petition as being based on inherent anticipation. We find that the Petition at pages 24–25 (and the cited testimony in the Declaration of Dr. Thomas Albrecht (Ex. 1016, "Albrecht Declaration")) sets forth Petitioner's argument that a POSA would have understood Hennecken to be disclosing different servo stripe numbers on each servo track. Because we denied institution of *inter partes* review with respect to claims 1–3 and 10 based on this misapprehension, we grant Petitioner's

Rehearing Request with respect to this contention. Consequently, we now analyze Petitioner's challenge that Hennecken anticipates claims 1–3 and 10 of the '805 patent.[4]

Petitioner relies on the Albrecht Declaration to support its argument that a POSA would have understood Hennecken to disclose "a plurality of servo bands on each of which is written a different servo signal for tracking control of a magnetic head." *See* Pet. 23–25 (citing Ex. 1016 ¶¶ 106–108, 157, 163, 175–177, 182, 186, 187). For example, Dr. Albrecht testifies that a POSA would have understood that Hennecken's servo stripe number "describes a number that identifies the respective servo track," and would further understand "that by encoding the servo track number into each servo track, a read element can identify the servo track being read without needing to reference any other servo track." Ex. 1016 ¶ 107. Dr. Albrecht further testifies that:

> In particular, Hennecken points out that the servo stripe number varies between servo tracks. *Id.* at C2:L16–19 ("Fourth, the low frequency pattern is typically written by a single current driver, and thus cannot contain any information that varies between the servo tracks, such as a servo stripe number."). Thus, Hennecken describes providing each servo track with a different respective servo stripe number, which necessarily enables a servo read element to identify the servo track being read without referencing other servo tracks. That is, a servo read element need do nothing more that read the unique servo stripe number embedded in a servo track to identify it.

Id. ¶ 108.

[4] We provided an overview of the '805 patent and Hennecken in our Decision. Dec. 2–6, 8–9.

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