

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION,
Petitioner,

v.

FUJIFILM CORPORATION,
Patent Owner.

Cases IPR2017-00800
Patents 6,767,612 B2

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

ABRAHAM, *Administrative Patent Judge*.

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

Sony Corporation (“Petitioner”) filed a Corrected Petition seeking *inter partes* review of claims 1, 2, 4, 5, and 7–11 (“challenged claims”) of U.S. Patent No. 6,767,612 B2 (Ex. 1001, “the ’612 patent”). Paper 9 (“Pet.”). Fujifilm Corporation (“Patent Owner”) filed a Patent Owner Preliminary Response to the Petition. Paper 13 (“Prelim. Resp.”).

On August 18, 2017, we issued a Decision instituting *inter partes* review with respect to the questions of whether the subject matter of the challenged claims would have been obvious in view of the combined teachings of Matsuno¹ and Endo,² and Matsuno, Endo, and Wallace.³ Paper 14, 23. We declined to institute *inter partes* review with respect to the question of whether the subject matter of the challenged claims would have been obvious in view of the combined teachings of Matsuno, Endo, Wallace, and Yamazaki.⁴ *Id.* at 22–23. Also on August 18, 2017, we issued a Scheduling Order setting May 17, 2018, as the date for oral argument, if requested by the parties. Paper 15, 7. Patent Owner submitted an Oral Hearing Request on April 5, 2018 (Paper 33), and Petitioner submitted an Oral Hearing Request on April 9, 2018 (Paper 34).

On April 26, 2018, subsequent to the Supreme Court’s decision in *SAS Inst., Inc. v. Iancu*, No. 16-969, 2018 WL 1914661, at *10 (U.S. Apr. 24, 2018), we issued an Order modifying our Decision instituting *inter*

¹ Matsuno, JP 2001-84549A, published Mar. 30, 2001 (“Matsuno,” Ex. 1004).

² Endo et al., JP 2000-40218A, published Feb. 8, 2000 (“Endo,” Ex. 1005).

³ R.L. Wallace, Jr., *The Reproduction of Magnetically Recorded Signals*, BELL SYS. TECH. J. 1145–1173 (1951) (“Wallace,” Ex. 1006).

⁴ Yamazaki et al., U.S. Patent No. 6,017,605, issued Jan. 25, 2000 (“Yamazaki,” Ex. 1007).

partes review to institute on all of the grounds presented in the Petition, including the question of whether the subject matter of the challenged claims would have been obvious in view of the combined teachings of Matsuno, Endo, Wallace, and Yamazaki. Paper 35, 2. We also ordered the parties to confer to determine whether it would be necessary to change the schedule or to submit briefing not already permitted under the Scheduling Order, and if so, to request a conference call with the panel to seek authorization for such changes. *Id.*

On May 7, 2018, a conference call was held between counsel for the parties and Judges Kokoski, Ankenbrand, and Abraham. During the call, counsel for the parties indicated that, after conferring, they desired to conduct additional discovery and file supplemental briefs to address whether the subject matter of the challenged claims would have been obvious in view of the combined teachings of Matsuno, Endo, Wallace, and Yamazaki. The parties also requested authorization to amend the Scheduling Order to account for the at least one additional deposition and supplemental briefing sought by Patent Owner and Petitioner. The parties were optimistic that the deposition would occur in early June 2018, and had agreed to a briefing schedule allowing each party three weeks to submit supplemental briefs, subject to the condition that Petitioner may need more time to file its supplemental reply brief if additional discovery was deemed necessary. The parties also indicated that they agreed to limit the deposition to three (3) hours and the supplemental briefs to seven (7) pages each.

We noted the parties' agreement and request for authorization to submit additional briefing and change the Scheduling Order. The parties acknowledged that we would have to reschedule the hearing set for May 17,

IPR2017-00800
Patent 6,767,612 B2

2018, in order to account for the proposed modifications to the schedule. We asked the parties to submit a joint proposed modified Scheduling Order by May 11, 2018, reflecting the agreements discussed during the conference.

At this time, the panel expects the proposed schedule to permit issuance of a final written decision on or before the statutory due date of August 17, 2018. In order to do so, the panel intends to reschedule the hearing during the month of July, and will provide a specific date once we receive the parties' proposed modified Scheduling Order.

Accordingly, it is

ORDERED that the parties shall file a joint proposed modified Scheduling Order on or before May 11, 2018; and

FURTHER ORDERED that the oral hearing previously scheduled for May 17, 2018, is postponed until further notice.

IPR2017-00800
Patent 6,767,612 B2

PETITIONER:

Michael Rader
Randy Pritzker
Richard Giunta
Gerald Hrycyszyn
Brandon Blackwell
WOLF, GREENFIELD & SACKS, P.C.
Mrader-PTAB@wolfgreenfield.com
RPritzker-PTAB@wolfgreenfield.com
RGiunta-PTAB@wolfgreenfield.com
GHrycyszyn-PTAB@wolfgreenfield.com
BBlackwell-PTAB@wolfgreenfield.com

PATENT OWNER:

Eliot Williams
Robert Scheinfeld
Robert Maier
Michael E. Knierim
Joseph C. Akalski
BAKER BOTTS LLP
eliot.williams@bakerbotts.com
robert.scheinfeld@bakerbotts.com
robert.maier@bakerbotts.com
michael.knierim@bakerbotts.com
joseph.akalski@bakerbotts.com