

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FUJIFILM CORPORATION,
Petitioner,

v.

SONY CORPORATION
Patent Owner.

Case IPR2017-01267
Patent 7,029,774 B1

Before JO-ANNE M. KOKOSKI, JON B. TORNQUIST,
and JEFFREY W. ABRAHAM, *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 1–13 and 15–20 of U.S. Patent No. 7,029,774 B1 (“the ’774 patent,” Ex. 1001) are unpatentable.

A. *Procedural History*

FUJIFILM Corporation (“Petitioner”) filed a Petition (“Pet.”) to institute an *inter partes* review of claims 1–13 and 15–20 of the ’774 patent based on the following grounds: (1) whether claims 1–12 and 15–20 are unpatentable under 35 U.S.C. § 102 as being anticipated by Law¹, and (2) whether claims 1–13 and 15–20 are unpatentable under 35 U.S.C. § 103 as being obvious over the combined teachings of Law and Sasaki². Paper 1, 5. Sony Corporation (“Patent Owner”) did not file a Preliminary Response. Pursuant to 35 U.S.C. § 314(a), we instituted an *inter partes* review of claims 1–13 and 15–20 based on our determination that the information presented in the Petition demonstrated a reasonable likelihood that Petitioner would prevail on its challenge that claims 1–13 and 15–20 are unpatentable under 35 U.S.C. § 103 as obvious over the combined teachings of Law and Sasaki.³ Paper 11 (“Dec. on Inst.” or “Institution Decision”), 16.

¹ U.S. Patent No. 5,507,747, issued March 4, 1997 (Ex. 1004).

² Japanese Patent App. Pub. No. P2003-317228A, published Nov. 7, 2003 (Ex. 1005). We refer to the English translation of the original reference as “Sasaki.”

³ We subsequently modified our Institution Decision to include review of “all challenged claims and all of the grounds presented in the Petition”

After institution of trial, Patent Owner filed a Patent Owner Response (“PO Resp.,” Paper 18), and Petitioner filed a Reply (“Reply,” Paper 25). Petitioner relies on the Declaration of Ryosuke Isobe⁴ (“the Isobe Declaration,” Ex. 1003), and the Rebuttal Declaration of Dr. Bart Raeymaekers (“the Raeymaekers Declaration,” Ex. 1031). Patent Owner relies on the Declaration of Prof. Frank Talke (“the Talke Declaration,” Ex. 2026). Patent Owner also filed a Motion for Observations on Cross-Examination of Dr. Raeymaekers (Paper 37), and Petitioner filed a Response (Paper 38). An oral hearing was held on July 31, 2018, and a transcript is included in the record. Paper 42 (“Tr.”).

B. Related Proceedings

Petitioner identifies *Sony Corp. v. FUJIFILM Holdings Corp.*, Case 1:16-cv-05988 (S.D.N.Y.) as a related matter. Pet. 63. Patent Owner identifies *Sony Corp. v. FUJIFILM Holdings Corp.*, No. 337-TA-1036 (ITC) and *Sony Corp. v. FUJIFILM Holdings Corp.*, No. 1:16-cv-25210 (S.D. Fla.) as related matters. Paper 5, 1. The ’774 patent currently is the subject of IPR2017-01268, also filed by Petitioner. Pet. 63.

(Paper 21, 2), then granted (Paper 29) the parties’ Joint Motion to Limit the Petition (Paper 28), limiting this proceeding to the originally instituted ground, namely, obviousness of claims 1–13 and 15–20 based on the combined teachings of Law and Sasaki.

⁴ With Board authorization (Paper 6), Patent Owner filed a Motion to Exclude and Disqualify Ryosuke Isobe as Petitioner’s Expert Witness (Paper 7), and Petitioner filed an Opposition (Paper 8). We denied Patent Owner’s Motion. Paper 9.

C. *The '774 Patent*

The '774 patent, titled “Magnetic Recording Medium with Backside to Decrease Recording Surface Embossment,” relates to “magnetic recording media, such as magnetic tapes, having a backside configured to decrease pitting or embossment” of a recording surface of the magnetic recording media. Ex. 1001, 1:7–12. The '774 patent explains that the backside surface of a typical recording medium has bimodal roughness that defines a plurality of peaks and valleys, and that when the medium is wound such that the second winding extends on top of the first winding, the peaks on the backside of the second winding contact the front surface of the first winding. *Id.* at 2:5–12. This limits the contact between the first winding and the second winding, decreasing friction between the windings as well as between the medium and the read/write mechanism during use. *Id.* at 2:13–17. The interaction between the peaks on the second winding and the surface of the first winding can also cause the peaks to imprint upon the front surface of the first winding, creating pits or embossments that can damage the recording characteristics of the magnetic recording medium. *Id.* at 2:17–23. Therefore, according to the '774 patent, “it is desirable to create a magnetic recording medium having a backside configured to improve the durability and frictional characteristics of the magnetic recording medium while decreasing embossment of the recording surfaces of the magnetic recording medium.” *Id.* at 2:24–28.

Figure 2 of the '774 patent is reproduced below.

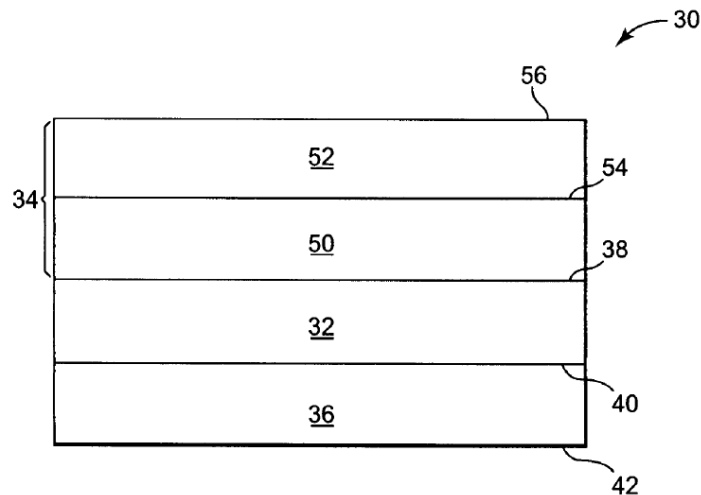


Fig. 2

Figure 2 is a schematic illustration of a cross-sectional view of one embodiment of the magnetic recording medium described in the '774 patent. Ex. 1001, 3:10–11. Magnetic recording medium 30 includes substrate 32, magnetic side 34, and backside 36. *Id.* at 3:36–37. Substrate 32 defines top surface 38 and bottom surface 40 opposite top surface 38, and magnetic side 34 (which provides the recordable material to magnetic recording medium 30) extends over and is bonded to top surface 38. *Id.* at 3:38–43. Magnetic side 34 includes support layer 50 and magnetic recording layer 52. *Id.* at 4:12–16. Support layer 50 extends over and is bonded to top surface 38, and defines a top surface 54 opposite top surface 38. *Id.* at 4:16–19. Magnetic recording layer 52 extends over and is bonded to top surface 54 of support layer 50, defining recording surface 56 opposite support layer 50. *Id.* at 4:19–22. Backside 36 extends along and is bonded to bottom surface 40, and defines an outer surface 42 opposite substrate 32. *Id.* at 3:43–46.

According to the '774 patent, “magnetic recording medium 30 exhibits improved signal and error characteristics by decreasing pitting or

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.