

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FUJIFILM CORPORATION,  
Petitioner,

v.

SONY CORPORATION  
Patent Owner.

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Case IPR2017-01268  
Patent 7,029,774 B1

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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 shown by a preponderance of the evidence that claims 15 and 17 of U.S. Patent No. 7,029,774 B1 (“the ’774 patent,” Ex. 1001) are unpatentable, and has not shown by a preponderance of the evidence that claims 1–11, 16, and 18–20 of the ’774 patent are unpatentable.

### A. *Procedural History*

FUJIFILM Corporation (“Petitioner”) filed a Petition (“Pet.”) to institute an *inter partes* review of claims 1–11 and 15–20 (“the challenged claims”) of the ’774 patent based on the following grounds: (1) whether claims 15 and 17 are unpatentable under 35 U.S.C. § 102 as being anticipated by Ishikawa<sup>1</sup>, (2) whether claims 1–11 and 15–20 are unpatentable under 35 U.S.C. § 103 as being obvious over Aonuma<sup>2</sup>, and (3) whether claims 1–11 and 15–20 are unpatentable under 35 U.S.C. § 103 as being obvious over the combined teachings of Aonuma and Abe<sup>3</sup>. Paper 1, 12. 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

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<sup>1</sup> U.S. Patent App. Pub. No. US 2003/0054203 A1, published March 20, 2003 (Ex. 1015).

<sup>2</sup> Japanese Patent App. Pub. No. P2003-36520A, published Feb. 7, 2003 (Ex. 1017). We refer to “Aonuma” as the English translation of the original reference.

<sup>3</sup> European Patent App. Pub. No. 0 494 793 A1, published July 15, 1992 (Ex. 1013).

claims 1–11 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 1–11 and 15–20 are unpatentable with respect to all three grounds set forth in the Petition. Paper 11 (“Dec. on Inst.”), 17–18.

After institution of trial, Patent Owner filed a Patent Owner Response (“PO Resp.,” Paper 21), and Petitioner filed a Reply (“Reply,” Paper 27). Petitioner relies on the Declaration of Ryosuke Isobe<sup>4</sup> (“the Isobe Declaration,” Ex. 1003), the Declaration of Norihito Kasada (“the Kasada Declaration,” Ex. 1019), the Declaration of Dr. Bart Raeymaekers (“the Raeymaekers Declaration,” Ex. 1018), and the Rebuttal Declaration of Dr. Bart Raeymaekers (“the Raeymaekers Rebuttal 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 38), and Petitioner filed a Response (Paper 39).

Petitioner filed a Motion to Exclude Exhibit 2040, and paragraphs 121–126 of the Talke Declaration. Paper 33. Patent Owner filed an Opposition (Paper 41), and Petitioner filed a Reply (Paper 42). Patent Owner filed a Motion to Exclude certain paragraphs of the Kasada Declaration, the Isobe Declaration, the Raeymaekers Declaration, and the Raeymaekers Rebuttal Declaration, and Exhibits 1037 and 1038. Paper 36.

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<sup>4</sup> 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.

Petitioner filed an Opposition (Paper 40), and Patent Owner filed a Reply (Paper 43).

An oral hearing was held on July 31, 2018, and a transcript is included in the record. Paper 47 (“Tr.”).

*B. Related Proceedings*

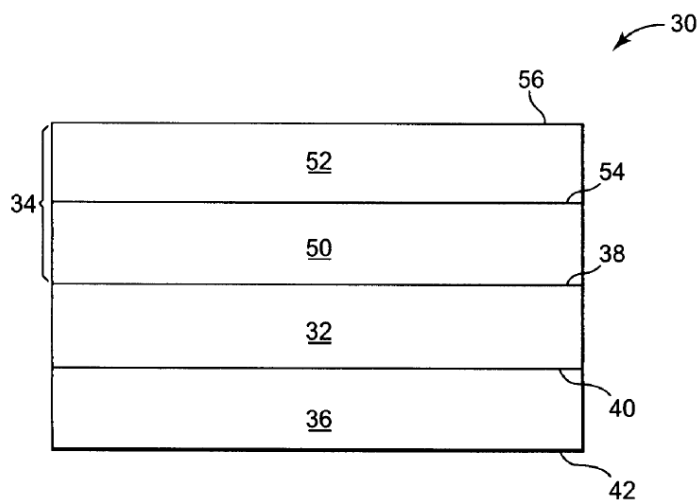
Petitioner identifies *Sony Corp. v. FUJIFILM Holdings Corp.*, Case 1:16-cv-05988 (S.D.N.Y.) as a related matter. Pet. 64. Patent Owner identifies *Sony Corp. v. FUJIFILM Holdings Corp.*, No. 337-TA-1036 (ITC) and *Sony Corp. v. FUJIFILM Holdings Corp.*, No. 1:16-cv-25210 (S.D. Fla.) as related matters. Paper 5, 1. Additionally, the ’774 patent is the subject of IPR2017-01267, also filed by Petitioner. Pet. 64.

*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

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