

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 IPR2017-01277  
Patent 6,345,779 B1

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Before JEFFREY S. SMITH, MICHAEL J. FITZPATRICK, and  
PATRICK M. BOUCHER, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION  
Instituting *Inter Partes* Review  
37 C.F.R. § 42.108

## I. INTRODUCTION

Petitioner filed a Petition for *inter partes* review of claims 1–6 of U.S. Patent No. 6,345,779 B1 (Ex. 1001, “the ’779 patent”). Paper 1 (“Pet.”). Patent Owner filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). An *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a); *see also* 37 C.F.R. § 42.108.

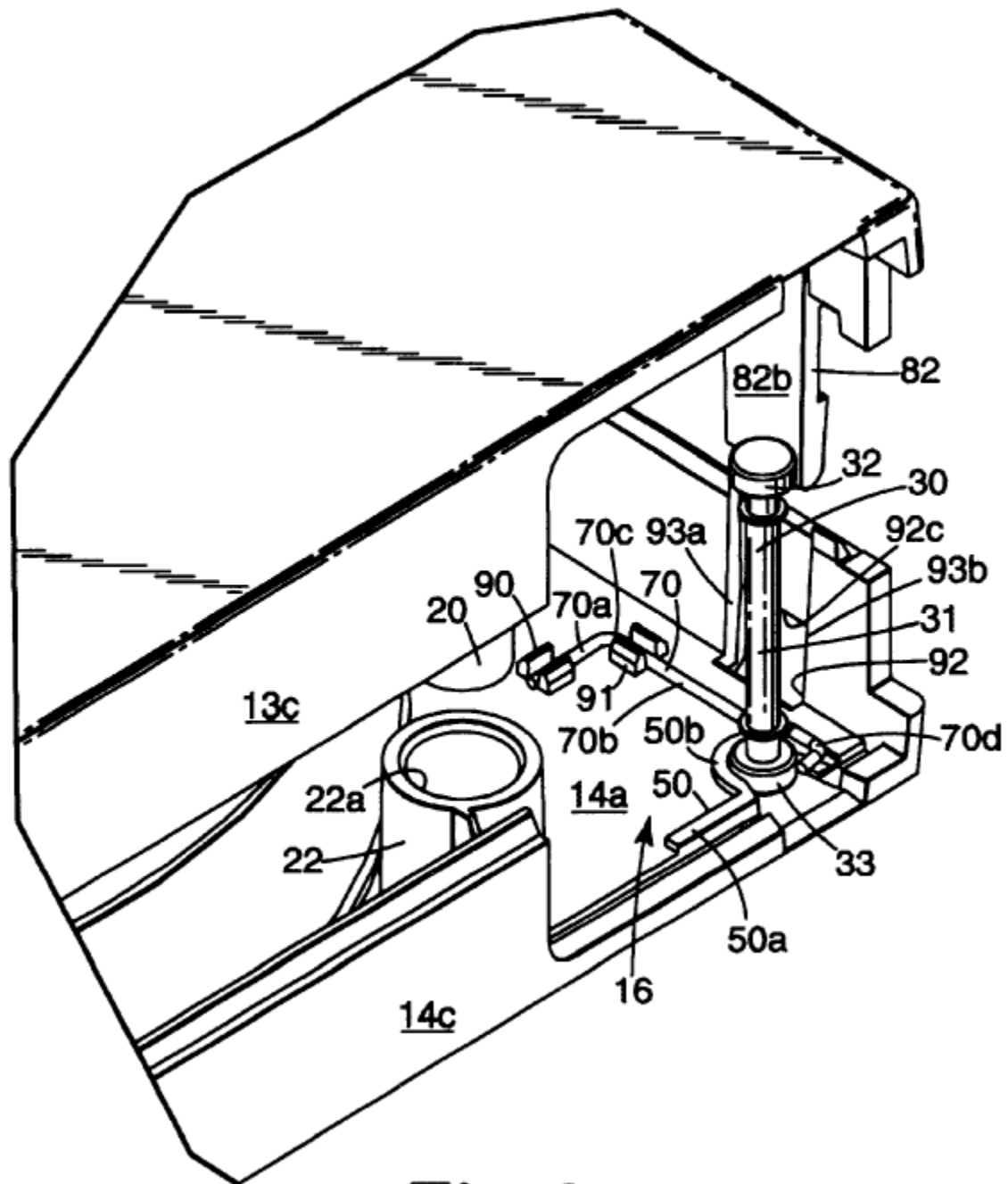
Upon consideration of the Petition and the Preliminary Response, we are persuaded Petitioner has demonstrated a reasonable likelihood that it would prevail in establishing the unpatentability of claims 1–6 of the ’779 patent. Accordingly, we institute an *inter partes* review.

### A. Related Matters

Both parties point out that the ’779 patent was asserted against FUJIFILM Holdings Corporation, *et al.*, in *Sony Corporation et al. v. FUJIFILM Holdings Corporation, et al.*, No. 337-TA-1036 (ITC) and *Sony Corporation et al. v. FUJIFILM Holdings Corporation, et al.*, Case No. 1:16-cv-25210 (S.D. Fla.). Pet. 1; Paper 4.

### B. The ’779 Patent

The ’779 patent relates to a data storage tape cartridge having a retainer for a leader pin. Ex. 1001, 1:5–8. Figure 3 of the ’779 patent is reproduced below.



**Fig. 3**

Figure 3 above shows a fragmentary horizontal cross-sectional view of a magnetic tape cartridge. Ex. 1001, 2:24-25. The magnetic tape cartridge includes housing 12 having first section 13 and second section 14 operatively connected to each other. Ex. 1001, Abstract, Figs. 1 and 3. First

positioning member 40 and second positioning member 50 are operatively connected to the housing and are in axial alignment with each other. Ex. 1001, Abstract; Figs. 3 and 5. Leader pin 30 is positioned in positioning members 40 and 50. Springs 60 and 70 secure leader pin 30 in position. *Id.* Tape access opening 16, formed in housing 12, provides access to leader pin 30. *Id.* at 3:33–36.

As shown in Figure 3, spring 70 is generally L-shaped and has a first portion and a second portion. *Id.* at 4:1–2. Base member 70a forms the first portion of spring 70, and elongate member 70b forms the second portion. *Id.* at 4:2–3. Elongate member 70b has a first end 70c and an arcuate second end 70d. *Id.* at 4:4–7, 17–18. First portion 70a is operatively connected to housing section 14 by suitable means such as sonic welding or hot staking. *Id.* at 4:9–11. Second portion 70b is not connected to section 14, in order to apply a force to leader pin 30, to hold the leader pin in place. *Id.* at 4:14–16. For example, when leader pin 30 is inserted into access opening 16, cylindrical end 33 of the leader pin pushes second end 70d of the spring away, to allow end 33 to be positioned in positioning member 50. *Id.* at 4:16–18, 5:11–16. Then, second end 70d of the spring provides a positive force, to hold the leader pin in this position. *Id.* at 4:18–20, 5:16–18.

Positioning member 40 and spring 60, located on section 13 of housing 12 as shown in Figure 5, have similar configurations and provide similar functions as positioning member 50 and spring 70. *Id.* at Abstract, 3:45–4:21, 5:8–18, Fig. 5.

### *C. Illustrative Claim*

Claim 1 of the challenged claims of the '779 patent is independent and illustrative of the claimed subject matter:

1. A data storage cartridge comprising:
  - a) a housing having a first section and a second section operatively connected to form the housing;
  - b) the housing defining a tape access opening;
  - c) a first positioning member operatively connected to the first section and a second positioning member operatively connected to the second section, the positioning members in axial alignment;
  - d) an end of tape attachment member having a first end positioned in the first positioning member and a second end positioned in the second positioning member;
  - e) a first spring having a first portion operatively connected to the first section and a moveable second portion securing the end of tape attachment member in position; and
  - f) a second spring having a first portion operatively connected to the second section and a moveable second portion securing the end of tape attachment member in position.

Ex. 1001, 5:25–43.

*D. References*

Petitioner relies on the following references. Pet. 15–16.

Reference	Patent No.	Date	Ex. No.
Morita	US 6,236,539 B1	May 22, 2001	1004
Sandell	US 4,945,530	July 31, 1990	1005
Ishihara	JP H11-339432	Dec. 10, 1999	1006

Petitioner also relies on the Declaration of William Vanderheyden (Ex. 1002) in support of its arguments. Patent Owner relies on the Declaration of Dr. Richard Klopp (Ex. 2002) in support of its arguments.

*E. Asserted Ground of Unpatentability*

Petitioner contends that claims 1–6 of the '779 patent are unpatentable based on the following specific grounds:

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