

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FUJIFILM CORPORATION,
Petitioner,

v.

SONY CORPORATION,
Patent Owner.

Case IPR2017-01389
Patent 6,896,959 B2

Before JON B. TORNQUIST, JEFFREY W. ABRAHAM, and
ELIZABETH M. ROESEL, *Administrative Patent Judges*.

ABRAHAM, *Administrative Patent Judge*.

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

Fujifilm Corporation (“Petitioner”) filed a Petition seeking *inter partes* review of claims 1–18 (“challenged claims”) of U.S. Patent No. 6,896,959 B2 (Ex. 1001, “the ’959 patent”) based on the following grounds:

Ground	Reference(s)	Statutory Basis	Claim(s) Challenged
1	Mori ¹	§ 102	1–9 and 11–16
2	Sasaki ²	§ 102	1–9 and 11–18
3	Aonuma ³	§ 102	1, 2, and 4–18
4	Aunoma and Mori	§ 103	1–18
5	Aonuma and Sasaki	§ 103	1 and 6
6	Mori and Aonuma	§ 103	10, 17, and 18
7	Mori and Sasaki	§ 103	17 and 18
8	Sasaki and Aonuma	§ 103	10
9	Mori, Mee, ⁴ and Tokuoka ⁵	§ 103	1–9 and 11–16
10	Sasaki, Mee, and Tokuoka	§ 103	1–9 and 11–18
11	Aonuma	§ 103	1, 2, and 4–18

¹ Mori et al., JP 2002-74641A, published Mar. 15, 2002 (“Mori,” Ex. 1003 (certified translation); Ex. 1022 (original)).

² Sasaki et al., JP 2000-40217A, published Feb. 8, 2000 (“Sasaki,” Ex. 1004 (certified translation); Ex. 1019 (original)).

³ Aonuma, JP 2001-319315A, published Nov. 16, 2001 (“Aonuma,” Ex. 1002 (certified translation); Ex. 1018 (original)).

⁴ Magnetic Recording, Volume I: Technology (C. Denis Mee & Eric. D. Daniel eds., 1987) (“Mee,” Ex. 1005).

⁵ Tokuoka, U.S. Patent No. 4,347,291, issued Aug. 31, 1982 (“Tokuoka,” Ex. 1006).

Paper 1 (“Pet.”). Sony Corporation (“Patent Owner”) filed a Patent Owner Preliminary Response to the Petition. Paper 8 (“Prelim. Resp.”). In our institution decision, we ordered review of all challenged claims but limited the proceeding to Grounds 1, 2, and 4–8. Paper 9. On April 27, 2018, we modified our institution decision to include review of “all challenged claims and all grounds presented in the Petition.” Paper 15, 2.

In view of our April 27, 2018 Order modifying the institution decision, the parties filed a Joint Proposal for Additional Briefing and a Revised Schedule. Paper 16. According to the parties’ Joint Proposal, “Petitioner agrees to withdraw Ground 9 (combination of Mori in view of Mee and Tokuoka) and Ground 10 (combination of Sasaki in view of Mee and Tokuoka) from its Petition.” *Id.* at 1. Grounds 3 and 11 remain in the proceeding, but Patent Owner agrees it will not seek to cross-examine Petitioner’s declarant, Dr. Wang, on these grounds. *Id.*

The parties agree that Patent Owner may file a supplemental Patent Owner Response addressing only Grounds 3 and 11 and limited to 5,000 words. *Id.* The parties also agree that the supplemental response and supporting supplemental declaration of Dr. Bain (if necessary) shall be filed by June 15, 2018.

The parties further agree to modify DUE DATES 2 and 4 in the original Scheduling Order (Paper 10), such that the new deadline for DUE DATE 2 is July 27, 2018, and the new deadline for DUE DATE 4 is August 3, 2018. Paper 16, 1. The parties also agree that the deadline for DUE DATE 3 is no longer applicable. *Id.*

Removing Grounds 9 and 10 from this dispute, allowing the requested briefing, and modifying the scheduling order, pursuant to the parties’ joint

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request, serves our overarching goal of resolving this proceeding in a just, speedy, and inexpensive manner. 37 C.F.R. § 42.1(b).

Accordingly, it is hereby

ORDERED that the Petition is limited to Grounds 1–8 and 11;

FURTHER ORDERED that Patent Owner may file a supplemental Patent Owner Response on or before June 15, 2018; such supplemental response shall address only Grounds 3 and 11, and is limited to 5,000 words;

FURTHER ORDERED that Patent Owner shall not cross-examine Dr. Wang on Grounds 3 and 11; and

FURTHER ORDERED that the schedule is modified such that the new deadline for DUE DATE 2 is July 27, 2018, and the new deadline for DUE DATE 4 is August 3, 2018.

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