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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*.

FINAL WRITTEN DECISION
35 U.S.C. § 318 and *37 C.F.R. § 42.73*

I. INTRODUCTION

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"). Paper 1 ("Pet."). Sony Corporation ("Patent Owner") filed a Patent Owner Preliminary Response to the Petition. Paper 8 ("Prelim. Resp."). On December 8, 2017, we instituted an *inter partes* review of all challenged claims, but not all grounds raised in the Petition. Paper 9 ("Inst. Dec.").

After institution, Patent Owner filed a Patent Owner Response (Paper 14, "PO Resp."). On April 27, 2018, we issued an order modifying our Institution Decision to include all grounds raised in the Petition. Paper 15. After receiving authorization from the Board, Patent Owner filed a Supplemental Patent Owner Response (Paper 18, "Suppl. PO Resp.")[1] addressing the previously non-instituted grounds, and Petitioner filed a Reply (Paper 24).

An oral hearing was held on September 20, 2018, and a transcript of the hearing has been entered into the record of the proceeding. Paper 30 ("Tr.").

We have jurisdiction under 35 U.S.C. § 6. 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

[1] In the Supplemental Patent Owner Response, Patent Owner indicated Petitioner "agreed to drop" two grounds raised in the Petition. Suppl. PO Resp. 4 (referring to Grounds 9 and 10 in the Petition). Petitioner agrees. Tr. 4:12–13 (agreeing that Petitioner dropped Grounds 9 and 10 from the Petition). Because Petitioner has withdrawn Grounds 9 and 10 from the Petition, we do not address them in this Final Written Decision.

preponderance of the evidence that claims 1–18 of the '959 patent are unpatentable.

II. BACKGROUND

A. Related Proceedings

The parties indicate that the '959 patent is involved in *Certain Magnetic Tape Cartridges and Components Thereof* (ITC Investigation No. 337-TA-1036). Pet. 1; Paper 4, 1. Patent Owner further identifies the following litigation as related: *Sony Corporation v. Fujifilm Holdings Corporation*, Civil Action No. 1:16-cv-25210 (S.D. Fla.). Paper 4, 1.

B. The '959 Patent

The '959 patent, titled "Magnetic Recording Medium Having Narrow Pulse Width Characteristics," issued on May 24, 2005. Ex. 1001, at [54], [45]. The '959 patent discloses a dual-layer magnetic recording media having a magnetic layer that "includes a volume concentration of at least about 35% of a primary magnetic metallic particulate pigment material having a coercivity of at least about 2000 Oe, and an average particle size of less than about 100 nm, and a binder system therefor." *Id.* at 2:59–63. As a result, the magnetic recording media "exhibit narrower pulsewidth characteristics and lowered remanence-thickness product." *Id.* at 1:11–13.

The '959 patent explains that pulsewidth, "often abbreviated as PW50," is one measure of magnetic media performance (*id.* at 2:29–30), and

> is tested by recording a signal on a magnetic recording medium at a sufficiently low density that the transitions are isolated from one another; i.e., they do not interact or interfere with one another. The amplified, unequalized and unfiltered signal from the read head is displayed on an oscilloscope and the width along the time axis of the resulting positive and/or negative pulses halfway from the baseline to their peaks is measured.

> This time interval is multiplied by the tape transport speed to obtain the pulsewidth, as a distance.

Id. at 3:32–42. According to the '959 patent, remanence-thickness product "is abbreviated Mr*t, and means the product of the remanent magnetization after saturation in a strong magnetic field (10 kOe) multiplied by the thickness of the magnetic coating. This value is measured in memu/cm^2." *Id.* at 3:43–47.

The '959 patent discloses that the recording medium preferably has a PW50 of less than about 500 nm and a Mr*t of less than about 5.0 memu/cm^2. *Id.* at 2:63–66. The '959 patent describes the preparation of several examples, and Table 1 provides physical attributes and PW50 results for those examples. *Id.* at 9:55–10:50.

C. Illustrative Claim

Petitioner challenges claims 1–18 of the '959 patent. Claim 1 is the only independent claim and is reproduced below:

> 1. A dual-layer magnetic recording medium comprising a non-magnetic substrate having a front side and a back side, a lower support layer formed over the front side and a magnetic upper recording layer formed over said lower layer, comprising a volume concentration of at least about 35% of a primary magnetic metallic particulate pigment having a coercivity of at least about 2000 Oe, said magnetic pigment particles having an average particle length of no more than about 100 nm, and a binder for the pigment, wherein said medium has a remanence-thickness product, Mr*t, of less than about 5.0 memu/cm^2, an orientation ratio greater than about 2.0, and a PW50 of less than about 500 nm.

Ex. 1001, 10:52–64.

D. References

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

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

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

E. Reviewed Grounds of Patentability

Reference(s)	Statutory Basis	Claim(s) Challenged
Mori	§ 102	1–9 and 11–16
Sasaki	§ 102	1–9 and 11–18
Aonuma	§ 102	1, 2, and 4–18
Aonuma and Mori	§ 103	1–18
Aonuma and Sasaki	§ 103	1 and 6
Mori and Aonuma	§ 103	10, 17, and 18
Mori and Sasaki	§ 103	17 and 18
Sasaki and Aonuma	§ 103	10
Aonuma	§ 103	1, 2, and 4–18

III. ANALYSIS

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b) (2016); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable interpretation standard). Absent a special definition for a claim term being set forth in the

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