

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FUJIFILM CORPORATION,
Petitioner,

v.

SONY CORPORATION,
Patent Owner.

Case IPR2017-01390
Patent 7,115,331 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. 7,115,331 B2 (Ex. 1001, “the ’331 patent”) based on the following grounds:

Ground	Reference(s)	Statutory Basis	Claim(s) Challenged
1	Mori ¹	§ 102	1–11, 13, and 16–18
2	Sasaki ²	§ 102	1–11 and 13–18
3	Aonuma ³ and Mori	§ 103	1–18
4	Sasaki and Mori	§ 103	1–11 and 13–18
5	Mori and Aunoma	§ 103	12, 14, and 15
6	Mori and Sasaki	§ 103	14 and 15
7	Mori, Mee, ⁴ and Tokuoka ⁵	§ 103	1–11, 13, and 16–18
8	Sasaki, Mee, and Tokuoka	§ 103	1–11 and 13–18
9	Mori and Mee	§ 103	1–11, 13, and 16–18
10	Sasaki and Mee	§ 103	1–11 and 13–18

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 (for claims 1, 3–11 and 13 only), 3, 5, 6, 9, and 10. 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 7 (combination of Mori in view of Mee and Tokuoka) and Ground 8 (combination of Sasaki in view of Mee and Tokuoka) from its Petition.” *Id.* at 1. Ground 2, Ground 4, and the newly-instituted claims in Ground 1 (claims 2 and 16–18) 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 Ground 2, Ground 4, and the newly-instituted claims in Ground 1 (claims 2 and 16–18) 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 7 and 8 from this dispute, allowing the requested briefing, and modifying the scheduling order, pursuant to the parties' joint 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 1–6, 9, and 10;

FURTHER ORDERED that Patent Owner may file a supplemental Patent Owner Response on or before June 15, 2018; such supplemental response shall address only Ground 2, Ground 4, and the newly-instituted claims in Ground 1 (claims 2 and 16–18), and is limited to 5,000 words;

FURTHER ORDERED that Patent Owner shall not cross-examine Dr. Wang on Ground 2, Ground 4, and the newly-instituted claims in Ground 1 (claims 2 and 16–18); 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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