

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SONY CORPORATION  
Petitioner

v.

Patent of YISSUM RESEARCH DEVELOPMENT COMPANY OF THE  
HEBREW UNIVERSITY OF JERUSALEM  
Patent Owner

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Case IPR2013-00219 (SCM)<sup>1</sup>  
Patent 7,477,284

Title: SYSTEM AND METHOD FOR CAPTURING AND VIEWING  
STEREOSCOPIC PANORAMIC IMAGES

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Before SALLY C. MEDLEY, KARL D. EASTHOM, and  
JAMES B. ARPIN, *Administrative Patent Judges*.

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**PATENT OWNER'S OPPOSITION TO MOTION TO EXCLUDE**

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<sup>1</sup> The IPR2013-00327 proceeding has been joined with this proceeding.

**TABLE OF CONTENTS**

I. INTRODUCTION..... 1

II. STATEMENT OF MATERIAL FACTS IN DISPUTE ..... 1

III. STATEMENT OF RELIEF REQUESTED ..... 1

IV. REASONS WHY PETITIONER’S MOTION TO EXCLUDE SHOULD BE DENIED ..... 1

    A. Exhibits YRD-2012 and YRD-2013 are Relevant to the Issues in the Present Proceeding and Petitioner Failed to Serve This Evidence as Required by Applicable Rules..... 1

    B. Exhibits YRD-2012 and YRD-2013 Were Properly Introduced to Address Issues Raised by Petitioner ..... 7

    C. The Motion is an Attempt to Exclude Evidence that is Necessary in the Interest-of-Justice..... 9

V. CONCLUSION .....10

**CERTIFICATE OF SERVICE .....11**

## **I. INTRODUCTION**

In accordance with 37 C.F.R. § 42.23 and the Scheduling Order (Paper 17) at 4-5 of September 23, 2013, Yissum Research Development Company of the Hebrew University of Jerusalem (“Patent Owner”) submits this Opposition in response to Sony Corporation’s (“Petitioner”) Motion to Exclude ( Paper 47), filed on May 14, 2014.

## **II. STATEMENT OF MATERIAL FACTS IN DISPUTE**

Petitioner did not submit a statement of material facts in its Motion to Exclude. Accordingly, Patent Owner neither denies nor admits any facts.

## **III. STATEMENT OF RELIEF REQUESTED**

Patent Owner requests that Petitioner’s Motion to Exclude be denied.

## **IV. REASONS WHY PETITIONER’S MOTION TO EXCLUDE SHOULD BE DENIED**

### **A. Exhibits YRD-2012 and YRD-2013 are Relevant to the Issues in the Present Proceeding and Petitioner Failed to Serve This Evidence as Required by Applicable Rules**

Petitioner in its Motion (Paper 47 at 3) asserts that exhibits YRD-2012 and YRD-2013, original translations of Kawakita and Asahi produced by Petitioner in previous litigation, are irrelevant and that Patent Owner waived its objections. These assertions fail as discussed below.

Contrary to Petitioner’s assertion, exhibits YRD-2012 and YRD-2013 are directly relevant to issues in the present *inter partes* review proceeding. These exhibits are the original translations of Kawakita and Asahi that were produced by

Petitioner Sony in previous litigation, and which are materially different than the translations of these references, i.e., SONY-1004 and SONY-1010, submitted in the present *inter partes* review proceeding. Compare YRD-2012 to SONY-1010 and YRD-2013 to SONY-2003. The original translations are also inconsistent with positions advanced by Petitioner. See e.g., Patent Owner's Motion for Observation, Paper 43 at ¶ 2 and ¶¶ 4-5. Therefore, exhibits YRD-2013 and YRD-2012 are relevant to issues in the present proceeding.

Petitioner's second assertion – that Patent Owner waived its objections – is a red herring, designed to detract from evidence of Petitioner's failure to comply with applicable rules in the present *inter partes* review proceeding. Pursuant to 37 C.F.R. § 42.51(b)(1)(iii) “[u]nless previously served, a party must serve relevant information that is inconsistent with a position advanced by the party during the proceeding concurrent with the filing of the documents or things that contains the inconsistency.” In the present case, Petitioner was fully aware of the inconsistencies between the translations of these references, since Petitioner is the one that specifically sought out, obtained, and relied upon the different translations of Kawakita (SONY-1004) and Asahi (SONY-1010) in its Petition. In doing so, however, Petitioner failed to serve Patent Owner's counsel with the inconsistent original translations of Kawakita and Asahi, in the present proceeding, as required by 37 C.F.R. § 42.51(b)(1)(iii).

Rather than explaining why it failed to comply with applicable rules, Petitioner in its Motion attempts to excuse itself by arguing that these documents were produced during previous litigation. *See* Paper 47 at 4-5. But this does not excuse Petitioner from serving Patent Owner's counsel with the inconsistent evidence in the present *inter partes* review proceeding. *See* C.F.R. § 42.51(b)(1)(iii) "a party must serve relevant information that is inconsistent ... concurrent with the filing."; *see also* 37 C.F.R. §§ 42.6(e) (3) noting that "[i]f a party is represented by counsel of record in the proceeding, service must be on counsel." If Petitioner had properly served Patent Owner's counsel as required by the rules, such service would have been reflected in Petitioner's exhibit list. *See* 37 C.F.R. §§ 42.63(e) noting that "[e]ach party must maintain an exhibit list with the exhibit number and a brief description of each exhibit. If the exhibit is not filed, the exhibit list should note that fact." Petitioner's exhibit list does not note that these translations were served. Given that Petitioner had "a duty of candor and good faith to the Office" under 37 C.F.R. §§ 42.11, Petitioner should have put Patent Owner's counsel and the Board on notice that it had obtained different translations specifically for the purposes of the present proceeding. It failed to do so. Therefore, Petitioner is not excused from failing to comply with applicable rules.

Petitioner in its Motion also fails to provide any explanation as to why it was necessary to change its position and obtain different translations of Kawakita and Asahi for the purposes of the present *inter partes* review proceeding. The Trial

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