

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION,
Petitioner,

v.

FUJIFILM CORPORATION,
Patent Owner.

Case IPR2018-00876 (Patent 6,462,905 B1)
Case IPR2018-00877 (Patent 6,462,905 B1)¹

Before SALLY C. MEDLEY, GREGG I. ANDERSON, and
SHEILA F. McSHANE, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

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

¹ The parties are not authorized to use this caption. The parties will continue to use the individual case captions.

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INTRODUCTION

In an email dated March 29, 2019, Fuji Corporation (“Patent Owner”) requested a conference call for authorization to file a motion under 37 C.F.R. § 42.123 to submit supplemental information in the above identified proceedings, IPR No. 2018-00876 (“’876 IPR”) and IPR No. 2018-00877 (“’877 IPR”). On April 1, 2019, a conference call was held with counsel for Patent Owner, Sony Corporation (“Petitioner”), and Judges Medley, Anderson, and McShane participating.

In the March 29 email and confirmed during the conference call, the supplemental information Patent Owner seeks to file is a “corrected version of William Vanderheyden’s declaration (Ex. 2008) in both IPRs to include a sworn statement in accordance with 37 C.F.R. § 1.68, with no other changes.” As stated in the March 29 email, Petitioner confirmed during the call that it opposes the request.

BACKGROUND FACTS

The Vanderheyden declarations were filed as part of Patent Owner’s Response (’876 IPR, Paper 21; ’877 IPR, Paper 17). The Vanderheyden declarations are signed and dated but do not include an oath or declaration. *See* Ex. 2008 ¶ 283, signature block. Patent Owner states the omission was inadvertent, i.e., a mistake. Petitioner does not contest that a mistake was made. Petitioner is not aware of any other reason or bad faith associated with the omission.

Petitioner first raised the issue in its Reply filed on March 27, 2019, in both IPRs, two days prior to the March 29 email. Both Replies include the same argument with slight differences in wording. The argument from the ’876 IPR is set out below in its entirety.

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Exhibit 2008 fails to meet the requirements of either 37 C.F.R. § 1.68 and 28 U.S.C. § 1746. Ex-2008 ¶¶282-283. The Board affords such “declarations” no weight because they lack necessary safeguards to ensure credibility. *ZTE (USA) Inc. v. Evolved Wireless LLC*, IPR2016-00757, 2017 WL 6206107, *10 (P.T.A.B. Nov. 30, 2017); *Int’l Bus. Machines Corp. v. Intellectual Ventures II LLC*, IPR2015-01323, Paper 38, 9-12 (P.T.A.B. Sept. 27, 2015).

’876 IPR, Paper 25, 26; *see also* ’877 IPR, Paper 21, 26 (same argument with different wording).

DISCUSSION

The policy behind our rules for *inter partes* review is “to secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1 (b). It is incumbent on the parties to “act with courtesy and decorum in all proceedings before the Board, including in interactions with other parties.” 37 C.F.R. § 42.1 (c).

The circumstances which bring this dispute to us are not exemplary of the policies which govern these proceedings. Dr. Vanderhayden’s deposition was taken on February 27, 2019, a month before Petitioner’s Replies were filed. *See* ’876 and ’877 IPR, Ex. 1037. Dr. Vanderhayden’s testimony was taken under oath (Ex. 1037, 4:1–4) and he was subjected to cross-examination regarding his original declaration. During the conference call, Petitioner suggested that only those portions of Dr. Vanderhayden’s original declaration (Ex. 2008) covered in the deposition could be considered. Such a piecemeal approach is unworkable, unnecessary, and inconsistent with the argument in the Reply. That Dr. Vanderhayden’s testimony was taken removes any doubt concerning affording weight to his original statement.

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Petitioner, however, chose to wait to raise the issue that is now before us in its Reply. Neither did Petitioner object to the evidence, as was done in one of the cases it cites. *See International Business Machines*, Paper 38, 9.

The absence of an oath or declaration is not so trivial, however, as to be unnecessary. Testimonial evidence usually requires an oath or declaration as provided by our rules and statute. *See* 37 C.F.R. § 1.68; 28 U.S.C. § 1746. We also expect the parties to follow the rules and procedures under which *inter partes* review is conducted.

Nonetheless, unintentional, easily and quickly corrected mistakes are not a basis for what is essentially a request to exclude the Vanderhayden declarations by giving them no weight as requested in the Reply. The prejudice to Patent Owner would significantly outweigh any perceived prejudice Petitioner believes it has suffered. Patent Owner is able to timely correct the omission and we are presented with no reason not to permit it to do so.

The *ZTE* and *International Business Machines* cases cited by Petitioner are consistent with our decision. Neither case supports Petitioner's position. *ZTE* is similar to this case in that Petitioner raised the issue in its reply, giving Patent Owner notice. *ZTE*, Paper 42, 24. Despite notice, "Patent Owner took no affirmative steps to cure the defect." *Id.* *International Business Machines* related to evidence where Patent Owner timely served objections to a declaration and Petitioner did not serve supplemental evidence in response to Patent Owner's objections. *International Business Machines*, Paper 38, 9. Unlike *ZTE* or *International Business Machines*, Patent Owner here acted immediately upon notice of the omission.

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Patent Owner seeks relief pursuant to 37 C.F.R. § 42.123. The rule provides a party must file a motion to submit supplemental information and, if more than one month after institution of trial, as is the case here, the following showing is required.

(b) *Late submission of supplemental information.* A party seeking to submit supplemental information more than one month after the date the trial is instituted, must request authorization to file a motion to submit the information. The motion to submit supplemental information must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice.

37 C.F.R. § 42.123(b). Although under these facts Patent Owner could make the required showing under Rule 123, to require it to do so would unnecessarily add expense and time for the parties, requiring additional Board resources.

Based on the facts before us, Patent Owner will be given ten business days from the date of the conference or April 1, 2019, to serve and file supplemental information in the form of a corrected Vanderhayden declaration. The same exhibit number should be used and the original declaration will be expunged.

ORDER

It is accordingly

ORDERED that Patent Owner will be given ten business days from the date of the conference or until April 15, 2019, to serve and file supplemental information in the form of a corrected Vanderhayden declaration Exhibit 2008;

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