

Paper No. ____

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION
Petitioner,

v.

FUJIFILM CORPORATION
Patent Owner.

Case No. IPR2018-00876
Patent No. 6,462,905 B1

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

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Patent Owner Fujifilm Corporation (“Fujifilm”) seeks to exclude evidence Sony introduced with its Reply (Paper No. 25) to refute arguments Fujifilm made in its Patent Owner Response (Paper No. 21). The lone piece of evidence Fujifilm seeks to exclude—Exhibit 1034 (“the ECMA 319 Standard”)—is relevant to this proceeding, and Fujifilm has not met its burden of proving it is entitled to the extraordinary exclusionary relief it seeks. 37 C.F.R. § 42.20(c).

I. THE ECMA 319 STANDARD IS RELEVANT, NOT PREJUDICIAL AND WAS TIMELY SERVED

A. The ECMA 319 Standard Is Relevant

In its POR, Fujifilm argued that “the McAllister-I figures (including Figure 2A) fail to show any clearance between the disclosed locking gear and reel hub.” POR at 23. In his reply declaration, Mr. von Alten explained that such an interpretation of the McAllister-I figures was impractical because clearance necessarily exists between the locking gear and reel hub to permit the hub to rotate around the locking gear. Ex. 1033 ¶¶ 9, 11 (cited in Paper No. 25 (“Reply”) at 3).

Among other evidence that Mr. von Alten cited to support his opinion was Exhibit 1034—the ECMA 319 Standard. Ex. 1033 ¶ 16. As Mr. von Alten explained, the ECMA 319 Standard was “the standard that the LTO consortium prepared in the late 1990s and published in 2001.” *Id.* Because Fujifilm concedes McAllister-I depicts an “LTO-type” cartridge (POR at 13), the original standardized design of such a cartridge is highly relevant to understanding how a

POSA would have interpreted McAllister-I. Unsurprising, as Mr. von Alten demonstrated, the ECMA 319 Standard “clearly shows” that clearance between an LTO cartridge’s locking gear and reel hub was a standard design. Ex. 1033 ¶ 16.

Fujifilm also argued that the initial LTO cartridge design “included *tight fitting* male and female interlocking structures” such that the LTO consortium “assumed that the braking member would be limited to a one-dimensional movement parallel to the axis of rotation of the reel, without the potential for misalignment.” POR at 10 (emphasis added). Fujifilm then argued that because the cartridge depicted in McAllister-I was an LTO cartridge, a POSA would have interpreted McAllister-I’s figures to depict a “tight fit” between its male and female interlocking structures that eliminated any “clearance” between the structures that would otherwise have caused brake misalignment. POR at 25.

The ECMA 319 Standard—which describes the “initial LTO cartridge design” Fujifilm references—directly refutes Fujifilm’s argument. *See* Ex. 1033 ¶ ¶ 24 (describing the ECMA 319 Standard as “the published standard for the first generation of LTO cartridges”). As Mr. von Alten explained, the ECMA 319 Standard demonstrates that the “LTO consortium absolutely recognized that the mating components that connect the braking member to the cartridge shell would have clearances, and even specified the maximum effect of those clearances.” Ex. 1033 ¶ 24. For example, as Mr. von Alten explained, the standard permits the

cartridge reel to rotate and/or be displaced relative to its center by certain amounts and clearance between the mating structures is a cause of such permitted rotation and/or displacement. Ex. 1033 ¶¶ 24-26.

As it directly refutes arguments Fujifilm presented in its POR, the ECMA 319 Standard is relevant and admissible. Fed. R. Evid. 403 (“Evidence is relevant if: (a) it has a tendency to make a fact more or less probable than it would be without the evidence; and (b) the fact is of consequence in determining the action.”). That the ECMA 319 Standard is not prior art because it did not publish until 2001¹ does not make the exhibit inadmissible. *Yeda Research v. Mylan Pharms.*, 906 F.3d 1031, 1041 (Fed. Cir. 2018) (“Based on the statutory scheme, the PTO’s own regulations, and prior Board decisions, the Board can rely on evidence other than just prior art.”); *Dominion Dealer Sols., LLC v. AutoAlert, Inc.*, IPR2014-00684, 2014 WL 5035359, at *5 (P.T.A.B. Oct. 6, 2014) (non-prior art references properly relied on to demonstrate “how one with ordinary skill in the art would have understood a prior art disclosure”). At best, its non-prior art status goes to the weight the Board affords the evidence, not its admissibility. *Incyte Corp. v. Concert Pharrms., Inc.*, IPR2017-01256, Paper No. 119 at 41 (P.T.A.B.

¹ It was, however, being prepared in the late 1990s, i.e., contemporaneous with the ’905 Patent and McAllister-I. Ex. 1033 ¶ 16. *See also* POR at 8 (“Linear Tape Open (‘LTO’) is a type of magnetic tape cartridge developed in the late 1990s.”).

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