Paper No. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Sony Corporation
Petitioner

v.

FUJIFILM Corporation
Patent Owner

Case IPR2018-00876
U.S. Patent No. 6,462,905

REPLY TO OPPOSITION TO MOTION TO EXCLUDE

I. INTRODUCTION

In Petitioner's Reply, Petitioner submitted for the first time Exhibit 1034 (ECMA-319) in an attempt to fill gaps it recognized in the prior art. Petitioner's submission of Exhibit 1034 is irrelevant, untimely and prejudicial. Further, Petitioner never cited to Exhibit 1034 in its Petitioner's Reply (or Petition), and instead, Petitioner tries to circumvent the rules by incorporating by reference the alleged teachings of Exhibit 1034 into its Reply.

II. APPLICABLE LAW

Generally the Board follows the Federal Rules of Evidence (FRE). *See* 37 C.F.R. § 42.62. FRE 402 and 403 provide that irrelevant evidence is not admissible and that even if evidence is relevant, it may be excluded if its probative value would be substantially outweighed by the danger of unfair prejudice and confusion of the relevant issues that it presents. Fed. R. Evid. 402, 403. Further, several regulations are also in place to ensure the Petition sets forth the grounds of unpatentability and evidence is not incorporated by reference. 37 C.F.R. § 42.22 ("each petition …. must include … a detailed explanation of the significance of the evidence..."); § 42.6(a)(3) ("Arguments must not be incorporated by reference from one document into another document.").

III. EXHIBIT 1034 SHOULD BE EXCLUDED

A. Patent Owner Did Not Waive Its Objection to Exhibit 1034

Petitioner argues that Patent Owner waived its right to exclude Exhibit 1034 as being untimely and outside the scope. Petitioner's Opposition to Patent Owner's Motion (Paper No. 34) ("Opposition") at 5. This is simply not true. In Patent Owner's Objections to Petitioner's Reply, Patent Owner specifically objected to Exhibit 1034 as not being "relied upon by Petitioner in any Ground of its inter partes review Petition." *See* Paper No. 27 at 3. Accordingly, Patent Owner has not "waived its right to seek exclusion" of Exhibit 1034.

B. Exhibit 1034 Is Unfairly Prejudicial As It Is Admittedly Not Prior Art But Used By Petitioner to Fill in the Gaps of McAllister-I

Further, Petitioner's Opposition highlights the prejudicial nature of Exhibit 1034. As Petitioner admits in its Opposition, Petitioner's expert relies on Exhibit 1034 to show the alleged specification that the "LTO consortium prepared in the late 1990s." Opposition at 1. Petitioner further argues that "the original standardized design" is "highly relevant" to show how a POSA would have interpreted the prior art. *See* Opposition at 1-2. Moreover, Petitioner goes one step further and argues that since Exhibit 1034 allegedly discloses clearances, the prior art on which Petitioner relies does as well.

However, Petitioner does not dispute that Exhibit 1034 postdates the '905 patent and is not prior art. Further, Petitioner has not provided any support for a relationship between the disclosure of Exhibit 1034 and the prior art. Any alleged

clearance shown in Exhibit 1034 does not show or imply clearance in the prior art. Petitioner's reliance on Exhibit 1034, to imply features in the prior art and its purported teaching of a motivation to combine the prior art, is prejudicial.

Accordingly, since Exhibit 1034 is not prior art but Petitioner relies on Exhibit 1034 to imply features in the prior art, Exhibit 1034 is confusing and unfairly prejudicial.

C. Petitioner Concedes Exhibit 1034 Is Not Cited In Its Reply, But Attempts to Improperly Incorporate Its Teachings By Reference

In opposition, Petitioner concedes that Exhibit 1034 is "not expressly cited" in its Reply, and Exhibit 1034 is also not cited in the Petition. *See* Opposition at 5. However, Petitioner argues that Mr. von Alten's testimony which discusses Exhibit 1034 is cited in its Reply, and thus, Petitioner incorporates the teachings of Exhibit 1034 by reference. However, 37 CFR § 42.6(a)(3) expressly notes that "[a]rguments must ***not*** be incorporated by reference from one document into another document."

Petitioner cites to *Cellco Partnership d/b/a Verizon Wireless v. Bridge and Post, Inc.*, IPR2018-00054, Paper No. 40 at 75 (P.T.A.B. Apr. 15, 2019). Opposition at 6. However, in *Cellco*, Petitioner relied on the cited references not to meet a claim limitation, but instead to show the state of the art at the time of the invention. *Id.* at 73-75. In addition, the cited references in *Cellco* predate the challenged patent. *See Id.* (Patent Owner filed a motion to exclude Exhibits 1012, 1020, 1021, 1028, and 1031, all of which predate the March 2007 priority date of the challenged patent).

In this case, Petitioner relies on postdated Exhibit 1034 to imply features into the prior art. Specifically, Petitioner relies on Exhibit 1034 for its motivation to combine the prior art. Indeed, Petitioner argues that Exhibit 1034 implies a "requirement for operational clearance" in the prior art, and thus, a person of ordinary skill in the art would allegedly add guide members to prevent misalignment or tilting of the locking gear. *See* Ex. 1033 (von Alten Declaration) at 14. Thus, Petitioner relies on Exhibit 1034 for more than a showing of the state of the art, and cannot improperly incorporate postdated Exhibit 1034 and related arguments by reference. Accordingly, Exhibit 1034 should be excluded from the record.

IV. CONCLUSION

Because Exhibit 1034 cannot support Petitioner's grounds submitted in the Petition, Exhibit 1034 is irrelevant under FRE 401-402. Further, since Exhibit 1034 is not prior art, and Petitioner is using it to imply that certain features existed in the prior art, Exhibit 1034 is unduly prejudicial under FRE 403.

June 4, 2019

Respectfully,

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