

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

Record of Oral Hearing
Held: June 21, 2019

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

Case IPR2018-00876
Patent 6,462,905 B1

APPEARANCES:

ON BEHALF OF THE PETITIONER:

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The above-entitled matter came on for hearing on Friday, June 21, 2019, commencing at 1:00 p.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia.

PROCEEDINGS

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MS. SMITH: All rise.

JUDGE MEDLEY: Please be seated. Give me a moment here to get set up. Okay. Good afternoon. This is the hearing for IPR2018-00876, Sony Corporation v. Fujifilm Corporation involving U.S. Patent No. 6,462,905. At this time, we'd like the parties to please enter as counsel for the record, beginning with the Petitioner.

MR. SPEED: Good afternoon, Your Honors. Nathan Speed on behalf of Petitioner from Wolf Greenfield & Sacks, and joining me is lead counsel Richard Giunta also from Wolf Greenfield & Sacks.

JUDGE MEDLEY: Okay; thank you; and for Patent Owner?

MR. WILLIAMS: Good afternoon, Your Honor. Eliot Williams of Baker Botts for the Patent Owner; and with me today is Margaret Welsh also with Baker Botts.

JUDGE MEDLEY: Thank you. Each party has 45 minutes, total time, to present arguments. Petitioner, you'll proceed first to present your case with respect to the challenged claims and grounds for which the Board instituted a trial and may reserve of your argument time to respond to arguments presented by Patent Owner. Thereafter, Patent Owner will respond to Petitioner's presentation and may reserve argument time for sur-rebuttal. Are there any questions as to the order of presentations?

MR. WILLIAMS: No, Your Honor. I'm (inaudible).

JUDGE MEDLEY: Okay. Petitioner, would you like to reserve rebuttal time?

MR. SPEED: I'd like to reserve five minutes for this trial.

1 JUDGE MEDLEY: Five minutes? Okay. And Patent Owner, would
2 you like to reserve sur-rebuttal time?

3 MR. WILLIAMS: No; I don't intend to.

4 JUDGE MEDLEY: Okay. And just as a reminder, Judges Anderson
5 and McShane cannot see the demonstratives if you project them on the
6 screen. They can only see you at the podium. So, please refer to the slide
7 number that you're referring to so that they may follow along. Also, please
8 speak into the microphones that they may hear what you have to say. If you
9 speak from the table where you're sitting, they won't be able to hear you.
10 We would like to also remind the parties that this hearing is open to the
11 public, and the transcript will be entered into the public record of the
12 proceeding; and with that, we will get started. Petitioner, you may proceed.

13 MR. SPEED: Thank you, Your Honors. I'm on slide 2 to begin. In
14 this trial, we have five grounds that were instituted. The first three relate,
15 primarily, to the McAllister II as the primary reference; and grounds six and
16 seven relate to the Mizutani reference. There were grounds four and five in
17 our petition, but those are no longer relevant.

18 Turning to slide 3 and a very brief overview of the patent in this case,
19 the patent deals with a magnetic tape cartridge. Those have been around for
20 a long time, for decades. The particular design of a cartridge recited in the
21 '905 Patent relates to the linear tape open design or LTO design. There's no
22 dispute that the LTO design was known in the art at the time of the filing of
23 this patent.

24 On slide 3, I have annotated images from the petition at 11 through
25 13, and you can see these conventional elements which are a red casing; a
26 green reel, it has flanges that would house the tape; and a circular hub that

1 spins when it's put into a tape drive. Inside that hub is a yellow -- what
2 we've highlighted in yellow -- a braking gear that moves up and down; and
3 when it's down as it's shown in figure 1, it's engaged with an engagement
4 gear on the reel that also rotates with the reel. So, the way this works is the
5 brake goes up and it frees the reel to rotate, and when you want to stop the
6 reel from rotating, the brake comes down and it engages the engagement
7 gear.

8 Now, how does it move up and down? That's shown in the third
9 image on slide 3 which is this release member; and this is kind of the aspect
10 of the LTO design that was invented at that time. The orange release
11 member is a triangular-shaped body with legs that stick down through holes
12 in the reel; and so, when this tape is inserted into a tape drive, teeth on the
13 drive engage those legs and push them up which, in turn, causes the brake
14 member to rise and, I believe, it's engaged state becomes disengaged and
15 allows the reel to rotate.

16 If we turn quickly to slide 4, we can see annotated images from the
17 petition at 13 to 14; and on the top left we have the McAllister II reference.
18 And as you can see in the annotated drawing, all of those conventional
19 elements, including -- what I forgot to mention -- was like an urging
20 member, which is a spring that pushes the brake down. All those elements
21 were known in the art, as shown in the McAllister I reference; and there's no
22 dispute that the McAllister I reference discloses each of a braking member;
23 an urging member; a releasing member; an engagement projection.

24 The problem in claim slide 5, the problem with the '905 Patent
25 purports to identify in the LTO design is explained at column 1, lines 53 to
26 column 2, line 8. The inventors purported to identify that the brake can

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