

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

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

ANDERSON, *Administrative Patent Judge*.

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

INTRODUCTION

On August 2, 2018, a telephone conference was held between Sony Corporation (“Petitioner”), FUJIFILM Corporation, Inc. (“Patent Owner”), and Judges Anderson and McShane. The conference was requested by Petitioner in an email dated July 30, 2018. Petitioner requests authorization to file a two-page Reply to address an argument regarding the broadest reasonable interpretation of the claim term “gear tooth” that Patent Owner raises in its Preliminary Response (Paper 8). The Petition (Paper 2) does not construe “gear tooth.”

DISCUSSION

Petitioner argues good cause exists for leave to file a Reply because Petitioner could not have reasonably anticipated that Patent Owner would propose a construction for “gear tooth” that was inconsistent with references cited during prosecution of the challenged patents, including references that the named inventors authored. In addition, Petitioner asserts the proposed construction is unreasonably narrow. Petitioner also argues a Reply would fully inform us of the reasons Petitioner believed Patent Owner’s position was inconsistent.

The Preliminary Response does not assert that the Petition is defective for failing to construe “gear tooth.” Patent Owner confirmed that position during the conference call.

We are not persuaded that these circumstances warrant additional briefing. Should we institute trial, Petitioner’s position can be further briefed during the normal course of trial.

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ORDER

It is accordingly,
ORDERED, Petitioner's request to file a Reply to Patent Owner's
proposed construction of "gear tooth" in the Preliminary Response is denied.

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