

UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION, )  
)  
Petitioner, ) IPR Nos. 2018-00876  
) 2018-00877  
v. )  
)  
FUJIFILM CORPORATION, )  
)  
Patent Owner. )  
\_\_\_\_\_ )

VIDEOTAPED DEPOSITION OF THOMAS VON ALTEN

Wednesday, December 12, 2018

Boise, Idaho

Reported By:

Andrea J. Couch, CSR, RDR, CRR, CRC

Job No. 23689

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1  
2  
3 The videotaped deposition of  
4 Thomas Von Alten was convened Wednesday,  
5 December 12, 2018, commencing at 8:04 a.m., held at:  
6  
7 Comfort Suites Airport  
8 2906 South Vista Avenue  
9 Boise, Idaho  
10  
11 before Andrea J. Couch, Certified Shorthand Reporter,  
12 Registered Diplomat Reporter, Certified Realtime Reporter,  
13 Certified Realtime Captioner, and Notary Public in and  
14 for the State of Idaho.  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25

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1 A P P E A R A N C E S:  
2  
3 For the Sony Petitioner:  
4 BY: NATHAN SPEED, ESQUIRE  
5 WOLF GREENFIELD & SACKS, P.C.  
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8 617-646-8283  
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10  
11 For the FUJIFILM Patent Owner:  
12 BY: KATHARINE BURKE, ESQUIRE  
13 BY: AARON RABINOWITZ, ESQUIRE  
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15 1299 Pennsylvania Avenue, Northwest  
16 Washington, D.C. 20004  
17 202-639-7751  
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20  
21 ALSO PRESENT:  
22 Chris Ennis, Videographer  
23  
24  
25

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Page 5

1 P R O C E E D I N G S  
2  
3 VIDEOPHOTOGRAPHER: Okay. So the camera  
4 is rolling and we are on the record.  
5 This is the video deposition of  
6 Thomas Von Alten in the matter of Sony  
7 versus FUJIFILM, IPR 2018-00876 and  
8 IPR 2018-00877. The deposition is being  
9 held at the Comfort Suites, 2906 South  
10 Vista Avenue in Boise, Idaho, on December  
11 12th, 2018, at approximately 8:04 a.m.  
12 My name is Chris Ennis. I am  
13 from the firm of TSL, and I am the legal  
14 video specialist. The court reporter is  
15 Andrea Couch in association with TSL.  
16 And will Counsel please  
17 introduce themselves.  
18 MS. BURKE: Katharine Burke from  
19 Baker Botts for FUJIFILM.  
20 MR. RABINOWITZ: Aaron Rabinowitz  
21 from Baker Botts for FUJIFILM.  
22 MR. SPEED: Nathan Speed from Wolf  
23 Greenfield & Sacks for petitioner, Sony.  
24 VIDEOGRAPHER: And if the court  
25 reporter will please swear the witness.

1 THOMAS VON ALTEN,  
 2 a witness having been first duly sworn to  
 3 tell the truth, the whole truth and nothing  
 4 but the truth, was examined and testified as  
 5 follows:

6 EXAMINATION

7 BY MS. BURKE:

8 Q. Good morning, sir. Can you  
 9 please state your name for the record.

10 A. Good morning. My name is  
 11 Thomas William Von Alten.

12 Q. And where do you reside?

13 A. Here in Boise, Idaho, at  
 14 2824 North Grandee Street.

15 Q. And we met at your deposition  
 16 in April in the ITC matter between Sony  
 17 and FUJIFILM, right?

18 A. We did. I thought it was May,  
 19 but --

20 Q. May.

21 Have you sat for any  
 22 depositions since that deposition in the  
 23 ITC matter between Sony and FUJIFILM?  
 24 A. I have not.

25

1 A. I do.

2 Q. Is that a declaration that  
 3 you've submitted in these proceedings?

4 A. It is.

5 Q. You understand that these  
 6 proceedings relate to inter partes review  
 7 proceedings at the United States Patent  
 8 and Trademark Office filed by Sony against  
 9 the 905 patent, correct?

10 A. I do.

11 Q. And you'll understand if I  
 12 refer to those inter partes review  
 13 proceedings as "IPRs" for purposes of this  
 14 deposition?

15 A. Yes, I will.

16 Q. And for the IPRs, you prepared  
 17 one declaration.

18 Is that correct?

19 A. Yes.

20 Q. And you understand that that  
 21 declaration has been filed in both IPRs.

22 Is that right?

23 A. I understand that, yes.

24 Q. Do you intend to perform any  
 25 additional work related to Sony's IPRs

1 Q. You understand you are under  
 2 oath today, the same as if you were in a  
 3 court of law, correct?

4 A. I do understand.

5 Q. Is there any reason you won't  
 6 be able to answer my questions fully and  
 7 truthfully?

8 A. There is not.

9 Q. All right. In front of you are  
 10 two exhibits that have been marked 1001  
 11 and 1004. Exhibit 1001 is U.S. Patent No.  
 12 6,462,905.

13 Do you see that?

14 A. I do.

15 Q. And you reviewed the 905 patent  
 16 for purposes of your declaration in this  
 17 matter?

18 A. I have.

19 Q. And you will understand if I  
 20 refer to Exhibit 1001 as "the 905 patent,"  
 21 correct?

22 A. I will.

23 Q. And then Exhibit 1004 is the  
 24 declaration of Thomas W. Von Alten.

25 Do you see that?

1 against the 905 patent after this  
 2 deposition?

3 A. I don't have any plans, but I  
 4 am responsive to Sony's counsel and their  
 5 requests.

6 Q. But as of today, you don't have  
 7 any plans to perform additional work  
 8 relating to the IPRs.

9 Is that correct?

10 A. That's correct.

11 Q. All right. I think you  
 12 discussed with my colleagues previously  
 13 that you started working at HP,  
 14 Hewlett-Packard, in 1983.

15 Is that correct?

16 A. Yes.

17 Q. And you'll understand if I  
 18 refer to Hewlett-Packard as "HP" for  
 19 purposes of this deposition?

20 A. I will.

21 Q. Prior to 1983, did you work on  
 22 magnetic tape cartridges at all?

23 A. I did not.

24 Q. And then at HP from 1983 to  
 25 1986, you worked on printed circuit

1 assemblies, correct?  
 2 A. Yes.  
 3 Q. Printed circuit assemblies are  
 4 different than magnetic tape drives,  
 5 correct?  
 6 A. Yes.  
 7 Q. You did not work on printed --  
 8 I'm sorry, magnetic tape drives from 1983  
 9 to 1986, correct?  
 10 A. I did not.  
 11 Q. And from 1986 to 1989, you  
 12 began working on disk drives at HP, right?  
 13 A. Yes.  
 14 Q. And you did not work on  
 15 magnetic tape drives from 1986 to 1989?  
 16 A. Not in their manufacture, no.  
 17 I was a user of them as a computer user in  
 18 high-end work stations, that sort of  
 19 thing, but --  
 20 Q. But for purposes of your job  
 21 responsibilities at HP, you did not have  
 22 responsibilities relating to magnetic tape  
 23 cartridges or drives, correct?  
 24 A. I did not.  
 25 Q. In 1989, you went to Stanford

1 A. I did not.  
 2 Q. So before 1996, you did not  
 3 have any work or education experience  
 4 relating to magnetic tape cartridges.  
 5 Is that fair?  
 6 A. Not specifically, but the  
 7 general background in mechanical  
 8 engineering, process engineering, and  
 9 design engineering all have applicability.  
 10 Q. Yeah, that wasn't my question.  
 11 My question was if you had any  
 12 work or education experience related to  
 13 magnetic tape cartridges.  
 14 A. No.  
 15 Q. You've heard of the IBM 3480  
 16 cartridge?  
 17 A. I have.  
 18 Q. You never worked at IBM,  
 19 correct?  
 20 A. I did not.  
 21 Q. You never worked on the  
 22 development of IBM 3480 cartridges,  
 23 correct?  
 24 A. I did not.  
 25 Q. You never worked on the design

1 to study manufacturing systems engineering  
 2 for a year.  
 3 Is that correct?  
 4 A. Yes.  
 5 Q. Did you study magnetic tape  
 6 cartridges at Stanford?  
 7 A. Not specifically, no.  
 8 Q. Did you study magnetic tape  
 9 drives at Stanford?  
 10 A. No.  
 11 Q. In 1990, you returned to HP.  
 12 Is that right?  
 13 A. Yes.  
 14 Q. And from 1990 to 1996, you  
 15 again worked on disk drive systems,  
 16 correct?  
 17 A. Yes. I was working in the  
 18 design lab for disk memory division.  
 19 Q. Okay. You did not work on  
 20 magnetic tape cartridges in the period  
 21 from 1990 to 1996, correct?  
 22 A. That's correct.  
 23 Q. And you did not work on  
 24 magnetic tape drives in the period  
 25 from 1990 to 1996?

1 of IBM 3480 cartridges, correct?  
 2 A. No.  
 3 Q. Okay. In 1996, you moved from  
 4 the disk memory division to a Computer  
 5 Peripheral Bristol division at HP,  
 6 correct?  
 7 A. Yes.  
 8 Q. And you worked at the Computer  
 9 Peripheral Bristol division for three  
 10 years.  
 11 Is that right?  
 12 A. Yes.  
 13 Q. And during that time from 1996  
 14 to 1999, you worked on magnetic tape  
 15 storage, correct?  
 16 A. I did, yes.  
 17 Q. Okay. And then in 1999, you  
 18 left computer peripherals and began to  
 19 work at HP Labs.  
 20 Is that right?  
 21 A. I worked on a project with  
 22 HP Labs. I was technically still an  
 23 employee here in Boise.  
 24 Q. Okay. Beginning in 1999, your  
 25 work with HP Labs did not relate to

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1 magnetic tape cartridges, correct?  
2 A. That's correct. I was still  
3 available for consultation with the  
4 previous project that I had been on.  
5 Q. But beginning in 1999, you had  
6 no further responsibilities relating to  
7 magnetic tape cartridges at HP, correct?  
8 A. That's correct.  
9 Q. And you did not, beginning in  
10 1999, have any further responsibilities  
11 relating to magnetic tape drives at HP,  
12 correct?  
13 A. Yes. I'd just make one  
14 correction there. Beginning in 1999 --  
15 My transition was in late 1999.  
16 So I was involved with tape drives from  
17 January through late summer/fall.  
18 Q. Okay. Understood.  
19 Beginning in late 1999, you did  
20 not have any further responsibilities  
21 relating to magnetic tape drives at HP,  
22 correct?  
23 A. One qualification. Sorry.  
24 There were a number of patents  
25 that had been applied for and were in

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1 process, and so I was still available and  
2 responsive to requests for completion of  
3 those patent applications.  
4 Q. Your work responsibilities  
5 beginning in late 1999 were not directed  
6 at magnetic tape drives?  
7 A. Not primarily, no.  
8 Q. Okay. Then in 2003, you  
9 decided to leave HP and become  
10 self-employed, correct?  
11 A. Yes.  
12 Q. And you've been self-employed  
13 since 2003.  
14 Is that right?  
15 A. Yes.  
16 Q. And in 2003, you left the field  
17 of tape cartridge --  
18 Well, let me start over.  
19 Since 2003, you've not had any  
20 work responsibilities relating to tape  
21 cartridges.  
22 Is that correct?  
23 A. That's correct.  
24 Q. And since 2003, you've not had  
25 any work responsibilities relating to tape

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1 drives.  
2 Is that correct?  
3 A. That's correct.  
4 Q. You've done nothing in the  
5 field of tape cartridge engineering since  
6 2003, correct?  
7 A. Not until I became involved in  
8 this case.  
9 Q. So prior to your involvement in  
10 this litigation --  
11 Let me --  
12 Setting aside your involvement  
13 in the litigation, you've had nothing --  
14 done nothing in the field of tape  
15 cartridge engineering since 2003, correct?  
16 A. That's correct.  
17 Q. So throughout your career, the  
18 only experience you've had -- work  
19 experience you've had related to magnetic  
20 tape cartridges came through your work on  
21 the tape storage project at HP from 1996  
22 through 1999.  
23 Is that right?  
24 A. Yes.  
25 Q. All right. If you could look

Page 17

1 at Exhibit 1004, your declaration, and  
2 turn to page 5, please.  
3 So page 5 sets forth Section 3,  
4 "Relevant Legal Standards."  
5 Do you see that?  
6 A. I do.  
7 Q. And Section 3 sets forth your  
8 full understanding of principles of  
9 anticipation and obviousness that you've  
10 applied in this matter, correct?  
11 A. Yes.  
12 Q. And you received your  
13 understanding from Sony's lawyers,  
14 correct?  
15 A. Yes.  
16 Q. You trusted that Sony's lawyers  
17 provided you full and complete  
18 descriptions of the applicable law of  
19 anticipation and obviousness, right?  
20 A. I did.  
21 Q. If a legal principle is not  
22 described in Section 3 of your  
23 declaration, you did not consider it,  
24 correct?  
25 MR. SPEED: Objection.

5 (Pages 14 to 17)

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