Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Sony Corporation
Petitioner

v.

FUJIFILM Corporation
Patent Owner

Case IPR2018-00877
U.S. Patent No. 6,462,905

PATENT OWNER'S MOTION TO EXCLUDE

I. INTRODUCTION

Patent Owner moves to exclude Exhibit 1034 (ECMA 319) under the Federal Rules of Evidence. Exhibit 1034 was submitted for the first time along with Petitioner's Reply, but was not cited in the Petition or Petitioner's Reply. 37 C.F.R. § 42.6(a)(3). Exhibit 1034 is not prior art and is irrelevant, prejudicial, and outside the proper scope of this proceeding. Patent Owner timely objected to this exhibit (Paper 23).

II. REASONS THE REQUESTED RELIEF SHOULD BE GRANTED

A. Federal Rules of Evidence

The Federal Rules of Evidence (FRE) apply to inter partes reviews. 37 C.F.R. § 42.62. FRE 401 and 402 provide that only relevant evidence is admissible. FRE 403 allows exclusion for evidence whose probative value is substantially outweighed by a danger of "unfair prejudice" or "confusing the issues."

B. Exhibit 1034 is Irrelevant, Prejudicial, and Untimely

As an initial matter, Petitioner does not cite Exhibit 1034 in its Petition or in Petitioner's Reply; the document is relied upon only by Petitioner's expert in his written testimony. It should be excluded from the record on that basis alone. *See* 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.").

Exhibit 1034 is a document entitled ECMA Standard 319, titled Data Interchange on 12,7 mm 384-Track Magnetic Tape Cartridges – Ultrium 1 Format. Mr. von Alten first cited to Exhibit 1034 in his "Reply Declaration" submitted with Petitioner's Reply. Mr. von Alten relied on this exhibit to allegedly show that "ECMA-319, the standard that the LTO consortium prepared in the late 1990s and published in 2001" illustrated clearance between the braking member and the inner surface of the hub. Ex. 1033 ¶16, n4. In addition, Mr. von Alten relied on Exhibit 1034 to show that the LTO consortium allegedly "absolutely recognized that the mating components that connect the braking member to the cartridge shell would have clearances." Ex. 1033 ¶24.

However, as Mr. von Alten admits, Exhibit 1034 was "published in 2001," and thus, postdates U.S. Patent No. 6,462,905 ("'905 Patent"). The '905 Patent has a priority date of November 8, 1999 and Exhibit 1034 was not published until June 2001. Thus, Exhibit 1034 is not prior art to the '905 Patent.

Further, Mr. von Alten appears to rely on Exhibit 1034 to show that since Exhibit 1034 allegedly discloses clearances, the prior art on which Petitioner relies does as well. However, Petitioner has not provided any support for a relationship

between the disclosure of Exhibit 1034 and the prior art, and any alleged clearance shown in Exhibit 1034 does not show or imply clearance in the prior art.

III. 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.

May 21, 2019

Respectfully,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on the 21st day of May 2019, a complete and entire copy of this Motion to Exclude Evidence was filed with the PTAB through its E2E system and served via email on attorneys of record for Sony at the following address:

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Respectfully submitted,
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