Trials@uspto.gov
571-272-7822

Paper 10
Entered: October 9, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION,
Petitioner,

v.

FUJIFILM CORPORATION,
Patent Owner.

Case IPR2018-00877
Patent 6,462,905 B1

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

ANDERSON, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

I. INTRODUCTION

Sony Corporation ("Petitioner")[1] filed a Petition (Paper 2, "Pet.") pursuant to 35 U.S.C. §§ 311–19 to institute an *inter partes* review of claims 1–4 ("challenged claims") of U.S. Patent No. 6,462,905 ("the '905 patent"), filed November 8, 2000.[2] Ex. 1001, [22]. The Petition is supported by the Declaration of Thomas W. von Alten ("von Alten Declaration," Ex. 1004). FUJIFILM Corporation ("Patent Owner") filed a Preliminary Response (Paper 6, "Prelim. Resp.").

We have authority under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). A final written decision under 35 U.S.C. § 318(a) must decide the patentability of all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S.Ct. 1348 (2018). At the institution phase, once it is determined that there is a reasonable likelihood that Petitioner will succeed on a single claim, review of all claims is justified. *Id.* at 1356. After considering the evidence and arguments presented in the Petition and Preliminary Response, we determine that Petitioner has demonstrated a reasonable likelihood of success in proving that at least claim 1 of the '905 patent is unpatentable. We therefore institute an *inter partes* review of all of the challenged claims.

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[1] The Petition identifies Sony Corporation of America, Sony Electronics Inc., Sony Storage Media Solutions Corporation, Sony Storage Media Manufacturing Corporation, Sony Latin America, Inc., and Sony Digital Audio Disc Corporation as additional real parties in interest. Pet. 6.

[2] The '905 patent lists two Japanese applications, JP 11-317166 and JP 11-318464, filed respectively November 8, 1999, and November 9, 1999. Ex. 1001, [30]. The Petition assumes the claims are entitled to the benefit of the foreign priority dates of the two Japanese applications. Pet. 8.

II. BACKGROUND

A. Related Proceedings

The parties advise us that the following litigation is pending and may be affected by this proceeding: (1) *Fujifilm Corp. v. Sony Corp.*, 1-17-cv-01309 (D. Del. 2017); and (2) *Certain Magnetic Data Storage Tapes and Cartridges Containing the Same*, 337-TA-1076 (USITC Sept. 19, 2017). Pet. 6; Paper 4, 2. Petitioner has filed a second petition for *inter partes* review of the '905 patent,[3] which also challenges claims 1–4. *Id.*

B. Technology and the '905 Patent

The '905 patent relates to a magnetic tape cartridge comprising a cartridge casing and a single reel about which magnetic tape is wound, all of which is maintained in a housing. Ex. 1001, 1:6–11. A reel stopper means prevents rotation of the reel when the magnetic tape cartridge is not being used. *Id.*

1. Technology

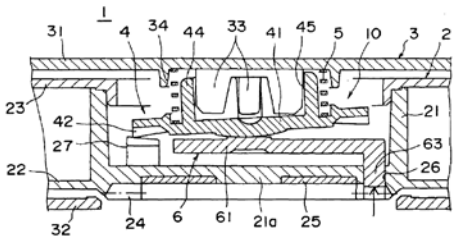
Magnetic tape cartridges (Fig. 5 below at 1) are used as a recording medium for external memory of a computer. Ex. 1001, 1:13–15. Magnetic tape is wound around a single reel (Fig. 5 below at 2) for rotation in a cartridge casing housing the reel. *Id.* at 1:15–17. The magnetic tape cartridge is provided with "a reel stopper means which prevents rotation of the reel when the magnetic tape cartridge is not being used," preventing tape jams or accidentally drawing out the tape. *Id.* at 1:20–24.

[3] Sony Corporation v. FUJIFILM Corporation, IPR2018-00876 ("'876 IPR"). Paper 4, 2.

A tape drive of an external memory of the computer rotates the reel when the magnetic tape cartridge is loaded in a tape drive. Ex. 1001, 25–31. A brake member of the reel stopper means engages and disengages the reel to prevent or permit rotation of the reel by the tape drive. *Id.* The brake member locks the reel so that the reel is not accidentally rotated or drawn out. *Id.* at 1:46–47. A release member "drives the brake member to release the reel in response to a reel chucking action" of the tape drive so the reel can be rotated and thus loaded and unloaded. *Id.* 1:47–51.

The prior art described above is illustrated in Figure 5 of the '905 patent. Ex. 1001, 1:58–61. Figure 5 is reproduced below.

FIG. 5



PRIOR ART

Figure 5 is a fragmentary cross-sectional view showing a magnetic tape cartridge where braking member 4 is inclined. Ex. 1001, 5:5–7, 5:52 (braking member 4). When release member 6 drives the brake member to release the reel, the brake member can be inclined. *Id.* at 5:57–59. The "gear teeth on the brake member can be brought into contact with the rear teeth on the reel while the reel is rotated." *Id.* at 1:61–63. This misalignment can cause "generation of noise, obstruction of rotation of the reel and unstable magnetic tape loading/unloading action." *Id.* at 1:63–65.

The prior art also experiences problems "when the braking gear and the engagement gear are engaged with each other at a substantially normal surface facing against the tape-unwinding direction." Ex. 1001, 2:17–20. Specifically, the magnetic tape may be cut when the reel is rotated in the tape-winding direction "due to drop impact when the magnetic tape cartridge drops." *Id.* at 2:15–16. Drop impact occurs when the brake member is moved and the braking gear is disengaged from the engagement gear. *Id.* at 2:25–29. Further, "[s]ince the reel cannot be rotated in the tape-unwinding direction or the direction in which the tension on the magnetic is released, the tape winding force acting on the magnetic tape can stretch the tape to deteriorate the magnetic recording" and reliability of the tape cartridge. *Id.* at 2:29–38.

2. '905 Patent (Ex. 1001)

The '905 patent purports to resolve the problems with the prior art by three different approaches reflected in the three independent claims. The first approach is a guide member, which is recited in claim 1. When the braking gear of the braking member is meshed with the engagement gear, "the outer periphery of the braking member 4 is guided by guide members 39 formed on the inner surface of the reel hub 21 of the reel 2." Ex. 1001, 6:26–30. The guide members help center the braking member, keeping it away from the inclined position shown in Figure 5. *Id.* at 9:61–63.

Figure 2 of the '905 patent is reproduced below.

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