

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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CANFIELD SCIENTIFIC, INC.,  
Petitioner,

v.

MELANOSCAN, LLC,  
Patent Owner.

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Case IPR: 2017-02125  
Patent No. 7,359,748

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**DECLARATION OF JULIANNE M. HARTZELL**

Canfield Scientific, Inc. - Exhibit 1048 Canfield Scientific, Inc. v. Melanoscan, LLC IPR2017-02125
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I, Julianne M. Hartzell, declare as follows:

1. I am a partner at the law firm of Marshall, Gerstein & Borun LLP and I am lead counsel for Petitioner Canfield Scientific, Inc. in this proceeding.

2. The Patent Owner in this proceeding cited to the declaration of its inventor, Dr. Rhett Drugge, in support of its Patent Owner Response. *See, e.g.*, Paper 23 at p. 3 citing Exhibit 2010.

3. I contacted Patent Owner to reach agreement on a date for Dr. Drugge's deposition, but Dr. Drugge was not able to appear during the scheduled cross-examination period, which was to end August 31, 2018. At Patent Owner's request, Petitioner agreed to an extension of time to accommodate Dr. Drugge's need to delay his deposition until September 20, 2018. The parties stipulated to an extension to file Petitioner's Reply until October 1, 2018.

4. Again at the Patent Owner's Request, the parties agreed to entry of the Default Protective Order on September 20, 2018. Following the deposition, I received the Patent Owner's confidentiality designations with respect to the deposition transcript on Friday September 28, 2018.

5. Late in the evening of October 1, 2018, I believed that I was ready to timely file Petitioner's Reply. As I finalized the word count certification, while the software stated that I had used approximately 5400 words, it became apparent to me that the word count software was not counting words contained in footnotes.

To comply with the word count limitation for a Reply, I realized that I needed to remove several hundred words from Petitioner's Reply. I spent approximately 25 minutes making the edits necessary to comply with the word count limitation.

6. As soon as I was within the word count limitation, I finalized the Reply. Because the Reply referenced portions of the deposition that had been designated confidential, I also needed to create both a redacted and confidential version of the brief.

7. I began filing the Reply and its supporting materials (including nine exhibits with confidential and redacted versions of two of those exhibits and a motion to seal) before midnight Eastern Time on October 1. I received filing receipts for these materials between 12:04 and 12:13 a.m. Eastern on October 2, 2018.

8. I then served these materials on the Patent Owner. Due to the size of the exhibits, I sent the materials in multiple emails to avoid potential size restrictions. The last email to Patent Owner was sent at 12:29 a.m. Eastern on October 2, 2018.

9. Petitioner's Reply provides citations to obviousness cases that correct misstatements of law made in the Patent Owner's Response. For example, Patent Owner's Response states that Petitioner improperly modifies one reference with "only certain features" of a second reference. Paper 23 at p. 12. Patent Owner

misstates the law of obviousness when it contends that such a modification is improper. Petitioner's reply identifies caselaw explaining that obviousness based on multiple references does not require the physical substitution of all elements of a second reference. Paper 35 at p. 9. Similarly, the Patent Owner argues that by identifying a preferred embodiment, one reference teaches away from the use of the other disclosed embodiments. Paper 23 at p. 49. Petitioner's Reply identifies cases explaining that the disclosure of a preferred embodiment does not teach away from a non-preferred embodiment. Paper 35 at p. 17.

10. Patent Owner's Response brief, while filed at 11:59 p.m. Eastern on the night that it was due, was served on Petitioner after midnight Eastern time. I received the email with the service copy of the Patent Owner's Response Brief at 12:14 a.m. Eastern. However, I did not believe that Petitioner experienced any prejudice resulting from the delay in service. I did not therefore consider any complaint necessary in view of the interests of justice served by a complete record.

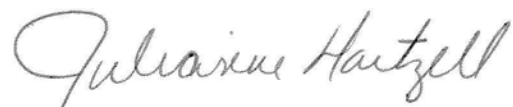
11. I contacted counsel for the Patent Owner on October 2, 2018, advising them that the filing had been inadvertently delayed, and asking if they would object to deeming the Reply to be timely filed. On October 3, 2018 at the Patent Owner's request, I provided a draft motion to deem the reply timely filed. I also asked that the Patent Owner identify any prejudice that it believes it has suffered as a result of the delay so that it could be addressed in the motion. Counsel for the

Patent Owner replied on October 5, 2018, stating that Patent Owner does not consent to the motion. After I left an additional voicemail asking for clarification regarding whether the Patent Owner believes it was prejudiced by the delay and offering to seek to remedy any such prejudice, counsel for the Patent Owner responded that the Patent Owner believes it is prejudiced but did not identify any specific prejudice.

12. Patent Owner served its Objections to Evidence cited in the Reply on October 10, 2018. Petitioner consents to any extension necessary to treat such objections as timely if the Reply is deemed filed on October 1, 2018.

13. All statements made herein are true to the best of my knowledge and all statements made on information and belief are believed to be true. I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct to the best of my knowledge.

Executed on October 12, 2018

A handwritten signature in cursive script, reading "Julianne Hartzell".

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Julianne M. Hartzell