

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CANFIELD SCIENTIFIC, INC.
Petitioner

v.

MELANOSCAN LLC
Patent Owner

Case No. IPR2017-002125
Patent 7,359,748

**PATENT OWNER'S OBJECTIONS UNDER 37 CFR § 42.64(b)(1)
TO EVIDENCE SUBMITTED IN CONNECTION WITH PETITION**

Pursuant to 37 CFR § 42.64(b)(1), Patent Owner Melanoscan LLC objects to evidence submitted in Petitioner Canfield Scientific, Inc.'s Corrected Petition filed on November 27, 2017 (Paper 9) as follows:

Exhibit	Objection(s)
Ex. 1003	<ol style="list-style-type: none"><li data-bbox="410 541 1427 1014">1. Lack of relevance under FRE 401-402. Exhibit 1003 does not support the propositions for which it is cited and thus any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403. <i>See</i> Ex. 1016, Muller Decl. at ¶¶ 111, 113, 126, 153, 235, 346, 376, <i>infra</i>.<li data-bbox="410 1056 1427 1434">2. Hearsay without exception under FRE 801-803. The statements in the Exhibit were not made while the declarant(s) were testifying in this trial and are offered by Petitioner to prove the truth of the matter asserted, and not subject to any of the exceptions in FRE 802 or 803.
Ex. 1004	<ol style="list-style-type: none"><li data-bbox="410 1486 1427 1854">1. Lack of authentication under FRE 901-902. Exhibit 1004 contains no date of publication, and therefore is not sufficiently authenticated, including as being prior art. In view thereof, Exhibit 1004 lacks relevance under FRE 401-402, and any probative value is substantially outweighed by a danger of

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	<p>unfair prejudice and/or confusing the issues under FRE 403.</p> <p>2. Lack of relevance under FRE 401-402. Exhibit 1004 does not support the propositions for which it is cited and thus any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403. <i>See</i> Ex. 1016, Muller Decl. at ¶¶ 90, 91, 118, 126, 137, 146, 218, 219, 245, 246, 248, 251 (<i>infra</i>).</p> <p>3. Hearsay without exception under FRE 801-803. The statements in the Exhibit were not made while the declarant(s) were testifying in this trial and are offered by Petitioner to prove the truth of the matter asserted, and not subject to any of the exceptions in FRE 802 or 803.</p>
Ex. 1005	<p>1. Lack of relevance under FRE 401-402. Exhibit 1005 does not support the proposition for which it is cited, and thus any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403. <i>See</i> Ex. 1016, Muller Decl. at ¶¶ 119, 121, 143, 225, 299, 300.</p> <p>2. Hearsay without exception under FRE 801-803. The statements in the Exhibit were not made while the declarant(s) were</p>

Exhibit	Objection(s)
	<p>testifying in this trial and are offered by Petitioner to prove the truth of the matter asserted, and not subject to any of the exceptions in FRE 802 or 803.</p>
Ex. 1008	<ol style="list-style-type: none"> 1. Lack of relevance under FRE 401-402. IPR was not instituted on any ground involving this Exhibit. Thus, any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403. 2. Lack of authentication under FRE 901-902. The purported date of publication on the document does not appear to have been included on the document at the time of publication. Therefore, it not sufficiently authenticated, including as prior art. In view thereof, Exhibit 1008 lacks relevance under FRE 401-402 for this additional reason, and any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403. 3. Hearsay without exception under FRE 801-803. The statements in the Exhibit were not made while the declarant(s) were testifying in this trial and are offered by Petitioner to prove the truth of the matter asserted, and not subject to any of the

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	exceptions in FRE 802 or 803.
Ex. 1009	<ol style="list-style-type: none"> <li data-bbox="407 373 1427 667">1. Lack of relevance under FRE 401-402. IPR was not instituted on any ground involving this Exhibit. Thus, any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403. <li data-bbox="407 709 1427 1087">2. Hearsay without exception under FRE 801-803. The statements in the Exhibit were not made while the declarant(s) were testifying in this trial and are offered by Petitioner to prove the truth of the matter asserted, and not subject to any of the exceptions in FRE 802 or 803.
Ex. 1011	<ol style="list-style-type: none"> <li data-bbox="407 1140 1427 1434">1. Lack of relevance under FRE 401-402. IPR was not instituted on any ground involving this Exhibit. Thus, any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403. <li data-bbox="407 1476 1427 1854">2. Hearsay without exception under FRE 801-803. The statements in the Exhibit were not made while the declarant(s) were testifying in this trial and are offered by Petitioner to prove the truth of the matter asserted, and not subject to any of the exceptions in FRE 802 or 803.

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Ex. 1012	<ol style="list-style-type: none"> 1. Lack of relevance under FRE 401-402. IPR was not instituted on any ground involving this Exhibit. Thus, any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403. 2. Hearsay without exception under FRE 801-803. The statements in the Exhibit were not made while the declarant(s) were testifying in this trial and are offered by Petitioner to prove the truth of the matter asserted, and not subject to any of the exceptions in FRE 802 or 803.
Ex. 1013	<ol style="list-style-type: none"> 1. Lack of relevance under FRE 401-402. IPR was not instituted on any ground involving this Exhibit. Thus, any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403. 2. Hearsay without exception under FRE 801-803. The statements in the Exhibit were not made while the declarant(s) were testifying in this trial and are offered by Petitioner to prove the truth of the matter asserted, and not subject to any of the exceptions in FRE 802 or 803.
Ex. 1014	<ol style="list-style-type: none"> 1. Lack of relevance under FRE 401-402. IPR was not instituted

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	<p>on any ground involving this Exhibit. Further, Exhibit 1014 does not support the proposition for which it is cited. <i>See</i> Ex. 1016, Muller Decl. at 99 (<i>infra</i>). Thus, any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403.</p> <p>2. Hearsay without exception under FRE 801-803. The statements in the Exhibit were not made while the declarant(s) were testifying in this trial and are offered by Petitioner to prove the truth of the matter asserted, and not subject to any of the exceptions in FRE 802 or 803.</p>
Ex. 1015	<p>1. Lack of relevance under FRE 401-402. IPR was not instituted on any ground involving this Exhibit. Thus, any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403.</p> <p>2. Hearsay without exception under FRE 801-803. The statements in the Exhibit were not made while the declarant(s) were testifying in this trial and are offered by Petitioner to prove the truth of the matter asserted, and not subject to any of the exceptions in FRE 802 or 803.</p>

Exhibit	Objection(s)
Ex. 1016	<p>The following portions of Dr. Muller’s Declaration should be stricken for at least the reasons summarized below. <i>See also</i> objections to Exhibits 1003-1009 and 1011-1015 above.</p> <ol style="list-style-type: none"> 1. Paragraph 44 – The second sentence of this paragraph is not based on sufficient facts or data, does not involve the reliable application of the pertinent principles and methods to the facts of this matter, and is unintelligible and will not help the trier of fact to understand the evidence or to determine a fact in issue. 2. Paragraph 46 – The last three sentences of this paragraph are not based on sufficient facts or data, do not involve the reliable application of the pertinent principles and methods to the facts of this matter, including, but not limited to, that they are not adequately supported by the ‘748 patent and its file history, and will not help the trier of fact to understand the evidence or to determine a fact in issue. 3. Paragraph 50 – Dr. Muller’s claim construction is not based on sufficient facts or data, does not involve the reliable application of the pertinent principles and methods to the facts of this matter, including, but not limited to, that it is not adequately

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	<p>supported by the '748 patent and its file history, and will not help the trier of fact to understand the evidence or to determine a fact in issue.</p> <p>4. Paragraph 56 – Dr. Muller’s claim construction is not based on sufficient facts or data, does not involve the reliable application of the pertinent principles and methods to the facts of this matter, including, but not limited to, that it is not adequately supported by the '748 patent and its file history, and will not help the trier of fact to understand the evidence or to determine a fact in issue.</p> <p>5. Paragraph 90 – The first two sentences and last sentence are not based on sufficient facts or data, as they are not adequately supported by Exhibit 1004, do not involve the reliable application of the pertinent principles and methods to the facts of this matter, and will not help the trier of fact to understand the evidence or to determine a fact in issue.</p> <p>6. Paragraph 91 – Dr. Muller’s statements are not based on sufficient facts or data, as they are not adequately supported by Exhibit 1004, do not involve the reliable application of the</p>

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	<p>pertinent principles and methods to the facts of this matter, and will not help the trier of fact to understand the evidence or to determine a fact in issue.</p> <p>7. Paragraph 99 – The statements in this paragraph are and/or are based on hearsay contained in Exhibit 1014 (<i>see</i> objections to Exhibit 1014 above) and are not the kinds of facts or data experts in the field of the ‘748 patent would reasonably rely on in forming an opinion on the subject in compliance with FRE 703. Therefore, Dr. Muller’s statements are not based on sufficient facts or data, do not involve the reliable application of the pertinent principles and methods to the facts of this matter, and will not help the trier of fact to understand the evidence or to determine a fact in issue.</p> <p>8. Paragraph 111 - The second to last sentence is not based on sufficient facts or data, as they are not adequately supported by Exhibit 1003, does not involve the reliable application of the pertinent principles and methods to the facts of this matter, and will not help the trier of fact to understand the evidence or to determine a fact in issue.</p>

Exhibit	Objection(s)
	<p>9. Paragraph 113 – Dr. Muller’s statement that Exhibit 1003 “demonstrates that . . . measurements of such lesions were . . . calculable using the focal length and resolution of the camera and distance from the imaging position” is not based on sufficient facts or data, as it is not adequately supported by Exhibit 1003, does not involve the reliable application of the pertinent principles and methods to the facts of this matter, and will not help the trier of fact to understand the evidence or to determine a fact in issue.</p> <p>10. Paragraph 118 – Dr. Muller’s statement that Exhibit 1004 was published on July 7, 1997 is not adequately supported by the exhibit, as it is undated (<i>see</i> objections to Exhibit 1004). Therefore, this statement is not based on sufficient facts or data, and will not help the trier of fact to understand the evidence or to determine a fact in issue.</p> <p>11. Paragraph 119 – Dr. Muller’s contention that Exhibit 1005 “surveyed . . . imaging devices including that described in [Exhibit 1004]” is not based on sufficient facts or data, as it is not adequately supported by Exhibit 1005, does not involve the</p>

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	<p>reliable application of the pertinent principles and methods to the facts of this matter, and will not help the trier of fact to understand the evidence or to determine a fact in issue.</p> <p>12. Paragraph 121 - Dr. Muller’s statement that “Daanen [Exhibit 1005] also notes, the use of steady mounted cameras in Hurley [Exhibit 1004] provide additional advantages over systems having moveable cameras, such as Voigt . . .” is not based on sufficient facts or data, as it is not adequately supported by Exhibit 1005, does not involve the reliable application of the pertinent principles and methods to the facts of this matter, and will not help the trier of fact to understand the evidence or to determine a fact in issue.</p> <p>13. Paragraph 126 – The second sentence is not based on sufficient facts or data, as they are not adequately supported by Exhibit 1004, does not involve the reliable application of the pertinent principles and methods to the facts of this matter, and will not help the trier of fact to understand the evidence or to determine a fact in issue.</p> <p>14. Paragraph 136 – In the last sentence, Dr. Muller has not reliably</p>

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	<p>applied the pertinent principles and methods to the facts of this matter because the claim construction used by Dr. Muller is incorrect and not adequately supported by the ‘748 patent and its file history. Additionally for these reasons, Dr. Muller’s statement is not relevant under FRE 401, and any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403, and as such will not help the trier of fact to understand the evidence or to determine a fact in issue.</p> <p>15. Paragraph 137 – The first sentence is not based on sufficient facts or data, as it is not adequately supported by Exhibit 1004, does not involve the reliable application of the pertinent principles and methods to the facts of this matter, and will not help the trier of fact to understand the evidence or to determine a fact in issue.</p> <p>16. Paragraph 143 - Dr. Muller’s contentions that “Daanen [Exhibit 1005] also notes, the use of steady mounted cameras in Hurley [Exhibit 1004] provide additional advantages over systems having moveable cameras, such as Voigt . . .” is not based on</p>

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	<p>sufficient facts or data, as it is not adequately supported by Exhibit 1005, does not involve the reliable application of the pertinent principles and methods to the facts of this matter, and will not help the trier of fact to understand the evidence or to determine a fact in issue.</p> <p>17. Paragraph 145 - Dr. Muller’s contentions that Exhibit 1004 discloses a specified imaging position and his definition of the centerline (“located on opposite sides of the centerline of the specified imaging position (defining the centerline as the frontal plane of the body dividing the person from side to side)” and “located on opposite sides of the centerline of the specified imaging position (defining the centerline as the sagittal plane of the body dividing the person from front to back)”) is not based on sufficient facts or data, as it is not adequately supported by Exhibit 1004, and utilizes an incorrect claim construction that is not adequately supported by the ‘748 patent and its file history. Dr. Muller has not has not reliably applied the pertinent principles and methods to the facts of this matter. Additionally for these reasons, Dr. Muller’s contentions are not relevant</p>

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	<p>under FRE 401, and any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403, and as such will not help the trier of fact to understand the evidence or to determine a fact in issue.</p> <p>18. Paragraph 153 – The second to last sentence, including Dr. Muller’s contention with respect to “using the resolution of the camera [in Exhibit 1003] and its focal length,” is not based on sufficient facts or data, as they are not adequately supported by Exhibit 1003, does not involve the reliable application of the pertinent principles and methods to the facts of this matter, and will not help the trier of fact to understand the evidence or to determine a fact in issue.</p> <p>19. Paragraph 155 – Dr. Muller’s contentions utilize an incorrect claim construction that is not adequately supported by the ‘748 patent and its file history. Dr. Muller has not has not reliably applied the pertinent principles and methods to the facts of this matter. Additionally for these reasons, Dr. Muller’s contentions are not relevant under FRE 401, and any probative value is substantially outweighed by a danger of unfair prejudice and/or</p>

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	<p>confusing the issues under FRE 403, and as such will not help the trier of fact to understand the evidence or to determine a fact in issue. This paragraph also is unintelligible to the extent it states “to measure as precisely as the patented invention features found in the captured images,” and therefore will not help the trier of fact to understand the evidence or to determine a fact in issue for this additional reason.</p> <p>20. Paragraph 213 - Dr. Muller’s claim construction as set forth in the first sentence and utilized in this paragraph to form the conclusion in the last sentence, is not based on sufficient facts or data and Dr. Muller has not reliably applied the pertinent principles and methods to the facts of this matter, including, but not limited to, that it is not adequately supported by the ‘748 patent and its file history.</p> <p>21. Paragraph 216 - In the last sentence, Dr. Muller has not reliably applied the pertinent principles and methods to the facts of this matter because the claim construction used by Dr. Muller is incorrect and not adequately supported by the ‘748 patent and its file history. Additionally for these reasons, Dr. Muller’s</p>

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	<p>statement is not relevant under FRE 401, and any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403, and as such will not help the trier of fact to understand the evidence or to determine a fact in issue.</p> <p>22. Paragraph 219 - The first sentence is not based on sufficient facts or data, as it is not adequately supported by Exhibit 1004, does not involve the reliable application of the pertinent principles and methods to the facts of this matter, and will not help the trier of fact to understand the evidence or to determine a fact in issue.</p> <p>23. Paragraph 225 - Dr. Muller’s statement that “Daanen [Exhibit 1005] also notes, the use of steady mounted cameras in Hurley [Exhibit 1004] provide additional advantages over systems having moveable cameras, such as Voigt . . .” is not based on sufficient facts or data, as it is not adequately supported by Exhibit 1005, does not involve the reliable application of the pertinent principles and methods to the facts of this matter, and will not help the trier of fact to understand the evidence or to</p>

Exhibit	Objection(s)
	<p>determine a fact in issue.</p> <p>24. Paragraph 235 - The second to last sentence, including Dr. Muller’s contentions with respect to “using the resolution of the camera [of Exhibit 1003] and its focal length,” is not based on sufficient facts or data, as they are not adequately supported by Exhibit 1003, does not involve the reliable application of the pertinent principles and methods to the facts of this matter, and will not help the trier of fact to understand the evidence or to determine a fact in issue.</p> <p>25. Paragraphs 239-297 – These paragraphs relate to an asserted ground of unpatentability upon which trial has not been instituted. They are therefore not relevant under FRE 401, and any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403, and as such will not help the trier of fact to understand the evidence or to determine a fact in issue.</p> <p>26.Paragraph 245 – In addition to the objection set forth at No. 25 above, the first sentence is not based on sufficient facts or data, as it is not adequately supported by Exhibit 1004, does not</p>

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	<p>involve the reliable application of the pertinent principles and methods to the facts of this matter, and will not help the trier of fact to understand the evidence or to determine a fact in issue..</p> <p>Additionally for these reasons, Dr. Muller's contentions are not relevant under FRE 401, and any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403, and as such will not help the trier of fact to understand the evidence or to determine a fact in issue for this additional reason.</p> <p>27. Paragraph 246 – In addition to the objection set forth at No. 25 above, this paragraph utilizes an incorrect claim construction that is not adequately supported by the '748 patent and its file history. Dr. Muller has not has not reliably applied the pertinent principles and methods to the facts of this matter. Additionally for these reasons, Dr. Muller's contentions are not relevant under FRE 401, and any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403, and as such will not help the trier of fact to understand the evidence or to determine a fact in issue.</p>

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	<p>28. Paragraph 248 - In addition to the objection set forth at No. 25 above, the first and third sentences of this paragraph are not based on sufficient facts or data, as they are not adequately supported by Exhibit 1004, and Dr. Muller has not has not reliably applied the pertinent principles and methods to the facts of this matter. Additionally for these reasons, Dr. Muller's contentions are not relevant under FRE 401, and any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403, and as such will not help the trier of fact to understand the evidence or to determine a fact in issue.</p> <p>29. Paragraph 251 – In addition to the objection set forth at No. 25 above, this paragraph is not based on sufficient facts or data, as it is not adequately supported by Exhibit 1004, and Dr. Muller has not has not reliably applied the pertinent principles and methods to the facts of this matter. Additionally for these reasons, Dr. Muller's contentions are not relevant under FRE 401, and any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under</p>

Exhibit	Objection(s)
	<p>FRE 403, and as such will not help the trier of fact to understand the evidence or to determine a fact in issue.</p> <p>30. Paragraph 299 - Dr. Muller’s contention that Exhibit 1005 discusses Exhibit 1004 or the contents therein (“The body scanner described in Hurley above was also briefly discussed in Daanen as a system available from a company called TC²”) is not based on sufficient facts or data, as it is not adequately supported by Exhibit 1005, does not involve the reliable application of the pertinent principles and methods to the facts of this matter, and will not help the trier of fact to understand the evidence or to determine a fact in issue.</p> <p>31. Paragraph 300 - Dr. Muller’s contention that Exhibit 1005 discusses the use of steady mounted cameras in Exhibit 1004 (“Daanen further explains that the use of steady mounted cameras in Hurley and other products allows for . . .”) is not based on sufficient facts or data, as it is not adequately supported by Exhibit 1005, and thus does not involve the reliable application of the pertinent principles and methods to the facts of this matter, and will not help the trier of fact to</p>

Exhibit	Objection(s)
	<p>understand the evidence or to determine a fact in issue.</p> <p>32. Paragraph 303 – The last sentence utilizes an incorrect claim construction (“if the centerline divided the person being imaged from front to back”) that is not adequately supported by the ‘748 patent and its file history. Dr. Muller has not reliably applied the pertinent principles and methods to the facts of this matter. Additionally for these reasons, Dr. Muller’s contentions are not relevant under FRE 401, and any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403, and as such will not help the trier of fact to understand the evidence or to determine a fact in issue.</p> <p>33. Paragraph 346 –The last two sentences, including Dr. Muller’s contention with respect to “using the resolution of the camera [of Exhibit 1003] and its focal length,” is not based on sufficient facts or data, as they are not adequately supported by Exhibit 1003, and Dr. Muller has not reliably applied the pertinent principles and methods to the facts of this matter.</p> <p>34. Paragraph 376 – In this paragraph, Dr. Muller incorporates by reference his previous discussions of Exhibit 1003. Patent</p>

Exhibit	Objection(s)
	<p>Owner objects on the same grounds as it objects above to Exhibit 1003 and Dr. Muller's consideration, discussion and reliance thereof.</p> <p>35. Paragraphs 396-397 - These paragraphs relate to an asserted ground of unpatentability upon which trial has not been instituted. They are therefore not relevant under FRE 401, and any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403, and as such will not help the trier of fact to understand the evidence or to determine a fact in issue.</p>

These objections have been made within ten business days of the March 30, 2018

Decision on Institution in compliance with 37 C.F.R. § 42.64(b)(1).

Respectfully submitted,

Date: April 13, 2018

/Kevin L. Reiner/

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CERTIFICATE OF SERVICE

I hereby certify that on this 13th day of April, a true and correct copy of the foregoing Patent Owner's Objections under 37 CFR § 42.64(b)(1) to Evidence Submitted in connection with the Petition, including this Certificate of Service, has been caused to be served in its entirety via electronic mail on counsel of record for Petitioner as set forth below, and through filing this document through the Patent Trial and Appeal Board End to End System:

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Respectfully Submitted

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