

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CANFIELD SCIENTIFIC, INC.,
Petitioner,

v.

MELANOSCAN, LLC,
Patent Owner.

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

**PETITIONER'S MOTION TO SUBMIT SUPPLEMENTAL
INFORMATION**

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Exhibit No.	Description
1004	“Body Measurement System using White Light Projected Patterns for Made-to-Measure Apparel” by Jeffrey D. Hurley, et al.” (“Hurley”)
1005	Heim A.M. Daanen and Jeroen van de Water, “Whole Body Scanners,” Displays 19 (1998) 111-120 (“Daanen”)
1031	Second Declaration of Dr. Jan-Peter Muller
1033	M.H. Demers, J.D. Hurley, R.C. Wulpern, J.R. Grindon, “Three-dimensional surface capture for body measurements using projected sinusoidal patterns,” IS&T/SPIE’s 9 th Annual symposium on electronic imaging: science and technology, San Jose CA, USA, 1997.
1034	U.S. Patent No. 6,373,963

I. Introduction

Petitioner presents this motion to submit the following supplemental information consistent with the Board’s May 15, 2017, Order (Paper 18):

Exhibit No.	Description
1031	Second Declaration of Dr. Jan-Peter Muller
1033	M.H. Demers, J.D. Hurley, R.C. Wulpern, J.R. Grindon, “Three-dimensional surface capture for body measurements using projected sinusoidal patterns,” IS&T/SPIE’s 9 th Annual symposium on electronic imaging: science and technology, San Jose CA, USA, 1997.
1034	U.S. Patent No. 6,373,963

II. Material Facts

1. Among other grounds, the Board instituted review with respect to two grounds of unpatentability relating to a combination of prior art references that includes Exhibit 1004, “Body Measurement System using White Light Projected Patterns for Made-to-Measure Apparel” by Jeffrey D. Hurley, et al.” (“Hurley”). Paper No. 15 at p. 37.

2. In its Petition and Expert Declaration, Petitioner asserted that Hurley discloses a specified imaging position by disclosing that a calibration object is placed approximately where the subject will be standing. *See, e.g.*, Paper No. 9 at pp. 28-31; Ex. 1016 at ¶¶ 90, 126, 136-37, 144-45.

3. U.S. Patent No. 6,373,963 (“the ‘963 patent”), Exhibit 1034, is a patent filed by the authors of the Hurley paper (Ex. 1004) on February 2, 1999. The ‘963 patent describes the same calibration process described in Hurley.

Compare ‘963 patent at col. 11, ll. 26-45, with Ex. 1004 at p. 10-11. The ‘963 patent further discloses that this calibration system includes footprint indicators, confirming the calibration position as the one where the subject will be standing. ‘963 patent at col. 4, ll. 30-35; col. 5, ll. 2-4.

4. The Board also instituted review based on a combination of the Hurley paper (Ex. 1004) and Heim A.M. Daanen and Jeroen van de Water, “Whole Body Scanners,” Displays 19 (1998) 111-120 (“Daanen,” Exhibit 1005). Paper No. 15 at p. 37 ¶ 5. Petitioner asserted that advantages of the system disclosed in Hurley were described in Daanen. *See, e.g.*, Paper No. 9 at p. 20; Ex. 1016 at ¶¶ 72, 119. Daanen describes the system disclosed in Hurley, but cites to a similar article from earlier in the same year by the same authors describing the same structure for an imaging system. Petitioner seeks to file the article as Exhibit 1033.

5. Exhibit 1031 is a Second Declaration of Dr. Jan-Peter Muller which addresses Exhibits 1033 and 1034. Dr. Muller previously submitted a Declaration in support of Petitioner’s Petition.

III. Reasons for Granting the Requested Relief

A. Legal Authorities Supporting this Motion

A party may file a motion to submit supplemental information if authorization is requested within one month of the date the trial is instituted and the supplemental information is “relevant to a claim for which the trial has been instituted.” 37 C.F.R. § 42.123(a). The guiding principle for the Board in making

any determination is to ensure efficient administration of the Office and the ability of the Office to complete IPR proceedings in a timely manner. A showing that supplemental information could not have been included earlier is not required.

Blue Coat Sys, Inc. v. Finjan, Inc., IPR2016-01444, Paper 28 (PTAB 2017).

“The purpose of the trial in an inter partes review proceeding is to give the parties an opportunity to build a record by introducing evidence—not simply to weigh evidence of which the Board is already aware.” *Genzyme Therapeutic Prods. Ltd. P’ship v. Biomarin Pharm. Inc.*, 825 F.3d 1360, 1367 (Fed. Cir. 2016). If the situation were otherwise, 37 C.F.R. § 42.123 would be useless to petitioners. *Seabery North America, Inc. v. Lincoln Global, Inc.*, IPR2016-00840, Paper 40 at p. 7 (PTAB 2017).

B. The Petition is timely

Petitioner made the request on April 30, 2018, within one month of the Institution Decision.

C. The Exhibits are Relevant to Claims the Board Will Review

Petitioner seeks to rely upon the supplemental information to provide further confirmatory evidence of the two specific assertions in its original petition relating to instituted grounds of invalidity. This information neither changes the grounds on which Petitioner seeks invalidity nor the evidence relied upon.

Although the ‘963 patent is prior art to U.S. Patent No. 7,359,748, under 35 U.S.C. §102(e) Petitioner does not seek to add it as a new ground of

unpatentability. Rather, Petitioner submits Exhibit 1034 as confirmation and additional support for the assertion in its petition that the statement “approximately where the subject will be standing” is indicative of a specified imaging position. Together with this Exhibit, Petitioner submits paragraphs 9-11 of Exhibit 1031, the Second Declaration of Dr. Jan-Peter Muller, describing how these disclosures of the ‘963 patent confirm the understandings of the Hurley article by one of ordinary skill in the art.

While Exhibit 1033 constitutes 102(b) prior art to the ‘748 patent, Petitioner does not submit it as a new ground of unpatentability. Rather, Petitioner relies upon it as confirmation and additional support for the assertion in its Petition that Daanen recognizes the advantages of the device disclosed in Hurley. Petitioner seeks to submit this Exhibit along with paragraphs 5-8 of Exhibit 1031, the Second Declaration of Dr. Jan-Peter Muller, which explain the relevant equivalence of the two Hurley articles with respect to the disclosures in the Daanen article.

During the recent call with the Board, Patent Owner announced it had no objection to submission of Paragraphs 3 and 4 of Dr. Muller’s Second Declaration, Exhibit 1031. Paragraphs 1, 2 and 12 of Exhibit 1031 merely include Dr. Muller’s statements concerning compensation, background, and his oath. Paragraphs 5-8 and 9-11 are addressed above.

In *Pacific Market International, LLC v. Ignite USA, LLC*, IPR2015-00561, Paper No. 23 (PTAB 2014), the Petitioner sought to introduce supplemental

information directed to reasons to combine the prior art references identified in its Petition. *Id.* at p. 3-4. The Board admitted the information as additional evidence confirming the positions presented in the Petition.

Canfield similarly seeks to submit information confirming its earlier evidence that one of ordinary skill in the art would understand that Hurley (Ex. 1004) discloses a specified imaging position and that Daanen (Ex. 1005) discusses the device described in Hurley. These new Exhibits provide context regarding the knowledge and understandings one of skill in the art would bring to the prior art identified in the instituted grounds. *Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1365 (Fed. Cir. 2015) (vacating the Board's decision because Board had declined to consider a post-petition reference providing context). Such a use is appropriate and promotes efficiency by allowing the Patent Owner to address the supplemental information in its Patent Owner's Response.

IV. Conclusion

Petitioner requests the Board grant this motion, permitting the Petitioner to file exhibits 1031, 1033, and 1034.

Respectfully submitted,

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CERTIFICATE OF FILING AND SERVICE

The undersigned hereby certifies that, pursuant to 37 CFR §§ 42.6(e), copies of the foregoing “MOTION TO SUBMIT SUPPLEMENTAL INFORMATION” is being filed via the Patent Trial and Appeal Board’s End to End (PTAB E2D) system and is being served today, May 16, 2018, by electronic mail on counsel for the Patent Owner:

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