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**UNITED STATES PATENT AND TRADEMARK OFFICE  
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 No. IPR2017-02125

Patent No.: 7,359,748

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**PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO  
SUBMIT SUPPLEMENTAL INFORMATION UNDER 37 C.F.R. § 42.123(a)**

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Patent Owner (“Melanoscan”) opposes Petitioner’s (“Canfield’s”) Motion to Submit Supplemental Information (Paper 19) and submission of proposed Exhibits 1031 (second declaration of Canfield’s expert Dr. Muller), 1033 (Demers *et al.* article (“Demers”)) and 1034 (U.S. Pat. no. 6,373,963 (“the ‘963 patent”)) for the following reasons.

## **I. RESPONSE TO CANFIELD’S ALLEGED MATERIAL FACTS**

1. Admitted that this IPR includes two grounds of unpatentability involving Exhibit 1004 (“Hurley”). The remainder of ¶ 1 is denied.

2. Admitted.

3. Admitted that the ‘963 patent names authors of Hurley as inventors, discloses footprints demonstrating where an occupant should stand during scanning, and discloses a calibration process. The remainder of ¶ 3 is denied.

4. Admitted that this IPR includes a ground of unpatentability involving Hurley and Exhibit 1005 (“Daanen”), that Canfield asserted that the advantages of the system disclosed in Hurley were described in Daanen, and that Daanen cites an article by some of the authors of Hurley allegedly published in the same year as Hurley describing an imaging system. The remainder of ¶ 4 is denied.

5. Admitted.

## **II. ARGUMENT**

Canfield’s reliance on Hurley for unpatentability is defective at least because

it fails to teach or suggest a “specified imaging position” as required by the challenged claims. *See* Paper 20 at 29 (Board’s finding of same). Recognizing the defects in its petition, Canfield seeks to inject new prior art and expert testimony to fill the gaps. Canfield is attempting to improperly assert new grounds of unpatentability and otherwise bolster the original evidence in its petition “based on feedback gleaned from the institution decision.” *Mitsubishi Plastics, Inc. v. Celgard, LLC*, IPR2014-00524, Paper 30, at 5-6 (PTAB Nov. 28, 2014) (“the Board has denied motions under § 42.123(a) where the petitioner sought to use the supplemental information at issue to bolster the challenges presented originally in the Petition”); *accord Medtronic, Inc. v. Endotach LLC*, IPR2014-00100, Paper 18, at 4 (PTAB Apr. 21, 2014) (“Petitioner may not raise a new ground of patentability after institution of trial”); *see VTech Commc’ns, Inc. v. Spherix Inc.*, IPR 2014-01431, Paper 7, at 3-4 (PTAB Apr. 7, 2015) (proffered supplemental information would improperly “change the evidence originally relied upon in the Petition”). Further, Demers, the ‘963 patent, and Muller’s related expert testimony easily could have been submitted with the petition. *See Laboratoire Francais du Fractionnement et des Biotech. S.A. v. Novo Nordisk Healthcare AG*, IPR2017-00028, Paper 22, at 4-5 (PTAB June 13, 2017) (noting that “[t]he Board may take into account whether the supplemental information was reasonably available to the petitioner at the time the petition was filed” and denying motion).

Canfield asserts it is not adding new grounds of patentability or bolstering its petition. But this is not true. Canfield wants the Board to consider the new exhibits as additional substantive evidence of unpatentability, and also for interpreting Hurley as containing disclosure it does not have. Canfield's characterization of the exhibits as "further confirmatory evidence" and "additional support" of its unpatentability contentions (Paper 19 at 3, 4) demonstrates its attempt to bolster its evidence. Dr. Muller likewise uses the new prior art to bolster his original opinions and add new opinions. *E.g.*, Ex. 1031 ¶¶ 7 (using Demers to conclude that one of ordinary skill would understand that Daanen's discussion of Demers applies to Hurley); 10 (using the '963 patent, *e.g.*, footprints disclosed therein but not in Hurley, to conclude that one of ordinary skill would understand Hurley to include a specified imaging position); 11 (opining that Demers and the '963 patent "provide[] additional support" for his previous opinion as to one of ordinary skill's understanding of Hurley). Moreover, because Muller's new opinions as to one of ordinary skill's understanding of Hurley derive (at least in part) from a review of Demers and the '963 patent, Canfield asserts a new ground of unpatentability - one based on Demers and the '963 patent in addition to Hurley. *See, e.g.*, Ex. 1031 ¶¶ 5-11; Paper 19 at 4 (asserting "these disclosures of the '963 patent" further support unpatentability in view of Hurley).

Thus, as in *Laboratoire Francais*, Canfield "seeks to bolster its petition by

introducing new prior art teachings in response to arguments presented in Patent Owner's Preliminary Response." Paper 22, at 3-4 (denying submission of new prior art and related expert testimony that allegedly "further supports [Petitioner's] position"). The Board should likewise deny Canfield's motion. *See id.*

Further, the new references were reasonably available to Canfield. Demers was cited and discussed in Daanen. A simple search for patents of the Hurley authors would have found the '963 patent. Canfield's lack of diligence should not be rewarded to the significant prejudice of Melanoscan. *See Laboratoire Francais*, Paper 22 at 4-5 ("a diligent search" would have found the evidence).

The cases Canfield cites do not involve submission of new prior art or new expert testimony to substantively support unpatentability contentions and therefore are inapposite. *Blue Coat Sys.* and *Seabery* involved merely documents supporting publication dates of prior art. *Blue Coat Sys., Inc. v. Finjan, Inc.*, IPR2016-01444, Paper 28, at 3-4, 7 (PTAB Oct. 23, 2017); *Seabery N. Am., Inc. v. Lincoln Global, Inc.*, IPR2016-00840, Paper 40, at 2, 4 (PTAB Mar. 15, 2017).

*Pacific Mkt., LLC v. Ignite USA, LLC* did not involve new prior art but rather involved expert testimony regarding prior art asserted in the petition that the Board specifically found did not change the grounds of unpatentability or type of evidence in the petition. IPR2015-00561, Paper 23, at 3-4 (PTAB Dec. 2, 2014). Where, as here, the supplemental information would change the grounds of

unpatentability or bolster the evidence in the petition, it is not permitted. *E.g.*, *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 448 (Fed. Cir. 2015) (distinguishing *Pacific Mkt.*); *VTech Commc'ns*, Paper 7 at 3-4 (same).

Neither *Genzyme Therapeutic Prods. Ltd. P'ship v. Biomarin Pharm. Inc.*, 825 F.3d 1360 (Fed. Cir. 2016), nor *Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359 (Fed. Cir. 2015), involved supplemental information, but, rather, the Board's treatment of references originally in the petition. *Genzyme Therapeutic*, 825 F.3d at 1367; *Ariosa Diagnostics*, 805 F.3d at 1365, 1367.

Nor does *Ariosa* support Canfield's contention that its new evidence permissibly provides "context regarding the knowledge and understanding one of ordinary skill in the art would bring to the prior art" in its petition. Paper 19 at 5. *Ariosa* nowhere mentions "context," much less states that new prior art may be submitted to bolster one of ordinary skill's "understanding" of prior art in the petition. Moreover, as discussed above, the exhibits are not proffered for "context" or "background," but to add evidence in order to address Hurley's deficiencies.

### **III. CONCLUSION**

Canfield fails to demonstrate entitlement to submit Exhibits 1031, 1033 or 1034, or that such relief is warranted. The Board should deny Canfield's motion.



Date: May 23, 2018

*Respectfully Submitted*

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## **CERTIFICATE OF SERVICE**

I hereby certify that on this 23rd day of May, 2018, a true and correct copy of the foregoing Patent Owner's Opposition to Petitioner's Motion to Submit Supplemental Information, 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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