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

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 PETITIONER'S REPLY

Pursuant to 37 CFR § 42.64(b)(1), Patent Owner Melanoscan LLC objects to evidence submitted in connection with Petitioner Canfield Scientific, Inc.'s Reply (Papers 33 and 35 (redacted version of Paper 33)) as follows:

Exhibit	Objection(s)
Ex. 1036	The following portions of Dr. Muller's Third Declaration should be excluded and/or stricken for at least the reasons summarized below. *See also* Patent Owner's objections to Exhibits 1038-1045 below, and Patent Owner's Objections filed April 13, 2018 (Paper No. 24) to evidence previously filed by Petitioner, which apply to those portions of Dr. Muller's testimony that is based on and/or cites such evidence. 1. Dr. Muller cites to and relies on deposition testimony of Dr. Drugge that is not admissible or is otherwise subject to objection. *See* Exhibit 1039, *infra*. 2. Paragraph 5 – The first 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, including, but not limited to, that it is not adequately supported by the '748 patent, and will not help the trier of fact to understand the evidence or to determine a fact in

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	issue. The third 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, including, but not limited to, that it is not adequately supported by the cited testimony of Dr. Drugge, and will not help the trier of fact to understand the evidence or to determine a fact in issue. 3. Paragraph 7 – 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, including, but not limited to, that it is not adequately supported by the cited testimony of Dr. Drugge, and will not help the trier of fact to understand the evidence or to determine a fact in issue. 4. Paragraph 9 – This paragraph will not help the trier of fact to understand the evidence or to determine a fact in issue to the extent it discusses prior art or activities of the patentee prior to the filing date of the '748 patent on which no ground of this IPR was instituted. Further, any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the

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	issues under FRE 403. 5. Paragraph 10 – This paragraph will not help the trier of fact to understand the evidence or to determine a fact in issue as it discusses prior art not asserted by Petitioner as rendering any claim in the IPR as unpatentable and/or it impermissibly asserts a new argument of unpatentability Petitioner could have presented earlier. *See* Office Patent Trial Guide, August 2018 Update, p. 15. Further, any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403. 6. Paragraph 11 – This paragraph will not help the trier of fact to understand the evidence or to determine a fact in issue as it discusses prior art not asserted by Petitioner as rendering any claim in the IPR as unpatentable and/or it impermissibly asserts a new argument of unpatentability Petitioner could have presented earlier. *See* Office Patent Trial Guide, August 2018 Update, p. 15. Thus, any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403.

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	7. Paragraph 12 - This paragraph will not help the trier of fact to understand the evidence or to determine a fact in issue to the extent it discusses Exhibit 1045, as it is not relevant to any fact in issue. Further, any probative value thereof is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403. In addition, the last 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 will not help the trier of fact to understand the evidence or to determine a fact in issue. 8. Paragraph 14 – The second, third and fourth 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 it is not adequately supported by the cited testimony of Dr. Drugge, and will not help the trier of fact to understand the evidence or to determine a fact in issue. 9. Paragraph 27 – The second sentence of this paragraph is not based on sufficient facts or data, does not involve the reliable

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	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 Hurley (Exhibit 1004), and will not help the trier of fact to understand the evidence or to determine a fact in issue. The fourth 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 will not help the trier of fact to understand the evidence or to determine a fact in issue. The last two sentences of this paragraph will not help the trier of fact understand the evidence or determine a fact in issue. 10. Paragraph 28 – This IPR was not instituted on any ground involving Exhibit 1034, and Exhibit 1034 is not in evidence. Further, Dr. Muller's testimony constitutes an impermissible new ground of unpatentability and/or an improper attempt to bolster the Petition. Thus, this paragraph will not help the trier of fact to understand the evidence or to determine a fact in issue, and any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403.

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	Further, the first and last 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, and will not help the trier of fact to understand the evidence or to determine a fact in issue. 11. Paragraph 30 – The fifth 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, including, but not limited to, that it is not adequately supported by the testimony of Dr. Drugge, and will not help the trier of fact to understand the evidence or to determine a fact in issue. The sixth and seventh 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 Hurley (Exhibit 1004), and will not help the trier of fact to understand the evidence or to determine a fact in issue. 12. Paragraph 32 – The second to last sentence of this paragraph is

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	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 Hurley (Exhibit 1004), and will not help the trier of fact to understand the evidence or to determine a fact in issue. 13. Paragraph 35 - The first 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, including, but not limited to, that it is not adequately supported by the testimony of Dr. Van der Weide, and will not help the trier of fact to understand the evidence or to determine a fact in issue. 14. Paragraph 36 – The last sentence of this paragraph will not help the trier of fact to understand the evidence or to determine a fact in issue to the extent it discusses "other prior art," as the ground of unpatentability discussed was not instituted on such art and/or Dr. Muller's testimony constitutes an impermissible new ground of unpatentability and/or an improper attempt to bolster

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	the Petition. Further, any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403. 15. Paragraph 38 – This paragraph will not help the trier of fact to understand the evidence or to determine a fact in issue as the ground of unpatentability discussed was not instituted based on Daanen (Exhibit 1005). Further, the last sentence of the 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 will not help the trier of fact to understand the evidence or to determine a fact in issue. Further, any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403. 16. Paragraph 40 – The second to last 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, including, but not limited to, that it is not adequately supported by Voigt (Exhibit 1003), and will not help

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	the trier of fact to understand the evidence or to determine a fact in issue. 17. Paragraph 41 – The third, fifth and seventh 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 Voigt (Exhibit 1003), and will not help the trier of fact to understand the evidence or to determine a fact in issue. 18. Paragraph 43 - This paragraph will not help the trier of fact to understand the evidence or to determine a fact in issue to the extent it discusses Daanen (Exhibit 1005), Crampton (Exhibit 1006), or the "other cited art," as the ground of unpatentability discussed was not instituted based on Daanen or Crampton or the referenced "other cited art." Further, this IPR was not instituted on any ground involving both Hurley (Exhibit 1004) and Crampton (Exhibit 1006) or the referenced "other cited art," and thus Dr. Muller's testimony constitutes an impermissible new ground of unpatentability and/or an improper attempt to

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	bolster the Petition. Further, any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403. In addition, the ninth 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, including, but not limited to, that it is not adequately supported by Daanen (Exhibit 1005), and will not help the trier of fact to understand the evidence or to determine a fact in issue. 19. Paragraph 45 - The third 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, including, but not limited to, that it is not adequately supported by Voigt (Exhibit 1003), and will not help the trier of fact to understand the evidence or to determine a fact in issue. 20. Paragraph 46 – This paragraph will not help the trier of fact to understand the evidence or to determine a fact in issue to the extent it discusses Crampton (Exhibit 1006), as the ground of

Exhibit	Objection(s)
	unpatentability discussed was not instituted based on Crampton. Further, the IPR was not instituted on any ground involving both Hurley (Exhibit 1004) and Crampton (Exhibit 1006), or any ground involving Exhibits 1011 and 1034 (the latter of which is also not in evidence), and thus Dr. Muller's testimony constitutes an impermissible new ground of unpatentability and/or an improper attempt to bolster the Petition. Further, any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403. In addition, 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, including, but not limited to, that it is not adequately supported by Voigt (Exhibit 1003), and will not help the trier of fact to understand the evidence or to determine a fact in issue. 21. Paragraph 49 - The last 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, including, but not limited to, that it is not

Exhibit	Objection(s)
	adequately supported by the cited testimony of Dr. Drugge, and will not help the trier of fact to understand the evidence or to determine a fact in issue. 22. Paragraph 55 - This IPR was not instituted on any ground involving Exhibit 1034, and Exhibit 1034 is not in evidence. Further, Dr. Muller's testimony constitutes an impermissible new ground of unpatentability and/or an improper attempt to bolster the Petition. Any probative value of Dr. Muller's testimony on same is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403. Further, 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, including, but not limited to, that it is not adequately supported by Hurley, and will not help the trier of fact to understand the evidence or to determine a fact in issue. 23. Paragraph 56 – The sixth 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

Exhibit	Objection(s)
	of this matter, including, but not limited to, that it is not adequately supported by Voigt (Exhibit 1003), and will not help the trier of fact to understand the evidence or to determine a fact in issue. 24. Paragraph 61 - 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, including, but not limited to, that it is not adequately supported by the testimony of Dr. Van der Weide, and will not help the trier of fact to understand the evidence or to determine a fact in issue. 25. Paragraph 62 - The first 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, including, but not limited to, that it is not adequately supported by the testimony of Dr. Van der Weide, and will not help the trier of fact to understand the evidence or to determine a fact in issue. 26. Paragraph 65 - The second, seventh, eighth and ninth sentences of this paragraph are not based on sufficient facts or data, do not

Exhibit	Objection(s)
	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 Crampton (Exhibit 1006), and will not help the trier of fact to understand the evidence or to determine a fact in issue. 27. Paragraph 70 - The sixth 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, including, but not limited to, that it is not adequately supported by Crampton (Exhibit 1006), and will not help the trier of fact to understand the evidence or to determine a fact in issue. 28. Paragraph 80 - 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, including, but not limited to, that it is not adequately supported by Daanen (Exhibit 1005), and will not help the trier of fact to understand the evidence or to determine a fact in issue. 29. Paragraph 81 – This IPR was not instituted on any ground

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	involving Exhibit 1033, and Exhibit 1033 is not in evidence. Further, Dr. Muller's testimony constitutes an impermissible new ground of unpatentability and/or an improper attempt to bolster the Petition. This paragraph will not help the trier of fact to understand the evidence or to determine a fact in issue, and any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403. 30. Paragraph 82 – This IPR was not instituted on any ground involving Exhibit 1033, and Exhibit 1033 is not in evidence. Further, Dr. Muller's testimony constitutes an impermissible new ground of unpatentability and/or an improper attempt to bolster the Petition. This paragraph will not help the trier of fact to understand the evidence or to determine a fact in issue, and any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403. Further, last 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 will not help the trier of fact to understand the evidence or to

Exhibit	Objection(s)
	determine a fact in issue. 31. Paragraph 89 – 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, including, but not limited to, that it is not adequately supported by Daanen (Exhibit 1005), and will not help the trier of fact to understand the evidence or to determine a fact in issue. 32. Paragraph 91 – 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, including, but not limited to, that it is not adequately supported by Daanen (Exhibit 1005), and will not help the trier of fact to understand the evidence or to determine a fact in issue. 33. Paragraph 92 – The last two 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

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	adequately supported by Daanen (Exhibit 1005), and will not help the trier of fact to understand the evidence or to determine a fact in issue. 34. Paragraph 97 – This IPR was not instituted on any ground involving Exhibit 1014. Dr. Muller's testimony constitutes an impermissible new ground of unpatentability and/or an improper attempt to bolster the Petition. This paragraph will not help the trier of fact to understand the evidence or to determine a fact in issue, and any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403. 35. Paragraph 98 - This IPR was not instituted on any ground involving Exhibit 1015. Dr. Muller's testimony constitutes an impermissible new ground of unpatentability and/or an improper attempt to bolster the Petition. This paragraph will not help the trier of fact to understand the evidence or to determine a fact in issue, and any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403.

Exhibit	Objection(s)
	36. Paragraph 102 – The first two 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 it is not adequately supported by the cited testimony of Dr. Drugge, and will not help the trier of fact to understand the evidence or to determine a fact in issue. 37. Paragraph 103 – The first 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, including, but not limited to, that it is not adequately supported by the cited testimony of Dr. Drugge, and will not help the trier of fact to understand the evidence or to determine a fact in issue. The second sentence of this paragraph is 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 it is not adequately supported by the testimony of Dr. Drugge and Hurley (Exhibit 1004), and will not help the trier of fact to

Exhibit	Objection(s)
	understand the evidence or to determine a fact in issue. 38. Paragraph 104 – This paragraph is 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 it is not adequately supported by the cited testimony of Dr. Drugge, and will not help the trier of fact to understand the evidence or to determine a fact in issue.
Ex. 1038	1. Lack of relevance under FRE 401-402. The vast majority of Exhibit 1038 does not support and is not related to 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. *See* Ex. 1036, Muller Decl. at ¶ 34. 2. Not timely filed pursuant to the Scheduling Order of April 9, 2018 (Paper no. 16) as modified by the Parties' Stipulation filed August 22, 2018 (Papers no. 24, 25).
Ex. 1039	1. Patent Owner maintains, preserves, and does not waive the objections set forth during the deposition of Dr. Drugge pursuant to 37 C.F.R. § 42.64(a) as if they were fully set forth

Exhibit	Objection(s)
	herein. 2. Not timely filed pursuant to the Scheduling Order of April 9, 2018 (Paper no. 16) as modified by the Parties' Stipulation filed August 22, 2018 (Papers no. 24, 25).
Ex. 1040	1. Lack of relevance under FRE 401-402. Exhibit 1040 does not support 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. *See* Ex. 1036, Muller Decl. at ¶¶ 102, 103, 104, *supra*. 2. Not timely filed pursuant to the Scheduling Order of April 9, 2018 (Paper no. 16) as modified by the Parties' Stipulation filed August 22, 2018 (Papers no. 24, 25).
Ex. 1041	Not timely filed pursuant to the Scheduling Order of April 9, 2018 (Paper no. 16) as modified by the Parties' Stipulation filed August 22, 2018 (Papers no. 24, 25).
Ex. 1042	Not timely filed pursuant to the Scheduling Order of April 9, 2018 (Paper no. 16) as modified by the Parties' Stipulation filed August 22, 2018 (Papers no. 24, 25).
Ex. 1043	Not timely filed pursuant to the Scheduling Order of April 9,

Exhibit	Objection(s)
	2018 (Paper no. 16) as modified by the Parties' Stipulation filed August 22, 2018 (Papers no. 24, 25).
Ex. 1044	Not timely filed pursuant to the Scheduling Order of April 9, 2018 (Paper no. 16) as modified by the Parties' Stipulation filed August 22, 2018 (Papers no. 24, 25).
Ex. 1045	1. Lack of relevance under FRE 401-402. Exhibit 1045 will not help the trier of fact to understand the evidence or to determine a fact in issue. Any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under FRE 403. *See* Ex. 1036 Muller Decl. at ¶ 12, *supra*. 2. Not timely filed pursuant to the Scheduling Order of April 9, 2018 (Paper no. 16) as modified by the Parties' Stipulation filed August 22, 2018 (Papers no. 24, 25).
Ex. 1046	1. Exhibit 1046 is a redacted version of Exhibit 1036. Patent Owner objects to Exhibit 1046 on the same grounds as it objects to Exhibit 1036. *See supra* at p. 2-20. 2. Not timely filed pursuant to the Scheduling Order of April 9, 2018 (Paper no. 16) as modified by the Parties' Stipulation filed August 22, 2018 (Papers no. 24, 25).

Exhibit	Objection(s)
Ex. 1047	1. Exhibit 1047 is a redacted version of Exhibit 1039. Patent Owner objects to Exhibit 1047 on the same grounds as it objects to Exhibit 1039. *See supra* at p. 20-21. 2. Not timely filed pursuant to the Scheduling Order of April 9, 2018 (Paper no. 16) as modified by the Parties' Stipulation filed August 22, 2018 (Papers no. 24, 25).

These objections have been made within five business days of the October 2, 2018 service of Petitioner's evidence in compliance with 37 C.F.R. § 42.64(b)(1).

Respectfully submitted,

Date: October 10, 2018

/Kevin L. Reiner/

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CERTIFICATE OF SERVICE

I hereby certify that on this 10th day of October, 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 Petitioner's Reply, 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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