
**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

CANFIELD SCIENTIFIC, INC.,
Petitioner

v.

MELANOSCAN LLC,
Patent Owner

Case No. IPR2017-02125

Patent No.: 7,359,748

**PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO
DEEM REPLY AND SUPPORTING EXHIBITS TIMELY**

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Petitioner's ("Canfield's") late filing of its Reply and supporting documents may be excused only if it shows good cause or that it is entitled to relief in the interests of justice. *See* 37 C.F.R. § 42.5(c). Canfield does not even attempt to argue that good cause exists, nor has it shown it is entitled to relief in the interests of justice. Instead, Canfield tries to blame the Patent Owner ("Melanoscan"). But Canfield's untimeliness is entirely its own fault.

Canfield first blames Melanoscan because it did not receive the confidentiality designations for Dr. Drugge's deposition until September 28, 2018. However, Canfield fails to inform the Board that Melanoscan did not receive a copy of the deposition transcript from Canfield until after the close of business on September 25, and only then, after requesting Canfield to provide it. Melanoscan and Dr. Drugge then worked diligently and provided the designations to Canfield in less than three days, *i.e.*, by 12:30 PM on September 28.¹ Clearly, Melanoscan was diligent and Canfield was not.

Canfield next tries to blame Melanoscan for its untimeliness because the parties agreed to extend the deadline to take Dr. Drugge's deposition.² But this

¹ Although the rules allowed Melanoscan ten days from receipt of the transcript to provide its designations, it did so in under three days. *See* Office Trial Practice Guide, 77 FR 48756, 48770, App. B § (d)(5) (Aug. 12, 2012).

² The parties originally agreed to reset Canfield's Reply deadline to September 30, 2018. *See* Paper No. 25. Melanoscan agreed to Canfield's subsequent request to further extend its Reply deadline to October 1. *See* Paper No. 26.

excuse does not hold water because the parties correspondingly extended the deadline for Canfield's Reply and the deposition was timely taken. Canfield was provided the full amount of time that it agreed to between Dr. Drugge's deposition and the filing of its Reply and cannot now claim it was not enough time.

Canfield next tries to blame Melanoscan because Canfield needed more time than it anticipated to reply to the merits of Melanoscan's Response. Exhibit 1048 ("Hartzell Decl.") ¶ 9. But Canfield had over three months – more time than the Board initially set in its scheduling order –to prepare its Reply. Further, when Canfield agreed to the extended deadline for its Reply, it was fully aware of Melanoscan's Response and the work required to formulate its Reply. Canfield cannot now claim that Melanoscan's arguments and evidence somehow caught it by surprise and that it needed more time.

Canfield's final excuse is that it experienced unexplained technical difficulties in performing the word count. Hartzell Decl. ¶ 5. Although Canfield's excuse is less than clear, it is clear that the 25-minute delay caused by purported technical difficulties made the difference between a timely and late filing, and demonstrates that Canfield simply "finished" its reply too late and too close to the deadline. In the *Pacific Mkt. Intl., LLC v. Ignite USA, LLC* case relied on by Canfield, the Board found that similar circumstances did not excuse the late filing. IPR2014-00561, Paper 40, at 3-4 (PTAB May 12, 2015).

Canfield has a history of lateness and lack of diligence in this IPR, to the prejudice of Melanoscan. The most glaring instance is Canfield's attempt, nearly seven months after it filed its Petition, to file multiple pieces of new prior art and new expert testimony asserting new grounds of unpatentability not presented in the Petition as required by 35 U.S.C. § 312. As Melanoscan noted in its Opposition (Paper No. 21) to Canfield's pending motion to file the new documents and testimony long after the deadline (Paper No. 19), these publicly-available documents easily could have been located and the new expert testimony on them presented in the Petition. Canfield's failure to do so represents a glaring lack of diligence and disregard for the Board's deadlines.

Canfield's repeated failure to meet deadlines, to make untimely filings without legitimate excuse, and to blame Melanoscan for its own lack of diligence, should be rejected. It is respectfully submitted that Canfield be held to the deadlines set in this matter and that its motion be denied.³

³ Contrary to Canfield's assertion (Motion p. 3), Melanoscan would not need an extension for its Objections to the evidence in Canfield's Reply (Paper No. 37). Melanoscan filed its objections within the required five business days of service of the Reply. *See* 37 C.F.R. § 42.64(b). 37 C.F.R. § 42.5(c) authorizes the Board to excuse a party's late action, but does not alter the date the party actually filed or served its papers, and therefore does not retroactively change the other party's deadlines.

Date: October 17, 2018

Respectfully Submitted

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CERTIFICATE OF SERVICE

I hereby certify that on this 17th day of October, 2018, a true and correct copy of the foregoing Patent Owner's Opposition to Petitioner's Motion to Deem Reply And Supporting Exhibits Timely, 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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