

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 EXCLUDE EVIDENCE

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Petitioner Canfield Scientific, Inc. moves under 37 C.F.R. § 42.64(c) to exclude the portions of Exhibits 2010 and 2019 and of the Patent Owner's Response discussed below.

II. STATEMENT OF MATERIAL FACTS

1. The Patent Owner's Response, filed on June 20, 2018 Paper cited Exhibits 2010, the Declaration of Dr. Rhett Drugge, and 2019, the Declaration of Dr. Daniel van der Weide.

2. The first and second paragraphs of page 5 of the Patent Owner's Response cites to statements made in U.S. Patent No. 7,359,748 (Exhibit 1001) regarding the state of the art. Specifically, the Response states that "Prior to the invention, patient examination usually consisted of visual inspection of the skin, or of photographs of the skin by a practitioner" and that Dr. Drugge recognized the need for repeatable imaging conditions, including among other things lighting, image scale, and angle relative to the camera, to accurately assess whether a clinically significant change had occurred." These citations rely upon statements made in the '748 Patent that "There is a need for a practical device that allows for the rapid screening of individuals for skin cancer and other maladies of the skin in early states of development" and "In light of the many advantages of early detection, there exists a clear need for a device that can greatly enhance the current

methods of skin cancer screening.” Ex. 1001 at 1:51-53 and 3:59-61. Similarly, the second paragraph cites to the patent for purported disadvantages of prior art systems including patient modesty concerns. Ex. 1001 at 6:6-10. Petitioner objected to these statements as hearsay not subject to any exception. (Petitioner’s Objections to Evidence Paper 24 at p. 2).

4. In paragraph 22 of Exhibit 2010, Dr. Drugge states that at the time of his invention, “one could not obtain the necessary repeatable imaging conditions” and that it was “impossible for the photographer to duplicate the lighting, viewing angles and scale of each photograph at a later time.” In paragraph 27, Dr. Drugge further states that, “under the photography techniques at the time, it was essentially impossible to provide the same scale in photographs taken at different times” and that “[e]xisting imaging systems were not capable of imaging and tracking the relevant sub millimeter skin features.”

5. Petitioner objected to these statements on the ground that they lack foundation under FRE 602. (Petitioner’s Objections to Evidence Paper 24 at p.3).

6. During his deposition on September 20, 2018, Dr. Drugge acknowledged that he was not the first person to come up with the idea of taking a photo at one time and a photo at a later date from precisely the same distance to scale those photos to the same scale and, in fact, it was possible at the time of his invention to do that. Ex. 1039 at p. 133 of 253 at lines 5-9; 11; 13-20; 22-p. 134

line 10. Dr. Drugge further testified that there is no question that it is possible for someone to make reproducible photographs, and added additional limitations to the statements in his declaration. Ex. 1039 at p. p. 134, line 12 – p. 135, line 10; p. 135 line 16 to page 136, line 9; Page 136, line 11 to p. 137, line 7.

7. In paragraph 40 of Exhibit 2010, Dr. Drugge states that the TIP device has been a significant benefit to patients and has increased convenience for patients. He further states that “the world’s smallest detected melanoma was located using the technology.” Petitioner objected that this paragraph constitutes hearsay and that it lacks foundation under FRE 602. Further, Petitioner objected that any probative value of the statement is outweighed by prejudice under FRE 403. Paper 24 at p. 4.

8. Dr. Drugge’s declaration provides no basis for his alleged knowledge of the size of all melanoma detected in the world.

9. During his deposition on September 20, 2018, Dr. Drugge testified
[REDACTED]
[REDACTED]. Ex. 1039
at p. 85 out of 253 at 14-20; 85:23-86:17; 88:10-16; 91:17-22; 94:4-12.

10. At various points throughout his declaration, Dr. van der Weide seeks to incorporate claim limitations that are no present in the ‘748 patent. For example, in the last sentence of paragraph 44, he seeks to distinguish prior art relating to 3D

body measurement on the basis that it uses highly non-uniform light that is incompatible with imaging skin. In paragraph 45, he again seeks to distinguish 3D measurement systems that use data gathered from images of the body to construct a 3D model. Dr. van der Weide similarly suggests that the claims of the ‘748 patent require the use of color photography to diagnose melanoma, require the use of diffuse white light sources, or require complete imaging of the body. Ex. 2019 at ¶¶ 64, 72, 77, 90, 93.

11. Melanoscan did not propose any claim construction that limits the scope of the patent claims to imaging devices using color photography, to light sources using diffuse white light, requires full body imaging without shadowing or occlusion, or precludes 3D modeling based on data gathered from images. The claims at issue of the ‘748 patent do not limit light sources to diffuse, broad-spectrum illumination, are not limited to imaging skin, do not require the use of color photography, do not require complete imaging of the body, and are not limited to diagnosis of melanoma. The preamble of the independent claims refers to the identification of any malady that effects human tissue and is not limited to maladies diagnosed by color changes to the skin. Ex. 1001 at 21:63-64; 8:36 (detecting abcess); 6:55-58 (detecting skeletal conditions). The invention’s scope encompasses uses including measuring the body’s surface and body morphology shape evaluations for medical, physical training, and clothing purposes. Ex. 1001

at 5:60-8:3. The patent discloses that imaging devices encompass anything that can accurately capture the physiological attributes desired from the subject patient. Ex. 1016 at ¶ 45; Ex. 1001 at 4:25-41. The patent discloses a wide array of light sources. *See* Ex. 1016 at ¶47. The independent claims are directed to imaging “the person or portion thereof.” Claims 1; 51.

11. Petitioner objected to each of Dr. van der Weide’s statements set forth above on the grounds that they rely upon an improper claim construction and not relevant under FRE 401 to the claims in suit. Petitioner further objected that any probative value is outweighed by the danger of unfair prejudice under FRE 403. Paper 24 at pp. 7-11, 13.

III. LEGAL AUTHORITY

Admissibility of evidence in IPR proceedings is governed by the Federal Rules of Evidence and the USPTO Rules. *See* 37 C.F.R. §§ 42.62 (“Applicability of the Federal rules of evidence”); 42.61(a) (stating that “[e]vidence that is not taken, sought, or filed in accordance with this subpart is not admissible”). Accordingly, evidence may be excluded on the basis of lack of foundation (FRE 602), relevance (Fed. R. Evid. 401), or hearsay (Fed. R. Evid. 801-807).

IV. THE IDENTIFIED PORTIONS OF THE PATENT OWNER'S RESPONSE, EXHIBIT 2010 AND EXHIBIT 2019 SHOULD BE EXCLUDED

A. The Patent Owner's Response Relies Upon Hearsay Statements in the '748 Patent

Those portions of the '748 patent identified in Material Fact 2 above constitute hearsay statements about the state of the art. These are self-serving statements made by the patent owner regarding alleged drawbacks of the prior art. While such statements could constitute party admissions if cited by petitioner, no such exception allows the patent owner to affirmatively rely on these statements as evidence. The PTAB has noted the hearsay nature of patent specifications, noting that the specification is only admissible to prove what the specification describes or discloses, not the truth of the matters asserted therein. *See* Patent Trial and Appeal Board Standing Order at ¶ 152.2.1; *Wojciak v. Nishiyama*, 61 U.S.P.Q.2d 1576, at *4 (BPAI 2001). For that reason, the citations to Ex. 1001 at 1:51-53 and 3:59-61 and Ex. 1001 at 6:6-10 on page 5 of the Patent Owner's Response should be excluded as hearsay.

B. Paragraphs 22, 27, and 40 of Dr. Drugge's Declaration Should be Stricken for Lack of Foundation and Hearsay

Dr. Drugge's conclusory statements as set forth below and in Material Facts 4 and 7 should be excluded for lack of foundation. Dr. Drugge has not set forth any basis to conclude that he has personal knowledge of the statements made.

- “Under the techniques available at the time, one could not obtain the necessary repeatable imaging conditions. In the typical situation where a photographer would take multiple photographs of a patient with a handle-held camera, or even if the camera was mounted on a tripod, it was essentially impossible for the photographer to duplicate the lighting, viewing angles, and scale of each photograph at a later time.” Ex. 2010 at ¶ 22.
- “For similar reasons as discussed above, under the photography techniques at the time, it was essentially impossible to provide the same scale in photographs taken at different times.” “Existing imaging systems were not capable of imaging and tracking the relevant sub millimeter skin features.” Ex. 2010 at ¶ 27.
- “The TIP has been a significant benefit to patients. The TIP reduced time and increased convenience for patients through its rapid, whole body, imaging capability. More importantly, it has enabled earlier detection of cancers, and of smaller cancers, which boosts cure/survival probability. In fact, the world’s smallest detected melanoma was located using the technology, which findings were published in 2016.” Ex. 2010 at ¶ 40.

As confirmed by Dr. Drugge's deposition testimony, Dr. Drugge has provided no foundation for making representations that it was impossible to provide the same scale in photos or provide reproducible lighting and viewing angles. Material Fact 6. As is apparent from Voigt, Ex. 1003, which provided reproducible lighting, viewing angles, and scale, and as Dr. Drugge himself testified these statements are incorrect and unsupported. *Id.* The statements should be excluded for lack of foundation. Similarly, Dr. Drugge's declaration provides no basis to support Dr. Drugge's assertions that he has knowledge of the size of every melanoma detected throughout the world. Material Facts 7-9. Because there is no support for his statement, it should be excluded for lack of foundation.

Further, Dr. Drugge cannot speak on behalf of his dermatology patients. Material Fact 7. His representation regarding the benefit to patients and the increased convenience for patients are offered for the truth of the matter asserted and appear to be based on unidentified out of court statement by patients. These out of court statements constitute hearsay and should be excluded.

C. Dr. van der Weide's Statements That Seek to Incorporate Claim Limitations Not Present in the Patent Should be Excluded as Irrelevant

Each of the following statements by Dr. van der Weide are irrelevant to the claims at issue, because it would require his statements require the application of

improper claim constructions that read in limitations not present in the claims at issue and not, in fact, argued by Melanoscan.

With respect to paragraphs 44 and 45, Dr. van der Weide states that 3D imaging prior art would not be considered by one of skill in the art because such art uses non-uniform monochromatic light that would not be useful for skin imaging systems and such systems use 3D measurement data to construct a model of the body. The claims at issue are not limited to skin imaging systems or systems that use diffuse, broad spectrum illumination and have no restriction on using data gathered from cameras, as has been done in the cited prior art to construct a model. Because the scope of the invention encompasses a wide range of light sources, uses, and imaging devices as set forth in Material Fact 11, Dr. van der Weide's statements are not relevant to the claims at issue. To the extent they have any probative value it is out-weighed by the potential prejudice from his misconception of the claims. For these reasons, the last sentence of paragraph 44 and the third and fourth sentences of paragraph 45 of Exhibit 2019 should be excluded under FRE 402 and 403.

With respect to paragraph 64, Dr. van der Weide states that Hurley is not photography, seeking to limit the claim at issue to photography and the generation of photographic images based apparently upon the title of the patent. Hurley in fact does capture images using CCD cameras and generate data from those images (Ex.

1004 at Section 4.2, p. 7), but Dr. van der Weide's attempt to read in a photography limitation to the claims is improper and his discussion of photography in paragraph 64 is not relevant to any claim and is more prejudicial than probative. For these reasons, the entire paragraph should be excluded.

In paragraph 72 and 77, Dr. van der Weide makes similar statements that Crampton is not photographic because it uses highly non-uniform light to generate a model and would not be useful for imaging skin conditions. Again, Crampton uses cameras to capture images from which data is gathered. Because this analysis requires improperly limiting the claims at issue to Dr. van der Weide's proposed definition of photography, these paragraphs should be excluded under FRE 402 and 403. Similarly, the second sentence of paragraph 93 relies upon Dr. van der Weide's improper limitation of the scope of the claims in suit pursuant to Dr. van der Weide's definition of photography and should be excluded for the same reasons.

Dr. van der Weide makes similar statements regarding the Daanen reference in paragraph 90. For the same reasons, the second sentence of paragraph 90 should be excluded. Similarly, in the second to last sentence of paragraph 90, Dr. van der Weide states that, in the proposed combination, "[c]omplete imaging of the body is not achieved, even with additional cameras." Because the claims at issue are not directed to complete imaging of the body without shadowing or occlusion, this

sentence is not relevant to the Board's analysis and should be excluded under FRE 402 and 403.

CONCLUSION

For the reasons set forth above, the identified portions of the Patent Owner's Response, the Declaration of Dr. Drugge (Ex. 2010) and the Declaration of Dr. van der Weide (Ex. 2019) should be excluded.

Respectfully submitted,

October 31, 2018

/Julianne M. Hartzell/

Julianne M. Hartzell (Reg. No. 44,748)

jhartzell@marshallip.com

Lead Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that, pursuant to 37 CFR §§ 42.6(e), copies of the foregoing “PETITIONER’S MOTION TO EXCLUDE EVIDENCE” is being served today, October 31, by electronic mail on counsel for the Patent Owner and through filing this document through the Patent Trial and Appeal Board End to End System:

mgarratana@mccarter.com
kreiner@mccarter.com.

/Julianne M. Hartzell/

Julianne M. Hartzell (Reg. No. 44,748)
Lead Counsel for Petitioner
MARSHALL, GERSTEIN & BORUN LLP