
**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 MOTION TO EXCLUDE CANFIELD EVIDENCE
UNDER 37 C.F.R. § 42.64**

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I. Introduction.

Patent Owner Melanoscan, LLC (“Melanoscan”) respectfully moves the Patent Trial and Appeal Board for an Order pursuant to 37 C.F.R. § 42.64(c) that excludes certain evidence Petitioner Canfield Scientific, Inc. (“Canfield”) submitted in this proceeding.

II. Exhibits 1008, 1009, 1011, 1012, 1013, 1014 and 1015 Should Be Excluded.

Exhibit 1008, 1009, 1011, 1012, 1013, 1014 and 1015 should be excluded under Fed. R. Evid. 401, 402 and 403. The objections thereto were timely made in Patent Owner’s Objections filed on April 13, 2018 (Paper 17, pp. 4–7).

These exhibits are not relevant because the IPR was not instituted on any ground for which the exhibit is asserted as rendering any challenged claim unpatentable. Thus, they will not help the trier of fact to understand the evidence or to determine a fact in issue. *See* Fed. R. Evid. 401. Further, as they lack relevance, any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues. *See* Fed. R. Evid. 403.

Patent Owner thus requests that the Board exclude these exhibits.

III. Parts of Exhibit 1016 Should Be Excluded.

The testimony in Paragraphs 396 to 397 of Dr. Muller’s Declaration (Ex. 1016) should be excluded under Fed. R. Evid. 401, 402 and 403. The objections

thereto were timely made in Patent Owner's Objections filed April 13, 2018 (Paper 17, pp. 8–23).

The testimony relates to a ground of unpatentability upon which trial has not been instituted, namely a combination of Exhibits 1003, 1006, 1007 and 1014. Thus, it lacks relevance because it will not help the trier of fact to understand the evidence or to determine a fact in issue. *See* Fed. R. Evid. 401. As it lacks any relevance, any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under Fed R. Evid. 403.

In addition, per Section II *supra*, Exhibit 1014 should be excluded, and thus this testimony should be excluded under Fed. R. Evid. 104 as based on evidence not of record.

Patent Owner thus requests that the Board exclude this testimony.

IV. Parts of Exhibit 1036 Should Be Excluded.

The testimony in Dr. Muller's Third Declaration (Ex. 1036) should be excluded as set forth below. The objections thereto were timely made in Patent Owner's Objections filed on October 10, 2018 (Paper 37, pp. 2-20).

- a) Paragraph 9 – This paragraph should be excluded under Fed. R. Evid. 401, 402 and 403 to the extent it discusses activities of the patentee prior to the filing date of the patent upon which the IPR was instituted. No ground of this IPR was instituted thereon. Thus, it lacks relevance because it will not help

the trier of fact to understand the evidence or to determine a fact in issue. *See* Fed. R. Evid. 401. As it lacks any relevance, any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under Fed. R. Evid. 403.

- b) Paragraph 10 – This paragraph should be excluded under Fed. R. Evid. 401, 402 and 403. It discusses prior art not asserted by Petitioner as rendering any claim in the IPR as unpatentable. Thus, it lacks relevance because it will not help the trier of fact to understand the evidence or to determine a fact in issue. *See* Fed. R. Evid. 401. As it lacks any relevance, any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under Fed. R. Evid. 403. In addition, it impermissibly asserts a new argument of unpatentability Petitioner could have presented earlier, and should be excluded on this basis also. *See* Office Patent Trial Guide, August 2018 Update, pp. 14-15.
- c) Paragraph 11 – This paragraph should be excluded under Fed. R. Evid. 401, 402 and 403. It discusses prior art not asserted by Petitioner as rendering any claim in the IPR as unpatentable. Thus, it lacks relevance because it will not help the trier of fact to understand the evidence or to determine a fact in issue. *See* Fed. R. Evid. 401. As it lacks any relevance, any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the

issues under Fed. R. Evid. 403. In addition, it impermissibly asserts a new argument of unpatentability Petitioner could have presented earlier, and should be excluded on this basis also. *See* Office Patent Trial Guide, August 2018 Update, pp. 14-15.

d) Paragraph 28 – This testimony discusses Exhibit 1034. Exhibit 1034 is not in evidence, and was not asserted in the Petition as rendering any claim in the IPR unpatentable. The testimony thereon constitutes an impermissible new ground of unpatentability and/or an improper attempt to bolster the Petition, and should be excluded. *See Mitsubishi Plastics, Inc. v. Celgard, LLC*, IPR2014-00524, Paper 30, at 5-6 (P.T.A.B. Nov. 28, 2014). The testimony should also be excluded under Fed. R. Evid. 401, 402 and 403. It lacks relevance because, as no instituted ground is based on Exhibit 1034, it will not help the trier of fact to understand the evidence or to determine a fact in issue. *See* Fed. R. Evid. 401. As it lacks any relevance, any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under Fed. R. Evid. 403.

e) Paragraph 36 – The last sentence of this paragraph should be excluded to the extent it discusses “other prior art.” The ground of unpatentability discussed was not instituted on such art, and so the testimony lacks relevance under Fed. R. Evid. 401-402 because it will not help the trier of fact to

understand the evidence or to determine a fact in issue. *See* Fed. R. Evid. 401. As it lacks any relevance, any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under Fed. R. Evid. 403. In addition, such “other prior art” was not asserted in the Petition as rendering any claim in the IPR unpatentable, nor was the IPR instituted on any ground thereof. The testimony therefore constitutes an impermissible new ground of unpatentability and/or an improper attempt to bolster the Petition, and should be excluded. *See Mitsubishi Plastics*, IPR2014-00524, Paper 30, at 5-6.

- f) Paragraph 43 - This testimony should be excluded to the extent it discusses Exhibit 1005, Exhibit 1006, and/or “other cited art.” The ground of unpatentability discussed was not instituted based on such, and so the testimony lacks relevance under Fed. R. Evid. 401-402 because it will not help the trier of fact to understand the evidence or to determine a fact in issue. *See* Fed. R. Evid. 401. As it lacks any relevance, any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under Fed. R. Evid. 403. Further, the Petition did not assert and the IPR was not instituted on any ground involving both Exhibit 1004 and Exhibit 1006 and/or the “other cited art.” Thus, the testimony constitutes an impermissible new ground of unpatentability and/or an improper attempt to

bolster the Petition, and should be excluded. *See Mitsubishi Plastics, IPR2014-00524, Paper 30, at 5-6.*

- g) Paragraph 46 - This testimony should be excluded to the extent it discusses Exhibits 1006, 1011 and 1034. The ground of unpatentability discussed was not instituted based on such, and so the testimony lacks relevance under Fed. R. Evid. 401-402 because it will not help the trier of fact to understand the evidence or to determine a fact in issue. *See Fed. R. Evid. 401.* As it lacks any relevance, any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under Fed. R. Evid. 403. Further, the Petition did not assert and the IPR was not instituted on any ground involving both Exhibit 1004 and Exhibit 1006, or any ground involving Exhibits 1011 and 1034, which is not in evidence. Thus, the testimony constitutes an impermissible new ground of unpatentability and/or an improper attempt to bolster the Petition, and should be excluded. *See Mitsubishi Plastics, IPR2014-00524, Paper 30, at 5-6.*
- h) Paragraph 55 – This testimony discusses Exhibit 1034. Exhibit 1034 is not in evidence, and was not asserted in the Petition as rendering any claim in the IPR unpatentable. The testimony thereon constitutes an impermissible new ground of unpatentability and/or an improper attempt to bolster the Petition, and should be excluded. *See Mitsubishi Plastics, Inc., IPR2014-00524, Paper*

30, at 5-6. The testimony should also be excluded under Fed. R. Evid. 401, 402 and 403. It lacks relevance because, as no instituted ground is based on Exhibit 1034, it will not help the trier of fact to understand the evidence or to determine a fact in issue. *See* Fed. R. Evid. 401. As it lacks any relevance, any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under Fed. R. Evid. 403.

- i) Paragraph 81 – This testimony discusses Exhibit 1033. Exhibit 1033 is not in evidence, and was not asserted in the Petition as rendering any claim in the IPR unpatentable. The testimony thereon constitutes an impermissible new ground of unpatentability and/or an improper attempt to bolster the Petition, and should be excluded. *See Mitsubishi Plastics, Inc.*, IPR2014-00524, Paper 30, at 5-6. The testimony should also be excluded under Fed. R. Evid. 401, 402 and 403. It lacks relevance because, as no instituted ground is based on Exhibit 1033, it will not help the trier of fact to understand the evidence or to determine a fact in issue. *See* Fed. R. Evid. 401. As it lacks any relevance, any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under Fed. R. Evid. 403.
- j) Paragraph 82 – This testimony discusses Exhibit 1033. Exhibit 1033 is not in evidence, and was not asserted in the Petition as rendering any claim in the IPR unpatentable. The testimony thereon constitutes an impermissible new

ground of unpatentability and/or an improper attempt to bolster the Petition, and should be excluded. *See Mitsubishi Plastics, Inc.*, IPR2014-00524, Paper 30, at 5-6. The testimony should also be excluded under Fed. R. Evid. 401, 402 and 403. It lacks relevance because, as no instituted ground is based on Exhibit 1033, it will not help the trier of fact to understand the evidence or to determine a fact in issue. *See* Fed. R. Evid. 401. As it lacks any relevance, any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under Fed. R. Evid. 403.

- k) Paragraph 97 – This testimony discusses Exhibit 1014. Exhibit 1014 was not asserted in the Petition as rendering any claim in the IPR unpatentable. The testimony thereon constitutes an impermissible new ground of unpatentability and/or an improper attempt to bolster the Petition, and should be excluded. *See Mitsubishi Plastics, Inc.*, IPR2014-00524, Paper 30, at 5-6. The testimony should also be excluded under Fed. R. Evid. 401, 402 and 403. It lacks relevance because, as no instituted ground is based on Exhibit 1014, it will not help the trier of fact to understand the evidence or to determine a fact in issue. *See* Fed. R. Evid. 401. As it lacks any relevance, any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under Fed. R. Evid. 403.

- l) Paragraph 98 – This testimony discusses Exhibit 1015. Exhibit 1015 was not asserted in the Petition as rendering any claim in the IPR unpatentable. The testimony thereon constitutes an impermissible new ground of unpatentability and/or an improper attempt to bolster the Petition, and should be excluded. *See Mitsubishi Plastics, Inc.*, IPR2014-00524, Paper 30, at 5-6. The testimony should also be excluded under Fed. R. Evid. 401, 402 and 403. It lacks relevance because, as no instituted ground is based on Exhibit 1015, it will not help the trier of fact to understand the evidence or to determine a fact in issue. *See* Fed. R. Evid. 401. As it lacks any relevance, any probative value is substantially outweighed by a danger of unfair prejudice and/or confusing the issues under Fed. R. Evid. 403.

Patent Owner thus requests that the Board exclude this testimony.

V. Exhibits 1038-1047 Should Be Excluded.

Exhibit 1038-1047 should be excluded for Petitioner's failure to timely file the exhibits 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). The objections thereto were timely made in Patent Owner's Objections filed on October 10, 2018 (Paper 37, pp. 20-23).

In addition, Exhibit 1046 is a redacted version of Exhibit 1036. The portions of Exhibit 1046 that correspond to the portions of Exhibit 1036 that Patent Owner

requests the Board exclude (Section IV *supra*) should be excluded on the same grounds. The objections thereto were timely made in Patent Owner's Objections filed on October 10, 2018 (Paper 37, p. 22).

Patent Owner thus requests that the Board exclude these exhibits testimony.

VI. Conclusion.

For the reasons stated above, Melanoscan respectfully requests that the Board exclude Exhibits 1008, 1009, 1011-1015, 1038-1047, and the indicated portions of Exhibits 1016, 1036 and 1046 from consideration in this proceeding, IPR2017-02125.

Date: October 31, 2018

Respectfully Submitted

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CERTIFICATE OF SERVICE

I certify that on this 31st day of October, 2018, a true and correct copy of the foregoing Patent Owner's Motion to Exclude Canfield Evidence Under 37 C.F.R. § 42.64, 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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