
**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 EXCLUDE**

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Patent Owner (“Melanoscan”) opposes Petitioner’s (“Canfield’s”) Motion to Exclude (“Mot.”), Paper no. 42. The Board should deny the motion in its entirety.

I. RESPONSE TO CANFIELD’S ALLEGED MATERIAL FACTS

1. Admitted.

2. Admitted that Patent Owner’s Response (“POR”), Paper no. 23, cites to U.S. Patent 7,359,748 (Ex. 1001). Admitted that the POR contains the quotations in the second sentence. Admitted that page 5 of the POR cites to portions of Ex. 1001 containing the quotations recited in the third sentence, and also cites to Ex. 1001, 6:6-10.¹ Admitted that Canfield objected as stated in the last sentence. The remainder of ¶ 2 is denied.

4.² Admitted that Dr. Drugge’s declaration (Ex. 2010) contains the partial and incomplete quotations recited. The remainder of ¶ 4 is denied.

5. Admitted.

6. Admitted that, in his deposition, Dr. Drugge testified that he was not the first “to come up with” taking a photo at one time and a photo at a later date precisely at the same distance. The remainder of ¶ 6 is denied.

7. Admitted that Ex. 2010 ¶ 40 states, “The TIP has been a significant benefit to patients.” Admitted that ¶ 40 states that the TIP “increased convenience

¹ The ‘748 patent is cited by column:lines format.

² Canfield’s Statement of Facts does not contain a paragraph 3.

for patients.” Admitted that ¶ 40 contains the partial and incomplete quotation recited in the second sentence. Admitted that Canfield objected to ¶ 40. The remainder of ¶ 7 is denied.

8. Denied.

9. Admitted that, in his deposition, Dr. Drugge testified that, in addition to measuring the melanoma with the TIP, it was also measured using a dermatoscope. Admitted that Dr. Drugge testified that he would not rely on an optical system alone in evaluating that melanoma. The remainder of ¶ 9 is denied.

10. Denied.

11. The first three sentences are admitted. Admitted that the ‘748 patent discloses evaluation of body morphology and shape by medical personnel, physical trainers and clothiers. Admitted that the ‘748 patent discloses accurately capturing the physical attributes desired from the subject patient. Admitted that the ‘748 patent discloses multiple types of light sources. Admitted that the independent claims recite imaging devices/means that generate an image of a person or portion thereof. The remainder of ¶ 11 is denied.

11.³ Admitted that Canfield objected to Ex. 2019 ¶¶ 44, 64, 72, 77, the second and sixth sentences of Ex. 2019 ¶ 90, and the second sentence of Ex. 2019 ¶ 93 on the grounds listed. The remainder of ¶ 11 is denied.

³ Canfield’s motion contains two paragraph 11’s.

II. ARGUMENT

Under the Federal Rules of Evidence (“FRE”), *see* 37 C.F.R. § 42.62, the evidence that Canfield seeks to exclude is admissible and should not be excluded.

A. The Board Should Not Exclude Citations to the ‘748 Patent

Canfield contends that Melanoscan’s citations to 1:51-53, 3:59-61⁴ and 6:6-10 of the ‘748 patent on page 5 of the POR should be excluded because those portions of the patent “constitute hearsay statements about the state of the art.” Mot., 1, 6. Canfield is incorrect.

Column 1, lines 51-53 reads:

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 stages of development.

Contrary to Canfield’s contentions, this passage does not mention the state of the art. Rather, it is directed to the inventor’s belief of a need that gave rise to his invention and to provide context for his statements about the advantages of his invention.

Column 3, lines 28-30 reads:

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.

Column 6, lines 6-10 reads:

⁴ The POR p. 5 does not cite 3:59-61 as Canfield contends. However, Canfield’s Material Fact 2 upon which its exclusion request is based quotes language at 3:28-30. Melanoscan thus addresses the POR’s citation to 3:28-30.

The consistent lighting and repeatability of the imaging technique make it ideal for replacing the skin cancer screening environment where poor lighting, patient movement and dialogue, patient modesty and other factors increase the likelihood of an incomplete examination.

These too are not statements regarding the state of the art. Rather, they express the inventor's beliefs of a need that gave rise to his invention and of the advantages of his invention. They thus support the statements for which they are cited on page 5 of the POR that discuss advantages and benefits of the invention, but not because they purport to describe the state of the art.

Though 3:28-30 refers to "current methods," it does not describe what those "methods" are, and thus does not purport to describe the state of the art. Similarly, 6:6-10 does not describe the state of the art. Rather, it expresses Dr. Drugge's belief as to advantages of the invention over a particular skin cancer screening environment. The passage does not state that such environment constitutes the state of the art, or that all of the prior art has such features.

Thus, Melanoscan's citations should not be excluded as Canfield contends.

Wojciak v. Nishiyama relied on by Canfield does not require otherwise. There, an applicant in an interference sought to rely on experimental data described in the specification. 61 U.S.P.Q.2d 1576, 1580 (B.P.A.I. 2001). The Board noted that the specification itself cannot establish that the experiments were carried out or that such data was, in fact, obtained. *Id.* Under Board procedures, then, a party must file an affidavit by someone having first-hand knowledge of how the data was

generated. *Id.* The party did file an affidavit, but the Board found the evidence did not establish that the affiant had the requisite first-hand knowledge of how the experiments were performed, and so excluded the data. *Id.* at 1581.

Wojciak is irrelevant to the situation here, which does not involve experimental data in the patent or reliance on such. The Board's affidavit requirement is not implicated and *Wojciak* is inapposite.

B. The Board Should Not Exclude Drugge's Declaration Testimony

Canfield contends that Ex. 2010 ¶¶ 22, 27 and 40 should be excluded for lacking foundation because "Dr. Drugge has not set forth any basis that he has personal knowledge of the statements made." Mot., 6. Canfield is not correct.

A witness has sufficient personal knowledge to testify unless no reasonable fact-finder "could believe that the witness had the ability and opportunity to perceive" what he testified about. *United States v. Hickey*, 917 F.2d 901, 904 (6th Cir. 1990); *see also United States v. Finley*, 2014 U.S. Dist. LEXIS 123808, at *5 (W.D. Pa. Sept. 5, 2014) (FRE 602 sets a "low threshold" for admissibility). Personal knowledge can be established by the witness's occupation or the nature of his participation in the matters testified about. *Broad. Music, Inc. v. Tex. Border Mgmt.*, 2012 U.S. Dist. LEXIS 133052, at *7 (N.D. Tex. Sept. 18, 2012); *see United States v. Rodriguez*, 162 F.3d 135, 144 (1st Cir. 1998).

Drugge's declaration clearly shows he had personal knowledge. He has been

a practicing physician since 1988, is Board Certified in Dermatology, and has treated dermatology patients from all over the world. Ex. 2010 ¶¶ 7, 9-11. As such, he was familiar with and used cancer detection techniques in use before his invention, including visual inspection by physicians and photography. *Id.* ¶¶ 16-17. As to the latter, he conducted research on the use of photographs for dermatological examination. *Id.* ¶ 18. He was tapped as an expert in digital skin imaging by multiple medical organizations, and worked with the U.S. Veterans Administration (“VA”) on digital photographic examination. *Id.* In view of his experience and recognized expertise, Drugge clearly has personal knowledge of dermatological photographic techniques and the drawbacks thereof as he testified. Ex. 2010 ¶¶ 22, 27; *see Broad. Music*, 2012 U.S. Dist. LEXIS 133052, at *7.

Other evidence of record further establishes his personal knowledge. His CV lists a plethora of research and publications in dermatological photography. Ex. 2011, 2-7 (*e.g.*, “Digital Skin Imaging Research;” Whited *et al.*, *A Pilot Trial of Digital Imaging in Skin Cancer*). He testified at deposition about his extensive training and experience. Ex. 1039, 44:7-14⁵ (studying and development of teledermatology); 44:15-45:3 (research studies and publications); 45:21-25 (used skin imagery for measurements since 1988); 81:1-8 (discussing “experience in diagnostic imaging of the skin”); 129:22-130:1 (same); 125:22-126:3; 142:1-7 (VA

⁵ Testimony is cited by page:lines format.

work revealed problems with handheld cameras that were typically used).

As for his personal knowledge of the benefits the invention has provided to patients testified to in ¶ 40, that derives from his and colleagues' use of the invention in their medical practices and research "for almost twenty years." Ex. 2010 ¶ 34. In view of such, Dr. Drugge certainly "had the ability and opportunity" to observe and determine how the invention has benefited patients, and thus has personal knowledge as to those benefits. *See Hickey*, 917 F.2d at 904; *Broad. Music*, 2012 U.S. Dist. LEXIS 133052, at *7; *see also* Ex. 2010 ¶¶ 35-39 (knowledge of the function and operation of the invention). He also testified extensively about such at deposition. *E.g.*, Ex. 1039, 63:1-10 (discussing how his invention reduces time/cost and increases convenience), 93:15-19 (discussing ongoing research using his invention); 99:17-24 ([REDACTED] [REDACTED]); 137:12-138:10 (value and benefits of invention); 139:13-140:1 ([REDACTED] [REDACTED]); 164:1-10 (benefits of 20-year database of patient images from invention); 165:5-16 (same).

Canfield further contends that the last sentence of ¶ 40 stating that the invention located the world's smallest detected melanoma lacks foundation because there is "no basis to support Dr. Drugge's assertions that he has knowledge of the size of every detected melanoma in the world." Mot., 8.

However, he did not assert that he knows the size of every detected melanoma. Further, Canfield imparts a ludicrous absolutism to his testimony. Dr. Drugge is testifying as to his knowledge. After decades of practice and research, Dr. Drugge has broad knowledge of reports of the sizes of detected melanomas. *See* Exs. 2010 ¶¶ 7, 9-11, 16-18; 2011, 2-7. He thus has adequate foundation to testify that the melanoma is the smallest detected. *See Broad. Music*, 2012 U.S. Dist. LEXIS 133052, at *7. Canfield cites no evidence a smaller melanoma has been detected.

Canfield also attacks ¶ 40 on hearsay grounds. Mot., 8. Canfield contends that Dr. Drugge's testimony that the TIP benefited and reduced time and increased convenience for patients constitutes "out of court statement [sic] by patients." It is not. Dr. Drugge does not state or imply that his testimony represents statements by patients. Rather, the testimony represents his non-hearsay observations and conclusions based on examining and treating patients using the invention for nearly two decades. Ex. 2010 ¶¶ 34 (nearly 30,000 patient image sets generated); 41 (patient image sets provide information to researchers for designing cancer screenings); 35 (reduced image acquisition time); 39 (no calibration device required). As discussed above, Dr. Drugge's vast experience with patient treatment and research places him in an excellent position to make such observations. *See supra*, p. 6-7; *Hickey*, 917 F.2d at 904; *Broad. Music*, 2012 U.S. Dist. LEXIS 133052, at *7. As a simple example, he could readily observe that substantially

simultaneously generating images of the patient using the invention would take less time and thus increase convenience for patients as compared to the prior practice of “sequentially taking individual photographs” – without patients telling him so. Ex. 2010 ¶¶ 20, 35.

Canfield also attacks the testimony as simply being “wrong.” Mot., 8. Canfield is incorrect. Canfield cites Drugge’s deposition testimony as allegedly admitting that, prior to his invention, it was not “impossible” to reproduce imaging scale, lighting and viewing angles at a later time. He made no such admission. Dr. Drugge’s Declaration states that it was “essentially impossible” in the “typical situation” where a photographer used a hand-held or tripod mounted camera. Ex. 2019 ¶ 22. His deposition is not contrary. Rather, it confirms that his Declaration speaks to the typical situations he had experienced in his work. Ex. 1039, 133:17-136:7 (“the typical situation is my reference point”). He then explained how the typical situation contrasts to a theoretical “perfect world” in which such repeatability may be possible. *Id.* 134:16-21.

Canfield also cites Voigt as evidencing that repeatability was possible. However, Voigt, with its position framework and vertically-sliding camera, Ex. 1003, is not the “typical situation” about which Dr. Drugge testified. Canfield also ignores the context of his testimony, which is recounting what he “came to realize” before his invention. Ex. 2010 ¶¶ 15, 21. Dr. Drugge had no knowledge of Voigt at

the time of his invention, and Canfield cites no evidence that he did.

Moreover, the evidence Canfield cites, at most, goes to the weight of Dr. Drugge's testimony, not its admissibility or his personal knowledge, and is improperly raised by Canfield. *See Search Am., Inc. v. Transunion Intelligence, LLC*, CBM2013-00037, Paper 67, at *12-13 (P.T.A.B. Feb 3, 2015) (arguments went to weight of evidence, not admissibility); Office Patent Trial Practice Guide, August 2018 Update, at 16 ("A motion to exclude is not a vehicle for addressing the weight to be given evidence"). The Board should ignore Canfield's arguments.

Dr. Drugge's testimony is thus admissible and should not be excluded.

C. The Board Should Not Exclude Dr. Van Der Weide's Testimony

Canfield alleges that portions of van der Weide's declaration should be excluded as not relevant under FRE 401, or alternatively, under FRE 403, as based on improper claim constructions that "read in" limitations not present in the claims. Mot., 8-11. However, his testimony is not based on improper claim constructions, nor did he "read in" limitations not present in the claims. Canfield mischaracterizes and takes the testimony out of context.

Evidence is relevant if it has a tendency to make a fact more or less probable than without it and the fact is of consequence in the proceeding. FRE 401. That is the case here.

Four of Canfield's five grounds of unpatentability in this IPR contend that a

person of ordinary skill in the art (“POSA”) would modify Voigt (Ex. 1003) in view of Hurley, Crampton and Daanen. Whether a POSA would combine the references as contended is a factual issue that Canfield has the burden to prove. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 419 (2007); *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367-68 (Fed. Cir. 2016).

Dr. van der Weide testified that a POSA would not combine the prior art and so the claims are not obvious. *E.g.*, Ex. 2019 ¶¶ 45, 64, 67, 70, 92, 94. The objected-to testimony relates to this issue. He testified as to the differences between Voigt on the one hand and Hurley, Crampton and Daanen on the other. The courts have held that differences among the prior art are relevant to whether a POSA would combine them. *See Apple Inc. v. Samsung Elecs. Co.*, 839 F.3d 1034, 1051-52, n.14 (Fed. Cir. 2016) (though analogous art, references were sufficiently different so that “a skilled artisan would not have been motivated to combine [them]”); *Proctor & Gamble Co. v. Team Techs., Inc.*, 2014 U.S. Dist. LEXIS 119060, at *79 (S.D. Ohio July 3, 2014) (even if analogous, a POSA would not have combined the references due to their differences). The differences about which van der Weide testified reinforce why it is more probable that a POSA would not combine Hurley, Daanen or Crampton with Voigt, which is a fact of consequence as to whether the claims were non-obvious. *See KSR*, 550 U.S. at 419. His testimony is thus relevant. *See* FRE 401.

The testimony is unambiguously directed to the relevant issue of significant differences between Canfield’s secondary references (Hurley, Crampton, Daanen) and its primary reference, Voigt. Voigt is directed to a skin imaging system that provides a user, *e.g.*, a dermatologist, with images of a patient’s skin in order to detect, measure and track skin lesions such as melanomas and other skin cancers over time. Exs. 1003, 981-83; 2019 ¶¶ 46, 51. In ¶ 44, van der Weide first addresses Canfield’s contentions that “a POSA reading Voigt in light of certain 3D body measurement art would find it obvious to combine” that art, stating that “the prior art provides no reason for a POSA” to do so. He then notes that the 3D body measurement art uses illumination that is “incompatible” with that “necessary for imaging skin.” The context makes clear that Dr. van der Weide is pointing out differences between Hurley, Daanen and Crampton’s 3D body measurement systems and Voigt’s skin imaging system. The other objected-to testimony likewise discusses differences between the cited art.

Turning to ¶ 45, the Board should disregard that portion of Canfield’s motion because it did not timely object to the testimony. Canfield seeks exclusion of the third and fourth sentences of this paragraph under FRE 401-403. Mot., 5, 9. However, Canfield’s previously-filed objections did not assert those grounds. *See* Paper 24 at 7. Thus, Canfield did not preserve its asserted grounds to exclude as required by 37 C.F.R. § 42.64(b)(1).

Canfield's contentions nonetheless fail on the merits. Here, Dr. van der Weide states differences between Voigt and the secondary references: unlike Voigt, the latter "does not image skin." Ex. 2019 ¶ 45.

In ¶ 64, he points out further differences between Hurley and Voigt. Unlike Voigt that photographs a subject "to reveal accurate details of a skin condition," Hurley uses illumination unsuitable for such, providing the user with "a quantitative model of body measurements . . . not [] photographic images."

Similarly, in ¶¶ 72 and 77, he discusses the differences between the lighting in Crampton and Voigt: the "non-uniform light" used in Crampton would "inhibit[] ... accurate diagnostics of skin conditions, as taught, *e.g.*, by Voigt." Further, Crampton's 3D avatar model "does not detect much less preserve skin conditions" as do the images Voigt provides.

In ¶ 90, Dr. van der Weide discusses that Daanen, "[l]ike Hurley and Crampton," creates "geometric models of the body," not "reproducible images to enable longitudinal study of lesion changes" as does Voigt. Ex. 1003, 981, 987. Likewise, in ¶ 93, he states that Daanen "outputs, not an image suitable for tracking skin lesions" as does Voigt, "but rather a set of coordinates for describing the geometry of the subject."

In all this testimony it is clear that Dr. van der Weide is discussing differences among the cited art, not claim construction.

Canfield contends that Dr. van der Weide’s discussion of photography, lighting, and skin imaging systems seeks to improperly “read in” limitations to the claims. Mot., 9-10. Nowhere in this testimony, though, does he discuss the construction of the claims or state that the claims have such limitations.⁶ The plain reading and context of the testimony makes clear that Dr. van der Weide discusses these topics because they relate to Voigt and the differences between Voigt and other cited art. Voigt is a skin imaging system, provides the user with color images of the skin, and uses certain lighting to do so. Ex. 1003. The other art does not. *See* Exs. 1004-06. Canfield’s attempt to impute his discussion of Voigt and the differences between Voigt and the other art to claim construction is baseless.

Canfield further contends that Dr. van der Weide’s testimony in ¶ 90 that the alleged combination of Voigt, Hurley and Daanen would not provide “[c]omplete body imaging” should be excluded because the claims are not limited to complete body imaging. Mot., 10-11. This too is baseless. The testimony rebuts Canfield’s contention that a POSA would make the combination “to achieve total body coverage.” Petition (Paper no. 9), 77. It thus relates to the alleged rationale for combining the references, not construction of the claims. *See KSR*, 550 U.S. at 419. The testimony is relevant under FRE 401 because, as Canfield’s alleged rationale

⁶ In contrast, where Dr. van der Weide elsewhere discusses claim construction, he makes this clear. Ex. 2019, ¶¶ 36-42 (section entitled “**CLAIM CONSTRUCTION**”).

could not be achieved, it is less probable that a POSA would make the combination. *See Intelligent Bio-Sys.*, 821 F.3d at 1367-68 (a POSA must have a reasonable expectation of success); *see also* FRE 401.

As for Canfield's FRE 403 contentions, Canfield alleges that the probative value of the testimony is outweighed by "potential prejudice." Mot. 9, 10. However, the clear and direct relevance of the testimony to the patentability inquiry demonstrates that, not only is its probative value not *substantially* outweighed by a danger of unfair prejudice, *see* FRE 403, but its probative value far outweighs any alleged prejudice.⁷ Moreover, Canfield does not, as it must, explain what the alleged prejudice is, why such is unfair, and why such substantially outweighs the probative value. *See id.*

The testimony is thus admissible and should not be excluded.

III. CONCLUSION

The evidence that Canfield seeks to exclude is admissible. The Board should deny Canfield's motion to exclude in its entirety.

⁷ Canfield does not contend that other "dangers" listed under FRE 403 warrant exclusion. Nonetheless, no grounds for exclusion under FRE 403 exist.

Date: November 14, 2018

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CERTIFICATE OF SERVICE

I hereby certify that on this 14th day of November 2018, a true and correct copy of the foregoing Patent Owner's Opposition to Petitioner's Motion to Exclude 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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