

**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.

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Case IPR: 2017-02125  
Patent No. 7,359,748

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**PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO  
EXCLUDE EVIDENCE**

## **TABLE OF CONTENTS**

	<b>Page</b>
I. Introduction .....	1
II. Legal Authority.....	1
III. Exhibits 1008, 1009, and 1011-1015 are Relevant to the State of the Art and the Background Knowledge One of Skill in the Art Would Bring to the Prior Art References Constituting Invalidity Grounds .....	2
IV. The Identified Portions of Exhibit 1036 are Relevant to the Background Knowledge of One of Skill in the Art, the Scope of Relevant Art, and the Interpretation of References Cited in Invalidity Grounds .....	7
V. The Board Should Consider Exhibits 1038-1047 in the Interests of Justice .....	15
VI. Conclusion.....	15

## **TABLE OF AUTHORITIES**

**Page(s)**

### **Cases**

<i>Ariosa Diagnostics v. Verinata Health, Inc.</i> , 805 F.3d 1359 (Fed. Cir. 2015) .....	1, 2, 12
<i>Belden v. Berk-tek LLC</i> , 803 F.3d 1064 (Fed. Cir. 2015) .....	9, 11
<i>Blue Coat Sys, Inc. v. Finjan, Inc.</i> , IPR2016-01444, Paper 28 (PTAB 2017) .....	12
<i>Cross Medical Prods., Inc. v. Medtronic Sofamor Danek, Inc.</i> , 424 F.3d 1293 (Fed. Cir. 2005) .....	13
<i>Genzyme Therapeutic Prods. Ltd. P’ship v. Biomarin Pharm. Inc.</i> , 825 F.3d 1360 (Fed. Cir. 2016 ) .....	2
<i>IBG LLC v. Trading Techs. Int’l, Inc.</i> , CBM2016-00054, 2017 WL 4708078 (PTAB October 17, 2017) .....	1
<i>KSR Intern. Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007) .....	13, 14
<i>Pacific Market Int’l, LLC v. Ignite USA, LLC</i> , IPR2015-00561, Paper No. 23 (PTAB 2014) .....	11
<i>Seabery North America, Inc. v. Lincoln Global, Inc.</i> , IPR2016-00840, Paper 40 (PTAB 2017) .....	2
<i>Valmont Industries, Inc. v. Lindsay Corp.</i> , 730 Fed. Appx. 918 (Fed. Cir. 2018) .....	12

### **Other Authorities**

37 C.F.R. § 42.20 .....	1
37 C.F.R. § 42.123 .....	1, 2

## **I. INTRODUCTION**

Patent Owner has moved to exclude exhibits 1008, 1009, 1011-1015, 1038-1041 and portions of exhibits 1016 and 1036. The Patent Owner has not met its burden and the Board should deny Patent Owner's motion.

## **II. LEGAL AUTHORITY**

The moving party has the burden of proof to establish that it is entitled to the requested relief. 37 C.F.R. § 42.20. Mere conclusory statements of prejudice are insufficient to satisfy the movant's burden for FRE 403. *IBG LLC v. Trading Techs. Int'l., Inc.*, CBM2016-00054, 2017 WL 4708078 at \*32 (PTAB October 17, 2017).

Prior "[a]rt can legitimately serve to document that knowledge that skilled artisans would bring to bear in reading the prior art identified as providing obviousness." *Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1365 (Fed. Cir. 2015) (finding that the Board erred in refusing to consider a reference because it was not prior art presented as the basis for obviousness).

A party may file a motion to submit supplemental information if authorization is requested within one month of the date the trial is instituted and the supplemental information is "relevant to a claim for which the trial has been instituted." 37 C.F.R. § 42.123(a).

“The introduction of new evidence in the course of the trial is to be expected in *inter partes* review trial proceedings and, as long as the opposing party is given notice of the evidence and an opportunity to respond to it, the introduction of such evidence is perfectly permissible...” *Genzyme Therapeutic Prods. Ltd. P’ship v. Biomarin Pharm. Inc.*, 825 F.3d 1360, 1366 (Fed. Cir. 2016 ). If the situation were otherwise, 37 C.F.R. § 42.123 would be useless. *Seabery North America, Inc. v. Lincoln Global, Inc.*, IPR2016-00840, Paper 40 at p. 7 (PTAB 2017).

**III. EXHIBITS 1008, 1009, AND 1011-1015 ARE RELEVANT TO THE STATE OF THE ART AND THE BACKGROUND KNOWLEDGE ONE OF SKILL IN THE ART WOULD BRING TO THE PRIOR ART REFERENCES CONSTITUTING INVALIDITY GROUNDS**

Patent Owner seeks to exclude Exhibits 1008, 1009, 1011, 1012, 1013, 1014, and 1015 as irrelevant. The only basis Patent Owner offers is that these references were not identified as one of the pieces of prior art defining a combination for obviousness. Petitioner, however, relies upon them to explain the background knowledge of a POSA at the time of the invention.

The Federal Circuit has rejected Melanoscan’s objections. In *Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1365 (Fed. Cir. 2015), the Federal Circuit found reasoning similar to Melanoscan’s to be error stating that “[a]rt can legitimately serve to document the knowledge that skilled artisans would bring to bear in reading the prior art identified as producing obviousness.” The cited exhibit “had to be considered by the Board,” according to the Federal Circuit,

even though it was not one of the pieces of prior art presented as the basis for obviousness, where such exhibit was cited in testimony regarding the state of the art. That is exactly what Petitioner has done with these references.

Exhibits 1008 and 1009 are relevant to the state of the art and the background knowledge of a POSA at the time of the invention. These exhibits, according to Dr. Muller, explain that, at the time of the invention a POSA would have appreciated that digital imaging had applications in a wide variety of fields, including quantifying “deviations in body shape such as warts and scars and to map the progress of gravity through regular body scans.” Ex. 1016 at ¶ 61. Similarly, Dr. Muller cited Exhibit 1009 to illustrate that a POSA would have been generally familiar with the use of multiple cameras or an array of cameras when all around coverage is needed, particularly when capturing images of a human being. Ex. 1016 at ¶ 67.

Exhibit 1011 describes Dr. Muller’s own prior work in the field. This exhibit is relevant not only to the background understanding of a POSA, but additionally serves to evince Dr. Muller’s qualifications as an expert. Dr. Muller used this reference to explain his early work to develop systems for making 3d measurement of facial features using a pair of CCD cameras to take pictures of the face with different lighting scenarios. These images were used to make spatial measurements using a reference coordinate system and creating a 3d model. Ex.

1016 at ¶ 8. Dr. Muller cited this exhibit in connection with his qualifications and experience to opine as an expert in the field.

Moreover, Exhibit 1011 serves to rebut Dr. van der Weide's unsupported statements that modification of Voigt Ex. 1003 would require removal of the patient positioning framework. *See, e.g.*, Ex. 2019 ¶¶ 51-53, 55-57. Dr. Muller cited this article to rebut Dr. van der Weide testimony concerning possible modifications to the system disclosed in Voigt to accommodate multiple cameras. Ex. 1036 at ¶ 46.

Exhibit 1012 is offered in conjunction with Dr. Muller's testimony concerning well-known principles of photogrammetry by July 26, 2000. Exhibit 1012 provides relevant background concerning the knowledge that a POSA would have had with respect to using camera coordinates to effect measurements of imaged features. Exhibit 1012 assists in resolving how a POSA would construe and interpret limitations relating to such camera-based measurements found on the claims of the '748 patent. Ex. 1016 at ¶ 60. This exhibit, according to Dr. Muller, explains that it was a well-known principle of photogrammetry, that the scale of an image relative to the object imaged is determined by the ratio of the focal length of the camera to the distance from the front camera lens to the object imaged. The '748 patent recites measuring imaged features using a camera's focal length, its

resolution, its coordinates and its predetermined distance relative to the specified imaging position. Exhibit 1012 is relevant to an understanding of these limitations..

Exhibit 1013 is relevant both to the background knowledge of a POSA and how a POSA having such knowledge would understand the disclosures in Voigt (Ex. 1003). Dr. Muller relied upon the reference to generally explain the concept of topographic photogrammetry, *i.e.*, the measurement of photographed features from a distance. Ex. 1016 at ¶¶ 154, 236. Specifically, Dr. Muller testified how a person of skill in photogrammetry would understand the calculations performed in Voigt to measure skin lesions shown in the captured image based upon Voigt's disclosure (Ex. 1003).

Exhibits 1014 and 1015 are relevant to the background knowledge of a POSA regarding the state of the art and how that background knowledge would be applied to the disclosure of one of the references included in an invalidity ground. Exhibits 1014 and 1015 provide background concerning the knowledge a POSA would have had regarding the growing acceptance of the use of USB cables and hubs as of the time of the invention. Dr. Muller testified that both explain the state of the art generally and inform a POSA's interpretation of prior art, such as the prior art Dye reference (Exhibit 1007) cited as invalidity grounds. Dye is one of the prior art references cited in Ground 5 for its disclosure of the use of USB in a system for displaying 2D and 3D objects. Ex. 1016 at ¶¶ 98, 99, 208.



In addition, Patent Owner's expert Dr. van der Weide himself relied upon Exhibit 1015 in support of his opinions. Dr. Muller's discussion of both Exhibits 1014 and 1015 is further relevant as rebuttal to the opinions of Patent Owner's expert. The Patent Owner's expert, Dr. van der Weide, in his own testimony of the state of the art also block-quoted and cited Exhibit 1015 in a paragraph referenced in the Patent Owner's Response. Ex. 2019 at ¶ 45, Paper 23 at p. 29. The Patent Owner cannot both rely upon Exhibit 1015 and seek to exclude it.

The Patent Owner further argues that, even if relevant, the admission of these exhibits would be unduly prejudicial. Patent Owner identifies no such prejudice. In view of the relevance for each exhibit set forth above and the lack of identification of any prejudice, the Patent Owner has not met its burden to show that these exhibits should be excluded.

Because each of Exhibits 1008, 1009, 1011-1015 are relevant to the state of the art and the background knowledge that a POSA would bring to interpreting the prior art relied upon in the invalidity grounds, they are all relevant and should not be excluded. Further, Exhibit 1011 is also relevant to Dr. Muller's qualifications as an expert and should not be excluded.

#### **IV. THE IDENTIFIED PORTIONS OF EXHIBIT 1036 ARE RELEVANT TO THE BACKGROUND KNOWLEDGE OF ONE OF SKILL IN THE ART, THE SCOPE OF RELEVANT ART, AND THE INTERPRETATION OF REFERENCES CITED IN INVALIDITY GROUNDS**

The Patent Owner alleges that certain portions of Dr. Muller's declaration testimony (Exhibits 1016 and 1036) are not relevant and are unduly prejudicial. Each identified paragraph is relevant and Patent Owner has failed to establish any basis for their exclusion. .

With respect to Exhibit 1016, Melanoscan seeks to exclude paragraphs 396 and 397, alleging that they relate only to an invalidity ground not asserted in the petition. Paragraph 396 and 397 are relevant to provide background information regarding the use of USB ports and hubs at the time of the invention and are relevant to the Voigt, Crampton, and Dye combination of Ground 5. In paragraph 396, Dr. Muller testified that Exhibit 1014 discloses that a POSA would appreciate as many as 127 devices could be connected to the computer through a series of USB hubs and that this is important when using multiple devices such as digital cameras. Ex. 1016 at ¶ 296. This is relevant to a POSA's understanding of Dye's discussion of the use of USB and to the background knowledge one would bring when reading the references asserted in Ground 5.

In paragraph 397, Dr. Muller testified that the use of USB hubs to connect peripheral devices was a known substitute for prior connections, such as those used

in Daanen (Exhibit 1005). This is relevant to a POSA's background knowledge of the substitutability of connectors, such as those used in the references relied upon in Ground 5 and to the motivation to combine those references.

The challenged portions of Exhibit 1036 (*i.e.* portions of paragraphs 9, 28, 36, 43, 46, 81, 82, 97, 98) are proper rebuttal to the arguments advanced and expert opinions submitted by the Patent Owner. With respect to portions paragraphs 9, 28, 36, 43, 46, 81, 82, 97, 98, Patent Owner's relevance objections merely reprise the arguments already discussed and disposed of in Section III, above Patent Owner's additional argument that the cited testimony and exhibits constitute impermissible new grounds of unpatentability or improper attempts to bolster the Petition are incorrect. Petitioner has not asserted these exhibits as new invalidity combinations, but has instead made appropriate reference to them in order to rebut Patent Owner's arguments.

In paragraphs 97 and 98 of Exhibit 1036, Dr. Muller testifies regarding Exhibits 1014 and 1015 (the USB references discussed above) in response to Dr. van der Weide's declaration testimony (Ex. 2016 at ¶ 45) regarding the state of USB technology. Indeed, Patent Owner's expert himself relied upon Exhibit 1015 in support of his opinions. Dr. Muller's testimony in these paragraphs is not only relevant to the state of the art and the background knowledge of a person of skill,

but is directly responsive to the Patent Owner's expert. His testimony should not be excluded. *See Belden*, 803 F.3d at 1077–79.

The Patent Owner seeks to exclude portions of paragraphs 28, 36, 46, and 55 of Exhibit 1036. These portions make reference to Exhibit 1034 (a contemporaneous patent issued to the authors of the prior art Hurley article (Exhibit 1004) ). The Patent Owner further seeks to exclude portions of paragraphs 81 and 82 that refer to Exhibit 1033. Exhibit 1033 is an article authored by the authors of Hurley 1004. This article is cited in prior art Daanen article (Exhibit 1005). These paragraphs of Dr. Muller' declaration (Exhibit 1036), as well as the references to which they refer (Exhibits 1033-34), are offered to rebut arguments made by Patent Owner and testimony provided in Patent Owner's declaration.

In Dr. Muller's initial declaration, he testified that a POSA would understand the Hurley article (Exhibit 1004) to disclose a specified position where the person being imaged is located based upon its discussion of the use of a calibration object. *See* Ex. 1016 at ¶¶ 90, 91, 126, 137, 219, 245, 248, 251. The Patent Owner challenged this reading of Hurley. Paper 17 at pp. 3, 9, 12, 13, 17-21. The Patent Owner similarly objected to Dr. Muller's statements that the Daanen article (Exhibit 1005) describes the use of steady mounted cameras of the type disclosed in the Hurley article. *Id.* In response to these objections, Petitioner

timely served its disclosure of supplemental evidence (attached hereto as Exhibit 1049) on April 27, 2018, identifying Exhibits 1033, 1034, and a further declaration from Dr. Muller (Exhibit 1031) addressing Melanoscan's objections. *See* Exhibit 1031 at ¶¶ 5-11. Petitioner further timely sought authorization on April 30, 2018, to file these same exhibits as supplemental information pursuant to 37 C.F.R. § 42.123(a)(1). With leave of the Board, the parties briefed the request to file supplemental information in Paper 19 and Paper 21.

In its Response, Patent Owner further reiterated these arguments *See, e.g.*, Paper 23 at pp. 20, 31, 51-52.

Besides being properly considered as supplemental evidence (*see* Paper 19), Exhibits 1033 and 1034 (and Dr. Muller's accompanying discussion thereof) are also properly considered to rebut the arguments advanced by Patent Owner, and the opinions of its expert.

Exhibit 1033 provides context regarding the understanding that a POSA would have had when reading the discussion in the Daanen article (Ex. 1005) of the TC<sup>2</sup> scanning system. Dr. Muller testified that a POSA would have understood that Daanen was referencing the technology described in Hurley Exhibit 1004, based upon its inclusion of identical photographs of the system described in Exhibit 1004, its discussion of similar advantages and features, and its citation to the

companion article of the Hurley authors concerning the same system (Exhibit 1033). *See* Ex. 1031 at ¶¶ 5-8.

Similarly, Exhibit 1034 rebuts the arguments advanced by Patent Owner, and the opinions of its expert, by provides further context regarding the understanding a POSA would have had when reading the disclosures in Hurley Exhibit 1004. Patent Owner has asserted that the disclosures in the Hurley article (Exhibit 1004) are incompatible with use of a specified imaging position. *See* Exhibit 1031 at ¶¶ 9-11. Exhibit 1034 and Dr. Muller’s discussion in these paragraphs that make reference to it, however, are presented to rebut these arguments and opinions advanced by Patent Owner. These references merely confirm Dr. Muller’s original positions presented in the petition. They do not constitute new grounds or material shifts in Petitioner’s arguments. *See Belden v. Berk-tek LLC*, 803 F.3d 1064, 1077–79 (Fed. Cir. 2015) (“Evidence admitted in rebuttal to respond to the patent owner's criticisms will commonly confirm the prima facie case. That does not make it necessary to the prima facie case.”); *accord. Pacific Market Int’l, LLC v. Ignite USA, LLC*, IPR2015-00561, Paper No. 23 at p. 3-4 (PTAB 2014) (allowing additional evidence that confirms the prima facie case set forth in the petition).

While Canfield is not required to show that supplemental information could not have been included earlier, until the Patent Owner raised its arguments, it was

not apparent that this additional context would be necessary to clarify the understanding of a POSA upon reading Hurley (Exhibit 1004) and Daanen (Exhibit 1005). *Blue Coat Sys, Inc. v. Finjan, Inc.*, IPR2016-01444, Paper 28 (PTAB 2017). Rebuttal to the patent owner's criticisms is appropriate in a Reply. *Valmont Industries, Inc. v. Lindsay Corp.*, 730 Fed. Appx. 918, 922 (Fed. Cir. 2018) ("Our case law makes clear that a petitioner may submit additional evidence in the reply in response to the patent owner's response."). In view of the Patent Owner's arguments regarding Daanen and its discussion of Hurley and Hurley's discussion of the specified imaging position, Exhibits 1031, 1033, and 1034 are all relevant as are the portions of Exhibit 1036 discussing these exhibits.

The Patent Owner further seeks to exclude the last sentence of paragraph 36 of Exhibit 1036. In this sentence, Dr. Muller rebuts Dr. van der Weide's opinion that a POSA reading Hurley Exhibit 1004 would not have understood that the device disclosed in Hurley functioned. Dr. Muller testified that Dr. van der Weide's interpretation disregards the full context of the article and the other prior art that would have been known to a POSA, such as the Hurley patent and Daanen's discussion of the Hurley/TC<sup>2</sup> device. The background knowledge that a POSA would have had when reading Hurley is relevant to whether that POSA would have shared Dr. van der Weide's unsupported assertions that the Hurley device would not function. *See, e.g., Ariosa*, 805 F.3d at 1365.

The Patent Owner also seeks to exclude paragraphs 43 and 46 of Dr. Muller's Declaration (Ex. 1036). In paragraph 43, Dr. Muller explains a POSA's motivation to combine Voigt with Hurley. The Patent Owner argues that this is improper because certain of the motivations cited by Dr. Muller come from sources not specified in the particular invalidity ground. But the motivation to combine is not required to be found in the references cited in the invalidity grounds themselves. The motivation to combine can be found in the prior art, the nature of the problem, or the knowledge of a person having ordinary skill in the art. *See, e.g., KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. 398, 420 (2007); *Cross Medical Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1322 (Fed. Cir. 2005). The exhibits about which Dr. Muller testified in paragraph 43, including Exhibits 1005, 1006, and the other cited art constitute information that would have been within the POSA's general knowledge and are relevant to the obviousness analysis.

Similarly, in paragraph 46, Dr. Muller testified regarding the general background knowledge that a POSA would have had relating to routine modifications that could be made when adding multiple cameras to Voigt (Exhibit 1003). Dr. Muller cites to Exhibits 1006, 1011, and 1034 as providing background information that would have been known to a POSA. The Supreme Court explained in *KSR* that this background knowledge possessed by a person having ordinary skill in the art, including inferences and creative steps that a person of



ordinary skill in the art would employ to combine references, is relevant to the obviousness analysis. *KSR*, 550 US at 417-418.

Finally, the Patent Owner objects to Dr. Muller's discussion of Dr. Drugge's deposition testimony at paragraphs 9-11 of his declaration (Exhibit 1036). The paragraphs of Dr. Muller's declaration directly respond to arguments of the Patent Owner and its expert. Patent Owner's expert, for example, asserted that one seeking to solve the problems the inventor sought to solve would not have deemed relevant systems directed to 3D imaging of the human body. Dr. Muller, however, noted that Dr. Drugge himself testified that he considered such 3D body scanning systems to constitute relevant prior art with respect to the problem to be solved. Specifically, Dr. Drugge testified that he looked to 3D scanning systems similar to those identified as grounds of invalidity. He admitted to having investigated, for example, the Cyberware WB4 system described in the prior art Daanen article (Exhibit 1005), one of the references relied upon in invalidity ground 4. While Dr. Muller had testified about the Cyberware product, including Figure 3 of Exhibit 1005, in his first declaration when describing that Exhibit's disclosures and the state of the art (*see* Exhibit 1016 at ¶ 71), he did not then have the benefit of Dr. Drugge own testimony that he deemed the Cyberware product relevant and that he had, in fact, looked to it when developing his own invention. Dr. Drugge's deposition was not taken until September 20, 2018. This information is relevant to

the scope of art that a POSA would have considered and to the relevance of 3D scanning systems when developing an imaging system such as the one disclosed in the '748 patent, and it directly rebuts the arguments and opinions advanced by Patent Owner. For these reasons, paragraphs 9-11 are relevant.

The Patent Owner asserts, in connection with each of its relevance arguments, that the testimony at issue is not relevant and, therefore, any probative value is substantially outweighed by a danger of unfair prejudice. However, the Patent Owner does not identify any such prejudice. Because Petitioner has established the relevance of each challenged paragraph of Exhibit 1036, the Patent Owner's motion to exclude those paragraphs should be denied.

#### **V. THE BOARD SHOULD CONSIDER EXHIBITS 1038-1047 IN THE INTERESTS OF JUSTICE**

As set forth in the parties' briefing in connection with Petitioner's Motion to Deem Reply and Supporting Exhibits Timely-Filed (Paper 39), the interests of justice require that the Board consider Exhibits 1038-1047, which were filed a few minutes after the midnight deadline to file those documents. *See Pacific Market*, Paper 40 at pp. 4-5; Paper 39.

#### **VI. CONCLUSION**

For the reasons set forth above, Melanoscan's Motion to Exclude Evidence should be denied in its entirety.

Respectfully submitted,

September November 14, 2018

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that, pursuant to 37 CFR §§ 42.6(e), copies of the foregoing “PETITIONER’S OPPOSITION TO PATENT OWNER’S MOTION TO EXCLUDE EVIDENCE” is being served today, November 14, 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:

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