

**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 REPLY IN SUPPORT OF ITS MOTION TO EXCLUDE  
EVIDENCE**

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## **I. INTRODUCTION**

Melanoscan's Opposition to Petitioner's Motion to Exclude lacks merit.

## **II. THE IDENTIFIED EVIDENCE SHOULD BE EXCLUDED**

### **A. The Patent Owner Identifies No Exception to the Hearsay Rule**

In response to Petitioner's objection that the Patent Owner's Response relies upon hearsay statements in the '748 Patent, Patent Owner does not identify a hearsay exception, but instead recharacterizes those statements in a manner contrary to its use in the Response (Paper 23). Despite citing to those portions of the patent to support statements in the Response describing how patient examination was conducted "[p]rior to the invention," the Patent Owner now seeks to limit its citation of the patent merely to "the inventor's belief that a need arose for his invention" and providing context about the advantages of his invention. The portions of the patent challenged, however, contain no such caveat. Rather, those portions state, without qualification, that "[t]here is a need" and "there exists a clear need." These statements constitute [incorrect] self-serving statements by the inventor regarding what existed in the art at the time of his invention and cannot be relied upon by the inventor for the truth of the matter asserted.

### **B. Patent Owner's Opposition Fails to Identify Support for Dr. Drugge's Challenged Testimony**

With respect to the challenged portions of Dr. Drugge's testimony, Patent Owner again seeks to reframe what was stated.

Among other reasons, Dr. Drugge's testimony concerning purported results using his TIP device are properly excluded because Dr. Drugge testified that he did not actually employ his TIP device to achieve the measurements he describes. Dr. Drugge acknowledged during deposition questioning that the measurements he made of the described lesion were made using a hand held visual magnifying device known as a dermoscope. Ex. 1039 at p. 91 of 253, ll. 17-22. This measurement was not made using the TIP device. Ex. 1039 at p. 89 of 253, l. 25-p. 90, l. 1. No nexus exists between the described measurements and the practice of the claimed invention. The testimony regarding the use of the TIP technology to detect a specific melanoma should be excluded.

With respect to Dr. Drugge's characterizations of the state of the art in Paragraphs 22 and 27 of Exhibit 2010, Patent Owner seeks to recast these statements as relating only to "the typical situations that Dr. Drugge had experienced in his work." Paper 50 at p. 9. Dr. Drugge's statements are directed much more broadly stating that "one could not obtain the necessary repeatable imaging conditions," "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." Rather than identifying any evidence showing that Dr. Drugge had personal knowledge sufficient to support

such broad contentions, Patent Owner admits that his knowledge is limited only to those situations he has experienced. Patent Owner admits that Dr. Drugge lacks personal knowledge, for example, of Voigt Exhibit 1003, a 1995 article discussing the use of photographic image analysis of cutaneous lesions in melanoma screening. Paper 50 at 9-10. This lack of knowledge of technology used to examine patients for melanoma supports Petitioner's objection that Dr. Drugge lacks the necessary personal knowledge to testify regarding the state of the art in patient examination and regarding what was possible or impossible in photography techniques at the time as he has done in ¶¶ 22 and 27 of Exhibit 2010.

The cases cited by Patent Owner are inapposite. The question in *U.S. v. Hickey* was whether or not a witness lacks personal knowledge in light of an admitted drug addiction. *United States v. Hickey*, 917 F.2d 904 (6th Cir. 1990). No such allegations have been made here. In *Broadcast Music*, while it is unclear what statements were challenged for lack of personal knowledge, the court found that the witness's work on behalf of the plaintiff and her knowledge of the facts and circumstances of the case provided a basis for her challenged statements. *Broad. Music, Inc. v. Texas*, 2012 WL 4119111 at \*3 (N.D. Tex. Sept. 18, 2012). Rather than offering a basis for Dr. Drugge to characterize what was or was not impossible in imaging patients, Patent Owner instead admits to the limited scope of his knowledge. Without support, Dr. Drugge's testimony 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**

With Dr. van der Weide's declaration, Patent Owner again seeks to recharacterize the challenged testimony, arguing that Dr. van der Weide has done nothing more than identify differences in the prior art combinations that would be relevant for purposes of motivation to combine. Again, as with Dr. Drugge, Dr. van der Weide's testimony goes much further. For example, in paragraph 64 of his declaration, Dr. van der Weide states "a POSA would not even consult the non-photographic arts, including Hurley, to combine with Voigt" because Hurley, despite using a CCD camera to capture images, was allegedly not using photography. This goes beyond the fact question of whether a POSA would have a motivation to combine and is instead directed to whether or not the non-photographic arts would have been consulted by a POSA. That is a question of whether or not the art is analogous, which turns on the scope of the claimed invention. *See In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). Thus, Dr. van der Weide is testifying, without basis, that the claims of the patent are limited to his definition of photography. Dr. van der Weide again makes this distinction regarding whether the references perform "photography" in the other challenged paragraphs. Because this testimony is premised on an improper claim construction, it should be excluded.

The cases cited by Patent Owner do not require a contrary result. *Apple v. Samsung* merely affirms a jury's determination that a particular prior art reference would not have provided a motivation to combine. *Apple Inc. v. Samsung Elecs. Co.*, 839 F.3d 1034, 1051 (Fed. Cir. 2016). The *Procter & Gamble* case applies the analogous art test to determine that a reference does not constitute analogous art, and then states that even if it were analogous, there would be no motivation to combine. *Procter & Gamble Co. v. Team Techs., Inc.*, No. 1:12cv552, 2014 WL 12656554 at \*25 (S.D. Ohio July 3, 2014). The Patent Owner contends that Dr. van der Weide is not arguing that the art is non-analogous, so the court's analysis finding the reference non-analogous offers no relevant guidance.

Because Dr. van der Weide's testimony goes beyond an analysis of the motivation to combine and instead improperly limits the scope of the claims, it should be excluded.

### **III. CONCLUSION**

For the reasons set forth above and in Petitioner's Motion to Exclude Evidence, the identified evidence should be excluded.

Respectfully submitted,

November 21, 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 REPLY IN SUPPORT OF ITS MOTION TO EXCLUDE EVIDENCE” is being served today, November 21, 2018 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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