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**UNITED STATES PATENT AND TRADEMARK OFFICE  
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 No. IPR2017-02125

Patent No.: 7,359,748

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**PATENT OWNER'S REPLY IN SUPPORT OF ITS  
MOTION TO EXCLUDE**

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## **I. INTRODUCTION**

Patent Owner (“Melanoscan”) submits this Reply in further support of its Motion (“Mot.”) to Exclude Petitioner’s (“Canfield’s”) evidence (Paper No. 47).

## **II. ARGUMENT**

### **A. Paragraphs 396 and 397 of Muller’s Declaration (Ex. 1016) Should Be Excluded**

Muller testifies in these paragraphs that a combination of Voigt, Crampton, Dye and Ex. 1014 renders claims unpatentable, even though this IPR was not brought or instituted on any such ground. Mot., 1-2. Canfield does not contend the IPR includes such a ground, but rather that these paragraphs merely provide “background” information on prior art use of Universal Serial Buses (“USB”). Paper No. 51 (“Opp.”), 7. This is clearly not true.

These paragraphs are in a section entitled “Obviousness of Claim 46 over Voigt in combination with Crampton, Dye and Office World [Ex. 1014].” After contending that Ex. 1014 discloses USB hubs, Muller opines that

[I]n combination with Voigt, Crampton, and Dye, it would have been obvious to one of ordinary skill in the art to use the USB hubs discussed in Office World in the system created by the combination of Voigt, Crampton, and Dye ... USB hubs would be an obvious choice ... to use in such a system.

Ex. 1016 ¶¶ 396-97. Muller is unequivocally asserting unpatentability over a combination including Ex. 1014, not merely providing “background” information. As the Petition asserts no ground including such combination, these paragraphs will not help the trier of fact to understand the evidence or to determine a fact in

issue, and should be excluded. *See* Fed. R. Evid. 401.

**B. The Portions of Muller’s Declaration (Ex. 1036) Identified in Melanoscan’s Motion Should Be Excluded**

The identified portions of Ex. 1036 should be excluded for the reasons set forth in the Motion (p. 2-9). Canfield’s arguments to the contrary are unavailing.

Starting with Muller’s testimony on Ex. 1034, the exhibit is not referenced in the Petition<sup>1</sup>. The Board agreed with Melanoscan on Ground 3 of the Petition that Hurley does not have the claimed “specified imaging position.” Paper No. 15, 29-30. Hence, Canfield seeks to use Ex. 1034 to improperly bolster the Petition on this point. *See Mitsubishi Plastics, Inc. v. Celgard, LLC*, IPR2014-00524, Paper 30, at 5-6 (P.T.A.B. Nov. 28, 2014); Paper No. 21, 2-4. Canfield argues against exclusion by asserting that Ex. 1034 “confirm[s] Dr. Muller’s original positions presented in the petition” that Hurley has a “specified imaging position.” Opp., 11; *see* Ex. 1036 ¶ 55 (“As discussed in [Ex. 1034], Hurley uses a foot map to mark” where the person stands). This is not correct. Ex. 1034 makes no reference to Hurley, and, contrary to Canfield’s contentions, was not “contemporaneous” with it – it was filed well-after Hurley’s publication. It confirms nothing about Hurley.

Moreover, it is clear Ex. 1034 is impermissibly being asserted as an additional reference to demonstrate obviousness. Muller states “it would have been

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<sup>1</sup> Exs. 1033 and 1034 are not in evidence and the Board should not allow them into evidence for the reasons Melanoscan has previously set forth. *See* Paper No. 21, 2-4.

obvious to incorporate indicators of the type described [in Ex. 1034] to designate the calibrated position at which the person was to stand for imaging.” Ex. 1036 ¶ 28. He further contends that Voigt could be modified using “a number of means [] available to position a patient,” citing Ex. 1034 as “disclosing the use of footprints.” Ex. 1036, ¶ 46. Thus, Muller alleges that a POSA would modify art cited in the Petition in view of Ex. 1034 to add footprints or another “indicator.” This constitutes an improper new combination of prior art not asserted in the Petition. *See VTech Commc’ns, Inc. v. Spherix Inc.*, IPR 2014-01431, Paper 7, at 3-4 (P.T.A.B. Apr. 7, 2015); Office Patent Trial Practice Guide, August 2018 Update at 14-15; *see also* Paper Nos. 21, 2-4; 40, 3.

Canfield likewise seeks to use Ex. 1033 to improperly bolster the Petition. *See Mitsubishi Plastics*, at 5-6. Canfield contends Muller’s discussion of Ex. 1033 merely “provides context” to a POSA reading Daanen. Opp. 10-11. What Muller contends, though, is that a POSA would analyze the disclosure of Ex. 1033, compare it to Hurley, and based on that comparison, combine Daanen with Hurley. Ex. 1036 ¶ 82. That is, Muller contends a POSA would combine Daanen and Hurley in view of the teachings of Ex. 1033. Ex. 1033 is thus precisely the type of belated new evidence that is prohibited, even though it may be “in response to arguments presented in Patent Owner’s” papers. *See Laboratoire Francais du Fractionnement et des Biotech. S.A. v. Novo Nordisk Healthcare AG*, IPR2017-

00028, Paper 22, at 3-4 (P.T.A.B. June 13, 2017); *see also* Paper No. 21, 2-4.

Canfield's case law is inapposite. *Belden* involved testimony about prior art asserted in the petition, not later-asserted art. 805 F.3d 1064, 1077-79 (Fed. Cir. 2015). So did *Pacific Mkg.*, IPR2015-00561, Paper 23, at 3-4 (P.T.A.B. Dec. 2, 2014), and *Valmont*, 730 Fed. Appx. 918, 922 (Fed. Circ. 2018). *Belden* found that the prior art in the petition supplied the prima facie case. 805 F.3d at 1079. Here, Muller relies on the new art to make a prima facie case, *i.e.*, a POSA would modify art cited in the petition in view of the new art. Ex. 1036 ¶¶ 28, 46. *Blue Coat Sys*, IPR2016-01444, Paper 28, at 3-4, 7 (P.T.A.B. Oct. 23, 2017), and *Seabery*, IPR2016-00840, Paper 40, at 2, 4 (P.T.A.B. Mar. 15, 2017) are even further afield, relating to documents supporting publication dates of prior art cited in petitions.

As for the other identified portions of Ex. 1036, Canfield contends that Muller's discussions of prior art and combinations not asserted in the Petition permissibly discuss the "state of the art." Opp., 12-13. However, here too Muller relies on such not for "the state of the art," but to allege obviousness, and thus impermissibly asserts new grounds of unpatentability. *See, e.g.*, 1036 ¶¶ 43 (POSA would combine Voigt and Hurley in view of Crampton's teachings); 98 ("POSA would understand from the disclosure of Exhibits 1014 and 1015 that the use of USB ... was obvious"); *see also VTech Commc'ns*, Paper 7, at 3-4.

**C. Exhibits 1011-1015 Should Be Excluded Because They Are Relied On For Obviousness**

Canfield contends that these Exhibits relate merely to “background knowledge” of a POSA. Opp., 2. Yet Muller alleges that these documents should be combined with art cited in the Petition to render claims unpatentable. Muller explicitly combines Exs. 1014 and 1015 with other prior art. Exs. 1016 ¶ 16-17; 1036 ¶ 98. Similarly, Muller alleges that it would be obvious to modify Voigt in view of Exs. 1012 and 1013. Ex. 1016 ¶¶ 154-55, 236-237. Muller further alleges that a POSA would substitute Voigt’s positioning framework with the X-ray cephalostat of Ex. 1011. Ex. 1036 ¶ 46. Thus, Muller asserts unpatentability based on these exhibits combined with prior art cited in the Petition. As the Petition fails to assert, and the IPR contains no grounds, including such combinations, they should be excluded as not relevant. *See* Fed. R. Evid. 401.

**D. Exhibits 1038-1047 Should Be Excluded**

For the reasons Melanoscan explained in its opposition (*see* Paper No. 40, 1-3) to Canfield’s motion to deem its reply and accompanying exhibits timely (Paper No. 39), Canfield’s untimely filing of these documents should not be excused. The documents should thus be excluded. *See id.*

**III. CONCLUSION**

For the reasons set forth herein and Melanoscan’s opening brief (Paper No. 47), the Board should grant Melanoscan’s motion to exclude in its entirety.



Date: November 21, 2018

*Respectfully Submitted*

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## **CERTIFICATE OF SERVICE**

I hereby certify that on this 21<sup>st</sup> day of November 2018, a true and correct copy of the foregoing Patent Owner's Reply in Support of Its 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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