

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

CANFIELD SCIENTIFIC, INC.,  
Petitioner

v.

MELANOSCAN LLC  
Patent Owner

---

Case IPR2017-02125  
U.S. Patent No. 7,359,748

---

**PATENT OWNER'S MANDATORY NOTICES  
PURSUANT TO 37 C.F.R. § 42.8**

Pursuant to 37 C.F.R. § 42.8(a)(2), Patent Owner Melanoscan LLC (“Melanoscan”) hereby submits the following mandatory notices in connection with Canfield Scientific, Inc.’s Petition for *Inter Partes* Review of U.S. Patent No. 7,359,748, Case No. 2017-02125.

**I. 37 C.F.R. § 42.8(b)(1): REAL PARTY-IN-INTEREST**

The real party-in-interest is Melanoscan LLC.

**II. 37 C.F.R. § 42.8(b)(2): RELATED MATTERS**

Melanoscan identifies the following matter under 37 C.F.R. § 42.8(b)(2):

*Canfield Scientific, Inc. v. Melanoscan LLC and Dr. Rhett Drugge*, C.A. No. 16-4636 (D.N.J.).

That matter will affect a decision in this proceeding because it bars institution of the petitioned for Inter Partes Review pursuant to 35 U.S.C. § 315(a). The present petitioner (Canfield Scientific, Inc.) filed that matter as an action for declaratory judgment of noninfringement of U.S. Patent No. 7,359,748 that is the subject of this Petition. Petitioner subsequently filed for a declaratory judgment of invalidity of the patent in that matter almost three months prior to the filing of this Petition. Thus, 35 U.S.C. § 315(a) bars institution of the Inter Partes Review of the patent sought by Petitioner.

### **III. 37 C.F.R. § 42.8(b)(3): LEAD AND BACK-UP COUNSEL**

#### Lead Counsel for Melanoscan:

Mark D. Giarratana (Reg. No. 32,615)  
mgiarratana@mccarter.com  
McCarter & English, LLP  
CityPlace I  
185 Asylum Street, 36th Floor  
Hartford, CT 06103  
Tel.: 860-275-6700  
Fax.: 860-724-3397

#### Back-Up Counsel for Melanoscan:

Kevin L. Reiner (Reg. No. 43,040)  
kreiner@mccarter.com  
McCarter & English, LLP  
CityPlace I  
185 Asylum Street, 36th Floor  
Hartford, CT 06103  
Tel.: 860-275-6700  
Fax.: 860-724-3397

### **IV. 37 C.F.R. § 42.8(b)(4): SERVICE INFORMATION**

Please address all correspondence to the lead and back-up counsel as listed above.

Melanoscan consents to electronic service by email to all of the following email addresses:

mgiarratana@mccarter.com  
kreiner@mccarter.com  
bbanjac@mccarter.com  
hartforddocketing@mccarter.com.

Dated: October 12, 2017

By:           /Kevin L. Reiner/          

Mark D. Giarratana (Lead Counsel)

Reg. No. 32,615

mgarratana@mccarter.com

McCarter & English, LLP

CityPlace I

185 Asylum Street, 36th Floor

Hartford, CT 06103

Kevin L. Reiner (Back-up Counsel)

Reg. No. 43,040

kreiner@mccarter.com

McCarter & English, LLP

CityPlace I

185 Asylum Street, 36th Floor

Hartford, CT 06103

Counsel for Melanoscan LLC

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of this PATENT OWNER'S MANDATORY NOTICES PURSUANT TO 37 C.F.R. § 42.8, including this Certificate of Service, has been caused to be served in its entirety on October 12, 2017 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.

Julianne M. Hartzell  
Sandip H. Patel  
Thomas L. Duston  
Marshall, Gerstein & Borun LLP  
6300 Willis Tower  
233 South Wacker Drive  
Chicago, IL 60606-6357  
jhartzell@marshallip.com  
spatel@marshallip.com  
tduston@marshallip.com  
docket@marshallip.com

Dated: October 12, 2017

By:           /Kevin L. Reiner/            
Kevin L. Reiner (Back-up Counsel)  
Reg. No. 43,040  
kreiner@mccarter.com  
McCarter & English, LLP  
CityPlace I  
185 Asylum Street, 36th Floor  
Hartford, CT 06103  
  
Counsel for Melanoscan LLC