

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
Patent 7,359,748 B1

Before MICHAEL W. KIM, *Vice Chief Administrative Patent Judge*, and
LYNNE H. BROWNE and SCOTT C. MOORE, *Administrative Patent
Judges*.

MOORE, Administrative Patent Judge.

ORDER
Conduct of Proceeding
37 C.F.R. § 42.5

In its petition (Paper 9, “Petition” or “Pet.”),¹ Petitioner requested an *inter partes* review of claims 1–8, 11, 30, 32–34, 46, and 51 of U.S. Patent No. 7,359,748 B1 (Ex. 1001, the “’748 patent”), on the following grounds:

Ground	References	Basis	Challenged Claims
1	Voigt and Hurley	§ 103(a)	1–5, 8, 11, 30, 33, 34, 46, and 51
2	Voigt and Crampton	§ 103(a)	1–4, 8, 11, 30, 33, 34, and 51
3	Hurley	§ 103(a)	1–8, 11, 30, 33, 34, and 46
4	Voigt, Hurley, Daanen	§ 103(a)	6 and 7
5	Voigt, Crampton, Dye	§ 103(a)	32 and 46

Pet. 2.

On May 26, 2019, we issued a final written decision determining that Petitioner had failed to demonstrate by a preponderance of the evidence that any of the challenged claims was unpatentable. Paper 62. Petitioner subsequently appealed.

On February 28, 2021, the Court of Appeals for the Federal Circuit determined that claims 1 and 51 were unpatentable as obvious over the teachings of Voigt in combination with Hurley, Crampton, and/or Daanen, vacated our final written decision as to dependent claims 2–8, 11, 30, 32–34, and 46, and remanded the case to us for a determination as to the patentability of these dependent claims. *See Canfield Scientific, Inc. v. Melanoscan, LLC*, Case No. 19-1927, D.I. 51 (Fed. Cir. Feb. 18, 2021) (“Federal Circuit Decision” or “Fed. Cir. Dec.”).

¹ Reference to the Petition herein refer to the Corrected Petition, entered November 27, 2017.

A conference call with the parties was held on May 6, 2021, concerning how to proceed on remand. During that conference call, the parties agreed that the Federal Circuit Decision that claims 1 and 51 were unpatentable over the combined teachings of Voight and other references, did not revive Ground 3, which is based on Voight alone. Accordingly, the parties agree that Ground 3 is not within the scope of the remand.

Regarding Ground 4, which challenges dependent claims 6 and 7, the parties disagreed during the conference call as to whether this ground was revived by the Federal Circuit Decision. Petitioner argued that the Federal Circuit Decision addresses Petitioner's arguments regarding claims 6 and 7 and thus establishes that these claims are unpatentable, notwithstanding the fact that the Federal Circuit did not so hold. Patent Owner disagreed, and argued that the Federal Circuit Decision does not extinguish all of its arguments for the patentability of claims 6 and 7.

Regarding Grounds 1, 2, and 5, Patent Owner focused its arguments during trial on independent claims 1 and 51. Paper 23 ("Response" or "Resp."), 10–50, 61. Patent Owner's Response did not raise any separate, substantive arguments regarding the patentability of dependent claims 2–5, 8, 11, 30, 33, 34, and 46. *See id.* Petitioner argued during the conference call that Patent Owner waived the right to raise separate arguments for the patentability of dependent claims 2–5, 8, 11, 30, 33, 34, and 46 by failing to raise such arguments in the Response. *See* Paper 16, 6 ("The patent owner is cautioned that any arguments for patentability not raised in the response will be deemed waived."). Patent Owner argued during the conference that arguments for the patentability of claims 2, 3, and 34 remain live notwithstanding the fact that Patent Owner failed to raise those arguments

separately in the Response. According to Patent Owner, the Federal Circuit's decision finding independent claim 1 unpatentable did not necessarily address the rationales to combine that Petitioner relied on with respect to dependent claims 2 and 3. Patent Owner also argued that claim 34 contains additional limitations similar to those recited in claims 6 and 7, and that the patentability of claim 34 thus also remains a live issue.

Patent Owner did not argue during the conference that its Response set forth any arguments for the patentability of dependent claims 4, 5, 8, 11, 30, 33, or 46. Accordingly, it appears undisputed that Patent Owner waived the right to make any separate arguments for the patentability of at least these dependent claims. *See* Paper 16, 6.

In view of the foregoing disputes, we invite briefing on the issue of which (if any) arguments for the patentability of dependent claims set forth in the Response remain live on remand. If Patent Owner contends that arguments in the Response demonstrate patentability of claims 2, 3, 6, 7, and/or 34, Patent Owner may file a brief not longer than five pages that identifies, on a claim-by-claim basis, each argument for patentability that was set forth in the Response that allegedly remains live on remand. Patent Owner shall briefly explain why each such argument remains live on remand, and shall cite to the specific pages in the Response where each argument was made. Patent Owner shall file this brief not later than seven business days after entry of this Order. Patent Owner is reminded that any arguments not set forth in the Response were waived during the original trial and will not be considered on remand. Paper 16, 6.

To the extent Petitioner disagrees with any of Patent Owner's contentions, Petitioner may file a responsive brief of not more than five

pages that explains, on a claim-by-claim basis, why each argument set forth by Patent Owner was waived or is no longer viable. Any such response shall be filed not more than seven business days after Patent Owner's brief is filed.

Accordingly, it is hereby:

ORDERED that Patent Owner may file a brief of five pages or less in accordance with the foregoing instructions not more than seven business after entry of this order; and

FURTHER ORDERED that Petitioner may file a responsive brief up to five pages in length in accordance with the foregoing instructions not more than seven business days after the date Patent Owner's brief is filed.

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PETITIONER

Julianne Hartzell
Sandip Patel
Thomas Duston
MARSHALL, GERSTEIN & BORUN LLP
jhartzell@marshallip.com
spatel@marshallip.com
tduston@marshallip.com

PATENT OWNER:

Mark Giarratana
Kevin Reiner
MCCARTER & ENGLISH, LLP
mgiarratana@mccarter.com
kreiner@mccarter.com