
**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

CANFIELD SCIENTIFIC, INC.,
Petitioner

v.

MELANOSCAN LLC,
Patent Owner

Case No. IPR2017-02125

Patent No.: 7,359,748

**PATENT OWNER'S BRIEF REGARDING ARGUMENTS FOR
PATENTABILITY OF CLAIMS 2, 3, 6, 7 AND 34 THAT REMAIN LIVE
ON REMAND**

Patent Owner summarizes below with respect to claims 2, 3, 6, 7 and 34 the arguments for patentability that remain live on remand, including pin cites to the Response and a brief explanation of why each argument remains live on remand.

Canfield's arguments as to claims 6, 7 and 34 all require imaging devices behind the subject. Pet. 46 (arguing "modification of Voigt to incorporate the multiple cameras of Hurley [including rear camera arrays 1 and 2] to provide whole body imaging" where the "six views captured by Hurley . . . illustrate the result"), 77 ("POSA seeking to image the entire body in a single pose would . . . adopt the camera configuration of . . . Vitronic . . . in Voigt's enclosure" including a rear-facing "fourth imaging array (circled in blue and numbered 4)").

Patent Owner argued that "Voigt's rear wall . . . to which the sliders are mounted . . . would completely block the view of the cameras located behind the patient. Resp. 30-32." FWD 15; *see* Resp. 59 (images occluded). The Board found that Patent Owner "supports its assertions with detailed testimony from Dr. Van Der Weide. See Ex. 2019, ¶¶ 55-58." *Id.* 16. The Board agreed with and credited this testimony, pertinently finding that "Voigt's rear wall would have blocked the view of the two rear-facing cameras." *Id.* 16. The Board found that (i) "The Petition does not identify any specific modifications to Voigt's system . . ., much less offer any persuasive rationale for why a person of ordinary skill . . . would have implemented such modifications." *Id.* 17; *see also* 23-24; and (ii) "Petitioner's attempt[s] to

incorporate by reference the potential modifications and alternative unpatentability theories” from the Muller Declarations and Reply were improper. *Id.* 17-19; Resp. 32. Patent Owner further argued, and the Board found, that “[t]he Petition is devoid of any persuasive explanation of how Voigt’s position framework could have been modified to simultaneously employ both Hurley’s arrangement of imaging sensors and Daanen’s arrangement of arrays, or of why a person of ordinary skill . . . would have had reason to simultaneously use both Hurley’s imaging sensors and Daanen’s arrays.” FWD 31; Resp. 55-60.

The foregoing arguments remain live on remand and dictate affirming the patentability of claims 6, 7 and 34. Canfield admits that the Voigt and Hurley or Crampton combinations applied to claim 34, and the Voigt, Hurley and Daanen combination applied to claims 6 and 7, require cameras positioned to the rear of the subject. Pet. 46, 77. The Federal Circuit found that Voigt places the subject being imaged “against a wall of the enclosure.” Exhibit 2033 at 14. The Petition places the subject on Voigt’s stand between the horizontally adjustable sliders. Pet. 26-27. As summarized above, Canfield’s Petition fails to present any argument or evidence to remove Voigt’s rear wall, much less any specific modifications to Voigt’s position framework that would allow the rear-facing cameras to image the subject.

Petitioner argued during the May 6, 2021 conference call that the Federal Circuit found the Voigt combinations “place the subject at the center of the enclosure

surrounded by cameras and lights.” This is not correct. The law of the case doctrine “is limited to issues that were actually decided, either explicitly or by necessary implication.” *Transocean Offshore Deepwater Drilling, Inc. v. Maersk Drilling United States, Inc.*, 699 F.3d 1340, 1347 (Fed. Cir. 2012) (internal quotes omitted).

Canfield never argued before the Board that the Voigt combinations place the subject “at the center of the enclosure,” and therefore the Federal Circuit did not decide this issue, either explicitly or by necessary implication. To the contrary, Canfield argued that the subject “stood on the stand,” and the “standing position was fixed” by the “horizontally adjustable scaled sliders” on Voigt’s rear wall. Pet. 11-12, 26-27. On appeal, Canfield impermissibly asserted new unpatentability theories, but nevertheless placed the subject on Voigt’s stand fixed between the sliders on the rear wall, not at the center of the enclosure. Exhibit 2034 at 8 (“the person is positioned on a stand (red) . . . between sliders (blue)”), 23 (“Voigt would maintain its stand and adjustable sliders”), 28 (“Voigt’s sliders would continue to specify the imaging position and would continue to provide repeatable image registration”). Canfield never argued that the Voigt combinations “place the subject at the center of the enclosure.” Any such argument would have violated 35 U.S.C. § 312 and the Federal Circuit could not have decided the appeal on that basis. Rather, Canfield argued that the Voigt combinations meet claims 1 and 51 by substituting Hurley or Crampton’s front cameras for Voigt’s single camera with the subject being imaged

between the sliders. Pet. 29 (arguing that Hurley’s front cameras “3 and 4” meet the claimed “plurality of imaging devices”), 52-53; Exhibit 2034 at 22, 38, 49.

Canfield erroneously asserts that the Federal Circuit’s statements that (i) the Board did not mention “the placement of the subject at the center of the multi-camera system as in Hurley or Crampton,” and (ii) “Claims 1 and 51 are not limited as to the location of the subject being imaged,” Exhibit 2033 at 13, support its position. The Board did not mention “placement of the subject at the center” because it was never argued. And, while claims 1 and 51 do not necessarily limit the location of the subject, Canfield’s Petition did. The foregoing statements were “not necessary to the outcome” of the decision and thus “dicta and non-binding,” because the Federal Circuit held that claims 1 and 51 are obvious because they “place the subject within the enclosure, as in the prior art, and place multiple cameras and lights within the enclosure, as in the prior art.” Exhibit 2033 at 14; *Haddad v. Alexander, Zelmanski, Danner & Fioritto, PLLC*, 758 F.3d 777, 781 (6th Cir. 2014). Thus, in finding claims 1 and 51 obvious, the Federal Circuit determined only that it was necessary to “place the subject within the enclosure” not “at the center.” *Id.*; see *Transocean Offshore Deepwater Drilling, Inc.*, 699 F.3d at 1347 (law of the case limited to issues necessarily decided). Further, by issuing a general remand as to the other challenged claims, the Federal Circuit “did not intend to decide a factual issue that was not within its province.” *Chapman v. NASA*, 736 F.2d 238, 242 (5th Cir. 1984).

With respect to claims 2 and 3, Canfield's only asserted rationale for the combination was "to address Voigt's concerns with artificial shadowing" and to "avoid shadowing," respectively. Pet. 37-38, 55-56. Patent Owner argued, with citation to detailed testimony from Dr. Van Der Weide, that Canfield's rationales for modifying Voigt to "avoid shadowing" were flawed. Resp. 30-33; Ex. 2019, ¶¶ 55-58; *see also* Resp. 59. The Board credited the testimony and agreed with the arguments. FWD 15-16, 24. Patent Owner further argued that the only way to "avoid shadowing" "would be to completely remove Voigt's position framework," but then the combination "would lack the claimed specified imaging position/second means [and] a centerline defined thereby," "would not provide the claimed invention," "would render Voigt inoperable or unsatisfactory for its intended purpose," and "would also improperly change the principle of operation of Voigt." Resp. 30-35. The Federal Circuit found that in Hurley the front cameras image "the front and side of the body." Exhibit 2033 at 8. The Federal Circuit did not change the Board's finding that the Voigt combinations would include Voigt's sliders and the sliders would cause shadowing. FWD 16, 24. Hurley's or Crampton's front cameras necessarily would image the sliders, the sliders would cause shadowing and preclude Canfield's rationales, and therefore this argument remains live and dictates affirming the patentability of claims 2 and 3.

Date: December 3, 2021

Respectfully Submitted

By: /Mark D. Giarratana/

Mark D. Giarratana

Reg. No. 32,615

mgarratana@mccarter.com

Kevin L. Reiner

Reg. No. 43,040

kreiner@mccarter.com

McCarter & English, LLP

CityPlace I

185 Asylum Street, 36th Floor

Hartford, CT 06103

(860) 275-6700

(860) 724-3397 (fax)

Attorneys for Patent Owner

Melanoscan LLC

CERTIFICATE OF SERVICE

I hereby certify that on this 3rd day of December 2021, a true and correct copy of the foregoing PATENT OWNER'S BRIEF REGARDING ARGUMENTS FOR PATENTABILITY OF CLAIMS 2, 3, 6, 7 AND 34 THAT REMAIN LIVE ON REMAND 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:

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
lsolski@marshallip.com
docket@marshallip.com

Date: December 3, 2021

Respectfully Submitted

By: /Kevin L. Reiner/
Mark D. Giarratana
Reg. No. 32,615
mgiarratana@mccarter.com
Kevin L. Reiner
Reg. No. 43,040
kreiner@mccarter.com
McCarter & English, LLP
CityPlace I
185 Asylum Street, 36th Floor
Hartford, CT 06103

(860) 275-6700
(860) 724-3397 (fax)

Attorneys for Patent Owner
Melanoscan LLC