UNITED STATES PATENT AND TRADEMARK OFFICE

IN THE UNITED STATES PATENT TRIAL AND APPEAL BOARD

DIGITAL CHECK CORP. d/b/a ST IMAGING
Petitioner

v.

E-IMAGEDATA CORP.
Patent Owner

CASE NO. IPR2017-00177
U.S. PATENT NO. 8,537,279

PETITIONER'S RESPONSE IN OPPOSITION TO PATENT OWNER'S MOTION TO EXCLUDE

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Petitioner's Updated List of Exhibits

Ex. 1001: U.S. Patent No. 8,537,279 ("'279 Patent")

Ex. 1002: Declaration of Anthony J. Senn

Ex. 1003: *Curriculum vitae* of Anthony J. Senn

Ex. 1004: U.S. Publication No. 2004/0012827 ("*Fujinawa*")

Ex. 1005: U.S. Patent No. 5,585,937 ("*Kokubo*")

Ex. 1006: U.S. Patent No. 5,061,955 ("*Watanabe*")

Ex. 1007: 5100 FICHE SCANSTATION, Field Service Manual

Ex. 1011: Excerpt of Fundamentals of Machine Design textbook

Ex. 1012: Deposition Transcript of Jonathan Ellis

Ex. 1013: Excerpt of Illustrated Sourcebook of Mechanical Components textbook

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I. INTRODUCTION

Petitioner submits this Opposition to Patent Owner's ("PO") Motion to Exclude (Paper 15). It is PO's burden to show that the evidence is inadmissible. 37 C.F.R. § 42.20(c). Far from meeting this burden, PO's motion makes bare assertions and references to the Federal Rules of Evidence ("FRE") but fails to provide *any* explanation of how they apply or why the particular evidence is inadmissible.

The Board has made its position clear: "There is a strong public policy for making all information filed in a non-jury, quasi-judicial administrative proceeding available to the public, especially in an *inter partes* review which determines the patentability of claims in an issued patent. It is better to have a complete record of the evidence submitted by the parties than to exclude particular pieces." *Nichia Corp. v. Emcore Corp.*, IPR2012-00005, Paper 68, at 59 (PTAB Feb. 11, 2014). The Board has further clarified that a motion to exclude is not the forum to challenge the sufficiency of evidence. *Biomarin Pharm. Inc. v. Genzyme Therapeutic Prods. Ltd. P'ship*, IPR2013-00537, Paper 79, at 24-25 (PTAB Feb. 23, 2015). Against this backdrop, PO now moves to exclude annotated figures from the prior art, evidence that pertains to non-instituted grounds, and evidence that falls squarely within the bounds of admissibility under the FRE. As detailed below, PO's motion should be denied in its entirety.

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II. ARGUMENT

A. Drawings and Figures in the Petition Used to Illustrate Petitioner's Invalidity Theories are Admissible

PO seeks to exclude the illustration on page 11 of the petition. (Paper 15 at 3). The illustration is also found on page 11 of Exhibit 1002. The illustration is a schematic representation of the prior art used by the Petitioner to represent the well known features of the prior art. (Paper 1 at 11, Ex. 1002 at ¶28, Ex. 1004 at Fig. 4). The illustration helps frame Petitioner's invalidity theories. Petitioner's expert, Tony Senn, laid the foundation for the illustration as "a schematic representation of the Fujinawa microform imaging apparatus (e.g., Ex. 1004 at Fig. 4)…representative of the well known features of microform imaging apparatuses." (Ex. 1002 at ¶28). Mr. Senn is a mechanical engineer with over 25 years of experience in the field, including at least 10 years of design work on microform scanning equipment. (Ex. 1002 at ¶¶7-19). PO has not questioned Mr. Senn's credentials as one of skill in the art or his ability to opine on the prior art.

PO's assertion that the illustration is an "inaccurate and unfair representation of the purported prior art" (Paper 15 at 3) goes to weight, not admissibility. As laid out in *Corning Inc. v. DSMIP Assets B.V.*, the Board's approach to considering the admissibility of evidence is "[s]imilar to a district court in a bench trial, the Board, sitting as a non-jury tribunal with administrative expertise, is well-positioned to determine and assign appropriate weight to evidence presented."

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