

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

E-IMAGEDATA CORP.,  
Patent Owner.

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Case IPR2017-00177  
Patent 8,537,279 B2

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Before KEN B. BARRETT, JENNIFER MEYER CHAGNON, and  
MELISSA A. HAAPALA, *Administrative Patent Judges*.

HAAPALA, *Administrative Patent Judge*.

FINAL WRITTEN DECISION  
*35 U.S.C § 318(a) and 37 C.F.R. § 42.73*

Digital Check Corp. d/b/a ST Imaging (“Petitioner”) filed a Petition pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 44 and 49 of U.S. Patent No. 8,537,279 B2 (“the ’279 patent”). Paper 1 (“Pet.”). Applying the standard set forth in 35 U.S.C. § 314(a), we granted Petitioner’s request and instituted an *inter partes* review of all challenged claims. Paper 6 (“Dec.”).

During the trial, Patent Owner timely filed a Response (Paper 11, “PO Resp.”), to which Petitioner timely filed a Reply (Paper 14, “Reply”). Petitioner requested an oral hearing, but then withdrew its request and we canceled the hearing. *See* Papers 16, 20.

Additionally, Patent Owner filed a Motion to Exclude Evidence (Paper 15), to which Petitioner filed an Opposition (Paper 18), and Patent Owner filed a Reply (Paper 19).

We have jurisdiction under 35 U.S.C. § 6. This Decision is a Final Written Decision under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73 as to the patentability of the claims on which we instituted trial. Based on the record before us, we determine that Petitioner has shown, by a preponderance of the evidence, that claims 44 and 49 of the ’279 patent are unpatentable.

## I. BACKGROUND

### A. *The ’279 Patent (Ex. 1001)*

The ’279 patent describes a digital microform imaging apparatus (DMIA) that may be used to view/scan a broad range of microfilm media types (e.g., microfilm, microfiche, 16 mm or 35 mm film roll). *See* Ex. 1001, 1:12–13, 3:19–20, 7:50–53. The DMIA can accommodate a broad range of image reduction ratios without the need to change zoom lenses. *See id.* at 3:21–23. Figure 4 of the ’279 patent is reproduced below:

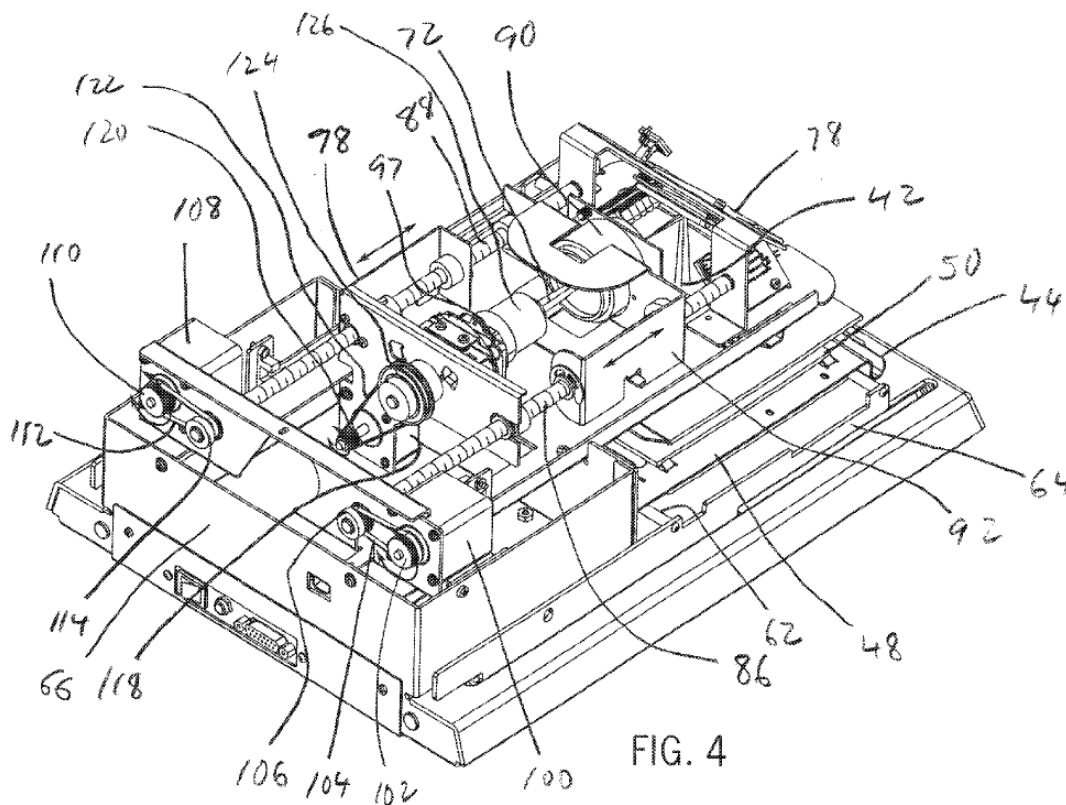


Figure 4 illustrates a perspective view of a DMIA with the cover removed and as viewed from generally rearward of the apparatus. *Id.* at 3:58–60.

The DMIA illustrated in Figure 4 includes: microform media support 44; chassis 66; mirror mount 78; first lead screw 86; second lead screw 88; lens 90; area sensor 97; first carriage 92; second carriage 98; first motor 100; second motor 108; timing pulleys 102, 106, 110, 114; and belts 104, 112. *See id.* at 5:1–6:5. Microform media support 44 is configured to support a microform media. *Id.* at 5:1–2. A fold mirror (not shown) reflects incident light transmitted through microform media and is connected to mirror mount 78, which is connected to chassis 66. *Id.* at 5:25–27, 5:30–32. Lens 90 is connected to first carriage 92, which is linearly adjustable by rotating first lead screw 86. *Id.* at 5:37–39. Area sensor 97 is connected to second carriage 98, which is linearly adjustable by rotating second lead screw 88.

*Id.* at 5:46–48. First motor 100 is rotationally coupled to first lead screw 86 by timing pulley 102, belt 104 with teeth, and timing pulley 106; and second motor 108 is rotationally coupled to second lead screw 88 by timing pulley 110, belt 112 with teeth, and timing pulley 114. *Id.* at 6:1–5.

A controller (not shown) is electrically connected to first motor 100, second motor 108, and area sensor 97. *Id.* at 6:5–7. The controller receives commands and inputs, controls first and second motors 100, 108 and other components of the DMIA, and outputs an image data of area sensor 97. *Id.* at 6:7–11. The layout of the DMIA, including separately adjustable area sensor 97 and lens 90, and algorithms for moving the lens and sensor to appropriate respective locations to achieve proper magnification and focus of the image allows the DMIA to autofocus to accommodate different reduction ratios of different film media without the need for iterative measurements and refocusing of lens 90. *Id.* at 5:55–64. The DMIA depicted in Figure 4 includes additional components not described.

#### *B. Illustrative Claim*

Claims 44 and 49 are independent claims. Claim 44 is illustrative of the subject matter at issue.

44. A digital microform imaging apparatus, comprising:
  - a chassis;
  - a fold mirror supported by the chassis;
  - a first elongated and substantially straight<sup>1</sup> lead member supported by the chassis;
  - a first carriage slidingly coupled to the first lead member;

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<sup>1</sup> The '279 patent includes a Certificate of Correction, which corrects “strait” to be “straight.” *See* Ex. 1001, 25.

an area sensor supported by the first carriage for movement therewith to adjust a distance between the area sensor and the fold mirror;

a lens supported by the chassis and positioned between the area sensor and the fold mirror; and

a first motor coupled to the first carriage via a first belt for moving the first carriage within a range of motion along at least a portion of the first lead member.

*C. Instituted Grounds of Unpatentability*

Petitioner relies on the following references:

1. U.S. Patent Application No. 2004/0012827 A1, published Jan. 22, 2004 (“Fujinawa”) (Ex. 1004).
2. U.S. Patent No. 5,585,937, issued Dec. 17, 1996 (“Kokubo”) (Ex. 1005).
3. U.S. Patent No. 5,061,955, issued Oct. 29, 1991 (“Watanabe”) (Ex 1006).

We instituted trial under 35 U.S.C. § 103(a) based on the following combinations of references. Dec 20.

References	Claim(s)
Fujinawa and Kokubo	44, 49
Fujinawa and Watanabe	49

In support of its contentions, Petitioner submitted a declaration by its witness, Anthony J. Senn, PE. Ex. 1002. In response, Patent Owner submitted a declaration by its witness, Jonathan D. Ellis, PhD. Ex. 2005. Both experts were cross-examined during the trial, and transcripts of their depositions are in the record. Exs. 2007 (Senn deposition); 1012 (Ellis deposition).

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