

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

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

v.

E-IMAGEDATA CORP.,  
Patent Owner.

---

Case IPR2017-00177  
Patent 8,537,279 B2

---

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

HAAPALA, *Administrative Patent Judge*.

DECISION  
Institution of *Inter Partes* Review  
37 C.F.R. § 42.108

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.”). e-ImageData Corp. (“Patent Owner”) filed a Preliminary Response. Paper 5 (“Prelim. Resp.”). Applying the standard set forth in 35 U.S.C. § 314(a), which requires demonstration of a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim, we grant Petitioner’s request and institute an *inter partes* review of all challenged claims.

## 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:

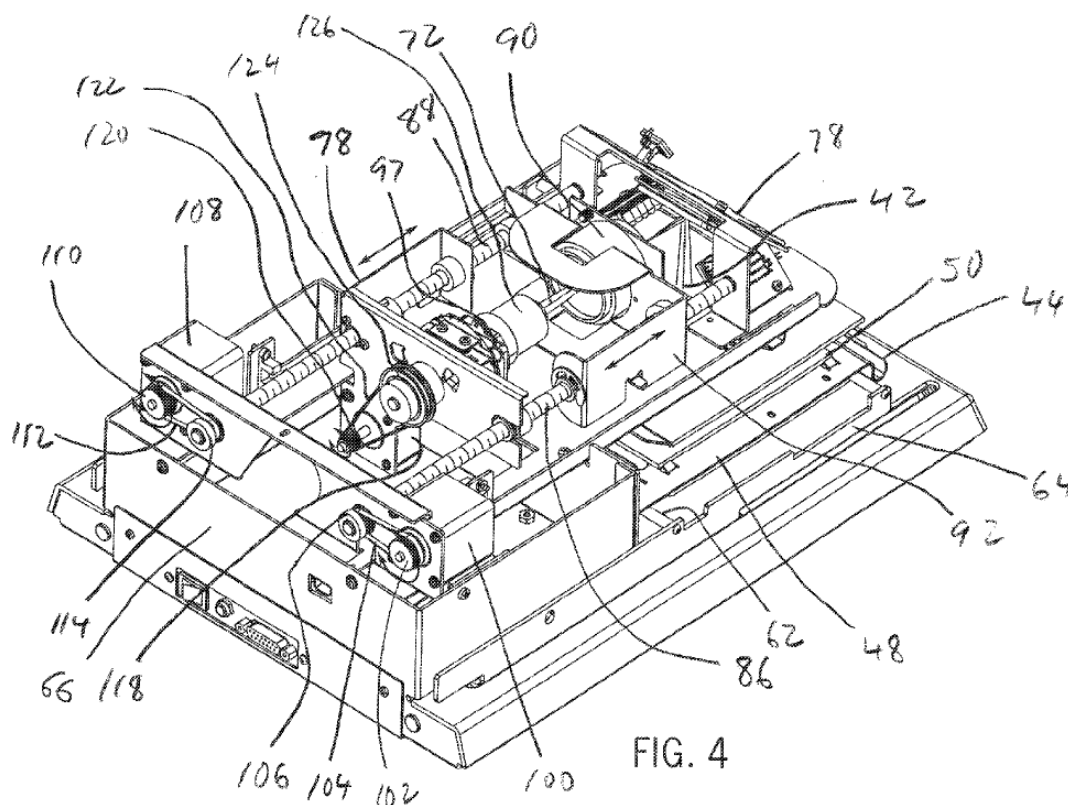


Figure 4 illustrates a perspective view of a DMIA with the cover removed and as viewed from generally rearward of the apparatus. *Id.* at 3:58–60.

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.

1. 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;

---

<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. References*

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).

### *D. Grounds Asserted*

Petitioner challenges the patentability of the claims of the ’279 patent under 35 U.S.C. § 103(a) over the following combinations of references:

References	Claims
Fujinawa and Kokubo	44, 49
Fujinawa and Watanabe	44, 49

### *E. Related Proceedings*

Patent Owner identifies the ’279 patent as a continuation of U.S. Patent No. 8,269,890 (’890 patent), and a parent to U.S. Patent No. 9,179,019 (’019 patent) and U.S. Patent No. 9,197,766 (’766 patent). Paper 4. Petitioner and Patent Owner identify numerous matters as related to this proceeding, including currently pending U.S. Patent Application No. 14/931,583, which is a continuation of the ’279 patent; Petitioner’s concurrently filed Petition for *inter partes* review of the ’019 patent

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.