

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

PATENT OWNER'S OBJECTIONS UNDER 37 C.F.R. § 42.64(b)(1)
TO EVIDENCE SUBMITTED WITH PETITION FOR *INTER PARTES* REVIEW

Patent Trial and Appeal Board
United States Patent and Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

Under 37 C.F.R. § 42.64(b)(1), Patent Owner e-ImageData Corp. objects to the admissibility of the evidence identified below that Petitioner submitted as exhibits to or referenced in its Petition for *Inter Partes* Review (Paper No. 1).

1. Petition

Patent Owner objects to the drawings and figures in the Petition under Fed. R. Evid. 401–403 and 901 as lacking authenticity, lacking foundation, assuming facts not in evidence, unfair representations, and unduly prejudicial. For example, the illustration on page 11 is an inaccurate and unfair representation of the purported prior art, is not authentic, and lacks foundation.

2. Ex. 1002

Under Fed. R. Evid. 702 and 703 and 37 C.F.R. § 42.65, Patent Owner objects to Exhibit 1002 (Senn Declaration). Mr. Senn’s statements and opinions are conclusory, do not attempt to take into account the level of skill in the art, and are based on neither sufficient facts and data nor reliable principles and methods. For example, Exhibit 1002 does not provide a sufficient explanation or rationale behind Mr. Senn’s assertions of obviousness or his stated motivations to combine. As another example, Exhibit 1002 does not explain how combinations of prior art would be implemented or achieved, nor how or whether such implementations would work.

Patent Owner additionally objects to Exhibit 1002 as lacking foundation, assuming facts not in evidence, containing testimony on matters as to which the witness lacks personal knowledge, conclusory and containing testimony concerning documents for which authentication required by Fed. R. Evid. 901 is lacking. For example, paragraphs 9, 28, 36, 49, 52, 69–79 are objected to as lacking foundation, conclusory, and not supported by underlying facts. For example, paragraph 70 states “a person of ordinary skill in the art would have been motivated to combine these references, and would have been readily able to combine them.” This statement is conclusory, lacks foundation, and is not supported by the underlying facts. Paragraph 71 states “[s]ince both Kokubo and Fujinawa are image readers, a person of skill in the art would have been motivated to combine the teachings of each.” This statement is conclusory, lacks foundation, and is not supported by the underlying facts. Paragraph 73 states that the combination of Fujinawa and Kokubo would have been a “simple substitution.” This statement is conclusory, lacks foundation, and is not supported by the underlying facts. Paragraph 74 states that “a person of skill in the art could and would have combined Fujinawa with Kokubo” This statement is conclusory, lacks foundation, and is not supported by the underlying facts. Paragraph 77 states “Watanabe discloses an alternative mechanism using a rod, belt, and pulley(s).” This statement is conclusory, lacks foundation, and is not supported by the

underlying facts. Paragraph 79 states “a person of skill in the art could and would have combined Fujinawa with Watanabe as discussed above.” This statement is conclusory, lacks foundation, and is not supported by the underlying facts.

Patent Owner objects to the drawings and figures in Exhibit 1002 under Fed. R. Evid. 401–403, 602, 702, 703, and 901 as lacking authenticity, lacking foundation, lacking personal knowledge, assuming facts not in evidence, unfair representations, and unduly prejudicial. For example, the drawings on pages 11 and 26 are inaccurate and unfair representations of the prior art, not authentic, and lack foundation.

Patent Owner objects to Exhibit 1002 under Fed. R. Evid. 401 and 402 to the extent it relates to issues on which the Board did not institute review in its May 8, 2017 Decision (Paper 6). Specifically, at least paragraph 69 relates solely to issues on which the Board did not institute review. Patent Owner further objects to Exhibit 1002 under Fed. R. Evid. 401 and 402 to the extent it cites or relies upon references, exhibits, or grounds not expressly adopted by the Board.

3. Ex. 1007

Patent Owner objects to Exhibit 1007 under Fed. R. Evid. 401 and 402 as irrelevant to the issues in this proceeding.

Patent Owner additionally objects to Exhibit 1007 under Fed. R. Evid. 901 as lacking authenticity. Patent Owner objects to Exhibit 1007 under Fed. R. Evid.

802 as inadmissible hearsay. Patent Owner also objects to Exhibit 1007 because it is not a printed publication. Specifically, there is no evidence that this document was publicly available.

Patent Owner has made these objections within 10 business days from the May 8, 2017 institution of trial.

Respectfully submitted,

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