

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 RESPONSE TO THE PETITION

Patent Trial and Appeal Board
United States Patent and Trademark Office
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Alexandria, VA 22313-1450

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LIST OF EXHIBITS

Number	Brief Description
2001	6/6/2013 Information Disclosure Statement submitted by applicant, Application Serial No. 13/560,283
2002	6/17/2013 List of References cited by applicant and considered by examiner, Application Serial No. 13/560,283
2003	6/25/2013 Notice of Allowance and Fee(s) Due, Application Serial No. 13/560,283
2004	11/4/2016 Claim Construction Order, Dkt. No. 38, <i>e-ImageData Corp. v. Digital Check Corp.</i> , Civil Action No. 16-cv-576, E. D. Wis.
2005	Declaration of Jonathan D. Ellis
2006	Curriculum vitae of Jonathan D. Ellis
2007	Deposition Transcript of Anthony J. Senn

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I. INTRODUCTION AND SUMMARY OF THE ARGUMENT.

The patent at issue in this proceeding relates to a digital microfilm imaging apparatus (DMIA). A DMIA magnifies a microform, such as microfilm or microfiche, so a user can view and read the microform. To do so, the DMIA must precisely position both a lens and image sensor along an optical path relative to the microform. The positioning is critical. If the lens or image sensor is out of position by thousandths of an inch, the image will not be in focus and will be unreadable. The claimed technology is aimed at reducing the overall size, complexity, and footprint of a DMIA, while still allowing for the required precision placement of the lens and sensor so that users can view different media at different magnifications.

To achieve this precise positioning, the '279 Patent discloses a device that supports a lens and an area sensor on carriages that are driven by drive mechanisms along lead members. As claimed in claim 44, a belt is used to move the carriage along the lead member. As claimed in claim 49, a carriage extends between a lead member and a drive mechanism.

Petitioner, ST Imaging, has failed to prove the unpatentability of claims 44 and 49. The claims are valid because at the time of the invention, those of skill in the art believed smooth belts and pulleys easily slipped and were not capable of providing the precision placement necessary for optical focusing. ST Imaging has

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