

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

PETITION FOR *INTER PARTES* REVIEW

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box. 1450
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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

I. INTRODUCTION

Digital Check Corp. d/b/a ST Imaging (“Petitioner”) requests *Inter Partes* Review (“IPR”) of claims 44 and 49 of U.S. Patent No. 8,537,279 (“‘279 Patent”) (Ex. 1001).

The ‘279 Patent discloses and claims microform imaging apparatuses. Microform readers were ubiquitous long before the ‘279 Patent. The ‘279 Patent acknowledges that the principle features of microform readers—a chassis, a mirror, a lens, an image sensor and an adjuster—were well known many years prior to the alleged invention. (Ex. 1001 at 2:16-29 and 2:43-44; Ex. 1002 at ¶¶ 21-22). The ‘279 Patent further recognizes that the digital aspects incorporated into the claimed invention were not novel. (Ex. 1001 at 2:21-24 and 2:43-44; Ex. 1002 at ¶ 21). Rather, digitization of microfilm was a natural result of the prevalence of computers and the digital age. (Ex. 1001 at 1:53-60; Ex. 1002 at ¶ 21).

The microform reader of the ‘279 Patent purports to be more “compact and versatile” than prior art readers. (Ex. 1001 at 2:52-55; Ex. 1002 at ¶ 22). Yet, claims 44 and 49 of the ‘279 Patent fail to claim any novel elements or a novel arrangement of elements that were not already well known in the prior art. In short, claims 44 and 49 are nothing more than a straightforward recitation of conventional, well-known microform imaging technology.

As described in detail below, the Board should institute IPR and cancel

