

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 MOTION TO EXCLUDE EVIDENCE
UNDER 37 C.F.R. § 42.64(C)

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

Pursuant to 37 C.F.R. § 42.64(c) and the Scheduling Order (Paper No. 7), Patent Owner timely submits this Motion to Exclude Evidence. Patent Owner moves to exclude certain figures in the Petition for *Inter Partes* Review (Paper No. 1) (“Petition”), portions of Exhibit 1002, and Exhibit 1007. The Board should grant Patent Owner’s Motion to Exclude for the reasons set forth below.

I. STATEMENT OF FACTS

The Board instituted *inter partes* review of (1) claims 44 and 49 as allegedly unpatentable under 35 U.S.C. § 103 (a) over Fujinawa and Kokubo, and (2) claim 49 as allegedly unpatentable under 35 U.S.C. § 103 (a) over Fujinawa and Watanabe. (Institution Decision, Paper No. 6, p. 20.) Patent Owner timely served Petitioner with objections to the admissibility of certain figures in the Petition, portions of Exhibit 1002, and Exhibit 1007 on May 22, 2017. (Paper No. 8.) Petitioner did not respond to the objections by filing supplemental evidence within the time period allowed by the rules.

II. IDENTIFICATION OF WHERE EVIDENCE WAS RELIED UPON

The following is a listing of where in the record the evidence sought to be excluded was relied on by the Petitioner:

A. Petition

Petitioner relied on the illustration on page 11 of the Petition on pages 11 and 12 of the Petition.

B. Exhibit 1002

Petitioner relied on the objected to portions of Exhibit 1002 (Senn Declaration) in its Petition. Specifically, Petitioner referenced paragraph 28 of Exhibit 1002 on page 11 of the Petition. Petitioner referenced paragraph 69 on pages 39 and 40 of the Petition.

C. Exhibit 1007

Petitioner relied on this exhibit in the Petition at pages 12–16. Petitioner also relied on this exhibit in Exhibit 1002 (Senn Declaration) at paragraphs 30–32 and 34–36.

III. ARGUMENT

Each of the above identified challenged exhibits are addressed in turn, in numerical order, beginning with the inadmissible portions of the Petition itself.

A. The Drawings And Figures In The Petition Are Inadmissible Because They Lack Foundation And Are Unduly Prejudicial

Patent Owner timely objected 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. (Paper No. 8 at 1.) Federal Rules of Evidence 401 and 402 provide the framework for determining if evidence is inadmissible due to relevance: evidence is relevant if it has a “tendency to make a fact more or less probable than it would be without the evidence,” Fed. R. Evid. 401, and “[i]rrelevant evidence is not admissible.” Fed.

R. Evid. 402. However, under Federal Rule of Evidence 403, the Board “may exclude relevant evidence if its probative value is substantially outweighed by a danger of one or more of the following: unfair prejudice, confusing the issues, misleading the jury” Additionally, the Petitioner must authenticate the evidence on which it relies, “[t]o satisfy the requirement of authenticating or identifying an item of evidence, the proponent must produce evidence sufficient to support a finding that the item is what the proponent claims it is.” Fed. R. Evid. 901.

Here, the unsupported illustration should be excluded as irrelevant and highly prejudicial. Specifically, the illustration on page 11 of the Petition is an inaccurate and unfair representation of the purported prior art. This inadmissible illustration is also provided in the Senn Declaration (*See* Ex. 1002, ¶ 28.) The Petitioner fails to authenticate how this illustration is a “well-known prior art process” by producing evidence sufficient to support that contention in either the Petition or the Senn Declaration (Ex. 1002). Rather, the only support for this position is the statement that this illustration “is a schematic representation of the Fujinawa microform imaging apparatus (e.g., Ex. 1004 at Fig. 4).” (Ex. 1002, ¶ 28.) This illustration when it is nothing more than a one-sided interpretation and representation of a figure disclosed in *Fujinawa*. Accordingly, this illustration should be excluded.

B. The Figure Of Ex. 1002 Is Inadmissible Because It Lacks Foundation And Is Unduly Prejudicial

The drawings and figures in Ex. 1002 were timely objected to 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. As previously discussed with relation to the Petition, the illustration in paragraph 28, which also appears on page 11 of the Petition, is nothing more than a one-sided interpretation and representation of a figure disclosed in *Fujinawa*, and should be excluded as unduly prejudicial.

C. Portions Of Ex. 1002 Are Inadmissible Because They Relate To Claims On Which The Board Did Not Institute Review

Patent Owner timely objected to Ex. 1002 under Fed. R. Evid. 401 and 402 to the extent it relates to claims on which the Board did not institute review in its May 8, 2017 Decision (Paper 6). (Paper No. 8 at 3.) Specifically, at least paragraph 69 relates solely to claims on which the Board did not institute review, and is thus irrelevant and inadmissible.

D. Ex. 1007 Is Inadmissible Because It Lacks Authenticity And Is Hearsay

Patent Owner also timely objected to Ex. 1007 under Fed. R. Evid. 901 as lacking authenticity and under Fed. R. Evid. 802 as inadmissible hearsay. (Paper No. 8 at 3.)

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