

**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 NO. IPR2017-00178  
U.S. PATENT NO. 9,179,019

---

**PETITIONER'S RESPONSE IN OPPOSITION TO PATENT OWNER'S  
MOTION TO EXCLUDE**

## Table of Contents

I.	INTRODUCTION .....	1
II.	ARGUMENT .....	2
	A. Drawings and Figures in the Petition Used to Illustrate Petitioner’s Invalidation Theories are Admissible.....	2
	B. The Senn Declaration (Exhibit 1002) is Relevant and Admissible.....	4
	C. Exhibits 1006, 1007, 1008, 1009, and 1010 are Relevant and Admissible.....	5
	D. Exhibits 1007, 1008 and 1009 Satisfy the Admissibility Requirements of the Federal Rules of Evidence .....	6
	1. Exhibit 1007 is Authenticated Under FRE 901(b)(4) and is Not Hearsay .....	7
	2. Exhibit 1008 is Authenticated Under FRE 901(b)(4) and 902(6) and is Not Hearsay .....	9
	3. Exhibit 1009 is Authenticated Under FRE 902(11) and is Not Hearsay.....	11
III.	CONCLUSION.....	12

**Petitioner's Updated List of Exhibits**

- Ex. 1001: U.S. Patent No. 9,179,019 (“‘019 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
- Ex. 1008: Minolta UC-1 Universal Film Carrier (“*Minolta*”)
- Ex. 1009: Parts Manual for UC-6E, EC, ECM Motorized Combo Squared Corner  
Parts Numbers 210000-01,02,03 (“*Minolta*”)
- Ex. 1010: Declaration of Philip G. Barboni
- Ex. 1011: Excerpt of Fundamentals of Machine Design textbook
- Ex. 1012: Deposition Transcript of Jonathan Ellis
- Ex. 1013: Excerpt of Illustrated Sourcebook of Mechanical Components textbook

## I. INTRODUCTION

Petitioner submits this Opposition to Patent Owner's ("PO") Motion to Exclude (Paper 17). It is the opponent who bears the burden of establishing inadmissibility of an exhibit. 37 C.F.R. § 42.20(c). Far from meeting this burden, PO's motion makes a laundry list of objections under the Federal Rules of Evidence ("FRE") but fails to provide *any* explanation of how they apply or why the particular evidence is inadmissible.

The Board has made its position clear: "There is a strong public policy for making all information filed in a non-jury, quasi-judicial administrative proceeding available to the public, especially in an *inter partes* review which determines the patentability of claims in an issued patent. It is better to have a complete record of the evidence submitted by the parties than to exclude particular pieces." *Nichia Corp. v. Emcore Corp.*, IPR2012-00005, Paper 68, at 59 (PTAB Feb. 11, 2014). The Board has further clarified that a motion to exclude is not the forum to challenge the sufficiency of evidence. *Biomarin Pharm. Inc. v. Genzyme Therapeutic Prods. Ltd. P'ship*, IPR2013-00537, Paper 79, at 24-25 (PTAB Feb. 23, 2015). Against this backdrop, PO now moves to exclude annotated figures from the prior art, evidence that pertains to non-instituted grounds, and evidence that falls squarely within the bounds of admissibility under the FRE. As detailed below, PO's motion should be denied in its entirety.

## II. ARGUMENT

### A. Drawings and Figures in the Petition Used to Illustrate Petitioner's Invalidity Theories are Admissible

PO seeks to exclude the “illustration” on page 9 of the petition and the “annotated figure” on page 51 of the petition.<sup>1</sup> (Paper 17 at 4). Petitioner’s expert, Tony Senn, laid the foundation for the illustration as “a schematic representation of the Fujinawa microform imaging apparatus (e.g., Ex. 1004 at Fig. 4)...representative of the well known features of microform imaging apparatuses.” (Ex. 1002 at ¶28; *see also* Paper 2 at 9, 10; Ex. 1004 at Fig. 4). Mr. Senn, likewise, laid the foundation for the annotated figure in paragraph 104 of his declaration by detailing the substitution of the *Fujinawa* drive mechanism with a *Kokubo*-type drive mechanism as depicted in the annotated figure. (Ex. 1002 at ¶104). The illustration and annotated figure are used by Petitioner to help illustrate its invalidity theory. (Paper 2 at 9, 50-51; Ex. 1002 at ¶¶28, 104; Ex. 1004 at Fig. 4). Mr. Senn is a mechanical engineer with over 25 years of experience in the field, including at least 10 years of design work on microform scanning equipment. (Ex. 1002 at ¶¶7-19). PO has not questioned Mr. Senn’s credentials as one of skill in

---

<sup>1</sup> For consistency, Petitioner has used the same nomenclature as PO’s motion to exclude—“illustration” for the figure on page 9 and “annotated figure” for the figure on page 51.

# 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.