

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 IPR2017-00178
Patent 9,179,019 B2

PATENT OWNER'S REPLY IN SUPPORT OF ITS
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

Patent Owner hereby submits the following reply in support of its Motion to Exclude Evidence (Paper 17).

I. INTRODUCTION

Patent Owner's Motion to Exclude Evidence establishes that the challenged evidence fails to meet the requirements as set forth in the Federal Rules of Evidence. It is clear that "[t]he admissibility of evidence in an IPR proceeding generally is governed by the Federal Rules of Evidence." *Universal Remote Control, Inc. v. Universal Elecs., Inc.*, IPR2014-01146, Paper No. 36 (PTAB Dec. 10, 2015) (citing 37 C.F.R. § 42.62(a); *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48758)); *see also* 37 C.F.R. § 42.104(b)(5). Patent Owner has met the burden of establishing inadmissibility of the challenged evidence under 37 C.F.R. § 42.20(c). Because Petitioner has failed to provide evidence that meets the requirements of admissibility under the Federal Rules of Evidence, as demonstrated in Patent Owner's Motion to Exclude, the challenged evidence is inadmissible and should be excluded.

II. ARGUMENT

A. Patent Owner Sufficiently Supported Its Motion

Petitioner's claim that Patent Owner motion contains bare assertions is unavailing because Patent Owner followed the guidance provided by the PTAB for motions to exclude. For example, in *Flir Systems, Inc., v. Leak Surveys, Inc.*, the

PTAB provided an example of a how a motion to exclude might be succinctly presented:

In addressing the admissibility of Ex. 1005, a motion to exclude could state the following.

Exhibit 1005

1. Identity of the exhibit and portion thereof sought to be excluded: test data described in Exhibit 1005, Example 1.
2. Objection: Hearsay: Fed. R. Evid. 802; 37 C.F.R. § 42.61(c).
3. An objection was made in an Objection to Evidence, filed [state date filed]. See Ex. 2011, page x, lines y–z.
4. Petitioner relies on the objected data on pages 5–6 of the Petition.
5. The relied upon data is hearsay. Petitioner has not presented the testimony of any individual having first-hand of the testing described in Example 1.

Nothing more is needed.

If petitioner believes an exception to the hearsay rule applies, petitioner may address the exception in an opposition to which patent owner may a reply.

Case IPR2014-014-00411, Paper 113 at 6–7 (P.T.A.B. Sept. 3, 2015) (emphasis added). Patent Owner followed the PTAB’s guidance and noting more was needed.

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

Petitioner’s illustration and annotated figure are inadmissible as unfairly prejudicial because they are inaccurate representations of the prior art Fujinawa reference. Representations of the prior art should be excluded when the danger of unfair prejudice outweighs the probative value of the evidence. *See Callaway Golf*

Co. v. Acushnet Co., 576 F.3d 1331, 1342 (Fed. Cir. 2009). Petitioner’s “schematic representation” oversimplifies and misrepresents the Fujinawa reference by, for example, depicting the lead members as smooth rods when the reference clearly discloses threaded worms. (Ex. 1004 at Fig. 4.) Petitioner’s annotated figure depicts the device of Fujinawa in a way undisclosed in the prior art. These two depictions are inaccurate and unfairly prejudicial.

The *Intri-Plex* case is readily distinguishable. In *Intri-Plex*, the Board denied a motion to exclude “annotated excerpts of Figures” from a particular reference. *Intri-Plex Techs., Inc. v. Saint-Gobain Perf. Plastics Rencol Ltd.*, IPR2014-00309, Paper 83, at 17–18 (P.T.A.B. Mar. 23, 2014). The Board found that there was no danger of confusion and unfair prejudice because it was able to “differentiate between the actual figures in [the reference] and counsel’s demonstrative annotations thereto.” *Id.* at 18.

Unlike in *Intri-Plex* where counsel provided annotated versions of actual figures of a reference, here the Petitioner provides a newly created “schematic representation” of the purported prior art and a figure annotated in a manner not disclosed in the prior art. (Paper 1 at 9, 52; Ex. 1002 at ¶ 28). Unlike in *Intri-Plex*, there is the real possibility that the Board may rely on the created illustration and figure instead of the actual teachings of the cited references. IPR2014-00309, Paper 83, at 18. Accordingly the challenged illustration should be excluded.

C. Exhibits 1007, 1008, and 1009 are Inadmissible

Petitioner erroneously argues that the title page and copyright information is sufficient to self-authenticate Ex. 1007. However, the title of the device and other publicly available information about the 5100 Fiche Scanstation is insufficient to self authenticate the document. *U.S. v. Mitts*, 396 Fed. App'x. 296, 302 (6th Cir. 2010) (public information not distinctive under FRE 901(b)(4)). Likewise, the copyright information is not probative of the admissibility of the document. *See, e.g., Stryker Corp. v. Karl Storz Endoscopy-Am., Inc.*, IPR2015-00677, Paper 15 at 18–19 (P.T.A.B. Sept. 2, 2015); *see also TRW Automotive v. Magna Elec. Inc.*, IPR2014-01347, Paper 25 at 6 (P.T.A.B. Jan. 6, 2016). Thus, without more, Petitioner has failed to produce evidence sufficient to support a finding that the item is what the proponent claims it is, and Exhibit 1007 should be excluded.

Petitioner has not shown that Exhibit 1008 is a self-authenticating periodical. Petitioner has not provided any evidence showing that Exhibit 1008 is indeed a report published in a periodical called “Library Technology Reports.” Instead, Petitioner cites only to the Exhibit itself and the ISBN listed. This information is insufficient to show that Exhibit 1008 is self-authenticating under Fed. R. Evid. 902(6). *See TRW Auto. U.S. LLC, v. Magna Elecs. Inc.*, IPR2014-01348, Paper 25 at 5–11 (P.T.A.B. Jan. 15, 2016) (holding that an exhibit was not self-

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