

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 PRELIMINARY RESPONSE TO PETITION

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

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LIST OF EXHIBITS

Number	Brief Description
2001	8/15/2013 Information Disclosure Statement submitted by applicant, Application Serial No. 13/968,080
2002	10/8/2014 List of References cited by applicant and considered by examiner, Application Serial No. 13/968,080
2003	2/26/2015 Notice of Allowance and Fee(s) Due, Application Serial No. 13/968,080
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.

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I. THE BOARD SHOULD NOT INSTITUTE *INTER PARTES* REVIEW.

The Board should deny ST Imaging's Petition for *inter partes* review of U.S. Patent No. 9,179,019 for both procedural and substantive defects.

First, procedural defects warrant denial of institution. The Office has already found that the '019 Patent is patentable over the same or substantially the same references that ST Imaging relies upon in its Ground 1. During prosecution, the Examiner considered Fujinawa, the primary reference, and a reference substantially similar to Kokubo. For Grounds 2 and 3, ST Imaging relies on a reference that is not a printed publication.

Second, ST Imaging improperly used the '019 Patent as a roadmap for putting together the various elements of the claimed invention. ST Imaging demonstrates its impermissible hindsight reconstruction by failing to articulate any reason why one of skill in the art would have made the proposed modifications.

Third, the teachings of the prior art references do not render the claims obvious. Specifically, ST Imaging's proposed modifications to Fujinawa's device would render the device inoperable for its intended purpose, violate longstanding principles of mechanical design, and add needless complexity to an otherwise simple design.

Fourth, the prior art references fail to even disclose numerous limitations from dependent claims.

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