

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

Before KEN B. BARRETT, JENNIFER MEYER CHAGNON, and
MELISSA A. HAAPALA, *Administrative Patent Judges*.

HAAPALA, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C § 318(a) and 37 C.F.R. § 42.73

Digital Check Corp. d/b/a ST Imaging (“Petitioner”) filed a Petition pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 1–3, 5–9, 20–35, 37, 39–41, 43, 44, 47, 53–57, 63–68, 74, 79, 81, 84–87, 91–96, and 101 of U.S. Patent No. 9,179,019 B2 (“the ’019 patent”). Paper 2 (“Pet.”). Applying the standard set forth in 35 U.S.C. § 314(a), we granted Petitioner’s request and instituted an *inter partes* review of claims 1–3, 5–7, 20–28, 31, 41, 43, 44, 53, and 63; we declined to institute a review as to the other claims challenged. Paper 6 (“Dec.”).

During the trial, Patent Owner timely filed a Response (Paper 11, “PO Resp.”), to which Petitioner timely filed a Reply (Paper 16, “Reply”). Petitioner requested an oral hearing, but then withdrew its request and we canceled the hearing. *See* Papers 18, 22.

Additionally, Patent Owner filed a Motion to Exclude Evidence (Paper 17), to which Petitioner filed an Opposition (Paper 20), and Patent Owner filed a Reply (Paper 21).

We have jurisdiction under 35 U.S.C. § 6. This Decision is a Final Written Decision under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73 as to the patentability of the claims on which we instituted trial. Based on the record before us, we determine that Petitioner has shown, by a preponderance of the evidence, that claims 1–3, 5–7, 20–25, 27, 28, 31, 41, 43, 44, 53, and 63 of the ’019 patent are unpatentable. Petitioner has not shown that claim 26 of the ’019 patent is unpatentable.

I. BACKGROUND

A. *The ’019 Patent (Ex. 1001)*

The ’019 patent describes a digital microform imaging apparatus (DMIA) that may be used to view/scan a broad range of microfilm media types (e.g., microfilm, microfiche, 16 mm or 36 mm film roll). *See*

Ex. 1001, 1:19–20, 3:26–28. The DMIA can accommodate a broad range of image reduction ratios without the need to change zoom lenses. *See id.* at 3:28–30, 7:56–59. Figure 4 of the '019 patent is reproduced below:

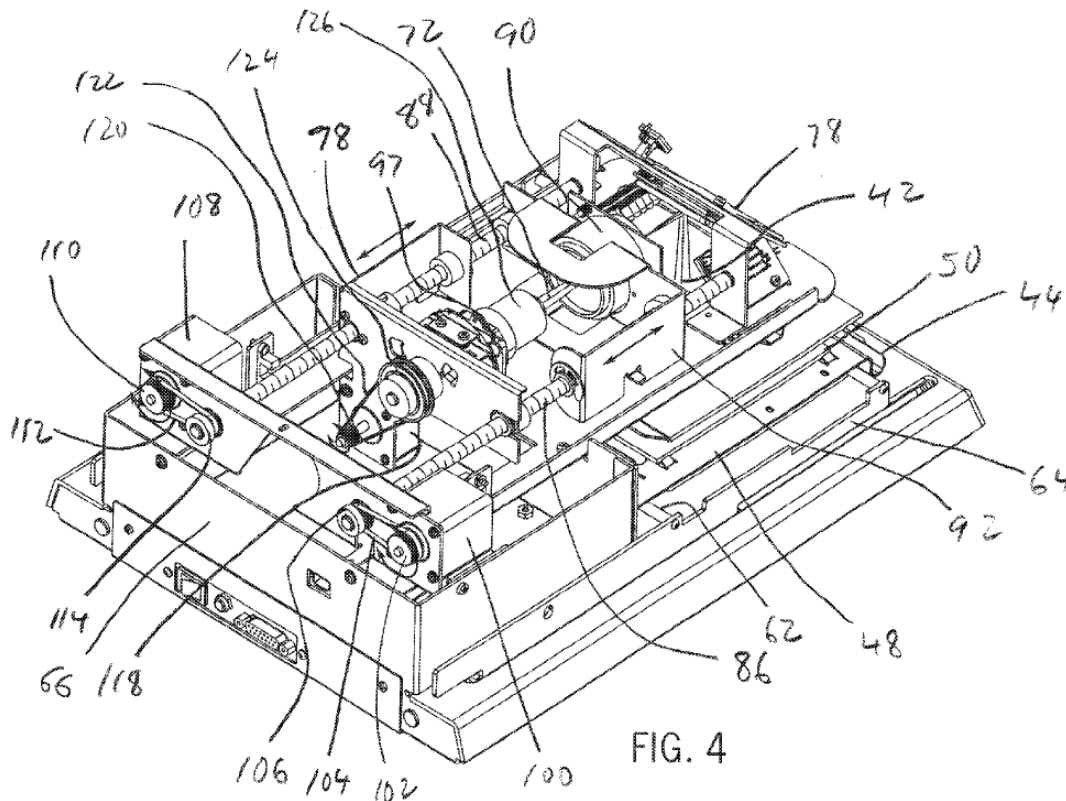


Figure 4 illustrates a perspective view of a DMIA with the cover removed and as viewed from generally rearward of the apparatus. *Id.* at 3:65–67.

The DMIA illustrated in Figure 4 includes: microform media support 44; chassis 66; mirror mount 78; first lead screw 86; second lead screw 88; lens 90; area sensor 97; first carriage 92; second carriage 98; first motor 100; second motor 108; timing pulleys 102, 106, 110, 114; and belts 104, 112. *See id.* at 5:8–6:11. Microform media support 44 is configured to support a microform media. *Id.* at 5:8–10. A fold mirror (not shown) reflects incident light transmitted through microform media and is connected to mirror mount 78, which is connected to chassis 66. *Id.* at 5:31–33, 5:36–38. Lens 90 is

connected to first carriage 92, which is linearly adjustable by rotating first lead screw 86. *Id.* at 5:43–45. Area sensor 97 is connected to second carriage 98, which is linearly adjustable by rotating second lead screw 88. *Id.* at 5:52–54. First motor 100 is rotationally coupled to first lead screw 86 by timing pulley 102, belt 104 with teeth, and timing pulley 106; and second motor 108 is rotationally coupled to second lead screw 88 by timing pulley 110, belt 112 with teeth, and timing pulley 114. *Id.* at 6:7–9.

A controller (not shown) is electrically connected to first motor 100, second motor 108, and area sensor 97. *Id.* at 6:11–13. The controller receives commands and inputs, controls first and second motors 100, 108 and other components of the DMIA, and outputs an image data of area sensor 97. *Id.* at 6:13–17. The layout of the DMIA, including separately adjustable area sensor 97 and lens 90, and algorithms for moving the lens and sensor to appropriate respective locations to achieve proper magnification and focus of the image, allow the DMIA to autofocus to accommodate different reduction ratios of different film media without the need for iterative measurements and refocusing of lens 90. *Id.* at 5:61–7:3. The DMIA depicted in Figure 4 includes additional components not described.

B. Illustrative Claim

Claims 1, 41, and 63 are independent claims. Claim 1 is illustrative of the subject matter at issue.

1. A digital microform imaging apparatus, comprising:
 - a chassis;
 - a fold mirror supported by the chassis and including a reflecting surface for directing light from a first optical axis to a second optical axis;

a first elongated and substantially straight lead member supported by the chassis and aligned along a substantially horizontal axis, the first lead member including an elongated shaft;

a first drive mechanism supported by the chassis and extending alongside and spaced apart from the first lead member;

a first motor including a first motor shaft that engages the first drive mechanism;

a first carriage coupled to the first lead member for movement there along and coupled to the chassis via the first drive mechanism and the first motor such that rotation of the first motor shaft causes the first carriage to move along the first lead member along a trajectory that is substantially parallel to the second optical axis;

an area sensor supported by the first carriage and aligned with the second optical axis for movement along the second optical axis within a first range to adjust a distance between the area sensor and the fold mirror; and

a lens supported by the chassis along the second optical axis and positioned between the area sensor and the fold mirror;

wherein the lens and the area sensor are located on a first lateral side of the first lead member and located on a first lateral side of the first drive mechanism.

C. Instituted Grounds of Unpatentability

Petitioner relies on the following references:

1. U.S. Patent Application No. 2004/0012827 A1, published Jan. 22, 2004 (“Fujinawa”) (Ex. 1004).
2. U.S. Patent No. 5,585,937, issued Dec. 17, 1996 (“Kokubo”) (Ex. 1005).

We instituted trial under 35 U.S.C. § 103(a) based on the following combination of references. Dec 23.

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