

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 OBJECTIONS UNDER 37 C.F.R. § 42.64(b)(1)
TO EVIDENCE SUBMITTED WITH PETITION FOR *INTER PARTES* REVIEW

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

Under 37 C.F.R. § 42.64(b)(1), Patent Owner e-ImageData Corp. objects to the admissibility of the evidence identified below that Petitioner submitted as exhibits to or referenced in its Petition for *Inter Partes* Review (Paper No. 2).

1. Petition

Patent Owner objects 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. For example, the illustration on page 9 is an inaccurate and unfair representation of the purported prior art, is not authentic, and lacks foundation. The drawing on page 51 is an inaccurate and unfair representation of the purported prior art, is not authentic, and lacks foundation, specifically with respect to the alleged location of first lead member. The drawing on page 51 is an inaccurate and unfair representation of the purported prior art, is not authentic, and lacks foundation, specifically with respect to the alleged location of first lead member and drive mechanism.

2. Ex. 1002

Under Fed. R. Evid. 702 and 703 and 37 C.F.R. § 42.65, Patent Owner objects to Exhibit 1002 (Senn Declaration). Mr. Senn’s statements and opinions are conclusory, do not attempt to take into account the level of skill in the art, and are based on neither sufficient facts and data nor reliable principles and methods.

For example, Exhibit 1002 does not provide sufficient explanation or rationale behind Mr. Senn’s assertions of obviousness or his stated motivations to combine. As another example, Exhibit 1002 does not explain how combinations of prior art would be implemented or achieved, nor how or whether such implementations would work.

Patent Owner additionally objects to Exhibit 1002 as lacking foundation, assuming facts not in evidence, containing testimony on matters as to which the witness lacks personal knowledge, conclusory and containing testimony concerning documents for which authentication required by Fed. R. Evid. 901 is lacking. For example, paragraphs 23–39, 53, 57, and 99–107 are objected to as lacking foundation, conclusory, and not supported by underlying facts. For example, paragraph 99 states “a person of ordinary skill in the art would have been motivated to combine these references, and would have been readily able to combine them.” This statement is conclusory, lacks foundation, and is not supported by the underlying facts. Paragraph 100 states “[s]ince both Kokubo and Fujinawa are image readers, a person of skill in the art would have been motivated to combine the teachings of each. This statement is conclusory, lacks foundation, and is not supported by the underlying facts. Paragraph 102 states that the combination of Fujinawa and Kokubo would have been a “simple substitution.” This statement is conclusory, lacks foundation, and is not supported by the

underlying facts. Paragraph 104 states that “one of ordinary skill in the art would have known to simply substitute a second Kokubo-type drive mechanism and lead member.” This statement is conclusory, lacks foundation, and is not supported by the underlying facts. Paragraph 107 states “a person of skill in the art could and would have combined Fujinawa with Kokubo to result in the claimed invention.” This statement is conclusory, lacks foundation, and is not supported by the underlying facts.

Patent Owner objects to the drawings and figures in Exhibit 1002 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. For example, the drawing on page 11 is an inaccurate and unfair representation of the prior art, is not authentic, and lacks foundation.

Patent Owner objects to Exhibit 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 April 25, 2017 Decision (Paper 6). Specifically, at least paragraphs 61, 66–71, 78, 85–98, and 108–117 relate solely to claims on which the Board did not institute review. Patent Owner further objects to Exhibit 1002 under Fed. R. Evid. 401 and 402 to the extent it cites or relies upon references, exhibits, or grounds not expressly adopted by the Board.

3. Ex. 1006

Patent Owner objects to Exhibit 1006 under Fed. R. Evid. 401 and 402 because it relates solely to claims on which the Board did not institute review.

4. Ex. 1007

Patent Owner objects to Exhibit 1007 under Fed. R. Evid. 401 and 402 because it relates solely to claims on which the Board did not institute review.

Patent Owner additionally objects to Exhibit 1007 under Fed. R. Evid. 901 as lacking authenticity. Patent Owner objects to Exhibit 1007 under Fed. R. Evid. 802 as inadmissible hearsay. Patent Owner also objects to Exhibit 1007 because it is not a printed publication. Specifically, there is no evidence that this document was publicly available.

5. Ex. 1008

Patent Owner objects to Exhibit 1008 under Fed. R. Evid. 401 and 402 because it relates solely to claims on which the Board did not institute review.

Patent Owner additionally objects to Exhibit 1008 under Fed. R. Evid. 901 as lacking authenticity. Patent Owner objects to Exhibit 1008 under Fed. R. Evid. 802 as inadmissible hearsay. Patent Owner also objects to Exhibit 1008 because it is not a printed publication. Specifically, there is no evidence that this document was publicly available.

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