

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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DIGITAL CHECK CORP. d/b/a ST IMAGING,  
Petitioner,

v.

E-IMAGEDATA CORP.  
Patent Owner.

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Case IPR2017-00178  
Patent 9,179,019 B2

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PATENT OWNER RESPONSE TO THE 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	6/6/2013 Information Disclosure Statement submitted by applicant, Application Serial No. 13/560,283
2002	6/17/2013 List of References cited by applicant and considered by examiner, Application Serial No. 13/560,283
2003	6/25/2013 Notice of Allowance and Fee(s) Due, Application Serial No. 13/560,283
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.
2005	Declaration of Jonathan D. Ellis
2006	Curriculum vitae of Jonathan D. Ellis
2007	Deposition Transcript of Anthony J. Senn

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## **I. INTRODUCTION AND SUMMARY OF THE ARGUMENT.**

The patent at issue in this proceeding relates to a digital microfilm imaging apparatus (DMIA). A DMIA magnifies a microform, such as microfilm or microfiche, so a user can view and read the microform. To do so, the DMIA must precisely position both a lens and image sensor along an optical path relative to the microform. The positioning is critical. If the lens or image sensor is out of position by thousandths of an inch, the image will not be in focus and will be unreadable. The claimed technology is aimed at reducing the overall size, complexity, and footprint of a DMIA, while still allowing for the required precision placement of the lens and sensor so that users can view different media at different magnifications.

To achieve this precise positioning, the '019 Patent discloses a device that supports a lens and an area sensor on carriages that are driven by drive mechanisms along lead members. Claim 1 requires “a first drive mechanism . . . extending alongside and spaced apart from the first lead member” and “the lens and 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.” Independent claims 41 and 63 require a first or second drive mechanism extending alongside and spaced apart from the first lead member.

Petitioner, ST Imaging, has failed to prove the unpatentability of claims 1, 41, and 63. The claims are valid because at the time of the invention, those of skill in the art believed smooth belts and pulleys easily slipped and were not capable of providing the precision placement necessary for optical focusing. ST Imaging has not identified prior art using a smooth belt or pulley system to provide precision placement of objects for optical focusing. Further, ST Imaging has not proven it was known to use a smooth belt or pulley system to move components along an optical path. Fujinawa, the primary reference relied on by ST Imaging, precisely positions the lens and sensor using threaded worms, not a belt drive mechanism, which is nowhere in Fujinawa. Using hindsight to reconstruct the claims, ST Imaging relies on Kokubo's disclosure of a smooth belt and pulley system used for moving a reading unit in a flatbed scanner. Kokubo's belt and pulley system is not used for precisely positioning a lens relative to a sensor or a sensor relative to a lens along an optical path. Having found no motivation to combine the references, ST Imaging improperly contends that the use of a belt-based drive system from a flatbed scanner in the precision focusing device of Fujinawa would have been a simple substitution.

ST Imaging's simple substitution argument fails for at least three reasons. First, none of the references at issue in this proceeding disclose use of a belt-based drive mechanism to position a lens or sensor along an optical path. ST Imaging

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