

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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**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  
U.S. PATENT NO. 9,179,019

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**REPLY TO PATENT OWNER RESPONSE**

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**List of Exhibits**

- Ex. 1001: U.S. Patent No. 9,179,019 (“‘019 Patent”)
- Ex. 1002: Declaration of Anthony J. Senn
- Ex. 1003: *Curriculum vitae* of Anthony J. Senn
- Ex. 1004: U.S. Publication No. 2004/0012827 (“*Fujinawa*”)
- Ex. 1005: U.S. Patent No. 5,585,937 (“*Kokubo*”)
- Ex. 1006: U.S. Patent No. 5,061,955 (“*Watanabe*”)
- Ex. 1007: 5100 FICHE SCANSTATION, Field Service Manual
- Ex. 1008: Minolta UC-1 Universal Film Carrier (“Minolta”)
- Ex. 1009: Parts Manual for UC-6E, EC, ECM Motorized Combo Squared Corner  
Parts Numbers 210000-01,02,03 (“Minolta”)
- Ex. 1010: Declaration of Philip G. Barboni
- Ex. 1011: Excerpt of Fundamentals of Machine Design textbook
- Ex. 1012: Deposition Transcript of Jonathan Ellis
- Ex. 1013: Excerpt of Illustrated Sourcebook of Mechanical Components textbook

## I. INTRODUCTION

Patent Owner's ("PO") Response fails to rebut the basic premise that a substitution of one known drive mechanism for another yields a predictable result—translation of motion. (Petition at 8-9, 22-24; *see also*, Decision at 14-16). As the Board's preliminary decision acknowledged, "if a person of ordinary skill can implement a predictable variation (such as a simple substitution of one known element for another), it is likely to be obvious under § 103." (Decision at 15) (citing *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417-418 (2007)). PO's Response seeks to add complexity to what is a straight forward application of *KSR* by misconstruing the prior art, the knowledge of one of skill in the art, and the claim limitations. PO argues that "at the time of the invention smooth belts and pulleys were known to slip, which if substituted into the '019 Patent, would not allow the device to function for its intended purpose of precision focusing." (Response at 12). But PO's Response suffers from one fatal flaw—the prior art teaches *toothed* belts which PO's expert concedes provide the required precision. Indeed, PO's Response was systematically dismantled by its expert who was forced to admit that the (1) prior art of record discloses a "toothed belt" and (2) toothed belts are capable of precision movement. Moreover, PO's Response fails to address the plain teachings of the *combination* of the prior art references. In the

end, PO's Response does not undercut the Petition's reasoning with respect to Claims 1-3, 5-7, 20-28, 31, 41, 43, 44, 53, and 63.

## II. PERSON OF ORDINARY SKILL IN THE ART

Petitioner submits that a person of ordinary skill in the art ("POSA") of the '019 Patent would have had at least a bachelor's of science degree in either electrical engineering or mechanical engineering with at least 3 years' experience designing electro-mechanical products including experience designing imaging equipment such as copiers, scanners, and/or microform scanners and readers. (Petition at 16). The Board did not disagree with the definition of a POSA proposed by Petitioner. (*See generally*, Decision). PO provided a separate definition of a POSA: a degree in mechanical or optical engineering and 3 years of experience working with or designing scanners, camera systems or printers, which involve opto-mechanical systems similar to that described in the '019 Patent and the prior art. (PO Response at 4). However, PO did not argue how its proposal would change the analysis, if at all. Under either definition of POSA, Petitioner's analysis remains the same.

## III. CLAIM CONSTRUCTION

Petitioner agrees with the Board's conclusion that the claim terms should be given their ordinary and customary meaning in this proceeding. (Decision at 8). PO's Response suggests that the broadest reasonable interpretation of the preamble

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