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.

_____

Case IPR2017-00178
Patent 9,179,019 B2

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PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE
UNDER 37 C.F.R. § 42.64(C)

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

Pursuant to 37 C.F.R. § 42.64(c) and the Scheduling Order (Paper No. 7), Patent Owner timely submits this Motion to Exclude Evidence. Patent Owner moves to exclude certain figures in the Petition for *Inter Partes* Review (Paper No. 2) ("Petition"), portions of Exhibit 1002, and Exhibits 1006, 1007, 1008, 1009. The Board should grant Patent Owner's Motion to Exclude for the reasons set forth below.

I.   STATEMENT OF FACTS

The Board instituted *inter partes* review of claims 1–3, 5–7, 20–28, 31, 41, 43, 44, 53, and 63 as allegedly unpatentable under 35 U.S.C. § 103 (a) over Fujinawa (Ex. 1004) and Kokubo (Ex. 1005) on April 25, 2017. (Institution Decision, Paper No. 6, p. 23.) Patent Owner timely served Petitioner with objections to the admissibility of certain figures in the Petition and Exhibits 1002, 1006, 1007, 1008, 1009, and 1010 on May 9, 2017. (Paper No. 8.) Petitioner did not respond to the objections by filing supplemental evidence within the time period allowed by the rules.

II.   IDENTIFICATION OF WHERE EVIDENCE WAS RELIED UPON

The following is a listing of where in the record the evidence sought to be excluded was relied on by the Petitioner:

A. Petition

Petitioner relied on the illustration on page 9 of the Petition on pages 9 and 10 of the Petition. Petitioner relied on the modified figure on page 51 of the Petition on pages 50 and 51 of the Petition.

B. Exhibit 1002

Petitioner relied on the objected to portions of Exhibit 1002 (Senn Declaration) throughout its Petition. Specifically, Petitioner referenced paragraphs 28, 61, 66–71, 78, 85–98, and 108–117 on pages 41, 42, 44, 46, and 49–81 of the Petition.

C. Exhibit 1006

Petitioner relied on this exhibit in the Petition at pages 10–14. Petitioner also relied on this exhibit in Exhibit 1002 (Senn Declaration) at paragraphs 29–37.

D. Exhibit 1007

Petitioner relied on this exhibit in the Petition at pages 10–14. Petitioner also relied on this exhibit in Exhibit 1002 (Senn Declaration) at paragraphs 29–37.

E. Exhibit 1008

Petitioner relied on this exhibit in the Petition at pages 5–6, and 58–61. Petitioner also relied on this exhibit in Exhibit 1002 (Senn Declaration) at paragraphs 37, 86, 87, 89–91, 95, 97, 98.

F. Exhibit 1009

Petitioner relied on this exhibit in the Petition at pages 5–6, and 54–64.

Petitioner also relied on this exhibit in Exhibit 1002 (Senn Declaration) at

paragraphs 37, 86, 88, 91–98.

G. Exhibit 1010

Petitioner relied on this exhibit in the Petition at pages 6, 55, and 61.

III. ARGUMENT

Each of the above identified challenged exhibits are addressed in turn, in

numerical order, beginning with the inadmissible portions of the Petition itself.

A. Certain Drawings And Figures In The Petition Are Inadmissible Because They Lack Foundation And Are Unduly Prejudicial

Patent Owner timely objected 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.

(Paper No. 8 at 1.) Federal Rules of Evidence 401 and 402 provide the framework

for determining if evidence is inadmissible due to relevance: evidence is relevant if

it has a "tendency to make a fact more or less probable than it would be without the

evidence," Fed. R. Evid. 401, and "[i]rrelevant evidence is not admissible." Fed.

R. Evid. 402. However, under Fed. R. Evid. 403, the Board "may exclude relevant

evidence if its probative value is substantially outweighed by a danger of one or

more of the following: unfair prejudice, confusing the issues, misleading the jury

….." Additionally, the Petitioner must authenticate the evidence on which it relies, "[t]o satisfy the requirement of authenticating or identifying an item of evidence, the proponent must produce evidence sufficient to support a finding that the item is what the proponent claims it is." Fed. R. Evid. 901.

Here, the unsupported drawings and purported annotated figures should be excluded as irrelevant and highly prejudicial. The illustration on page 9 of the Petition is an inaccurate and unfair representation of the purported prior art. This inadmissible illustration is also provided in the Senn Declaration (*See* Ex. 1002, ¶ 28.) The Petitioner fails to authenticate how this illustration is a "well-known prior art process" by producing evidence sufficient to support that contention in either the Petition or the Senn Declaration (Ex. 1002). Rather, the only support for this position is the statement that this illustration "is a schematic representation of the Fujinawa microform imaging apparatus (e.g., Ex. 1004 at Fig. 4)." (Ex. 1002, ¶ 28.) This illustration is nothing more than a one-sided interpretation and representation of a figure disclosed in *Fujinawa*. Accordingly, this illustration should be excluded. Similarly, the drawing on page 51 of the Petition is a modified versions of the figure in *Fujinawa*, and includes Petitioner's contentions and characterizations of the figure. This annotated and modified figure is not evidence of the disclosure of *Fujinawa.*

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