

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 IPR2017-00346
Patent 9,197,766 B2

PATENT OWNER'S PRELIMINARY RESPONSE TO 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	“Got Film? ST200X” Brochure
2002	8/15/2013 Information Disclosure Statement submitted by applicant, Application Serial No. 13/968,080
2003	10/8/2014 List of References cited by applicant and considered by examiner, Application Serial No. 13/968,080
2004	2/26/2015 Notice of Allowance and Fee(s) Due, Application Serial No. 13/968,080
2005	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.

I. THE BOARD SHOULD NOT INSTITUTE AN *INTER PARTES* REVIEW.

The Board should deny ST Imaging's Petition for *inter partes* review of U.S. Patent No. 9,197,766 for both procedural and substantive defects.

First, procedural defects warrant denial of institution. The Office has already found that the '766 Patent is patentable over the same or substantially the same references that ST Imaging relies upon in the Petition. Additionally, for both Grounds 1 and 2, ST Imaging relies on a reference that is not a printed publication.

Second, the Board should deny institution because ST Imaging's Petition does not "demonstrate that it is more likely than not that any one of the claims challenged in the petition is unpatentable." *See* 37 C.F.R. § 42.208(c).

ST Imaging improperly used the '766 Patent as a roadmap for putting together the various elements of the claimed invention. ST Imaging demonstrates its impermissible hindsight reconstruction by failing to adequately articulate a reason why one of skill in the art would have made the proposed modifications.

Additionally, the teachings of the prior art references do not render the claims obvious. The cited prior art does not disclose numerous claim limitations and ST Imaging has failed to show that the proposed combinations would have been obvious.

For at least the foregoing reasons, ST Imaging's Petition should be denied in its entirety.

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