

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

Before KEN B. BARRETT, JENNIFER MEYER CHAGNON, and
MELISSA A., HAAPALA, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

A. *Background and Summary*

Digital Check Corp. d/b/a ST Imaging (“Petitioner”) filed a Petition requesting *inter partes* review of U.S. Patent No. 9,197,766 B2 (“the ’766 patent,” Ex. 1001). Paper 1 (“Pet.”). The Petition challenges the patentability of claims 41–43, 46, 49, 53, and 54 of the ’766 patent on grounds of obviousness under 35 U.S.C. § 103. e-ImageData Corp. (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 5 (“Prelim. Resp.”).

An *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Having considered the arguments and evidence presented by Petitioner and Patent Owner, we determine that Petitioner has not demonstrated a reasonable likelihood that it would prevail in establishing the unpatentability of the challenged claims of the ’766 patent.

B. *Related Proceedings*

Patent Owner identifies the ’766 patent as a continuation of U.S. Patent No. 9,179,019, which is a continuation of U.S. Patent No. 8,537,279, which is a continuation of U.S. Patent No. 8,269,890. Paper 4. One or both parties identify, as matters involving or related to the ’766 patent, a number of district court litigation matters involving these patents, including *e-ImageData Corp v. Digital Check Corp.*, No. 2:16-cv-576 (E.D. Wis.), and Patent Trial and Appeal Board cases IPR2017-00177 (U.S. Patent

No. 8,537,279) and IPR2017-00178 (U.S. Patent No. 9,179,019). Pet. 2;
Paper 4.

C. The '766 Patent

The '766 patent describes a digital microform imaging apparatus (DMIA) that may be used to view/scan a broad range of microfilm media types (e.g., microfilm, microfiche, aperture cards, 16 mm or 36 mm film roll). *See* Ex. 1001, 1:19–20, 7:56–58. The DMIA can accommodate a broad range of image reduction ratios without the need to change zoom lenses. *See id.* at 3:28–30. According to the '766 patent, an advantage of an embodiment is that “it provides a compact microfilm viewer/scanner.” *Id.* at 3:26–27. Figure 4 of the '766 patent is reproduced below:

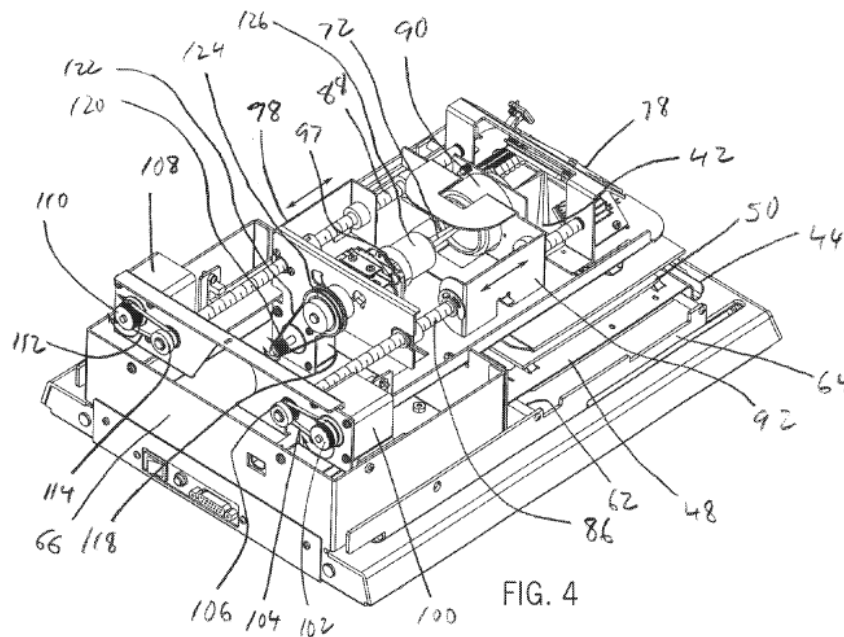


Figure 4 illustrates a perspective view of a DMIA with the cover removed and as viewed from generally rearward of the apparatus. *Id.* at 3:65–67.

The DMIA illustrated in Figure 4 includes: microform media support 44; chassis 66; mirror mount 78; first lead screw 86; second lead screw 88;

lens 90; area sensor 97; first carriage 92; second carriage 98; first motor 100; second motor 108; timing pulleys 102, 106, 110, 114; and belts 104, 112. *See id.* at 5:8–6:11. Microform media support 44 is configured to support a microform media. *Id.* at 5:8–10. A fold mirror (not shown) reflects incident light transmitted through microform media and is connected to mirror mount 78, which is connected to chassis 66. *Id.* at 5:31–33, 5:36–38. Lens 90 is connected to first carriage 92, which is linearly adjustable by rotating first lead screw 86. *Id.* at 5:43–45. Area sensor 97 is connected to second carriage 98, which is linearly adjustable by rotating second lead screw 88. *Id.* at 5:52–54. First motor 100 is rotationally coupled to first lead screw 86 by timing pulley 102, belt 104 with teeth, and timing pulley 106; and second motor 108 is rotationally coupled to second lead screw 88 by timing pulley 110, belt 112 with teeth, and timing pulley 114. *Id.* at 6:7–9.

A controller (not shown) is electrically connected to first motor 100, second motor 108, and area sensor 97. *Id.* at 6:11–13. The controller receives commands and inputs, controls first and second motors 100, 108 and other components of the DMIA, and outputs an image data of area sensor 97. *Id.* at 6:13–17. The layout of the DMIA, including separately adjustable area sensor 97 and lens 90, and algorithms for moving the lens and sensor to appropriate respective locations to achieve proper magnification and focus of the image, allows the DMIA to autofocus to accommodate different reduction ratios of different film media without the need for iterative measurements and refocusing of lens 90. *Id.* at 5:61–6:3. The DMIA depicted in Figure 4 includes additional components not described.

D. Illustrative Claim

Of the challenged claims of the '766 patent, claims 41 and 49 are independent claims. The remaining challenged claims directly depend from claim 41 or claim 49. Claim 41, reproduced below, is illustrative:

41. A digital microform imaging apparatus, comprising:
- a support structure that forms first and second cavities, the first and second cavities spaced apart to form a substantially horizontal gap there between;
 - a microform media support structure mounted within the horizontal gap for movement along a substantially horizontal longitudinal direction and a substantially horizontal transverse direction that is substantially perpendicular to the longitudinal direction;
 - an illumination source mounted within the first cavity to direct light along a first substantially vertical optical axis across the gap and into a front portion of the second cavity;
 - a fold mirror including a reflecting surface, the fold mirror supported within the second cavity and aligned with the first optical axis so that at least a portion of the light from the illumination source is directed at the reflecting surface, the reflecting surface forming a substantially 45 degree angle with the first optical axis and directing light that subtends the reflecting surface along a substantially horizontal second optical axis that forms a substantially 90 degree angle with the first optical axis, the second optical axis extending away from the reflecting surface and toward a rear portion of the second cavity;
 - an area sensor supported within the second cavity and aligned along the second optical axis, the area sensor supported along the second optical axis for movement there along within a first range of movement; and
 - a lens supported within the second cavity between the fold mirror and the area sensor for movement along the second optical axis within a second range of movement, the second range overlapping the first range at least somewhat.

Ex. 1001, 12:20–52.

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