

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**IN THE UNITED STATES 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: IPR2017-00346  
U.S. PATENT NO. 9,197,766

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**PETITION FOR *INTER PARTES* REVIEW**

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Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box. 1450  
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**LIST OF EXHIBITS**

- Ex. 1001: U.S. Patent No. 9,197,766 (“766 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: U.S. Patent No. 5,574,577 (“*Wally*”)

## I. INTRODUCTION

Digital Check Corp. d/b/a ST Imaging (“Petitioner”) requests *Inter Partes* Review (“IPR”) of claims 41-43, 46, 49, 53, and 54 (“Challenged Claims”) of U.S. Patent No. 9,197,766 (“‘766 Patent”) (Ex. 1001).

The ‘766 Patent discloses and claims microform imaging apparatuses. Microform readers were ubiquitous long before the ‘766 Patent. The ‘766 Patent acknowledges that the principle features of microform readers—a chassis, a mirror, a lens, an image sensor and an adjuster—were well-known many years prior to the alleged invention. (Ex. 1001, 2:23-36). The ‘766 Patent further recognizes that the digital aspects incorporated into the claimed invention were not novel. (Ex. 1001, 2:28-31). Rather, digitization of microfilm was a natural result of the prevalence of computers and the digital age. (Ex. 1001, 1:60-67).

The microform reader of the ‘766 Patent purports to be more “compact and versatile” than prior art readers. (Ex. 1001, 2:59-62; Ex. 1002, ¶22). Yet, the Challenged Claims fail to claim any novel elements or a novel arrangement of elements that were not already well-known in the prior art. In short, the Challenged Claims are nothing more than a straightforward recitation of conventional, well-known microform imaging technology.

As described in detail below, the Board should institute IPR and cancel the Challenged Claims.

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