

Keywords: 35 U.S.C. § 103; obviousness; *inter partes* review

General: Claims are obvious if a person of ordinary skill in the art would have been motivated to combine/modify prior art systems with predictable results. Findings of obviousness are a matter of law and thus reviewed *de novo*.

Canfield Scientific, Inc. vs. Melanoscan, LLC
United States Court of Appeals for the Federal Circuit
No. 2019-1927
Decided: February 18, 2021

I. Facts

Melanoscan, LLC. (“Melanoscan”) owns U.S. Patent No. 7,359,748 (“the ‘748 patent”), which is directed to an apparatus for photographing a person’s skin for identifying signs skin cancer. As claimed, the apparatus includes an enclosure configured to receive a person, or a portion of a person, a plurality of imaging devices, vertically and laterally spaced from one another, on opposite sides of the centerline of the enclosure, and a plurality of light sources spaced relative to one another.

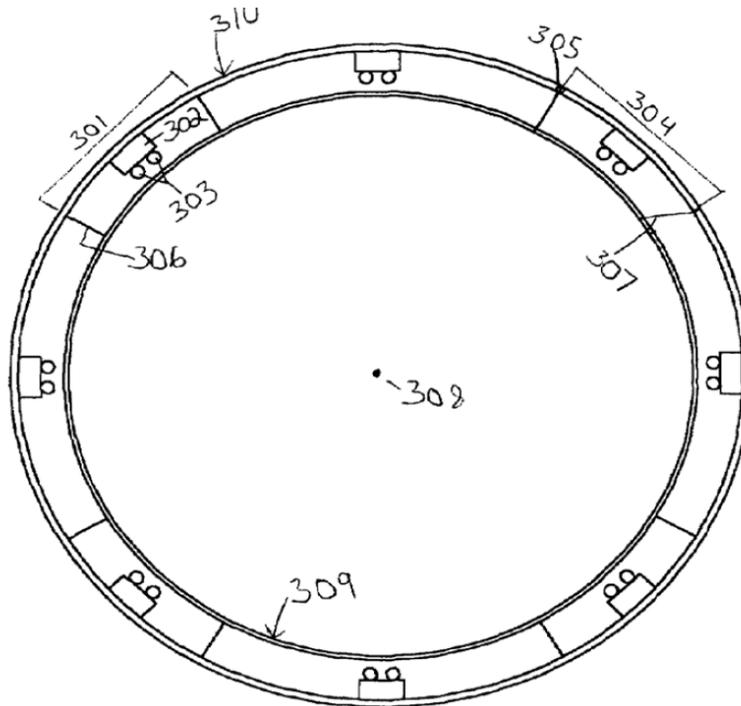


Figure 3 of the ‘748 patent

Claim 1 of the '748 patent recites:

1. A device for the identification of maladies that effect [sic] human tissue comprising:

an enclosure configured to receive a person or portion thereof for imaging the person or portion thereof, wherein the enclosure defines a specified imaging position for placing the person or portion thereof within the enclosure for imaging, and the specified imaging position defines a centerline;

a plurality of imaging devices, wherein a plurality of the imaging devices are vertically spaced relative to each other, a plurality of the imaging devices are laterally spaced relative to each other, a plurality of the imaging devices are located on opposite sides of the centerline of the specified imaging position relative to each other, and each imaging device is located a predetermined distance relative to the specified imaging position; and

a plurality of light sources spaced relative to each other and peripheral to the plurality of imaging devices that illuminate the person or portion thereof located at the specified imaging position and generate refraction and reflectance light therefrom;

wherein each of said imaging devices generates an image of the illuminated person or portion thereof located at the specified imaging position, and defines respective coordinates and said respective predetermined distance relative to the specified imaging position, and defines a respective focal length and resolution information, allowing precise measurement of imaged features of the person or portion thereof located at the specified imaging position.

Canfield Scientific, Inc. ("Canfield") petitioned the U.S. Patent Trial and Appeal Board ("PTAB") for *inter partes* review ("IPR") of the '748 patent, asserting that claims 1-8, 11, 30, 32-34, 46, and 51 are obvious based on five prior art references. The PTAB found that all of the challenged claims were non-obvious in view of the references identified by Canfield. Canfield appealed the PTAB's decision, arguing that the PTAB refused to consider arguments and evidence submitted by Canfield and that the PTAB misapplied the law of obviousness.

II. Issue

Did the PTAB err in determining that the claims were not obvious in view of the prior art provided by Canfield?

III. Discussion

Yes. As a preliminary matter, the Federal Circuit ("the court") noted that patentability on the ground of obviousness is a matter of law. Accordingly, the court reviews the PTAB's decision *de novo*. Any factual findings underlying the PTAB's finding of obviousness are reviewed by the standard of support by substantial evidence.

Though Canfield submitted five references for consideration in the IPR, the court focused its analysis on the Voigt, Hurley, and Crampton references. The Voigt reference (FIG. 1 reproduced below) discloses an enclosure having lights and cameras for imaging a patient's skin to detect signs skin cancer. However, rather than having cameras vertically and laterally spaced from one another, on opposite sides of the centerline of the enclosure, Voigt discloses that the patient stands along a wall, thus preventing the patient from being imaged on all sides.

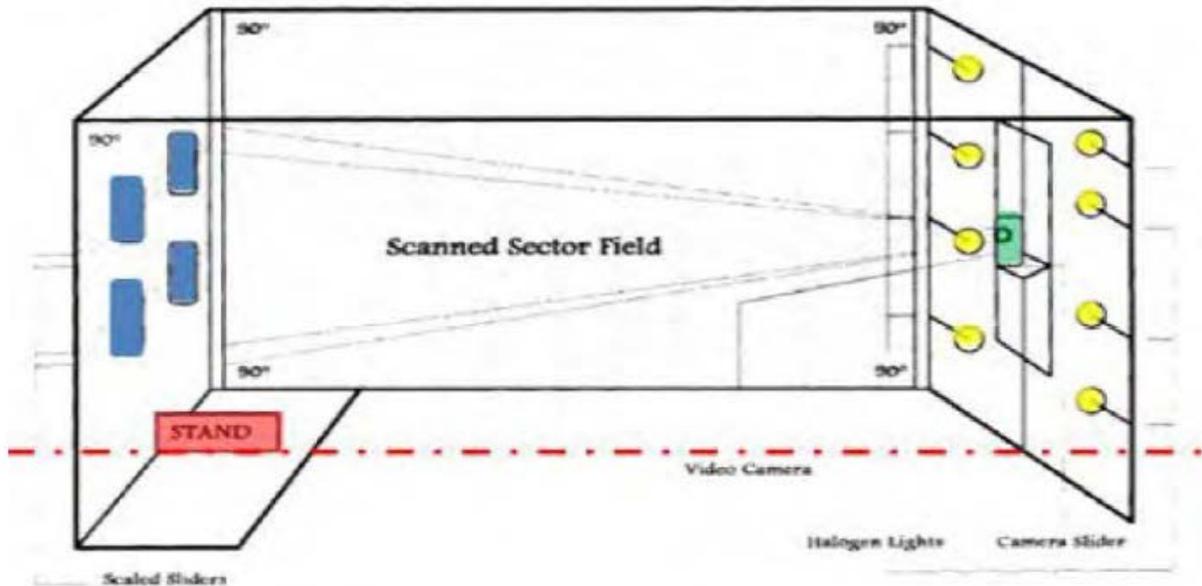


Figure 1 of Voigt (as annotated by Canfield)

The Hurley reference (FIG. 2.1 reproduced below) discloses a non-contact body measurement system for making made-to-measure apparel. Hurley discloses six imaging sensors, two each disposed on three towers (e.g., a high position and a low position). The towers are equipped with lights and situated such that the imaging sensors placed on two of the towers capture the front and sides of the person being measured, and the imaging sensors placed on the third tower capture the person's back.

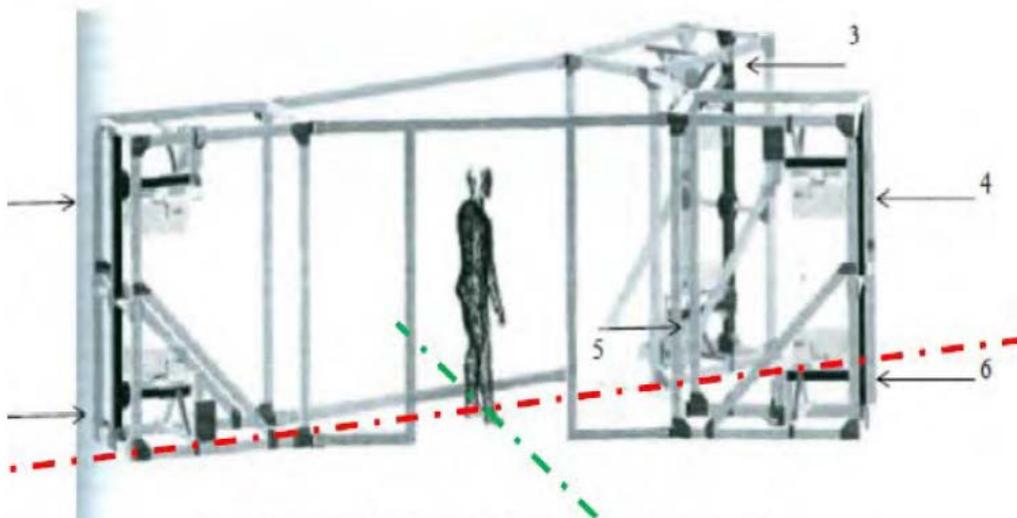


Figure 2.1 of Hurley (as annotated by Canfield)

The Crampton reference (FIG. 1 reproduced below) discloses an apparatus for imaging the surface of a person and creating an avatar of the person. The Crampton reference discloses that image resolution may be enhanced by using multiple cameras from multiple angles.

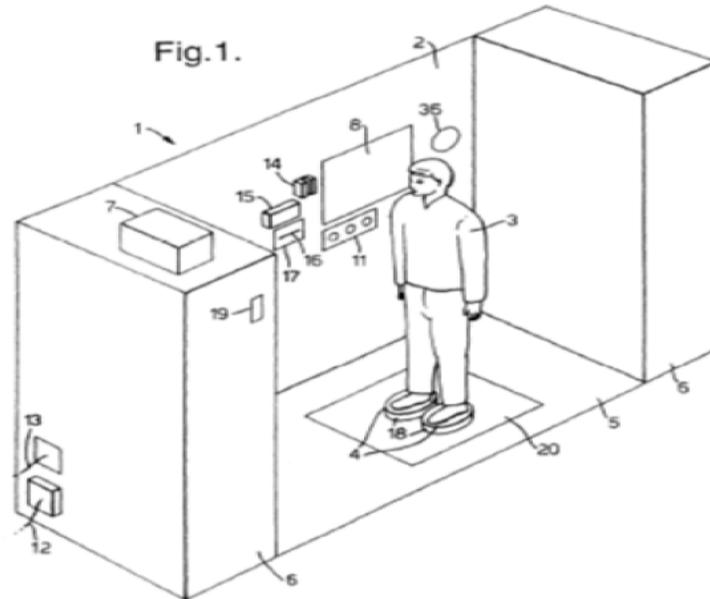


Figure 1 of Crampton

During the IPR, Canfield's expert witness stated that Voigt discloses capturing one side of a person's torso and that to increase the quantity of skin captured without having to reposition the person being imaged, a person of ordinary skill in the art would have been motivated to modify the system disclosed in Voigt to employ multiple cameras as taught by Hurley. Melanoscan's expert witness stated that there was no motivation to make the modification proposed by Canfield's expert with a reasonable expectation of success. The PTAB agreed with Melanoscan's expert and found that the Voigt reference's wall and horizontally adjustable sliders would have blocked the views of the additional cameras.

The court disagreed and noted that the PTAB failed to recognize that Hurley and Crampton teach placing the subject at the center of the enclosure rather than along one side of the enclosure, as taught by Voigt. Accordingly, the court found that it would have been obvious to one of ordinary skill in the art to modify the system of Voigt by adding the additional cameras taught by Hurley and Crampton and moving the subject to the center of the enclosure, as taught by Hurley and Crampton.

Accordingly, the court reversed the PTAB's finding of patentability as to independent claims 1 and 51. The PTAB did not separately analyze the dependent claims, so the court vacated the PTAB's decision as to dependent claims 2-8, 11, 30, 32-34, and 46 and remanded for determination of patentability of those claims.

IV. Conclusion

The court reversed the PTAB's finding of patentability as to independent claims 1 and 51. Because the PTAB did not separately analyze the dependent claims, the court vacated the PTAB's decision as

to dependent claims 2-8, 11, 30, 32-34, and 46 and remanded for determination of patentability of those claims.

V. Takeaways

When making arguments against combinations of references used in an obviousness rejection, try to anticipate alternate interpretations and/or combinations of the cited references and develop arguments that cannot be easily rebutted by making minor adjustments to how references are interpreted and/or combined. Additionally, though it can be difficult to anticipate what references will be cited when drafting an application, use dependent claims and the specification to give yourself some options to go in multiple directions with claim amendments and/or arguments.