

CANFIELD SCIENTIFIC, INC., v. MELANOSCAN, LLC, Appeal No. 2019-1927 (Fed. Cir. February 18, 2021). Before Newman, Dyk and Reyna. Appealed from Patent Trial and Appeal Board.

Background:

In an *inter partes* review, Canfield challenged the claims of a patent owned by Melanoscan. The claims of Melanoscan's patent are directed to an imaging device composed of a plurality of cameras and light sources spaced vertically and laterally around a person for detecting skin cancer and other skin-related maladies. In their petition for review, Canfield cited five references: Voigt, Hurley, Crampton, Daanen and Dye.

All parties agreed that the only feature recited in independent claims 1 and 51 that was not taught by Voigt was a plurality of cameras spaced vertically and laterally around the person. Voigt discloses a position framework for imaging the skin of a person for skin-related maladies by placing a person on a stand with their front or back facing a wall having position sliders and providing a camera and light sources at the opposite end of the wall facing the position sliders.

Canfield argued that it would have been obvious to have modified Voigt to arrange a plurality of cameras vertically and laterally around the person based on the teachings of Hurley, Crampton, Daanen and Dye, which all disclose different examples of a plurality of cameras arranged vertically and/or laterally relative to a person. The Board found that it would not have been obvious to modify Voigt's position framework with multiple imaging devices in the manner taught in Hurley, Crampton, Daanen and Dye because Voigt's sliders would occlude certain portions of the patient's skin and Voigt's rear wall (i.e., the wall to which the sliders are mounted) would completely block the view of the cameras located behind the patient. Thus, the Board held all of the challenged claims in Melanoscan's patent patentable, which Canfield appealed.

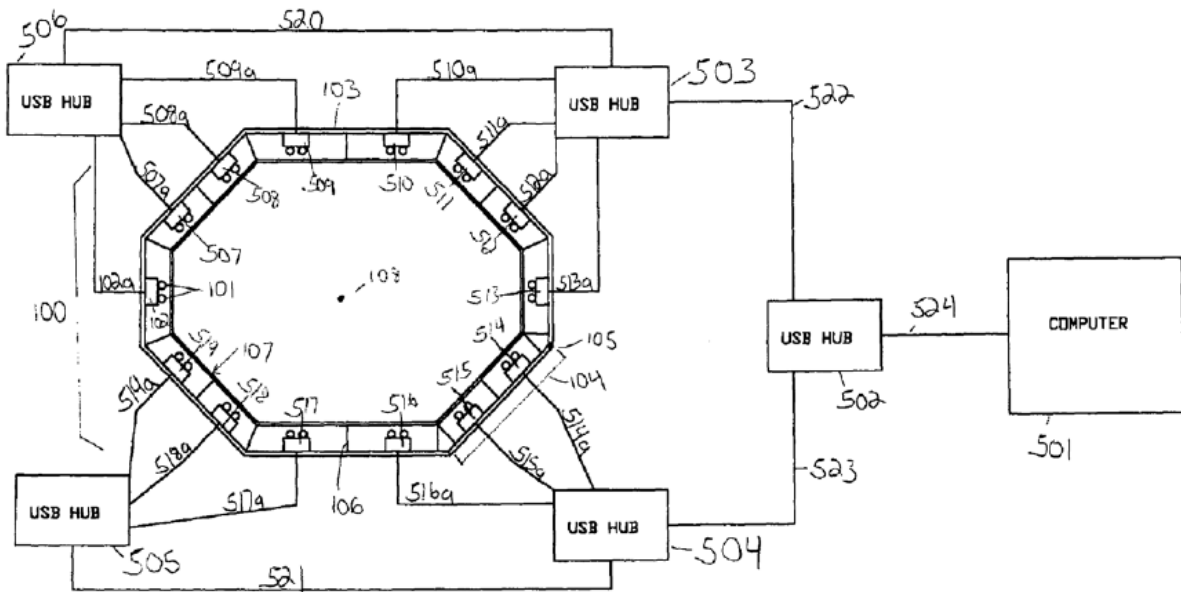
Issue/Holding:

Did the PTAB err in holding that the claims of Melanoscan's patent were not obvious over the cited prior art? Yes, reversed in part, vacated in part and remanded.

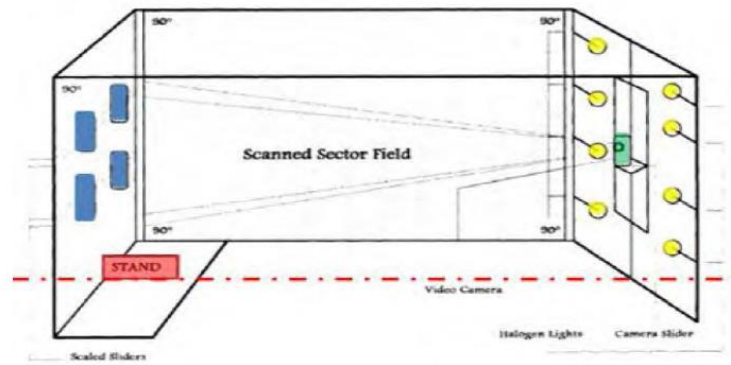
Discussion:

The Federal Circuit found that independent claims 1 and 51 of Melanoscan's patent do not limit the placement of the subject being imaged. The Federal Circuit also found that the references show various placements of the subject being imaged (i.e., Voigt places the subject against a wall, and Hurley, Crampton, and Daanen centrally place the subject within a framework). The Federal Circuit disagreed with the Board's finding of non-obviousness and asserted that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR*, 550 U.S. at 416. Therefore, the Federal Circuit ruled that the features of claims 1 and 51 would have been obvious over the combination of the five references.

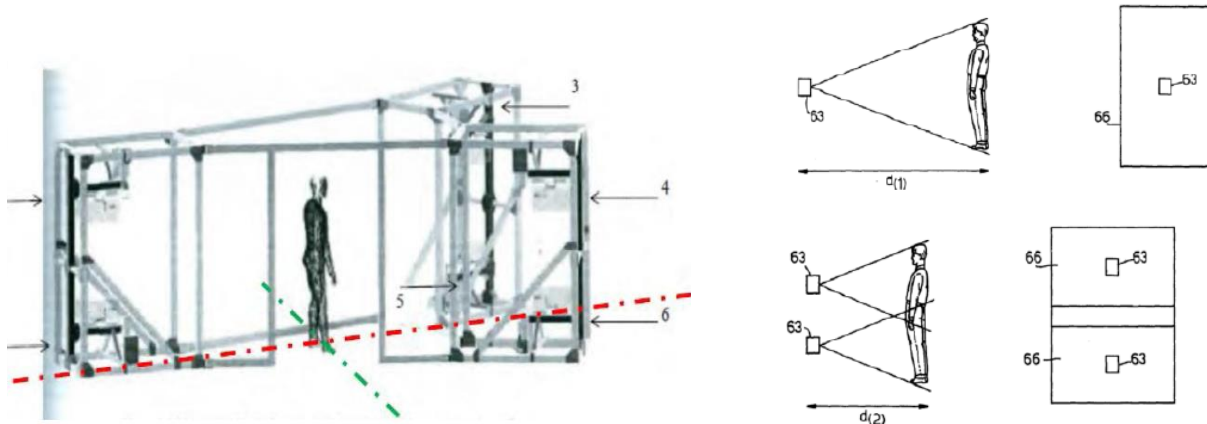
Accordingly, the Federal Circuit reversed the Board's ruling of patentability for claims 1 and 51 of Melanoscan's patent. But, because the Board did not separately analyze the dependent claims upon holding independent claims 1 and 51 to be patentable, the Federal Circuit vacated and remanded to the Board for further proceedings with respect to the dependent claims.



**Fig. 5 of Melanoscan's Patent**



**Annotated Fig. 1 of Voigt**



**Annotated Fig. 2.1 of Hurley**

**Fig. 9 of Crampton**