UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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RICOH AMERICAS CORPORATION and XEROX CORPORATION,
Petitioner,

v.

MPHJ TECHNOLOGY INVESTMENTS, LLC,
Patent Owner.

_____

Case IPR2013-00302
Patent 7,986,426 B1

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Before MICHAEL P. TIERNEY, KARL D. EASTHOM, and
GREGG I. ANDERSON, *Administrative Patent Judges.*

EASTHOM, *Administrative Patent Judge*.

DECISION
Request for Rehearing
*37 C.F.R. § 42.71(d)*

# I. BACKGROUND

In a Final Written Decision, we determined, by a preponderance of evidence, that Petitioner had shown that claims 1–5 and 7–11 of U.S. Patent No. 7,986,426 B1 were unpatentable, but had not shown that claim 6 was unpatentable. Paper 52. In its Rehearing Request, Petitioner requests the Board to withdraw "the finding that claim 6 of U.S. Patent No. 7,986,426 B1 (Ex. 1001 "'426 Patent") is not unpatentable over Salgado (Ex. 1005)." Paper 53, 1 ("Req. Reh'g."). For the reasons that follow, we deny the requested relief.

The applicable standard for a request for rehearing is set forth in 37 C.F.R. § 42.71(d), which provides, in relevant part, the following:

> A party dissatisfied with a decision may file a request for rehearing, without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, opposition, or a reply.

# II. DISCUSSION

Petitioner has not shown that we overlooked or misapprehended a previously addressed matter that warrants the requested relief. Petitioner's contention reduces to the assertion that Petitioner showed by a preponderance of evidence in its Petition that Salgado discloses the startup limitation recited in claim 6.

Petitioner contends that the Board interpreted the term "startup" too narrowly in reliance on Patent Owner's argument: "[Patent Owner's] argument implies that the term 'startup' applies to a specific system or component, which – under the BRI – it does not." Req. Reh'g 8–9. According to this contention, Petitioner "respectfully request[s] that the Board reconsider the scope of the 'startup' limitation, and find that it encompasses reading a list upon startup of a

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process that uses items on the list – which is expressly disclosed by Salgado."
Reh'g. Req. 10.

Notwithstanding the contentions, the Petition does not construe the term "startup" explicitly. Under 37 C.F.R. § 42.104(b) (3) & (4), the Petition must "identify . . . (3) [h]ow the challenged claim is to be construed. . . . [and] (4) "[h]ow the construed claim is unpatentable under the statutory grounds specified . . . . The Petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon."

Claim 6 recites "wherein the server module includes . . . a list of said input, output, client, process and server modules that can be used in said data management system, said list being read on startup." Claim 6 depends from claim 5, which recites a "data management system" that includes "at least one processor" that "implement[s]" a "software application" that includes "at least one" server module. In other words, claim 6 logically and implicitly requires "said list [of said modules as recited in claim 5] being read on startup" to refer to the startup of a module, processor, or system, in claim 5 that either accesses or contains the list: i.e., either the server module, at least one processor, or the management system. Such a reading is consistent with the '302 Patent Specification. *See*, *e.g*., Ex. 1001, col. 72, ll. 46–47 ("The Server Modules read[] this list on startup . . . ."); col. 16, ll. 55–61 (implying either startup of the server module or management system).

In other words, in claims 5 and 6, the "server module" is part of the recited software application. Therefore, the recited startup implies invoking the software server module, which reads the list upon such an invocation, or the recited startup implies powering up the management system or the processor that employs the software server module that reads the list upon power up. *See* claims 5 and 6.

Petitioner maintains that it "cit[ed] to the claim chart for element 10.2a-b" to address the "startup" limitation. *See* Reh'g Req. 10, 10–12 (purporting to read claim 6 on Salgado, citing Pet. 38, 40). However, claim 10 elements "10.2a-b" do not recite a startup limitation, as the Final Written Decision finds and determines. *See* Paper 52, 49. Petitioner also explains that "[t]he Petition relied on Salgado at column 16, lines 58–67 to address the 'startup' limitation." Reh'g Req. 10 (citing Pet. 38, 40). That is not correct. The column 16 citation appears on page 40, which not only includes another citation to column 14, but specifically addresses elements of claim 10, which does not recite a startup limitation, as noted above.

Petitioner also notes, in the Rehearing Request, that the cited column 16 passage refers to Figure 8 in Salgado, and argues as follows: "the very first step of Fig. 8, teaches 'provide client with metaphor elements.'" Reh'g Req. 10. Petitioner then explains that "[t]hus, in the very first step of the process in FIG. 8 of Salgado – i.e., on 'startup' of the process to build a document workflow – metaphor elements are read from a list, which meets the 'startup' limitation of claim 6." *Id*. at 11. Petitioner also relies on the Board's finding that Salgado's common file includes a list. *See id*. at 11–12.

However, Petitioner fails to point the Board to where its Petition discusses Figure 8. Pages 38 and 40 of the Petition do not refer to Figure 8, and do not discuss a "first step" or "startup." Instead, Petitioner presents this explanation for the first time in its Rehearing Request. In light of the issue Patent Owner presents with respect to claim 6 as discussed further below, the Petition does not provide a discernable explanation regarding the startup limitation that satisfies the ultimate burden of showing unpatentability. Page 40 of the Petition quotes a passage in Salgado about metaphor elements that the Petition maps to claim 10 elements 10.2a-b. Petitioner does not point to where its Petition explains clearly that

providing a client with metaphor elements relates to reading Salgado's common
file on startup of anything, let alone startup of a server module, or a processor or
management system implementing the module. In summary, Petitioner fails to
point the Board to where the Petition asserts that "startup" in claim 6 corresponds
to employing the first step of the process in Figure 8. Petitioner effectively
requests the Board to fill in the gaps to satisfy its required final burden of proof
regarding claim 6, because we made initial findings and instituted trial on claim 6
based on a lesser burden at the institution stage.

Assuming for the sake of argument that it would be proper for the Board to
consider the new explanation by Petitioner, Petitioner fails to show persuasively
how reading a list at a first step in the flow diagram of Figure 8 constitutes reading
a list at startup as required by claim 6. Figure 8, step 170, does not represent a first
step of a process. Rather, Figure 8 constitutes a part of a process that begins
according to Figure 7 at a prior step 146. *See* Ex. 1004, Fig. 7, col. 14, ll.10–11
(Figures "7–11 [represent] a technique for implementing a metaphorical job
ticket/control system.")

Therefore, even if the flow diagram of Figure 8 somehow relates to the
software server module of claim 6, and even if providing metaphor elements from
a common file constitutes reading a list of the required modules recited in claim 6,
it is possible, if not probable, that the sub-process represented by Figure 8 was
invoked (i.e., started-up) prior to implementing step 170 of the process, i.e., even if
step 170 represents a first step of the sub-process represented by Figure 8.
According to Salgado, "[i]n one embodiment [that Petitioner appears to rely upon],
the user is provided with a selection from a plurality of metaphor elements. These
may be provided by way of a common file which is accessible to users across the
network." Ex. 1004, col. 16, ll. 64–67. Hence, even if the common file is read at

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