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Paper 8
Entered: November 21, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RICOH AMERICAS CORPORATION and XEROX CORPORATION
Petitioner

v.

MPHJ TECHNOLOGY INVESTMENTS, LLC
Patent Owner

Case IPR2013-00302
Patent 7,986,426 B1

Before SALLY C. MEDLEY, MICHAEL P. TIERNEY, and KARL D. EASTHOM, *Administrative Patent Judges.*

EASTHOM, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner, Ricoh Americas Corporation and Xerox Corporation, filed a Petition requesting an *inter partes* review of claims 1-11 of U.S. Patent No. 7,986,426. Paper 1 ("Pet."). Patent Owner, MPHJ Technology Investments LLC, did not file a Preliminary Response. We have jurisdiction under 35 U.S.C. § 314.

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a):

> THRESHOLD – The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 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.

Pursuant to the defined threshold under 35 U.S.C. § 314(a), the Board institutes an *inter partes* review of claims 1-11 of the '426 Patent.

A. Related Proceedings

According to Petitioner, the '426 Patent is involved in a declaratory judgment action, *Engineering & Inspection Services, LLC v. IntPar, LLC*, No. 13-0801 (E.D. La., Oct. 10, 2013), and, with related patents, is also the subject of a consumer protection lawsuit, *Vermont v. MPHJ Tech. Investments LLC*, No. 282-5-13 (Ver. Sup. Ct., May, 2013) (MPHJ filing notice of removal to D. Vt., June 7, 2013 (No. 2:13-cv-00170)). *See* Pet. 3. The '426 Patent is related to U.S. Patent No. 6,771,381, which is the subject of *inter partes* review IPR2013-00309.

B. The '426 Patent

The '426 Patent describes the "Virtual Copier" (VC) system. The system enables a personal computer user to scan paper from a first device and copy an

electronic version of it to another remote device, or integrate that electronic version with a separate computer application in the network. *See* Ex. 1001, Abstract.

According to the '426 Patent, "VC can be viewed as a copier. Like a copier, VC takes paper in, and produces paper going out. The only difference is that VC does not distinguish between electronic and physical paper." *Id*. at col. 70, ll. 37-39.

VC extends from "its simplest form" to its "more sophisticated form":

> In its simplest form it extends the notion of copying from a process that involves paper going through a conventional copier device, to a process that involves paper being scanned from a device at one location and copied to a device at another location. In its more sophisticated form, VC can copy paper from a device at one location directly into a business application residing on a network or on the Internet, or [vice] versa.

Id. at col. 5, ll. 48-55.

The VC includes "five essential modules": input module, output module, process module, client module, and server module. "Each module is a counterpart to an aspect that is found on a conventional copier." *Id*. at col. 70, ll. 41-43. Notwithstanding that the latter sentence refers to each module, the '426 Patent ambiguously states that "[t]here is no counterpart to VC's Server Module on a conventional copier." *Id*. at col. 71, ll. 26-27. In any event, the other four modules have "counterparts" on "conventional" copiers: "The Input Module manages paper or electronic paper entering VC. . . . The counterpart to VC's Input Module on a conventional copier is the scanner subsystem." *Id*. at col. 70, ll. 47-53. "The Output Module manages paper or electronic paper exiting VC. . . . The counterpart to VC's Output Module on a conventional copier is the printer or fax subsystem." *Id*. at ll. 54-61. "The Process Module applies processing to the electronic paper as it is being copied. . . . The counterpart to VC's Process Module on a conventional

copier is the controller." *Id*. at l. 61 – col. 71, l. 3. "The Client Module presents the electronic paper as it is being copied, and any relevant information related to the input or output functions. . . . The counterpart to VC's Client Module on a conventional copier is the panel." *Id*. at col. 71, ll. 4-12. "Unlike conventional copiers, VC's Server Module is a unique subsystem that can communicate with the other modules as well as third-party applications." *Id*. at ll. 13-15.

Figure 28 of the '426 Patent, reproduced below, represents an embodiment of VC:

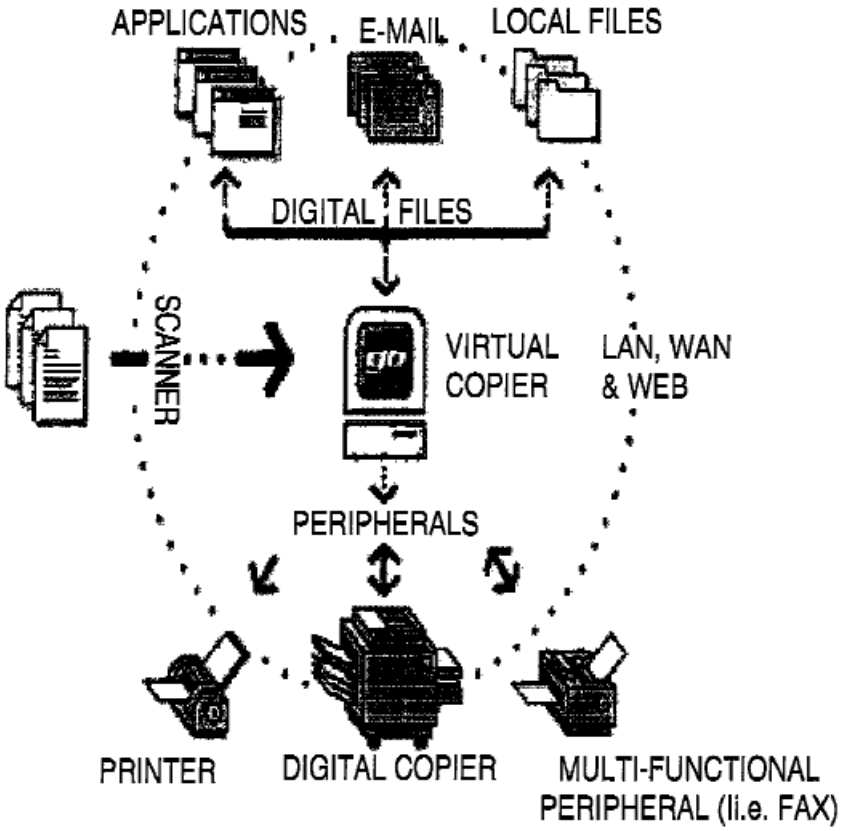

FIG. 28

Figure 28 depicts various peripheral devices attached to a Virtual Copier on a network. *See id*. at Abstract.

C. Exemplary Claims

Of the challenged claims, claims 1-5 and 9-11 are independent. Challenged claims 1, 5, and 10 follow:

> 1. A computer data management system including at least one of an electronic image, graphics and document management system capable of transmitting at least one of an electronic image, electronic graphics and electronic document to a plurality of external destinations including one or more of external devices and applications responsively connectable to at least one of locally and via Internet, comprising:
>
> at least one scanner, digital copier or other multifunction peripheral capable of rendering at least one of said electronic image, electronic graphics and electronic document;
>
> at least one memory storing a plurality of interface protocols for interfacing and communicating;
>
> at least one processor responsively connectable to said at least one memory, and implementing the plurality of interface protocols as a software application for interfacing and communicating with the plurality of external destinations including the one or more of the external devices and applications,
>
> wherein the computer data management system includes integration of at least one of said electronic image, electronic graphics and electronic document using software so that said electronic image, electronic graphics and electronic document gets seamlessly replicated and transmitted to at least one of said plurality of external destinations.

> 5. A computer data management system including at least one of an electronic image, graphics and document management system capable of transmitting at least one of an electronic image, electronic graphics and electronic document to a plurality of external destinations including one or more of external devices and

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