

**UNITED STATES PATENT AND TRADEMARK OFFICE**

---

**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

---

**RICOH AMERICAS CORPORATION  
XEROX CORPORATION**  
Petitioners

v.

**MPHJ TECHNOLOGY INVESTMENTS LLC**  
Patent Owner

---

Case IPR2013-00302  
Patent No. 7,986,426 B1

---

**PETITIONERS' REQUEST FOR REHEARING**

***Mail Stop "PATENT BOARD"***  
Patent Trial and Appeal Board  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Table of Contents**

I. Relief Requested.....1

II. Overview.....1

III. Statement of Facts Relevant to Claim 6 .....3

    A. Trial Institution: Petition demonstrates a reasonable likelihood that claim 6 is anticipated by Salgado.....4

    B. During Trial: The issue of whether Salgado discloses the “startup” limitation of claim 6 was never addressed by the Board or MPHJ.....6

    C. Final Written Decision: Petitioners did not show that Salgado discloses the “startup” limitation of claim 6 .....7

IV. The Board should have found that claim 6 is unpatentable as anticipated by Salgado.....7

    A. The Board misapprehended the scope of the “startup” limitation. ....8

    B. The Board overlooked Salgado’s teaching (relied in the Petition) that the first step – *i.e.*, “startup” – in a process to build a document workflow is to read the list from “a common file ... across the network.” .....10

V. Conclusion .....14

## **I. Relief Requested**

Petitioners Ricoh Americas Corporation and Xerox Corporation (“Ricoch and Xerox”) respectfully ask the Board to reconsider its Final Written Decision (paper 52, “Final Decision”) as to 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).

## **II. Overview**

Dependent claim 6, including the limitations of independent claim 5, is a lengthy and convoluted claim with over 500 words and many limitations. Included among those limitations is a “maintain list of available module means” that requires “a list of ... input, output, and process modules” to be “read on startup.” The Institution Decision held that Salgado discloses the “maintain list of available module means,” including the list of modules, but the Final Decision held that Salgado does not disclose “said list being read on startup” (“startup limitation”).

Yet, the Petition provided evidence that Salgado’s list of modules is read on startup by explicitly directing the Board to a portion of Salgado that shows the list being read on startup of a document workflow process. In the Institution Decision, the Board initially agreed that the “startup limitation” is disclosed by Salgado, and Patent Owner (“MPHJ”) never refuted this initial finding. In the Final Decision, the Board reversed its position as to whether Salgado taught the “startup

limitation,” misapprehending the scope of “startup” and overlooking the Petition’s explicit showing that Salgado teaches this limitation.

The interest of justice supports reversal of the Board’s finding relative to claim 6. In the Institution Decision, the Board denied five other grounds challenging the claims, including an obviousness ground based on Salgado. This denial was arbitrary and denied Petitioners the opportunity to present obviousness-based arguments based on Salgado, and to present other arguments relative to references, such as Ohkubo (Ex. 1004), which Petitioners and Petitioners’ expert explained have technical strengths over the references asserted in the other grounds.

The Patent Owner is not prejudiced by reversal of the Board’s Final Decision, as it was put on notice in the Institution Decision that Salgado discloses the “startup limitation,” and chose not to refute this finding. In fact, Patent Owner had at least three opportunities to raise this issue – in a Preliminary Response (which it did not file), in its Patent Owner Response, and in the Oral Hearing – but failed to raise it each time.

On the other hand, Petitioners are prejudiced by the Board’s Final Decision relative to claim 6. Following the Institution Decision, Petitioners never had an opportunity to present new arguments or evidence (nor did they have any notice that they needed to revisit their “startup limitation” arguments) relative to Salgado

disclosing the “startup limitation.” Specifically, following the Institution Decision, the Board never again raised an issue with respect to the “startup limitation” and Salgado, and Patent Owner never refuted this point. Thus, under the *inter partes* review rules, Petitioners were not permitted to revisit its arguments.<sup>1</sup>

For at least these reasons, Petitioners respectfully request that the Board grant this Request and find claim 6 unpatentable.

### III. Statement of Facts Relevant to Claim 6

Ricoh and Xerox petitioned (paper 1, “Pet.”) the Board seeking *Inter Partes* Review of the ’426 patent on the following grounds:

Ground	35 USC	Index of Reference(s)	Claims
1	102(b)	XNS (inherent features evidenced by GIS 150)	1-11
2	102(b)	Ohkubo	1-11
3	102(e)	Salgado	1-11
4	102(a)/(e)	Harkins	1-11
5	103(a)	Ohkubo in view of APA	3, 5-9, 11

---

<sup>1</sup> A petitioner’s reply may only respond to arguments raised in the corresponding opposition. 37 C.F.R. § 42.23. During oral hearing “no new evidence or arguments may be presented at the oral argument.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012).

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.