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Paper 35
Entered: November 19, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HEWLETT-PACKARD CO.,
Petitioner,

v.

MPHJ TECHNOLOGY INVESTMENTS, LLC,
Patent Owner.

Case IPR2013-00309
Patent 6,771,381 B1

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

EASTHOM, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

Petitioner, Hewlett-Packard Co., filed a (resubmitted) Petition requesting *inter partes* review of claims 1–15 of U.S. Patent No. 6,771,381 (Ex. 1001). Paper 6 ("Pet."). Patent Owner, MPHJ Technology Investments, LLC, did not file a (non-required) Preliminary Response, and we instituted *inter partes* review of claims 1–15, on two grounds of unpatentability, as listed below. *See* Paper 9 ("Dec. on Inst.").

Subsequent to institution, Patent Owner filed a Patent Owner Response (Paper 20, "PO Resp."), and Petitioner filed a Reply (Paper 25, "Pet. Reply") thereto. Substantively, Petitioner relies on a declaration by Mark Wibbels (Ex. 1005), and Patent Owner relies on a declaration by Glenn Weadock (Ex. 2002). Patent Owner deposed Mr. Wibbels. Ex. 2003. The parties requested and appeared at an oral hearing before the panel, which transpired on August 18, 2014. The record includes a transcript of the hearing. Paper 34 ("Tr.").

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision, issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73, addresses issues and arguments raised during trial.

For the reasons that follow, we determine that Petitioner has met its burden of proving, by a preponderance of the evidence, that claims 1–12, 14, and 15 of the '381 Patent are unpatentable. Petitioner, however, has not demonstrated by a preponderance of the evidence that claim 13 of the '381 Patent is unpatentable.

A. Related Proceedings

According to Petitioner, the '381 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. 1; Ex. 1016. The '381 Patent application is a grand-parent to U.S. Patent No. 7,986,426, which is also the subject of an *inter partes* review. *See Ricoh Americas Corp. v. MPHH Tech. Invs., LLC*, Case IPR2013-00302 (PTAB) ("'302 IPR").

B. The '381 Patent

The '381 Patent describes a "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 '381 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. 71, ll. 62–65.

The 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. 47–54.

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. 71, l. 66 – col. 72, l. 1. Notwithstanding that the latter sentence refers to each module, the '381 Patent ambiguously states that "[t]here is no counterpart to VC's Server Module on a

conventional copier." *Id*. at col. 72, ll. 59–60. 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. 72, ll. 5–13. "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. 14–23. "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 ll. 24–34. "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 ll. 34–45. "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. 44–47.

Figure 28 of the '381 Patent follows:

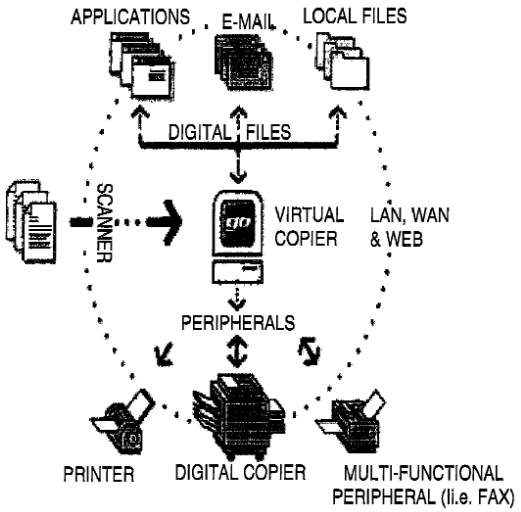

FIG. 28

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

C. Illustrative Claim

Of the challenged claims, claims 1 and 12–15 are independent. Challenged claim 1 follows:

> 1. [1.P] 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 at least one of locally and via the Internet, comprising:
>
> [1.1] at least one memory storing a plurality of interface protocols for interfacing and communicating;
>
> [1.2] 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 said software application comprises at least one of:
>
> [1.3] at least one input module managing data comprising at least one of paper and electronic paper input to the computer data management system, and managing at least one imaging device to input the data through at least one of a scanner and a digital copier, and managing the electronic paper from at least one third-party software applications; and
>
> [1.4] at least one module communicable with said at least one input, output, client, and process modules and external applications, and capable of dynamically

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