

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HEWLETT-PACKARD COMPANY
Petitioner

v.

MPHJ TECHNOLOGY INVESTMENTS, LLC
Patent Owner

Case IPR2013-00309
Patent 6,771,381 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, Hewlett-Packard Company, filed a revised Petition requesting an *inter partes* review of claims 1-15 of U.S. Patent No. 6,771,381. Paper 6 (“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 1-15 of the ’381 Patent.

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., date not listed), 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 is related to U.S. Patent No. 7,986,426, which is the subject of another *inter partes* review, IPR2013-00302.

B. The '381 Patent

The '318 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 '318 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. 46-52.

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 '318 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, reproduced below, represents an embodiment of VC:

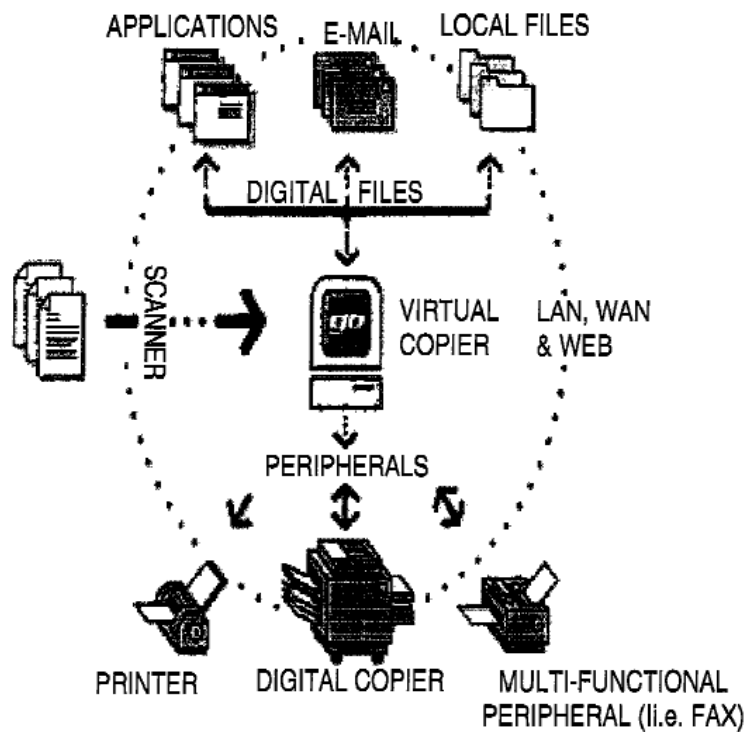


FIG. 28

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

C. Exemplary Claim

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

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 at least one of locally and via the Internet, comprising:

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 said software application comprises at least one of:

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 at least one module communicable with said at least one input, output, client, and process modules and external applications, and capable of dynamically combining the external applications with at least one of digital capturing devices and digital imaging devices.

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