

Keywords: provisional application; claim construction; incorporation by reference; disavowal of claim scope.

General: Statements in a provisional application omitted from the subsequent non-provisional application may affect the construction of the non-provisional claims.

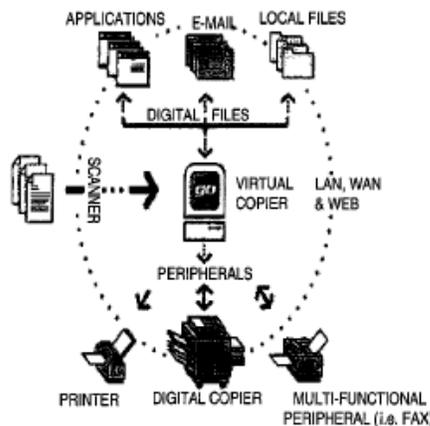
MPHJ Technology Investments, LLC v. Ricoh Americas Corporation, Xerox Corporation, Lexmark International, Inc.

(2016-1243 Fed. Cir. 2017)

February 13, 2017

I. Facts and Procedural History

MPHJ Technology Investments, LLC (hereinafter, “MPHJ”) is the assignee of a patent 8,488,173 (hereinafter, “‘173 patent”) related to a Virtual Copier (VC) for scanning a document at one location and copying the document to another location. The scanned document may be printed at the other location, stored at the other location, or attached to an email.



The ‘173 patent filed in 2011 claims priority to provisional application 60/108,798 (hereinafter, “‘798 application”) filed November 13, 1998. The ‘173 patent incorporates by reference all of the designated “related” applications. MPHJ is a non-practicing entity that has issued thousands of demand letters to companies of all sizes requesting a licensing fee of \$1,000 per worker for the use of a multi-function printer’s scan-to-email function. The imaging/printing manufacturers Ricoh, Xerox, and Lexmark requested an *Inter Partes* Review of the ‘173 patent.

Claim 1 of the ‘173 patent recites, *inter alia*, “in response to the selection of said Go button, ... [an] electronic document gets seamlessly replicated and transmitted to at least one of said plurality of external destinations.” MPHJ argued that “seamless” transmission requires a one-step operation without human intervention. Claim 4 of the ‘173 patent recites, *inter alia*, “interfacing between at least one of said scanner, digital copier or other multifunction peripheral and email application software using a first of said interface protocols.” MPHJ argued that this recited “interfacing” requires the operation from scanner to email destination to occur in a single step. MPHJ asserted that the ‘798 application supports the claim construction of a requirement of a single-step operation. The Patent Trial and Appeal Board (PTAB) disagreed and construed the claims as including scanning and emailing in separate steps or in a single step, with or without

intervention by a human or a machine. With this claim construction, the PTAB invalidated all claims (1-8) of the '173 patent as both anticipated and/or obvious in view of several references.

II. Issue

Did the PTAB err in construing the claims as not limited to a single-step operation?

III. Discussion

No. The majority of the panel of the Federal Circuit affirmed the construction by the PTAB that the claims are not limited to single-step operation of copying and transmitting. MPHJ argued that the more narrow single-step claim construction of the recited "seamless" transmission is supported by the following portions of the '798 application:

Patent: The IMAGinE Virtual Copier Interface: A Simple Method of Presenting to a User the Complex Operation of Copying Files or Electronic Images to and from Digital Imaging Devices and/or Software Applications in One Step

...

The IMAGinE Virtual Copier can copy paper from a physical device directly into a third-party software application in one step. Using other applications, such as Visioneer's Paperport or Xerox's Paxis, the user must first "import" or scan paper into the capture application and then drag or direct the output to another location. With the IMAGinE Virtual Copier, a single button (the Go button) directly copies paper from a scan-like device (either a copier with a scan attachment or a scanner) and places it within the third-party application.

MPHJ argued that those statements expressly limited the scope of the invention to a one-step copying and sending process. However, the Federal Circuit noted that those statements in the '798 application were omitted from the '173 patent. MPHJ argued that because those omitted sections were not explicitly disclaimed, they are part of the prosecution history and are properly relied on to explain and limit the claims. Citing another Federal Circuit decision¹, the majority agreed that the provisional application can contribute to the understanding of the claims. Here, the majority concludes that one of ordinary skill in the art in this field would deem the deletion of the above statements from the '173 patent to be significant. The majority finds no statement or suggestion in the '173 patent of an intent to limit the claims to the deleted one-step operation discussed in the '798 application.

Additionally, while the '173 patent does describe the single-step operation as "optional," the majority asserts that with the deleted statements from the provisional, one would reasonably conclude that the inventor intended for the single-step operation to be optional, rather than obligatory. The majority makes no mention of the incorporation by reference of the '798 application into the '173 patent.

Agreeing with the claim construction by the PTAB, the Federal Circuit also agreed² with the PTAB that the substantial evidence supports the findings of anticipation and obviousness by the cited references.

¹ *Trs. Of Columbia Univ. in New York v. Symantec Corp.*, 811 F.3d 1359, 1365 (Fed. Cir. 2016)

² The Federal Circuit also reviewed whether there was substantial evidence to support the anticipation and obviousness conclusions by the PTAB. Although the majority and the dissent reached different conclusions on the single-step operation claim construction and the anticipation conclusions, the primary issue for this brief is the effect of the provisional application on the claim construction.

IV. Conclusion

Changes between a provisional application and the subsequent non-provisional application may affect the claim construction. Additionally, incorporation of the provisional application by reference into the non-provisional application may not be given full weight.

Good practice may be to take special care when removing material from the non-provisional application that was present in the provisional application. Better practice may be to only add material to the non-provisional application rather than delete any material that was present in the provisional application. Best practice may be to draft good provisional applications to begin with that are as complete as possible, and to provide picture-claims to specific embodiments of value to the client or emphasized in the disclosure materials.

V. Dissent

Judge O'Malley notes that the '798 application was incorporated by reference into the '173 patent, noting that a provisional application incorporated by reference is "effectively part of the host document as if it were explicitly contained therein."³ Judge O'Malley notes that the patentee did the opposite of deleting by incorporating in full the '798 application. Additionally, she notes that the '798 application states that the purpose of the patent "is to protect our new 'Go' operation that designates a *single-step copying function* for copying ... between disparate digital imaging devices."⁴ She concludes that statements of the '798 application and the '173 patent collectively rise to the level of clear and unmistakable disavowal of claim scope. Thus, Judge O'Malley believes that the proper claim construction would be limited to single-step operation of copying and transmitting. With that claim construction, she finds that claims 1-3 are anticipated, but claims 4-8 are neither anticipated nor obvious in view of the cited references.

³ *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000).

⁴ Dissent, page 10.