

MPHJ TECH. INVESTMENTS, LLC v. RICOH AMS. CORP., Appeal No. 2016-1243 (Fed. Cir. February 13, 2017). Before Newman, Lourie, and O'Malley. Appealed from P.T.A.B.

Background:

Ricoh requested Inter Partes Review ("IPR") to invalidate the claims of MPHJ's patent directed to scanning a paper from a device at one location and copying that paper to a device at another location. The claims of MPHJ's patent recited terms of "interfacing" and "Go button," which MPHJ argued during the IPR should be construed to require a single-step transfer from scanner to email or other destination. The Patent Trial and Appeal Board ("Board") disagreed, construing the claims as including scanning and emailing, whether in separate steps or in a single step, with or without user intervention by human or by machine. Based on this construction, the Board invalidated MPHJ's patent in view of prior art. MPHJ appealed.

Issue/Holding:

Did the PTAB err in its construction of the claims of MPHJ's patent and in its corresponding invalidation of those claims? No, affirmed.

Discussion:

MPHJ argued that its claim interpretation was supported by the provisional application that gave rise to its patent, specifically citing two statements in that application referring to "one step" operation. MPHJ thus concluded that those statements "expressly limited the scope of the invention" to a one-step copying and sending process.

The Federal Circuit disagreed. It first noted that the statements from the provisional application relied on by MPHJ were omitted from the non-provisional application. The court concluded that one of ordinary skill in the art would find this omission to be significant. The Federal Circuit also turned to the abstract and specification of MPHJ's patent, which referred to the "one step" operation as being "optional." The court thus affirmed the Board's claim construction and subsequent finding of invalidity.

Concurrence and Dissent:

Judge O'Malley concurred in part and dissented in part. She argued that the Board misconstrued the terms "Go button" and "interfacing" to encompass the use of manual intervention to render and transmit a scanned document. She would therefore affirm the Board's finding that certain claims of MPHJ's patent are anticipated, but she would reverse its finding for other claims.