

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOSHIBA TEC CORPORATION AND TOSHIBA
AMERICA BUSINESS SOLUTIONS, INC.,
Petitioner,

v.

K.MIZRA, LLC,
Patent Owner.

IPR2022-01426
Patent 7,570,400 B2

Before NATHAN A. ENGELS, AARON W. MOORE, and
IFTIKHAR AHMED, *Administrative Patent Judges*.

ENGELS, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Petitioner Toshiba Tec Corporation and Toshiba America Business Solutions, Inc. (collectively, “Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–4 of U.S. Patent No. 7,570,400 B2 (Ex. 1001, “the ’400 patent”). Patent Owner K.Mizra, LLC filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless the information presented in the Petition and any response thereto shows “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Upon consideration of the Petition and the evidence of record, we determine Petitioner has not demonstrated a reasonable likelihood of prevailing in establishing unpatentability of at least one claim of the ’400 patent. Accordingly, we do not institute *inter partes* review.

A. *Real Parties-in-Interest*

Petitioner identifies Toshiba Tec Corporation; Toshiba America Business Solutions, Inc.; Toshiba America, Inc.; and Toshiba Corporation as real parties-in-interest. Pet. 98. Patent Owner identifies K.Mizra LLC as the real party-in-interest. Paper 4, 1.

B. *Related Matters*

The parties state that the ’400 patent is the subject of *K.Mizra, LLC v. Toshiba Tec Corporation*, No. 6:21-cv-1293-PGB-EJK (M.D. Fla.) (pending) and *K.Mizra, LLC v. Lexmark International, Inc.*, No. 1:21-cv-209299-JEM (S.D. Fla.) (dismissed). Pet. 99; Paper 4, 1.

C. Illustrative Claim

The '400 patent relates to devices for scanning or reading documents. Ex. 1001, codes (54), (57). The '400 patent states that a document to be scanned can be positioned between a document holder and a glass platen. Claim 1, reproduced below, is the only independent claim and is illustrative of the challenged claims.

1. A document reading device configured to read an image of an original document placed on a document platen, comprising:

a document tray for an original document to be stacked thereon;

an output tray for receiving the original document that is output after an image thereof is read;

a document transport path on which the original document is transported, the original transport path leading from the document tray through an image reading area to the output tray;

a movable member that serves as part of a bottom surface of the document reading device, the movable member being supported pivotably around a pivot axis that is perpendicular to a document transport direction on the document transport path, and the movable member having a free end and a pivotal end; and

a document holder that includes a flexible sheet, the document holder being positioned so as to extend over the whole length and breadth of the document platen,

wherein the movable member is pivotable from a position to cover a portion of the document transport path to a position to expose the portion toward the document platen, and

wherein the document holder is fixed at portions other than a portion that is positioned immediately below the pivot axis, to the bottom surface of the document reading device.

Ex. 1001, 8:4–31.

D. Alleged Grounds of Unpatentability

Petitioner asserts that claims 1–4 would have been unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–4	102(b) ¹	Kitaoka I ²
1–3	102(b)	Tsutsui ³
1–3	102(a)	Tobinaga ⁴
4	103(a)	Tsutsui, Kitaoka I
4	103(a)	Tobinaga, Kitaoka I
1–4	103(a)	Kitaoka II, ⁵ Kitaoka I

II. ANALYSIS

A. Level of Ordinary Skill in the Art

In determining the level of skill in the art, we consider the type of problems encountered in the art, the prior art solutions to those problems, the rapidity with which innovations are made, the sophistication of the technology, and the educational level of active workers in the field. *Custom*

¹ Based on the filing date of the applications to which the '400 patent claims priority, we apply the pre-AIA versions of §§ 102 and 103; however, our analysis would be the same under the current version of the statute.

² Japanese Unexamined Patent Application JP 2002-278174A, publ. Sept. 27, 2002. Ex. 1006 (certified translation).

³ Japanese Unexamined Patent Application JP 2003-261242A, publ. Sept. 16, 2003. Ex. 1010 (certified translation).

⁴ Japanese Unexamined Patent Application JP 2004-21007A, publ. Jan. 22, 2004. Ex. 1012 (certified translation).

⁵ Japanese Unexamined Patent Application JP 2004-254202A, Sept. 9, 2004. Ex. 1008 (certified translation).

Accessories, Inc. v. Jeffrey-Allan Indus., Inc., 807 F.2d 955, 962 (Fed. Cir. 1986); *Orthopedic Equip. Co. v. U.S.*, 702 F.2d 1005, 1011 (Fed. Cir. 1983).

Petitioner contends a person of ordinary skill in the art at the time of the invention would have been a person with a “[b]achelor’s degree in mechanical engineering or a related field and approximately two years of work experience in the printer or related industry” and that additional education could substitute for professional experience, while significant work experience could substitute for formal education. Pet. 10 (citing Ex. 1003 ¶¶ 51–54). Patent Owner states that it agrees with Petitioner’s proposed level of ordinary skill for the purposes of this proceeding. Prelim. Resp. 5.

We apply Petitioner’s level of ordinary skill for the purposes of this Decision.

B. “a document holder that includes a flexible sheet, the document holder being positioned so as to extend over the whole length and breadth of the document platen,”

Each challenged claim recites a document holder with the following additional language: “the document holder being positioned so as to extend over the whole length and breadth of the document platen” (the “disputed claim language”). As explained below, we determine this limitation is dispositive of each of Petitioner’s challenges.

1. Kitaoka I

Asserting that Kitaoka I anticipates claims 1–4, Petitioner contends “Kitaoka I discloses a document holder, referred to as ‘pressing plate white sheet 90,’ which is a flexible, elastic sheet ‘used for both pressing the document against the contact glass 21b and as a white reference.’” Pet. 29 (citing Ex. 1006 ¶¶ 8, 39, 40, 44; Ex. 1003 ¶¶ 103, 104). Further, Petitioner

contains the document holder is depicted in Figures 4 and 6 of Kitaoka I. Pet. 29–30.

Critically, though, Figures 4 and 6 of Kitaoka I do not depict the document platen, and Petitioner does not address how Kitaoka I satisfies the disputed claim language. To the contrary, Patent Owner argues, and we agree, that Figure 1 of Kitaoka I depicts the document platen extending beyond the document holder, as illustrated in Patent Owner’s annotated version of Figure 1 of Kitaoka I, reproduced below.

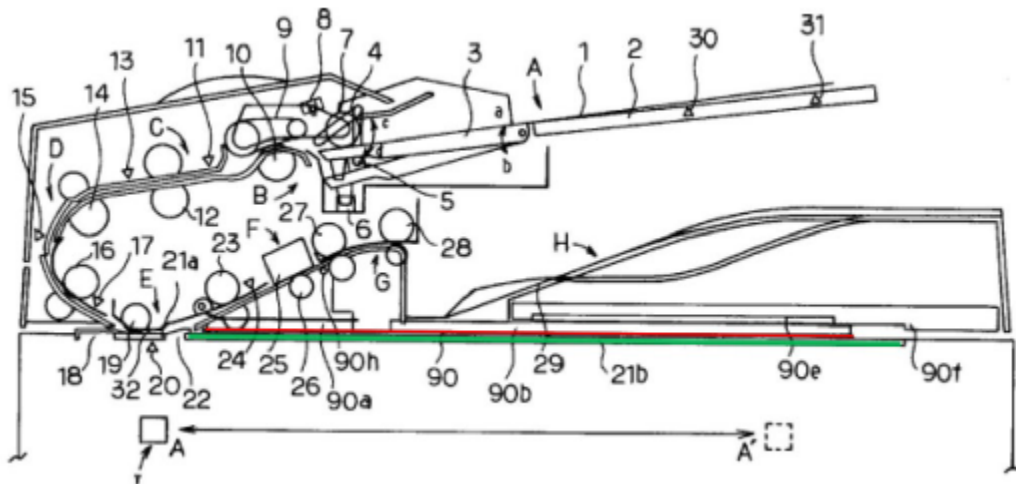


Figure 1 of Kitaoka I (annotated)

Patent Owner’s annotated version of Figure 1 of Kitaoka I depicts “pressing plate white sheet 90” (document holder) shaded in red and “contact glass 21b” (platen) in green. Prelim. Resp. 17. As evidenced by Figure 1 of Kitaoka I, the cited platen extends laterally beyond the cited document holder, such that Kitaoka I does not disclose “the document holder being positioned so as to extend over the whole length and breadth of the document platen,” as recited in claim 1.

Accordingly, Petitioner has not shown a reasonable likelihood that it would prevail in showing that any of claims 1–4 is anticipated by Kitaoka I.

2. *Tsutsui*

Asserting that Tsutsui anticipates claims 1–3, Petitioner contends “Tsutsui discloses a flexible document holder, referred to as ‘platen 58,’ which is made from a deformable resin material that has elasticity, and is provided across the contact surface of the platen glass 204 . . . and bottom inverting guide plate 41.” Pet. 48 (citing Ex. 1010 ¶¶ 21, 27, 33, Figs. 1, 4; Ex. 1003 ¶¶ 153–154). Petitioner also states that “[d]uring prosecution of the Japanese counterpart to the ’400 patent, the original assignee acknowledged that Tsutsui disclosed a flexible document holder that ‘faces the entire surface of the document platform’ or platen.” Pet. 49 (quoting Ex. 1014, 2, 3). Without addressing any alleged significance of that prosecution history or otherwise addressing the disputed claim language, Petitioner states “[a]ccordingly, a [person of ordinary skill in the art] would understand that Tsutsui discloses this claim limitation.” Pet. 50 (citing ¶¶ 153–158 (mirroring the Petition without further substantive explanation)).

Patent Owner argues, and we agree, that “platen 58” (cited by Petitioner as the document holder) in Tsutsui does not completely cover the cited platen (platen glass 204), as depicted in Patent Owner’s annotated version of Figure 1 of Tsutsui, reproduced below.

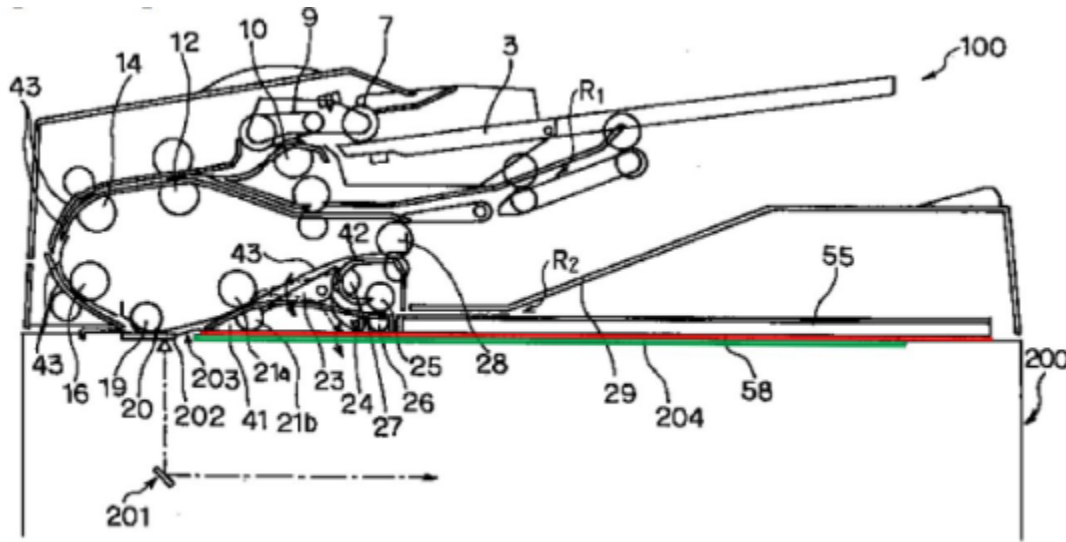


Figure 1 of Tsutsui (annotated)

Patent Owner’s annotated version of Figure 1 of Tsutsui depicts the alleged document holder (platen 58) shaded in red and the cited platen (platen glass 204) shaded in green. Prelim. Resp. 18. As shown in Figure 1, the cited platen (platen glass 204) extends laterally beyond the alleged document holder (platen 58), such that TsuT sui does not disclose “the document holder being positioned so as to extend over the whole length and breadth of the document platen,” as recited in claim 1.

Accordingly, Petitioner has not shown a reasonable likelihood that it would prevail in showing that any of claims 1–3 is anticipated by TsuT sui.

3. Tobinaga

Asserting that Tobinaga anticipates claims 1–3, Petitioner contends “Tobinaga discloses a document holder, referred to as a ‘pressing plate sheet 140,’” that includes a flexible “white sheet 144,” an elastic body sheet 143, and a flexible film sheet 142.” Pet. 63 (citing Ex. 1012 ¶¶ 9, 20–22, 29, 31–33, 45). Quoting Tobinaga, Petitioner further argues that “[t]he white sheet covers the entirety of the platen and is colored white ‘so that the peripheral

edges of the document will not be printed in black.” Pet. 63–64 (citing Ex. 1012 ¶¶ 9, 20–22, 29, 31–33, 45; Ex. 1003 ¶¶ 199–201).

Petitioner also cites Figures 1 and 2 of Tobinaga as depicting the alleged document holder. Pet. 64–65 (citing Ex. 1012, Figs. 1, 2; Ex. 1003 ¶¶ 199–202). Neither of Tobinaga’s Figures 1 or 2 depicts the alleged platen (contact glass), though.

Patent Owner argues that “[t]he white sheet need not cover the entirety of the platen to prevent the peripheral edges of the document from being printed in black; it need only extend beyond the edges of the document.” Prelim. Resp. 30. Further, Patent Owner contends that Figures 3 and 11 of Tobinaga show that the “white sheet 144” covers only a portion of the alleged platen (contact glass 200). Prelim. Resp. 31–32.

Reproduced below is Patent Owner's annotated version of Figure 11 of Tobinaga.

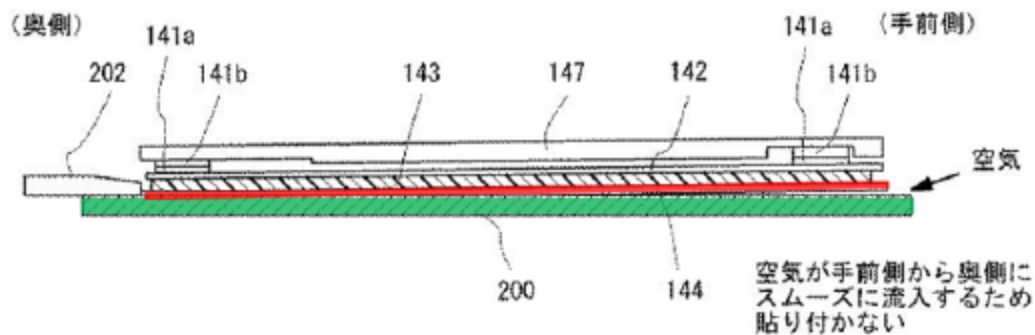


Figure 11 of Tobinaga (annotated)

Patent Owner's annotated version of Figure 11 of Tobinaga depicts the cited document holder (white sheet 144) shaded in red and the cited platen (contact glass 200) shaded in green. Prelim. Resp. 32. As shown in Figure 11, the contact glass 200 extends laterally beyond white sheet 144, such that Tobinaga's statement that the white sheet 144 prevents black edges around

the periphery of a scanned document does not establish that Tobinaga discloses the disputed claim language. To the contrary, the evidence of record supports Patent Owner's arguments that Tobinaga does not disclose "the document holder being positioned so as to extend over the whole length and breadth of the document platen," as recited in claim 1.

Accordingly, Petitioner has not shown a reasonable likelihood that it would prevail in showing that any of claims 1–3 is anticipated by Tobinaga.

4. Kitaoka II, Kitaoka I

Asserting that claims 1–4 are unpatentable in view of Kitaoka II and Kitaoka I, Petitioner contends "Kitaoka II discloses a document holder, referred to as 'pressing plate white sheet 90' or 'white sheet,'" that "contacts the document that is placed on' the document platen ('glass plate 21' or 'contact glass[]')." Pet. 82–83 (citing Ex. 1008 ¶¶ 11, 32, 33, 36; Ex. 247, 248). Further, Petitioner contends the document holder is depicted in Figure 5 and 6 of Kitaoka II. Pet. 83.

Critically, though, Figures 5 and 6 of Kitaoka II do not depict the document platen, and Petitioner does not address how Kitaoka II satisfies the disputed claim language. To the contrary, Patent Owner argues, and we agree, that Figure 1 of Kitaoka II depicts the document platen extending laterally beyond the document holder, as illustrated in Patent Owner's annotated version of Figure 1 of Kitaoka II, reproduced below.

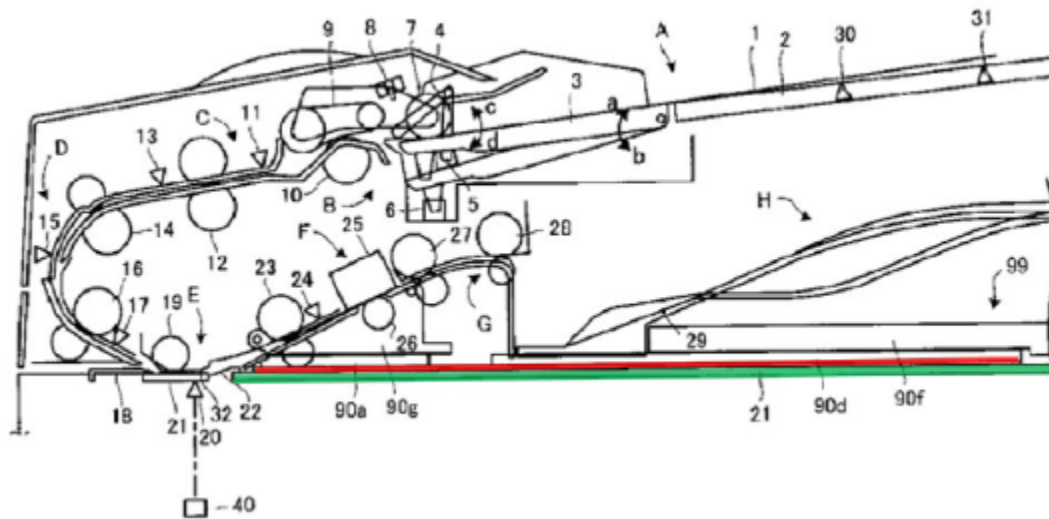


Figure 1 of Kitaoka II (annotated)

Patent Owner's annotated version of Figure 1 of Kitaoka II depicts "pressing plate white sheet 90" (document holder) shaded in red and "contact glass 21" (platen) in green. Prelim. Resp. 37. As evidenced by Figure 1 of Kitaoka II, the cited platen extends laterally beyond the cited document holder, such that Kitaoka II does not disclose "the document holder being positioned so as to extend over the whole length and breadth of the document platen," as recited in claim 1.

Petitioner does not specifically argue that the disputed limitation would have been an obvious modification of Kitaoka II and Kitaoka I. Accordingly, Petitioner has not shown a reasonable likelihood that it would prevail in showing that any of claims 1–4 are unpatentable in view of Kitaoka II and Kitaoka I.

5. *Remaining Grounds*

Petitioner additionally asserts that dependent claim 4 is unpatentable in view of Tsutsui and Kitaoka I or in view of Tobinaga and Kitaoka I. Pet. 72–73. None of Petitioner's arguments regarding these combinations

addresses the deficiencies noted above regarding base claim 1. Accordingly, Petitioner has not shown a reasonable likelihood that it would prevail with respect to Petitioner's challenge to claim 4 as unpatentable in view of Tsutsui and Kitaoka I or in view of Tobinaga and Kitaoka I.

III. CONCLUSION

For the reasons set forth above, we determine that Petitioner has not demonstrated a reasonable likelihood that it will prevail with respect to at least one claim of the '400 patent. Accordingly, we do not institute an *inter partes* review.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition in IPR2022-01426 is denied and no *inter partes* review is instituted.

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FOR PETITIONER:

Douglas Stewart
Jared Schuettenhelm
Patrick Connolly
BRACEWELL LLP
doug.stewart@bracewell.com
jared.schuettenhelm@bracewell.com
patrick.connolly@bracewell.com

FOR PATENT OWNER:

Matthew C. Holohan
Robert R. Brunelli
SHERIDAN ROSS P.C.
mholohan@sheridanross.com
rbrunelli@sheridanross.com