

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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KATUN CORPORATION,  
Petitioner,

v.

TOSHIBA TEC CORPORATION and  
TOSHIBA AMERICA BUSINESS SOLUTIONS, INC.,  
Patent Owner.

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Case IPR2016-01010  
Patent 9,098,015 B2

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Before STACEY G. WHITE, JENNIFER MEYER CHAGNON, and  
MICHELLE N. WORMMEESTER, *Administrative Patent Judges*.

WORMMEESTER, *Administrative Patent Judge*.

DECISION  
Institution of *Inter Partes* Review  
37 C.F.R. § 42.108

Katun Corporation (“Petitioner”) filed a Corrected Petition (Paper 4, “Pet.”) requesting *inter partes* review of claims 1–8 of U.S. Patent No. 9,098,015 B2 (Ex. 1001, “the ’015 patent”). Toshiba Tec Corporation and Toshiba America Business Solutions, Inc. (collectively, “Patent Owner”) filed a Preliminary Response (Paper 8, “Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For the reasons that follow, we institute an *inter partes* review as to claims 1–8 of the ’015 patent.

## I. BACKGROUND

### A. *Related Proceedings*

The parties identify the following related case: *Toshiba Tec Corp. v. Katun Corp.*, Civ. No. 8:15-cv-01979 (C.D. Cal. Nov. 25, 2015). Pet. 4; Paper 6, 2.

### B. *The ’015 Patent*

The ’015 patent is titled “Toner Cartridge.” Ex. 1001, at [54]. According to the ’015 patent, a copier may malfunction if the toner cartridge used is not genuine (i.e., recommended by the manufacturer). *See id.* at 1:36–40. To address this problem, the ’015 patent provides a way to detect whether a toner cartridge is genuine once it is mounted into the copier. *Id.* at 2:11–13.

The toner cartridge of the '015 patent is shown in Figure 6 of the patent, which is reproduced below.

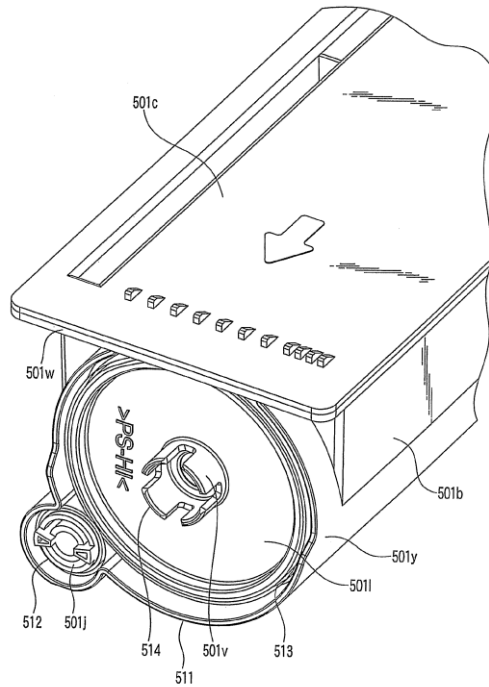


FIG. 6

Figure 6 shows the toner cartridge as viewed from its rear upper side.

Ex. 1001, 3:1–3. The cartridge includes at one end coupling member 501j, mixing gear 501l, and rotational body 501v. *Id.* at 6:1–7. Rotational body 501v has four slits spaced equally apart. *Id.* at 8:34–37.

The copier of the '015 patent includes an optical detector. *Id.* at 7:15–16, Fig. 7. The optical detector has a light emitting element and a light receiving element that face each other. *Id.* at 8:16–21. The light receiving element receives light from the light emitting element. *Id.* at 8:33–35.

When the toner cartridge is mounted into the copier, rotational body 501v is sandwiched between the light emitting and light receiving elements. *Id.* at 7:29–31, 8:59–61. Once the cartridge is mounted, rotational body 501v begins to rotate. *Id.* at 8:42–56. As rotational body 501v rotates, the light

receiving element receives light that passes through the slits, but not light that is blocked by portions of the rotational body between the slits. *Id.* at 8:63–9:2, Fig. 6. When the light receiving element receives light, it outputs a signal L in L time to a controlling unit; and when the light receiving element does not receive light, it outputs a signal H in H time to the controlling unit. *Id.* at 9:8–12, 9:20–22, Fig. 10. If the value of L time/H time falls between 0.2 and 0.8, then the controlling unit determines that the toner cartridge is a genuine product. *Id.* at 9:29–32. If the value of L time/H time falls outside that range, however, the controlling unit determines that the toner cartridge is not a genuine product. *Id.* at 9:32–35.

The '015 patent also provides a gear cover 501y for preventing rotational body 501v and gears 501j, 501l from entangling lead wires used for detection. *Id.* at 10:35–39, Figs. 6, 9.

### *C. Illustrative Claim*

Petitioner challenges claims 1–8 of the '015 patent. Claims 1 and 7 are independent. Claim 1 is illustrative of the claims under challenge:

1. A toner cartridge comprising:
  - a toner container which contains toner;
  - a toner supplying opening which supplies the toner contained in the toner container to an image forming apparatus;
  - an agitating member which agitates the toner contained in the toner container;
  - a conveying member which conveys the toner contained in the toner container toward the toner supplying opening;
  - a plurality of gears which are provided on an exterior portion of the toner container and rotate the conveying member and the agitating member, the plurality of gears including two gears which have different diameters;

- an optical penetration member which has a plurality of optical penetration parts and is coaxially provided on a large gear of the two gears; and
- a gear cover which covers a part of the plurality of the gears, the gear cover being extended in the same direction as an extending direction of the optical penetration member.

#### *D. Asserted Grounds of Unpatentability*

Petitioner challenges claims 1–8 of the '015 patent on the following grounds. Pet. 4, 30–88.

Reference(s)	Basis	Claims Challenged
Sugita <sup>1</sup>	§ 102	1, 7, and 8
Sugita	§ 103	1–8
Sugita and Nishimura <sup>2</sup>	§ 103	1–8
Matsuda <sup>3</sup> and Yokoi <sup>4</sup>	§ 103	1–8

As additional support, Petitioner proffers the Declaration of Dr. Larry A. Stauffer, Ph.D. (Ex. 1003). *See id.*

#### *E. Claim Interpretation*

We construe claims in an unexpired patent by applying the broadest reasonable interpretation in light of the specification of the patent in which they appear. *See* 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs. LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable interpretation standard). Under this standard, claim terms generally are given their ordinary and customary meaning, as would be

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<sup>1</sup> Sugita, U.S. Patent No. 6,687,478 B2, issued Feb. 3, 2004 (Ex. 1010).

<sup>2</sup> Nishimura, U.S. Design Patent No. D447,168 S, issued Aug. 28, 2001 (Ex. 1011).

<sup>3</sup> Matsuda, U.S. Patent No. 7,003,233 B2, issued Feb. 21, 2006 (Ex. 1012).

<sup>4</sup> Yokoi, U.S. Patent No. 5,940,658, issued Aug. 17, 1999 (Ex. 1013).

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