

For Immediate Release

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Contact: Jason Milch
312.846.9647
milchj@jaffeassociates.com

Xerox Emerges Victorious in Nine-Year Patent Dispute Over Fax Machine Technology

Katten successfully defends Xerox in matter

CHICAGO – A federal judge has granted summary judgment to Xerox Corporation in a nine-year patent dispute over fax machine technology. The case, argued in U.S. District Court for the Eastern District of Michigan, is *Jerry Kirsch, the Jerry Kirsch Living Trust, et al. v. Xerox Corporation and Samsung Electronics Co., Ltd* (Case No. 00-72778).

In November 2000, Jerry Kirsch and the Jerry Kirsch Living Trust brought suit against Xerox and other companies, claiming that they infringed on Kirsch's U.S. Patent No. 4, 816, 911 (the '911 patent). Mr. Kirsch's amended complaint asserted that Xerox offered for sale and sold multi-function fax machines that infringed the '911 patent. Mr. Kirsch had previously sued Brother Manufacturing and at the time he brought suit against Xerox, he also sued AOE Ricoh, Toshiba and Canon. By the time the Court ruled in favor of Xerox's motion for summary judgment on March 27, 2009, only Xerox and Canon remained in the case.

In ruling in Xerox's favor, the Court found that the '911 patent that had been asserted against Xerox was invalid. Judge Denise Page Hood noted that Xerox had proved by clear and convincing evidence that the Xerox 295, a machine with an RS232C option that utilized a technology covered by Mr. Kirsch's patent, had been available for more than a year before the filing date of the '911 patent and met all of the asserted claims of the '911 patent. This meant that the Xerox 295 acted as an "on-sale bar" to the '911 patent, making it invalid under 35 U.S.C. §102.

[Robert B. Breisblatt](#), a Chicago-based partner in the firm's [Patent Litigation Practice](#), represented Xerox in the case.

"We are pleased to have assisted Xerox in bringing this long-running matter to a successful and just conclusion," Mr. Breisblatt said. "The Court rightly found that if the plaintiffs were going to interpret the claims of their patent to cover the fax machines they accused of infringing the '911 patent, then that patent was invalid because Xerox's prior 295 machine would have met the same terms."

Katten's Patent Litigation Practice has represented small, mid-sized and large domestic corporations, multinational corporations and several universities in litigation involving patents related to biotechnology and life sciences, electrical and electronic systems, computer hardware

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and software, e-commerce and business methods, telecommunications, product design and mechanical systems. The experience and courtroom skills of Katten's patent attorneys in cases involving a broad range of designs, systems and applications have led to a proven track record in federal courts throughout the United States, and in patent and trademark offices worldwide.

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