

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EASTMAN KODAK CO., AGFA CORP., ESKO SOFTWARE BVBA, and
HEIDELBERG, USA,
Petitioner,

v.

CTP INNOVATIONS, LLC,
Patent Owner.

Case IPR2014-00790
Patent 6,611,349 B1

Before HOWARD B. BLANKENSHIP, BENJAMIN D. M. WOOD, and
BRIAN J. MCNAMARA, *Administrative Patent Judges*.

WOOD, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Eastman Kodak Co., Agfa Corp., Esko Software BVBA, and Heidelberg, USA (collectively, “Petitioner”) filed a request for rehearing (Paper 41, “Reh’g Req.”) of our Final Written Decision (Paper 40, “Final Dec.”). We requested (Paper 42) a response from CTP Innovations, LLC (“Patent Owner”), which was subsequently submitted (Paper 43, “Reh’g Req. Resp.”).

Petitioner requests that we reconsider our decision that Petitioner has not demonstrated that claims 1–3 of U.S. Patent No. 6,611,349 (the ’349 patent) are unpatentable. Patent Owner opposes. For the reasons set forth below, the request is denied.

II. STANDARD OF REVIEW

The burdens and requirements of a request for rehearing are stated in 37 C.F.R. § 42.71(d):

(d) Rehearing. . . . The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

III. ANALYSIS

A. *The ’349 Patent*

The ’349 patent describes a publishing and printing system that is distributed among three “facilities”: An *end user facility*, where content is created; a *central service facility*, where files are stored; and a *printing company facility* (or printer), where documents are printed. Independent

claims 1–3 are at issue in this case. Claim 1 is representative and is reproduced below:

1. A printing and publishing system which generates a printing plate-ready file from data provided remotely in real time using a communication network, the printing and publishing system comprising:

an end user facility coupled to a communication network, the end user facility providing page building operations, the page building operations including the design and construction of pages from images, text, and data available via said communication network;

a central service facility coupled to said communication network, the central service facility providing storage, file processing, remote access, and content management operations; the file processing operations including generating a plate-ready file from pages designed at said end user facility, said plate-ready file having a file format capable of high resolution and ready for creation of a printing plate;

a printing company facility coupled to said communication network, the printing company facility providing printing operations, the printing operations including producing a printing plate from said plate-ready file; and

wherein the end user facility further comprises a communication routing device coupling the end user facility to the communication network, a computer which performs page building operations, and a proofer which provides printed samples of pages.

We instituted an *inter partes* review of claims 1–3 based on the following grounds of unpatentability:

Reference[s]	Basis	Claims Challenged
Jebens, ¹ Apogee, ² and OPI White Paper ³	§ 103(a)	1–3
Dorfman, ⁴ Apogee, and Andersson ⁵	§ 103(a)	1 and 2
Dorfman, Apogee, Andersson, and OPI White Paper	§ 103(a)	3

Decision on Institution 25.

In our Final Decision, we construed “plate-ready file” to mean “a file that represents a page layout that has gone through prepress processing, including RIPing, and is ready to image to a plate using either a platesetter or imagesetter.” Final Dec. 12. We construed “end user facility,” “printing company facility,” and “central service facility,” to be “distinct components of the claimed printing and publishing system,” i.e., “separate entities, each connected to the same communication network to facilitate the transfer of data between each other.” *Id.* at 10–11.

B. Petitioner’s Rehearing Request Relies on a New Argument

For the Jebens/Apogee ground, the Petition relied on Jebens to teach the separate end user facility, central service facility, and printing company facility. Pet. 30–35. Likewise, for the Dorfman/Apogee grounds, Petitioner

¹ Jebens, US 6,321,231 (iss. Nov. 20, 2001) (Ex. 1006).

² Agfa Apogee, The PDF-based Production System (Ex. 1008).

³ Apple OPI White Paper (Ex. 1009).

⁴ Dorfman, WO 98/08176 (iss. Feb. 26, 1998) (Ex. 1007).

⁵ MATTIAS ANDERSSON ET AL., PDF PRINTING AND PUBLISHING, THE NEXT REVOLUTION AFTER GUTENBERG (Micro Publishing Press 1997) (“Andersson”) (Ex. 1010).

relied on Dorfman to teach separate end user, central service, and printing company facilities. *Id.* at 47–53. For all three grounds, Petitioner relied on Apogee to teach the generation of a plate-ready file from a digital file (specifically, a PDF file) by subjecting it to prepress operations and then RIPing. *Id.* at 26–27, 44–45. In doing so, Petitioner relied on a specific excerpt from Apogee, as follows:

Apogee Pilot normalizes the incoming files into PDF, collects the pages, imposes, does OPI image exchange and sends this imposed ‘digital flat’ to an Apogee PDF RIP. In the context of Apogee, the PDF RIP takes the device and format independent PDF digital master, and renders (rasterizes) it exactly for the selected output device. The result is a ‘Print Image File’ (PIF) that contains all the dots that will appear on the film or plate. . . . Apogee PrintDrive manages the Print Image Files (PIF) output by one or more RIPs, and controls output flow to a variety of output devices including Agfa imagesetters, proofers, and platesetters.

Id. at 26–27 (quoting Ex. 1008, 6–7).⁶ We refer to this quoted portion of Apogee as “Apogee Excerpt 1.”

Petitioner’s claim charts also relied on Apogee to teach the generation of a plate-ready file. *See id.* at 33–34, 51–52. In doing so, however, Petitioner included, after Apogee Excerpt 1, an additional excerpt from Apogee. That excerpt is as follows:

For volume applications, [Apogee PrintDrive] can be fed by multiple PDF RIPs over a TCP/IP network. This unique feature allows you to physically separate the rendering from the actual plate production, so your PDF RIP can be in the desktop

⁶ *See also id.* at 33 (“Apogee discloses the generation of a plate-ready file (“PIF,” below) that is ready for the creation of a printing plate” (citing Ex. 1008, 6-7)).

department and the PrintDrive can sit next to the output device, even in another town.

Id. at 33–34 (citing Ex. 1008, 6–7); *see also id.* at 51–52 (same). We refer to this portion of Apogee as “Apogee Excerpt 2.”

In its Response, Patent Owner argued, among other things, that the proposed combination does not teach a central service facility providing file processing services that include generating a plate-ready file. PO Resp. 26. Specifically, Patent Owner asserted that “[t]o the extent that Apogee discloses PDF RIP process [generating a plate-ready file], a POSITA would consider this process to be taking place at the jobber or supplier, i.e., at a printing company facility.” *Id.* at 32 (citing Ex. 2014 ¶ 24; Ex. 2017, 31:12–32:4).

In its Reply, Petitioner argued that “[n]othing in Apogee limits the implementation of the processes described therein to occur at a printing company facility, and one of ordinary skill could predictably implement Apogee at a central service facility.” Reply 5–6. In support of this assertion, Petitioner relied on the testimony of its Declarant, Professor Lawler, who in turn relied on Apogee Excerpt 1. *Id.* at 6 (citing Ex. 1022 ¶ 93 (citing Ex. 1008, 7)).

In the Final Decision, we reiterated that “[a]ll three claims recite a ‘central service facility’ that provides ‘file processing’ operations, which include ‘generating a plate-ready file.’” Final Dec. 27. We found, however, that Petitioner has not alleged that Jebens teaches generating a ‘plate-ready file’ as we have construed the term above, i.e., a file that ‘has gone through prepress processing, including RIPing.’” *Id.* We stated further that “[a]lthough Petitioner alleges that Jebens ‘clearly teaches the incorporation

of OPI into a pre-press workflow,’ Pet. Reply 8, Petitioner does not allege that the resulting file is a ‘plate-ready file,’ because it has not been RIPPed.” *Id.* We observed that “Apogee does teach generating a plate-ready file from a PDF, but does not teach or suggest that it be generated at any particular facility.” *Id.* We concluded that “Petitioner does not assert, much less point us to any evidence, that a person of ordinary skill in the art would have been motivated to combine Jebens and Apogee in such a way that a plate-ready file would have been produced at Jebens’ host facility (which is alleged to correspond to the claimed central service facility) rather than at its printing facility.” *Id.* at 27–28. We reached a similar conclusion with respect to the Dorfman/Apogee grounds. *Id.* at 32–33.

In its Request for Rehearing, Petitioner’s primary argument is that the Board “overlooked directly contradictory evidence in the trial record.” Reh’g Req. 1. The evidence to which Petitioner refers is Apogee Excerpt 2. *Id.* at 7. Petitioner argues that “contrary to the Board’s sole rationale for not finding claims 10–20 unpatentable, there is significant, documentary evidence of record, unrebutted, and relied on by Petitioners—that one of ordinary skill was well aware of generating plate-ready files at locations remote from the printing company facility (*i.e.*, in another town).” *Id.* at 8. In response to this argument, Patent Owner contends that “Apogee’s alleged disclosure of the provision of a plate-ready file to a remote printer does not change the Board’s conclusion,” because “it would not be obvious to a person of ordinary skill in the art to replace or modify the job order developer and conduit function of the central facility of Jebens with the Apogee PDF RIP process.” Reh’g Req. Resp. 4.

A request for rehearing is not an opportunity to present new arguments or evidence that could have been presented in the petition. 37 C.F.R. § 42.71(d). Here, Petitioner’s Rehearing Request relies on an argument—that Apogee teaches generating a plate-ready file “remote[ly] from the printing company facility”—that was not presented in the Petition. In the Petition, Petitioner consistently relied on Apogee to teach generation of a plate-ready file, including “raster[izing] the output of the prepress process.” Pet. 26, 33, 45, 51. Petitioner did not, however, in either its Petition or Reply, argue that Apogee teaches generating a plate-ready file at any particular location. Petitioner failed to do so even after Patent Owner expressly raised this issue in its Response, where it asserted that a person of ordinary skill in the art would have read Apogee to teach generating a plate-ready file “at a printing company facility.” PO Resp. 32. Petitioner only replied that “[n]othing in Apogee limits the implementation of the processes described therein to occur at a printing company facility, and one of ordinary skill could predictably implement Apogee at a central service facility.” Reply 5–6. Neither Petitioner nor its declarant cited Apogee Excerpt 2 to support this contention. If Petitioner believed that Apogee Excerpt 2 supports the assertion that “one of ordinary skill in the art was well aware of generating plate-ready files at locations remote from printing company facilities,” as it now asserts (Reh’g Req. 9–10), then it should have, at a minimum, stated so in its Reply. Merely including Apogee Excerpt 2 in its claim charts to support a different proposition is insufficient to change the fact that Petitioner’s Rehearing Request relies on a new reading of Apogee.

C. Petitioner Has Not Shown that We Misapprehended its Obviousness Grounds

Petitioner next argues that the Board misapprehended Petitioner's obviousness grounds. Reh'g Req. 11–14. Petitioner asserts that the grounds are based on Jebens and Dorfman as the primary references, and relied on their “specific system architecture.” *Id.* at 11. According to Petitioner, our decision “mistakenly looks to the secondary reference (Apogee) for architectural features relied upon in the primary references Jebens and Dorfman, and then suggests that Apogee would have to be modified to transmit a plate-ready file to a remote printer.” *Id.* at 13.

We disagree that we misapprehended Petitioner's grounds. On the contrary, we understood that Petitioner relied on Jebens and Dorfman to teach the separate end user, central service, and printing company facilities. Final Dec. 23–24, 31. We noted, however, that neither Jebens nor Dorfman teaches generating a plate-ready file as we construed the term above, i.e., a file that has gone through prepress processing and that has been RIPed. *Id.* at 26, 32. We further noted that although Apogee teaches generating a plate-ready file from a PDF file, “Petitioner does not assert, much less point us to any evidence, that a person of ordinary skill in the art would have been motivated to combine Jebens and Apogee in such a way that a plate-ready file would have been produced at Jebens' host facility . . . rather than at its printing facility.” *Id.* at 27–28; *see also id.* at 32. Recognizing that neither Jebens nor Dorfman discloses teaches generating a plate-ready file, we understand Petitioner's argument to be that, to meet the claim language, Petitioner only needed to show that its proposed combinations teach generating at a central service facility files *of any type*. This is incorrect. It

is not sufficient that the proposed combination generates any file, e.g., a PDF file that has not been RIPPed, at a central service facility. RIPPing is the final, and necessary, step in creating a plate-ready file. Thus, Petitioner needed to establish that the file alleged to be the plate-ready file generated at a central service facility had been RIPPed at the central service facility.

Petitioner relied on Apogee to teach RIPPing a file to create a plate-ready file, not to teach that RIPPing occurred someplace other than at the printer. That is why we determined that Petitioner's showing was insufficient. Accordingly, we are not persuaded that we misapprehended Petitioner's obviousness grounds.

IV. CONCLUSION

For the foregoing reasons, Petitioner's Request for Rehearing is denied.

V. ORDER

For the reasons given, Petitioner's Request for Rehearing is *denied*.

IPR2014-00790
Patent 6,611,349 B1

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