

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMMAND WEB OFFSET COMPANY, INC., WORZALLA
PUBLISHING COMPANY, SANDY ALEXANDER, INC.,
PUBLICATION PRINTERS CORP., SPECIALTY PROMOTIONS, INC.,
and TREND OFFSET PRINTING SERVICES INC.,
Petitioners,

v.

CTP INNOVATIONS, LLC,
Patent Owner.

Case IPR2016-00008
Patent 6,611,349 B1

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

McNAMARA, *Administrative Patent Judge*.

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

BACKGROUND

Command Web Offset Company, Inc., Worzalla Publishing Company, Sandy Alexander, Inc., Publication Printers Corp., Specialty Promotions, Inc., d/b/a Specialty Print Communications, and Trend Offset Printing Services Inc. (collectively, “Petitioner”) filed a petition, Paper 1 (“Pet.”), to institute an *inter partes* review of claims 4–9 (the “challenged claims”) of U.S. Patent No. 6,611,349 B1 (“the ’349 patent”). 35 U.S.C. § 311. CTP Innovations, LLC (“Patent Owner”) timely filed a Preliminary Response, Paper 12 (“Prelim. Resp.”), contending that the petition should be denied as to all challenged claims. We have jurisdiction under 37 C.F.R. § 42.4(a) and 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted unless the information presented in the Petition “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Having considered the arguments and the associated evidence presented in the Petition and the Preliminary Response, for the reasons described below, we decline to institute *inter partes* review.

REAL PARTIES IN INTEREST

Petitioner identifies the individual petitioner entities as the only real parties-in-interest. Pet. 1.

PENDING LITIGATION

The Petition states that “the ’349 patent is asserted in dozens of litigations, which have been identified in Ex. 1002” and that these lawsuits are pending as part of a multi-district litigation in the United States District Court for the District of Maryland. *Id.* at 1–2.

The '349 patent was also the subject of the following proceedings before the Patent Trial and Appeal Board:

Printing Industries of America v. CTP Innovations, LLC, (“PIA”)¹;
Eastman Kodak Co., Agfa Corp., Esko Software BVBA, and Heidelberg, USA v. CTP Innovations, LLC (“Kodak I”)²; and
Eastman Kodak Co., Agfa Corp., Esko Software BVBA, and Heidelberg, USA v. CTP Innovations, LLC (“Kodak II”)³.

THE '349 PATENT (EXHIBIT 1001)

The '349 patent relates to “a system and method of providing publishing and printing services via a communication network.” Ex. 1001, 1:9–10. According to the '349 patent, “[k]ey steps for producing printed materials using a plate process include (1) preparing copy elements for reproduction (the “design” stage), (2) prepress production, (3) platemaking, (4) printing, and (5) binding, finishing and distribution.” *Id.* at 1:12–15. In the first step, an end user – e.g., a publisher, direct marketer, advertising agency, or corporate communication department – uses a desktop publishing program such as “QuarkXpress” to design “pages” from image and data files. *Id.* at 1:16–25. In the prepress production stage, the user-created

¹ See, *Printing Industries of America v. CTP Innovations, LLC*, Case IPR2013-00474, slip op. (PTAB Dec. 31, 2013) (denying institution of *inter partes* review of claim 1–14). Ex. 1004.

² See, *Eastman Kodak Co., Agfa Corp., Esko Software BVBA, and Heidelberg, USA v. CTP Innovations, LLC*, Case IPR2014-00791, slip op. (PTAB Nov. 28, 2014)(instituting of *inter partes* review of claims 10–14). Ex. 1005.

³ See, *Eastman Kodak Co., Agfa Corp., Esko Software BVBA, and Heidelberg, USA v. CTP Innovations, LLC*, Case IPR2014-00790 (Kodak II)³, slip op. (PTAB Nov. 28, 2014)(instituting *inter partes* review of claims 1–3). Ex. 1006.

pages (also called “copy”) are “transformed into a medium that is reproducible for printing.” *Id.* at 1:26–28. This transformation typically involves typesetting, image capture and color correction, file conversion, “RIPing, proofing, imposition, filmsetting, and platesetting.” *Id.* at 1:29–32.

“RIPing” is based on the acronym “RIP,” which stands for raster images processor. *Id.* at 7:57–59. A RIP is a hardware or software component that “rasterizes” an image file – i.e., converts it to a “bitmap” or raster image. *Id.* “RIPing” is, therefore, synonymous with rasterizing. A bitmap “is a digitized collection of binary pixel information that gives an output device, such [as a printer, proofer or platesetter,] the ability to image [the file] to paper, film or plate.” *Id.* at 7:59–62. “Proofing” involves creating a sample of the finished product that is sent to the end user for approval. *Id.* at 1:32–35. “Imposition” involves arranging multiple pages into a single flat that can be used to create a printing plate. Ex. 1001, 1:38–40. According to the ’349 patent, imposition “is particularly important in the creation of booklets or catalogs, where pages are positioned using register marks to assist in the stripping, collating, and folding of the printed product.” *Id.* at 1:41–44. A printer makes a plate based on the imposed flat and uses the plate on a printing press to reproduce the product; the product is bound, finished and distributed to create the product in its final form. *Id.* at 1:45–51.

The ’349 patent describes and claims a publishing and printing system in which “[s]ystem components are installed at an end user facility, a printing company facility, and a central service facility,” each connected to the others via a communication network. *Id.* at 2:31–36, 51–56. Figure 1, reproduced below, depicts an embodiment of the claimed invention:

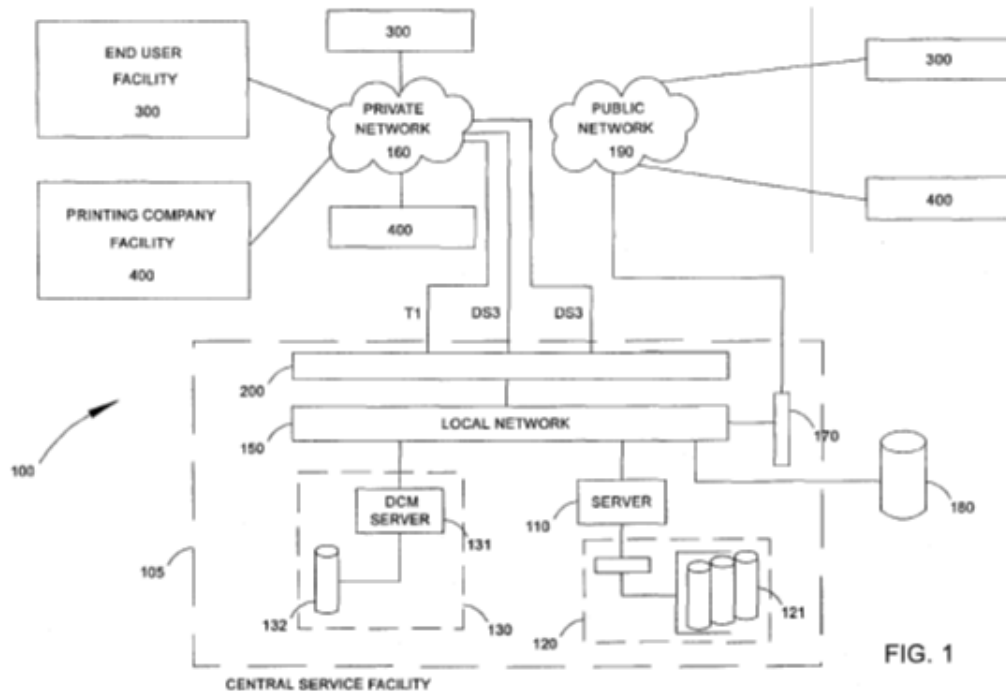


Figure 1 depicts end user facility 300, printing company facility 400, and central service facility 105 connected together via either private network 160 or public network 190. Ex. 1001, Fig. 1. In this embodiment, end user facility 300 comprises a router, desktop computer for page-building operations, a color proofer, and black and white printer for high-resolution proofing. *Id.* at 7:38–40, Figs. 1, 2, 5. Printing company facility 400 comprises a router, a hub, a server, a laser printer, a color plotter, and a platesetter, and performs production management, digital plate-making, desktop imposition, and press services. *Id.* at 8:31–33, 9:38–43, Figs. 1, 4, 5. Central service facility 105 comprises a server, “hierarchical storage management” (HSM) system 120, “digital content management” system

130, and local area network (LAN) 150. *Id.* at 5:40–50. An end user can store files in HSM system 120 to reduce storage needs at the end user facility. *Id.* at 7:19–23, 38–40.

ILLUSTRATIVE CLAIM

Claim 4 is illustrative of the challenged claims:

4. A method of generating a plate-ready file configured for the creation of a printing plate, said plate-ready file being associated with page layouts and being provided in real time from a remote location using a communication network, the method comprising:

remotely providing access to imaging files for searching and retrieving images used in the design of a page layout by a remote user,

establishing links to said imaging files, thereby creating a thin Postscript file from the page layout designed by the remote user;

parsing said thin Postscript file to extract data associated with low resolution images and replace with high resolution data, thereby forming a fat Postscript file,

creating a portable document format (PDF) file from said fat Postscript file, and

converting said PDF file to a file in plate-ready format.

ART CITED IN PETITIONER’S CHALLENGES

Petitioner cites the following references in its challenges to patentability:

Reference	Designation	Exhibit No.
Mattias Andersson, et al., PDF Printing and Publishing, The Next Revolution Press After Gutenberg, Micro Publishing (1997)	Andersson	Ex. 1008

The Seybold Report on Publishing Systems, Vol. 26, No. 11 (Seybold Publications, Feb. 24, 1997)	Seybold	Ex. 1018
Jorg Zeidler, Marwan Ramadan <i>I-Media: An Integrated Media Server and Media Database As a Basic Component of a Cross Media Publishing System</i> , Computers and Graphics, An International Journal Of Systems & Applications In Computer Science, Vol. 21, no. 6, pp. 693–702 (1997), Graphics in Electronics Printing and Publishing	I-Media	Ex. 1019
Xinet Full Press Brochure	FullPress	Ex. 1020
XiNet WebNative Brochure	WebNative	Ex. 1021

CHALLENGES ASSERTED IN PETITION

Claims	Statutory Basis	Challenge
4–5 and 7–9	35 U.S.C. § 103(a)	Obvious over FullPress in view of WebNative
6	35 U.S.C. § 103(a)	Obvious over FullPress in view of WebNative and Andersson
4–7	35 U.S.C. § 103(a)	Obvious Over I-Media in view of Andersson
8 and 9	35 U.S.C. § 103(a)	Obvious Over I-Media in view of Anderson and Seybold

CLAIM CONSTRUCTION

We interpret claims of an unexpired patent using the broadest reasonable construction in light of the specification of the patent in which they appear. *See* 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1278 (Fed. Cir. 2015) *cert. granted sub nom. Cuozzo Speed Techs. LLC v. Lee*, 84 USLW 3218 (U.S. Jan. 15, 2016) (No. 15-446). In applying a broadest reasonable construction, claim terms generally are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Any special definition for a claim term must be set forth in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

Plate-ready file . . . being provided in real time

Petitioner proposes that this term be construed to mean “encompassing, *inter alia*, the electronic transmission of data, images, and files over a communication network.” Pet. 24. Patent Owner argues that Petitioner’s construction ignores the term “real-time” or equates it to mean any electronic transmission over a communication network. Prelim. Resp. 4. Patent Owner contends that Petitioner’s definition is wrong because merely transmitting electronic data over communication network is not doing so in “real-time.” *Id.* at 4–5. Patent Owner acknowledges that in *Kodak I* we determined that the term “real-time,” which appears in the preamble of methods claims 4–14, does not limit the scope of the claims. *Id.* at 5; Ex. 1005, 13. We reached a similar conclusion in *Kodak II* concerning apparatus claims 1–3. Ex. 1006, 12–14. Although Patent Owner cites

passages from the specification of the '349 patent concerning a preferable implementation in a real-time manner, on this record we are not persuaded that the term “real-time” recites essential structure or steps so as to give life, meaning and vitality to the claim. Thus, we are not persuaded that the term “real time” limits the scope of the claims.

Plate-ready file

Petitioner proposes that the term “plate-ready file” be construed to mean “a digital file that is ready to output to a device for producing a printing plate.” Pet. 25. Patent Owner argues that Petitioner’s construction includes unnecessary elements and proposes that the term be construed to mean “a file that is ready to be made into a printing plate.” Prelim. Resp. 6. Neither party proposed a construction of plate ready file in PIA. In our Final Written Decision in Kodak I, 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. Kodak I, Paper 47, 8–9.

Patent Owner’s proposed construction is imprecise because, although a file may be used to create a plate, the file is not made into a plate, and therefore cannot be ready to be made into a printing plate. The specification states “The plate-ready file has a file format capable of high resolution and is ready for creation of a printing plate.” Ex. 1001, Abstract. We require no further construction of “plate-ready file” than that provided in the Abstract of the '349 patent and applied in Kodak I.

Thin PostScript file

Consistent with the construction we applied in Kodak II, the parties agree that the term “thin PostScript file” should be construed to mean “a PostScript file containing low resolution images.” Pet. 26; Prelim. Resp. 9.

Fat PostScript file

Consistent with the construction we applied in Kodak II, the parties agree that the term “fat PostScript file” should be construed to mean “a PostScript file containing high resolution images.” Pet. 26; Prelim. Resp. 9.

ANALYSIS OF PETITIONER’S PRIOR ART CHALLENGES

Introduction

All of Petitioner’s challenges assert obviousness under 35 U.S.C. § 103(a). A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). The level of ordinary skill in the art is reflected by the prior art of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001);

In re GPAC Inc., 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978).

Claims 4–5 and 7–9 As Obvious Over FullPress and WebNative

Petitioner cites FullPress for disclosing an Open Press Interface (OPI) server integrated with network applications providing a system workflow that automatically produces low resolution views for most document set up activities with original high resolution images being substituted when the final output is desired. Pet. 30 (citing Ex. 1020, 11). Petitioner notes the references in the '349 patent to an exemplary embodiment preferably using FullPress software or any OPI software. *Id.* at 29 (citing Ex. 1001, col. 5, ll. 62–64, col. 6, ll. 38–40). Petitioner cites FullPress as allowing printing and prepress specialists to share their files over a network. *Id.* at 34–35 (citing Ex. 1020, 3–4).

Petitioner further notes that Xinet combined FullPress and WebNative, which Xinet developed as a companion plug-in to FullPress. *Id.* at 31, 36. Petitioner cites WebNative as disclosing a system in which commercial printers and prepress shops have the ability to distribute low-resolution “For Placement Only” (“FPO”) images, high resolution digital art, and other files to their clients over the World Wide Web via a standard web browser. *Id.* (citing Ex. 1021, 1). According to Petitioner, using the WebNative workflow, one could preview and download low-resolution FPOs and web-ready images, such that OPI is carried out using thin and fat Post Script files. *Id.* at 31–32. Thus, according to Petitioner, FullPress and WebNative discloses the workflow of step recited in claim 4 of remotely providing access to imaging files for searching and retrieving images in the design of a page layout by a remote user. *Id.* at 35–36.

Petitioner cites our Decision on Institution in Kodak I for the proposition that the limitations in claim 4(b) [“establishing links to said imaging files, thereby creating a thin Postscript file from the page layout designed by the remote user”] and claim 4(c) [“parsing said thin Postscript file to extract data associated with low resolution images and replace with high resolution data, thereby forming a fat Postscript file”] simply tell one of ordinary skill to carry out OPI image swapping processing using the PostScript file type. Pet. 37 (citing Ex. 1005, 18). Petitioner contends that FullPress discloses generating smaller, more efficient PostScript files that are sent to the RIP and imaging device, and the claimed step of establishing links to the imaging files, creating a thin PostScript file from the page layout designed by the remote user. *Id.* at 37–39. Citing the Aldus OPI and the disclosure that FullPress replaces FPO views with high resolution source files, merging high-res images into the PostScript stream (*id.* at 37–38 (citing Ex. 1020, 5)), Petitioner notes that it was well known to those of ordinary skill that a thin PostScript file contained embedded OPI comments (or links) to the corresponding high resolution image. *Id.* at 38 (citing Declaration of Michael Jahn (“Jahn Decl.”), Ex. 1026 ¶¶ 26, 73). Petitioner argues that by disclosing a PostScript stream with FPO images replaced with high-resolution source files, it would have been known to one of ordinary skill to parse the thin PostScript file and thereby form a fat PostScript file, as claimed. *Id.* at 40 (citing Jahn Decl. ¶ 75).

The next step recited in claim 4 is creating a portable document format (PDF) file from the fat PostScript file. Petitioner notes that both FullPress and WebNative disclose sending the customer a PDF proof of the page layout for project approval and that both FullPress and WebNative use

PDF for proofing. Pet. 41–43 (citing Jahn Decl. ¶ 82–84; Ex. 1020, 14 (“FullPress also provides an option whereby the server may send the final PostScript to an Acrobat distiller to produce a PDF file. Current versions of Acrobat contain optimizations for on-line Internet delivery so that remote proofing can take place even more quickly.”); Ex. 1021, 2 (“WebNative also provides a mechanism for in-line proofing of PDF files.”)).

Although FullPress discloses converting the thin PostScript file to PDF for proofing purposes, it does not disclose explicitly the claimed conversion of a fat PostScript file because in FullPress the high resolution images that make up a fat PostScript file, as that term has been construed, are inserted at print time. Ex. 1020, 12. Instead, Petitioner argues that one of ordinary skill would have recognized a number of reasons to convert a fat PostScript file of FullPress into a PDF. Pet. 42–43 (citing Jahn Decl. ¶¶ 82–84).

Petitioner next argues that the final step in the FullPress workflow is to RIP the file and transmit the approved file to an image setter or other output device. *Id.* at 43; Jahn Decl. ¶ 86). According to Mr. Jahn, because plate setters were replacing image setters at the time the application for the ’349 patent was filed, it would have been known to one of ordinary skill to create a plate-ready file. Jahn Decl. ¶ 89. Mr. Jahn further testifies that the plate-ready file defines a page layout that has gone through the prepress process and has been RIPPed such that it contains the exact dots to be transferred onto a printing plate or in a format that can be used with an image setter. *Id.* ¶ 87. According to Mr. Jahn, whether creating a file for an image setter or a plate setter, in either scenario, after “the PDF goes through

one or more RIPs, the file is ready to be output to a device for producing a printing plate.” *Id.*

Mr. Jahn does not state that FullPress or WebNative discloses producing the plate-ready file from a PDF. As discussed above, in FullPress, the high resolution images that make up the fat PostScript file, as that term has been construed, are inserted at print time, which is after the PDF for proofing is generated. Instead, Petitioner and Mr. Jahn contend that one of ordinary skill would have known that it may be necessary to create a fat PostScript file prior to the conversion to PDF, if the workflow incorporated a version of Adobe Acrobat Distiller prior to the introduction of Adobe Acrobat Distiller PDF 1.2, because OPI comments (or links) were not preserved in earlier Distiller versions. Pet. 41. Thus, according to Petitioner, a person of ordinary skill would have known that the OPI comments would be lost in the conversion to PDF for proofing, unless the conversion to a fat PostScript file was done before the conversion to PDF. *Id.*

Patent Owner argues that FullPress discloses sending a PostScript file to the remote printer, where it is then processed, but does not disclose converting a fat PostScript file into a PDF file and then converting the PDF file into a plate-ready format, as recited in claim 4. Prelim. Resp. 14. Patent Owner further argues that WebNative, as a companion to FullPress, enables commercial printers and prepress shops to distribute the low-resolution FPO images to clients of the Internet using a web browser, but does not separately, or in combination with FullPress, disclose creating a PDF file from a created fat PostScript file and converting that PDF to a file in plate-ready format. *Id.* at 14–15.

Petitioner has demonstrated that a person of ordinary skill would have known PDFs have useful properties and that the combination of Full Press and WebNative together discloses sending a PDF to a customer for proofing. However, we are not persuaded that Petitioner has shown using a PDF in the workflow as the file from which a plate would be generated. Petitioner has not shown that FullPress or WebNative discloses using a PDF for this purpose. FullPress discloses: “an option whereby the server may send the final PostScript to an Acrobat Distiller to produce a PDF file. Current versions of Acrobat contain optimizations for on-line Internet delivery so that remote proofing can take place even more quickly.” Ex. 1020, 14. Nothing about this option suggests that sending the final PostScript to a Distiller for use in proofing in any way changes the workflow for creating the print-ready file. Instead Petitioner speculates that an incompatibility of early versions of Acrobat Distiller, if used for this undisclosed purpose, i.e., in the workflow for creating a print-ready file, would motivate a person of ordinary skill to take an action, i.e., converting a fat PostScript file to a PDF.

Petitioner’s articulated reasoning for its assertion that a person of ordinary skill would have known to create a fat PostScript file prior to creating a PDF is that in early versions of Acrobat Distiller the comments that would have allowed insertion of high resolution images at print time would have been lost. Pet. 41. Petitioner has not identified any reference to this issue in FullPress or WebNative. Petitioner does not provide evidence that such an issue would have existed at the time FullPress and WebNative were published. Petitioner solves a problem that had not been identified because the PDF in FullPress was used to proof a document, not to create a plate ready file. Petitioner’s analysis applies hindsight because it assumes

that a person of ordinary skill would be motivated to use a PDF to create such a plate ready file. However, the difficulties Petitioner explains such an approach would entail, if an early version of Distiller were present in the workflow, suggest a lack of motivation to use a PDF to create a plate ready file.

Thus, we are not persuaded that Petitioner has shown a reasonable likelihood it would prevail in its challenge to independent claim 4 as obvious under 35 U.S.C. § 103 over the combination of FullPress and WebNative and we decline to institute a trial on this ground. For the same reason, we decline to institute a trial of claims 5 and 7–9, which depend from claim 4 and are also challenged on this ground.

Claim 6 As Obvious Over FullPress, WebNative, and Andersson

Claim 6 depends from claim 4 and recites the further limitation of “converting said file in plate-ready format into a virtual proofing software file.” Petitioner notes that a soft proof is an on-screen proof, rather than a hard copy proof and cites Andersson as disclosing that if distilled correctly, the PDF can be used for soft proofing. Pet. 48. As discussed above, however, with respect to claim 4, from which claim 6 depends, we are not persuaded that Petitioner has demonstrated that FullPress and WebNative disclose that a PDF is used to create a plate ready file. Petitioner has not cited any disclosure in Andersson that overcomes this deficiency. Thus, we decline to institute a trial of claim 6 on the ground that claim 6 is obvious over the combination of FullPress, WebNative, and Andersson.

Claim 4–7 As obvious Over I-Media and Andersson

Noting that FullPress and WebNative concern traditional printing workflow for producing printed material, Petitioner cites I-Media as disclosing a workflow for cross media publishing across a variety of output mediums, print and electronic. Pet. 49. Petitioner notes that I-Media describes a system for generating both paper and electronic documents. *Id.* at 50 (citing Ex. 1019 §§ 1.1, 1.2). Petitioner further argues that I-Media discloses paper documents may be output to an image or plate setter after going through an OPI swapping process. *Id.* at 50–51 (citing Ex. 1019 § 2.2).

The cited portion of I-Media describes a Cross Media Publishing (CMP) system (client A) that uses an i-Media server for managing media data. Figure 3 of I-Media is shown below.

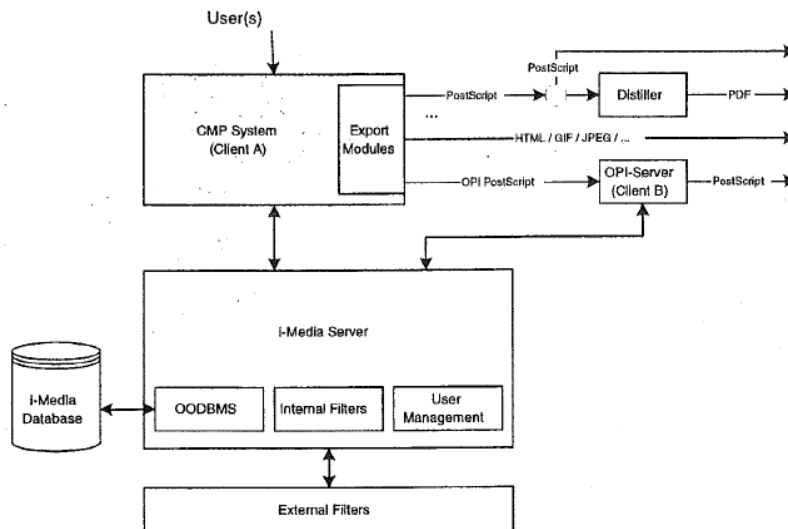


Fig. 3. Architecture of i-Media server and database and its clients (CMP system and OPI server).

The i-Media server consists of an object-oriented database management system (OODBMS), a user management module, a set of internal filters, and external filters, including stand-alone running RIP applications that can be called by the i-Media server. Ex. 1019, 6. The third party applications allow the creation and modification of media data. *Id.* Export modules, include third-party stand-alone systems such as Quark XPress for print publishing or Macromedia Director for multi-media presentations. *Id.* I-Media also discloses that another client (Client B) could run, e.g., on workstation (OPI-Server), that “translates OPI PostScript (PostScript encoded documents, where OPI comments were placed instead of high resolution images) to PostScript, which could be sent to an image or plate setter or even to a digital printing press.” *Id.*

Petitioner argues that in hosting user media data and utilizing OPI image swapping functionality on a remote server, I-Media provides remote access to “imaging files for searching and retrieving images used in the design of a page layout by a remote user,” as claimed. Pet. 52–53. Petitioner further argues that, through the use of an OPI server and embedded OPI comments in the Post Script documents produced by the CMP client system, I-Media teaches “establishing links to said imaging files, thereby creating a thin Post script file from the page layout design by the remote user,” as claimed. *Id.* at 54. Petitioner further contends that I-Media teaches the image swapping process with a PostScript file and, therefore, forms a fat PostScript file, as recited in the claims. *Id.*

Petitioner also argues that I-Media discloses the claimed feature of “creating a portable document format (PDF) file from said PostScript file.” *Id.* at 54–55. Figure 3 shows an output from an export module in the form

of a PostScript file being routed to a Distiller module which outputs a PDF. I-Media discloses that PDF is used for “distilling” PostScript and that PDF is becoming used as a page description device for displaying on screen as well as for printing on b/w or color printing device. Ex. 1019, 3.

Patent Owner argues I-Media does not disclose this step of claim 4 because in I-Media the remote user (Client A) converts the user-created document to a variety of formats, including PDF, using Expert Modules. Prelim. Resp. 16–17. Patent Owner contrasts I-Media’s disclosure of the user generating the PDF at the client computer with the limitation in claim 4, which requires that the steps be carried out at a facility separate from the remote user. *Id.* It is not clear from I-Media whether or not Client A is located at the user’s facility or a facility remote from the user.

As to the limitation in claim 4 that recites “converting said PDF file to a file in plate-ready format,” Petitioner contends that I-Media specifically describes sending a design CMP document “to an image or **plate-setter** or even to a digital printing press.” Pet. 56 (citing Ex. 1019 § 2.2).

Patent Owner contends that like FullPress, I-Media does not disclose creating a PDF from a created PostScript file and converting that PDF to a file in plate-ready format. Prelim. Resp. 16. Patent Owner cites Figure 3 of I-Media, which shows one process in which an OPI PostScript file is processed by an OPI server (Client B) to produce a PostScript file that is sent to a plate setter or a digital printing press. *Id.* at 16–17. In a separate process, a PostScript file is run through Distiller to produce a PDF, but there is no conversion of the PDF to a plate ready file. *Id.* Consistent with Petitioner’s argument that PDF files were known to be used for proofing and

other purposes (Pet. 55), Patent Owner argues that the PDF in I-Media also appears to be used for proofing. Prelim. Resp. 17.

Regardless of how the PDF file is used in the I-Media, we are persuaded by Patent Owner's argument that I-Media does not disclose using the PDF to create a plate-ready file. Instead, as shown in its Figure 3, I-Media discloses that the PostScript file is routed to the plate-setter or digital printer. Petitioner identifies no disclosure in I-Media of creating a plate-ready file from a PDF or routing the PDF to the plate-setter. Thus, Petitioner has not demonstrated it is reasonably likely to succeed in challenging independent claim 4, or claims 5–7 which depend from claim 4.

Claims 8 and 9 As Obvious Over I-Media, Andersson, and Seybold.

Claims 8 and 9 depend from claim 4. As discussed above, we are not persuaded that Petitioner has shown that the combination of I-Media and Andersson discloses or suggests creating a plate-ready file from a PDF. Petitioner cites Seybold as disclosing a client server product that facilitates remote access to images during page design. Pet. 59–60. However, Seybold does not disclose the claimed features lacking in the combination of I-Media and Andersson. Therefore, we are not persuaded that Petitioner has demonstrated it is reasonably likely to succeed in this challenge to claims 8 and 9.

SUMMARY

For the reasons discussed above, we are not persuaded that Petitioner has demonstrated it is reasonably likely to succeed in any of the challenges to the claims presented in the Petition.

ORDER

In consideration of the above, we decline to institute *inter partes* review of claims 4–9 of the '349 patent based on the challenges in the Petition.

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