UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

CTP INNOVATIONS, LLC,
Patent Owner.

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Case IPR2014-00788
Patent 6,738,155 B1

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

WOOD, *Administrative Patent Judge*.

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

I.   INTRODUCTION

A.   *Background*

Eastman Kodak Co., Agfa Corp., Esko Software BVBA, and Heidelberg, USA (collectively, "Petitioner") filed a request for rehearing (Paper 36, "Reh'g Req.") of our Final Written Decision (Paper 35, "Final Dec."). We requested (Paper 37) a response from CTP Innovations, LLC ("Patent Owner"), which was subsequently submitted (Paper 38, "Reh'g Req. Resp.").

Petitioner requests that we reconsider our decision that Petitioner has not demonstrated that claims 10–20 of U.S. Patent No. 6,738,155 (the '155 patent) are unpatentable. Patent Owner opposes. For the reasons set forth below, the request is granted.

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 '155 Patent*

The '155 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 10 and 16 are at issue in this case: claim 10 is drawn to a method that requires: (1) storing files; (2) providing the files to a remote user for designing a page layout; (3) generating a PDF from the designed page layout; (4) generating a "plate-ready file" from the PDF; and (5) *providing* the plate-ready file to a *remote* printer. Claim 10 is reproduced below:

> 10. A method of providing printing and publishing services to a remote client in real time using a communication network, the method comprising:
> storing files on a computer server, the files containing information relating to images, text, art, and data;
> providing said files to a remote client for the designing of a page layout;
> generating a portable document format (PDF) file from the designed page layout;
> generating a plate-ready file from said PDF file; and
> providing said plate-ready file to a remote printer.

Claim 16 is similar.

We instituted an *inter partes* review of claims 10–20 based on the following five grounds of unpatentability:

Reference[s]	Basis	Claims Challenged
Jebens[1] and Apogee[2]	§ 103(a)	10–13 and 15–20
Jebens, Apogee, and Andersson[3]	§ 103(a)	14

[1] Jebens, US 6,321,231 (iss. Nov. 20, 2001) (Ex. 1005).

[2] Agfa Apogee, The PDF-based Production System (1998) (Ex. 1007).

[3] MATTIAS ANDERSSON ET AL., PDF PRINTING AND PUBLISHING, THE NEXT REVOLUTION AFTER GUTENBERG (Micro Publishing Press 1997) ("Andersson") (Ex. 1009).

Reference[s]	Basis	Claims Challenged
Dorfman[4] and Apogee	§ 103(a)	10–13
Dorfman, Apogee, and Andersson	§ 103(a)	14 and 15
Dorfman, Apogee, and OPI White Paper[5]	§ 103(a)	16, 17, 19, and 20

Decision on Institution ("Dec. on Inst.") 25. For purposes of this decision, we refer to the first two grounds as the "Jebens/Apogee" grounds, and to the last three grounds as the "Dorfman/Apogee" grounds.

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. 10. We construed "remote printer" to mean "an offsite printing company facility accessible (by, e.g., an end user facility or central services facility) via a private or public communication network." *Id*. at 12. Because RIPing is the final step in creating a plate-ready file, we construed "providing said plate-ready file to a remote printer" to require generation of the plate-ready file, including RIPing, at a facility other than the printing company facility. *See id*. at 26 ("Simply put, a printer cannot be 'remote' with respect to itself. It follows that providing a plate-ready file to a 'remote printer' cannot be accomplished by the remote printer that receives the plate-ready file.").

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[4] Dorfman, WO 98/08176 (iss. Feb. 26, 1998) (Ex. 1006).

[5] Apple OPI White Paper (1995) (Ex. 1008).

B.   The Jebens/Apogee Grounds

The Petition asserted that claims 10–13 and 15–20 would have been obvious over Jebens and Apogee, and that claim 14 would have been obvious over Jebens, Apogee, and Andersson. Pet. 23–38. Of the challenged claims, claims 10 and 16 are independent. For purposes of this discussion, we treat claim 10 as representative.

In arguing that the combination of Jebens and Apogee renders claim 10 unpatentable, the Petition generally relied on Jebens for its disclosure of a "digital data management system" that "can be used to coordinate design, prepress, and printing activities, by connecting the front-end users (e.g., page designers) to service bureaus and printing companies over a communication network." Pet. 23. 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. Petitioner asserted that:

> [T]he generation of a plate-ready file involves subjecting the digital file to prepress operations (e.g., imposition, OPI, trapping, screening, color management, etc.) and then RIPing the digital file into a format that can be used, either directly or indirectly (e.g., via an imagesetter), to produce a printing plate. *The same is disclosed in Apogee. See, e.g.*, Ex. 1007 at pp. 6 and 7 ("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

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