

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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EASTMAN KODAK COMPANY, AGFA CORPORATION, ESKO SOFTWARE

BVBA, and HEIDELBERG, USA,

Petitioners,

v.

CTP INNOVATIONS, LLC,

Patent Owner.

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Case IPR2014-00788

U.S. Patent No. 6,738,155

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**PATENTS OWNER'S SUPPLEMENTAL BRIEF  
IN SUPPORT OF  
PATENTABILITY OF CLAIMS 10-20**

## INTRODUCTION

In its September 21, 2016 Decision (Paper 39), the Board partially granted the Petitioner's request for rehearing (Paper 35) with regard to the issue of whether claims 10-20 would have been obvious under the Dorfman grounds light of Apogee (Excerpt 2). The Board solicited further briefing from Patent Owner addressing whether claims 10-20 would have been obvious in light of the Dorfman/Apogee grounds.

As discussed below, claims 10-20 remain patentable even in light of the new Dorfman/Apogee grounds. A person of ordinary skill in the art would not find it obvious to modify Dorfman in view of Apogee to generate a plate-ready file from the PDF file and to provide said plate-ready file to a remote printer. In particular, there is no motivation to do so, as the suggested modification reduces the simplicity and efficiency of the Dorfman system, and the proposed combination would change the principle of operation of Dorfman by diverting the dynamic PDF file from being sent directly from the end user to the printing facility. In addition, there remain other defects in the proposed combination of prior art, including the attempt to use Dorfman's low-resolution dynamic PDF file to serve double-duty as both a low-resolution page layout design and a high-resolution PDF file.

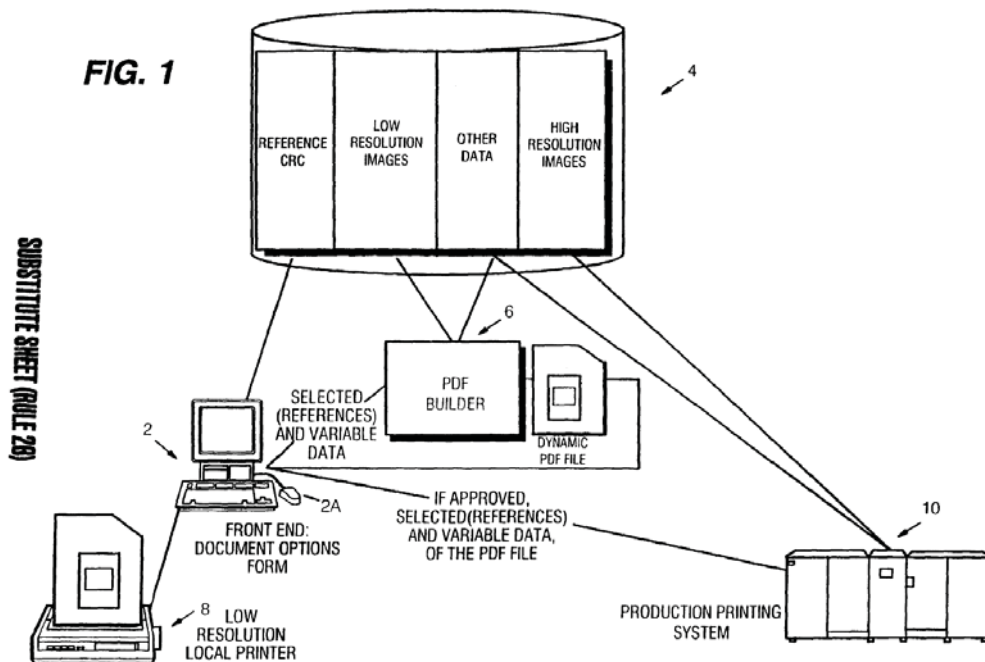
## ARGUMENT

### **A. There Is No Motivation To Modify Dorfman In Light of Apogee To Divert the Dynamic PDF File From Being Sent Directly to the Printing Facility.**

Petitioners have failed to provide a sufficient rationale for modifying Dorfman in light of Apogee in their suggested combination. The Petitioners must factually support any *prima facie* assertion of obviousness. The key to supporting any *prima facie* conclusion of obviousness under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007), noted that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit. Where a party seeks to invalidate a patent based on obviousness, it must demonstrate by a preponderance of evidence that a “skilled artisan would have had reason to combine the teaching of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success from doing so.” *In re Cyclobenzaprine Hydrochloride Extended Release Capsule Patent Litig.*, 676 F.3d 1063, 1068-69 (Fed. Cir. 2012). The Federal Circuit has stated that “rejections on obviousness grounds cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d at 988. *See also KSR*, 550 U.S. at 418.

Claims 10-20 of the '155 patent describe a method of providing printing and publishing services from the perspective of the central facility. The claims refer to files being sent to or received from a "remote client" or a "remote printer." Ex. 1001, Claims 10, 16. The context of the claims, read in light of the specification, demonstrate that all of the steps in the claimed method are carried out at a central facility, not a remote client or remote printer. The central facility (a) provides low-resolution files to a remote client for the designing of a page layout using the low-resolution files, (b) generates a high-resolution PDF file from the designed page layout (after the designed page layout is sent back from the remote client), (c) sends the high-resolution PDF file for additional proofing, (d) generates a plate-ready file from the high-resolution PDF file, and (e) sends the plate-ready file to a remote printer. *Id.*

In contrast, in the Dorfman system a central facility provides low-resolution files to a remote end-user at the front end (ref. 2) for the creation of a low-resolution dynamic PDF file, and the dynamic PDF file is sent to be printed *directly* to the production printing system from the remote front end (ref. 10). Ex. 1006 at p. 8:21-26 & Fig.1. It is at the printing system where low resolution images used in creating the dynamic PDF file are replaced by high resolution images by, for example, an open pre-press interface (OPI) before printing. *Id.* at p. 8:21-26. Figure 1 of Dorfman clearly shows this (reproduced below):



The high resolution images are separately downloaded to the production printing system from the database in the memory (ref. 4), independent from the transmission of the dynamic PDF file. Stevenson Decl. (Ex. 2014), at ¶ 50. The printing facility (ref. 10) then processes the dynamic PDF file in order to be ready for printing. Ex. 1006 at p. 8:21-26. Petitioner's expert, Professor Lawler, also testified that Figure 1 shows the high resolution files being sent to the production printing system separately from the PDF file, with the substitution of high resolution files for low resolution files taking place at the production printing system. Lawler Depo. Tr. (Ex. 2017), at 67:11-20.

Even assuming, *arguendo*, that the Dorfman production printing system is remote from a central service facility, there is no motivation to add an extra step to

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