

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EASTMAN KODAK COMPANY, AGFA CORPORATION, ESKO SOFTWARE
BVBA, and HEIDELBERG, USA

Petitioners,

v.

CTP INNOVATIONS, LLC

Patent Owner.

Case IPR2014-00788

Patent 6,738,155

**PETITIONERS' RESPONSIVE BRIEF PURSUANT TO THE DECISION
GRANTING PETITIONERS' REQUEST FOR REHEARING
UNDER 37 C.F.R. § 42.71**

Petitioners' Response to Request for Rehearing

Patent Owner has now squandered all three of its chances to address the remote printing teachings of Apogee. Claims 10-20 should now be cancelled.

In the Board's final written decision (Paper 35), the Board held that Petitioners failed to show that the Dorfman/Apogee combination teaches the limitation of "providing a plate-ready file to a remote printer" because "there is no evidence that a person of ordinary skill in the art would have had reason to produce the plate-ready file anywhere other than at Dorfman's production printing system." (Paper 35 at 31.) On rehearing, Petitioners directed the Board to the precise portion of Apogee that was previously cited for teaching that the disclosed PDF RIP process "allows you to physically separate the rendering from the actual plate production, so your PDF RIP [*i.e.*, plate-ready file] can be in the desktop department and the PrintDrive can sit next to the output device, **even in another town.**" (Ex. 1007 at 7, emphasis added.) That is, Apogee was cited for the specific teaching of "providing a plate-ready file to a *remote printer*" as the term "remote printer" has been construed by the Board ("an offsite printing company facility accessible via a private or public communication network"). Petitioners' expert explained the same, stating that "[i]n the combined system [of Dorfman and Apogee], the file that is sent to the printing system for production printing would be the plate-ready file or PIF described by Apogee." (Ex. 1021, ¶ 121.)

In its decision granting rehearing, the Board “agree[d] with Petitioner that Apogee [quoted above] addresses both the additional limitation of claim 12 as well as the ‘providing step’ of claim 10. More importantly Petitioner presented analysis that arguably addresses how Apogee corresponds to the ‘providing’ limitation as we construed the term.” (Paper 39 at 13.) Conspicuously absent from Patent Owner’s Response or Supplemental Brief is any analysis whatsoever as to the remote printing teaching of Apogee, or its straight forward application to the “providing” limitation of claims 10 and 16. In fact, Patent Owner mostly discusses the Dorfman reference in a vacuum as if Apogee did not exist at all. Petitioners, on the other hand, have presented both documentary evidence (Apogee) and testimonial evidence that the Dorfman/Apogee combination teaches “providing a plate-ready file to a remote printer,” none of which has ever been addressed, let alone rebutted, by Patent Owner. Petitioners respectfully submit that this uncontested, record evidence must now be accepted and claims 10-20 cancelled.

I. PATENT OWNER’S SUPPLEMENTAL BRIEF IS NON-RESPONSIVE

Patent Owner’s brief, like its previous filings, deliberately ignores Apogee’s teaching of “providing a plate-ready file to a remote printer.” As discussed above, Patent Owner does not offer a single argument that Apogee does not teach this limitation, which is the only reason the Board found against Petitioner originally

and the only question necessary to the resolution of this case. Despite Patent Owner having three opportunities to respond to Petitioners' argument (Patent Owner Response (Paper 19), Response to Request for Rehearing (Paper 38), and Supplemental Brief (Paper 40))—well beyond a full and fair opportunity to address the issue—the teachings of Apogee stand unrebutted.

The reason for Patent Owner's Apogee silence and avoidance is clear: in the co-pending litigation of the '155/'349 patents, Patent Owner insists that "remote printer" does not require geographic remoteness. Specifically, Patent Owner informed the district court that it will appeal the Board's remote printer construction ("an offsite printing company facility accessible via a private or public communication network") and that the term does not require the printer to be "geographically separate." (Ex. 1028 at p. 9:11-15, pp. 67:23–68:6.)¹ In other words, Patent Owner's refusal to address the disputed claim limitation or Apogee's corresponding teaching is deliberate and tactical. This is because Patent Owner

¹ Exhibit 1028 is submitted under 35 U.S.C. § 301(a)(2), authorizing any person at any time to provide the Office with evidence of inconsistent statements of the patent owner regarding claim scope. Thus, even if exhibits are not explicitly permitted in this filing, submission of Exhibit 1028 is authorized by statute.

believes that the proper construction of the term “remote printer” is even broader than that adopted by the Board, undercutting the Board’s only rational for distinguishing the Dorfman/Apogee ground in the first place.

As to the Patent Owner’s actual arguments of its Supplemental Brief, these have nothing to do with the claim limitations of the ’155 patent or the corresponding record in this proceeding; rather, they are directed to alleged features of the ’155/’349 patent specification. Patent Owner does not even pretend to relate such features to its claim language because it cannot. Patent Owner spends pages discussing independent claims 10 and 16 as (allegedly) limited to processing at certain locations and with a certain resolution. Yet claim 16 only requires that a PDF is generated from the page layout designed by the remote client and that a plate-ready file is sent to a remote printer. Claim 16 is not limited to a PDF of low or high-resolution; not limited to the location of PDF generation; not limited to the plate-ready file being generated from the PDF; and not limited to a location of plate-ready file generation. As to claim 18, Patent Owner alleges that Dorfman performs OPI at the printing facility and, therefore, cannot meet this claim limitation. Setting the veracity of this characterization of Dorfman aside, claim 18 modifies the PDF-generation step of claim 16 which, as noted above, only requires the PDF to be generated from files designed by the remote client—it does

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