

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 IPR2014-00790

U.S. Patent No. 6,611,349

**PETITIONERS' REQUEST FOR REHEARING
UNDER 37 C.F.R. § 42.71(d)**

I. SUMMARY OF ISSUES FOR REHEARING

Petitioners Eastman Kodak Company, Agfa Corporation, Esko Software BVBA, and Heidelberg, USA, Inc. (“Petitioners”) request rehearing under 37 C.F.R. § 42.71(d) of the Board’s Final Written Decision (“Decision,” Paper No. 40) finding that Petitioners have not demonstrated that claims 1-3 of U.S. Patent No. 6,611,349 (“the ’349 patent”) are unpatentable.

Independent claims 1-3 require, *inter alia*, a “central service facility” that “generat[es] a plate-ready file from pages designed at said end user facility....” There is no dispute that the Apogee reference teaches the generation of a plate-ready file—what Apogee calls a “PIF,” which is the file that is the output of Apogee’s PDF RIP Process. (Ex. 1008 at 6.) Rather, the sole reason the Board ruled in favor of Patent Owner was due to the mistaken belief that there is no 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.” (Decision at 27-28, 32-33.)

In reaching this conclusion, the Board overlooked directly contradictory evidence in the trial record, particularly the cited portion of the Apogee reference itself. For the element of “generating a plate-ready file from pages designed at said end user facility,” Petitioners relied upon Apogee’s teaching of PDF RIPs, which

are undisputed to be “plate-ready files” within the meaning of the '349 patent.

Importantly, Apogee expressly describes these plate-ready files as being sent to a remote printing facility “in another town.” (*See, e.g.*, Petition¹ at 33-34, 51-52, citing Ex. 1008 at 6-7.) On page 7, Apogee describes its PrintDrive system (which receives the plate-ready files after they have been created by the PDF RIP process) as “allow[ing] you to physically separate the rendering from the actual plate production, so your PDF RIP can be in the desktop department and the PrintDrive can sit next to the output device, **even in another town.**” (Petition at 33-34, 51-52, citing Ex. 1008 at 7, emphasis added.) Petitioners' claim charts, accepted by the Board as demonstrating a reasonable likelihood of prevailing on the merits, directed Patent Owner and the Board to this precise portion of Apogee. (*See* Petition at 33-34, 36, 38, 51-52, 54, and 58.) Patent Owner failed to rebut this evidentiary showing that Apogee employs a printing facility remote from the facility that performs plate-ready file processing, with the plate-ready files then being sent from the file processing facility (*i.e.*, Jeben's/Dorfman's central service facility) to the remote printing facility. The Board's sole reason for not holding claims 1-3 unpatentable overlooked this key aspect of the record.

Lastly, Petitioners' obviousness grounds rely on the system architecture from Jebens and Dorfman as primary references, not Apogee. There is no doubt

¹ Citations to the Petition are to the “corrected” Petition, Paper 4.

(or dispute) that the central service facility of Jebens routes to-be-printed files from a remote client, through its host or central service facility, to a remote printing facility. The Board agreed with the architectural framework of the Jebens Ground in its final written decision. (Decision at 13-14, 23-24.) The same holds true for the Dorfman grounds. (Decision at 29-30.) When Jebens/Dorfman is *modified* with the PDF processing teachings of Apogee—as applied in the grounds accepted by the Board—the to-be-printed file routed from the central service facility to the remote printing facility is the plate-ready file of Apogee. Yet, the Board's Decision mistakenly looks to the secondary reference (Apogee) for architectural structure relied upon in the primary references, and then suggests that Apogee, not the primary references, would have to be modified to produce a plate-ready file at a central service facility, rather than at a printing facility.

However, the issue for obviousness is not whether Apogee needs to be modified, but whether one of ordinary skill would have been motivated to modify Jebens/Dorfman to include the PDF processing teachings of Apogee at the disclosed central service facilities of the prior art. As to this point, and as explained below, the Petition and supporting evidence provided an un rebutted motivation of why the PDF workflow of Apogee and accompanying plate-ready file were desirable and would have been an obvious modification to the Jebens/Dorfman central service architecture. (*See* Petition at 25-27 and 43-45.)

Thus, even if Apogee's explicit teaching of remote printing could be ignored, which it cannot, the Board's Decision misapprehends the trial grounds.

Apogee plainly employs a remote printing facility in "another town" from the facility that performs plate-ready file processing (*i.e.*, the central service facilities of Jebens or Dorfman), and Petitioners explicitly relied on this teaching in the Petition. The Board has overlooked the record in this proceeding and misapprehended the trial grounds. For these reasons, Petitioners respectfully request that the Board grant rehearing and cancel claims 1-3 of the '349 patent.

II. LEGAL STANDARDS

"A party dissatisfied with a decision may file a request for rehearing, without prior authorization from the Board." 37 C.F.R. § 42.71(d). "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." *Id.* Here, the Board overlooked Apogee's express teaching that one of ordinary skill would have, and in fact did, consider generating a plate-ready file at locations remote from the printing company facility, such as the central service facility of Jebens or Dorfman. Similarly, the Board misapprehended Petitioners' proposed grounds of unpatentability, relying on the system structure of Apogee when the proposed grounds were based upon the system architecture of the primary references Jebens and Dorfman.

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