

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 IPR2014-00791

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

PETITIONERS' REPLY BRIEF

Pursuant to 37 C.F.R. §§ 42.23 and 42.24(c)(1), Eastman Kodak Company, Agfa Corporation, Esko Software BVBA, and Heidelberg, USA (“Petitioners”) hereby submit the following Reply in Support of their Petition for *Inter Partes* Review (“IPR”).

I. INTRODUCTION

Patent Owner's response is plainly impertinent to the instituted grounds.

Trial has been instituted on claims 10-14 of the '349 patent in view of Jebens and Apogee, as well as Dorfman, Apogee, and OPI White Paper. (*See* Paper 9 at 27.) Despite the Board's admonishment in its institution decision that "nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures" (*id.* at 21), Patent Owner (a) continues to focus its arguments on alleged shortcomings of each reference individually; (b) ignores the proposed combinations set forth in the Petition; and (c) reiterates its same arguments from Patent Owner's preliminary response.

Further, in an attempt to salvage its claims, Patent Owner and its expert continually and improperly read limitations from the specification into claims 10-14. As with its preliminary response, Patent Owner fails to rebut the grounds of unpatentability set forth by Petitioners by simply repeating its earlier, failed arguments.

II. THE JEBENS GROUND RENDERS CLAIMS 10-14 UNPATENTABLE

Claims 10-14 are rendered obvious in view of Jebens and Apogee. Patent Owner's alleged basis for distinguishing these claims stems from an improper reading of the claims and the prior art. Patent Owner also fails to consider the

proposed combination as a whole, attacking the references individually instead.

Claim 10 of the '349 patent recites, in pertinent part, (a) "storing high resolution files on a computer server;" (b) "generating low resolution files corresponding to said high resolution files;" (c) "providing said low resolution files to a remote client...;" (d) "generating a plate-ready file from the page layout designed by said remote client;" and (e) "providing said plate ready file to a remote printer."

Conspicuously absent from these claims is any requirement regarding where the steps of "generating a plate-ready file..." or "providing said plate ready file to a remote printer" must occur. Yet Patent Owner attempts to distinguish its claims on the basis of these phantom limitations. In a misguided attempt to import limitations from the specification into claims 10-14, Patent Owner (and its expert) simply state that, "based upon the specification" (Ex. 2014 at ¶ 17), these steps would occur at the central service facility. (Resp. at 21, *citing* Ex. 2014 at ¶ 17.) Then, based upon this unduly narrow claim construction, Patent Owner argues that "Jebens does *not* teach the step of generating a plate-ready file at a central service facility (*i.e.*, a facility separate from a remote client and a remote printer), and providing that plate-ready file to a remote printer." (Resp. at 21-22, emphasis in original.)

As an initial matter, and as noted above, there is absolutely **no** requirement in claim 10 that the step of generating a plate-ready file must occur at a central

service facility, or that the plate-ready file that is provided to the remote printer must come from a central service facility.¹ Other than referencing a few lines of the specification, Patent Owner and its expert provide no analysis as to why this limitation should be read into the claims. *See e.g., Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 913 (Fed. Cir. 2004) (“it is improper to read limitations from a preferred embodiment described in the specification—even if it is the only embodiment—into the claims absent a clear indication in the intrinsic record that the patentee intended the claims to be so limited”). As Patent Owner has not presented any rationale whatsoever, nor could it, as to why the features of the specification should be incorporated into claims 10-14, this argument is baseless and should be ignored.

All that claim 10 requires is the generation of a plate-ready file from the page layout designed by the client, and providing the plate-ready file to a remote

¹ Claim 11 states that “the low resolution files are stored in a storage device at a central service facility.” This requirement, which only appears in claim 11, and only relates to the storage of low resolution files, further supports Petitioners’ argument that claim 10 is not limited to generating a plate-ready file at a central service facility, or limited to the plate-ready file being provided to the remote printer from a central service facility.

printer. As set forth in the Petition, these steps are clearly taught by Apogee. (Petition at 40-41; Ex. 1022 at ¶¶ 90-94.) Indeed, Patent Owner agrees that these steps are taught by Apogee. (Resp. at 27.) Patent Owner's only dispute is that Apogee allegedly describes these steps as occurring at a printing company facility, not at a central service facility. However, as set forth above, this argument is entirely misplaced because claim 10 does not include any requirement that the steps of generating a plate-ready file, or providing the plate-ready file to a remote printer, have to occur (or occur from) a specific location.

Nonetheless, Prof. Lawler explained in his declaration that "Apogee thus describes one known process for taking a page layout designed by an end user and turning that incoming file, whether in PostScript or PDF, into a PIF or plate-ready file that can be output to a desired device." (Ex. 1022 at ¶ 94.) Similarly, Prof. Lawler explained that "For 'direct-to' production, Agfa developed ... the Apogee PrintDrive. 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 platesetters." (Ex. 1022 at ¶ 93, *citing* Ex. 1008 at 7.) Nothing in Apogee limits implementation of the processes described therein to a printing company facility and one of ordinary skill in the art could predictably implement Apogee at a central service facility (assuming, *arguendo*, that such was

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