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 IPR2014-00791
Patent 6,611,349 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
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Eastman Kodak Co., Agfa Corp., Esko Software BVBA, and Heidelberg, USA (collectively, "Petitioner") filed a request for rehearing (Paper 48, "Reh'g Req.") of our Final Written Decision (Paper 47, "Final Dec."). We requested (Paper 49) a response from CTP Innovations, LLC ("Patent Owner"), which was subsequently submitted (Paper 50, "Reh'g Req. Resp.").

Petitioner requests that we reconsider our decision that Petitioner has not demonstrated that claims 10–14 of U.S. Patent No. 6,611,349 (the '349 patent) are unpatentable. Patent Owner opposes. For the reasons set forth below, the request is denied.

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 '349 Patent*

The '349 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. Of the challenged claims, claim 10 is independent and is reproduced below:

10. A method of generating a plate-ready file configured for the creation of a printing plate, said plate-ready file being associated with page layouts and being provided in real time from a remote location using a communication network, the method comprising:

storing high resolution files on a computer server;

generating low resolution files corresponding to said high resolution files;

providing said low resolution files to a remote client for the designing of a page layout via a communication network;

generating a plate-ready file from the page layout designed by said remote client; and

providing said plate-ready file to a remote printer.

We instituted an *inter partes* review of claims 10–14 based on the following grounds of unpatentability:

Reference[s]	Basis	Claims Challenged
Jebens,[1] and Apogee[2]	§ 103(a)	10–14
Dorfman,[3] Apogee, and OPI White Paper[4]	§ 103(a)	10–14

Decision on Institution 25.

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. 9. We construed "remote printer" to mean "an offsite printing company facility accessible (by, e.g., an end user facility or

[1] Jebens, US 6,321,231 (iss. Nov. 20, 2001) (Ex. 1006).

[2] Agfa Apogee, The PDF–based Production System (Ex. 1008).

[3] Dorfman, WO 98/08176 (iss. Feb. 26, 1998) (Ex. 1007).

[4] Apple OPI White Paper (Ex. 1009).

central services facility) via a private or public communication network."
Id. at 11. 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 25 ("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.").

B. Petitioner's Rehearing Request Relies on New Evidence and a New Argument

In asserting that the combination of Jebens and Apogee rendered claim 10 unpatentable, the Petition relied on Jebens to teach the steps of (1) storing high resolution files on a computer server; (2) generating low resolution files corresponding to said high resolution files; (3) providing said low resolution files to a remote client for the designing of a page layout via a communication network; and (4) providing a plate-ready file to a remote printer. Pet. 39–41. Likewise, for the ground based on Dorfman, Apogee, and OPI White Paper, Petitioner relied on either Dorfman or OPI White Paper to teach these steps. *Id*. at 55–57. For both grounds, Petitioner relied on Apogee to teach the step of "generating a plate-ready file from the page layout designed by said remote client." *Id*. at 27, 40–41, 57. In doing so, Petitioner relied on a specific excerpt from Apogee, as follows:

> 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 platesetters.

Id. at 40-41, 48-49, 53, 57 (quoting Ex. 1008, 6–7 (emphasis omitted)). We refer to this quoted portion of Apogee as "Apogee Excerpt 1."

In its Response, Patent Owner argued, among other things, that the proposed combination does not teach a "facility separate from a remote client and a remote printer carrying out the steps of generating a plate-ready file from a page layout designed by a remote client, and the step of providing said plate-ready file to a remote printer." PO Resp. 21. Patent Owner further asserted that "[t]o the extent that Apogee discloses the generation of a plate-ready file in the form of a PIF through the Apogee PDF RIP process, a POSITA would consider this process to be taking place at the jobber or supplier, i.e., at a printing company facility." *Id*. at 27 (citing Ex. 2014 ¶ 24; Ex. 2017, 31:12–32:4). Petitioner replied that "[n]othing in Apogee limits the implementation of the processes described therein to a printing company facility, and one of ordinary skill could predictably implement Apogee at a central service facility." Reply 4. In support of this contention, Petitioner relied on the testimony of its declarant, Professor Lawler, who in turn relied on Apogee Excerpt 1. *Id*. (citing Ex. 1022 ¶¶ 93–94).

In the Final Decision, we reiterated that "for the proposed combination of Jebens and Apogee to teach [providing a plate-ready file to a remote printer], either the end user or the host facility must produce the plate-ready file and provide it to the printer." Final Dec. 25. We found, however, that "Jebens does not teach or suggest generating a 'plate-ready

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