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 IPR2014-00791

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

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**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. 47) finding that Petitioners have not demonstrated that claims 10-14 of U.S. Patent No. 6,611,349 ("the '349 patent") are unpatentable.

Independent claim 10 requires, *inter alia*, "providing said plate-ready file to a remote printer." Before this occurs, the plate-ready file must be generated. 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 teaching in Apogee of providing a plate-ready file to a remote printer—*i.e.*, that "there is no evidence that a person of ordinary skill in the art would have considered generating a plate-ready file anywhere other than where the printing plates are produced: at the printing facility." (Decision at 26, 30.)

In reaching this conclusion, the Board overlooked directly contradictory evidence in the trial record, particularly the cited portion of the Apogee reference

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itself. (*See* Petition[1] at 40-41 and 57, citing Ex. 1008 at 6-7.) For the step of "generating a plate-ready file from said PDF file," 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 printer "in another town." 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."** (Ex. 1008 at 7, emphasis added.) Petitioners' claim charts directed Patent Owner and the Board to this precise portion of Apogee teaching the generation of a plate-ready file at locations remote from the printing company facility, with those files then being sent from the file processing facility to the remote printing facility. (*See* Petition at 40-41, 53, 57.) The Board's sole reason for not holding claims 10-14 unpatentable overlooked this key aspect of the record.

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

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[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 to a remote printer. The Board agreed with the architectural

framework of the Jebens Ground in its final written decision. (Decision at 12-13,

22.) The same holds true for the Dorfman ground. (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 to the

remote printer 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 route a plate-ready file to a

remote printer.

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. As to this

point, and as explained below, the Petition and supporting evidence provided an

unrebutted 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 architecture. (*See* Petition at 27-29, 32-33, and 47-49.) 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 printer in "another town" 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 10-14 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. Similarly, the Board misapprehended Petitioners' proposed ground of unpatentability, relying on the system structure of Apogee when the proposed ground was based upon the system architecture of the primary references Jebens and Dorfman.

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