UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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COMMAND WEB OFFSET COMPANY, INC.; WORZALLA PUBLISHING
COMPANY; SANDY ALEXANDER, INC.; PUBLICATION PRINTERS CORP.;
SPECIALTY PROMOTIONS, INC.; and TREND OFFSET PRINTING
SERVICES INC.

Petitioners,

v.

CTP INNOVATIONS, LLC

Patent Owner.

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Case IPR2016-00008

Patent 6,611,349

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

## I.    SUMMARY OF ISSUES FOR REHEARING

Petitioners Command Web Offset Company, Inc., Worzalla Publishing Company, Sandy Alexander, Inc., Publication Printers Corp., Specialty Promotions, Inc., and Trend Offset Printing Services Inc. ("Petitioners") request rehearing under 37 C.F.R. § 42.71(c) of the Board's March 28, 2016 Decision denying institution of *inter partes* review ("Decision," Paper No. 13) against claims 4-9 of U.S. Patent No. 6,611,349 ("the '349 patent").

Independent claim 4 of the '349 patent requires, *inter alia*, "creating a thin PostScript file," "forming a fat PostScript file," "creating a ... PDF ... from said fat PostScript file," and "converting said PDF file to a file in plate-ready format."  Not only were each of these steps known prior to the filing of the '349 patent, but they were obvious in combination.  The sole reason the Board denied institution was due to the apparent misapprehension that "Petitioner has [not] shown using a PDF in the [FullPress/WebNative] workflow as the file from which a plate would be generated."  (Decision at 15; *see also id.* at 16.)  More specifically, the Board found that Petitioners and its expert, Michael Jahn ("Mr. Jahn"), did not "state that FullPress or WebNative discloses producing the plate-ready file from a PDF.... [I]n FullPress, the high resolution images that make up the fat PostScript file, as that term has been construed, are inserted at print time, *which is after the PDF for proofing is generated*."  (Decision at 14 (emphasis added).)

In arriving at its conclusion that the high-resolution images are only inserted after proofing, it is respectfully submitted that the Board overlooked the fact that the remote proofing option of FullPress/WebNative utilizes a *final PostScript file* (*i.e.,* fat PostScript file) to generate the remotely transmitted PDF. Although FullPress generally states that "the latest high-resolution images [are inserted] at print time," as noted by the Board (Decision at 13), the Board's Decision overlooks Petitioners reliance on the remote proofing option in FullPress and WebNative. The remote proofing option modifies the general procedure because "the server may send the ***final PostScript*** to an Acrobat distiller to produce a PDF file." (Petition at 42 (citing Ex. 1020 at 14 (emphasis added)).)

This workflow procedure for remote proofing is confirmed by WebNative, a companion plug-in to FullPress. (*See* Petition at 31.) WebNative illustrates a remote proofing workflow wherein the high-resolution images that make up the fat PostScript file are inserted into the to-be-printed file ***before*** the PDF for proofing is generated—not after—as mistakenly concluded by the Board. (*See* Petition at 31 (citing Ex. 1021 at 1) (emphasis added).) Specifically, the FullPress/WebNative Workflow depicts at step 6, "reliably *relinking* FPOs [*i.e.,* low-resolution to high-resolution image swapping]," and then sending a proof to the client (step 7) that is ultimately approved for final output (steps 8 and 9). (*Id.* (emphasis added).) Thus, the proofing file that is generated post image swapping, sent to the client for

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approval, and then ultimately converted to a plate-ready format, is a PDF file. (*See* Petition at 42.) As such, the Board's statement that "the high resolution images that make up a fat PostScript file, ...., are inserted at print time" (Decision at 13) is a misapprehension of the teachings of FullPress relied upon in the petition.

Second, the Board's dismissal of Petitioners' evidence regarding problems with early versions of Acrobat Distiller and the need to create a fat PostScript file to preserve OPI comments—simply because this problem was not explicitly noted in FullPress or WebNative (Decision at 15-16)—suffers from the exact rigid application of the teaching-suggestion-motivation ("TSM") test rejected by the Supreme Court in *KSR Int'l Co. v. Teleflex, Inc.,* 550 U.S. 398, 418 (2007). It is respectfully submitted that, far from speculating, Petitioners provided testimonial evidence of one of skill in the art (evidence itself) and four separate documents that demonstrate Petitioners' rationale. (*See* Petition at 40 (citing Ex. 1007 at 6); Petition at 41 (citing Ex. 1015 at 4; Ex. 1016 at 2; Ex. 1017 at 3).) Petitioners' citation to these *prior art* documents, which evidence a specific motivation to generate a fat PostScript file prior to converting to PDF, is the antithesis of hindsight. This evidence was not addressed anywhere in the Board's Decision. Accordingly, Petitioners respectfully request that the Board institute IPR against claims 4-9 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.*  Under 37 C.F.R. § 42.71(c), "[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion."  An abuse of discretion "occurs where the decision is based on an erroneous interpretation of the law, on factual findings that are not supported by substantial evidence, or represents an unreasonable judgment in weighing relevant factors."  S*tar Fruits S.N.C. v. United  States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005).

Here, the Board's factual finding that Petitioners have not shown that a person of ordinary skill in the art ("POSA") would have used a PDF as the file from which a plate-ready file would be generated in FullPress/WebNative is unsupported in the record and directly refuted by the relied upon remote proofing workflow.  Similarly, the Board incorrectly interpreted the law as requiring the obviousness rationale set forth by Petitioners to be found or suggested within the four corners of FullPress or WebNative.

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