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Paper 21
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EASTMAN KODAK CO., AGFA CORP., ESKO SOFTWARE BVBA, and HEIDELBERG, USA,
Petitioner,

v.

CTP INNOVATIONS, LLC,
Patent Owner.

Case IPR2014-00791
Patent 6,611,349 B1

Before HOWARD B. BLANKENSHIP, BENJAMIN D. M. WOOD, and BRIAN J. MCNAMARA, *Administrative Patent Judges.*

WOOD, *Administrative Patent Judge*.

DECISION
Petitioner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

A. Background

Eastman Kodak Co., Agfa Corp., Esko Software BVBA, and Heidelberg, USA (collectively, "Petitioner") filed a request for rehearing (Paper 12, "Reh'g Req.") of our decision, dated November 28, 2014 (Paper 9, "Decision," or "Dec.") denying institution with respect to several of Petitioner's proposed grounds of unpatentability of claims 4–9 of U.S. Patent No. 6,611,349 ("the '349 patent"). Reh'g Req. 1. Petitioner requests that we reconsider our determination not to institute an *inter partes* review on the following grounds: (1) claims 4–8 as obvious over Dorfman, Apogee, and OPI White Paper; (2) claim 9 as obvious over Dorfman, Apogee, OPI White Paper, and Adams II;[1] and (3) claims 4–9 as obvious over Jebens, Apogee, and OPI White Paper. *Id*. For the reasons stated below, Petitioner's request is granted-in-part for the limited purpose of further explaining our determination not to institute on the Dorfman grounds, and denied in all other respects.

II. STANDARD OF REVIEW

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 when a "decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment." *PPG Indus., Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted). The request must identify, specifically,

[1] Grounds (1) and (2) will be referred to as the "Dorfman grounds."

all matters the party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d).

III. DISCUSSION

A. Claims 4–9—The Dorfman Grounds

In its Petition, Petitioner alleged that claims 4–8 were obvious over Dorfman, Apogee, and OPI White Paper, and that claim 9 was obvious over Dorfman, Apogee, OPI White Paper, and Adams II. Pet. 44–55, 59–60. Claim 4 is independent, and is drawn to a "method of generating a plate-ready file" that is "associated with page layouts" provided "from a remote location using a communication network," comprising the steps of: (1) "remotely providing access to imaging files for searching and retrieving images used in the design of a page layout by a remote user;" (2) "establishing links to said imaging files, thereby creating a *thin Postscript file* from the page layout designed by the remote user;" (3) "parsing said thin Postscript file to extract data associated with low resolution images and replace with high resolution data, thereby forming a *fat Postscript file*;" (4) "*creating a portable document format (PDF) file from said fat Postscript file*;" and (5) "converting said PDF file to a file in plate-ready format." Ex. 1001, 22:31–48 (emphasis added). Claims 5–9 depend from claim 4. *Id*. at 22:49–23:2.

Dorfman describes a "technique for easily creating and proofing customized printed material before printing on a production printing system." Ex. 1007, 1 (abstract). A user can access a template in PDF from the system's website and modify the template by adding low-resolution copies of selected images and other variable data, thereby creating a dynamic PDF file representing the material to be printed. *Id*. at 4:3–8, 8:1–

4. The PDF may be viewed or printed to a local low-resolution printer for final proofing. *Id*. at 8:4–11. The user can make any necessary changes or corrections to the PDF file from the system website and send the file "for printing using conventional printing technology where the low resolution images would be replaced by the high resolution images by an OPI . . . process before printing." *Id*. at 4:18–21, 8:23–26.[2]

In our decision on institution, we stated that Petitioner did not present sufficient evidence to persuade us that "a person of ordinary skill in the art would have considered using Postscript files with Dorfman's system in a way that corresponds to the steps of claim 4." Dec. 26. We noted that Dorfman teaches a workflow based on the PDF format rather than the Postscript format, and therefore does not teach creating a thin Postscript file, converting it to a fat Postscript file, and converting the fat Postscript file to a PDF file. *Id*. at 25. We also found unpersuasive Petitioner's assertion that "[u]tilizing Postscript files in the OPI process rather than PDF files would have been an obvious substitution to one of ordinary skill in the art." *Id*. (citing Pet. 46–47; Ex. 1022 ¶¶ 130–131). We stated that Petitioner's assertion might be true with respect to the OPI process in general, but "Petitioner has not presented persuasive evidence that a skilled artisan would have made that substitution in combination with Dorfman's system." *Id*. We explained that Dorfman's system uses the PDF format to obtain specific benefits beyond facilitating OPI image exchange, and that "[t]here is no evidence that these benefits would obtain by using Postscript files with

[2] As discussed in the Decision, OPI, or "Open Prepress Interface," is an "image swapping" process in which a user designs pages using low-resolution image files, which, prior to printing, are exchanged for high-resolution versions of the image files by an OPI server. Dec. 18.

Dorfman's system." *Id*. at 26. We noted that, on the contrary, Professor Lawler testified that there are numerous benefits to using PDF over Postscript, suggesting that a person of ordinary skill would have preferred working with PDF files rather than Postscript files, and thus would have been unlikely to modify Dorfman to use Postscript files. *Id*. at 26.

In its Rehearing Request, Petitioner asserts that we "overlooked facts" and "misapprehended the law" in declining to institute *inter partes* review based on the Dorfman grounds. Reh'g Req. 3–9. Specifically, Petitioner argues that each of the following "piece[s] of evidence" was "overlooked and not addressed by the Board:"

(1) Dorfman's page layout templates may be tailored to a specific user through the use of "variable data" (*id*. at 4 (citing Pet. 46; Ex. 1007, 7:9–27; Ex. 1022 ¶ 112));

(2) according to Professor Lawler, one of ordinary skill in the art would have understood that the "variable data provided by the users" could be "user specific images, artwork, or other types of data" (*id*. (citing Pet. 46; Ex. 1022 ¶ 112));

(3) a user of Dorfman's system "could easily and predictably" include a company's logo on a page layout, or a photo of an item for sale, by "integrating known page building operations using PostScript-based OPI with the Dorfman system" (*id*. at 5 (citing Pet. 46–47; Ex. 1022 ¶¶ 115–118)); and

(4) "[a]s taught by OPI White Paper, the traditional way of performing OPI at the time the '349 patent was filed was to create thin and fat Postscript files" (*id*. (citing Pet. 52; Ex. 1009, 12; Ex. 1022 ¶¶ 130–133)).

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