

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 IPR2014-00788
Patent 6,738,155 B1

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

WOOD, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

A. Background

Eastman Kodak Co., Agfa Corp., Esko Software BVBA, and Heidelberg, USA (collectively, “Petitioner”) filed a Corrected Petition (Paper 4, “Pet.”) to institute an *inter partes* review of claims 10–20 of U.S. Patent No. 6,738,155 B1 (Ex. 1001, “the ’155 patent”). CTP Innovations, LLC (“Patent Owner”) filed a Preliminary Response (Paper 8) (“Prelim. Resp.”). We instituted an *inter partes* review of claims 10–20 based on the following alleged grounds of unpatentability:

References	Basis	Claim(s) Challenged
Jebens ¹ and Apogee ²	§ 103(a)	10–13 and 15–20
Jebens, Apogee, and Andersson ³	§ 103(a)	14
Dorfman ⁴ and Apogee	§ 103(a)	10–13
Dorfman, Apogee, and Andersson	§ 103(a)	14 and 15
Dorfman, Apogee, and OPI White Paper ⁵	§ 103(a)	16, 17, 19, and 20

Decision on Institution (“Dec. on Inst.”) 25.

¹ Jebens et al., US 6,321,231 B1 (iss. Nov. 20, 2001) (Ex. 1005).

² AGFA, Agfa Apogee, The PDF-based Production System (1998) (Ex. 1007).

³ MATTIAS ANDERSSON ET AL., PDF PRINTING AND PUBLISHING, THE NEXT REVOLUTION AFTER GUTENBERG (Micro Publishing Press 1997) (“Andersson”) (Ex. 1009).

⁴ Dorfman et al., WO 98/08176 (pub. Feb. 26, 1998) (Ex. 1006).

⁵ Apple OPI White Paper (1995) (Ex. 1008).

After the Board instituted trial, Patent Owner filed a Patent Owner Response (Paper 19, “PO Resp.”),⁶ to which Petitioner replied (Paper 24, “Pet. Reply”). Oral Hearing was held on June 30, 2015, and the Hearing Transcript (Paper 34, “Tr.”) has been entered in the record.

We have jurisdiction under 35 U.S.C. § 6(c). This Final Decision is entered pursuant to 35 U.S.C. § 318(a). We determine that Petitioner has not shown by a preponderance of the evidence that claims 10–20 are unpatentable.

B. Related Proceedings

Petitioner discloses that the ’155 patent has been asserted in 49 infringement actions. Pet. 1; Ex. 1002. Petitioner also has filed three additional petitions for *inter partes* review: IPR2014-00789, for review of claims 1–9 of the ’155 patent; IPR2014-00790, for review of claims 1–3 of U.S. Patent No. 6,611,349 (“the ’349 patent”), which shares the ’155 patent’s disclosure; and IPR2014-00791, for review of claims 4–14 of the ’349 patent. Pet. 2. The ’155 and ’349 patents were also the subject of two previous petitions for *inter partes* review, both of which were denied. *See Printing Indus. of Am. v. CTP Innovations, LLC*, Case IPR2013-00474 (PTAB Dec. 31, 2013) (Paper 16) (denying petition for *inter partes* review of the ’349 patent); *Printing Indus. of Am. v. CTP Innovations, LLC*, Case IPR2013-00489 (PTAB Dec. 30, 2013) (Paper 15) (denying petition for *inter partes* review of the ’155 patent).

⁶ Patent Owner also filed two motions to exclude evidence, which are discussed in section II.B.3 below.

C. The '155 Patent

The '155 patent issued May 18, 2004 from an application filed July 30, 1999. Ex. 1001, cover page. The '155 patent relates to “a system and method of providing publishing and printing services via a communications network.” *Id.* at 1:9–10. According to the '155 patent, “[k]ey steps for producing printed materials using a plate process include (1) preparing copy elements for reproduction, (2) prepress production, (3) platemaking, (4) printing, and (5) binding, finishing and distribution.” *Id.* at 1:12–15. In the first or “design” stage, an end user—e.g., a publisher, direct marketer, advertising agency, or corporate communication department—uses a desktop publishing program such as “QuarkXpress” to design “pages” from image and data files. *Id.* at 1:16–25. In the prepress production stage, the user-created pages are “transformed into a medium that is reproducible for printing.” *Id.* at 1:26–28. This transformation typically involves typesetting, image capture and color correction, file conversion, “RIPing, trapping, proofing, imposition, filmsetting, and platemaking.” *Id.* at 1:29–32.

“RIPing” is based on the acronym “RIP,” which stands for raster image processor. *Id.* at 7:57–59. A RIP is a hardware or software component that “rasterize[s]” an image file—i.e., converts it to a “bitmap” or raster image. *Id.* “RIPing” is therefore synonymous with rasterizing. A bitmap “is a digitized collection of binary pixel information that gives an output device, such [as a printer, proofer, or platemaking device,] the ability to image data to paper, film, or plate.” *Id.* at 7:59–62. “Proofing” involves creating a sample of the finished product that is sent to the end user for approval. *Id.* at 1:32–35. Once the end user approves the proof, a medium, such as a computer-to-plate (CTP) file, is produced and sent to the printer. *Id.* at

1:35–39. “Imposition” involves “the set of pages on a particular plate as well as their positioning and orientation” to facilitate “the stripping, collating, and folding of the printed product.” *Id.* at 1:38–44. A printer makes a plate “using the medium created during prepress,” e.g., a CTP file. *Id.* at 1:45–48. The printer uses the plate on a printing press to reproduce the product, which is then bound, finished, and distributed. *Id.* at 1:45–51.

The '155 patent describes and claims a publishing and printing system in which “[s]ystem components are installed at an end user facility, a printing company facility, and a central service facility,” each connected to the others via a communication network. *Id.* at 2:31–36, 51–56. Figure 1, reproduced below, depicts an embodiment of the claimed invention:

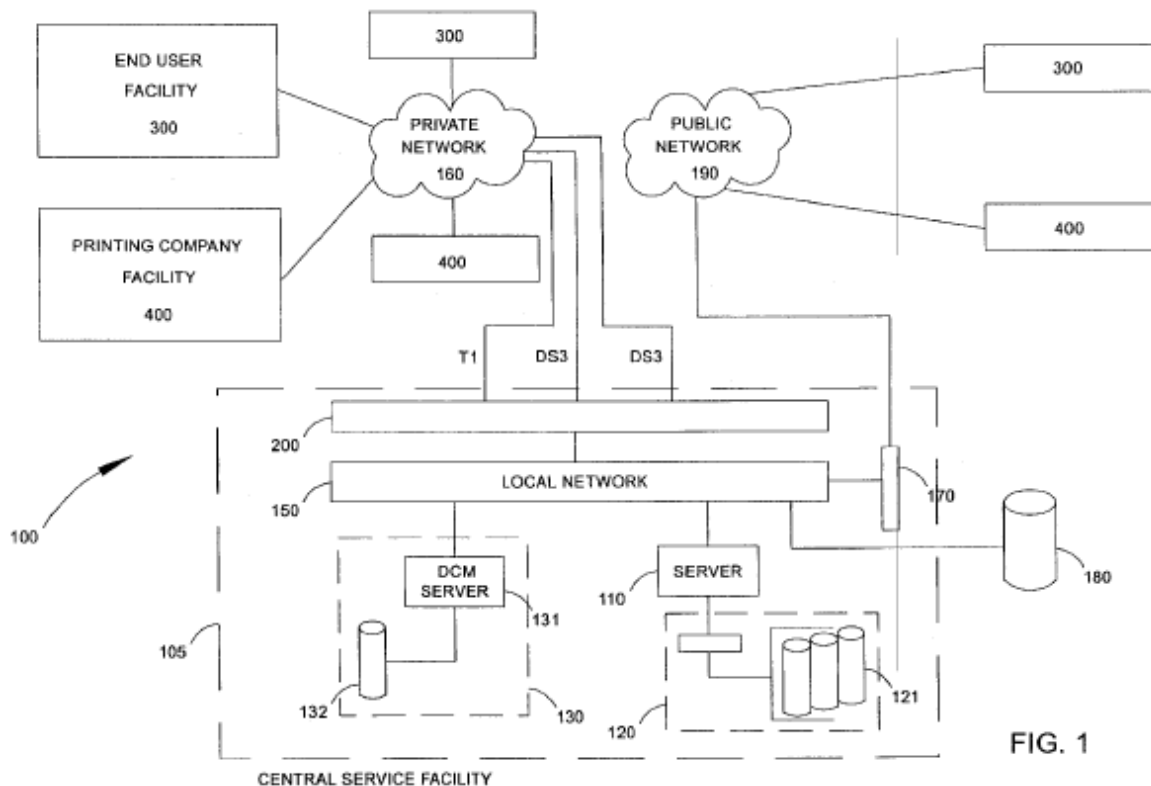


Figure 1 depicts end user facility 300, printing company facility 400, and central service facility 105 connected together via either private network

160 or public network 190. *Id.* at Fig. 1. In this embodiment, end user facility 300 comprises a router, a desktop computer for page-building operations, and a color proofer and black and white printer for high-resolution proofing. *Id.* at 7:38–40, Figs. 1, 2, 5. Printing company facility 400 comprises a router, a server, a desktop computer, a laser printer, a color plotter, and a platesetter, and performs production management, digital plate-making, desktop imposition, and press services. *Id.* at 8:31–33, 9:38–43, Figs. 1, 4, 5. Central service facility 105 comprises server 110, “hierarchical storage management” (HSM) system 120, “digital content management” system 130, local area network (LAN) 150 and communication routing device 200. *Id.* at 5:34–50. “Data may be exchanged between central service facility 105 and either private network 160 or public network 190 in any suitable format, such as in accordance with the Internet Protocol (IP), the Transmission Control Protocol (TCP), or other known protocols.” *Id.* at 5:21–25. An end user can store files in HSM system 120 to reduce storage needs at the end user facility. *Id.* at 7:19–23, 38–40.

Server 110 uses software capable of performing “open prepress interface” (OPI) operations. *Id.* at 5:62–64. OPI operations include “high resolution image swapping.” *Id.* at 10:31–33. That is, OPI permits a lower resolution image file to be used as a proxy for a higher resolution file during page-building operations, which is advantageous because the low resolution image can be transmitted and manipulated more quickly. *Id.* at 7:46–49, 10:44–49. The low resolution images are replaced by the corresponding high resolution images before final proofing and printing. *Id.* at 7:49–51.

D. Illustrative Claims

Claims 10 and 16 are independent, and are drawn to methods of providing printing and publishing services to a remote client using a communication network. Claims 11–15 depend from claim 10, and claims 17–20 depend from claim 16.

Claims 10 and 16 are reproduced below:

10. A method of providing printing and publishing services to a remote client in real time using a communication network, the method comprising:

storing files on a computer server, the files containing information relating to images, text, art, and data;

providing said files to a remote client for the designing of a page layout;

generating a portable document format (PDF) file from the designed page layout;

generating a plate-ready file from said PDF file; and
providing said plate-ready file to a remote printer.

16. A method of providing printing and publishing services to a remote client performing any one of page layout designing and plate press printing where said printing and publishing services are provided in real time using a wide area 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;

generating a portable document format (PDF) file from the page layout designed by said remote client;

providing said PDF file to said remote client; and
providing a plate-ready file to a remote printer.

II. ANALYSIS

A. *Claim Construction*

The claims of an unexpired patent are interpreted using the broadest reasonable interpretation in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1278 (Fed. Cir. 2015). Under this standard, the claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010). Any special definition for a claim term must be set forth in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

We expressly construe below only those claim terms that require analysis to resolve arguments related to the patentability of the challenged claims. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (holding that “only those [claim] terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy”). All other terms will be accorded their ordinary and customary meaning as would be understood by one of ordinary skill at the time of the invention.

1. *“A method of providing printing and publishing services to a remote client in real time using a communication network” (claim 10); “A method of providing printing and publishing services to a remote client . . . in real time using a wide area communication network” (claim 16)*

The preamble for each of independent claims 10 and 16 recites a method of providing printing and publishing services to a remote client “in real time.” In the Decision on Institution, we determined that “the

preambles in the claims at issue, including the term ‘real time,’ do not limit the scope of the claims.” Dec. on Inst. 11–13. Neither Patent Owner in its Response nor Petitioner in its Reply disputed this determination. Further, we are not aware of any evidence adduced at trial that calls this determination into question. Therefore, based on our analysis in the Decision on Institution, we determine that the preambles in the claims at issue, including the term “real time,” do not limit the scope of the claims.

2. *plate-ready file (all claims)*

Each of independent claims 10 and 16 uses the term “plate-ready file.” Petitioner asserts that:

The plate-ready file represents a page layout file that has gone through the prepress process (e.g., imposition, screening, trapping, color management, etc.) and has been RIPPed such that it contains the exact dots to be transferred onto a printing plate. [Ex. 1021] at ¶ 65. The plate-ready file may be in a format that can be used with a platesetter as the output device, such that the digital file is directly used to create a printing plate; or in a format that can be used with an imagesetter, such that the digital file is indirectly used to create a printing plate. *Id.* at ¶¶ 65–69.

Pet. 22 (footnote omitted).

Patent Owner asserts that a plate-ready file is “a file that is ready to be made into a printing plate.” PO Resp. 10–11 (emphasis omitted). Patent Owner relies in part on the deposition testimony of Petitioner’s expert, Brian Lawler, which mirrors Petitioner’s contentions above. *Id.* at 12 (quoting Ex. 2017 at 35:19–36:3).

The Specification does not define “plate-ready file” expressly, but its meaning is discernible from the term itself: a file that can be used to produce a printing plate without further modification. *See* Ex. 1001, 10:7–

14 (equating the term “plate-ready file” with “a single file that is stable, predictable, and ready to image to proof or plate”). Moreover, as Petitioner states, the plate-ready file can be used with a platesetter to create a plate directly, or with an imagesetter to produce film that is then used to create the plate. Pet. 22. Further, we agree with the parties that because the file is “plate-ready,” it represents a page layout file that has gone through the prepress process, including RIPing. That is the purpose of prepress production: transforming “copy” into “a medium that is reproducible for printing,” such as a “computer to plate (CTP) file.” *Id.* at 1:26–38.

Accordingly, in addition to the constructions we applied in the Decision on Institution, we construe “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.

3. *remote printer (all claims)*

Each of independent claims 10 and 16 recites the step of providing a plate-ready file to a “remote printer.” Neither party proposes a construction for the term. Although the Specification does not define the term expressly, it uses the term “printer” to mean the entity or facility that manufactures the printing plates and uses the plates to create the final printed product.⁷ Ex. 1001, 1:45–50. The Specification also identifies a “printing company facility” as performing this “final printing” step, *id.* at 2:41–44, which

⁷ The Specification uses “printer” in a different context to refer to a specific component of the end-user facility, i.e., “black and white laser printer 340.” Ex. 1001, 7:20. This component is used for end-user proofing rather than final printing, so it is unlikely that the claims use “printer” to refer to this component.

indicates that “printer” as used in claims 10 and 16 is synonymous with “printing company facility.”

The Specification also does not define “remote.” When the intrinsic evidence does not define a term, “one may look to technical dictionaries for assistance in determining [the] term’s meaning to a person of ordinary skill in the art.” *Atofina v. Great Lakes Chem. Corp.*, 441 F.3d 991, 996 (Fed. Cir. 2006). In the context of a telecommunications system, “remote” was defined at the time of the invention as “pertaining to a system or device that is accessed through a telephone line,” and the opposite of “local.”

NEWTON’S TELECOM DICTIONARY 692 (15th ed. 1999) (Ex. 3001). This is suggestive of the depiction of end-user facility 300, central-service facility 105, and printing company facility 400 as linked to private network 160 or public network 190, except the communication links to the private network are T-1 and DS3 lines rather than telephone lines. Ex. 1001, 4:64–65.

Because these facilities access each other via private network 160 (also referred to as “remote network 160,” *id.* at 5:66) or public network 190, the facilities can be said to be “remote” with respect to each other. The Specification also uses “remote” in a similar context to mean “offsite.” *See id.* at 5:31–32 (“*Offsite* storage facility 180 provides *remote* archival system for disaster contingency purposes.” (emphasis added)). This is consistent with a plain meaning of the term. *See* WEBSTER’S DICTIONARY OF MODERN ENGLISH 447 (1st ed. 1987) (defining “remote” as “far away, distant”) (Ex. 3002). It is also consistent with the technical dictionary’s definition of “remote” as being the opposite of “local.”

Based on the above discussion, “remote printer” means an offsite printing company facility accessible (by, e.g., an end user facility or central services facility) via a private or public communication network.

B. Claims 10–13 and 15–20—Jebens and Apogee

Petitioner asserts that claims 10–13 and 15–20 are unpatentable under 35 U.S.C. § 103(a) as obvious over Jebens and Apogee. Pet. 23–37.

1. Jebens

Jebens describes “a digital image management and order delivery system.” Ex. 1005, 2:13–14. The system provides a centralized, searchable database of digital images that can be used and modified by authorized users. *Id.* at 4:54–56. The system also serves as a job order developer and conduit for routing files from a client, such as an advertising agency, to a printer. *Id.* at 4:60–62. Figure 1, reproduced below, illustrates Jebens’ invention.

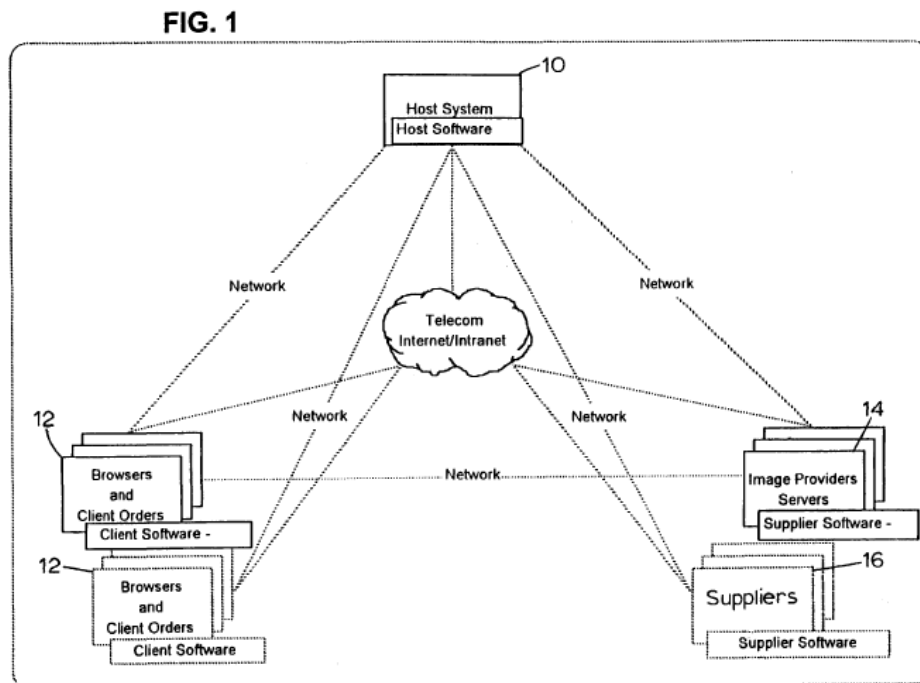


Figure 1 depicts a data management and work-order delivery system constructed according to Jebens. *Id.* at 4:20–23. The system comprises host system 10 in communication with a variety of users, such as browsers and client “orderers” 12, image providers 14, and suppliers 16. *Id.* at 6:52–65. The host system software includes, *inter alia*, an image database that archives low and high resolution copies of digital image files. *Id.* at 8:12–13. The system is “ideally suited for facilitating publication and the like.” *Id.* at 4:66–67. Image providers 14 may include a corporation that stores digital images of its products on host system 10 to more efficiently use its in-house computer storage facilities. *Id.* at 4:67–5:5, 6:55–60. Browsers and client orderers 12 may include an advertising agency that the corporation hires to create a brochure using the stored images, and suppliers 16 may include the printer that will print the finished brochure. *Id.* at 5:5–10, 6:54–65. To use the system, the corporation gives the agency information to access the host system; the agency searches the host system, downloads low-resolution copies of desired images, and uses the low-resolution images to create the brochure. *Id.* at 5:11–17. The agency then reconnects to the system “to request that the system electronically route the created document with high resolution copies of the selected digital images to a publishing entity such as a printer, where the finalized brochure would be published.” *Id.* at 5:17–22. Communication between host system 10 and users 12, 14, and 16 “can be effected by any known means of connectivity,” such as “through local area networks or wide area networks,” or “hardwired to one another as an intranet.” *Id.* at 6:66–7:4, 7:20.

2. *Apogee*

Apogee describes the Agfa Apogee print-production system. Ex. 1007, 1. Content can be created in any format and output to Apogee in either PostScript or PDF; Apogee normalizes incoming files to PDF “to guarantee complete predictability and compatibility.” *Id.* at 3–4. The PDF files are stored as individual PDF pages and become “Digital Masters” to create all production versions of the document and to provide a version that can be proofed and edited remotely. *Id.* at 4, 6. For a specific print job, Apogee collects the appropriate pages, automatically imposes the pages into a “digital flat,” and rasterizes it for the selected output device (e.g., an image setter or plate setter). *Id.* at 6. The result is a “Print Image File” (PIF) that “contains all the dots that will appear on the film or plate.” *Id.*

3. *Whether Apogee Is a Prior Art Publication*

Before discussing the merits of this ground of unpatentability, we first address Patent Owner’s contention, PO Resp. 53–59, that Petitioner has not shown that Apogee was publicly accessible before July 30, 1999, the ’155 patent’s filing date. Petitioner contends that Apogee—which bears a copyright date of 1998 by Agfa-Gevaert N.V.—was published in 1998, and “[a]t the latest” was made available to the public on May 28, 1998. Pet. 5 (citing Ex. 1022); *see* Ex. 1007, 8. Petitioner relies on the Declaration of Johan Suetens, an employee of Agfa Graphics, to support this contention. Mr. Suetens testifies that in 1998 he was responsible for “marketing-communications of commercial printing” at Agfa. Ex. 1022 ¶ 4. According to Mr. Suetens, the Apogee reference was created to promote the Agfa Apogee system to potential customers. *Id.* ¶ 8. Mr. Suetens further testifies that a code appearing on the last page of the Apogee reference—

“NEFDU”—is unique to the Apogee reference, and is used by Agfa’s “Enterprise Management System” to track the document. *Id.* ¶ 10.

Attachment D to Mr. Suetens’ Declaration is a printout from the Enterprise Management System that Mr. Suetens asserts shows that 76,030 copies of the Apogee reference were printed for Agfa in April 1998. *Id.* Mr. Suetens asserts that this printed version of the Apogee reference was distributed by Agfa sales departments at “seminars, exhibitions, and demos of Apogee to the public,” and was made available to the public as an electronic PDF file on Agfa’s website, www.agfahome.com, no later than May 28, 1998, when Agfa issued a press briefing announcing the release of Apogee Pilot. *Id.* ¶¶ 8–10.

Patent Owner counters that “Petitioners have failed to establish that [Apogee] was distributed outside of Agfa or was otherwise publicly accessible.” PO Resp. 53. Based on Mr. Suetens’ deposition testimony, Patent Owner asserts that he “has no actual personal knowledge of when (or even if) the Apogee reference was distributed to the public, made available to the public, or provided to any member of the public.” *Id.* at 54. According to Patent Owner, Mr. Suetens testified at his deposition that (1) Agfa’s marketing-communication department “does not provide documents—including the Apogee reference—directly to the public,” but only makes documents available to Agfa subsidiaries (*id.* (citing Ex. 2016, 23:8–24:10)); (2) he does not have any personal knowledge of the distribution of the Apogee reference to a customer or potential customer, or when the printed form would have been distributed to Agfa subsidiaries (*id.* at 54–55 (citing Ex. 2016, 34:4–18, 40:7–41:1, 50:5–23)); (3) he does not know who, if anyone, posted a PDF version of Apogee on Agfa’s website or

when it was posted (*id.* at 57 (citing Ex. 2016, 48:3–49:21); and (4) he does not remember seeing it on the website (*id.*).

Petitioner responds to Patent Owner’s contentions by submitting additional evidence with its Reply, i.e., a supplemental Declaration from Mr. Suetens (“Supplemental Suetens Declaration,” Exhibit 1024), and a Declaration from Michael Jahn (“Jahn Declaration,” Exhibit 1023). Attached to the Supplemental Suetens Declaration are additional records obtained from Agfa’s Electronic Management System. Ex. 1024, Att. E–H. According to Mr. Suetens, these records demonstrate how the Electronic Management System tracked the ordering and delivery of copies of the Apogee reference and other promotional brochures from Agfa headquarters to its subsidiaries and regional offices in 1998. For example, Mr. Suetens testifies that Attachment H demonstrates that 400 copies of the Apogee reference were sent to Declarant Michael Jahn. *Id.* ¶ 14, Att. H.

Mr. Jahn testifies that from August 1997 to September 2001 he worked for Agfa Corporation as a contract consultant. Ex. 1023 ¶¶ 4–5. Mr. Jahn asserts that “it was my job, beginning in August 1997 until leaving the company in September 2001, to travel internationally and throughout the U.S. to meet with potential customers and industry groups for the purpose of educating them on the AGFA Apogee PDF workflow.” *Id.* ¶ 10. He states that he “recognize[d] [the Apogee reference] as one that I personally distributed to interested members of the public on behalf of Agfa beginning in 1998, and thereafter.” *Id.* ¶ 9. For example, Mr. Jahn testified that he attended the “Vue/Point conference 9th annual communication event held April 14–16 in Arlington, Virginia, and the PIRA International meeting held in England,” and that “[a]t these conferences, . . . [t]he Apogee [reference]

was the literature that attendees were given to take back to their office.” *Id.* ¶¶ 10–11. Mr. Jahn also testifies that he directed conference attendees to his website, www.jahn.org, where he had posted and made publicly available an earlier “near identical” version of the Apogee reference. *Id.* ¶¶ 12, 15, Att. C.

a. Patent Owner’s First Motion to Exclude Evidence

On April 2, 2015, concurrently with its Patent Owner Response, Patent Owner filed its First Motion to exclude the Apogee reference, Ex. 1007, and Mr. Sueten’s first Declaration, Ex. 1022. Paper 18, 4–8. On April 16, 2015, Petitioner responded to Patent Owner’s First Motion as if it were evidentiary objections filed under 37 C.F.R. § 42.64(b)(1), and served on Patent Owner “supplemental evidence” under 37 C.F.R. § 64(b)(2); specifically, the Supplemental Suetens Declaration and the Jahn Declaration. Paper 30, 3; Tr. 31:4–8.

Patent Owner seeks to exclude Mr. Suetens’ first Declaration for essentially the same reasons discussed above: that Mr. Suetens lacks personal knowledge regarding the public accessibility of Apogee. We have reviewed the First Motion and determine that Patent Owner’s objections to the First Suetens Declaration go more to the weight of the Declaration than to its admissibility. Further, we note that the public accessibility of the Apogee reference is a substantive issue that is better suited for Patent Owner’s Response than for a motion to exclude. For these reasons, we deny Patent Owner’s First Motion to Exclude.

b. Patent Owner's Second Motion to Exclude Evidence

Patent Owner filed its Second Motion on June 11, 2015, ten days after Petitioner filed its Reply and Exhibits 1023 and 1024, the Jahn Declaration and Supplemental Suetens Declaration, respectively. In the Second Motion Patent Owner moves for the exclusion of these Declarations. Patent Owner's principal argument is that the Declarations constitute "supplemental information, not supplemental evidence." Paper 26, 10. According to Patent Owner, "[i]nformation submitted to the Board that is directed to the public accessibility of Apogee is per se supplemental information . . . because Apogee serves as one of Petitioners' asserted bases for unpatentability." *Id.* Because Petitioner did not follow the procedure for submitting supplemental information under 37 C.F.R. § 42.123(b), Patent Owner argues that the Supplemental Suetens Declaration should be excluded. *Id.* at 11.

Petitioner responds that both the Jahn and Supplemental Suetens Declarations are "offered solely to support the admissibility of Apogee," and "are not offered to further support 'any argument on the merits (i.e., regarding the patentability or unpatentability of a claim)' in view of Apogee and, therefore, are proper supplemental evidence." Paper 30, 4.

As an initial matter, we reject the notion that evidence submitted to support a reference's public availability can never be served as "supplemental evidence" under 37 C.F.R. § 42.64(b)(2). The rule does not limit the subject matter of evidence served under this rule, and at least two other panels have noted that such evidence has been served as supplemental evidence. *See Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, Case

IPR2014-00788
Patent 6,738,155 B1

IPR2013-00369, slip op. at 2, 5 (PTAB Feb. 5, 2014) (Paper 37) (noting its understanding that the supplemental information under consideration previously had been served to Patent Owner in response to Patent Owner's evidentiary objections); *Toyota Motor Corp. v. American Vehicular Scis., LLC*, Case IPR2013-00417, slip op. at 8 (PTAB Jan. 7, 2015) (Paper 78) (noting Petitioner's submission of supplemental evidence to establish a prior-art reference's publication date).

More importantly, we disagree with Patent Owner that evidence must be submitted as supplemental information in accordance with 37 C.F.R. § 42.123 in order for the evidence to be admitted as rebuttal evidence with Petitioner's Reply. The Board "has broad discretion to regulate the presentation of evidence under Fed. R. Evid. 611(a)." *Belden Inc. v. Berk-Tek LLC*, ---F.3d---, 2015 WL 6756451, at *14 (Fed. Cir. Nov. 5, 2015). In particular, the Board has discretion to permit Petitioner to submit evidence with its Reply to rebut an argument raised in the Patent Owner Response. *Id.*; *Flir Sys., Inc. v. Leak Surveys, Inc.*, Case IPR2014-00411, slip op. at 11 (PTAB Sept. 3, 2015) (Paper 113).

Under the circumstances of this case, we determine not to exclude the Jahns and Supplemental Suetens Declarations. First, the Declarations serve the permissible rebuttal function of responding directly to an argument Patent Owner made in its Response, PO Resp. 53, that Petitioner has failed to establish that Apogee "was distributed outside of Agfa." *See Belden*, 2015 WL 6756451, at *14 ("the traditional principle [is] that evidence offered to rebut must accomplish the function of rebuttal; 'to explain, repel, counteract, or disprove the evidence of the adverse party'" (internal citation omitted)); *Flir*, slip op. at 11 ("[t]he object of a reply is to address arguments

made in an opposition”). Second, Patent Owner had a fair opportunity to respond to the Declarations. Because the Declarations were served on Patent Owner on April 16,⁸ well before they were filed with the Reply, Patent Owner had ample opportunity to depose Mr. Jahn and Mr. Suetens before the June 11 deadline for filing motions for observations regarding cross-examination. Indeed, Patent Owner has not argued that it did not depose the declarants because it was unable to do so, but rather because it believed that such depositions were “unnecessary.” Paper 33, 4–5. Finally, the Declarations do not add to the evidence initially presented in the Petition to support the grounds of unpatentability authorized in this proceeding, but are relied on only to support the public accessibility of a reference that was presented with the Petition. *See Belden*, 2015 WL 6756451, at *11 (rejecting argument that rebuttal expert declaration was necessary to establish prima facie case of unpatentability because “prior art itself, together with the Petition, sufficed to supply a prima facie case of obviousness”).

We have reviewed the additional arguments that Patent Owner raises in support of its Motion, and determine that they address the weight to be given the Declarations rather than their admissibility. For these reasons, Patent Owner’s Second Motion to Exclude Evidence is denied.

c. Petitioner Has Shown That Apogee Is Prior Art

“In order to qualify as a printed publication within the meaning of § 102, a reference must have been sufficiently accessible to the public interested in the art.” *In re Lister*, 583 F.3d 1307, 1311 (Fed. Cir. 2009)

⁸ Paper 30, 3; Tr. 31:4–8.

(internal citation and quotation marks omitted). “Whether a reference is publicly accessible is determined on a case-by-case basis based on the facts and circumstances surrounding the reference’s disclosure to members of the public.” *Id.* (internal citation and quotation marks omitted). “A reference is considered publicly accessible if it was disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” *Id.* (internal citation and quotation marks omitted).

We find that Petitioner has shown by a preponderance of the evidence that Apogee was publicly accessible before the ’155 patent’s filing date. There does not seem to be any dispute that Apogee was printed at least as early as April 1998. Further, Petitioner has shown that a large number of copies were printed and distributed to Agfa subsidiaries around the world in 1998. Ex. 1024 ¶¶ 10–14, Atts. E–H. Petitioner has also proffered evidence of at least one Agfa sales representative, Mr. Jahn, publicly distributing Apogee to potential customers at conferences. Ex. 1023. Given that Apogee was created to promote the Apogee system to prospective customers, and that a very large number of copies of the reference were printed, it is reasonable to infer that many of these copies made their way into the possession of interested persons. We also credit Mr. Jahn’s testimony that an earlier version of Apogee was posted on his website before the critical date, and that he directed interested persons to that document. Although we do not rely on this version itself in considering Petitioner’s grounds of unpatentability, we consider this testimony further evidence that a person of ordinary skill, using reasonable diligence, could have gained access to the Apogee reference.

4. *Claims 10–13 and 15*

Petitioner generally relies on Jebens for its disclosure of a “digital data management system” that “can be used to coordinate design, prepress, and printing activities, by connecting the front-end users (e.g., page designers) to service bureaus and printing companies over a communication network.” Pet. 23. Petitioner relies on Apogee to teach the generation of a plate-ready file by subjecting the digital file to prepress operations and then RIPing the digital file into a format that can be used to produce a printing plate. *Id.* at 28. According to Petitioner, Apogee shows:

[W]hat would have been well-known and understood to one of ordinary skill—namely, that in order for a printing plate to be produced, a software program that rasterizes the output of the prepress process must be incorporated into the printing system workflow to produce a plate-ready file. Thus one of ordinary skill in the art would have been motivated to incorporate Apogee into the Jebens printing system to allow for a printing facility to produce a printing plate for offset printing.

Id. at 28–29 (citing Ex. 1021 ¶ 94).

a. The Parties’ Contentions

With respect to independent claim 10, Petitioner relies on Jebens to teach the steps of: “storing files on a computer server, the files containing information relating to images, text, art, and data;” and “providing said files to a remote client for the designing of a page layout.” Pet. 30 (citing Ex. 1005, 2:64–3:10, 5:54–65). For the step of “generating a [PDF] file from the designed page layout,” Petitioner first points to Jebens’ teaching that the end user may create a “PDL” file, which could be either a PostScript or PDF file. *Id.* (citing Ex. 1005, 13:58–67). Petitioner next relies on Apogee’s teaching that the Apogee system normalizes all incoming files, including PostScript

files, into PDF, imposes the pages, does OPI image exchange, and sends the resulting PDF file to Apogee PDF RIP to be RIPed. *Id.* at 30–31 (citing Ex. 1007, 3, 6–7). For the step of “generating a plate-ready file from said PDF file,” Petitioner again relies on Apogee’s disclosure of generating a “Print Image File” (“PIF”) from a PDF file. *Id.* at 31 (citing Ex. 1007, 6–7). Finally, for the step of “providing said plate-ready file to a remote printer,” Petitioner relies on Jebens’ teaching that the end user can “request that the system electronically route the created document with high resolution copies of the selected digital images to a publishing entity such as a printer, where the finalized brochure would be published.” *Id.* (citing Ex. 1005, 5:17–22).

Patent Owner disputes that the combination of Jebens and Apogee renders claim 10 unpatentable. Patent Owner asserts 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.” PO Resp. 22. Patent Owner also disputes Petitioner’s expert’s opinion that the Jebens system replaces the low-resolution copies of images with the original high-resolution copies, arguing that “it only serves as an image warehouse and job order forwarding service, and simply forwards the document as received from the advertising agency without modifying the document.” *Id.* at 23 (citing Ex. 2014 ¶¶ 25–28). Patent Owner is of the view that “the Jebens system is not creating a plate-ready file and sending it to a printing facility, but merely passing along the document created by the advertising agency along with high-resolution copies of images in the document.” *Id.* at 24 (citing Ex. 2014 ¶ 25). Thus, according to Patent Owner, “a POSITA would recognize that Jebens does not substantively process the created document

file” received from the user; instead “the created document is simply bundled with other files and compressed for transmission to a jobber or supplier” (e.g., printer) where “[p]rocessing the created document file occurs.” *Id.* at 26–27 (citing Ex. 2014 ¶ 29). Patent Owner further contends that “Apogee does not cure the defects of Jebens,” because “Apogee discloses generating a plate-ready file in the form of a [PIF] through the Apogee PDF RIP process . . . and a POSITA would consider this process to be occurring at the jobber or supplier, *i.e.*, at a printing company facility.” *Id.* at 27 (citing Ex. 2014 ¶ 30).

Petitioner replies that “there is absolutely *no* requirement in claims 10 and 16 that the step of generating a plate-ready file must occur at a central service facility, or that the plate-ready file provided to the remote printer must come from a central service facility.” Pet. Reply 2–3 (emphasis in original). Petitioner asserts that “[a]ll that claims 10 and 16 require is the generation of a PDF from the page layout designed by the client, and the generation/providing of a plate-ready file to a remote printer,” all of which Apogee teaches. *Id.* at 3. Further, according to Petitioner, even if the claims did contain such a requirement, “[n]othing in Apogee limits the implementation of the processes described therein to occur at a printing company facility, and one of ordinary skill could predictably implement Apogee at a central service facility.” *Id.* at 4 (emphasis in original). Petitioner cites to Professor Lawler’s deposition testimony that “the generation of a plate-ready file as described by Apogee can occur **either** at the printing facility or the host/central service facility, and that none of the reference[s] are limited to preparing the plate-ready file at the central service

facility or the printing company facility.” *Id.* (citing Ex. 2017, 1001:21–103:3).

Petitioner also disputes Patent Owner’s argument that Jebens’ central services facility does not carry out OPI. Petitioner contends, first, that “none of the challenged claims recite or require OPI to occur,” and, second, even if such a requirement existed or if OPI is necessary to create a plate-ready file, “Petitioners’ rely on Apogee for its teaching of a plate-ready file, not Jebens alone, which clearly teaches the incorporation of OPI into a pre-press workflow.” Pet. Reply 5–6. Petitioner also asserts that Jebens does, in fact, perform OPI, “which could occur either at the central service facility or printing company facility,” arguing that “[w]hether the files are already embedded in the page layout [when it is routed to the printer], or sent separately, they have been swapped or ‘replaced’ for the low resolution images used during page building operations and, therefore, OPI has occurred.” Pet. Reply 6–7.

b. Analysis

We need not resolve whether Jebens performs OPI because, as Petitioner points out, claim 10 does not require OPI. And while we agree with Petitioner that claim 10 does not necessarily require the production of a plate-ready file at a central services facility,⁹ we disagree that claim 10 does not place any restrictions on where the file is produced and from where it is provided. As noted above, claim 10 requires that the plate-ready file must be provided “to a remote printer.” In the context of the ’155 Patent, we construed “remote printer” to mean “an offsite printing company facility

⁹ Claim 10 only requires a “client” and a “printer” that are “remote” with respect to each other.

accessible (by, e.g., an end user facility or central services facility) via a private or public network.” 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.

Thus, for the proposed combination of Jebens and Apogee to teach this limitation, either the end user or the host facility must produce the plate-ready file and provide it to the printer. Petitioner argues that “one of ordinary skill *could* predictably implement Apogee at a central service facility.” Pet. Reply 4 (emphasis added). But as our reviewing court recently stated, “obviousness concerns whether a skilled artisan not only *could have made* but *would have been motivated to make* the combinations or modifications of prior art to arrive at the claimed invention.” *Belden*, 2015 WL 6756451, at *5 (emphasis in original) (citing *InTouch Techs., Inc. v. VGO Commc’n, Inc.*, 751 F.3d 1327, 1352 (Fed. Cir. 2014)).

Jebens does not teach or suggest generating a “plate-ready file” as we have construed the term above, i.e., a file that “that has gone through prepress processing, including RIPing.” Apogee teaches generating a plate-ready file from a PDF, but does not teach or suggest providing it to a remote printer. Petitioner asserts that “one of ordinary skill in the art would have been motivated to incorporate Apogee into the Jebens printing system to allow for a printing facility to produce a printing plate for offset printing.” Pet. 29. But Petitioner does not point us to any evidence—in Jebens, Apogee, or otherwise—that a person of ordinary skill in the art would have combined Jebens and Apogee in such a way that a plate-ready file would have been produced at Jebens’ host facility or end user facility rather than at

its printing facility. In other words, 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. Evidence that a skilled artisan could have generated the plate-ready file at Jebens' host facility, without any evidence of a reason why the skilled artisan would have done so, is insufficient to show obviousness. *See KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 421–23 (2007) (considering the obviousness of a claim to an adjustable automobile throttle pedal combined with an electronic sensor, holding that “[a] person having ordinary skill in the art could have combined [the adjustable pedal] with a pedal position sensor in a fashion encompassed by [the claim], and would have seen the benefits of doing so” (emphasis added)); *InTouch Techs.*, 751 F.3d at 1352 (holding that expert witness “succumbed to hindsight bias” in basing obviousness opinion on “belief that one of ordinary skill in the art *could* combine these references, not that they *would* have been motivated to do so” (emphasis in original)). For these reasons, Petitioner has not shown by a preponderance of the evidence that claim 10, and its dependent claims 11–13 and 15, would have been obvious over Jebens and Apogee.

5. *Claims 16–20*

Claim 16 is similar to claim 10, and in particular requires the step of “providing a plate-ready file to a remote printer.” The parties make the same arguments and rely on the same evidence for claim 16 as for claim 10. Pet. 35; PO Resp. 21–27; Pet. Reply 1–7. Therefore, for the reasons discussed above, we determine that Petitioner has not shown by a preponderance of the evidence that claim 16, and its dependent claims 17–20, would have been obvious over Jebens and Apogee.

C. Claim 14—Jebens, Apogee, and Andersson

Claim 14 depends from claim 10 and additionally requires that “the step of generating a plate-ready file from said PDF file comprises converting said PDF file to a PostScript file.” Ex. 1001, 22:25–27. Petitioner does not rely on Andersson to cure the deficiency noted above with respect to Jebens and Apogee. Therefore, for the reasons stated above, Petitioner has not shown by a preponderance of the evidence that claim 14 would have been obvious over Jebens, Apogee, and Andersson.

D. Claims 10–13—Dorfman and Apogee

Petitioner contends that claims 10–13 are unpatentable under 35 U.S.C. § 103(a) as obvious over Dorfman and Apogee. Pet. 39–48.

1. Dorfman

Dorfman describes a “technique for easily creating and proofing customized printed material before printing on a production printing system.” Ex. 1006 (abstract). A user can access a template in PDF format from the system’s website, modify the template by adding low-resolution copies of selected images and other variable data, and thereby create a dynamic PDF file. *Id.* at 4:3–8, 8:1–4.¹⁰ The PDF file 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

¹⁰ We conform to Petitioner’s usage of Dorfman’s original page numbers rather than Petitioner’s supplemental page numbers.

the high resolution images by an OPI . . . process before printing.” *Id.* at 4:18–21; *see id.* at 8:23–26.

Figure 1, reproduced below, depicts an embodiment of this system:

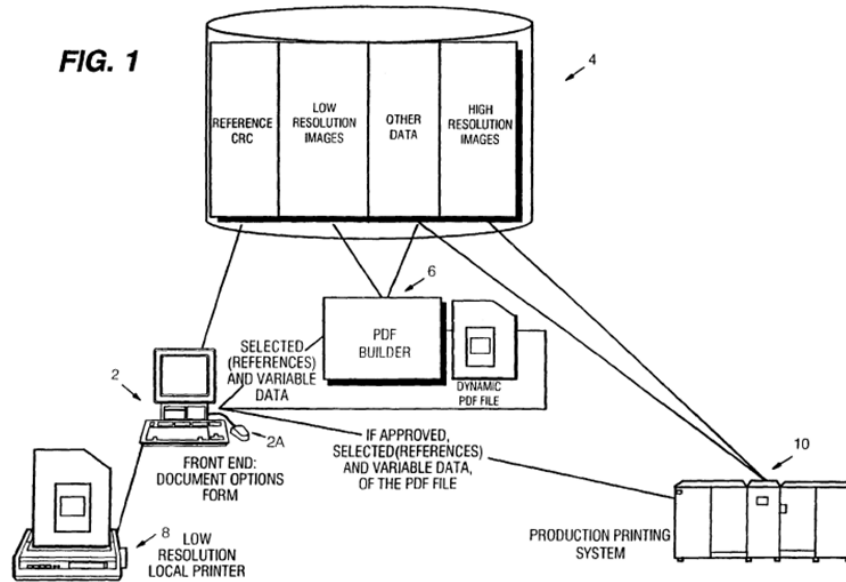


Figure 1 depicts Dorfman’s system comprising front end 2, memory 4, PDF builder 6, and production printing system 10. *Id.* at 5:25–6:7. Front end 2 may be the office of a graphic artist employed by an advertising agency, and typically includes a PC with internet connectivity and browser software. *Id.* at 5:29–6:10. Memory 4, PDF builder 6, and printing system 10 are remotely located from front end 2, e.g., at the facilities of a commercial printing service. *Id.* at 6:4–7. Memory 4 may contain a reference library, low resolution and high resolution images, and other data. *Id.* at 5:27–29. Commercial printer 10 maintains a website that allows front end users access to templates and images stored in memory 4. *Id.* at 6:10–13.

2. *The Parties' Contentions*

Petitioner relies on Dorfman to teach the steps of (1) “storing files on a computer server, the files containing information relating to images, text, art, and data;” (2) “providing said files to a remote client for the designing of a page layout;” and (3) “generating a [PDF] from the designed page layout.” Pet. 45–46 (citing Ex. 1006, 5:27–29, 1:17–20, 7:15–8:5, Fig. 3). Petitioner relies on Apogee to teach “generating a plate-ready file from said PDF file.” *Id.* at 46–47 (citing Ex. 1007, 6–7). For the step of “providing said plate-ready file to a remote printer,” Petitioner relies on the following teaching from Dorfman:

[W]here the commercial printer uses conventional printing technology, the dynamic PDF file generated for proofing is sent to the printing system, and low resolution images used in creating the dynamic PDF file are replaced by high resolution images by, for example, an open pre-press interface (OPI) before printing.

Id. at 46–47 (quoting Ex. 1006, 8:21–26).

In response, Patent Owner argues that claim 10 “requires a separate central service facility and printing company facility,” but Dorfman “merges the central service facility and the printing company facility, which are described as all being present at the same remote location, e.g., the facilities of a commercial printing service.” PO Resp. 40 (citing Ex. 1006, 6:4–7). Patent Owner further argues that “Apogee does not cure this defect.” *Id.*

Petitioner replies that “there is **no** limitation in claims 10–20 reciting a central service facility, let alone a geographically separate central service and printing company.” Pet. Reply 14 (emphasis in original). According to Petitioner “[a]ll [that] claims 10 and 16 require is for the remote printer to

receive a plate-ready file,” which “simply require[s] the printer to be distinct (or ‘remote’) from the components that carry out the other claimed steps.” *Id.* at 15.

3. *Analysis*

As stated above, the step of “providing a plate-ready file to a remote printer” cannot be performed by the remote printer, because the printer cannot be remote with respect to itself. Further, the proposed combination of Dorfman and Apogee suffers from the same deficiency noted above with respect to the Jebens/Apogee combination: there is no evidence that a person of ordinary skill in the art would have had reason to produce the plate-ready file anywhere other than at Dorfman’s production printing system. Therefore, for the reasons discussed above with respect to the Jebens/Apogee combination, we determine that Petitioner has not shown by a preponderance of the evidence that claims 10–13 would have been obvious over Dorfman and Apogee.

E. Claims 14 and 15—Dorfman, Apogee, and Andersson

Claims 14 and 15 depend from claim 10. Petitioner does not rely on Andersson to cure the deficiency noted above with respect to the combination of Dorfman and Apogee. Therefore, for the reasons discussed above, we determine that Petitioner has not shown by a preponderance of the evidence that claims 14 and 15 would have been obvious over Dorfman, Apogee, and Andersson.

F. Claims 16–20—Dorfman, Apogee, Andersson, and OPI White Paper

Petitioner contends that claims 16–20 would have been obvious over Dorfman, Apogee, Andersson, and OPI White Paper (Ex. 1008). Pet. 51–58.

OPI White Paper is relied on primarily for its description of the OPI process. *Id.* at 54–57, and not to cure the deficiencies noted above with respect to the combination of Dorfman and Apogee. Therefore, we determine that Petitioner has not shown by a preponderance of the evidence that claims 16–20 would have been obvious over Dorfman, Apogee, Andersson, and OPI White Paper.

III. CONCLUSION

For the foregoing reasons, we determine that Petitioner has not shown by a preponderance of the evidence that claims 10–20 are unpatentable.

IV. ORDER

For the reasons given, it is

ORDERED that claims 10–20 of the '155 patent have not been shown to be unpatentable.

This is a Final Decision. Parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2014-00788
Patent 6,738,155 B1

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