

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ESSELTE CORP.,
Petitioner,

v.

DYMO,
Patent Owner.

Case IPR2015-00781
Patent 6,890,113 B2

Before DAVID C. MCKONE, BARBARA A. PARVIS, and
JO-ANNE M. KOKOSKI, *Administrative Patent Judges*.

MCKONE, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

A. Background

Esselte Corp., Esselte AB, and Esselte Leitz GMBH & Co. KG (collectively “Petitioner”) filed a Petition (Paper 1, “Pet.”) to institute an *inter partes* review of claim 16 of U.S. Patent No. 6,890,113 B2 (Ex. 1001, “the ’113 patent”). DYMO (“Patent Owner”) filed a Preliminary Response (Paper 9, “Prelim. Resp.”).¹

Upon consideration of the Petition and the Preliminary Response, we are persuaded, under 35 U.S.C. § 314(a), that Petitioner demonstrates a reasonable likelihood that it would prevail in showing the unpatentability of claim 16. Accordingly, we institute an *inter partes* review of claim 16 of the ’113 patent.

B. Related Matter

The ’113 patent has been asserted in *Sanford L.P. (d/b/a/ DYMO), and DYMO B.V.B.A. v. Esselte AB*, No. 1:14-cv-07616-VSB (S.D.N.Y). Pet. 1; Paper 6, 1.

C. References Relied Upon

MICROSOFT PRESS, STEP BY STEP, MICROSOFT OFFICE 2000, SELF-STUDY KIT (1999) (Ex. 1003, “Microsoft Self-Study Kit”);

DYMO CORP., DYMO USER MANUAL (2001) (Ex. 1004, “DYMO User Manual”);

¹ Paper 9, referenced herein, is a redacted version of Paper 10.

ADDRESSMATE SOFTWARE, USER MANUAL FOR ADDRESSMATE AND ADDRESSMATE PLUS (1994–95) (Ex. 1005, “AddressMate User Manual”); U.S. Patent No. 5,621, 864, issued Apr. 15, 1997 (Ex. 1008, “Benade”).

Petitioner also relies on the testimony of Stephen Gray (Ex. 1002, “Gray Decl.”).

D. The Asserted Grounds

Petitioner contends that claim 16 is unpatentable based on the following asserted grounds (Pet. 3–4):

Reference	Basis
AddressMate User Manual (“Printing the Entire Database” functionality)	§ 103(a)
AddressMate User Manual (“Importing/Merge-Printing” functionality)	§ 103(a)
Benade	§ 103(a)
DYMO User Manual	§ 103(a)
Microsoft Self-Study Kit	§ 103(a)

II. PURPORTED DEFECTS UNDER 37 C.F.R. § 42.104(a)

In a 2005 Stock Purchase Agreement (Ex. 2002, “SPA”), Petitioner Esselte AB sold Patent Owner to Newell Rubbermaid Inc. The assets sold included the ’113 patent. Ex. 2002 §§ 1.1, 3.23(a); Ex. 2003, Annex 1, at 19. Patent Owner contends that the Petition should be denied based on the SPA for two reasons. First, Patent Owner argues that the SPA includes a

forum selection clause that contractually bars Petitioner from pursuing relief at the Patent Office. Second, Patent Owner argues that the doctrine of assignor estoppel bars Petitioner from challenging the validity of a patent it sold to Newell Rubbermaid. We address both of these arguments below.

A. Assignor Estoppel

Patent Owner contends that “the doctrine of assignor estoppel [] bars the Petition.” Prelim. Resp. 36. Petitioner contends that the doctrine of assignor estoppel does not apply in an *inter partes* review proceeding. Pet. 2–3 n.1 (citing *Redline Detection LLC v. Star Envirotech, Inc.*, Case IPR2013-00106 (PTAB June 30, 2014) (Paper 66)). Patent Owner asserts that it disagrees with prior Board decisions “on the effect of assignor estoppel on a petitioner’s ability to [] file an IPR petition under Section 311(a).” Prelim. Resp. at 37.

In the *Redline* proceeding, the Board explained that 35 U.S.C. § 311(a) presents “a clear expression of Congress’s broad grant of the ability to challenge the patentability of patents through inter partes review.” *Redline Detection LLC v. Star Envirotech, Inc.*, Case IPR2013-00106, slip op. at 4 (PTAB Oct. 1, 2013) (Paper 40), Slip op. at 4. As Section 311(a) states, “a person who is not the owner of a patent may file with the Office a petition to institute an inter partes review of the patent.”

Patent Owner contends that “setting aside Section 311(a), there are other grounds by which the Board can recognize contractual bars or estoppel.” Prelim. Resp. 37. We recognize that Section 311(a)’s broad mandate is “[s]ubject to the provisions of this chapter.” 35 U.S.C. § 311(a).

The Statute places express limits on our consideration of a petition under Section 311(a). For example, 35 U.S.C. § 312 provides, *inter alia*, that “[a] Petition filed under section 311 may be considered only if . . . the petition identifies all real parties in interest.” As another example, 35 U.S.C. § 315(e) explicitly provides for estoppel in limited, defined circumstances. In contrast, there is no explicit provision in the Statute for assignor estoppel as a defense to a charge of unpatentability.

Patent Owner contends that two statutory provisions, 35 U.S.C. §§ 314 and 316, provide authority for us to consider assignor estoppel. Section 314(a) states:

Threshold.—The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

Patent Owner argues that “Petitioners that are barred by assignor estoppel from challenging the patent’s validity do not have a reasonable likelihood to prevail” because “[a]ssignor estoppel prevents an assignor from asserting that its own patent, for which it may have received value upon assignment, is invalid and worthless.” *Id.* at 37–38 (internal quotation marks omitted).

Patent Owner does not argue persuasively that Section 314(a) should be read so broadly as to authorize implicitly an equitable defense not provided explicitly by the Statute. The Board has said previously, and we agree, that “Congress has demonstrated that it will provide expressly for the application of equitable defenses when it so desires.” *See Redline*, Paper 40,

slip op. at 4 (citing *Intel Corp. v. Int’l Trade Comm’n*, 946 F.2d 821, 836–38 (Fed. Cir. 1991)). In *Intel*, the Federal Circuit upheld the International Trade Commission’s application of assignor estoppel, endorsing the Commission’s reasoning that its statute explicitly stated that “[a]ll legal and equitable defenses may be presented in all [section 337] cases.” 946 F.2d at 837 (quoting 19 U.S.C. § 1337(c)(1988)). Patent Owner points to no such statutory mandate here. *Cf. In re Harvey, Inter Partes Reexamination Control No. 95/000,155, Decision Dismissing Petition to Vacate* (Mar. 8, 2007), slip op. at 6–7 (determining that, in an *inter partes* reexamination, 35 U.S.C. § 311(a)² provided a broad statutory mandate that any third-party requester may file a request for *inter partes* reexamination and that Congress did not make provision for assignor estoppel in the statute). Accordingly, Patent Owner has not persuaded us that Section 314(a) provides a defense of assignor estoppel.

We also are not persuaded that Section 316 provides grounds for considering a defense of assignor estoppel. Section 316(a)(2) provides that the Director shall prescribe regulations, including “the standards for the showing of sufficient grounds to institute a review under section 314(a).” Section 316, however, does not provide explicitly for a defense of assignor estoppel. Patent Owner, citing Section 316(b), argues that the impact on the economy, the integrity of the patent system, and the Office’s efficient and timely administration of its proceedings are reasons we should apply

² The pre-AIA version of 35 U.S.C. § 311, governing *inter partes* reexamination.

assignor estoppel in *inter partes* review proceedings. Prelim. Resp. 38–40. Nevertheless, Patent Owner does not cite to any regulation prescribed by the Director that purports to authorize its defense of assignor estoppel.

Accordingly, Patent Owner has not shown that assignor estoppel is a defense that applies in *inter partes* review proceedings.

B. Contractual Bar

Patent Owner contends that the Petition is barred by a forum selection clause that requires that any action relating to the SPA be brought in a federal court sitting in the State of New York. Prelim. Resp. 34–35. Patent Owner includes the alleged contractual bar in its discussion of the applicability of Sections 314(a) and 316 to assignor estoppel, although these arguments predominantly are directed to assignor estoppel. *Id.* at 37–41. We reject Patent Owner’s contractual bar argument for the same reasons given above for assignor estoppel.

III. ANALYSIS

A. The ’113 Patent

The ’113 patent describes a mode of operation for a tape printer in which the printer automatically generates a plurality of labels. Ex. 1001, 4:46–48. The data for generating the labels is generally plain ASCII text and includes information such as lists of names and addresses and lists of articles to be labelled. *Id.* at 4:49–53. Information can be delimited using commas, separate lines, and blank spaces. The ’113 patent gives the

following example of a data file with data for three labels, delineated as separate lines, with fields within each line delineated by commas:

Pencils, US \$100
Pens, US \$0.50 each
Erasers, US \$1

Id. at 4:55–65.

Figure 5, reproduced below, illustrates an example of generating labels based on such data:

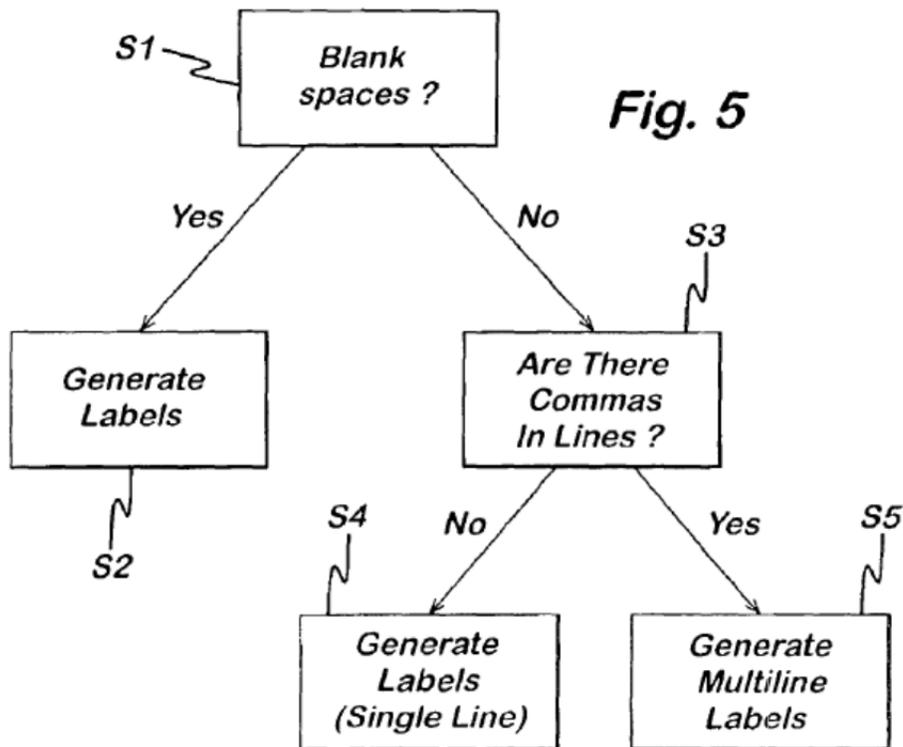


Figure 5 is a flow diagram of a method of generating labels from data files.

Id. at 2:35–36, 6:5–8.

In step S1, a processor (of the printer or an attached computer) determines if the data file has blank lines in it. If so, each label will consist

of the data between two blank lines and labels will be generated accordingly (step S2). *Id.* at 6:8–15. If the data file does not include blank lines, the processor, at step S3, determines whether there are commas in each line of the data. If not, each line of data represents a single-line label and labels will be generated accordingly (step S4). *Id.* at 6:16–20. If each line includes commas, then each line represents a single label, and the number of commas in a line of data determines how many lines will be printed for a particular label (e.g., a line of data that includes one comma will result in a label with two lines, with the comma specifying where the second line starts). Multiline labels will be generated accordingly (step S5). *Id.* at 6:21–27. For example, the first line of the data file shown above would result in the following label:

Pencils
US \$1.00

Id. at 5:5–7.

Claim 16, reproduced below, is the sole claim challenged in the Petition:

16. A tape printing method for printing an image on an image receiving tape comprising the steps of:
 - receiving data containing information for a plurality of individual labels;
 - processing said data to identify a plurality of individual label data fields to be printed on said plurality of individual labels;
 - generating a plurality of individual labels from the identified data; and
 - printing said plurality of individual labels.

B. Claim Construction

We interpret claims of an unexpired patent using the broadest reasonable construction in light of the specification of the patent in which they appear. *See* 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Techs., LLC*, No. 2014-1301, 2015 WL 4097949, at *6 (Fed. Cir. July 8, 2015). Claim terms generally are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

Claim 16 recites “processing said data to identify a plurality of individual label data fields.” Neither party proposes an express construction of this term. Nevertheless, Patent Owner distinguishes the cited prior art based on an implicit construction of this term. For example, Patent Owner argues that “[t]he claimed method is distinguished from the prior art at least in part by the automatic—as opposed to manual—identification of label data fields in the data, for example, based on certain indicators such as commas and blank lines.” Prelim. Resp. 8. In distinguishing AddressMate from claim 16, Patent Owner argues “the Importing/Merge-Printing functionality fails to demonstrate the ‘processing’ claim term, requiring automatic label data field identification.” *Id.* at 28. Likewise, in distinguishing Benade from claim 16, Patent Owner argues that “the ‘processing’ term in claim 16 requires an automatic identification of the label data fields contained in the data source.” *Id.* at 15. Thus, Patent Owner is interpreting “processing said data to identify a plurality of individual label data fields” to require

“automatic” identification of label fields. Patent Owner does not explain, however, what it means by “automatic” identification. At most, Patent Owner notes that, according to the Specification, “the software may be configured to automatically identify a comma or a blank line as signifying a new label.” *Id.* at 16. Patent Owner does not contend that this is a limiting example.

“Processing” is a broad and generic term used in numerous patents and publications dealing with computers, electronics, and software. For example, one technical dictionary defines “data processing” to mean “[t]he systematic performance of operations upon data, such as data manipulation, merging, sorting, and computing.” IEEE 100, THE AUTHORITATIVE DICTIONARY OF IEEE STANDARDS TERMS 272 (7th ed. 2000); *see also id.* at 85 (“processing *See*: multiprocessing; parallel processing; data processing; information processing.”) (Ex. 3001). Thus, the ordinary meaning of “processing” includes various operations, such as sorting, manipulating, merging, and computing.

Patent Owner does not point to any description in the Specification that would weigh in favor of its reading of claim 16. Indeed, the Specification describes controlling a tape printer to “automatically generate labels from a data file,” but does not describe the processing to include automatic identification or determination of label fields. The Specification provides examples of identifying where labels, and individual lines within the labels, start and stop, based on spaces and characters (e.g., commas) contained in the text of data within a data file. *See, e.g.*, Ex. 1001, 4:56–6:4. There is no indication, however, that this identification must be “automatic,”

nor is there any indication that the examples are intended to be exclusive. As to the term “processing,” the Specification simply states that “[t]he processing of the data file is done in the microprocessor of the tape printer, in the case of the stand-alone tape printer, or the processor of the processor board 204, in the case of the PC controlled tape printer.” *Id.* at 6:46–49. Thus, the Specification uses “processing” in accordance with its ordinary meaning, and does not limit the term to “automatic” identification of fields.

Patent Owner supports its position with declaration testimony of named inventor David Block, submitted on behalf of Petitioner in the co-pending district court litigation. Prelim. Resp. 8–9 (citing Ex. 2008 ¶¶ 25–27), 14 (same), 29 (same). Mr. Block testified that “[t]he inventive concept, as I saw it, was the automatic determination by the software of the different formats in the clipboard. This concept was ultimately embodied in [the ’113 patent] of which I am the named inventor.” Ex. 2008 ¶ 26. According to Mr. Block, one of his ideas was an “intelligent clipboard,” in which software “would be able to automatically and ‘intelligently’ recognize that the incoming pasted text represented multiple, different bales and would generate labels from that data.” *Id.* ¶ 25.

Inventor testimony on claim construction in this case is of limited value. As the Federal Circuit has counseled:

In particular, we have explained that “[t]he subjective intent of the inventor when he used a particular term is of little or no probative weight in determining the scope of a claim.”

Whether an inventor’s testimony is consistent with a broader or narrower claim scope, that testimony is still limited by the fact that an inventor understands the invention but may

not understand the claims, which are typically drafted by the attorney prosecuting the patent application. As we have explained, “it is not unusual for there to be a significant difference between what an inventor thinks his patented invention is and what the ultimate scope of the claims is after allowance by the PTO.”

Howmedica Osteonics Corp. v. Wright Med. Tech., Inc., 540 F.3d 1337, 1346–47 (Fed. Cir. 2008) (quoting *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 983 (Fed. Cir. 1995) (en banc)). In this proceeding, there is no indication that Mr. Block’s testimony is directed to the limitations recited in claim 16. Rather, Mr. Block refers to “intelligent” determination of “different formats.” Ex. 2008 ¶26. Claim 16 is not directed to the determination of the formats of received data. Rather, claim 16 simply recites “processing” to “identify a plurality of individual label data fields.” Patent Owner does not explain persuasively how testimony regarding the intelligent determination of the format of data pertains to processing data to identify individual label data fields. Thus, Mr. Block’s testimony is entitled to little weight.

In sum, Patent Owner has not introduced persuasive evidence or argument that “processing said data to identify a plurality of individual label data fields” should be construed to require automatic identification of label data fields. On this record, we give this term its ordinary meaning and decline to construe it further.

C. Obviousness over AddressMate User Manual

Petitioner contends that claim 16 would have been obvious over AddressMate User Manual. Petitioner supports its contentions with the testimony of Mr. Gray.

1. Overview of AddressMate User Manual

AddressMate User Manual is a user manual for using AddressMate Plus for Windows, address management software that integrates with word processing software such as Microsoft Word. Ex. 1005, 1-1. Using AddressMate Plus, a user can import names and addresses from a database or ASCII file and merge-print the names and addresses onto envelopes and labels. *Id.* at 1-2.

Petitioner focuses on two features described in AddressMate User Manual and argues that each provides a basis for obviousness. First, AddressMate User Manual describes a feature in which a user designs or opens a template, selects a number of names and addresses from a database, and uses a series of dialog boxes to cause the names and addresses to be merged with the template for printing onto envelopes or labels. *Id.* at 7-90–7-92. According to AddressMate User Manual, a user can “selectively pick names from the database and print their address information” or “can easily print all the addresses in the database.” *Id.* at 7-91. As to printing all the addresses in the database, AddressMate User Manual describes a “Print All Records command” that can be used to do so, with the result that “[a]ll the addresses in the database are merged with the current template, producing

the envelopes or labels you want.” *Id.* at 8-122–8-123. Petitioner refers to this feature as the “printing the entire database” functionality. Pet. 6–9.

AddressMate User Manual also describes a feature in which addresses can be imported from other databases or comma-delimited files and merge-printed. Ex. 1005, 9-126–9-128. In the case of a comma-delimited file, the user uses a dialog box to map the fields of the comma-delimited file to the fields defined in the AddressMate Plus database so that they can be matched properly with fields of a template into which the addresses can be merged for printing. *Id.* at 9-128–9-131. Petitioner refers to this feature as the “importing/merge-printing” functionality.

2. *Claim 16*

Petitioner contends that AddressMate User Manual would have rendered obvious a tape printing method for printing an image on an image receiving tape. Specifically, Petitioner argues that AddressMate User Manual lists several products supported by the AddressMate Plus software, including image receiving tape printers, and that AddressMate Plus was packaged with CoStar label tape printers. Pet. 9, 23. Thus, Petitioner argues, it would have been obvious, in light of AddressMate User Manual’s disclosure, to use the AddressMate Plus software discussed in AddressMate User Manual with a label tape printer. *Id.* at 9, 23. Patent Owner does not challenge this argument. On this record, Petitioner has articulated a reason, with rational underpinning, to use AddressMate User Manual’s teaching in the context of a tape printing method.

As explained above, Petitioner refers to two features of AddressMate User Manual as providing independent grounds for rendering the remaining limitations of claim 16 obvious.

First, Petitioner argues that AddressMate User Manual's description of the "printing the entire database" functionality teaches receiving data (from the database) containing information for a plurality of individual labels and processing that data to identify a plurality of individual label data fields to be printed on a plurality of individual labels. Pet. 7–13. Petitioner cites AddressMate User Manual's description of using a print dialog box to merge the addresses in the database with an existing label template as a description of generating and printing a plurality of individual labels from the identified data. *Id.* at 13. For the reasons given in the Petition, based on the current record, we agree that AddressMate User Manual teaches the "receiving," "generating," and "printing" limitations of claim 16.

Patent Owner responds that the "printing the entire database" feature does not teach processing said data to identify a plurality of individual label data fields. According to Patent Owner, the data processed in claim 16's "processing" step, by virtue of its antecedent basis, is the data received in the receiving step. Prelim. Resp. 12. Because the data to be merged from the database "is already identified in each separate database field," Patent Owner argues, the data would not need to be processed into individual label data fields. *Id.* at 13. As explained in Section III.B above, Patent Owner relies on a declaration of named inventor David Block to argue that claim 16's "processing" step requires "automatic" or "intelligent" identification of individual label data fields.

Mr. Block also testifies that he founded AddressMate Software and worked on AddressMate products, including AddressMate Plus. Ex. 2008 ¶¶ 2, 7. Patent Owner contends that Mr. Block admitted that AddressMate’s software was incapable of automatically and intelligently recognizing that incoming pasted text represented multiple, different labels and that AddressMate User Manual does not teach the “processing” limitation of claim 16. Prelim. Resp. 14 (citing Ex. 2008 ¶¶ 1–3, 25–27). We disagree with Patent Owner’s characterization of Mr. Block’s testimony. Rather, with respect to AddressMate’s software, Mr. Block testifies that AddressMate software permitted importing contacts or addresses from different applications, but the ’113 patent did not permit importing contacts or address books from different applications. Ex. 2008 ¶ 27. Patent Owner has not explained persuasively how this testimony relates to claim 16’s “processing” limitation. In any case, as explained in Section III.B above, the “processing” limitation does not require “automatic” or “intelligent” identification of a plurality of individual label data fields.

Second, Petitioner contends that AddressMate User Manual’s description of “importing/merge-printing” functionality teaches the “receiving” and “processing” limitations of claim 16. Pet. 23–27. Similar to its contentions for the “printing the entire database” feature, Petitioner cites to a description of merging data with a template and printing addresses to show the “generating” and “printing” limitations of claim 16. *Id.* at 27–29.

In response, Patent Owner argues that the “importing/merge-printing” feature does not teach the “processing” limitation of claim 16 because a user must first manually associate fields in the received data to corresponding

fields in the AddressMate Plus database before the data can be merged to a template. Prelim. Resp. 27–28. Once again citing to Mr. Block’s testimony, Patent Owner argues that the “importing/merge-printing” feature does not teach the “processing” limitation of claim 16 because it does not automatically or intelligently identify individual label data fields. *Id.* at 28–29 (citing Ex. 2008, 1–3, 25–27).

In the “printing the entire database” feature described in AddressMate User Manual, the beginnings and endings of label fields are identified based on the information supplied by a database. Ex. 1005, 8-122–8-123. In the “importing/merge-printing” feature, the beginnings and endings of labels, and lines within the labels, are determined by analyzing characters (e.g., commas) within the text of a received file, similar to the preferred embodiment of the ’113 patent. *Id.* at 9-129–9-130. Patent Owner does not persuasively explain why an initial manual mapping of the fields in the incoming data to the fields recognized by AddressMate Plus takes this example outside of “processing.” Claim 16 does not require (and the Specification does not describe) automatically associating incoming information with categories (e.g., identifying a name as a name). Rather, claim 16 requires identifying a plurality of individual label data fields. Likewise, the Specification describes identifying those fields by recognizing their beginnings and ends, as indicated by delimiting characters (e.g., commas), just as described in AddressMate User Manual.

On this record, we are persuaded that AddressMate User Manual’s description of software that receives address data from a fielded database (as in the “printing the entire database” example) or comma-delimited file (as in

the “importing/merge-printing” example), and identifies positions of a template into which the data is to be inserted, is a teaching of manipulating or sorting received data to identify a plurality of individual label data fields. Accordingly, we are persuaded that AddressMate User Manual teaches the “processing” limitation of claim 16.

On this record, Petitioner has demonstrated a reasonable likelihood that it would prevail in showing that claim 16 would have been obvious over AddressMate User Manual.

D. Obviousness over Benade

Petitioner contends that claim 16 would have been obvious over Benade. Petitioner supports its contentions with the testimony of Mr. Gray.

1. Overview of Benade

Benade describes a label printing apparatus that allows a user to design and use label templates. Ex. 1008, Abstract. Figure 1, reproduced below, illustrates an example.

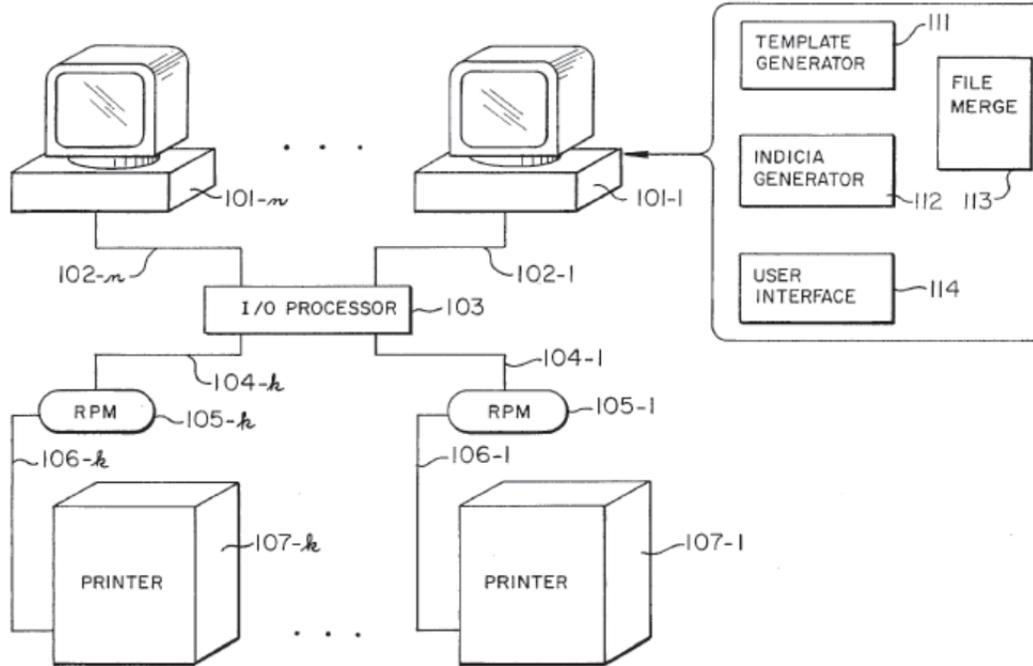


FIG. 1.

Figure 1 is a block diagram of the architecture of a label generation apparatus. *Id.* at 3:20–21.

The architecture includes a plurality of processors 101-1–101-n (e.g., personal computers) interconnected by busses 102-1–102-n to input/output (I/O) processor 103. *Id.* at 4:56–63. I/O processor 103 receives data files from the processors and sends the files to raster processing machines 105-1–105-k over output bus leads 104-1–104-k. *Id.* at 4:63–5:7. The raster processing machines convert the data files into formats usable by associated printers 107-1–107-k. *Id.* at 5:7–10.

Control routines 111–114 are loaded in each of the processors. *Id.* at 6:35–37. User interface 114 is a routine to interface with the label generation apparatus in a user friendly fashion with a keyboard and display.

Id. at 6:39–43. Template generator 111 produces definitions of fields of a label. *Id.* at 6:49–50. Indicia generator 112 defines and generates the indicia that are produced for the fields in the labels defined by template generator 111. *Id.* at 7:63–65. The indicia can include bar codes, alphanumeric codes, and color codes. *Id.* at 8:16–18. Once the parameters are input to indicia generator 112, indicia generator 112 generates a series of labels to be printed. *Id.* at 8:36–40. File merge routine 113 combines the template generated by template generator 111 and the indicia information generated by indicia generator 112 into an object file that contains all of the data necessary to define all of the labels in the series to be printed. *Id.* at 8:50–56.

In one example, labels are printed for files when a company takes on a new employee. *Id.* at 16:6–11. In this case, separate labels are printed for a payroll file, a department file, and a medical file. *Id.* at 16:11–13. According to the procedure outlined in Benade, the user is queried for input data, such as employee name, social security number, date of birth, pay grade, type of labels, etc. *Id.* at 19:49–52. The data can be input via a database, such as the database shown in Figure 13. *Id.* at 16:16–17. Indicia generator 112 automatically generates an ordered sequence of indicia. *Id.* at 19:52–54. A template is generated for each label. *Id.* at 19:57–62. Labels are produced by combining the indicia and template fields. *Id.* at 20:13–15. The label data is transmitted to the printer apparatus for printing. *Id.* at 20:15–17. Figures 17–19 depict example payroll, department, and medical file labels, respectively. *Id.* at 19:62–20:13.

2. Claim 16

Petitioner contends that Benade teaches a tape printing method, as recited in claim 16, pointing to Benade’s description of a technique used with various types of printers to print labels. Pet. 14–16. Petitioner argues Benade’s description of indicia generator 112 receiving input data from a database is a teaching of receiving data containing information for a plurality of individual labels. *Id.* at 14, 16–17. Petitioner further contends that Benade’s description of indicia generator 112 automatically generating an ordered sequence of indicia for a series of labels is a teaching of processing said data to identify a plurality of individual label data fields. *Id.* at 17–18. Petitioner also argues that Benade’s description of file merge routine 113 combining templates generated by template generator 111 with indicia generated by indicia generator 112 is a teaching of generating a plurality of individual labels from the identified data. *Id.* at 18–19. Finally, Petitioner argues that Benade teaches printing the labels generated by file merge routine 113. *Id.* at 19. For the reasons given in the Petition, based on the current record, we agree that Benade teaches the “receiving,” “generating” and “printing” limitations of claim 16.

Patent Owner argues that Benade does not teach the “processing” limitation of claim 16. Specifically, Patent Owner argues that Benade does not teach “automatic identification” of label data fields. Prelim. Resp. 16. Patent Owner contends that Benade’s description of “automatic *generation*” of an ordered sequence of indicia does not constitute a teaching of “automatic *identification*” of label data fields. *Id.* at 16–17. According to Patent Owner, “[t]o the extent Benade teaches any automation, that

disclosure in Benade pertains to the generating the sequence of writable indicia fields, not the identification of label data fields in an existing data set.” *Id.* at 17.

On this record, we are persuaded that data is manipulated or sorted by indicia generator 112 when it receives data and automatically generates a series of indicia. In order for indicia generator 112 to generate a series of indicia usable for merging and printing, it must identify the fields. *See* Ex. 1002 ¶ 71. Thus, we are persuaded that Benade teaches the “processing” step of claim 16. We note that, although Patent Owner does not explain what it means by “automatic” identification of label data fields, Benade explicitly describes the indicia generator 112 as “automatically” generating an ordered sequence of indicia. Ex. 1008, 19:52–54.

On this record, Petitioner has demonstrated a reasonable likelihood that it would prevail in showing that claim 16 would have been obvious over Benade.

E. Obviousness over DYMO User Manual

Petitioner contends that claim 16 would have been obvious over DYMO User Manual. Petitioner supports its contentions with the testimony of Mr. Gray.

1. Overview of DYMO User Manual

DYMO User Manual is a user manual for use of software for the DYMO LabelWriter product, which is a label printer. Ex. 1004, 1.³ DYMO User Manual describes a feature in which a user, using a menu and dialog box, can open an existing label file and edit the file. *Id.* at 15.

2. Claim 16

Claim 16 recites receiving data for “a plurality of individual labels,” processing the data for “said plurality of individual labels,” and generating and printing a “plurality of individual labels.”

Regarding “generating a plurality of individual labels from the identified data,” Petitioner contends that DYMO User Manual teaches “upon opening an existing label file, ‘the label[s] open[] in the new window.’” Pet. 22 (quoting Ex. 1004, 15 (brackets supplied by Petitioner)). As Patent Owner points out (Prelim. Resp. 21–22), this is a misrepresentation of DYMO User Manual. DYMO User Manual actually states, in the context of opening “an existing label file,” “[t]he label opens in the window.” Ex. 1004, 15. Petitioner does not justify adequately why it altered DYMO User Manual’s description to change the singular to the plural. Petitioner offers the testimony of Mr. Gray, who states, without significant explanation, that DYMO User Manual’s disclosure “means that the system

³ We refer to the page numbers of the document itself, above the exhibit number, rather than the numbering provided by Petitioner below the exhibit number.

described in the manual generates labels from the data identified in the data source.” Ex. 1002 ¶¶ 89–90. This evidence is conclusory and unpersuasive.

In sum, Petitioner has not shown that DYMO User Manual teaches “generating a plurality of individual labels from the identified data,” as recited in claim 16. Accordingly, Petitioner has not demonstrated a reasonable likelihood that it would prevail in showing that claim 16 would have been obvious over DYMO User Manual.

F. Obviousness over Microsoft Self-Study Kit

Petitioner contends that claim 16 would have been obvious over Microsoft Self-Study Kit. Petitioner, however, has not identified any manner in which Microsoft Self-Study Kit more clearly teaches any particular limitation of claim 16 as compared to AddressMate User Manual or Benade. Accordingly, we exercise our discretion and determine that this ground of unpatentability is redundant to the ground of unpatentability on which we initiate *inter partes* review, and, accordingly, we do not authorize *inter partes* review on the ground of obviousness over Microsoft Self-Study Kit. See 37 C.F.R. § 42.108(a); *Liberty Mutual Ins. Co. v. Progressive Casualty Ins. Co.*, Case CBM2012-00003, slip op. at 2–3 (PTAB Oct. 25, 2012) (Paper 7).

IV. CONCLUSION

We institute an *inter partes* review of claim 16. We have not yet made a final determination of the patentability of this claim or the construction of any claim term.

V. ORDER

For the reasons given, it is

ORDERED that *inter partes* review is instituted on the following grounds:

(1) Claim 16, under 35 U.S.C. § 103(a), as obvious over AddressMate; and

(2) Claim 16, under 35 U.S.C. § 103(a), as obvious over Benade;
FURTHER ORDERED that the trial is limited to the grounds identified above, and no other ground is authorized; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review of U.S. Patent No. 6,890,113 B2 is hereby instituted commencing on the entry date of this Order, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial.

IPR2015-00781
Patent 6,890,113 B2

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