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Paper 50
Entered: July 17, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PRIMERA TECHNOLOGY, INC.,
Petitioner,

v.

AUTOMATIC MANUFACTURING SYSTEMS, INC.,
D/B/A ACCUPLACE,
Patent Owner.

Case IPR2013-00196
Patent 8,013,884 B2

Before JOSIAH C. COCKS, JUSTIN T. ARBES, and MIRIAM L. QUINN, *Administrative Patent Judges.*

QUINN, *Administrative Patent Judge*.

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

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I. BACKGROUND

Primera Technology, Inc. ("Petitioner") requested *inter partes* review of claims 1-20 of U.S. Patent No. 8,013,884 B2 ("the '884 patent") pursuant to 35 U.S.C. §§ 311-319. Paper 6 ("Pet."). We granted the Petition and instituted trial for all asserted claims. Paper 19 ("Dec. on Inst."). Although Petitioner proposed six grounds of unpatentability, we instituted trial on three grounds:

a) obviousness of claims 1-5, 7, 8, 10-15, 17, 18, and 20 over Hodai[1] and Levine;[2]

b) obviousness of claims 6 and 16 over Hodai, Levine, and Geddes;[3] and

c) obviousness of claims 9 and 19 over Hodai, Levine, and Bouchard.[4]

During trial, Automatic Manufacturing Systems, Inc., d/b/a Accuplace ("Patent Owner"), filed a Patent Owner Response ("PO Resp.") addressing the three obviousness grounds and relying on the declaration of Dr. Charles DeBoer (Exhibit 2001). Paper 27. Petitioner filed a Reply to Patent Owner's Response ("Pet. Reply") relying primarily on additional prior art references and on Petitioner's cross-examination of Dr. DeBoer (Exhibit 1018). Paper 30.

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[1] JP Patent Pub. No. 2003-312063 ("Hodai") (Ex. 1003). Here we refer to the English translation (Ex. 1003) of the original reference (Ex. 1002). Petitioner has provided an affidavit attesting to the accuracy of the translation. *See* Ex. 1003; 37 C.F.R. § 42.63(b).

[2] U.S. Patent No. 5,676,910 ("Levine") (Ex. 1004).

[3] U.S. Patent No. 6,629,792 B2 ("Geddes") (Ex. 1005).

[4] U.S. Patent App. Pub. No. 2005/0219344 A1 ("Bouchard") (Ex. 1006).

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Both parties filed Motions to Exclude. In particular, Petitioner filed a motion seeking exclusion of Dr. DeBoer's testimony. Paper 36. Patent Owner's motion seeks to exclude the additional prior art references on which Petitioner relies in its Reply. Paper 43.

An oral hearing was held on April 28, 2014, and a transcript of the hearing is included in the record (Paper 49) ("Tr.").

We have jurisdiction under 35 U.S.C. § 6(c). This final written decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

For the reasons that follow, we determine that Petitioner has met its burden to prove by a preponderance of the evidence that claims 1-20 of the '884 patent are unpatentable.

A. THE '884 PATENT (EXHIBIT 1001)

The '884 patent[5] relates to "the attachment of information to objects," and more specifically to "attaching medical information to glass surfaces such [as] glass slides during the processing of these slides." Ex. 1001, col. 1, ll. 15-20. The patent describes the problem in the prior art of the potential error in matching patient information to a specimen slide. *Id.* at col. 1, ll. 21-48. One solution for preventing the error is to attach the patient

[5] The '884 patent, titled "Device and Method for Printing Information on Glass Surfaces," issued on September 6, 2011, based on Application 12/147,407, filed on June 26, 2008, which claims priority to Provisional Application 61/035,016, filed on March 9, 2008. On September 6, 2013, Patent Owner filed Application 14/020,322 for reissue of the '884 patent, seeking to add an additional claim 21 to the patent. The reissue application is pending.

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information at the time the specimen is placed on the slide. *Id.* at col. 1, ll. 49-51. The patent describes that at the time of the invention there were various known ways of marking specimen slides: printing labels and attaching them by hand or machine, printing on the slide with ink jet printers, and marking the slide with laser beams or diamond scribing. *Id.* at col. 1, ll. 60-65. According to the patent, however, these machines were large, complex, expensive, and costly to operate (*id.* at col. 1, l. 65 – col. 2, l. 3), provided no ability to verify the correctness of the information marked on the slide (*id.* at col. 2, ll. 9-15), were hazardous to operate (*id.* at col. 2, ll. 22-23), or produced dust byproduct (*id.* at col. 2, ll. 21-22). The '884 patent identifies a need for an "economical method that very accurately matches and places patient information on patient specimen slides, which provides these features with a maximum of flexibility for use in a diagnostic laboratory." *Id.* at col. 2, ll. 24-27.

In the summary of the invention, the patent describes the printing device as a device that prints medical information onto slides that are stored in a slide storage section, where the printing is performed with ink media tape and a print head to transfer the medical information onto the surface of the slide. *Id.* at col. 2, ll. 34-44. Reproduced below is an annotated Figure 2 of the '884 patent showing a front side perspective view of a printing device of a preferred embodiment of the invention and highlighting ink tape roll 170 and tape 180. *See* Ex. 1001, col. 3, ll. 39-41.

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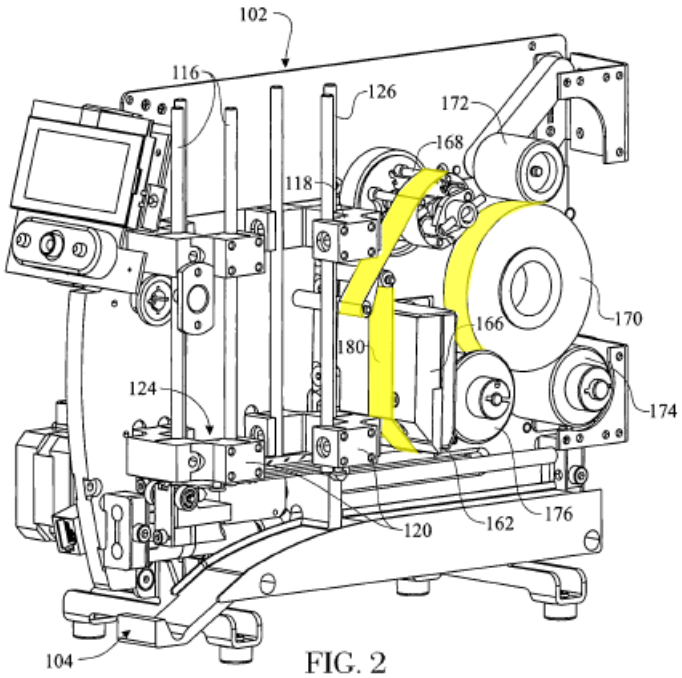

FIG. 2

As shown in Figure 2, the printing device includes slide storage section 102 for loading a plurality of slides and a printing section that includes print head assembly 166 with print head 162, take-up reel 168, ink tape roll 170, tension roller 172, driven roller 174, and support roller 176. *Id.* at col. 6, ll. 55-60. During printing, a slide carrier is "moved to the left incrementally, per print row, while in contact with the tape 180." *Id.* at col. 6, ll. 63-65. "This action draws the tape from the print rol[l] 170, such that an unprinted section of the tape 180 is interposed between the next print row beneath the print head 162." *Id.* at col. 6, ll. 65-67.

After printing the last row on the slide, "the print head and slide move to a non-contact position, and the slide transport moves the carrier with the completed slide to an output section." *Id.* at col. 2, ll. 51-54; *see also id.* at col. 6, ll. 16-18 (describing that a slide shuttles moves to the right to eject

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