

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ULTRATEC, INC.,
Petitioner,

v.

CAPTIONCALL, L.L.C.,
Patent Owner.

Case IPR2013-00288
Patent 8,379,801 B2

Before KEVIN F. TURNER, JONI Y. CHANG, and
MICHAEL R. ZECHER, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner, Ultratec, Inc. (“Ultratec”), filed a Petition requesting an *inter partes* review of claims 1–29 of U.S. Patent No. 8,379,801 B2 (Ex. 1001, “the ’801 patent”). Paper 2 (“Pet.”). Patent Owner, CaptionCall, L.L.C.¹ (“CaptionCall”), did not file a Preliminary Response. Upon reviewing the information presented in the Petition, the Board determined that there was a reasonable likelihood that Ultratec would prevail in challenging claims 1–29 as unpatentable under 35 U.S.C. §§ 102(b) and 103(a). Pursuant to 35 U.S.C. § 314, the Board instituted this proceeding on November 13, 2013, as to these claims of the ’801 patent. Paper 14 (“Dec.”).

During this proceeding, CaptionCall timely filed a Patent Owner Response (Paper 24, “PO Resp.”), and Ultratec timely filed a Reply to the Patent Owner Response (Paper 34, “Pet. Reply”). Shortly before an oral hearing was held on July 10, 2014 (Paper 62),² CaptionCall filed a notice indicating that it disclaimed claims 1, 2, 7, and 9 of the ’801 patent (Paper 52; Ex. 2007). As a result, the patentability of claims 1, 2, 7, and 9 will not be addressed further herein.

We have jurisdiction under 35 U.S.C. § 6(c). This decision is a final written decision under 35 U.S.C. § 318(a) as to the patentability of claims 3–6, 8, and 10–29 of the ’801 patent. Based on the record before us,

¹ On July 15, 2013, Patent Owner filed an updated mandatory notice indicating that Sorenson Communications, Inc., assigned its interest in the ’801 patent to CaptionCall, L.L.C. Paper 13, 1.

² Paper 62 is a transcript of the oral hearing.

Ultratec has demonstrated by a preponderance of the evidence that these claims are unpatentable.

A. The '801 Patent

The '801 patent generally relates to correcting errors within a text caption system used to facilitate hearing-impaired communication. Ex. 1001, 1:6–8. Figure 1 of the '801 patent, reproduced below, illustrates hearing-impaired communication system 100. *Id.* at 2:45–47, 3:38–41.

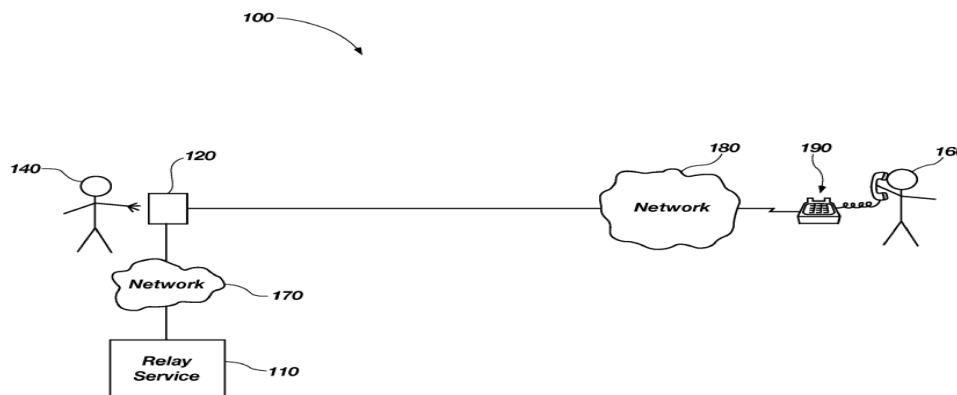


FIG. 1

As shown in Figure 1 of the '801 patent, communication system 100 includes communication device 120, communication device 190, and relay service 110. Ex. 1001, 3:41–43. Communication device 190 is coupled to communication device 120 via network 180, and communication device 120 is coupled to relay service 110 via network 170. *Id.* at 3:43–46. Relay service 110 may be configured to provide interpretative services to hearing-impaired user 140. *Id.* at 3:60–62. For instance, a human “call assistant” located at relay service 110 may facilitate a communication session between hearing-impaired user 140 and hearing-capable user 160. *Id.* at 3:62–65.

Communication device 190 may include a conventional telephone that hearing-capable user 160 uses to interact with communication device 120. Ex. 1001, 3:65–4:3. The voice of hearing-capable user 160 may be

transmitted through communication device 190 over network 180 to communication device 120, which, in turn, conveys the voice over network 170 to relay service 110. *Id.* at 4:3–8. Communication device 120 may include a captioned telephone, i.e., a telephone or any suitable communication device capable of receiving and displaying text messages. *Id.* at 4:9–12. As such, communication device 120 may be configured to receive and display text messages of the voice communication sent from relay service 110 via network 170. Ex. 1001, 4:15–19. In response, the voice of hearing-impaired user 140 may be transmitted through communication device 120 over network 180 to communication device 190. *Id.* at 4:12–15.

Figure 6 of the '801 patent, reproduced below, illustrates method 600 for correcting one or more textual errors within a text caption. Ex. 1001, 2:56–58; 6:54–57.

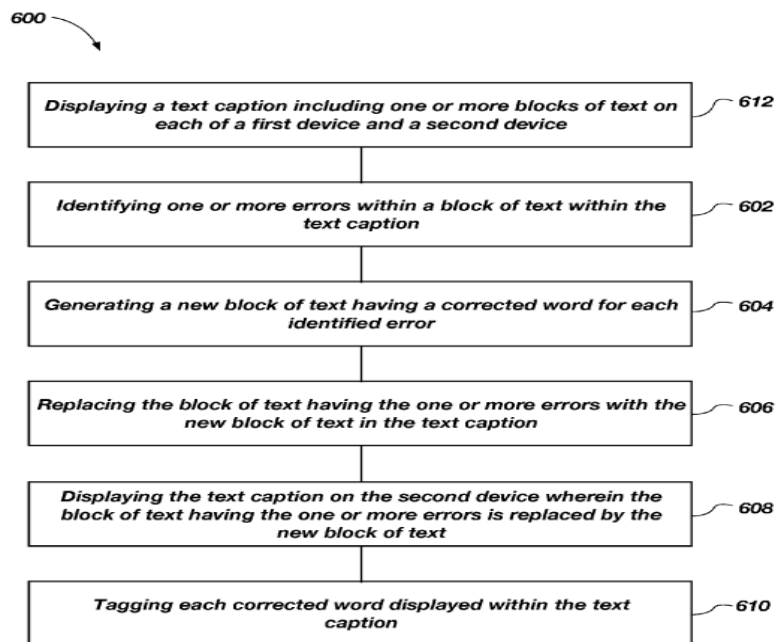


FIG. 6

As shown in Figure 6 of the '801 patent, step 612 includes displaying a text caption made up of one or more blocks of text on a first device, e.g., a device located at relay service 110, and a second device, e.g., communication device 120. Ex. 1001, 6:57–59. Step 602 includes identifying one or more errors within a block of text within the text caption. *Id.* at 6:59–61. Step 604 includes generating a new block of text that corrects the word associated with each identified error. *Id.* at 6:61–62. Step 606 includes replacing the block of text having one or more errors with the new block of text that corrects the word(s) associated with each identified error. Ex. 1001, 6:62–64. Step 608 includes displaying the new block of text in the text caption on the second device. *Id.* at 6:65–67. Finally, step 610 includes tagging each corrected word displayed within the text caption. *Id.* at 6:67–7:2.

B. Illustrative Claim

Of the challenged claims remaining in this proceeding, claims 14, 17, 25, and 29 are independent claims. Claims 3–6 and 8 directly or indirectly depend from independent claim 1, claims 10–13 directly depend from independent claim 9, claims 15 and 16 directly or indirectly depend from independent claim 14, claims 18–24 directly or indirectly depend from independent claim 17, and claims 26–28 directly depend from independent claim 25. Independent claim 14 is illustrative of the '801 patent and is reproduced below:

14. A computer-readable media storage medium storing instructions that when executed by a processor cause the processor to perform a method for providing error correction in a text caption, the method comprising:
 - displaying a text caption representing a text transcription of a voice signal transmitted between a first device and a

second device, the text caption including at least one block of text; and

displaying another block of text within the text caption on at least one of the first device and the second device by replacing the at least one block of text by the another block of text at a location of the at least one block of text within the text caption.

Ex. 1001, 8:32–44.

C. Related Proceeding

CaptionCall indicates that it asserted the '801 patent against Ultratec in a patent infringement counterclaim in *Ultratec, Inc. v. Sorenson Communications, Inc.*, No. 3:13-cv-00346, which was filed in the United States District Court for the Western District of Wisconsin. Paper 13, 1. After the oral hearing in this proceeding was held on July 10, 2014, Ultratec filed, separately as an exhibit, a copy of an opinion and order from that district court proceeding granting Ultratec's Motion for Summary Judgment on the grounds that claims 3–6, 8, and 10–29 would have been obvious as a matter of law over the combination of U.S. Patent No. 7,881,441 B2 ("Engelke 2") and U.S. Patent No. 7,428,702 B1 ("Cervantes"). Ex. 1024.

D. Prior Art Relied Upon

Ultratec relies upon the following prior art references:

Engelke ("Engelke 1")	US 6,567,503 B2	May 20, 2003	Ex. 1006
Engelke ("Engelke 2")	US 7,881,441 B2	Feb. 1, 2011 (filed Mar. 28, 2006)	Ex. 1008
Cervantes	US 7,428,702 B1	Sept. 23, 2008	Ex. 1009

E. Instituted Grounds of Unpatentability

We instituted this proceeding based on the asserted grounds of unpatentability set forth in the table below.

Challenged Claims	Basis	Reference(s)
1, 2, 7, and 9	§ 102(b)	Engelke 1 ³
1, 3–6, and 8–29	§ 103(a)	Engelke 2 and Cervantes

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, we construe a claim by applying the broadest reasonable interpretation in light of the specification of the patent in which it appears. 37 C.F.R. § 42.100(b); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012).

1. “*block(s) of text*” (*claims 3–5, 10, 11, 13–17, 19, and 24–29*)

In its Petition, Ultratec proposes that the claim phrase “block(s) of text” should be construed as “at least one word, sentence, or line of text.” Pet. 2 (citing Ex. 1001, 5:13–16, 60–63; 6:14–16, 29–37; figs. 3, 4). We adopted this claim construction in our Decision to Institute because it was the broadest reasonable interpretation consistent with the ordinary and customary meaning of “block(s) of text,” as would be understood by one with ordinary skill in the art in the context of the ’801 patent. Dec. 8–9. CaptionCall does not propose an alternative claim construction in its Patent Owner Response. We discern no reason to alter the claim construction proposed by Ultratec its Petition, and adopted by us in the Decision to Institute, for this Final Written Decision.

³ We no longer need to address this ground of unpatentability because, as we explained previously, CaptionCall disclaimed claims 1, 2, 7, and 9. Paper 52; Ex. 2007.

B. The Level of Skill in the Art

In determining the level of skill in the art, various factors may be considered, including “type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field.” *In re GPAC, Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) (citing *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986)). In its Petition, Ultratec asserts that a person with ordinary skill in the art would be an individual that possesses, “among other attributes, familiar[ity] with the electronic generation, correction, and display of transcribed or captioned text that is transmitted to and displayed on an electronic device.” Pet. 2 (citing Ex. 1001, 3:11–19; 5:5–11). In its Patent Owner Response, CaptionCall does not contest Ultratec’s assertion in this regard.

Notwithstanding Ultratec’s uncontested assertion regarding the level of skill in the art, Ultratec presents the Rebuttal Declaration of James. A. Steel, Jr. (Ex. 1021) with its Reply to expand upon what it meant by “other attributes” a witness must possess before he or she is qualified to offer testimony on the subject matter of the ’801 patent. This new argument and evidence are improper because they do not respond to any argument raised in the Patent Owner Response. 37 C.F.R. § 42.23(b) (“A reply may only respond to arguments raised in the corresponding . . . patent owner response.”). As discussed below, even considering Mr. Steel’s Declaration, we do not agree with Ultratec’s description of the level of skill in the art.

In his Rebuttal Declaration, Mr. Steel testifies that a person with ordinary skill in the art would be an individual that possesses an

undergraduate degree in one or more of the following areas: electrical engineering, computer science, or computer information systems. *Id.* at 7. Mr. Steel further testifies that a person with ordinary skill in the art would have a general knowledge of programming software applications for real-time transcriptions, as well as a general knowledge and understanding of the telecommunications needs of the deaf and hearing-impaired and the design goals and limitations of existing telecommunications technology for the deaf and hearing-impaired. *Id.*

We credit Mr. Steel's testimony regarding the education level of a person with ordinary skill in the art, but do not credit his testimony that a person with ordinary skill in the art must possess a general knowledge and understanding of the telecommunication needs, design goals, and limitations of text caption communication systems specifically for the deaf or hearing-impaired. The '801 patent purportedly addresses the problem of correcting errors within a transcript displayed on a text caption communication system. *See Ex. 1001, 1:38–64.* Although the '801 patent discusses this problem in the context of displaying a corrected transcript on, for example, a text captioned telephone for a deaf or hearing-impaired user, there is no indication that the problem must be narrowly focused such that it precludes correcting the transcript for a specific type of recipient. In our view, the problem addressed by the '801 patent is correcting errors in a transcript displayed in a text caption communication system, regardless of whether the prospective recipient of the corrected transcript is deaf or hearing-impaired.

In summary, a person with ordinary skill in the art would be an individual who possesses a bachelor in science in electrical engineering, computer science, or computer information systems, along with a general

knowledge and understanding of a text caption communication system, including “the electronic generation, correction, and display of transcribed or captioned text that is transmitted to and displayed on an electronic device.” Pet. 2 (quoting Ultratec’s uncontested assertion regarding the level of skill in the art).

C. 35 U.S.C. § 103(a) Ground of Unpatentability Based on the Combination of Engelke 2 and Cervantes

In its Petition, Ultratec contends that claims 3–6, 8, and 10–29 are unpatentable under 35 U.S.C. § 103(a) over the combination of Engelke 2 and Cervantes. Pet. 19–46. In support of this asserted ground of unpatentability, Ultratec relies upon claim charts to explain how the proffered combination teaches the claimed subject matter recited in each of these challenged claims. *Id.*

In its Patent Owner Response, CaptionCall does not contest that the combination of Engelke 2 and Cervantes teaches the claimed subject matter recited in claims 3–6, 8, and 10–29, but instead presents a number of arguments based on the following notions: (1) because Engelke 2 incorporates by reference Engelke 1, and Ultratec relies on Engelke 1 to teach certain claim features recited in these challenged claims, Ultratec’s proffered combination of Engelke 2 and Cervantes requires the disclosure of Engelke 1; (2) modifying Engelke 2 with Cervantes’s post transmission error correction would change Engelke 1’s principle of operation, or otherwise render it inoperable for its intended use; and (3) a person of ordinary skill in the art would not modify Engelke 1 with Cervantes’s post transmission error correction. PO Resp. 21–56.

We begin our analysis with the principles of law that generally apply to a ground of unpatentability based on obviousness, followed by brief discussions of Engelke 2 and Cervantes, and then we address each of CaptionCall's arguments in turn.

1. Principles of law

A claim is unpatentable under § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). We also recognize that prior art references must be “considered together with the knowledge of one of ordinary skill in the pertinent art.” *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (citing *In re Samour*, 571 F.2d 559, 562 (CCPA 1978)). We analyze the ground of unpatentability based on the combination of Engelke 2 and Cervantes with the principles identified above in mind.

2. Engelke 2

Engelke 2 generally relates to telephone systems that provide real-time text captioning for an individual who is hearing-impaired. Ex. 1008, 1:18–20. Figure 1 of Engelke 2, reproduced below, illustrates text captioned telephone system 10 that uses private branch exchange (“PBX”) telephone terminal 12 and desk top computer 14. *Id.* at 4:12–14, 53–56.

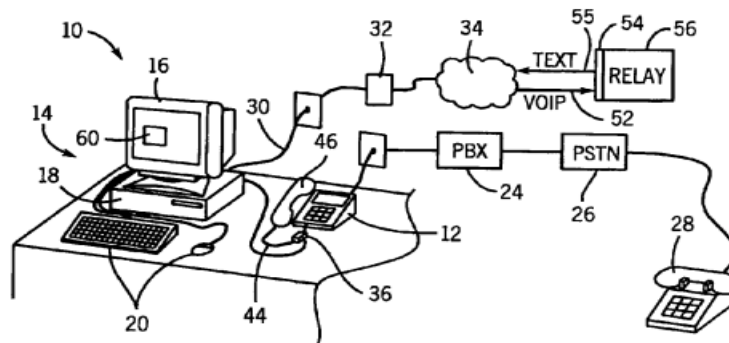


FIG. 1

As shown in Figure 1 of Engelke 2, desk top computer 14 includes display screen 16, base unit 18 containing a processor, memory, disk drives, and sound card, and keyboard or other entry device 20. Ex. 1008, 4:56–59. PBX telephone terminal 12 may be connected via an office wall jack 22 to PBX network 24 using a proprietary communication protocol. *Id.* at 4:60–62. PBX network 24 communicates with public switched telephone network 26, which, in turn, allows PBX telephone terminal 12 to connect to external telephone terminal 28. *Id.* at 4:62–67. Desk top computer 14 may connect to any one of the following: (1) Ethernet network 30 through an Ethernet card; (2) Internet 24 by passing local router 34; or (3) local router 32 by using one of a number of well-known wireless standards. Ex. 1008, 5:1–4.

In one embodiment, Engelke 2 discloses that relay service 56 is capable of forwarding captioning text 55 over the Internet to a caller through a text box 92 (illustrated in Figure 7) displayed within webpage 86 on desk top computer 14. Ex. 1008, 6:59–61. Text box 92 may use a browser plug-in or instant messaging program to provide the caller with consistent updating of the text as it is received. *Id.* at 6:61–64.

3. *Cervantes*

Cervantes generally relates to allowing users in an instant messaging environment to edit previous messages that have been exchanged and re-send the edited version of the message to target users. Ex. 1009, 1:42–45. In a typical conversation in an instant messaging system, a first user sends a message to a second user. *Id.* at 2:17–21. As soon as the first user sends the message, the first user may notice several mistakes in the message and, as a result, attempt to send a corrected message as soon as possible. *Id.* at 2:21–24. At this point, in order to understand what was meant by the original message, the second user needs to return to the original message received, read it again, and then read the corrected message. Ex. 1009, 2:28–31.

The invention disclosed in *Cervantes* purportedly solves this problem by allowing the first user to modify the original message when a mistake has been made. Ex. 1009, 2:38–41. In particular, when the first user notices a mistake in the original message, the first user puts a cursor over the original message, edits it, and once the revision is made, presses ENTER (“post-transmission error correction”). *Id.* at 2:41–44. The corrected word(s) may be highlighted, colored, underlined, or otherwise re-formatted for the purpose of notification. *Id.* at 2:44–46. The second user automatically sees these edits in a new message or, alternatively, the original message received by the second user dynamically changes to a new, edited version with the same color schemes. Ex. 1009, 2:55–60.

*4. Ultratec's Asserted Ground of Unpatentability Based on the
Combination of Engelke 2 and Cervantes Requires the
Disclosure of Engelke 1*

In its Petition, Ultratec contends that Engelke 2 incorporates by reference the entire disclosure of Engelke 1. Pet. 20. Ultratec then relies on the disclosure of Engelke 1 to teach certain claim features recited in claims 3–6, 8, and 10–29. *See, e.g., id.* at 23, 29, 32–33, 35–38, 41–42. In its Patent Owner Response, CaptionCall contends that, because Engelke 2 incorporates by reference Engelke 1, and Ultratec relies on the disclosure of Engelke 1 to teach certain claim features recited in these challenged claims, a proposed modification of Engelke 2 would require a modification to Engelke 1. PO Resp. 22–25.

As an initial matter, it is undisputed that Engelke 2 incorporates by reference Engelke 1. Ex. 1008, 5:37–42. Indeed, Ultratec relies upon specific teachings in Engelke 1 to explain how the combination of Engelke 2 and Cervantes renders obvious certain claim features recited in independent claims 14, 17, 25, and 29. For instance, Ultratec relies upon both Engelke 1's system that enables communication between hearing-capable user 12 and hearing-impaired user 14, and Engelke 2's system that enables text communication between a hearing-capable user and a hearing-impaired user via an Internet connection, to teach the “displaying a text caption representing a text transcription of a voice signal transmitted between a first device and a second device,” as recited in independent claim 14. Pet. 29–30 (citing Ex. 1006 1:18–21, 33–38; Ex. 1008, Abstract, 6:1–9, 5:19–30, figs. 1, 3). To justify its conclusion of obviousness regarding this claim feature recited in independent claim 14, Ultratec asserts that it would have been

obvious to one with ordinary skill in the art to substitute the error correction solution taught by Cervantes for the error correction solution of the Engelke 1 and Engelke 2 combination to yield the predictable result of in-line correction of previously transmitted erroneous text. *Id.* at 30.

Based on the undisputed fact that Engelke 2 incorporates by reference Engelke 1, as well as Ultratec's reliance on the disclosure of Engelke 1 when formulating the asserted grounds of unpatentability based on the combination of Engelke 2 and Cervantes, we are persuaded by CaptionCall's argument that a proposed modification of Engelke 2 also would require a modification to Engelke 1.

5. Cervantes is Analogous Art to the Invention Claimed in the '801 Patent Because it is Reasonably Pertinent to the Problem With Which the '801 Patent was Concerned

In its Patent Owner Response, CaptionCall contends that a person of ordinary skill in the art would not look to Cervantes for suggestions to modify Engelke 1. PO Resp. 54. In particular, CaptionCall argues that Cervantes does not recognize or address the same problem with which the '801 patent was concerned. *Id.* at 55. In its Reply, Ultratec contends that fields where text are displayed to a user, including the instant messaging system taught by Cervantes, would have commended themselves to the attention of the inventors of the '801 patent. Pet. Reply. 14.

We understand CaptionCall's position to be that Cervantes is not analogous art to the invention claimed in the '801 patent because it is not reasonably pertinent to the problem with which the '801 patent was concerned. We disagree. "A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it

is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992). "In other words, 'familiar items may have obvious uses beyond their primary purposes.'" *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1380 (Fed. Cir. 2007) (quoting *KSR*, 550 U.S. at 420).

The '801 patent discloses that there is a problem in the art of text caption communication systems with correcting errors in a text caption, and providing the corrected word(s) to a hearing-impaired user, such that he or she can understand the context of the correction without distracting from, or interrupting the continuity of, a conversation. *See* Ex. 1001, 1:38–2:3. Although Cervantes acknowledges that there are some advantages of using instant messaging instead of a phone service (Ex. 1009, 1:14–18), Cervantes nonetheless discloses that there is a problem in the art of instant messaging systems with correcting errors in instant messages exchanged between users. *See id.* at 1:21–39. Cervantes is analogous art to the invention claimed in the '801 patent because its disclosure of correcting errors in an instant message would be reasonably pertinent to the problem faced by the '801 patent of correcting errors in a text caption. Therefore, contrary to CaptionCall's argument, a person with ordinary skill in the art may look to Cervantes's post-transmission error correction for suggestions to modify Engelke 2, which incorporates by reference Engelke 1.

6. Modifying Engelke 1 with Cervantes's Post-transmission Error Correction Would Not Change Engelke 1's Principle of Operation

In its Patent Owner Response, CaptionCall contends that the principle of operation of Engelke 1 requires correcting the text of a transcript prior to

transmitting the transcript to a hearing-impaired user (“pre-transmission error correction”). PO Resp. 27 (citing Ex. 2003 ¶¶ 45–50). To support its contention that Engelke 1’s principle of operation is pre-transmission error correction, CaptionCall directs us to various disclosures in Engelke 1. *Id.* at 28–33 (citing Ex. 1006, Abstract (“An editing system . . . displays transcribed text on a screen prior to transmission so that a human call assistant may . . . initiate a correction of . . . words either through speech or text entry.”); 3:60–67 (“The editing text signal 46 causes [the text of the transcription] to appear on call assistant display 48 [so] that [it] may be reviewed by the call assistant 40 for possible correction using voicing or the keyboard 50 prior to be converted to a text stream signal 20.”); 6:13–15 (“Prior to the words being colored the second color 126 and transmitted (thus while the words are still in the queue 122), a correction of transcription errors may occur.”); figs. 3, 6. CaptionCall then asserts that modifying Engelke 1 with Cervantes’s post-transmission error correction would change Engelke 1’s principle of operation. *Id.* at 26–27 n. 5 (citing *In re Ratti*, 270 F.2d 810, 813 (CCPA 1959), 33–37).

In its Reply, Ultratec contends that Engelke 1 generally relates to an editing and correction system for real-time remote transcriptions for the deaf or hearing-impaired. Pet. Reply 7 (citing Ex. 1006, Abstract; 1:56–59). Ultratec further contends that Engelke 2 emphasizes that Engelke 1’s basic principle of operation is to provide a telecommunications relay service using “human operations working with speech recognition engines to rapidly translate voice signals into text streams.” *Id.* (quoting Ex.1008, 5:37–42). Ultratec then asserts that modifying Engelke 1 with Cervantes’s post-

transmission error correction would not change the basic functionality of the telecommunications relay service taught by Engelke 1 or Engelke 2. *Id.*

We are not persuaded by CaptionCall's argument because it limits Engelke 1's principle of operation to pre-transmission error correction. The title of Engelke 1 is "Real-Time Transcription Correction System."

Ex. 1006, at [54]. Engelke 1 generally relates to a system for transcribing voice communication into text and, in particular, to a system for facilitating real-time editing of a transcribed text stream by a human call assistant for higher accuracy. Ex. 1006, 1:19–22. Of particular importance is Engelke 1's stated objective to "generally improve the speed and accuracy of the transcription." *Id.* at 1:52–56.

There is no indication in these cited disclosures, or throughout the remaining disclosure in Engelke 1, that the timing of error correction by call assistant 40 is a critical or essential aspect of the relay service offered by Engelke 1's text caption communication system. Although CaptionCall directs us to various disclosures in Engelke 1 to support its assertion that error correction in a transcript only occurs prior to transmitting the transcript to a hearing-impaired user, those disclosures, by themselves, do not preclude post-transmission error correction. For instance, each of the disclosures in Engelke 1 relied upon by CaptionCall uses permissive language such as "may" when referring to the error corrections made by call assistant 40 prior to transmission. *See, e.g.*, Ex. 1006, Abstract; 3:60–67; 6:13–15.

In summary, we are not persuaded that Engelke 1's principle of operation should be limited to pre-transmission error correction. Instead, the principle of operation that more accurately epitomizes Engelke 1 is using a call assistant or operator to perform error correction in a text caption

communication system, regardless if the error correction occurs pre-transmission, post-transmission, or both.

With this in mind, we turn to CaptionCall's arguments that modifying Engelke 1 with Cervantes's post-transmission error correction would require a substantial reconstruction and redesign of certain features disclosed in Engelke 1—namely, circular buffer 85, macro keys 135, slider control 152, and call assistant display 48. We will address each of these features disclosed by Engelke 1 in turn.

a. Circular Buffer 85 and Macro Keys 135

In its Patent Owner Response, CaptionCall contends that modifying Engelke 1 with Cervantes's post-transmission error correction would eliminate or bypass Engelke 1's circular buffer 85, which, in turn, would prevent or seriously hinder the use of Engelke 1's macro keys 135. PO Resp. 37–42 (citing Ex. 1006, 4:38–40; 6:4–5, 35–60; fig.6; Ex. 2003 ¶¶ 54–58). In its Reply, Ultratec contends that, because Engelke 1 discloses that macro keys 135 are an alternative to other embodiments, the modification or elimination of this feature would not change Engelke 1's principle of operation. Pet. Reply 8 (citing Ex. 1006, 6:35–38).

For a number of reasons, we are not persuaded by CaptionCall's argument that modifying Engelke 1 with Cervantes's post-transmission error correction would require a substantial reconstruction and redesign of Engelke 1's circular buffer 85 and macro keys 135. First, this argument is predicated on the notion that Engelke 1's principle of operation is pre-transmission error correction. As we explained above, the principle of operation that more accurately epitomizes Engelke 1 is using a call assistant or operator to perform error correction in a text caption communication

system, regardless if the error correction occurs pre-transmission, post-transmission, or both. Second, Engelke 1 describes macro keys 135 as an alternative feature. Ex. 1006, 6:35–38. CaptionCall does not explain how the elimination of a feature that is described as an alternative somehow would change Engelke 1’s principle of operation. *See, e.g., In re Umbarger*, 407 F.2d 425, 430–31 (CCPA 1969) (finding *Ratti* inapplicable where the modified apparatus will operate “on the same principles as before”).

Third, CaptionCall does not explain adequately why Engelke 1’s macro keys 135 must be eliminated when modifying Engelke 1 with Cervantes’s post-transmission error correction. As evidenced by Engelke 1, macro keys represent common initial words in a sentence or phrase, such as “okay,” “but,” “hello,” etc., that may be used by a call assistant to minimize latency when processing voice to text. Ex. 1006, 6:49–60. CaptionCall does not provide sufficient or credible evidence that explains why using Engelke 1’s macro keys 135 to perform Cervantes’s post-transmission error correction would be uniquely challenging or otherwise beyond the level of an ordinary skilled artisan. *See Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418).

b. Slider Control 152

In its Patent Owner Response, CaptionCall contends that modifying Engelke 1 with Cervantes’s post-transmission error correction would prevent a hearing-impaired user from selecting the type and speed of transcription using slider control 152. PO Resp. 42–44 (citing Ex. 1006, fig.9; Ex. 2003 ¶ 59). In its Reply, Ultratec contends that, similar to Engelke 1’s macro keys 135, slider control 152 is an optional feature. Pet. Reply 9 (citing Ex. 1006, 7:32–36). Therefore, Ultratec asserts that the modification or

elimination of slider control 152 would not change Engelke 1's principle of operation. *Id.* at 9–10.

For essentially the same reasons discussed above with respect to Engelke 1's circular buffer 85 and macro keys 135, we are not persuaded by CaptionCall's argument that modifying Engelke 1 with Cervantes's post-transmission error correction would require a substantial reconstruction and redesign of Engelke 1's slider control 152. First, this argument is predicated on the notion that Engelke 1's principle of operation is pre-transmission error correction. As we explained above, the principle of operation that more accurately epitomizes Engelke 1 is using a call assistant or operator to perform error correction in a text caption communication system, regardless if the error correction occurs pre-transmission, post-transmission, or both. Second, Figure 9 of Engelke 1 illustrates that user terminal 22 may include, for example, slider control 152. Ex. 1006, 7:32–36. CaptionCall does not explain how the elimination of a feature that is described as exemplary somehow would change Engelke 1's principle of operation. *See, e.g., Umbarger*, 407 F.2d at 430–31.

Third, CaptionCall does not explain adequately why Engelke 1's slider control 52 must be eliminated when modifying Engelke 1 with Cervantes's post-transmission error correction. Engelke 1 discloses that slider control 152 provides a range of settings, including a faster transcription setting at the expense of more errors and a few errors setting that entails a much more precise transcription at the expense of some latency. Ex. 1006, 7:32–39. CaptionCall does not provide sufficient or credible evidence that explains why using the functionality of Engelke 1's slider control 152 with Cervantes's post-transmission error correction would

be uniquely challenging or otherwise beyond the level of an ordinary skilled artisan. *See Leapfrog*, 485 F.3d at 1161 (Fed. Cir. 2007).

c. Call Assistant display 48

In its Patent Owner Response, CaptionCall contends that modifying Engelke 1 with Cervantes's post-transmission error correction would render the color-coding scheme displayed on Engelke 1's call assistant display 48 meaningless because words would no longer be color-coded according to whether they already had been transmitted to the hearing-impaired user. PO Resp. 44–45 (citing Ex. 1006, 5:61–6:15; Ex. 2003 ¶ 60). In its Reply, Ultratec contends that the testimony provided by CaptionCall's expert, Mr. Occhiogrosso, regarding this issue is entitled to little weight because he does not substantiate his assertion that changing the content displayed on Engelke 1's call assistant display 48 would be beyond the skill level of an ordinary artisan. Pet. Reply 10. Ultratec further contends that, similar to the color-coding scheme taught by Engelke 1, Cervantes discloses that the sender's screen may be formatted to highlight corrected words. *Id.* (citing Ex. 1009, 3:10–14; fig. 3.)

We are not persuaded by CaptionCall's argument that modifying Engelke 1 with Cervantes's post-transmission error correction would require a substantial reconstruction and redesign of the content displayed on Engelke 1's call assistant display 48. In our view, this proffered combination would not affect the operability of Engelke 1's call assistant display 48, nor change the overall principle of operation of Engelke 1's text caption communication system. We do not credit the testimony of Mr. Occhiogrosso regarding the color-coding scheme displayed on Engelke 1's call assistant display 48. Instead, we agree with Ultratec that Cervantes

discloses a color-coding scheme similar to the color-coding scheme disclosed in Engelke 1. Cervantes discloses that, when a mistake in an original message is corrected and a new message is sent, the corrected word(s) may be highlighted, colored, underlined, or otherwise re-formatted for the purpose of notification. Ex. 1009, 2:41–46. One of ordinary skill in the art would have recognized that modifying Engelke 1 with Cervantes’s post-transmission error correction would not affect the operability of Engelke 1’s call assistant display 48 because it still would be capable of displaying a color-coding scheme for corrected words without changing the overall principle of operation of Engelke 1’s text caption communication system.

7. Modifying Engelke 1 with Cervantes’s Post-transmission Error Correction Would Not Render Engelke 1 Unsatisfactory for its Intended Purpose

In its Patent Owner Response, CaptionCall contends that modifying Engelke 1 with Cervantes’ post-transmission error correction would render Engelke 1 unsatisfactory for its intended purpose. PO Resp. 45–46. To support this contention, CaptionCall relies upon essentially the same arguments it presented when asserting that modifying Engelke 1 with Cervantes’s post-transmission error correction would change Engelke 1’s principle of operation. *Compare* PO Resp. 27–37, *with id.* at 46–52. For the same reasons discussed above, CaptionCall’s arguments are not persuasive.

8. Engelke 1 Does Not Distinguish Itself From Cervantes and, as a Result, Does Not Teach Away From the Invention Claimed in the ’801 Patent

In its Patent Owner Response, CaptionCall contends that a person of ordinary skill in the art would not modify Engelke 1 with Cervantes because

Engelke 1 distinguishes itself from the post-transmission error correction taught by Cervantes. PO Resp. 52–53 (citing *Leo Pharm. Prods. Ltd. v. Rea*, 726 F.3d 1346, 1355 (Fed. Cir. 2013)). In other words, CaptionCall argues that Engelke 1 is distinguishable from Cervantes because it solves the problem of error correction in a text caption communication system using pre-transmission error correction, whereas Cervantes solves the same problem using post-transmission error correction. *Id.* at 53. In its Reply, Ultratec contends that Engelke 1 does not address post-transmission error correction, much less in a distinguishing manner. Pet. Reply 13.

We understand CaptionCall’s position to be that Engelke 1 teaches away from Cervantes because Engelke 1’s pre-transmission error correction is distinguishable from Cervantes’s post-transmission error correction. We disagree. A reference teaches away from a claimed invention if it “criticizes, discredits, or otherwise discourages” modifying the reference to arrive at the claimed invention. *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). We will not, however, “read into a reference a teaching away from a process where no such language exists.” *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1364 (Fed. Cir. 2006).

We agree with Ultratec that Engelke 1 does not address explicitly post-transmission error correction, much less distinguish pre-transmission error correction from post-transmission error correction. Moreover, as we explained previously, there is no indication that Engelke 1 contemplates precluding post-transmission error correction. For instance, Engelke 1 uses permissive language such as “may” when referring to the error corrections made by call assistant 40 prior to transmission. *See, e.g.*, Ex. 1006, Abstract; 3:60–67; 6:13–15. Finally, CaptionCall does not identify, nor can

we find, a disclosure in Engelke 1 that criticizes, discredits, or otherwise discourages using post-transmission error correction to solve the problem of error correction in a text caption communication system.

9. Summary

Upon reviewing the contentions and supporting evidence presented by Ultratec for the grounds of unpatentability based on the combination of Engelke 2 and Cervantes (Pet. 19–46), we are persuaded that Ultratec presents sufficient evidence to support a finding that these prior art references teach the claimed subject matter recited in claims 3–6, 8, and 10–29. We also are persuaded that Ultratec provides an articulated reason with a rational underpinning to combine the teachings of Engelke 2 and Cervantes. *See, e.g., id.* 30–31, 34–35, 39–40, 44–45. Therefore, based on the record before us, we conclude that Ultratec has demonstrated by a preponderance of the evidence that claims 3–6, 8, and 10–29 are obvious over the combination of Engelke 2 and Cervantes.

D. CaptionCall's Motion to Exclude

CaptionCall filed a Motion to Exclude that seeks to exclude the redirect of Ultratec's rebuttal declarant, Mr. Steel (Ex. 2006, 210:1–216:18) for the following reasons: (1) Ultratec's redirect of Mr. Steel was beyond the scope of CaptionCall's cross examination of Mr. Steel; and (2) Ultratec's redirect of Mr. Steel was based on leading questions in violation of Federal Rule of Evidence ("FRE") 611(c).⁴ Paper 45. Ultratec opposes CaptionCall's Motion to Exclude. Paper 48. CaptionCall filed a Reply to Ultratec's Opposition to its Motion to Exclude. Paper 51. Ultratec did not

⁴ With a few exceptions not pertinent in this proceeding, the Federal Rules of Evidence apply to an *inter partes* review. 37 C.F.R. § 42.62.

rely upon its redirect of Mr. Steel during the oral hearing, nor did we rely upon it in reaching our final decision. Accordingly, we dismiss CaptionCall's Motion to Exclude the redirect of Mr. Steel as moot.

E. Ultratec's Motion to Exclude

Ultratec filed a Motion to Exclude that seeks to exclude the Declaration of Mr. Occhiogrosso (Ex. 2003) for the following reasons: (1) Mr. Occhiogrosso is not qualified to offer testimony concerning the subject matter of the '801 patent, in violation of FRE 702; and (2) Mr. Occhiogrosso fails to identify the level of skill in the art in his declaration and, therefore, his testimony is not based on sufficient facts and data, nor reliable principles and methods. Paper 39 ("Pet. Mot."). CaptionCall opposes Ultratec's Motion to Exclude. Paper 46. Ultratec filed a Reply to CaptionCall's Opposition to its Motion to Exclude. Paper 50.

Ultratec contends that Mr. Occhiogrosso is not qualified to testify in this proceeding because he never worked on a text caption communication system for the deaf or hearing-impaired prior to the filing date of the '801 patent. Pet. Mot. 3–5. We are not persuaded by Ultratec's argument because it narrowly focuses on Mr. Occhiogrosso's purported lack of work experience with text caption communication systems specifically for the deaf or hearing-impaired prior to November 24, 2009—the filing date of the '801 patent. Ex. 1001, at [22].

Pursuant to FRE 702, a witness who is qualified as an expert by knowledge, skill, experience, training, or education may testify in the form of opinion. Ultratec has not shown that, in the context of FRE 702, it matters whether Mr. Occhiogrosso has particular experience with text caption communication systems for the deaf or hearing-impaired, or whether

he acquired such experience prior to the filing date of the '801 patent. According to Mr. Occhiogrosso curriculum vitae, he possesses a Bachelor of Science in Electrical Engineering and a Master of Science in Electrical Engineering. Ex. 2004, 2. Mr. Occhiogrosso testifies that he has more than thirty years of experience in the field of telecommunications and information technology, and he has planned, designed, implemented, and managed large scale projects involving wired and wireless communication systems, including transmission of voice to text. Ex. 2003 ¶ 8; *see also* Ex. 2004, 2–7 (detailing Mr. Occhiogrosso's enterprise consulting engagements, research and development, and wireless experience).

As such, we are persuaded that Mr. Occhiogrosso is educated in, and has knowledge of, text caption communication systems even if he has not, for example, worked on a text caption communication system specifically for the deaf or hearing-impaired prior to November 24, 2009. Therefore, based on the record before us, Mr. Occhiogrosso is qualified to testify as to matters concerning text caption communication systems, including “the electronic generation, correction, and display of transcribed or captioned text that is transmitted to and displayed on an electronic device.” Pet. 2 (quoting Ultratec's uncontested assertion regarding the level of skill in the art).

Ultratec also contends that, because Mr. Occhiogrosso failed to identify the level of skill in the art in his declaration, his testimony regarding why the claims of the '801 patent would not have been obvious over the combination of Engelke 2 and Cervantes is unsupported and unreliable. Pet. Mot. 5–6. Ultratec's argument goes more towards the weight we should afford the Declaration of Mr. Occhiogrosso, rather than its admissibility. It is within our discretion to assign the appropriate weight to the testimony

offered by Mr. Occhiogrosso. *See, e.g., Yorkey v. Diab*, 601 F.3d 1279, 1284 (Fed. Cir. 2010) (holding the Board has discretion to give more weight to one item of evidence over another “unless no reasonable trier of fact could have done so”); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1368 (Fed. Cir. 2004) (“[T]he Board is entitled to weigh the declarations and conclude that the lack of factual corroboration warrants discounting the opinions expressed in the declarations.”). Accordingly, we deny Ultratec’s Motion to Exclude the Declaration of Mr. Occhiogrosso.

III. CONCLUSION

Ultratec has demonstrated by a preponderance of the evidence that claims 3–6, 8, and 10–29 of the ’801 patent are unpatentable under 35 U.S.C. § 103(a) over the combination of Engelke 2 and Cervantes.

IV. ORDER

In consideration of the foregoing, it is

ORDERED that Ultratec has demonstrated by a preponderance of the evidence that claims 3–6, 8, and 10–29 of the ’801 patent are unpatentable;

FURTHER ORDERED that CaptionCall’s Motion to Exclude is DISMISSED as moot;

FURTHER ORDERED that Ultratec’s Motion to Exclude is DENIED; and

FURTHER ORDERED that, because this is a final written decision, parties to this proceeding seeking judicial review of our decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2013-00288
Patent 8,379,801 B2

For PETITIONER:

Michael Jaskolski
Nicholas Seay
Martha Snyder
Michael Curley
Nikia Gray
Quarles & Brady LLP
michael.jaskolski@quarles.com
nicholas.seay@quarles.com
martha.snyder@quarles.com
michael.curley@quarles.com
nikia.gray@quarles.com

For PATENT OWNER:

Brian W. Oaks
Bryant C. Boren Jr.
Harper Batts
Adam Smoot
Baker Botts L.L.P.
brian.oaks@bakerbotts.com
bryant.c.boren@bakerbotts.com
harper.batts@bakerbotts.com
adam.smoot@bakerbotts.com