

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAPTIONCALL, LLC,
Petitioner,

v.

ULTRATEC, INC.,
Patent Owner.

Case IPR2013-00545
Patent 6,594,346 B2

Before WILLIAM V. SAINDON, BARBARA A. BENOIT, and
LYNNE E. PETTIGREW, *Administrative Patent Judges*.

BENOIT, *Administrative Patent Judge*.

DECISION
Denying Patent Owner's Request for Rehearing
37 C.F.R. § 42.71

INTRODUCTION

CaptionCall, LLC (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1 and 2 of U.S. Patent No. 6,594,346 B2 (Ex. 1001, “the ’346 patent”). Paper 1 (“Pet.” or “Petition”). We instituted an *inter partes* review for claims 1 and 2. Paper 6. In our Final Written Decision, we determined that Petitioner had shown by a preponderance of the evidence that claims 1 and 2 were unpatentable. Paper 65 (“Final Dec.” or “Final Decision”). Patent Owner, Ultratec, Inc., requests a rehearing of the Final Decision by an expanded panel. Paper 66 (“Req.” or “Request”).

Having considered Patent Owner’s Request, we decline to modify our Final Decision and deny the Request for Rehearing.

ANALYSIS

A request for rehearing must identify specifically all matters the party believes we misapprehended or overlooked, and the place where each matter was addressed previously in a motion, an opposition, or a reply. 37 C.F.R. § 42.71(d). Additionally, Patent Owner, as the party challenging the Final Decision, has the burden of showing the decision should be modified. *Id.*

We first address Patent Owner’s allegations of matters that we misapprehended or overlooked (Req. 1, 4–11). We then address Patent Owner’s allegations of improper panel composition (*id.* at 1–4).

Matters Allegedly Misapprehended or Overlooked

Patent Owner alleges we misapprehended or overlooked matters involving evidence of secondary considerations, the law concerning obviousness, and claim construction. We address each issue in turn.

Evidence of Secondary Considerations

Patent Owner alleges that we improperly made a determination of obviousness before separately analyzing Patent Owner's evidence of secondary considerations. Req. 4–5. We disagree. Rather, in Section II.D of our Final Decision, we determined the scope and content of the asserted prior art (Final Dec. 20–22); discussed the claimed subject matter relative to the asserted prior art, which included identifying differences between the claimed subject matter and the prior art in the context of the ordinary level of skill in the art (Final Dec. 22–31); determined Petitioner, with support of its declarant, had articulated a sufficient reason to support a conclusion of obviousness (Final Dec. 32–35); and analyzed Patent Owner's secondary considerations of nonobviousness (Final Dec. 35–39). *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). Only after that twenty-page discussion in Section II.D did we discuss the ultimate conclusion of obviousness of the claimed subject matter. Final Dec. 39.

Unlike the International Trade Commission in *Apple Inc. v. International Trade Commission*, 725 F.3d 1356, 1365 (Fed. Cir. 2013), cited by Patent Owner in its Request, we considered evidence relating to the *Graham* factors—including objective evidence of secondary considerations presented by Patent Owner—before determining the ultimate issue of obviousness. *Compare* Req. 4–5 *with* Final Dec. 20–39; *see Apple*, 725 F.3d at 1365 (“The ITC, however, never mentioned, much less weighed as part of the obviousness analysis, the secondary consideration evidence . . . presented.”). As noted in our Final Decision, we determined that:

Patent Owner fails to provide sufficient credible evidence to support its allegations of nonobviousness based on secondary considerations. When we balance Petitioner's evidence of obviousness against Patent Owner's asserted objective evidence of nonobviousness, we determine that a preponderance of the evidence supports Petitioner's position that claims 1 and 2 would have been obvious over Ryan and Alshawi.

Final Dec. 39. Thus, we recognized that the “ultimate conclusion of obviousness is a legal conclusion to be reached after weighing all the evidence on both sides.” *Apple*, 725 F.3d at 1365.

Patent Owner further contends we refused to consider Patent Owner's secondary considerations evidence. Req. 5. This is incorrect. We considered the arguments and evidence presented in Patent Owner's Response. Final Dec. 36–37. We concluded Patent Owner did “not provide sufficient analysis for us to determine whether Patent Owner has provided adequate evidence of secondary considerations and a nexus between any such evidence and the merits of the claimed invention.” *Id.*

In its Request, Patent Owner seems to suggest that we should have reviewed and analyzed the entirety of each of three declarations submitted by Patent Owner in support of its secondary considerations contention (Exs. 2003, 2004, and 2005). Req. 5. This also is incorrect because, in its Patent Owner Response, Patent Owner merely cited each declaration in its entirety without citing with particularity portions of these declarations. PO Resp. 49 (citing “declarations by Brenda Battat (Ex. 2004) and Constance Phelps (Ex. 2005)” and “declaration of Paul Ludwick (Ex. 2003)”).

We will not scour the 143 pages of declaration evidence submitted by Patent Owner and generally serve as an advocate for Patent Owner by

finding evidence of secondary considerations in the voluminous exhibits submitted. *Cf. DeSilva v DiLeonardi*, 181 F.3d 865, 866–67 (7th Cir. 1999) (“A brief must make all arguments accessible to the judges, rather than ask them to play archaeologist with the record.”); *Ernst Haas Studio, Inc. v. Palm Press, Inc.*, 164 F.3d 110, 111–12 (2d Cir. 1999) (“Appellant’s Brief is at best an invitation to the court to scour the record, research any legal theory that comes to mind, and serve generally as an advocate for appellant. We decline the invitation.”).

Testimony of Patent Owner’s Declarant

Patent Owner alleges we improperly disregarded Patent Owner’s declarant’s personal observations that secondary considerations of nonobviousness were commensurate in scope with the claimed subject matter. Req. 6–7. Patent Owner asserts that its declarant’s testimony consisted of personal observations and not opinion testimony. Req. 6.

As noted in our Final Decision, to show the requisite nexus, Patent Owner relied on its declarant’s testimony describing his visit to CapTel, Inc.’s relay center in Madison, Wisconsin. Final Dec. 37–38 (citing Ex. 2002 ¶ 47). We found the “conclusory assertions do not provide a sufficient connection between objective evidence and the claimed invention, and so do not establish the requisite nexus between the merits of the claimed invention and the evidence of secondary considerations.” Final Dec. 38–39.

We did not disregard this testimony; rather, we found it insufficient. To illustrate this insufficiency, in our Final Decision, we cited an example of the testimony provided for the disputed limitation “a digital computer connected to the microphone, the computer programmed to use a voice recognition computer software package trained to the voice of the call

assistant to translate the words spoken in voice by the call assistant into a digital text stream”:

I personally observed that the CapTel Service meets this claim element. I further confirmed this from my own knowledge of CapTel Service. This feature of the CapTel Service relay is present when the Service is used with each of the CapTel Phones and has always been included as part of the CapTel Service.

Final Dec. 38 (citing Ex. 2002 ¶ 48 (page 28)). We found that, because the declarant’s conclusions were based on personal observations, without sufficient supporting facts or data, his testimony provided little probative value. Final Dec. 38.

We reject Patent Owner’s assertion that, because there is no testimony to the contrary, we must accept its declarant’s “personal observations” on the claimed features being present in the system provided by CapTel Service and thereby conclude a nexus exists. Req. 6–7. We cited proper authority in the Final Decision for why we gave little probative value to this testimony of Patent Owner’s declarant—such “conclusory assertions do not provide a sufficient connection between objective evidence and the claimed invention.” Final Dec. 38 (citing *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.”)). In contrast to the case cited by Patent Owner, *Tudor v. Department of Treasury*, 639 F.3d 1362, 1365 (Fed. Cir. 2011), which involves testimony concerning a factual issue as to whether approval authority for referring investigations for prosecution was given, here we are weighing the conclusion of Patent Owner’s declarant that “the CapTel Service meets this claim element,”

without sufficient supporting facts or data as to why the CapTel Service meets the limitations in the challenged claims.

In re Mouttet

Patent Owner contends that we misapprehended *In re Mouttet*, 686 F.3d 1322 (Fed. Cir. 2012) in finding a motivation to combine Ryan¹ and Alshawi² and, therefore, erred in determining that the challenged claims would have been obvious. Req. 7–8 (citing Final Dec. 33). The Final Decision cited *Mouttet* for the proposition that a “determination of obviousness is not based on bodily incorporation of parts from one disclosed system into another, but what the combined teachings would have suggested to one with one of ordinary skill in the art.” Final Dec. 33 (citing *Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012); *In re Keller*, 642 F.2d 412, 425 (CCPA 1981)). We disagree that we misapprehended *Mouttet*, which states:

It is well-established that a determination of obviousness based on teachings from multiple references does not require an actual, physical substitution of elements. *In re Etter*, 756 F.2d 852, 859 (Fed. Cir. 1985) (en banc) (“*Etter*’s assertions that Azure cannot be incorporated in Ambrosio are basically irrelevant, the criterion being not whether the references could be physically combined but whether the claimed inventions are rendered obvious by the teachings of the prior art as a whole.”); *In re Sneed*, 710 F.2d 1544, 1550 (Fed. Cir. 1983) (“[I]t is not necessary that the inventions of the references be physically combinable to render obvious the invention under review.”); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (“The test for obviousness is not whether the features of a secondary reference may be bodily

¹ U.S. Patent No. 5,809,112 (Ex. 1004).

² U.S. Patent No. 5,815,196 (Ex. 1010).

incorporated into the structure of the primary reference....”).

In re Mouttet, 686 F.3d at 1332. Thus, we are not persuaded that we misapprehended *Mouttet*. Nor did we “disregard[] Patent Owner’s counter-evidence that there would be disincentives for a [person of ordinary skill in the art] to combine *Ryan* and *Alshawi*,” “given that *Alshawi*’s features are incompatible with the TDD devices with which *Ryan* is used.” Req. 8. Rather, in finding a sufficient reason one of ordinary skill in the art would combine the references, we considered the reasons identified by the Petition, weighed the testimony of the respective declarants, and considered Patent Owner’s arguments. Final Dec. 32–35.

Claim Construction

Because the parties articulated different views on how “trained to the voice of the call assistant” should be interpreted relative to asserted prior art, we analyzed Patent Owner’s implied constructions of the term and Patent Owner’s declarant’s testimony concerning the same. Final Dec. 8–10. In its Request for Rehearing, Patent Owner argues that we “misapprehended claim construction law” in determining software “trained to the voice of the call assistant” was not limited to training to the voice of one and only one particular call assistant and did not preclude voice recognition software that is designed or built in advance of implementation at the source code level to the voice of a call assistant. Req. 9–11.

First, Patent Owner contends that we erroneously relied on the Specification’s disclosure of “voice pattern.” Req. 9–11. We disagree that our reliance on the Specification’s “Brief Summary of the Invention,” which indicates “a speech recognition computer program which has been trained to

the voice *pattern* of the call assistant,” was improper. *See* Final Dec. 8 (quoting Ex. 1001, 2:51–54).

Rather, in our Final Decision, we contrasted the Specification’s use of “voice *pattern* of the call assistant” in its “Brief Summary of the Invention” with its use of “a voice recognition software package which is specifically trained to the voice of that *particular* call assistant” in the context of a particular embodiment of the invention shown in Figure 1. Final Dec. 8–9 (quoting Ex. 1001, 2:51–54, 6:21–24).

Based on the evidence in the Specification (including the Specification’s disclosure of “a voice pattern”), we determined that the Specification did not indicate expressly that the voice recognition software is trained to the voice of only that particular call assistant or otherwise indicate that the voice recognition software is trained for the voice of only one call assistant. Final Dec. 8. We concluded that “we will not limit ‘trained to the voice of the call assistant’ to require training to the voice of only one particular call assistant, because the claim language encompasses the invention as disclosed in the Specification—software trained to a voice *pattern* of a call assistant.” *Id.* at 9 (citing Ex. 1001, 2:41–49 (“Summary of the Invention”)).

We turn next to Patent Owner’s argument, in its Request for Rehearing, that we erred in concluding that “trained to the voice of the call assistant” does not include a temporal constraint that precludes voice recognition software that is designed or built in advance of implementation at the source code level to the voice pattern of a call assistant. Req. 11 (citing Final Dec. 7). According to Patent Owner, it did not have an

opportunity to address this issue because it was raised after briefing had concluded. Req. 11.

On the contrary, Patent Owner disputed during the *inter partes* review that Ryan disclosed “software trained to the voice of the call assistant to translate the words spoken in voice by the call assistant into a digital text stream,” as recited in independent claim 1. Final Dec. 24–25 (citing Pet. 34–36, 54–55 and PO Resp. 20–23). As noted in our Final Decision, Patent Owner argued in its Patent Owner Response that Ryan does not disclose the recited “voice recognition software trained to the voice of the call assistant” because Ryan discloses voice recognition software that is “designed.” Final Dec. 25 (citing PO Resp. 20–23). More specifically, according to Patent Owner, Ryan discloses software that is designed in advance of implementation at the source code level and, therefore, the software is not trained to the voice of a call assistant. *Id.* As such, Patent Owner initially raised in its Patent Owner Response the issue whether “trained to the voice of the call assistant” encompasses software designed in advance of implementation at the source code level. Therefore, we do not agree with Patent Owner that it did not have an opportunity to address this issue, which Patent Owner first raised itself.

Along these lines, Patent Owner also asserts in its Request for Rehearing that we overlooked an alleged admission at the Hearing by Petitioner that the claim language inherently includes a temporal constraint that precludes training when the software is designed in advance of implementation at the source code level. Req. 11 (citing Paper 64 (Hearing Transcript), 17:3–5). We are not persuaded that we did so. Rather, we

considered Petitioner's statement at the Hearing in light of the evidence of record.

In our Final Decision, we determined that the Specification discloses that the voice recognition software package is trained but does not indicate when or how the training occurs. Final Dec. 8 (citing Ex. 1001, 2:51–54, 6:21–24). We rejected Patent Owner's argument, relying on its declarant, that software "designed" is not software that is "trained to recognize individual voices" because we found insufficient support for Patent Owner's contention. Final Dec. 8 (citing PO Resp. 21). As we explained in our Final Decision, Patent Owner's declarant testified that a person of ordinary skill in the art would not have understood "trained" software to include "designed" software because technology to train software to recognize individual voices did not exist in 1994 and was not used in telecommunications relay service at that time. Final Dec. 25 (citing PO Resp. 25–27; Ex. 2001 ¶¶ 19–20). We weighed this testimony, which relied on capabilities of technology available in 1994, and concluded this testimony had little probative value of the understanding of one of ordinary skill in the art at the time of invention because the year of invention was 2001. Final Dec. 25. According to the challenged patent, commercial voice recognition software that is specifically trained to the voice of a particular call assistant was made "recently available." Ex. 1001, 6:20–36. Thus, the understanding of one of ordinary skill as of 2001 was crucial given the shift in voice recognition technology after 1994, and Patent Owner's declarant's testimony was only reflective of the understanding prior to this shift.

Thus, we do not agree with Patent Owner that we erred by not considering Petitioner's purported "admission" made at the Hearing. Rather,

we considered Petitioner’s statement in determining that Ryan’s description of benefits provided by voice recognition software that “is specifically designed to recognize the voice of particular relay agents” (Ex. 1005, 4:33–38) disclosed the trained software recited in claim 1 of the ’346 patent. See Final Dec. 23–29.

For the reasons given, we are not persuaded that we misapprehended claim construction law or that Patent Owner was not provided with an opportunity to address claim construction of “trained to the voice of the call assistant.”

Conclusion

Having reviewed Petitioner’s Request, we are not persuaded we misapprehended or overlooked any matter.

Alleged Panel Composition Errors

Patent Owner requests rehearing before an expanded panel and additionally asserts we exceeded our authority by issuing a Final Written Decision that did not include a judge that was on the panel of administrative patent judges who decided to institute the review. Req. 1–4. Panel composition for an *inter partes* review is specified in 35 U.S.C. § 6(c), which states “[e]ach . . . inter partes review shall be heard by at least 3 members of the Patent Trial and Appeal Board, who shall be designated by the Director.” The Director’s authority under 35 U.S.C. § 6 to designate panels has been delegated to the Chief Judge. See Patent Trial and Appeal Board Standard Operating Procedure 1 (Rev. 14) (May 8, 2015) (“PTAB SOP 1”).

As acknowledged by Patent Owner (Req. 2), the Final Decision was decided by three administrative patent judges, who are members of the

Board. *See* 35 U.S.C. § 6(a) (indicating that administrative patent judges, along with various members of the United States Patent and Trademark Office, constitute the Patent Trial and Appeal Board). The three administrative patent judges were designated by the Chief Judge according to PTAB SOP 1, titled “Assignment of Judges to Merits Panels, Interlocutory Panels, and Expanded Panels.” The Board, therefore, complied with the statutory requirements for panel composition. Accordingly, we did not issue the Final Decision with less than a “full panel,” as Patent Owner contends.

Moreover, the Chief Judge has discretion to designate judges to decide *inter partes* reviews. *See* PTAB SOP 1 at 2 (§ II.D) (“In general, the Chief Judge will designate a judge or judges, as appropriate, for all matters for AIA reviews.”); *see also* *AOL Inc. v. Coho Licensing LLC*, Case IPR2014-00771, slip op. at 2 (PTAB Mar. 24, 2015) (Paper 12) (informative) (setting forth that the designation of panel members is within the sole authority of the Chief Judge, as delegated by the Director). Patent Owner’s Request, therefore, does not show the composition of the panel that issued the Final Decision was arbitrary, capricious, or an abuse of discretion by the Board.

Patent Owner suggests an expanded panel is warranted to decide the Request in view of the panel composition and various allegations that we misapprehended the law. Req. 1. For the reasons given, Patent Owner does not persuade us that we misapprehended the law or the panel of three judges was deficient. Further, the Board’s procedures provide examples of reasons for expanding a panel, none of which apply here. PTAB SOP 1 at 3 (§ III.A). For example, an expanded panel may be appropriate when

“serious questions have been raised about the continuing viability of an apparently applicable precedential decision of the Board, or a panel of the Board renders a decision that conflicts with a precedential decision of the Board or an authoritative decision of the Board’s reviewing courts.” *Id.* Patent Owner’s Request does not show a conflict or other reason that weighs in favor of panel expansion. Even so, the panel informed the Chief Judge, who has authority to expand a panel, of Patent Owner’s request, and the Chief Judge declined to expand the panel. *See* PTAB SOP 1 at 4 (§ III.B). (“The Chief Judge will determine when an expanded panel is to be designated.”); *see also Apple Inc. v. Rensselaer Polytechnic Inst.*, Case IPR2014-00319, slip op. at 2 n.1 (PTAB Dec. 12, 2014) (Paper 20) (indicating only the Chief Judge, acting on behalf of the Director, may act to expand a panel and panels do not authorize panel expansion).

ORDER

It is hereby ORDERED that Petitioner’s Request for Rehearing is *denied*.

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PETITIONER:

Brian W. Oaks
Bryant C. Boren Jr.
Harper S. Batts
Adam F. Smoot
Joseph Gray
BAKER BOTTS L.L.P.
brian.oaks@bakerbotts.com
bryant.c.boren@bakerbotts.com
harper.batts@bakerbotts.com
adam.smoot@bakerbotts.com
joseph.gray@bakerbotts.com

PATENT OWNER:

Michael Jaskolski
Martha Snyder
Nikia L. Gray
Michael J. Curley
QUARLES & BRADY LLP
michael.jaskolski@quarles.com
martha.snyder@quarles.com
nikia.gray@quarles.com
Michael.curley@quarles.com