

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAPTIONCALL, LLC,
Petitioner,

v.

ULTRATEC, INC.,
Patent Owner.

Case IPR2013-00550
Patent 7,003,082 B2

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

SAINDON, *Administrative Patent Judge*.

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

I. INTRODUCTION

CaptionCall, LLC (“Petitioner”) filed a Petition requesting an *inter partes* review of claim 1 of U.S. Patent No. 7,003,082 (Ex. 1021, “the ’082 patent”). Paper 1 (“Pet.”). In our Decision Instituting *Inter Partes* Review, we granted review of claim 1. Paper 6 (“Inst. Dec.”). In our Final Written Decision, we determined that Petitioner had shown, by a preponderance of the evidence, that claim 1 was unpatentable. Paper 57 (“Final Dec.” or “Final Decision”). Patent Owner requests rehearing of the Final Decision. Paper 58 (“Req. Reh’g” or “Request”). Having considered Patent Owner’s Request, we decline to modify our Final Decision.

A. Applicable Standard of Review

In *inter partes* review, the petitioner has the burden of showing unpatentability by a preponderance of the evidence. 35 U.S.C. § 316(e). The standard of review for rehearing requests is set forth in 37 C.F.R. § 42.71(d), which states:

The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

B. Analysis

Petitioner alleges that we: (1) “misapprehend[ed] the law of anticipation and misapplie[d] [our] construction of ‘captioned telephone device’” (Req. Reh’g 1–11); (2) exceeded our authority by issuing a Final

Written Decision with less than a full panel (*id.* at 11–13); and (3) overlooked regulations requiring a written record (*id.* at 13–15). We address these allegations in turn.

1. Anticipation

Patent Owner alleges that we misinterpreted a footnote in *Net MoneyIn, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 n.5 (Fed. Cir. 2008), “for the proposition that anticipation can be based on combining characteristics of various distinct embodiments in a prior art reference.” Req. Reh’g 1 (citing to Final Dec. 20). Patent Owner’s argument mischaracterizes our Final Decision. We pointed to *Net MoneyIn* in support of our finding that McLaughlin “is describing options for a single system, *not separate embodiments.*” Final Dec. 20 (emphasis added).

Further, Patent Owner overstates the importance of the word “embodiment”; the anticipation inquiry is whether there is “a single prior art disclosure of all elements of a claimed invention arranged as in the claim,” i.e., the word “embodiment” is not itself governing. *Net MoneyIn*, 545 F.3d at 1359. In this case, Patent Owner has attempted repeatedly to get around McLaughlin’s anticipating disclosure by arguing that the various features are in different “embodiments,” essentially because they are under separate headings. But Patent Owner fails to address convincingly Petitioner’s assertions, backed by convincing testimony, that these features are all part of the same single prior art disclosure and arranged as claimed. In our Final Decision, we reviewed the facts and found that Petitioner had established that all of the elements of the claim were found in a single system in McLaughlin. *See generally* Final Dec. 15–24.

Patent Owner next alleges that we “explained that a captioned telephone device is a single device that has the features in the body of the claim.” Req. Reh’g 2. Patent Owner mischaracterizes our Final Decision; we made no such statement or implication regarding a “single device.” Our Final Decision already explains why a construction including the phrase “single device” is not commensurate with the broadest reasonable interpretation. *See* Final Dec. 7–9 (setting forth our construction of the “captioned telephone device”). Specifically, we pointed out that the specification of the ’082 patent instructed one of ordinary skill in the art that “the captured telephone device displays text but need not output any audio signals,” or, in other words, there was no requirement for all features of the claims to be found in one housing or a “single device.” Final Dec. 9 (citing, e.g., an example in the ’082 specification where the speaker/microphone portion (telephone) was depicted as a separate device from the text display portion); Ex. 1021, 9:20–32, Figs. 4–6.

Patent Owner then alleges that we erred because McLaughlin’s system “do[es] not employ devices that contain ‘circuitry to support connection to two telephone lines.’” Req. Reh’g 3–7. In our Final Decision, we discussed one way that Petitioner has shown that the various elements of the claim were described in McLaughlin (*see* Final Dec. 15–24), and we direct Patent Owner to pages 20–21, where we specifically address two telephone lines. The remainder of Patent Owner’s arguments are either a rehash of prior arguments or are new, waived, and not properly before us.¹

¹ It is Patent Owner’s burden to identify where it previously argued each matter it wishes to be reheard. 37 C.F.R. § 42.72(d). Patent Owner fails to do so.

Patent Owner lastly alleges that McLaughlin lacks a microphone and speaker in a single device. Req. Reh’g 7–11. The claim does not require a “single device,” as we discussed above and determined in our Final Decision, where we addressed the limitations actually claimed. *See, e.g.*, Final Dec. 18–20.

Reviewing Patent Owner’s Request, we determine that Patent Owner has failed to identify any matters we overlooked or misapprehended on the topic of anticipation.

2. *Panel Composition*

Patent Owner asserts we exceeded our authority by issuing a Final Written Decision “with less than a full panel.” Req. 11–13. 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. 11–12), 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.

3. Written Record

On November 4, 2014, after discovery and briefing were complete and a month before oral hearing, we held a conference call in which we denied Patent Owner’s request for authorization for a late submission of additional evidence. See 37 C.F.R. § 42.20(b) (“A motion will not be entered without Board authorization”); see also 37 C.F.R. § 42.123(b) (explaining that the late submission of supplemental information must be in the interests of justice). Patent Owner argues that the record is incomplete because we did not issue an order denying its motion. Req. Reh’g 13–14. Patent Owner’s mischaracterizes the events in this proceeding because no such motion was denied; we denied Patent Owner’s *request for authorization* to submit evidence and, as such, no order denying its motion

was necessary.^{2,3} To the extent Patent Owner wishes its denial of authorization to file late evidence to be further memorialized, this paper serves such purpose.

4. Request for Expanded Panel

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.C).

² Patent Owner also mischaracterizes its request for authorization for a late submission of supplemental information as "observations," but observations only apply to testimony taken during this proceeding. See Paper 7, 4–5 (Scheduling Order, addressing the proper utilization of observations on cross-examination).

³ Patent Owner also argues that we excluded the evidence it proposed to submit (Req. Reh'g 15), but no such evidence could be excluded from the record because it was never entered.

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(“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).

C. Conclusion

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

II. ORDER

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

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