

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAPTIONCALL, L.L.C.,
Petitioner,

v.

ULTRATEC, INC.,
Patent Owner.

Case IPR2015-01885
Patent 8,515,024 B2

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

SAINDON, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner requests an *inter partes* review of claims 1–4 of U.S. Patent No. 8,515,024 B2 (Ex. 1001, “the ’024 patent”). Paper 1 (“Pet.”). Patent Owner filed a Preliminary Response to the Petition. Paper 6 (“Prelim. Resp.”).

We have jurisdiction under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Upon consideration of the Petition and the exhibits cited therein, we do not institute an *inter partes* review of the challenged claims.

A. Related Matters

Petitioner filed its Petition concurrently with two other petitions challenging patents owned by Patent Owner: IPR2015-01886 (U.S. Patent 7,881,441) and IPR2015-01889 (U.S. Patent 9,131,045). Paper 5, 4. Petitioner and Patent Owner are also involved in a host of other *inter partes* reviews. Pet. 5–6; Paper 5, 2–4.

The parties are involved in several lawsuits involving patents covering related subject matter: *Ultratec, Inc. v. Sorenson Communications, Inc.*, No. 13-CV-00346 (W.D. Wis.); *Ultratec, Inc. v. Sorenson Communications, Inc.*, No. 14-CV-00066 (W.D. Wis.); *Ultratec, Inc. v. Sorenson Communications, Inc.*, No. 14-CV-00847 (W.D. Wis.). Pet. 5; Paper 5, 2–4.

B. The ’024 Patent

The ’024 patent is directed to a method of operating a captioned telephone device in which captioning service is set up prior to the call being

answered. Ex. 1001, Abstr. When a call is received at the captioned telephone device, the device then checks the status of control buttons to determine whether captioning is enabled. *Id.* at 6:66–7:2. If captioning is enabled, the captioned telephone device dials the relay on another line, so that, in the ideal scenario, the relay is on line to provide captions by the time the call is answered. *See id.* at 7:1–11 (describing when the relay is called); *see also id.* at 4:23–45 (explaining the benefits of a different, but similar embodiment).

C. Exemplary Claim

Claim 1 is the sole independent claim and is reproduced below:

1. A method of operating a captioned telephone call in which an assisted user is connected by a captioned telephone device which is connected both by a first line to a remote user and a second line to a relay providing captioning for a conversation, the method comprising the steps of:
 - when a call is received at the captioned telephone device on the first line, the captioned telephone device calling the relay on the second line to initiate captioning service set up prior to the call being answered;
 - after the call is answered, the captioned telephone device passing spoken words received on the first line to the second line; and
 - the captioning service then providing text captions of the spoken words back to the captioned telephone device on the second line.

Ex. 1001, 10:17–31.

D. Prior Art & Asserted Ground

Petitioner asserts that claims 1–4 of the '024 patent are anticipated by Engelke et al., U.S. Patent App. No. 2002/0085685 A1 (published July 4, 2002) (Ex. 1002) (hereinafter “the '685 publication”). Pet. 22. Petitioner also relies on the testimony of Benedict J. Occhiogrosso. Ex. 1004.

II. CLAIM CONSTRUCTION

We interpret the claims of an unexpired patent using the broadest reasonable interpretation in light of the specification of the patent. 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1278–80 (Fed. Cir. 2015) (“Congress implicitly approved the broadest reasonable interpretation standard in enacting the AIA,” and “the standard was properly adopted by PTO regulation.”), *cert. granted, sub nom. Cuozzo Speed Techs. LLC v. Lee*, 136 S. Ct. 890 (mem.) (2016). Under the broadest reasonable interpretation standard, claim terms 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. *In re Translogic Tech. Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Any special definition for a claim term must be set forth with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). Further, “[t]he PTO should also consult the patent’s prosecution history in proceedings in which the patent has been brought back to the agency for a second review.” *Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1298 (Fed. Cir. 2015).

A critical issue in this case is the proper construction for the following phrase in claim 1 (hereinafter the “when limitation”):

when a call is received at the captioned telephone
device on the first line, the captioned telephone

device calling the relay on the second line to initiate captioning service set up prior to the call being answered.

Petitioner's asserted ground relies on the particular construction it offers. *See* Prelim. Resp. 11 ("Petitioner's argument . . . is entirely tied to its . . . claim construction."). Before a detailed analysis, a brief overview of the parties' positions is useful to provide context. Petitioner's construction considers the when limitation to define a time period during which the relay is called: between call receipt and answer. Pet. 13. Importantly, Petitioner's construction reads the claim on a situation in which a call is received and then a user activates a control to call the relay before the user answers the call. *Id.* In contrast, Patent Owner argues that the when limitation requires the relay to be called at the moment the call is received. *See* Prelim. Resp. 2–3. Thus, Patent Owner's reading would preclude the claim from covering user intervention that causes the relay to be called once the call has been received.

A. Petitioner's Arguments Regarding the When Limitation

Petitioner asserts:

A person of ordinary skill in the art, considering the claim language, specification, and prosecution history would understand that this element (1) requires that the captioned telephone device call the relay to initiate a captioning service, and (2) establishes a time window during which the captioned telephone device must call the relay: between the time a call is received on the first line and the time when the assisted user answers that call.

Pet 13. Petitioner notes that Patent Owner might argue that the captioned telephone device might require automatic initiation of the call to the relay,

but that the claim “does *not* exclude a captioned telephone device making a connection to the relay in response to a user activating a control.” *Id.* In support of that position, Petitioner points to the “Dial on Ring” embodiment described in the ’024 patent, which states: “[w]hen the start of an incoming call is detected by the captioned telephone device, it then checks the status of the control buttons on the face of the device.” *Id.* at 13–14 (quoting Ex. 1001, 6:66–7:2) (emphasis omitted). After that point in time, Petitioner notes, is when “the ‘captioned telephone device immediately dials the number of the relay.’” *Id.* at 14 (quoting Ex. 1001, 7:2–4). Petitioner also notes that the claim does not mention detecting the incoming call and then automatically dialing the relay based on detecting the incoming call. *Id.* (citing Ex. 1004 ¶ 36 (Mr. Occhiogrosso testifying that not all aspects of the “Dial on Ring” embodiment are found in claim 1)).

Petitioner lastly points to the prosecution history of the ’024 patent in support of its position. During prosecution, the examiner initially rejected the application that issued as the ’024 patent as anticipated by the ’685 publication. Pet. 9; *see also* Ex. 1006, 312–318 (examiner’s rejection). The applicants attempted to distinguish the claims by argument, which the examiner ultimately found persuasive. Pet. 10–11; *see also* Ex. 1006, 327 (applicants’ argument), 348 (examiner’s reasons for allowance). Petitioner focuses on the following argument made by applicants:

While the user can press the button/key to initiate captioning prior to a call being placed or received [in the ’685 publication], this method of device operation is not the same as that called for in Claim 1 in which the captioned telephone device calls the relay when a call is received and prior to the call being answered.

Pet. 10 (quoting Ex. 1006, 327).¹ According to Petitioner, however, nothing the applicants argued here was a disavowal of claim scope and, as another matter, the examiner “did not properly construe the claims.” *Id.* at 10, 15, 17.

B. Patent Owner’s Arguments Regarding the When Limitation

Patent Owner argues that “the call to the relay is placed by the captioning device ‘when a call is received,’ not at some later time.” Prelim. Resp. 2. Patent Owner bases its argument on the word “when,” which Patent Owner argues is used as an adverb to mean “at what time.” *Id.* at 3 (citing Ex. 2002, 4 (defining “when” (adv.), *inter alia*, as “at what time”); Ex. 2004, 4; Ex. 2005, 5 (same)). Patent Owner also points to the ’024 patent’s specification, which states that “the captioned telephone device immediately dials the number of the relay.” *Id.* (quoting Ex. 1001, 6:66–7:4). Patent Owner argues that it is important to dial the relay without delay because “it can take [anywhere] from a few seconds to tens of seconds for the service to be set up,” such that dialing right away allows the user to answer the call with the relay already on line. *Id.* (citing Ex. 1001, 7:4–11). Patent Owner also argues, regarding the prosecution history, that

the applicant emphasized [that] claim 1 recites that the call to the relay is placed at a specific time, which is “when a call is received,” not when a user presses a button, which, although it could occur prior to or after the call is received, would not occur *when* it is received.

Id. at 4.

¹ Claim 1 in the prosecution history is the same as issued claim 1 of the ’024 patent.

Patent Owner then sets forth its arguments why we should not adopt Petitioner's construction. Prelim. Resp. 4–11. Patent Owner's arguments against Petitioner's construction rely on the various observations and arguments just addressed, *see id.*; we do not reiterate them here.

C. Discussion of the When Limitation

Petitioner argues that the “when” limitation defines a period of time, whereas Patent Owner argues it defines a single moment. Even under Patent Owner's interpretation of “when,” however, there technically must be a period of time involved. At a bare minimum, the phone would need to invoke some sort of circuitry or software to detect whether a call is being received, and then more circuitry or software to perform the act of dialing the relay. *See, e.g.*, Ex. 1001, 6:66–7:4 (discussing “detect[ing]” the “start of an incoming call” and “dial[ing] the relay”). As the '024 patent also indicates, the captioned telephone device may interrogate “the status of the control buttons on the face of the device” to determine whether captioning is enabled, thus implying the use of further circuitry or software. *Id.* at 7:1–2. These steps take some amount of time, even if minimal, and thus Petitioner is correct that there is some time period involved.

Notwithstanding, the underlying issue is not whether there is a time period, but rather whether the when limitation countenances: (1) a scenario in which a call is received and the device waits for a user to hit a button to enable the relay, or (2) a scenario in which a call is received and the device checks if captioning was enabled already, and if so, calls the relay, and if not, does not call the relay. We first look to the word “when.”

The word “when” itself does not preclude a time period, as Patent Owner argues. *See* Prelim. Resp. 3 (emphasizing the word “immediately” in

the specification) (quoting Ex. 1001, 6:66–7:4); *id.* at 5–6 (arguing the difference between the words “when” and “between”). Patent Owner points to Exhibit 2002 for a dictionary definition of “when” (as an adverb) as “at what time.” *Id.* at 5 (definition 1a). That same dictionary also provides “in what period” (definition 1a) and “in what circumstances” (definition 1b). Ex. 2002, 4. These definitions are consistent with Petitioner’s construction of the claim and we see no reason not to consider them in our analysis here. These definitions are also consistent with our prior observation that, as a practical matter, and as countenanced by the ’024 patent’s specification, there is some time period between receiving the call and calling the relay.

Patent Owner argues that Petitioner’s construction essentially converts “when” to “between.” Prelim. Resp. 5–7. Patent Owner also argues, “the phrase ‘prior to the call being answered’ modifies when the captioning service set up occurs, not when the captioned telephone device calls the relay,” such that the claim phrase in the latter part of the when limitation, “to initiate captioning service set up prior to the call being answered,” is “simply the intended result of the captioned telephone device calling the relay.” *Id.* at 10–11. In other words, we understand Patent Owner to be arguing that the claim phrase “prior to the call being answered” is not defining an endpoint of a time period, but rather expressing what happens when the relay is called—the step results in captioning service being set up prior to the call being answered.

Reading the “prior to” phrase to modify the “to initiate” phrase, as Patent Owner proposes, is consistent with typical English grammar. *See, e.g.,* William Strunk, Jr. & E.B. White, *The Elements of Style* 30 (4th ed. 2000) (“Modifiers should come, if possible, next to the words they modify”).

The end result, extending Patent Owner’s logic, would be that the limitation only defines two events—call receipt and calling the relay. The calling of the relay occurs prior to the call being answered, but the when limitation does not include a step of answering. This is consistent with the next limitation of claim 1, which discusses what happens “after the call is answered.” Thus, when reading the word “when” in context with the rest of the limitation, the claim appears to be setting forth an if-then condition²—if a call is received, then call the relay. This is consistent with Patent Owner’s proposed construction.

We now turn to the ’024 patent’s specification. The captioned telephone device is not described as immediately dialing the relay *upon detection* of a call, but rather *after checking* the status of control buttons. Ex. 1001, 6:66–7:4. As we discussed above with respect to the two scenarios, this passage leaves open the question of what happens if captioning is not selected when the call is detected but then, before the call is answered, captioning is selected. Petitioner argues that reading this passage in a manner that forecloses its interpretation would be “exclud[ing] embodiments disclosed in the specification,” Pet. 14, but this is a matter of interpreting the disclosure, not excluding embodiments.

The remainder of the specification does not discuss this claimed feature directly, but it does discuss other features in a manner that is useful to understand the context of the when limitation. For example, the ’024 patent describes one object of the invention to be “to provide a captioned telephone service that is as automatic as it can be made.” Ex. 1001, 2:16–

² In a manner similar to definition 1b above, “in what circumstances.”

19. When discussing the dial delay feature (essentially, the opposite scenario as claimed, where the assisted user is initiating the call), the '024 patent instructs the reader to “[a]ssume . . . that the assisted user wants the default configuration to be that his or her calls are . . . captioned.” *Id.* at 4:24–26. This is in line with the prior goal of making the device automatic and, at least facially, suggests that the user does not intervene to initiate calling; a setting is made prior to receipt/placement of the call. In another section, the '024 patent describes the assisted user's phone to be “set up to answer and automatically initiate captioning by a call on the second telephone line 18 to the relay 20.” *Id.* at 5:34–36. Specifically, “when a call is received by the telephone 10, it can test the condition of the second telephone line.” *Id.* at 5:36–37. The word “when” here is used in the if-then, “in what circumstances” meaning of the word, implying that it performs one step then another in sequence. In yet another section, the '024 patent discusses a similar feature in which one step is performed and then another: “If an incoming call is received . . . while the telephone is ringing, the captioned telephone device 12 checks the status of the second telephone line 18. If the second telephone line 18 is available, the normal implementation of two-line captioning can proceed.” *Id.* at 5:56–60. It is clear that the call to the relay here occurs immediately, without waiting for a user, because the '024 patent states that if the second line is unavailable, it notifies the user so that she can decide whether to answer the call without captioning. *Id.* at 5:60–66. These passages convey a general theme of the '024 patent to make the calling of the relay automatic upon receiving a call, without user intervention; this is consistent with Patent Owner's

construction. On the other hand, we do not find any embodiments in the '024 patent specification explicitly consistent with Petitioner's construction.

We lastly turn to the prosecution history. *See, e.g.*, Ex. 1006, 316 (examiner's 102 rejection), *id.* at 327 (applicants' arguments), *id.* at 348 (examiner's reasons for allowance). Applicants made the argument that "the '685 [Publication] requires that the user take action (e.g., press a button or a key) in order to invoke the captioning service," later contrasting this as "not the same as that called for in Claim 1 in which . . . [paraphrasing of claim language]." *Id.*; *see also* Prelim. Resp. 4 (characterizing applicants' argument as placing the call "at a specific time . . . not when a user presses a button"). The examiner's reasons for allowance essentially repeated applicants' argument, without further elaboration. *Id.* at 348. Thus, it appears that both the examiner and the applicants understood the claim not to include the scenario in which assisted user intervention causes the relay to be dialed (i.e., not to include Petitioner's proposed construction).

D. Conclusion Regarding the When Limitation

We have considered the evidence before us, including the claim language itself, the '024 patent's specification (*e.g.*, Ex. 1001, 2:16–19, 4:24–26, 5:34–41, 5:56–60, 6:62–7:16), the prosecution history (Ex. 1006, 316, 327, 348), and the level of ordinary skill (*e.g.*, Ex. 1004 ¶ 32). We are not persuaded that Petitioner's construction is the broadest reasonable interpretation in light of the specification. Petitioner argues that its construction is not precluded by the specification,³ but the broadest

³ *See, e.g.*, Pet. 13 ("the claim element does not exclude a captioned telephone device making a connection to the relay in response to a user activating a control so long as the captioned telephone device calls the relay

reasonable interpretation extends only to those constructions *consistent with* the specification. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (Claim limitations must be read “in light of the specification as it would be interpreted by one of ordinary skill in the art.”). The burden is on Petitioner to show why we should institute review, and Petitioner has not persuaded us that its construction is consistent with the specification.⁴ Therefore, we do not adopt Petitioner’s construction. Because Petitioner’s anticipation ground is premised solely upon its claim construction, we determine that Petitioner has not demonstrated a reasonable likelihood of success in showing anticipation. Accordingly, we do not institute *inter partes* review.

III.ORDER

In view of the foregoing, it is hereby ORDERED that the Petition for *inter partes* review is *denied*.

within the recited time period”).

⁴ Although a petitioner cannot be expected to preempt every argument a patent owner may make, it is reasonable to expect Petitioner here to have addressed this issue thoroughly because Petitioner was both aware of Patent Owner’s general position and aware that it was a critical issue in this case. *See* Pet. 13 (“the Patent Owner may argue that the claim requires automatic initiation of the call to the relay . . .”); *id.* at 15–17 (Petitioner discussing prosecution history, where this issue was dispositive).

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