

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAPTIONCALL, LLC,
Petitioner,

v.

ULTRATEC, INC.,
Patent Owner.

IPR2020-01216
Patent 10,491,746 B2

Before WILLIAM V. SAINDON, NATHAN A. ENGELS and
SCOTT B. HOWARD, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

INTRODUCTION

A. Background and Summary

CaptionCall, LLC (“Petitioner”) filed a Petition to institute an *inter partes* review of claims 3, 4, 5, and 12 of U.S. Patent No. 10,491,746 B2 (Ex. 1001, “the ’746 patent”). Paper 1 (“Pet.”). Ultratec, Inc. (“Patent Owner”) filed a Patent Owner’s Preliminary Response. Paper 6 (“Prelim. Resp.”). Pursuant to our authorization (Ex. 3001), Petitioner filed a Reply directed to Petitioner’s argument that we exercise our discretion pursuant to 35 U.S.C. § 325(d) to deny institution (Paper 7), and Patent Owner submitted a Sur-reply (Paper 8).

B. Real Parties in Interest

Petitioner identifies CaptionCall LLC and Sorenson Communications, LLC as the real parties in interest. Pet. 3.

Patent Owner identifies Ultratec, Inc. and CapTel, Inc. as the real parties in interest. Paper 3, 1 (Patent Owner’s Mandatory Notices).

C. Related Matters

The parties identify U.S. Patent Nos. 10,587,751 (which is subject to a pending petition in IPR2020-01217), 8,515,024, and 7,660,398 and U.S. Patent Application No. 16/677,293 as related patents or patent applications which may be affected by this proceeding. Pet. 3; Paper 3, 1–2. The parties also identify U.S. Patent No. 7,660,398 (“the ’398 patent”) and proceedings involving the ’398, including *CaptionCall LLC v. Ultratec, Inc.*, IPR2014-01287 (“IPR ’1287”), which may affect the decision here. Pet. 3; Paper 3, 2.

D. The ’746 Patent

The ’746 patent relates to a captioned telephone service that provides assistance to a user who is hard of hearing. Ex. 1001, code (57). Using a captioned telephone device, an assisted user receives normal voice from a

remote party, as well as a text transcription of the words spoken by the remote party. *Id.* at 1:50–57. The '746 patent describes a two-line captioned telephone service in which an assisted user's captioned telephone device connects via a first telephone line to a remote user and via a second telephone line to a relay that provides captioning for a conversation. *Id.* at 2:10–15.

Figure 2 of the '746 patent is reproduced below.

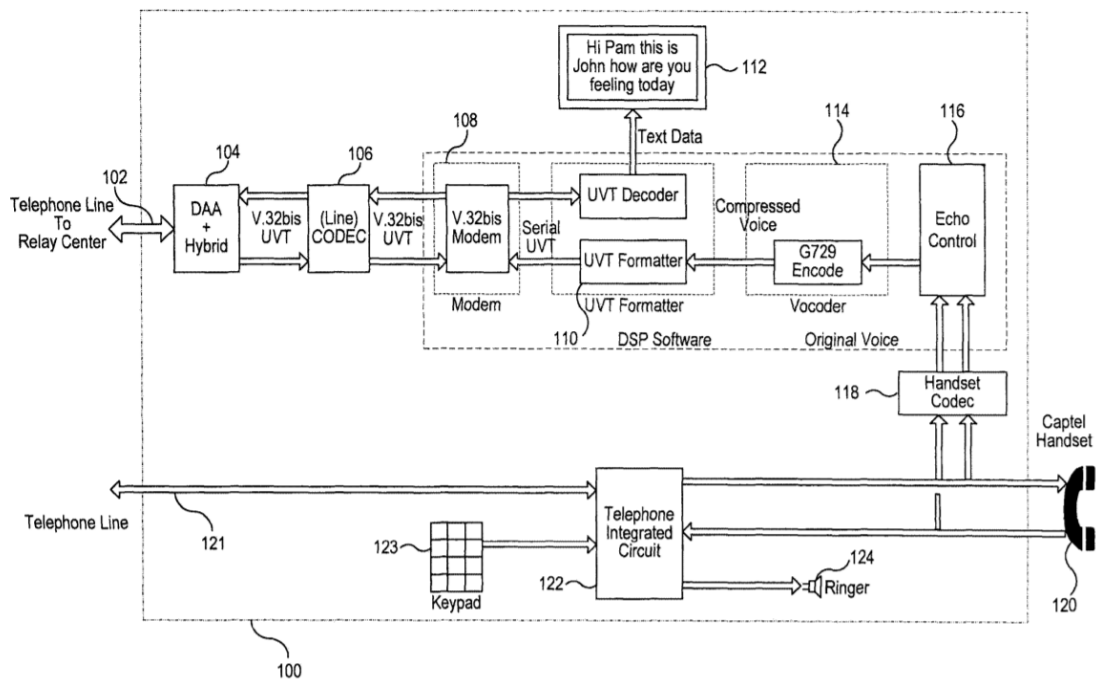


FIG. 2

Figure 2 is a schematic diagram of captioned telephone device 100 with an integrated telephone for the assisted user. *Id.* at 3:24–28. The captioned telephone device connects to a remote party via telephone line 121 and to a relay center via telephone line 102. *Id.* at 3:40–42, 3:60–64. The captioned telephone device passes the voice signal from telephone line 121 to the speaker in handset 120 for the assisted user. *Id.* at 3:60–62. It also passes the voice signal to codec 118 to be digitized and eventually sent to the relay over telephone line 102. *Id.* at 3:52–54. “[E]cho control circuit 116 is used

to remove the voice of the assisted user at . . . handset 120 from the voices of the other party.” *Id.* at 3:54–57. The remaining components compress, format, and send the signal to the relay over telephone line 102. *Id.* at 3:57–60. The relay transcribes the remote user’s voice to text, which is sent to the captioned telephone device via telephone line 102 and digitized, formatted, and transferred to visually readable display 112. *Id.* at 3:40–52.

E. Illustrative Claims

Claim 3 is an independent claim. Claim 3, reproduced below, is illustrative of the subject matter of the challenged claims.

3. A method of facilitating a captioned telephone call using a captioned telephone device used by an assisted user, the captioned telephone device connectable by a first line to a remote user and a second line to a relay providing captioning for a conversation, wherein the captioned telephone device includes at least one caption control feature for selecting automated captioning upon reception of an incoming call, the method comprising the steps of:

upon detecting an incoming call on the first line, without any assisted user input subsequent to the start of the call, the captioned telephone device checking a status of the caption control feature and, when a captioning default is selected, automatically calling the relay on the second line to initiate captioning service set up;

at the relay, a call assistant assigned to the call to generate text captions corresponding to words spoken by the remote user;

the captioned telephone device passing spoken words received from the remote user on the first line to the second line; and

the relay providing text captions of the spoken words back to the captioned telephone device on the second line, wherein words received on the first line include words spoken by the assisted user and words spoken by the remote user, the step of passing spoken words on the first line to the second line

including cancelling the words spoken by the assisted user and only passing words spoken by the remote user to the second line.

Ex. 1001, 11:1–28

F. Prior Art and Asserted Grounds

Petitioner asserts that claims 3, 4, 5, and 12 would have been unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §¹	Reference(s)/Basis
3, 12	103(a)	Engelke '685, ² Nelson, ³ Cannon ⁴
4, 5	103(a)	Engelke '685, Nelson, Cannon, Millios ⁵
3, 12	103(a)	Engelke '685, Nelson, Johnson ⁶
4, 5	103(a)	Engelke '685, Nelson, Johnson, Millios
3,12	103(a)	Engelke '685, Kinoshita ⁷
4, 5	103(a)	Engelke '685, Kinoshita, Millios

Petitioner also relies upon the testimony of Benedict J. Occhiogrosso (Ex. 1003).

¹ The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. § 103 that became effective on March 16, 2013. Because the '746 patent claims the benefit of the filing date from an application filed before March 16, 2013, we apply the pre-AIA version of the statutory basis for unpatentability. *See* Ex. 1001, code (63).

² US 2002/0085685 A1, published July 4, 2002 (Ex. 1004).

³ US 2003/0097262 A1, published May 22, 2003 (Ex. 1005).

⁴ US 6,430,270 B1, issued August 6, 2002 (Ex. 1006).

⁵ US 5,463,665, issued October 31, 1995 (Ex. 1008).

⁶ WO 87/50222, published December 31, 1997 (Ex. 1007).

⁷ US 2003/0045329 A1, published March 6, 2003 (Ex. 1009).

ANALYSIS

A. Legal Standards

In *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), the Supreme Court set out a framework for assessing obviousness under 35 U.S.C. § 103 that requires consideration of four factors: (1) the “level of ordinary skill in the pertinent art,” (2) the “scope and content of the prior art,” (3) the “differences between the prior art and the claims at issue,” and (4) objective evidence of non-obviousness such as “commercial success, long-felt but unsolved needs, failure of others, etc.” *Id.* at 17–18. “While the sequence of these questions might be reordered in any particular case,” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 407 (2007), the U.S. Court of Appeals for Federal Circuit has “repeatedly emphasized that an obviousness inquiry requires examination of all four *Graham* factors and that an obviousness determination can be made only after consideration of each factor,” *Nike, Inc. v. Adidas AG*, 812 F.3d 1326, 1335 (Fed. Cir. 2016), *overruled on other grounds by Aqua Prods., Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017) (en banc). We note that, with respect to the fourth *Graham* factor, the parties have not presented argument or evidence directed to objective evidence of nonobviousness. *See generally* Pet.; Prelim. Resp. Because neither party addressed objective evidence of obviousness at the time (*see generally* Pet.; Prelim. Resp.), the analysis below only addresses the first three *Graham* factors.

B. Level of Ordinary Skill in the Art

Factors pertinent to a determination of the level of ordinary skill in the art include “(1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and

(6) educational level of active workers in the field.” *Envtl. Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 696–697 (Fed. Cir. 1983) (citing *Orthopedic Equip. Co. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1381–82 (Fed. Cir. 1983)). “Not all such factors may be present in every case, and one or more of these or other factors may predominate in a particular case.” *Id.*

Petitioner argues that a person having ordinary skill in the art (“POSITA” or “POSA”) “would have had a bachelor’s degree in electrical engineering (or electrical and computer engineering) and a few years of experience with telephone communication system architecture, design and implementation, digitization of voice, and/or traditional relay systems.” Pet. 8 (citing Ex. 1003 ¶¶ 38–41). Petitioner further argues that “[a] person with less technical education but more experience, or vice versa, would have also met this standard.” *Id.*

Patent Owner does not explicitly address the level of skill. *See* Prelim. Resp. 11 (arguing “Petitioner’s arguments fail even under its recited definition of a [person having ordinary skill in the art]”). *Id.*

Because Petitioner’s recitation of the level of skill in the art is supported by the testimony of Mr. Occhiogrosso and not disputed at this time by Patent Owner, we adopt Petitioner’s proposed level of ordinary skill.

C. Claim Construction

We construe claims “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b).” 37 C.F.R. § 42.100(b) (2019). Specifically, we apply the principles set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–17 (Fed. Cir. 2005) (en banc). Under that standard, the words of a claim are generally given their “ordinary and customary meaning,” which is the meaning the

term would have to a person of ordinary skill at the time of the invention, in the context of the entire patent including the specification. *Phillips*, 415 F.3d at 1312–13.

Neither Petitioner nor Patent Owner requests that we construe any claim limitations. *See* Pet. 8; Prelim. Resp. 11.

Because no express construction is needed to resolve any dispute in this proceeding, we do not construe any of the claim limitations. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (noting that “we need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

D. Engelke ’685, Nelson, and Cannon, both without and with Millios

Petitioner argues that claims 3 and 12 would have been obvious over Engelke ’685, Nelson, and Cannon, and that claims 4 and 5 would have been obvious over Engelke ’685, Nelson, Cannon, and Millios. Based on the current record and for the reasons that follow, we are not persuaded that Petitioner has established a reasonable likelihood of prevailing with respect to any of the challenged claims.

1. Engelke ’685

Engelke ’685 is titled “System for Text Assisted Telephony” and describes both a one-line and a two-line captioned telephone service. Ex. 1004, code (54), ¶¶ 37–39. In a one-line captioned telephone service, a hearing user communicates through a telephone line with a relay, which converts the hearing user’s voice to text and transmits both the text and the hearing user’s voice to an assisted user’s captioned telephone device. *Id.*

¶ 37. In two-line captioned telephone service, the assisted user has two telephone lines, as shown in Figure 5, reproduced below.

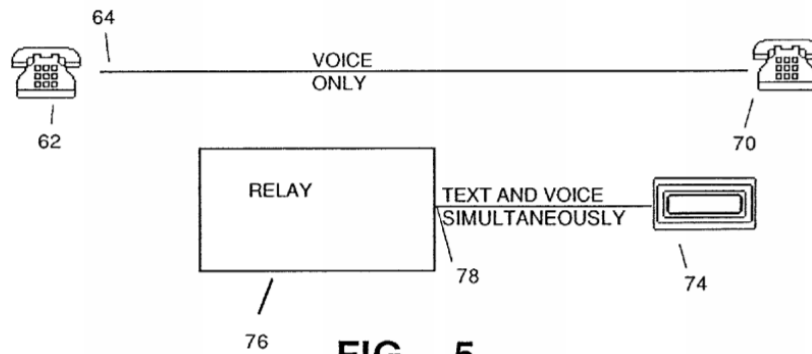


FIG. 5

Figure 5 illustrates two-line captioned telephone service, in which telephone 62 of the hearing user and telephone 70 of the assisted user are connected by telephone line 64. *Id.* ¶ 38. Personal interpreter/captioned telephone “PICT” device 74 transmits the voice signals on the first telephone line 64 to the second telephone line 78. *Id.* ¶ 40. Relay 76 converts the voice of the hearing user to text, which is transmitted via telephone 78 to captioned telephone device 74 for display to the assisted user. *Id.* ¶ 39.

Engelke ’685 also describes a particular type of relay, referred to as a “re-voicing relay.” *Id.* ¶¶ 25–35. In a re-voicing relay, a call assistant uses a headset with earphones and a microphone to listen to the hearing user’s voice and repeat the words spoken by the hearing user. *Id.* ¶ 25. The call assistant’s headset connects to a computer that has voice recognition software for translating the call assistant’s spoken words into text. *Id.* ¶ 26. The headset’s earphones may have noise cancellation capability “to cancel the sounds of the call assistant’s own voice” so the call assistant “would be less likely to be distracted by the words that he or she has spoken.” *Id.* ¶ 29.

2. *Nelson*

Nelson is titled “Handheld Device Having Speech-To Text Conversion Functionality” and is directed to “a handheld computing device having speech-to-text conversion functionality.” Ex. 1005, code (54), ¶ 1. More specifically, Nelson describes “[a] method of receiving voice communications, converting the voice communications to text, and displaying the text to a user.” *Id.* ¶ 17. As explained in Nelson Figure 3 (not reproduced) and paragraph 17, as a result of following the disclosed method, “the user may receive the telephone call as audible speech on the speaker and as visible text on the display.” *Id.* ¶ 17, Fig. 3.

3. *Cannon*

Cannon is titled “Automatic Conversational Record” and is directed “to customer premises equipment which automatically records the conversation between the user and the calling or called party based on a comparison of predetermined call related information relating to the calling or called party with predetermined entries in an appropriate table.” Ex. 1006, code (54), 1:9–14. Cannon describes, *inter alia*, how “only one side of the conversation may be recorded using an appropriate hybrid echo canceler (HEC). For instance, the far end voice may be canceled from the conversation leaving only the near end user’s voice for recording.” *Id.* at 5:13–17.

4. *Millios*

Millios is titled “Relaying of Messages Between Hearing Impaired Callers Using Keyboards and Other Callers” and is directed to “relaying calls between hearing impaired telephone callers using TDD (Telecommunications Device for the Deaf) or ASCII (a computer protocol) technology and other users including voice users, and particularly to

automatically connecting and completing such relay calls.” Ex. 1008, code (54), 1:6–11. More specifically, Millios discusses how the platform (CP1) monitors the call’s progress. For example, in discussing Figure 4 (not reproduced), Millios states that

the platform CP1 then asks whether the call has been answered. If yes, the call proceeds to step 414 and the platform CP1 bridges a CA [(communications assistant)] at one of the positions PO1 onto the call to perform the relay. If the answer is no, that is, the line is busy, out of order, or gives no answer, the platform CP1 in step 417 informs the caller automatically and no CA is needed unless requested. Because a large number of calls are either busy or give no answer, the use of the steps in FIG. 4 reduces the overall work time by avoiding use of the CA’s for calls that cannot be completed.

Id. at 5:11–20.

5. *Analysis of Claims 3–5 and 12*

a) *Petitioner’s Arguments*

Petitioner argues that a person having ordinary skill in the art would have been motivated to modify the teachings of Engelke ’685 in view of Cannon. *See* Pet. 23–28. Specifically, Petitioner argues that “Engelke ’685 already recognized that the call assistant is undertaking a difficult task to re-voice the sounds heard in the call assistant’s ear.” Pet. 24 (citing Ex. 1004 ¶ 29).⁸ According to Petitioner, Engelke ’685 teaches using “noise-cancelling headphones so that the call assistant would not hear their own voice, and thus avoid distraction while generating a transcription of the hearing user’s voice.” *Id.* (citing Ex. 1004 ¶ 29).

⁸ The parties italicize the names of prior art references. This Decision omits the italics.

Petitioner further argues that a reference by the same inventor, Engleke '825⁹ discusses

how the call assistant must be allowed to clearly distinguish between the two callers, or in other words, must be able to avoid the difficulty and distraction of determining which of the two voices on the telephone call to transcribe. To facilitate overcoming that issue, in Engleke '825, Engleke taught that the assisted user's voice could be attenuated, pitch shifted, or filtered so that the call assistant is better able to discriminate between the two voices, the one to be transcribed and the one to be ignored.

Pet. 24 (citing Ex. 1010 ¶ 23; Ex. 1003 ¶¶ 58–59).

Petitioner further argues that “simply attenuating, pitch shifting, filtering, or otherwise modifying the voice of the assisted user is only a partial solution, as the call assistant would still hear the words spoken by the assisted user.” Pet. 24–25. Petitioner further argues that “[a] POSITA would recognize that complete removal of the assisted user's voice such that the call assistant receives only the hearing user's voice would distract the call assistant even less than the partial solution of Engleke '825.” *Id.* at 25. According to Petitioner, a person having ordinary skill in the art “would have been motivated to incorporate the complete removal of the words spoken by the assisted user's voice, effectively isolating one side of the telephone conversation for processing, to further avoid distraction for the call assistant when generating a transcription of the hearing user's voice on the call.” *Id.* (citing Ex. 1003 ¶ 60).

As further support, Petitioner argues that Engleke '685 “includes teachings that suggest that only the voice of the hearing user is sent to the relay in the two-line captioned telephone embodiment.” Pet. 25–26 (citing

⁹ US 2001/0005825, published June 28, 2001 (Ex. 1010).

Ex. 1004 ¶¶ 38, 39). According to Petitioner, Engelke '685 does not provide an explicit teaching on how to achieve that feature and that “a POSITA would have looked to other telephony art at the time where one side of a conversation is isolated to independently process only that side of the conversation.” *Id.* at 26 (citing Ex. 1003 ¶ 61). One such reference identified by Petitioner is Cannon. *Id.* at 26–28 (citing Ex. 1003 ¶¶ 62–66; Ex. 1006, code (54), 1:6–14).

b) Patent Owner's Arguments

Patent Owner argues that Petitioner has failed to show that a person having ordinary skill in the art “would have recognized that it was problematic for the call assistant to receive the assisted user’s voice” or “would have been motivated to look to general telephony art to solve this unrecognized problem.” Prelim. Resp. 28; *see also id.* at 28–32.

First, Patent Owner argues that “Engelke '685 does not provide motivation to cancel the assisted user’s voice in a two-line system.” Prelim. Resp. 28. Accordingly to Patent Owner, “[i]n Engelke '685’s two-line system, voices of the hearing user and assisted user are sent to the call assistant at the relay.” *Id.* (citing Ex. 1004 ¶ 40). Patent Owner further argues that “the Board previously rejected Petitioner’s argument that the ‘assisted user’s device transmits only the hearing user’s voice signal to the call assistant’, finding that Engelke '685 ‘does not cancel any user’s voice from any telephone line.’” *Id.* at 29 (quoting Ex. 2003, 18–19; Ex. 2002, 11); *see also id.* at 29–30 (discussing Engelke '685 in detail) (citing Ex. 1004 ¶¶ 38–40, Ex. 2002, 3).

Patent Owner further argues that Engelke '685 “is limited to distraction by the call assistant’s own voice and does not suggest that the call assistant is distracted by the assisted user’s voice, as opposed to assisted by

the context of the other side of the conversation.” Prelim. Resp. 30 (discussing Ex. 1004 ¶ 29).

Second, Patent Owner argues that “Engelke ’825 similarly fails to teach or motivate a POSA to cancel the assisted user’s voice and, in fact, discourages cancelling the assisted user’s voice.” Prelim. Resp. 30. Patent Owner further argues that Engelke ’825 explicitly teaches transmitting the assisted user’s voice to supply context to the call assistant: “The call assistant hearing the assisted user’s voice is by design because, as explained by Engelke ’825, the assisted user’s ‘voice signal 30 [the assisted user’s voice] provides the call assistant 40 with context for a transcribed portion of the conversation.” *Id.* at 30–31 (quoting Ex. 1010 ¶ 23). According to Patent Owner, “[b]ased on this disclosure, a POSA would not be motivated to cancel the assisted user’s voice because it would remove the taught beneficial context for the transcribed portion of the call.” *Id.* at 31.

Third, Patent Owner argues that “Mr. Occhiogrosso’s declaration is conclusory and unsupported.” Prelim. Resp. 31. Specifically, Patent Owner argues that “Mr. Occhiogrosso provides no support that a POSA would have thought to cancel the assisted user’s voice at the captioned telephone device based on the disclosure of a call assistant’s headphones cancelling the call assistant’s voice.” *Id.* (citing Ex. 1003 ¶ 60; Ex. 2002, 11–13).

c) Our Analysis

Arguments for unpatentability based on obviousness must be supported by “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), *cited with approval in KSR*, 550 U.S. at 418. The requirement for a reason to combine the reference acts as a check on the potential for the improper use of hindsight. *See Plantronics, Inc. v. Aliph*,

Inc., 724 F.3d 1343, 1354 (Fed. Cir. 2013) (holding that an articulated reasoning “is especially important to guard against the dangers of hindsight bias”). Based on the current record, we are not sufficiently persuaded by Petitioner’s argument that a person having ordinary skill in the art would have modified Engelke ’685 to cancel the words spoken by the assisted user.

First, we agree with Patent Owner that Engelke ’685 does not address cancelling the words spoken by the assisted user. The only discussion of cancellation is in paragraph 29, which discusses cancelling the words spoken by the call assistant, not the assisted user, to prevent distractions associated with hearing their own voice:

It is a further enhancement to the operation of the relay constructed in accordance with the present invention that the earphones 38 have noise attenuating capability. Noise canceling earphones are commercially available today or, for this purpose, the computer 42 can be provided with noise canceling sound generation software which would create sound transmitted to the earphone 38 *so as to cancel the sounds of the call assistant’s own voice*. The noise attenuation or cancellation avoids distracting the call assistant, since he or she would then be less distracted by the words that he or she has spoken, and thus would be less likely to be distracted from the concentration of the task of re-voicing the sounds of the voice heard in the call assistant’s ear.

Ex. 1004 ¶ 29 (emphasis added). Nothing in paragraph 29 teaches or suggest cancelling the words spoken the assisted user. *See id.*

We are also not persuaded by Petitioner’s argument that Engelke ’685 paragraphs 38 and 39 teach not transmitting the words of the assisted user. Those paragraphs simply state that the voice of the hearing user is transmitted to the call assistant; they do not state, as Petitioner contends, that the call assistant receives *only* the voice of the hearing user. *See* Ex. 1004 ¶¶ 38–39. As the following paragraph explains, the “device automatically

transmits *the voice signals on the first telephone line* to the second telephone line (through the low-pass filter 86) for transmission to the relay.” *Id.* ¶ 40. The first line is used to transmit voice signals of both the remote user and the assisted user. Indeed, even Petitioner and its expert concede that the conversation of both the assisted user and hearing user are transmitted on the second line to the call assistant. *See* Pet. 12–13 (“A captioning device 74 includes a second line 78 that conveys the audio of the conversation between the assisted user and the hearing user on the first line 64 to a call assistant at a relay 76.”); Ex. 1003 ¶ 44 (same).

Second, we are not sufficiently persuaded by Petitioner’s arguments that Engelke ’825 teaches cancelling the words of the assisted user. Although Engelke ’825 teaches attenuating, pitch shifting, or filtering one of the voices to help the call assistant distinguish the two voice, Engelke ’825 teaches the importance of the call assistant hearing *both* voices to provide context:

The voice signal 30 provides the call assistant 40 with context for a transcribed portion of the conversation. The attenuator 23 modifies the voice signal 30 so as to allow the call assistant 40 to clearly distinguish it from the principal transcribed conversation from user 12. Other forms of discriminating between these two voices may be provided including, for example, slight pitch shifting or filtering.

Ex. 1010 ¶ 23. Accordingly, Engelke ’825 does not teach cancelling the words of the assisted user.

To the contrary, Engelke ’825 teaches away from cancelling the words of the assisted user. “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *DePuy*

Spine, Inc. v. Medtronic Sofamor Danek, Inc., 567 F.3d 1314, 1327 (Fed. Cir. 2009) (quoting *Ricoh Co. v. Quanta Comput. Inc.*, 550 F.3d 1325, 1332 (Fed. Cir. 2008)). However, “[a] reference does not teach away, however, if it merely expresses a general preference for an alternative invention but does not ‘criticize, discredit, or otherwise discourage’ investigation into the invention claimed.” *Id.* (quoting *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004)).

In this case, Engelke ’825 does more than express a general preference. Rather, Engelke ’825 discusses the importance of the call assistant hearing both the remote user and the assisted user in order to provide context:

In operation, the relay 10 receives the voice signal 16 [of hearing user 12] at computer 18 through an automatic gain control 36 providing an adjustment in gain to compensate for various attenuations of the voice signal 16 in its transmission. It is then combined with an attenuated version of the voice signal 30 (the other half of the conversation [by the deaf or hearing impaired user]) arriving via attenuator 23. *The voice signal 30 provides the call assistant 40 with context for a transcribed portion of the conversation.*

Ex. 1010 ¶ 29 (emphasis added); *see also id.* at Fig. 1, ¶ 20 (support for modifications). The discussion of the importance of context would have discouraged a person having ordinary skill in the art from cancelling the words to the assisted user and removing context.

Third, we do not find Mr. Occhiogrosso’s testimony sufficiently persuasive. Mr. Occhiogrosso’s testimony is substantially the same as Petitioner’s arguments and suffers the same defects discussed above. *Compare* Pet. 23–28, *with* Ex. 1003 ¶¶ 57–66.

Moreover, the crux of Mr. Occhiogrosso's testimony is paragraph 59, which explains why a person having ordinary skill in the art would have gone from "attenuating, pitch shifting, filtering, or otherwise modifying the voice of the assisted user" to the "complete removal of the assisted user's voice." *See* Ex. 1003 ¶ 59. However, Mr. Occhiogrosso provides no support for his opinion and does not cite any prior art reference that recognizes the problem he is purporting to solve. *See id.* We give such conclusory, unsupported assertions little weight. *See 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."); *Verlander v. Garner*, 348 F.3d 1359, 1371 (Fed. Cir. 2003) (Board has discretion to accord little weight to broad conclusory statements from expert witness); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 294 (Fed. Cir. 1985) (noting that the "[l]ack of factual support" for an expert opinion "may render the testimony of little probative value"); 37 C.F.R. § 42.65(a) ("Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.").

Accordingly, for the reasons discussed above, Petitioner has not provided sufficient reasoning with rational underpinning to prove why a person having ordinary skill in the art would have modified Engelke '685 with Cannon's noise cancelling technology. Therefore, the Petition has not demonstrated a reasonable likelihood of success in challenging claims 3 and 12 as obvious under 35 U.S.C. § 103(a) over Engelke '685 in view of Nelson and Cannon or claims 4 and 5 as obvious under 35 U.S.C. § 103(a) over Engelke '685 in view of Nelson, Cannon, and Millios.

E. Grounds Based on Engelke '685 and either Johnson or Kinoshita

1. Johnson

Johnson is titled “Wireless Smart Phone” and is directed “to a telephone device that includes a computer system that enable the telephone device to perform data processing functions.” Ex. 1007, code (54), 1:4–8. Relevant to this proceeding, Johnson teaches recording both parties to a phone call or only one of the parties:

A recording can also be made while a telephone call is in progress. It is possible to record not only the user of the telephone device of the present invention, but also the connected party on the other end of the telephone call. To record both sides of a telephone call in progress, switch 240 and switch 241 are both closed. By closing switch 240, the connected party is being recorded. By closing switch 241, the user of the telephone device that is speaking into microphone 108 is being recorded.

Id. at 16:16–23.

2. Kinoshita

Kinoshita is titled “Mobile Terminal Device and Method for Recording and Processing Telephone Call” and is directed to “a mobile terminal device for performing voice recognition, recording, and editing of a telephone call conversation in the mobile terminal device.” Ex. 1009, code (54), ¶ 2. Relevant to this proceeding, Kinoshita teaches that the controller of the cellular telephone could “take call packets of a caller and recognize only the caller’s voice” such that “only the caller’s part of the conversation (received voice) is transformed into [text] strings and stored.” *Id.* ¶¶ 39, 43.

3. Our analysis

In addition to the grounds based on combining Engelke '685 and Cannon, the Petition also sets forth grounds based on the combination of Engelke '685 with either Johnson or Kinoshita. *See* Pet. 6–7. As with the

grounds discussed in the previous section, Petitioner relies on Engelke '685 for the two-line captioned telephone service and either Johnson or Kinoshita for noise cancellation technology. *See* Pet. 37–54. Although the secondary reference is different in these additional grounds, Petitioner relies on substantially the same rationale for why a person having ordinary skill in the art would have modified Engelke '685. *See, e.g.,* Pet. 37 (“[A] POSITA would also have been motivated, at the time of the alleged invention of the '746 Patent, to modify the teachings of Engelke '685 with those of Johnson. For example, *for the same reason as described above for Ground 1*, a POSITA would have been motivated to modify the two-line captioned telephone device of Engelke '685 to include a feature to send only the words spoken by the remote user to the relay over the second line by isolating one side of the conversation.” (Emphasis added)), 46 (“Therefore, *as described above with respect to Ground 1*, a POSITA would have looked to other telephony art where one side of a conversation is isolated. Kinoshita provided another example of such a teaching.” (Emphasis added)).

Because Petitioner’s reason to combine is substantially the same as the reason given to combine Engelke '685 and Cannon, for the same reason as discussed above, Petitioner has not provided sufficient reasoning with rational underpinning to prove why a person having ordinary skill in the art would have modified Engelke '685 with Johnson’s or Kinoshita’s noise cancelling technology. Therefore, the Petition has not demonstrated a reasonable likelihood of success in challenging (1) claims 3 and 12 as obvious under 35 U.S.C. § 103(a) over Engelke '685 in view of Nelson and Johnson; (2) claims 4 and 5 as obvious under 35 U.S.C. § 103(a) over Engelke '685 in view of Nelson, Johnson, and Millios; (3) claims 3 and 12 as obvious under 35 U.S.C. § 103(a) over Engelke '685 in view of

Kinoshita; or (4) claims 4 and 5 as obvious under 35 U.S.C. § 103(a) over Engelke '685 in view of Kinoshita and Millios.

F. Discretionary Denial Pursuant to 35 U.S.C. § 325(d)

Patent Owner also argues that because a panel in an *inter partes* review involving a related patent determined “that a POSA would not have been motivated to modify Engelke '685 with a voice cancellation reference to cancel the assisted user’s voice in a two-line system,” we “should exercise its discretion to deny institution now.” Prelim. Resp. 11; *see also id.* at 12–26 (substance of argument).

Because we determine that Petitioner failed to show a reasonable likelihood that claims 3–5 and 12 are unpatentable based on the grounds presented, we do not address this argument.

CONCLUSION

For the foregoing reasons, we determine that Petitioner has failed to show a reasonable likelihood that claims 3–5 and 12 are unpatentable based on the grounds presented. Accordingly, we do not institute *inter partes* review of those challenged claims based on the current Petition.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314, no *inter partes* review is instituted as to any claim of the '746 patent.

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Patent 10,491,746 B2

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