

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ULTRATEC, INC.,  
Petitioner,

v.

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

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Case PGR2016-00037  
Patent 9,197,745 B1

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

BENOIT, *Administrative Patent Judge*.

DECISION  
Denying Institution of Post-Grant Review  
37 C.F.R. § 42.208

## I. INTRODUCTION

Ultratec, Inc. (“Petitioner”) filed a Petition requesting a post-grant review of claims 1–23 of U.S. Patent No. 9,197,745 B1 (Ex. 1001, “the ’745 patent” or “the challenged patent”). Paper 1 (“Pet.”). Patent Owner, CaptionCall, L.L.C., filed a Preliminary Response. Paper 9 (“Prelim. Resp.”). We have authority to determine whether to institute a post-grant review. 35 U.S.C. § 324; 37 C.F.R. § 42.4(a). The standard for instituting a post-grant review is set forth in 35 U.S.C. § 324(a), which provides that a post-grant review may be instituted only if “the information presented in the petition . . . demonstrate[s] that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.” 35 U.S.C. § 324(a).

After considering the Petition and the Preliminary Response, we determine that the information presented in the Petition does *not* demonstrate it is more likely than not that at least one of the challenged claims is unpatentable. Accordingly, we do not institute a post-grant review.

### *A. Related Matters*

Under 37 C.F.R. § 42.8(b)(2), each party must identify any judicial or administrative matters that would affect or be affected by a decision in this proceeding. Both parties identify pending, unpublished U.S. Patent Application No. 14/942,905, filed November 16, 2015, as a matter that would affect or be affected by this proceeding. Pet. 84; Paper 5 (Patent Owner Related Matters).

*B. The '745 Patent*

The '745 patent relates to techniques for automatically connecting to a captioning communication service to receive text captions following an interruption during a call. Ex. 1001, [54]. Figure 1 of the patent is set forth below.

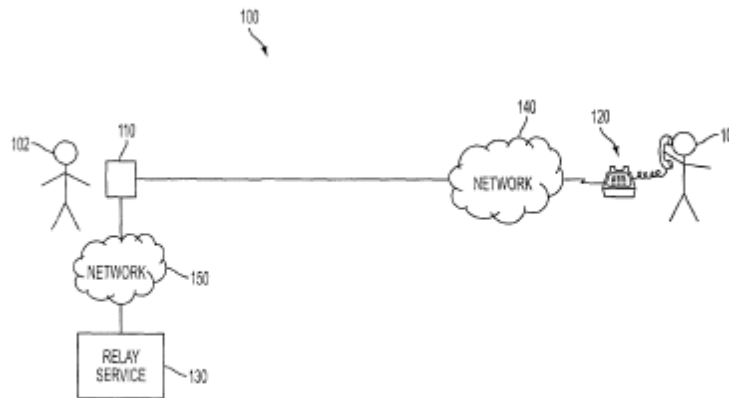


FIG. 1

As depicted in Figure 1, a communication system 100 is configured to facilitate a call between hearing-impaired user 102 and “far-end user” 104. *Id.* at 2:47–49, 4:61–63. First communication device 110 is configured to assist hearing-impaired user 102 by receiving and displaying text captions of the words spoken by far-end user 104 using second communication device 120. *Id.* at 5:27–36. To do so, relay service 130 provides, to first communication device 110 used by hearing-impaired user 102, captioning of the words spoken by far-end user into second communication device 120, which may be a conventional voice telephone. *Id.* at 5:46–48, 5:66–6:1. For example, a human call assistant at relay service 130 listens to the voice of far-end user 104 received in a voice signal and “re-voices” the heard words into a microphone at relay service 130. *Id.* at 5:66–6:8. Voice recognition

software at relay service 130 generates text captions that are transmitted to communication device 110 used by hearing-impaired user 102. *Id.* at 6:8–10.

Figure 4 of the '745 patent is set forth below.

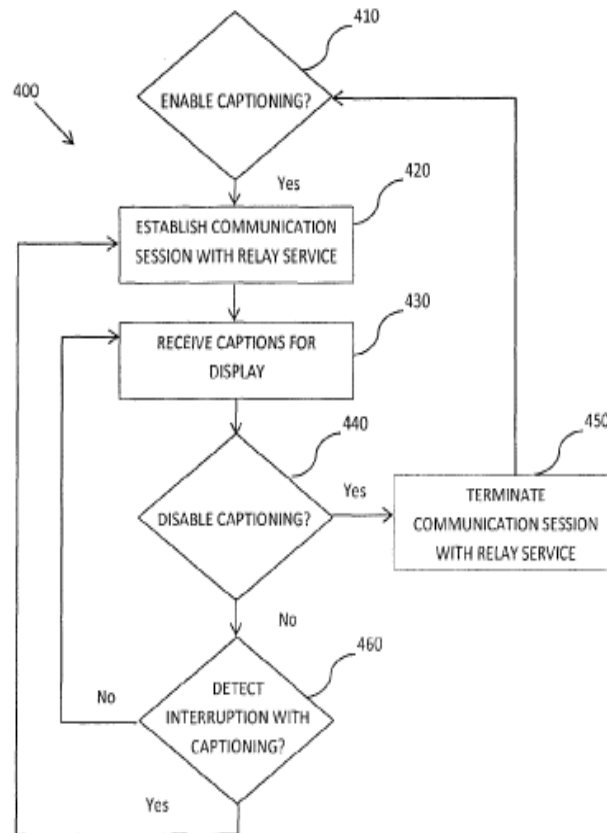


FIG. 4

Figure 4 depicts a flowchart illustrating a method for operating a communication device “to automatically reconnect with a relay service according to an embodiment of the disclosure.” *Id.* at 9:64–66. As shown, the processor of the device determines whether captioning has been enabled (step 410) and, if so, establishes a captioning communication session with

the relay service (step 420). *Id.* at 9:67–10:3. In some embodiments, “the user may select a caption button on the communication device to enable captioning.” *Id.* at 10:3–5. Text captions are received from the relay service and displayed on the communication device during the call (step 430). *Id.* at 10:18–20. Because the user may disable captioning at any time during a call, the processor determines whether the hearing-impaired user has disabled captioning (step 440) and, if so, terminates the captioning communication session between the communication device and the relay service (step 450). *Id.* at 10:22–31. If the processor detects an interruption with the captioning communication session (such as an interruption due to a network problem) (step 460), the communication device attempts to establish a captioning communication session (step 420); otherwise, the communication device continues to receive and display captions to the hearing-impaired user during the call (step 430).

### *C. Illustrative Claim*

Claims 1, 8, 9, and 21 of the ’745 patent are independent. Claim 1 is illustrative of the claimed subject matter:

1. An apparatus associated with a hearing-impaired user, the apparatus comprising:
  - communication elements configured to receive audio signals from a far end communication device, and receive captions corresponding to the audio signals from a captioning communication service that provides captioning assistance for hearing-impaired users; and
  - a processor operably coupled with the communication elements, the processor configured to:

connect with the far-end communication device through a first connection to establish a voice communication session between the apparatus and the far end communication device; and

automatically connect with the captioning communication service through a second connection to establish a captioning communication session during the voice communication session responsive to a determination that an attempted connection to the captioning communication service failed during a time in which a caption select option has been enabled by the hearing-impaired user,

wherein the attempted automatic connection through the second connection is not made during a time in which the caption select option has been disabled by the hearing-impaired user, and

wherein the first connection with the far-end communication device is maintained until being disconnected by the hearing-impaired user in both situations in which the caption select option is either enabled or disabled.

Ex. 1001, 13:37–65 (indentation added).

#### *D. Asserted Grounds of Unpatentability*

Petitioner contends that claims 1–23 of the '745 patent are unpatentable based on the following specific grounds<sup>1</sup> (Pet. 29–59):

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<sup>1</sup> The version of 35 U.S.C. § 103 that applies here is that of the Leahy-Smith America Invents Act (“AIA”), given the effective filing dates of the claims of the '745 patent. See Leahy-Smith American Invents Act, Pub. L. No. 112–29, 125 Stat. 284, 293 (2011).

| References                                                                      | Basis | Challenged Claims  |
|---------------------------------------------------------------------------------|-------|--------------------|
|                                                                                 | § 101 | 1–23               |
| Ultratec User Guide, <sup>2</sup> Engelke, <sup>3</sup> and Parker <sup>4</sup> | § 103 | 1, 8–14, and 20–23 |
| Ultratec User Guide, Engelke, Parker, and Labrador <sup>5</sup>                 | § 103 | 2–6 and 12         |
| Ultratec User Guide, Engelke, Parker, and FCC Proposed Rule <sup>6</sup>        | § 103 | 7 and 19           |
| Ultratec User Guide, Engelke, Parker, and Chitre <sup>7</sup>                   | § 103 | 15 and 16          |
| Ultratec User Guide, Engelke, Parker, and Hopkins <sup>8</sup>                  | § 103 | 17 and 18          |

*E. Eligibility of the '745 Patent for Post-Grant Review*

The post-grant review provisions of AIA apply only to patents subject to the first-inventor-to-file provisions of the AIA. AIA § 6(f)(2)(A).

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<sup>2</sup> Ultratec, Inc., *CapTel 840i How-to-Guide* (2012) (Ex. 1005, “the Ultratec User Guide” or “the 840i User Guide”).

<sup>3</sup> U.S. Patent No. 8,917,821 B2, filed Mar. 8, 2013, issued Dec. 23, 2014 (Ex. 1004, “Engelke” or “Engelke ’821”).

<sup>4</sup> U.S. Patent Application Pub. No. US 2015/0011251 A1, filed June 26, 2014, published Jan. 8, 2015 (Ex. 1006, “Parker”).

<sup>5</sup> U.S. Patent No. 8,861,703 B2, filed June 28, 2012, issued Oct. 14, 2014 (Ex. 1007, “Labrador”).

<sup>6</sup> Telecommunications Relay Services and Speech-to-Speech Services for Individuals with Hearing and Speech Disabilities, 71 Fed. Reg. 31,131 (June 1, 2006) (Ex. 1011, “FCC Proposed Rule”).

<sup>7</sup> U.S. Patent Application Pub. No. US 2014/0106699 A1, filed Oct. 17, 2013, published Apr. 17, 2014 (Ex. 1008, “Chitre”).

<sup>8</sup> U.S. Patent No. 8,804,944 B1, filed Oct. 28, 2008, issued Aug. 12, 2014

Specifically, the first inventor to file provisions apply to any application for patent, and to any patent issuing thereon, that contains or contained at any time a claim to a claimed invention that has an effective filing date on or after March 16, 2013. AIA § 3(n)(1). Furthermore, “[a] petition for a post-grant review may only be filed not later than the date that is 9 months after the date of the grant of the patent or of the issuance of a reissue patent (as the case may be).” 35 U.S.C. § 321(c); *see* 37 C.F.R. § 42.202(a).

Petitioner certifies that the ’745 patent is available for post-grant review. Pet. 5. The ’745 patent was filed March 25, 2015, its earliest effective filing date, and so on its face contains a claim that has an effective filing date on or after March 16, 2013. *See* Pet. 1; Ex. 1001, [22]. Petitioner also represents that the instant Petition was filed no later than nine months after the November 24, 2015 issue date of the ’745 patent. *See* Pet. 1; Ex. 1001, [45]; Paper 3 (according filing date of August 24, 2016). Petitioner also represents that it is not barred or estopped from requesting this post-grant review on the grounds asserted in the instant Petition. *See* Pet. 1. Patent Owner does not dispute that the ’745 patent is eligible for post-grant review. *See generally* Prelim. Resp.

We concur with Petitioner that the ’745 patent is available for post-grant review.

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(Ex. 1009, “Hopkins”).

## II. DISCUSSION

We now turn to Petitioner’s asserted grounds of unpatentability to determine whether Petitioner has met the threshold standard under 35 U.S.C. § 324(a) for instituting a post-grant review.

### A. Claim Construction

In a post-grant review, claim terms in an unexpired patent are interpreted according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.200(b); see *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) (upholding the use of broadest reasonable construction standard in *inter partes* review<sup>9</sup>). Consistent with the broadest reasonable construction standard, claim terms are presumed to have their ordinary and customary meaning as understood by one of ordinary skill in the art in the context of the entire patent disclosure at the time of the invention. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

Petitioner proposes constructions for “message” recited in claims 2, 4–8, and 12 and for “module” recited in claims 2–6 and 8. Pet. 9–11. Patent Owner challenges Petitioner’s proposed claim constructions as overly narrow. Prelim. Resp. 8–9. We determine, however, that no claim terms need express construction for this decision.

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<sup>9</sup> Regulations governing the claim construction standards for *inter partes* reviews and post-grant reviews use identical language: “[a] claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears.” Compare 37 C.F.R. § 42.100(b), with 37 C.F.R. § 42.200(b).

*B. Asserted Ground that Claims 1–23 Are Unpatentable Under § 101*

Petitioner challenges claims 1–23 of the '745 patent as directed to patent-ineligible subject matter under 35 U.S.C. § 101. Pet. 22–31. Patent-eligible subject matter is defined in 35 U.S.C. § 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

There are, however, three limited, judicially-created exceptions to the broad categories of patent-eligible subject matter in § 101: laws of nature; natural phenomena; and abstract ideas. *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293 (2012).

The Supreme Court set forth in *Mayo* and *Alice Corp. Pty, Ltd. v. CLS Bank International*, 134 S. Ct. 2347, 2355 (2014) a two-step framework “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice*, 134 S. Ct. at 2355. The first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If the claims are directed to a patent-ineligible concept, the second step in the analysis is to consider the elements of the claims “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 132 S. Ct. at 1298, 1297). In other words, the second step is to “search for an ‘inventive concept’—i.e., an element or combination of elements that is ‘sufficient to ensure that the

patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.” *Id.* (alteration in original) (quoting *Mayo*, 132 S. Ct. at 1294).

The central issue here is whether the challenged claims fall within the excluded category of abstract ideas. Thus, we start by applying the Supreme Court’s two-step framework, on a claim-by-claim basis, to determine whether a claim is “directed to” an abstract idea. This “directed to” inquiry does not “simply ask whether the claims *involve* a patent-ineligible concept” because “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016); *Mayo*, 132 S. Ct. at 1293. “Rather, the ‘directed to’ inquiry applies a stage-one filter to claims, considered in light of the specification, based on whether ‘their character as a whole is directed to excluded subject matter.’” *Id.* (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)).

Petitioner asserts that claims 1–23 describe a patent-ineligible abstract idea of “redialing,” which is “an activity that callers have performed for as long as there have been telephones.” Pet. 20. Petitioner contends that the claim steps of “detecting a failed connection” and “automatically attempting to connect” recited in independent method claim 9, and the claimed function of “automatically connect with the captioning communication service . . . responsive to a determination that an attempted connection to the captioning communication service failed . . .” recited in independent apparatus claims 1

and 8 (and similarly in independent claim 21) show that the claims are directed to the abstract idea of “redialing.” *Id.* at 21–22.

In opposition, Patent Owner correctly indicates that every improvement in computer-related technology is not necessarily abstract and so the step one analysis is applicable here. Prelim. Resp. 10–11 (quoting *Enfish*, 822 F.3d at 1335 (“We do not read *Alice* to broadly hold that all improvements in computer-related technology are inherently abstract and, therefore, must be considered at step two.”)). Patent Owner further argues that the claims recite “far more than anything resembling ‘redialing’” and are not directed to the proposed abstract concept of redialing, a term not used in the claims or specification. Prelim. Resp. 11–12. Patent Owner contends that maintaining the captioning connection for a hearing-impaired user “is not merely ‘redialing’ [because] it requires that the apparatus make specific determinations about the state of the connection, and the state of user-selected features . . . .” *Id.* at 12.

We agree with Patent Owner (Prelim. Resp. 12) that claim 1, as a whole, is directed to an apparatus that facilitates voice communication and captioned text communication using a relay for hearing-impaired users over one or more communications networks and, under specified circumstances—when captioning has been enabled by the hearing-impaired user and the system determines that an attempted connection has failed—automatically reconnects to a captioning communication service. In other words, the claim is directed to a communication device that automatically reconnects to a captioning communication service following an unwanted interruption to the

captioning communication service in certain circumstances. *See* Ex. 1001, 1:13–16 (describing the field of the disclosure as relating to a communication device that automatically reconnects to the captioning communication service “following an unwanted interruption to the captioning communication session”).

We determine that claim 1 as a whole is not directed to redialing a telephone as “callers have performed for as long as there have been telephones.” *See* Pet. 20. Moreover, the claim is directed to an apparatus having communication elements and a processor, and requires two connections and captioning, which, taken as a whole, distinguish claim 1 from a conventional telephone and further supports our determination that the claim merely involves, but is not directed to, the concept of reconnection or redialing.

Moreover, looking at the elements individually, claim 1 requires communication elements coupled with a processor configured to able to connect a communication device and connect with a captioning session over two connections. Claim 1 recites a function—“automatically connect with the captioning communication service through a second connection to establish a captioning communication session during the voice communication session responsive to a determination that an attempted connection to the captioning communication service failed during a time in which a caption select option has been enabled by the hearing-impaired user, wherein the attempted automatic connection through the second connection is not made during a time in which the caption select option has been

disabled by the hearing-impaired user”—which requires more than “redialing” a telephone. *See* Prelim. Resp. 11–12. Specifically, the claimed apparatus only performs the “automatically connect” function if three conditions are met: (i) responsive to a determination that an attempted connection to the captioning communication service failed (ii) during a time in which a caption select option has been enabled by the hearing-impaired user, and (iii) “the attempted automatic connection through the second connection is not made during a time in which the caption select option has been disabled by the hearing-impaired user.”

“The Supreme Court has not established a definitive rule to determine what constitutes an ‘abstract idea’ sufficient to satisfy the first step of the *Mayo/Alice* framework.” *Enfish*, 822 F.3d at 1334. A common approach is “to compare claims at issue to claims already found to be directed to an abstract idea in previous cases.” *Id.* Here, Petitioner asserts the challenged claims are similar to abstract claims in *Content Extraction and Transmission, LLC v. Wells Fargo Bank, National Association*, 776 F.3d 1343, 1347 (Fed. Cir. 2014), in *TLI Communications LLC Patent Litigation v. AV Automotive, L.L.C.*, 823 F.3d 607, 609–11 (Fed. Cir. 2016), and in *Planet Bingo, LLC v. VKGS LLC*, 576 Fed. App’x 1005, 1007–08 (Fed. Cir. 2014) (unpublished). Pet. 23–24.

Regarding *Content Extraction*, Petitioner contends that claim 1 is analogous to “claims for collecting, recognizing, and storing data [which] were directed to an abstract idea because “humans have always performed these functions.” *Id.* (citing *Content Extraction*, 776 F.3d at 1347).

Petitioner contends claim 1 similarly is “directed to functions that humans have always performed,” citing the specification of the challenged patent specification for support and contending that the challenged patent “concedes that redialing was ‘[c]onventionally’ performed by callers.” *Id.* at 20, 23–24 (citing Ex. 1001, 1:60–62). Petitioner, however, overgeneralizes the disclosure of the specification. The portion of the patent cited by Petitioner does not mention “redialing” but rather states “[c]onventionally, the user may need to press a caption button to start another captioning communication session with the relay service to again start to receive the text captions.” Ex. 1001, 1:60–62. Similarly, Petitioner’s assertion that the challenged patent “teaches that automating the redialing reduces the ‘burden’ on the caller” is unavailing. Pet. 20 (citing Ex. 1001, 11:7–11). Petitioner also characterizes this other portion of the specification as being directed to “redialing” (Pet. 20) when the text itself describes reconnecting the communication device used by a hearing-impaired user to the relay service in the event of that “captions are unintentionally disabled” during a call. Ex. 1001, 11:4–11.

Moreover, as Patent Owner correctly notes (Prelim. Resp. 17–18), unlike the claims in *Content Extraction*, claim 1 is not directed to “collecting, recognizing, and storing data.” Furthermore, Petitioner’s approach is predicated on discussing the claim at a high level of abstraction and virtually untethered to the language of the claim, an approach that we find unpersuasive. *See Enfish*, 822 F.3d at 1337 (criticizing an approach “describing the claims at such a high level of abstraction and untethered

from the language of the claims [because it] all but ensures that the exceptions to § 101 swallow the rule”).

For these reasons, we do not find persuasive Petitioner’s contention that claim 1 is analogous to the claims in *Content Extraction*.

Petitioner also contends claim 1 “merely recite[s] using the device to establish a connection” and so is like the recited telephone in *TLI Communications*, which was “merely a conduit for an abstract idea.” Pet. 23–24. As Patent Owner notes (Prelim. Resp. 19), the claimed telephone unit in *TLI Communications* merely performed the abstract idea of recording, communicating, and organizing images. We agree with Patent Owner’s position that claim 1 in the challenged patent is directed to “concrete [technology] specific to providing captioning to a hearing-impaired user” that cannot be added to a conventional telephone. Prelim. Resp. 19. Thus, we do not find persuasive Petitioner’s contention that claim 1 here is analogous to the claimed telephone in *TLI Communications*.

Finally, turning to *Planet Bingo, LLC v. VKGS LLC*, 576 App’x 1005, 1007–08 (Fed. Cir. 2014) (unpublished), Petitioner relies on the holding that claims directed to managing a game of bingo were directed to an abstract idea “because they related to ‘organizing human activity.’” Pet. 24. Petitioner contends that claim 1 of the challenged patent “recite[s] no more than the automation of a human activity” because claim 1 is “directed to addressing the supposed difficulties of callers detecting lost connections and reestablishing those connections.” *Id.* (citing Ex. 1001, 11:7–11).

Patent Owner contends that Petitioner’s argument is conclusory, untethered to the claims, and fails to consider the nature and context of the claimed invention. Prelim. Resp. 19. We agree with Patent Owner for the reasons discussed previously. Moreover, unlike claim 1, the claims in *Planet Bingo* directed to managing a game of bingo “consist[ed] solely of mental steps which can be carried out by a human using pen and paper.” *Planet Bingo*, 576 Fed. App’x at 1007–08. Petitioner has not persuaded us that the functions of automatically connecting to a captioning service under the specific conditions required by claim 1 are analogous to the claims in *Planet Bingo* directed to managing a game of bingo.

For these reasons, we determine that Petitioner has not demonstrated sufficiently for institution that claim 1 is directed to an abstract idea and, therefore, Petitioner has failed to demonstrate sufficiently that claim 1 is directed to patent-ineligible subject matter. Institution of a post-grant review for claim 1 as purportedly directed to ineligible subject matter under 35 U.S.C. § 101 requires meeting the threshold determination that claim 1 is more likely than not directed to ineligible subject matter. Petitioner has not met this threshold.

Petitioner generally argues the challenged claims together. Pet. 23–28; *but see* Pet. 21–22 (identifying limitations in claims 1, 8, 9, and 21). Petitioner identifies limitations in the independent claims—either method steps (claim 9) or functions for which an apparatus or electronic display are configured to perform (claims 1, 8, and 21)—that purportedly support

Petitioner's contention that the claims are directed to the abstract idea of redialing. *Id.* at 21–22 (identifying limitations in claims 1, 8, 9, and 21).

For reasons similar to those discussed above with respect to claim 1, we determine Petitioner has not sufficiently demonstrated that independent claims 8, 9, and 21 are directed to the abstract idea of “redialing.” Accordingly, we determine that Petitioner has not demonstrated sufficiently for institution that claims 8, 9, or 21 are directed to patent-ineligible subject matter.

Petitioner has not identified any dependent claims that would describe the purported abstract concept of “redialing.” *See id.* at 21–26. Rather, Petitioner addresses the challenged dependent claims only in the context of the second step of *Mayo/Alice*. Pet. 26–28. This is insufficient for institution in light of the determination that the Petitioner has failed to demonstrate sufficiently for institution that the independent claims are directed to an abstract concept.

In conclusion, having considered the information provided in the Petition and the Patent Owner's Preliminary Response, we determine that Petitioner has not demonstrated that it is more likely than not that claims 1–23 are directed to a patent-ineligible abstract idea of “redialing.” Accordingly, we do not institute Petitioner's asserted ground that claims 1–23 are unpatentable under 35 U.S.C. § 101.

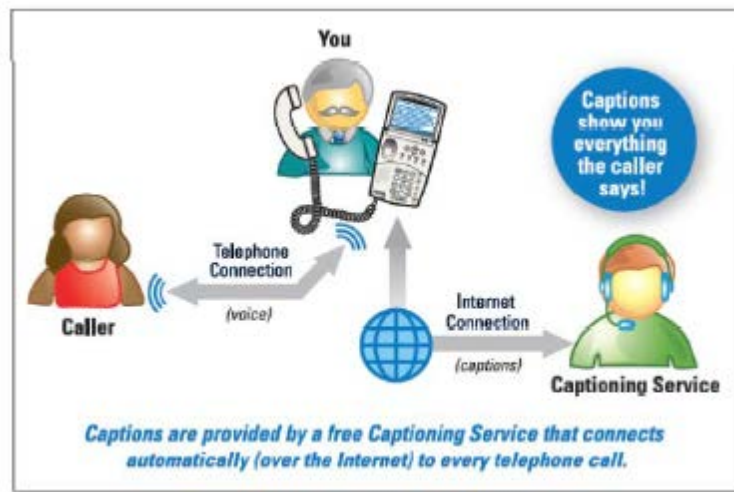
*C. Asserted Ground of Obviousness over  
the Ultratec User Guide, Engelke, and Parker*

Relying on declaration testimony from Ivan Zatkovich (Ex. 1002) and citations to asserted references, Petitioner contends claims 1, 8–14, and 20–23 are unpatentable under 35 U.S.C. § 103 as obvious over the combination of the Ultratec User Guide, Engelke, and Parker. Pet. 29–69. Patent Owner opposes institution on this ground. Prelim. Resp. 24–33, 38–46.

*1. Summary of the Ultratec User Guide*

Petitioner relies on the Ultratec User Guide, which describes how a user can operate a particular model of captioned telephone (i.e., CapTel 840i phone). Pet. 11, 24–33, 38–46; Ex. 1005, 6, 105. Petitioner contends the user guide is prior art to all of the claims of the challenged patent because the Ultratec User Guide was “publicly accessible to persons interested and ordinarily skilled in the art” prior to the earliest effective filing date claimed by the challenged patent (March 25, 2015). Pet. 11; Ex. 1001, [22]. Petitioner contends that the Ultratec User Guide was available from Ultratec’s publicly accessible website in 2012 and supports its contentions with a declaration from an independent third-party (an employee of the Internet Archive). Pet. 12 (citing Ex. 1005, 1–6). Petitioner also supports its contentions with a declaration from an Ultratec employee testifying about the availability of the Ultratec User Guide on its website and testifying that 9,256 physical copies of the user were distributed between October 2012 and April 2013 with the CapTel 840i captioned telephone. Pet. 11–12 (citing Ex. 2012 ¶¶ 7–11).

As described in the Ultratec User Guide, the captioned telephone provides captions corresponding to a caller's voice, as illustrated in the figure set forth below. Ex. 1005, 11.



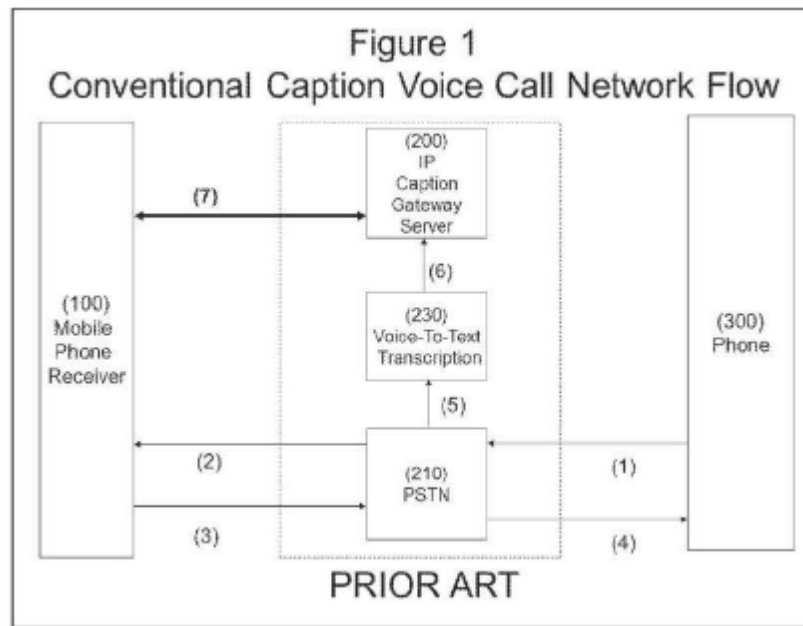
As illustrated in the figure, the captioned telephone uses an Internet connection to access a captioning service, where an operator uses voice recognition technology to generate captions of the caller's voice and sends the captions back to the captioned telephone. *Id.* The captioned telephone “connects automatically (over the Internet) to every telephone call” and uses both a telephone connection for voice between the captioned telephone and the caller and an Internet connection for captions between the captioned telephone and the captioning service. *Id.*

The Ultratec User Guide indicates captions can be turned on or off at any time during a call. *Id.* at 16. The Ultratec User Guide describes a captions button on the captioned telephone that controls whether captions are shown for a call. *Id.* The Ultratec User Guide instructs that “[t]o turn

the captions off, just press the CAPTIONS button to turn the red light off.”  
*Id.*

## 2. Summary of Parker

Parker is a United States patent application publication for an application filed on June 26, 2014. Ex. 1006, [22]. Parker describes transmitting to a mobile phone text captions that are derived from audio or video calls or broadcasts. *Id.* at Abstract. Parker’s Figure 1 is set forth below.



As depicted in Figure 1, “[t]he mobile call receiver (100)<sup>[10]</sup> is persistently connected to the IP caption gateway server (200) for receiving text captions, and the PSTN interconnect server (210) for sending/receiving voice.”

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<sup>10</sup> Parker uses the terms “mobile call receiver (100)” and “mobile phone receiver (100)” interchangeably. Compare Ex. 1006, Fig. 1, with *id.* ¶ 4.

*Id.* ¶ 4. Parker explains that “[i]f the mobile call receiver (100) was to become disconnected from the IP caption gateway server (200), disrupting the data connection, the mobile call receiver would not be able to receive any text captions.” *Id.* For this reason, “[t]he mobile call receiver (100) continuously seeks to be connected to the IP caption gateway server (200) and the PSTN interconnect server (210), and must be connected to both the IP data connection and voice connection—simultaneous voice and data must be supported and available at all times.” *Id.* Parker explains that “[i]f the mobile call receiver (100) temporarily becomes disconnected from the IP caption gateway server (200), it typically goes into a state of automated retries as it attempts to reconnect” and, “[i]f no reconnection can be established, the call is dropped and the text captions will no longer be delivered.” *Id.*

### *3. Independent Claim 1*

Petitioner contends that the Ultratec User Guide, Engelke, and Parker each describe a two-line captioned telephone that connects to a telephone used by a caller and also connects, over a different connection, to a captioned telephone service that provides captions corresponding to the words spoken by the caller. Pet. 13, 15.

#### *a. Devices and Captioning Communication Service*

For the devices and captioning communication service recited in claim 1, Petitioner relies on the Ultratec captioned telephone that connects over a PSTN line to a caller’s telephone and over an Internet connection to a captioning service. *Id.* at 37 (citing Ex. 1005). According to Petitioner,

Ultratec’s captioned telephone teaches a captioned telephone having a button to enable or disable captions, the caller’s telephone teaches the recited “far end communication device,” and the captioning service teaches the recited “captioning communication service that provides captioning assistance for hearing-impaired users.” *Id.* (citing Ex. 1005, 11).

Petitioner contends that the captioned telephone of the Ultratec User Guide would have conveyed to one of ordinary skill in the art the recited processor (*id.* at 38, 39) and bolsters its contentions with another reference (Engelke) that expressly describes a two-line captioned telephone having a processor (*id.* at 38, 39). Petitioner, with support of Mr. Zatkovich, provides reasons that would have prompted one of ordinary skill in the art to combine the Ultratec User Guide with Engelke. *Id.* at 29–31. Among the reasons Petitioner cites is that one of ordinary skill in the art would have turned to Engelke, a reference that purportedly also describes the same brand captioned telephone, to fill in the details regarding internal operations of such a device in order to implement user-focused functions described in the Ultratec User Guide. *Id.* at 29–30.

*b. Automatically Connect with the  
Captioning Communication Service*

Among other limitations, claim 1 requires the processor of the claimed apparatus to be configured to “automatically connect with the captioning communication service through a second connection to establish a captioning communication session” under certain conditions. Ex. 1001, 13:50–65. First, the processor of the automatic connection is configured to

establish a captioning communication session “responsive to a determination that an attempted connection to the captioning communication service failed” (“the failed attempt limitation”) and, second, “during a time in which a caption select option has been enabled by the hearing-impaired user” (“the when-enabled limitation”). *Id.* at 13:50–57. Third, the processor of the automatic connection is configured such that “the attempted automatic connection through the second connection is not made during a time in which the caption select option has been disabled by the hearing-impaired user” (“the when-not-disabled limitation”). *Id.* at 13:57–60. In sum, claim 1 requires automatic connection when an attempt to connect has failed and the “caption select option has been enabled by the hearing-impaired user,” but not when “the caption select option has been disabled by the hearing-impaired user.”

Petitioner presents excerpts from the Ultratec User Guide and from Parker as purportedly describing aspects of the automatically connect requirement with its three conditional limitations. In other words, Petitioner relies on a combination of the Ultratec User Guide and Parker as teaching or suggesting the automatically connect requirement and its three conditional limitations. More specifically, Petitioner relies on the description that the Ultratec captioned telephone “will automatically be connected over the Internet” to the captioning service only if the captions button is on. Pet. 40 (citing Ex. 1005, 29, 30–32, 33, 37) (quoting “To see captions during your call, make sure the red light around the CAPTIONS button is on. Your call will automatically be connected over the Internet to the free Captioning

Service. Captions can be turned on or off at any time during a call. To turn the captions off, just press the CAPTIONS button to turn the red light off.”). Petitioner relies on Parker’s description of an audio-to-text transcription system that sends captions to a mobile phone from an Internet protocol caption gateway server and sends voice to the mobile phone from a PSTN interconnect server. Pet. 41–42. Petitioner further relies on Parker’s description that the mobile phone “is persistently connected” to the Internet protocol caption gateway server and, “if the mobile phone receiver becomes disconnected from the caption server, the mobile phone receiver ‘goes into a state of automated retries as it attempts to reconnect.’” *Id.* at 41 (quoting Ex. 1006 ¶ 4). Because “automated retries” is plural, Petitioner contends that Parker discloses that the mobile phone attempts to connect several times and, therefore, “if a first attempt to reconnect fails, the second attempt to reconnect is an attempt resulting from (i.e., ‘responsive to’) a determination that an attempted connection to the captioning communication service failed.” *Id.* at 42 (discussing Ex. 1006 ¶ 4).

Petitioner presents separate excerpts from the Ultratec User Guide and excerpts from Parker as purportedly describing aspects of the automatically reconnect limitation. *Id.* at 40–42. Petitioner does not assert that either the Ultratec User Guide or Parker alone would have conveyed to one of ordinary skill in the art the automatically connect function with the three conditional limitations (*id.*), nor is such an assertion required under 35 U.S.C. § 103. Petitioner is required under 35 U.S.C. § 103, however, to explain how the combination of the references would have conveyed to one of ordinary skill

in the art the recited automatically connect function with its three conditional limitations. Petitioner has not provided such an explanation, much less adequate analysis by Mr. Zatkovich or factual support as to how one of ordinary skill in the art would understand the separate disclosures of the references to teach the automatically connect limitations.

Specifically absent from the Petition is any discussion as to how Petitioner's combination of references would have conveyed to one of ordinary skill in the art the limitations of automatically connecting under the required conditions—the failed attempt limitation, the when-enabled limitation, and the when-not-disabled limitation. Petitioner's combination relies on Parker's reconnection function to establish a lost persistent connection, but Parker's reconnection function does not do so conditionally, much less under the specific conditions required by claim 1. Petitioner does not explain how the combination of Parker's unconditional reconnection function would be understood by one of ordinary skill in the art to retry conditionally based on whether the Ultratec User Guide's caption button was enabling captioning and had not been disabled by the caption telephone user.

Furthermore, Petitioner contends that “adding an auto-retry and/or auto-reconnect feature as in Parker to a captioned telephone device as disclosed in [the Ultratec User Guide and Engelke] would amount to simply adding a known technique to a known system, wherein the technique operates in the same way as it was already known to operate and does not have any unpredictable result.” Pet. 34. As such, Petitioner's combination

expressly relies on Parker's auto-retry and/or auto-reconnect feature "*as in Parker*," which is an unconditional retry in the event of a lost connection.

In sum, neither reference by itself describes the automatically reconnect limitation and Petitioner fails to articulate how one of ordinary skill in the art would have understood the claimed automatic reconnect in view of the cited disparate disclosures from the references. "[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). Petitioner asserts in a conclusory manner that the combination of a teaching of a button to enable or disable captioning with a teaching of automatic reconnection unrelated to whether captioning is enabled or disabled would have conveyed to one of ordinary skill in the art the automatic reconnection limitation. Petitioner fails to provide adequate explanation or factual support. This flaw of the Petition is particularly problematic when the threshold for institution is "more likely than not," as here, rather than the threshold of "a reasonable likelihood" required to institute an *inter partes* review. Compare 35 U.S.C. § 324(a), with 35 U.S.C. § 314(a).

We further note that, during examination of the application that issued as the challenged patent, the Examiner substituted by amendment the limitation "during a time in which a caption select option has been enabled by the hearing-impaired user, wherein the attempted automatic connection through the second connection is not made during a time in which the caption select option has been disabled by the hearing-impaired user . . ." for

the condition “during a time in which the processor determines captions are to be enabled” when allowing claim 1. Ex. 1014, 11. Petitioner does not acknowledge or address this aspect of the prosecution history. This further weighs against a determination that Petitioner has met its burden for institution. *Cf. Arendi S.A.R.L. v. Apple, Inc.*, 832 F.3d 1355, 1363 (Fed. Cir. 2016) (requiring limitations missing from the prior art to be supported by evidence and a reasoned explanation and explaining that this is “particularly true where the missing limitation goes to the heart of an invention”).

In addition, as Patent Owner correctly notes, the Examiner added the when-enabled and when-not-disabled limitations to distinguish claim 1 from Parker’s description on which Petitioner now relies in its combination purportedly teaching or suggesting the when-enabled and not-disabled limitations. Ex. 1014, 17 (indicating that the “Examiner’s amendment was approved to overcome” Parker) (quoting Ex. 1006 (Parker) ¶ 4); *see* Ex. 1014, 10–16; Prelim. Resp. 41 (citing Ex. 1014, 10–16). This provides further evidence that Petitioner has failed to meet its burden by not explaining sufficiently how the combination of Parker and the Ultratec User Guide would have conveyed the limitations recited in claim 1 to one of ordinary skill in the art.

For these reasons, we determine that Petitioner has not made a sufficient showing that the combination of the Ultratec User Guide, Engelke, and Parker would have conveyed to one of ordinary skill in the art all of the limitations of claim 1. Thus, we are not persuaded that Petitioner has

demonstrated sufficiently for institution that claim 1 is more likely than not unpatentable on the asserted ground of obviousness over the Ultratec User Guide, Engelke, and Parker.

#### 4. Other Claims

In addition to claim 1, the challenged patent includes independent claims 8, 9, and 21. Similarly to claim 1, independent claim 8 recites “automatically connect with the captioning communication service through a second connection to establish a captioning communication session during the voice communication session responsive to a determination that an attempted connection to the captioning communication service failed during a time in which a caption select option has been enabled by the hearing-impaired user, wherein the attempted automatic connection through the second connection is not made during a time in which the caption select option has been disabled by the hearing-impaired user.” Ex. 1001, 14:45–55. For this aspect of the claim, Petitioner relies on the same argument made with respect to the corresponding limitation in claim 1. Pet. 44 (indicating “[s]ee *supra* Claim 1(d)”).

Independent claim 9 recites “detecting a failed connection between the captioning communication device and the captioning communication service through a second connection at a second time during the voice communication session while the caption select option is still.” Ex. 1001, 15:13–17. For this limitation, Petitioner relies on arguments made with respect to the automatically connecting limitation recited in claim 1 and further arguments regarding what Parker individually discloses with regard

to claim 8. Pet. 48 (indicating “[s]ee *supra* Claim 1(d), 8(g)”). Petitioner further relies on Parker’s indication that “[i]f no reconnection can be established, the call is dropped.” *Id.* (quoting Ex. 1006 ¶ 4). For reasons similar to those discussed previously with respect to claim 1, Petitioner here, too, fails to explain how the combination of references would have conveyed the claim limitation to one of ordinary skill in the art. Discussing Parker individually is not sufficient here because Parker alone does not describe the limitation.

Independent claim 21 recites “automatically connect to the captioning communication service through the second connection and establish a new captioning communication session during the voice communication session after the captioning communication session has been enabled and responsive to a determination that the captioning communication session is terminated in a manner that is different than a user input being received through the user interface.” Ex. 1001, 16:60–17:1. For this limitation, Petitioner relies on arguments made previously with respect to claims 1 and 8, which for reasons discussed previously we do not find adequate for institution. *See* Pet. 48 (indicating “[s]ee *supra* Claim 1(d), 8(g)”). Petitioner further relies on quotations from Parker’s paragraph 4 and cites to paragraph 6. *Id.* Petitioner, however, fails to explain adequately how Parker’s disclosure that “[i]f no reconnection can be established, the call is dropped” would have conveyed to one of ordinary skill in the art “responsive to a determination that the captioning communication session is terminated in a manner that is

different than a user input being received through the user interface,” as recited in claim 21.

For these reasons, we determine that Petitioner has not made a sufficient showing that the combination of the Ultratec User Guide, Engelke, and Parker would have conveyed to one of ordinary skill in the art all of the limitations recited in independent claims 8, 9, and 21 or claims 10–14, 20, 22, and 23 (which depend from independent claims 9 or 21). Thus, we are not persuaded that Petitioner has demonstrated sufficiently for institution that any of claims 8–14 and 20–23 are more likely than not unpatentable on the asserted ground of obviousness over the Ultratec User Guide, Engelke, and Parker.

## *5. Conclusion*

Accordingly, based on the evidence before us, we determine that the information presented does not show that it is more likely than not that at least one of the claims challenged in this asserted ground would have been unpatentable for obviousness over the Ultratec User Guide, Engelke, and Parker.

### *D. Other Asserted Grounds of Obviousness*

Petitioner also contends that dependent claims 2–7, 12, and 15–19 would have been obvious over the Ultratec User Guide, Engelke, Parker and another reference—one of Labrador, FCC Proposed Rule, Chitre, and Hopkins. Pet. 2–3, 59–83. In its assertions regarding these grounds, Petitioner does not provide additional arguments directed to limitations in

the independent claims and so implicitly relies on its arguments made previously. *Id.*

Accordingly, for the reasons discussed previously and based on the evidence before us, we determine that Petitioner has not made a sufficient showing that it is more likely than not that at least one of claims 2–7, 12, and 15–19 challenged in these additional grounds of obviousness is unpatentable.

### III. CONCLUSION

After considering the Petition and Preliminary Response, and the evidence cited therein, we determine that Petitioner has not demonstrated that it is more likely than not that any of the claims it challenges is unpatentable under 35 U.S.C. §§ 101 or 103. Accordingly, we do not institute post-grant review of any challenged claims on any asserted ground.

### IV. ORDER

After due consideration of the record before us, and for the foregoing reasons, it is:

ORDERED that the Petition is denied as to all challenged claims, and no post-grant review is instituted.

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