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Paper 95  
Entered: April 10, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CAPTIONCALL, L.L.C.,  
Petitioner,

v.

ULTRATEC, INC.,  
Patent Owner.

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Cases

IPR2013-00540 (Patent 6,233,314 B1)  
IPR2013-00541 (Patent 5,909,482)  
IPR2013-00542 (Patent 7,319,740 B2)  
IPR2013-00543 (Patent 7,555,104 B2)  
IPR2013-00544 (Patent 8,213,578 B2)  
IPR2013-00545 (Patent 6,594,346 B2)  
IPR2013-00549 (Patent 6,603,835 B2)  
IPR2013-00550 (Patent 7,003,082 B2)  
IPR2014-00780 (Patent 6,603,835 B2)

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

PER CURIAM.

DECISION ON REMAND  
*35 U.S.C. § 318(a); 35 U.S.C. § 144*

IPR2013-00540 (Patent 6,233,314) IPR2013-00541 (Patent 5,909,482)  
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IPR2013-00544 (Patent 8,213,578) IPR2013-00545 (Patent 6,594,346)  
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## I. INTRODUCTION

At issue in this Decision are nine petitions filed by CaptionCall, L.L.C. (“Petitioner”) requesting an *inter partes* review of certain claims in eight patents owned by Ultratec, Inc. (“Patent Owner”). Petitioner filed the first eight petitions on the same day. *See* IPR2013-00540 (“IPR540”), Paper 2 (challenging U.S. Patent No. 6,233,314 B1); IPR2013-00541 (“IPR541”), Paper 1 (challenging U.S. Patent No. 5,909,482); IPR2013-00542 (“IPR542”), Paper 1 (challenging U.S. Patent No. 7,319,740 B2); IPR2013-00543 (“IPR543”), Paper 1 (challenging U.S. Patent No. 7,555,104 B2); IPR2013-00544 (“IPR544”), Paper 1 (challenging U.S. Patent No. 8,213,578 B2); IPR2013-00545 (“IPR545”), Paper 1 (challenging U.S. Patent No. 6,594,346 B2); IPR2013-00549 (“IPR549”), Paper 1 (challenging U.S. Patent No. 6,603,835 B2); IPR2013-00550 (“IPR550”), Paper 1 (challenging U.S. Patent No. 7,003,082 B2). We instituted reviews based on the first eight petitions. While these reviews were proceeding in parallel, Petitioner filed a ninth petition seeking a second *inter partes* review of the patent challenged in IPR549 (i.e., U.S. Patent No. 6,603,835 B2), but challenging claims other than those under review in IPR549. *See* IPR2014-00780 (“IPR780”), Paper 7 (challenging U.S. Patent No. 6,603,835 B2).

In due course we issued nine final written decisions determining that Petitioner had shown by a preponderance of the evidence that all of the reviewed claims were unpatentable. IPR540, Paper 78, 53 (Final Written

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Decision); IPR541, Paper 76, 74 (Final Written Decision); IPR542, Paper 66, 29 (Final Written Decision); IPR543, Paper 66, 28 (Final Written Decision); IPR544, Paper 74, 54 (Final Written Decision); IPR545, Paper 65, 39 (Final Written Decision); IPR549, Paper 71, 33 (Final Written Decision); IPR550, Paper 57, 24 (Final Written Decision); and IPR780, Paper 35, 55 (Final Written Decision). Patent Owner appealed each of our final written decisions to the United States Court of Appeals for the Federal Circuit. The court issued its decision vacating our nine final written decisions and remanding these cases to the Board on August 28, 2017. *Ultratec, Inc. v. CaptionCall LLC*, 872 F.3d 1267 (Fed. Cir. 2017).

#### *A. The Inter Partes Reviews*

##### *1. The Challenged Patents*

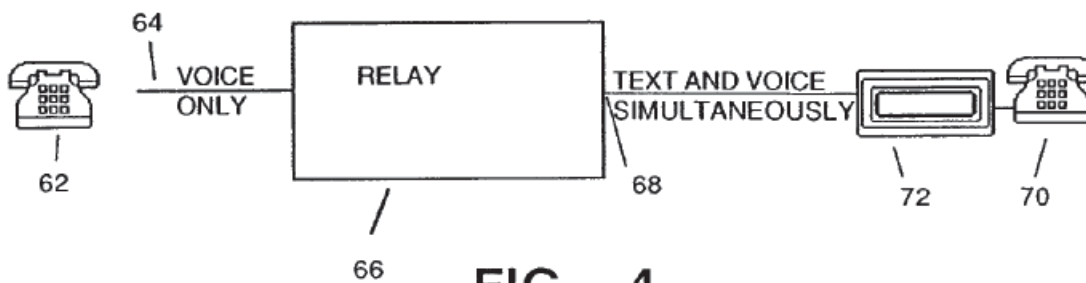
The challenged patents describe various systems and methods for assisting deaf, hard of hearing, or otherwise hearing-impaired individuals in using telephones. *See, e.g.*, IPR542, Ex. 1001, 1:26–29. A conventional system uses a device that includes a keyboard, a display, and a specific type of modem, and is known as a telecommunication device for the deaf (TDD), a text telephone (TT), or a teletype (TTY). *Id.* at 1:37–43. When a hearing person who does not have access to a TDD wishes to communicate with a hearing-impaired person who uses a TDD, the parties may utilize a relay system, in which a human intermediary, known as a “call assistant,” communicates with the hearing user by voice and with the hearing-impaired user by using a TDD. *Id.* at 1:66–2:11. In a conventional relay system, the

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call assistant types, at a TDD keyboard, the words spoken by the hearing user and voices to the hearing user the words received on the TDD from the hearing-impaired user. *Id.* at 2:11–16. The challenged patents relate to various alleged improvements for providing a captioned telephone service.

Some of the challenged patents relate to using voice recognition software at the relay. For example, instead of typing the hearing user’s words, the call assistant re-voices those words into a microphone that transmits the voice of the call assistant to a computer with voice recognition software trained specifically to the voice of the call assistant. *Id.* at 6:18–37. Using the voice recognition software, the computer translates the words of the call assistant to digital text, which is sent to a display of the hearing-impaired user. *Id.* at 6:50–57.

Many of the challenged patents describe a captioned telephone device at the site of the assisted user. *Id.* at 9:18–10:4. Figure 4 of the ’740 patent, reproduced below, illustrates the setup of a telephone call involving captioned telephone device 72:

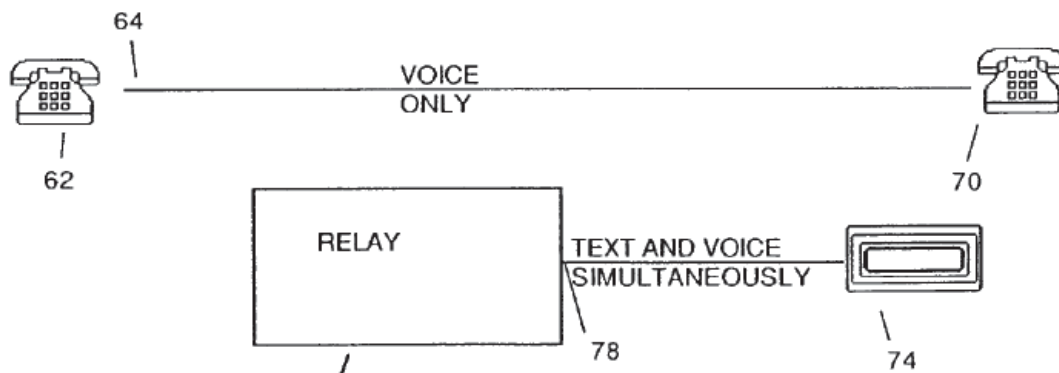


As shown in Figure 4, a hearing user at telephone 62 communicates with relay 66 through telephone line 64. *Id.* at 9:20–22. The relay communicates

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both the voice of the hearing user and a transcription of the text of the conversation through telephone line 68 to an assisted user. *Id.* at 9:22–23. At the assisted user’s site are captioned telephone device 72, which includes a display for text, and conventional telephone 70. *Id.* at 9:23–27. The functions of captioned telephone device 72 and telephone 70 may be combined into a single device. *Id.* at 9:36–43. The arrangement shown in Figure 4 sometimes is referred to as “single line” because only one line is used at the assisted user’s site. The single line carries both the text transcription and the voice of the hearing user between the assisted user’s site and the relay.

Some arrangements, however, involve two lines at the assisted user’s site—one line to connect the assisted user with the hearing user and another line to connect the assisted user with the relay. This arrangement is sometimes referred to as “two-line.” For example, Figure 5 of the ’740 patent, reproduced below, shows such an arrangement.



**FIG. 5**

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As shown in Figure 5, this embodiment utilizes voice-only telephone line 64 between telephone 62 of the hearing user and telephone 70 at the assisted user's location, and a separate connection—telephone line 78—carrying text and voice between relay 76 and captioned telephone device 74 at the assisted user's location. *Id.* at 9:44–54. The voice of the hearing user is received at telephone 70 and transferred to telephone line 78 for transmission to relay 76, which converts the spoken words to a text stream to be returned to the assisted user via telephone line 78. *Id.* at 9:54–57, 10:16–21.

## 2. *The Challenges*

In its challenges, Petitioner collectively asserted eleven references and relied on expert testimony of Mr. Benedict Occhiogrosso. In its Responses in six proceedings (IPR540, IPR541, IPR544, IPR545, IPR549, and IPR780), Patent Owner relied on expert testimony of Mr. Paul W. Ludwick. In the other three proceedings (IPR542, IPR543, and IPR550), Patent Owner relied on expert testimony of Mr. James A. Steel, Jr.

More specifically, Petitioner collectively asserted the following references as prior art against various challenged claims across the nine proceedings:

“Alshawi”—U.S. Patent No. 5,815,196.

“Choi”—W. Choi et al., Splitting and Routing Audio Signals in Systems with Speech Recognition, IBM TECHNICAL DISCLOSURE BULLETIN, Vol. 38, No. 12, 503–04 (December 1995).

“Engelke '405”—U.S. Patent No. 5,724,405.

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“Jones”—PCT International Publication No. WO 95/00946.

“Liebermann”—U.S. Patent No. 5,982,853.

“McLaughlin”—U.S. Patent No. 6,181,736 B1.

“Mukherji”—U.S. Patent No. 7,117,152 B1.

“Ryan”—U.S. Patent No. 5,809,112.

“Vasile”—U.S. Patent No. 5,289,523.

“Wycherley”—U.S. Patent No. 5,163,081.

“Yamamoto”—Seiichi Yamamoto & Masanobu Fujioka, *New Applications of Voice Recognition*, Proc. JASJ Conf. (March 1996).

The prior art references were considered in the nine proceedings in the following specific grounds:

IPR/Patent	Reference(s)	Basis	Claim(s)
IPR540 US 6,233,314	Ryan (Ex. 1004)	§ 102	1 and 2
	Wycherley (Ex. 1002) and Yamamoto (Ex. 1005, 1006) <sup>1</sup>	§ 103	1 and 2
IPR541 US 5,909,482	Ryan (Ex. 1004)	§ 102	1 and 5
	Wycherley (Ex. 1002) and Yamamoto (Ex. 1005, 1006)	§ 103	1 and 5
	Wycherley, Yamamoto, and Jones (Ex. 1008)	§ 103	2, 7, and 8
	Wycherley, Yamamoto, and Choi (Ex. 1009)	§ 103	3, 10, and 11
	Wycherley, Yamamoto, and Vasile (Ex. 1003)	§ 103	4, 13, and 14
	Wycherley, Yamamoto, and Liebermann (Ex. 1010)	§ 103	6

<sup>1</sup> Ex. 1005 is in Japanese; Ex. 1006 is a certified English translation.

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IPR/Patent	Reference(s)	Basis	Claim(s)
IPR541 US 5,909,482	Wycherley, Yamamoto, Jones, and Liebermann	§ 103	9
	Wycherley, Yamamoto, Choi, and Liebermann	§ 103	12
	Wycherley, Yamamoto, Vasile, and Liebermann	§ 103	15
IPR542 US 7,319,740	McLaughlin (Ex. 1009) and Ryan (Ex. 1004)	§ 103	1 and 2
IPR543 US 7,555,104	McLaughlin (Ex. 1012) and Ryan (Ex. 1005)	§ 103	1 and 2
IPR544 US 8,213,578	Ryan (Ex. 1004)	§ 102	7
	Wycherley (Ex. 1005) and Yamamoto (Ex. 1006, 1007) <sup>2</sup>	§ 103	7
	Ryan and McLaughlin (Ex. 1009)	§ 103	7–11
IPR545 US 6,594,346	Ryan (Ex. 1005) and Alshawi (Ex. 1010)	§ 103	1 and 2
IPR549 US 6,603,835	Liebermann (Ex. 1008) and Engelke '405 (Ex. 1005)	§ 103	1–5 and 7
IPR550 US 7,003,082	McLaughlin (Ex. 1006)	§ 102	1
IPR780 US 6,603,835	Liebermann (Ex. 1008), Engelke '405 (Ex. 1005), and Mukherji (Ex. 1009)	§ 103	6 and 8

Of particular relevance here are three prior art references—  
 McLaughlin, Ryan, and Yamamoto—and testimony of Petitioner's expert,

<sup>2</sup> Ex. 1006 is in Japanese; Ex. 1007 is a certified English translation.



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Mr. Occhiogrosso, concerning the disclosures of those references and his opinion that the challenged claims are unpatentable.

McLaughlin describes a simultaneous voice and data (SVD) modem used in connection with a relay service in which an operator mediates communications between a hearing person and a hearing-impaired person. IPR542, Ex. 1009, 30:13–31:63. McLaughlin describes a hearing-impaired user using an answering device or system comprising two SVD modems connected to two communication links, Line A and Line B. *Id.* at 30:59–63, 32:17–19. When a voice call from the hearing user arrives on the first line (Line A), the answering device sets up an SVD link with the relay service on the second line (Line B). *Id.* at 31:35–40. Voice sounds received from the hearing user on Line A are sent to the relay operator on Line B. *Id.* at 31:41–43. The relay operator translates the voice sounds into text, which is sent over Line B to appear on the screen of the hearing-impaired user’s answering device. *Id.* at 31:43–47. The hearing-impaired user also types responses back to the relay operator over Line B. *Id.* at 31:47–49. The relay operator voices the text, and the relay operator’s voice sounds are carried on Line B to the hearing-impaired user’s answering device and passed over to Line A to be heard by the hearing user. *Id.* at 31:49–52. Conversation among all three parties is “full duplex,” so that all parties may talk or type simultaneously. *Id.* at 31:55–62.

McLaughlin also provides details about how its SVD modems can be used to provide legacy services such as “voice carry over” (VCO) and “hearing carry over” (HCO). *Id.* at 29:65–30:12. Details regarding

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McLaughlin’s ability to operate in a number of modes are described in the section titled “Hearing/Speaking Persons Calling Deaf and/or Speech Impaired Persons,” which includes a number of subsections discussing the features of the invention. *See generally id.* at 29:18–34:56. One issue in these post-remand proceedings concerns expert testimony of Mr. Occhiogrosso regarding these various subsections in McLaughlin.

Issues in these post-remand proceedings also involve Mr. Occhiogrosso’s testimony concerning Ryan’s voice recognition software and its location. Ryan describes a relay interface system for communication between a standard telephone set used by a hearing user and a TDD used by a hearing-impaired person. IPR542, Ex. 1004, Abstract, 1:6–10. Figure 1 of Ryan is set forth below:

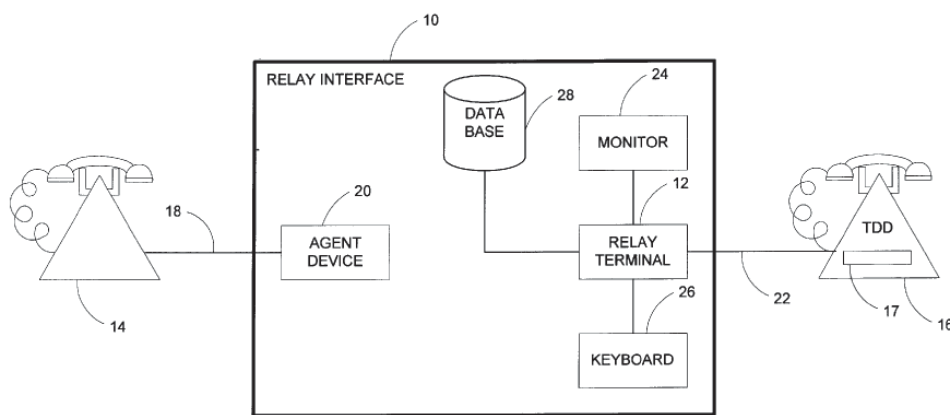


FIG. 1

As shown in Figure 1, Ryan’s relay interface 10 includes operator/relay terminal 12 and connects standard telephone set 14 with TDD 16 having associated display 17. *Id.* at 3:43–48. Telecommunications link 18 connects telephone 14 with relay interface 10 through agent

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device 20, and telecommunications link 22 connects TDD 16 with relay interface 10 through relay terminal 12. *Id.* at 3:48–52. An operator or relay agent typically is responsible for manipulating relay terminal 12 using keyboard 26 to relay messages between telephone 14 and TDD 16.

*Id.* at 4:19–21. Ryan indicates, however, that speech recognition software could be used to automate the relay function so that an operator or relay agent would not be required. *Id.* at 4:21–24. Ryan specifically describes using speech recognition software at agent device 20 to interpret a voice message from a caller at telephone 14 and convert the message from a voice format to a data format. *Id.* at 4:24–27. Ryan further provides:

If the software is specifically designed to recognize the voice of particular relay agents, the accuracy of the relay service may be improved by having one of these agents listen to the caller and repeat the voice message into a terminal adapted to convert the agent’s voice message into a data message.

*Id.* at 4:33–38.

A related issue in these post-remand proceedings involves Mr. Occhiogrosso’s testimony concerning the location of software in Yamamoto. Yamamoto describes tests of voice recognition systems. IPR540, Ex. 1006, 34–36. Along with other examples, Yamamoto describes a test with an operator assistance system for international calling, noting a preliminary step in an operator assistance system for international calling is “voice recognition of an operator repeating the question from the [international calling] user” to increase efficiency. *Id.* at 35 (§ 3.2).

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### *B. Post-Remand Proceedings*

In its opinion vacating the Board’s final written decisions and remanding these proceedings to the Board, the Federal Circuit provided the following instructions regarding the remand of these proceedings:

On remand, the Board shall admit and consider Mr. Occhiogrosso’s trial testimony [from *Ultratec, Inc. v. Sorenson Communications, Inc.*, No. 13-CV-00346 (W.D. Wis.)]. If the Board finds he gave inconsistent testimony, the Board shall consider the impact on the specific patents at issue in the trial testimony *as well as* on his credibility as a whole.

*Ultratec, Inc. v. CaptionCall LLC*, 872 F.3d 1267, 1275 (Fed. Cir. 2017).

We requested the parties submit proposals on the conduct of the remanded proceedings. *See, e.g.*, IPR540, Paper 104 (“Remand Order”), 4. After discussing their respective proposals in a conference call with the parties, we issued an order regarding the scope of remand, briefing, and supplementing the evidentiary record. *See, e.g.*, Remand Order; IPR540, Ex. 2029 (Transcript of conference call).

#### *1. Supplementing the Evidentiary Record*

The Federal Circuit directed us to “admit and consider Mr. Occhiogrosso’s trial testimony” but did not specify whether all of Mr. Occhiogrosso’s district court trial testimony, or only portions of it, should be admitted. *Ultratec*, 872 F.3d at 1275; Remand Order 9. Petitioner proposed that Patent Owner be permitted to supplement the evidentiary record with the portions of Mr. Occhiogrosso’s district court trial testimony on cross examination that Patent Owner alleges is inconsistent with his testimony in

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these *inter partes* reviews. Remand Order 9 (citing Ex. 2029, 10:2–15; Ex. 3004, 4).<sup>3</sup> Petitioner further proposed that Petitioner be permitted to supplement the record with additional trial testimony from Mr. Occhiogrosso as necessary to counter Patent Owner’s allegations of inconsistency. *Id.* (citing Ex. 2029, 10:16–25; Ex. 3004, 4).

Patent Owner proposed that it be permitted to supplement the record with Mr. Occhiogrosso’s allegedly inconsistent testimony and additional testimony as needed for context, or all of Mr. Occhiogrosso’s trial testimony if the Board believed that would be helpful. *Id.* (citing Ex. 2029, 24:16–22).

After considering the parties’ proposals and the Federal Circuit’s remand instructions, we indicated having all of Mr. Occhiogrosso’s trial testimony entered into the record of these proceedings would be beneficial. *Id.* We then ordered Patent Owner to submit a transcript of all of Mr. Occhiogrosso’s district court trial testimony as an exhibit or exhibits in each of these proceedings. *Id.* Subsequently, Patent Owner filed Mr. Occhiogrosso’s trial testimony in each proceeding as Exhibit 2031 (October 16, 2014 morning testimony), Exhibit 2032 (October 16, 2014 afternoon testimony), and Exhibit 2033 (October 17, 2014 testimony).

## 2. *Authorized Briefing*

Regarding briefing during the post-remand proceeding, Petitioner indicated that the remand from the Federal Circuit was narrow and was

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<sup>3</sup> Citations in the Remand Order are to exhibits in IPR540 unless otherwise noted.

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limited to consideration of Mr. Occhiogrosso's district court trial testimony as directed by the Federal Circuit. Remand Order 4 (citing Ex. 2029, 5:24–6:8; Ex. 3004, 1–2). In particular, Petitioner asserted that the Board should determine as a threshold issue whether Mr. Occhiogrosso gave inconsistent testimony, and then if, and only if, the Board determines he did, the Board should determine whether such inconsistent testimony impacts the patents at issue in these proceedings and Mr. Occhiogrosso's credibility as a whole. *Id.* (citing Ex. 3004, 1–2). Petitioner proposed that briefing by the parties should address both issues. Remand Order 4 (citing Ex. 3004, 2).

Patent Owner proposed that several topics should be briefed by the parties and considered by the Board on remand. *Id.* First, Patent Owner requested briefing to identify and explain alleged inconsistencies in Mr. Occhiogrosso's testimony as they span topically across the proceedings and to explain the impact of Mr. Occhiogrosso's credibility on the outcome of the proceedings. *Id.* (citing Ex. 2029, 12:21–13:20; Ex. 3004, 2). In this regard, Patent Owner's proposal regarding Mr. Occhiogrosso's testimony is similar to Petitioner's proposal described above. *Id.*

Patent Owner also sought to bring additional issues into the scope of the remanded proceedings. *Id.* at 5. In light of the recent expiration of the subject patents, Patent Owner proposed that the parties have the opportunity to brief what claim constructions, if any, would change under the standard set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), and the impact of any revised constructions. *Id.* (citing Ex. 2029, 14:9–16:20; Ex. 3004, 2). Patent Owner further proposed that it be

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permitted to submit, along with accompanying trial testimony, documentary evidence related to secondary considerations that had been designated under the district court's protective order but has been unsealed since briefing closed in the original *inter partes* review proceedings. *Id.* (citing Ex. 2029, 16:21–19:14, 20:13–15; Ex. 3004, 2). Patent Owner also requested briefing to explain the impact of such additional evidence on these proceedings. *Id.* (citing Ex. 3004, 2). Finally, Patent Owner sought targeted additional discovery and briefing on the issue of whether Petitioner identified all the real parties in interest. *Id.* (citing Ex. 2029, 20:22–24:8; Ex. 3004, 2). Patent Owner proposed a first round of briefing to address all topics except identification of real parties in interest, which Patent Owner proposed to address in a second round of briefing overlapping with the first. *Id.* (citing Ex. 3004, 1).

Mindful of the Federal Circuit's remand instructions, we authorized Patent Owner to file a brief that (i) identifies with particularity portions of Mr. Occhiogrosso's district court trial testimony that Patent Owner alleges is inconsistent and explains how it is inconsistent with specific testimony provided by Mr. Occhiogrosso in these proceedings, and (ii) explains how the allegedly inconsistent testimony impacts specific unpatentability determinations in the Board's final written decisions in these proceedings as well as how it impacts Mr. Occhiogrosso's credibility as a whole. *Id.* at 5–6.

We authorized Petitioner to file a responsive brief addressing the same issues as Patent Owner's brief. *Id.* at 6. We indicated that Petitioner may

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cite additional portions of Mr. Occhiogrosso’s trial testimony to counter Patent Owner’s allegations of inconsistency. *Id.*

Regarding logistics, we authorized each party to prepare a single brief addressing these issues with respect to all of the proceedings and submit that brief in each proceeding, making clear the proceeding in which any particular paper or exhibit was entered. *Id.*

Subsequently, Patent Owner filed its Consolidated Brief on Remand (*see, e.g.*, IPR540, Paper 106, “PO Br.”) and Petitioner filed its Response (*see, e.g.*, IPR540, Paper 107, “Pet. Br.”).

### 3. *Patent Owner’s Requests for Additional Briefing*

In our Remand Order, we also explained that, if we determined based on the parties’ initial remand briefs that Mr. Occhiogrosso provided inconsistent testimony and that any inconsistency impacted, in a material way, our unpatentability determinations regarding the patents at issue or Mr. Occhiogrosso’s credibility as a whole, we would consider at that time whether to authorize briefing directed to the additional issues identified by Patent Owner. Remand Order 6–7.

In addition, in our Remand Order, we specifically addressed Patent Owner’s request to bring claim construction issues into the post-remand proceedings. *Id.* at 5, 7–9. We indicated that we were aware that the *Phillips* standard of claim construction generally applies to patents that have expired. *Id.* at 7. We addressed the two cases cited by Patent Owner in support of its position that it should have the opportunity at this juncture to address the effect of any claim constructions that might change under the



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*Phillips* standard. *Id.* (citing Ex. 2029, 14:17–15:12 (citing *In re CSB-System Int’l, Inc.*, 832 F.3d 1335, 1340–41 (Fed. Cir. 2016); *Facebook, Inc. v. Pragmatus AV, LLC*, 582 F. App’x 864, 869 (Fed. Cir. 2014))). We noted that in *CSB-System*, the Federal Circuit held that when a patent expires during an appeal from an examiner’s final rejection in an ex parte reexamination, the Board must apply a *Phillips* claim construction. *Id.* (citing 832 F.3d at 1341). We also noted that in *Facebook*, the Federal Circuit construed claim terms under *Phillips* when patents subject to *inter partes* reexamination expired during the pendency of the appeal of the Board’s decisions to the Federal Circuit. *Id.* (citing 582 F. App’x at 868–69). We concluded that these cases were not particularly on point because neither one involves an *inter partes* review proceeding or addresses whether the Board in a remand proceeding, especially one with specific, tailored instructions from the Federal Circuit, necessarily must reinterpret under a *Phillips* framework any previously construed claim terms when a patent expires during the pendency of the remand. *Id.*

In opposition to Patent Owner’s position, Petitioner cited *Personal Web Technologies, LLC v. Apple, Inc.*, 848 F.3d 987 (Fed. Cir. 2017), in support of its position that we should not allow briefing on how claim terms would be construed under *Phillips*. Remand Order 8 (citing Ex. 2029, 26:18–27:14). We explained in our Remand Order that, in *Personal Web*, a patent subject to *inter partes* review expired after the Board’s final written decision but while a rehearing request was pending before the Board. *Id.* (citing *Personal Web*, 848 F.3d at 990). On appeal to the Federal Circuit,

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the parties disputed whether the Board properly applied a broadest reasonable interpretation standard in construing claim terms at issue, with the Director of the Patent and Trademark Office arguing in support of the Board's approach. *Id.* (citing *Personal Web*, 848 F.3d at 990). The court, however, determined that it need not resolve the dispute because the Board's construction was correct under either standard. *Id.* (citing *Personal Web*, 848 F.3d at 990). In our Remand Order, we concluded that, although Petitioner contends that *Personal Web* presents a situation similar to the one here, the Federal Circuit ultimately did not address the issue. *Id.*

In conclusion, we determined that the parties had not identified, and we were not aware of, any authority requiring us to reconsider on remand all of our earlier unpatentability determinations just because the patents have since expired. *Id.* Through its reasoning and explicit instructions to consider Mr. Occhiogrosso's trial testimony and the impact of any inconsistencies on the challenged patents and Mr. Occhiogrosso's credibility, the Federal Circuit carefully delineated the scope of the remand in these proceedings. *Id.* We further indicated that, if we determined in the course of following the court's remand instructions that inconsistencies in Mr. Occhiogrosso's testimony require us to reevaluate the patentability of any claims, we would at that point consider Patent Owner's requests for additional briefing on specific topics, including claim construction under the *Phillips* standard. *Id.* at 8–9.

Neither party requested rehearing of our Remand Order that indicated how the post-remand proceedings would be conducted. *See*

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37 C.F.R. § 42.71(d) (providing that a party dissatisfied with a decision may file a single request for rehearing without prior authorization from the Board and any such request must be filed within 14 days of the entry of a non-final decision). Patent Owner's counsel, however, contacted the Board on February 28, 2018 (eight weeks after entry of our Remand Order on January 3, 2018, and nearly four weeks after Patent Owner filed its Remand Brief on February 2, 2018) and again on May 8, 2018. Patent Owner sought confirmation that Patent Owner would be given the opportunity to put its arguments and evidence on the record regarding its arguments on real party in interest, claim construction, and purported additional evidence that Petitioner copied the claimed inventions, regardless of our ultimate conclusion on whether Mr. Occhiogrosso's testimony warrants revisiting the merits of these proceedings.

Our Remand Order unambiguously delineated the scope of authorized briefing: only whether Mr. Occhiogrosso's district court trial testimony was inconsistent with his testimony in these *inter partes* review proceedings and the impact of any inconsistency. Remand Order 5. Our Remand Order explained that this authorization reflected the Federal Circuit's specific instructions on the scope of remand (Remand Order 5) and repeated those instructions (Remand Order 2):

On remand, the Board shall admit and consider Mr. Occhiogrosso's trial testimony [from *Ultratec, Inc. v. Sorenson Communications, Inc.*, No. 13-CV-00346 (W.D. Wis.)]. If the Board finds he gave inconsistent testimony, the Board shall

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consider the impact on the specific patents at issue in the trial testimony *as well as* on his credibility as a whole.

*Ultratec*, 872 F.3d at 1275.

In view of the unambiguous instructions of the Federal Circuit reflected in our Remand Order, we view Patent Owner’s request for “confirmation” of its ability to present evidence and arguments outside the scope of remand as a request for rehearing of our order defining the scope of these post-remand proceedings. Patent Owner’s request was made six weeks after the deadline for filing a request for rehearing. We deny Patent Owner’s request because Patent Owner failed to comply with the 14-day requirement to file a request for rehearing. 37 C.F.R. § 42.71(d); *see* 37 C.F.R. § 42.25(b) (“Delay in seeking relief may justify a denial of relief sought.”). Moreover, in our Remand Order, we explained reasons for our determination of the scope of post-remand proceedings, particularly the clear instructions from the Federal Circuit as noted above. Remand Order 3–10. We also specifically explained our reasons for disagreeing with Patent Owner’s request to revisit the merits of all nine proceedings under the *Phillips* claim construction standard. *Id.* at 5, 7–9. In addition, the administrative record for each proceeding includes Patent Owner’s proposed scope of remand (Ex. 3004) and transcript of the conference call in which Patent Owner described the arguments and evidence it sought to be included in the scope of remand (Ex. 2029), each of which was cited in the Remand Order.

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## II. ANALYSIS

As mentioned above, Patent Owner alleges that Petitioner’s expert, Mr. Occhiogrosso, gave inconsistent testimony regarding the McLaughlin, Ryan, and Yamamoto references. We first address the testimony regarding McLaughlin, then the testimony regarding Ryan’s disclosure on voice recognition software, and finally the testimony regarding software location, the latter of which involves Ryan and Yamamoto.

### A. Testimony Regarding McLaughlin

Patent Owner states that “[a] central issue in these proceedings is whether *McLaughlin* discloses a captioned telephone device that provides both voice and text.” PO Br. 12. Patent Owner states that, in IPR550, we “relied on Occhiogrosso’s testimony that *McLaughlin* disclosed all of the claim elements in a ‘single system.’” *Id.* at 13. That the claim elements be disclosed in a single system is relevant because our holding in IPR550 is one of anticipation.<sup>4</sup> According to Patent Owner, Mr. Occhiogrosso testified

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<sup>4</sup> Anticipation prohibits the combination of distinct embodiments of a single reference. *See, e.g., Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008) (“[I]t is not enough that the prior art reference . . . includes multiple, distinct teachings that [an ordinary] artisan might somehow combine to achieve the claimed invention.”). Our analysis in the Final Written Decision in IPR550 uses the phrase “single system,” which should be understood to mean a disclosure describing a device arranged as claimed, sufficient for purposes of anticipation. IPR550, Paper 57, 20 (“McLaughlin’s disclosure . . . is describing options for a single system, not separate embodiments.”); *see also Net MoneyIN*, 545 F.3d at 1369 n.5 (“[C]ourts are not constrained to proceed example-by-example when

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before us that McLaughlin disclosed a single system described in multiple sections of McLaughlin’s specification, but “undermined that position at [the district court] trial.” *Id.* at 15; *see also id.* at 18–19 (listing the three passages Patent Owner believes support its position). Patent Owner concludes that Mr. Occhiogrosso cited to different sections of McLaughlin as if they disclosed a single system before us, but allegedly testified that they were different at the district court trial. *Id.* at 20.

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reviewing an allegedly anticipating prior art reference. Rather, the court must, while looking at the reference as a whole, conclude whether or not that reference discloses all elements of the claimed invention arranged as in the claim.”). Further, we distinguish between the features of a single system (i.e., a collection of components that operate together) and the features housed inside a single, contiguous box. In our Final Written Decision in IPR550, when we construed “captioned telephone device,” we noted that the specification of the ’082 patent made clear that various features of the device could be located in separate physical structures. IPR550, Paper 57, 9 (pointing out that the audio function may be separate from the text function (citing Ex. 1001, 9:20–32, 9:15–20, 10:67–11:3, and Figs. 4–6)). We reiterated that position in our Decision on Rehearing. IPR550, Paper 59, 4 (“[T]here was no requirement for all features of the claims to be found in one housing or a ‘single device.’”). Thus, when we say McLaughlin discloses a “single system,” we mean that McLaughlin discloses a collection of components that operate together. Contrary to Patent Owner’s allegations, we are not referring to the combination of multiple *embodiments*. *See* PO Br. 23–24. This distinction is relevant because in our Final Decision, the testimony of Mr. Occhiogrosso, and the arguments of Patent Owner may each use the word “system” slightly differently in different contexts, and it is that context that must be considered to understand the meaning.

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Petitioner asserts that Mr. Occhiogrosso has been consistent in his testimony throughout the PTAB and district court proceedings. In particular, Petitioner directs us to several passages in the testimony from the district court proceeding where Mr. Occhiogrosso indicates that he considers the various passages of McLaughlin to all describe “the same device,” consistent with his testimony in the IPRs. Pet. Br. 10 (citing Ex. 2032, 89:10–21); *id.* at 13 (citing Ex. 2032, 87:24–88:8); *id.* at 15 (citing Ex. 2032, 23:11–24:7); *id.* at 16 (citing Ex. 2032, 40:19–41:2). Petitioner addresses the three passages cited by Patent Owner and sets forth its explanation for why that testimony is not inconsistent. *Id.* at 10–14. Petitioner asserts that Mr. Occhiogrosso’s testimony was consistent before both tribunals. *Id.* at 16.

Having reviewed the arguments and evidence before us, we find Mr. Occhiogrosso’s district court testimony to be consistent with his IPR testimony regarding McLaughlin. In our analysis below, we address in turn the three passages from Mr. Occhiogrosso’s district court testimony cited by Patent Owner as evidence of inconsistency.<sup>5</sup> We then address the

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<sup>5</sup> The parties and the testimony reference various “sections” of McLaughlin, which refer to various headings in the body of that text. Section “A” is directed to column 29, line 64 to column 30, line 12. Section “B” is column 30, line 13 to column 33, line 54. Section “C” is column 33, line 55 to column 34, line 56. *See also, e.g.*, PO Br. 19 (“Occhiogrosso admitted that Section A discloses . . . .”); Ex. 2032, 89:10–21 (“Q. Do you know, as you’re sitting there right now, whether this system disclosed in section b) . . . is disclosing a different system than the other two sections that you cited?”). Sections A, B, and C are subsections of the larger section titled

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implications of this analysis on the Final Written Decisions in which we determined claims were unpatentable on grounds based at least in part on McLaughlin.

### 1. *Trial Testimony, Passage 1*

Patent Owner alleges that Mr. Occhiogrosso testified in district court that Section A of McLaughlin discloses a one-modem system while Section B discloses a two-modem system. PO Br. 18 (citing Ex. 2033, 39:19–40:8; Ex. 2032, 89:22–90:10). Petitioner responds that Mr. Occhiogrosso explains (at the portion immediately prior to Patent Owner’s cite) that he understands McLaughlin to be discussing the same device in those different sections. Pet. Br. 10–11 (citing Ex. 2032, 89:10–21). Reviewing these passages, it is clear to us that Mr. Occhiogrosso’s testimony is not inconsistent, and Patent Owner is only arguing semantics.

In the passage reproduced by Patent Owner at page 18 of its brief, Mr. Occhiogrosso is asked whether the Section A disclosure “is discussing a system in which the user *uses* one SVD modem.” Ex. 2033, 39:19–21 (emphasis added). Mr. Occhiogrosso answers in the affirmative. *Id.* at 39:22. Similarly, Mr. Occhiogrosso is asked about “the *use* of two SVD modems” in Section B, to which he answers in the affirmative again. *Id.* at 40:6–8 (emphasis added). The *use* of a system is different than its structure—a system must have at least the structure used, but it may have

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“Hearing/Speaking Persons Calling Deaf and/or Speech Impaired Persons.”  
*See supra* Section I.A.2.



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other structures not used in that particular passage. There is nothing in the above testimony that indicates that Mr. Occhiogrosso believes that sections A and B describe separate embodiments having different numbers of modems; he merely describes how many modems are *used* by the system in each section. This is entirely consistent with his testimony throughout the district court trial that McLaughlin teaches a single system having many features:

Q. Do you know, as you're sitting there right now, whether this system disclosed in section b) *New Techniques For Hearing/Speaking Persons to Call . . . Deaf and/or Speech Impaired Persons*, do you know whether this section is disclosing a different system than the other two sections that you cited?

A. My understanding of the specification is it's a versatile device that is capable of operating in a number of configurations, so it was my interpretation of the specifications that it's the same device.

Ex. 2032, 89:10–21.

Q. And you can't tell me, as you sit here right now, whether you cited two different sections?

A. Oh, no. They're clearly different sections.

Q. Are they different systems?

A. I don't believe they're different systems. They're a system deployed in a different context, one in a LAN/WAN, one in a WAN with two SVD links connected to it. So I couldn't categorically say they're two different systems. I don't think that was your earlier question perhaps or maybe I misunderstood it.

*Id.* at 87:24–88:8.

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Q. Do you understand -- do you have an understanding as to whether those are separate devices?

A. My understanding is it's an integrated device.

Q. An integrated device that what?

A. May have different operating modes.

Q. Would you turn, please, to page 006 of Exhibit 1913, which is column 3, lines 47 through 50? This is also a text in the McLaughlin patent?

A. Yes.

Q. Would you read that first sentence there in that paragraph?

A. "Different embodiments of the invention may include some but not others of the various modes and features."

Q. As a person of ordinary skill in the art, would you have read that section or that line before you read section 4?

A. Yes.

Ex. 2033, 24:3–19.

Q. This was a system in which there were two users who were connected directly to one another on a LAN or WAN connection, correct?

A. That's what's posited here, yes.

Q. So this is a different system than the system in section b) and a different system than the system in section a), correct?

A. No, I don't see that. In other words, to me it's another operating mode.

*Id.* at 40:19–41:2.

In IPR550, we based our finding that McLaughlin teaches a single system at least in part on Mr. Occhiogrosso's testimony before us, consistent

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with his testimony before the district court, that McLaughlin teaches a single system having many features. IPR550, Paper 57, 20.

## 2. Trial Testimony, Passage 2

Patent Owner alleges that Mr. Occhiogrosso “admitted that the Section A one-modem system discloses a traditional [Voice Carry Over] call, which uses a one-line arrangement.” PO Br. 19 (citing Ex. 2032, 90:7–19). Petitioner correctly points out that Mr. Occhiogrosso was not asked about McLaughlin’s system here, but rather was asked a hypothetical question about a “traditional VCO call.” Pet. Br. 11. The relevant portion of the testimony is reproduced below:

Q. In a VCO call, *in a traditional VCO call*, that’s a one-line arrangement, correct?

A. Yes.

Q. So the deaf user is connected on one line to the relay, correct?

A. *In a traditional VCO*, yes.

Ex. 2032, 90:14–19 (emphasis added).

We find no admission here regarding McLaughlin; Patent Owner is attempting to re-characterize Mr. Occhiogrosso’s discussion of a hypothetical *traditional VCO* system into a discussion of McLaughlin’s system. As additional evidence that Mr. Occhiogrosso’s testimony is consistent, we note that Mr. Occhiogrosso also expresses confusion over Patent Owner’s attempts to conflate McLaughlin’s disclosure of the “use” of certain components of the system in different sections with disclosures of multiple systems. When asked whether Section A “only us[es] one SVD

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modem,” Mr. Occhiogrosso responds that the singular word is used, but then expresses confusion as to why Patent Owner thinks this is important. Mr. Occhiogrosso responds that the use of a single modem does not mean that there are not more modems, and pushes back on Patent Owner’s attempts to elicit a different response. The entire discussion is reproduced below:

Q. Do you know, as you’re sitting there right now, whether this system disclosed in section b) *New Techniques For Hearing/Speaking Persons to Call . . . Deaf and/or Speech Impaired Persons*, do you know whether this section is disclosing a different system than the other two sections that you cited?

A. My understanding of the specification is it’s a versatile device that is capable of operating in a number of configurations, so it was my interpretation of the specifications that it's the same device.

Q. Okay. We just talked about how, in section a) *VCO/HCO With SVD Modems*, that system uses a relay. And then I think you agreed, over on column 33, the section c) *New Techniques For VCO/HCO Access*, that system does not use a relay, correct?

A. Correct.

Q. Now, let’s compare that with section a) in column 29, *VCO/HCO With SVD Modems*. That section discloses the user is only using one SVD modem; isn’t that correct?

A. I see it is singular word, “a SVD modem.” But I fail to, what’s the word I’m looking for, appreciate the depth of your question; in other words, what’s the big deal to equip the device with one or two modems.

Q. In a VCO call, in a traditional VCO call, that’s a one-line arrangement, correct?

A. Yes.

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Q. So the deaf user is connected on one line to the relay, correct?

A. In a traditional VCO, yes.

Q. So doesn't that inform us here that when McLaughlin is talking about a VCO call, he's talking about one connection and therefore one SVD modem?

A. I suppose you could have the two-line architecture still talk to the relay.

Q. That's not what McLaughlin says in section a) though, correct?

A. He really doesn't say. Where do you see where he says that?

Ex. 2032, 89:10–91:3.

Taking this discussion in context, Mr. Occhiogrosso testifies that the specification describes “the same device,” and then is asked about whether the device uses various components in various modes, to which Mr. Occhiogrosso answers in a manner consistent with his “same device” opinion. Mr. Occhiogrosso does not understand “what’s the big deal” with one or two modems because *using* a certain number of modems in one mode is different from *having* a certain number of modems.<sup>6</sup> Mr. Occhiogrosso later clarifies this when he responds that use of the VCO mode would only require one of the two modems (“I suppose you could have the two-line architecture still talk to the relay.”). In sum, the testimony of Mr.

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<sup>6</sup> Patent Owner argues that this “what’s the big deal” statement undermines Mr. Occhiogrosso’s position (PO Br. 21), but Patent Owner again conflates the description of a device using certain components with a device being limited only to those components, and also conflates Mr. Occhiogrosso’s confusion with Patent Owner’s questions with lack of understanding the technology.

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Occhiogrosso is that McLaughlin discloses a single device and, in his opinion, the silence of McLaughlin as to what to do with an unused modem in one mode that does not need that modem is not itself important.

### 3. *Trial Testimony, Passage 3*

Patent Owner alleges “Occhiogrosso admitted that Section A and Section C disclose ‘different systems’ because one discloses a relay and one does not.” PO Br. 19 (citing Ex. 2032, 88:9–15). Petitioner responds that Occhiogrosso makes clear, immediately prior to Patent Owner’s cited portion of the testimony, that he does not believe they are independent embodiments but rather different sections addressing the features of a multi-featured system. Pet. Br. 13–14. We reproduce the testimony cited by both parties below:

Q. And you can’t tell me, as you sit here right now, whether you cited two different sections?

A. Oh, no. They’re clearly different sections.

Q. Are they different systems?

A. I don’t believe they’re different systems. They’re a system deployed in a different context, one in a LAN/WAN, one in a WAN with two SVD links connected to it. So I couldn’t categorically say they’re two different systems. I don’t think that was your earlier question perhaps or maybe I misunderstood it.

Q. Does the system spanning -- that’s described in the paragraph spanning column 29 to 30 use a relay?

A. Yes.

Q. So looking back to your slide, this morning you cited two different systems, one that uses a relay and one that doesn’t, correct?

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A. I would have to say you are correct.

...

Q. Let's turn to McLaughlin and look at where those citations fall. Let's just start with column 31, line 43 to 47. And then let's trace back up column 31 and back up column 30 to column 30, lines 13 to 14. Do you see that your citations on this slide are to yet a third different system disclosed in McLaughlin?

A. What makes you believe this is a third different system?

Q. Do you know, as you're sitting there right now, whether this system disclosed in section b) *New Techniques For Hearing/Speaking Persons to Call . . . Deaf and/or Speech Impaired Persons*, do you know whether this section is disclosing a different system than the other two sections that you cited?

A. My understanding of the specification is it's a versatile device that is capable of operating in a number of configurations, so it was my interpretation of the specifications that it's the same device.

Ex. 2032, 87:24–89:21.

Just as in the prior passages, Mr. Occhiogrosso is consistent in his testimony that McLaughlin discloses a single system that uses the appropriate components when operating in different contexts. The testimony regarding “one [system] that uses a relay and one that doesn't” is not inconsistent with his position because Mr. Occhiogrosso is again testifying as to which components are *used*. That Mr. Occhiogrosso uses the word “system” as a stand-in for what he had previously called “context[s]” is merely arguing semantics. The substance of what Mr. Occhiogrosso is saying is clear based on the surrounding testimony, where he states that McLaughlin discloses a system having multiple features. *E.g.*, Ex. 2032,

IPR2013-00540 (Patent 6,233,314) IPR2013-00541 (Patent 5,909,482)  
IPR2013-00542 (Patent 7,319,740) IPR2013-00543 (Patent 7,555,104)  
IPR2013-00544 (Patent 8,213,578) IPR2013-00545 (Patent 6,594,346)  
IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
IPR2014-00780 (Patent 6,603,835)

18–21 (“My understanding of the specification is it’s a versatile device that is capable of operating in a number of configurations, so it was my interpretation of the specifications that it’s the same device.”). That Mr. Occhiogrosso possibly used a word imprecisely once during the day of oral testimony does not change his repeated statements that McLaughlin has a single device having certain features, even if some of them are not described as being used at the same time as other features.

#### 4. *Conclusion on Occhiogrosso’s Testimony Regarding McLaughlin*

Reviewing the arguments and evidence before us, we find that Mr. Occhiogrosso provided consistent testimony regarding McLaughlin in the district court and before us in the IPRs. Thus, we find that his testimony before us remains credible with regard to McLaughlin. Furthermore, contrary to Patent Owner’s arguments, we explain below why any alleged inconsistencies, even if they existed, do not impact the Final Written Decisions in IPR542, IPR543, IPR544, and IPR550, the only decisions addressing grounds based on McLaughlin.

##### *a. IPR2013-00542, IPR2013-00543, and IPR2013-00544*

In our Final Written Decisions in IPR542, IPR543, and IPR544, we determined that claims 1 and 2 of the ’740 patent, claims 1 and 2 of the ’104 patent, and claims 8–11 of the ’578 patent are unpatentable as obvious over the combination of McLaughlin and Ryan. IPR542, Paper 66, 29; IPR543, Paper 66, 28; IPR544, Paper 74, 54.<sup>7</sup> In each of these decisions, we

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<sup>7</sup> On rehearing, we modified our analysis regarding the rationale for



IPR2013-00540 (Patent 6,233,314) IPR2013-00541 (Patent 5,909,482)  
 IPR2013-00542 (Patent 7,319,740) IPR2013-00543 (Patent 7,555,104)  
 IPR2013-00544 (Patent 8,213,578) IPR2013-00545 (Patent 6,594,346)  
 IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
 IPR2014-00780 (Patent 6,603,835)

found that McLaughlin teaches a captioned telephone device as required by the claims. IPR542, Paper 66, 20 (citing Ex. 1009, 30:46–48, 30:59–63, 31:41–47, 32:41–52); IPR543, Paper 66, 19–20 (citing Ex. 1012, 30:46–48, 30:59–63, 31:41–47, 32:41–52); IPR544, Paper 74, 51 (citing Ex. 1009, 30:46–48, 30:59–63, 31:41–47, 32:41–52). Notably, all portions of McLaughlin explicitly cited in our analysis of that claim limitation appear in what Patent Owner refers to as Section B. Therefore, Patent Owner’s contention regarding Mr. Occhiogrosso’s allegedly inconsistent testimony—that he admitted in district court that different sections of McLaughlin (i.e., Sections A, B, and C) disclose different systems but testified before us that they disclose the same system—would not affect the result in these three decisions, even if the allegation were true, which it is not for the reasons explained above.

Moreover, Patent Owner’s entire argument regarding Mr. Occhiogrosso’s testimony on McLaughlin relates to our anticipation finding in IPR550, which, according to Patent Owner, relied on Mr. Occhiogrosso’s testimony that McLaughlin discloses all the claim elements in a “single system.” PO Br. 13. Thus, we agree with Petitioner that Patent Owner fails to explain how any alleged inconsistencies on this point implicate the obviousness determinations in IPR542, IPR543, and IPR544. *See* Pet.

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combining McLaughlin and Ryan, but did not reconsider our findings that McLaughlin teaches a captioned telephone device. *See* IPR542, Paper 68, 2–7 (Rehearing Decision); IPR543, Paper 68, 2–7 (Rehearing Decision); IPR544, Paper 76, 10–13 (Rehearing Decision).

IPR2013-00540 (Patent 6,233,314) IPR2013-00541 (Patent 5,909,482)  
IPR2013-00542 (Patent 7,319,740) IPR2013-00543 (Patent 7,555,104)  
IPR2013-00544 (Patent 8,213,578) IPR2013-00545 (Patent 6,594,346)  
IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
IPR2014-00780 (Patent 6,603,835)

Br. 18. Furthermore, even if our decisions in these cases had relied on disclosure from different sections of McLaughlin for teaching the captioned telephone device recited in the claims of the '740 patent, '104 patent, and '578 patent, such reliance would not preclude a conclusion of obviousness, even if the different sections described different systems (which, as explained above, was not Mr. Occhiogrosso's testimony in either the district court trial or the IPRs).

Finally, Patent Owner argues that in making our unpatentability determinations in IPR542, IPR543, and IPR544, we "explicitly credited [Mr.] Occhiogrosso's opinions over those of [Patent Owner's expert, Mr.] Steel."<sup>8</sup> PO Br. 22–23 (citing IPR542, Paper 66, 20, 24; IPR543, Paper 66, 20; IPR544, Paper 74, 51, 53). In our decisions, however, we first made findings as to McLaughlin's teaching of a captioned telephone device, supported by ample citation to McLaughlin, and explained why Patent Owner's arguments were unpersuasive. *See, e.g.*, IPR542, Paper 66, 20. Then, "based on our review of McLaughlin," we credited Mr. Occhiogrosso's testimony over that of Patent Owner's declarants. *Id.* In other words, Mr. Occhiogrosso's testimony only confirmed our independent

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<sup>8</sup> Patent Owner fails to recognize that in IPR544 it relied on the testimony of Mr. Ludwick, rather than that of Mr. Steel, in support of its unpatentability arguments, and we likewise referred to Mr. Ludwick's testimony in the Final Written Decision. *See e.g.*, IPR544, Paper 74, 51 (citing Ex. 2010 ¶¶ 32–34).

IPR2013-00540 (Patent 6,233,314) IPR2013-00541 (Patent 5,909,482)  
IPR2013-00542 (Patent 7,319,740) IPR2013-00543 (Patent 7,555,104)  
IPR2013-00544 (Patent 8,213,578) IPR2013-00545 (Patent 6,594,346)  
IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
IPR2014-00780 (Patent 6,603,835)

reading of McLaughlin, and, for the reasons discussed above, Mr.

Occhiogrosso's district court testimony aligns with his testimony before us.

*b. IPR2013-00550*

Patent Owner points out that we relied on the testimony of Mr. Occhiogrosso when we found in IPR550 that McLaughlin describes a microphone, a speaker, and a visually readable display. PO Br. 23–25. Indeed, in our analysis of claim 1 of the '082 patent, we relied on Mr. Occhiogrosso's testimony when we found that a “person of ordinary skill in the art would consider McLaughlin to be disclosing a device capable of all of the HCO/VCO features described therein.” IPR550, Paper 57, 20 (citing IPR550, Ex. 1030 ¶¶ 23–24). Patent Owner is incorrect, however, when it states “the Board cited no other evidence [besides Occhiogrosso] to support its findings that *McLaughlin* discloses a captioned telephone device.” PO Br. 24. Our analysis of claim 1 does not require citation to Mr. Occhiogrosso's testimony because we repeatedly cite to and rely on the McLaughlin reference itself. *See generally* IPR550, Paper 57, 15–24. Even as to the portion of the decision where we cited to Mr. Occhiogrosso's testimony, we had already found “the microphone, speaker, and display limitations properly read on the device described in McLaughlin.” *Id.* at 19; *see also id.* at 18–19 (citing to the various portions of McLaughlin disclosing these features). It was only in addressing Patent Owner's arguments that we cited Mr. Occhiogrosso's testimony. *Id.* at 19–20 (stating, “To the extent Patent Owner is arguing . . . ,” followed by our response to that potential argument). Accordingly, we have found Mr. Occhiogrosso's testimony

IPR2013-00540 (Patent 6,233,314) IPR2013-00541 (Patent 5,909,482)  
IPR2013-00542 (Patent 7,319,740) IPR2013-00543 (Patent 7,555,104)  
IPR2013-00544 (Patent 8,213,578) IPR2013-00545 (Patent 6,594,346)  
IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
IPR2014-00780 (Patent 6,603,835)

reliable and trustworthy, but even if we had not, it would not affect the outcome of IPR550.

*B. Testimony Regarding Ryan*

Patent Owner argues that during the district court trial, Mr. Occhiogrosso made “several related admissions” concerning his testimony “surrounding” Ryan. PO Br. 28. Specifically, Patent Owner contends that Mr. Occhiogrosso’s trial testimony was inconsistent with his opinion, provided in six of the proceedings before us,<sup>9</sup> that Ryan describes voice recognition software “trained to the voice of the call assistant,” as required by the claims at issue in those cases. *Id.* Patent Owner cites several excerpts of allegedly inconsistent trial testimony, which, when reordered, comprise the following single passage of testimony:

Q. Let’s focus on the sentence [from Ryan] we have highlighted, “If the software is specifically designed to recognize the voice of particular relay agents.” And if we could now compare with claim 1 of the ’482 patent, please, read along with me in the middle paragraph. “The digital computer using voice recognition computer software trained to the voice of the call assistant.” The sentence you cited in Ryan does not say “trained to the voice of the call assistant,” does it?

A. Could you put the sentence back up? The word *trained* does not appear in the sentence.

Q. Would you agree the act of designing software means developing a set of requirements and codifying those requirements into instructions in some kind of programming

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<sup>9</sup> IPR540, IPR541, IPR542, IPR543, IPR544, and IPR545.

IPR2013-00540 (Patent 6,233,314) IPR2013-00541 (Patent 5,909,482)  
IPR2013-00542 (Patent 7,319,740) IPR2013-00543 (Patent 7,555,104)  
IPR2013-00544 (Patent 8,213,578) IPR2013-00545 (Patent 6,594,346)  
IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
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language that would subsequently be compiled, in most instances, or interpreted and executed as a process?

A. That's one variation of software design.

Q. And that's your definition of the act of designing a software, isn't it?

A. I don't recall. Is that from another transcript? Perhaps. Sounds like something I might have said.

Q. Do you agree with that definition of the act of designing software?

A. I think that's a fair characterization of it.

Q. Earlier today you were talking about speaker-dependent voice recognition software and I believe you indicated that users train the software so it can learn their voice, correct?

A. Yes.

Q. The software isn't predesigned to recognize the voice when it's speaker dependent, correct?

A. Of course not.

Ex. 2032, 78:3–79:10.

Patent Owner alleges this trial testimony is inconsistent with Mr. Occhiogrosso's IPR testimony in three ways. First, Patent Owner contends that Mr. Occhiogrosso "admitted that *Ryan* did not say that its disclosed software was "trained to the voice of the call assistant." PO Br. 30 (citing Ex. 2032, 78:3–13). As set forth above, Mr. Occhiogrosso's actual testimony was that the word "trained" does not appear in the portion of the sentence from *Ryan* quoted to him during cross-examination. This testimony does not reveal an inconsistency, as Patent Owner does not allege Mr. Occhiogrosso testified during the IPRs that the applicable phrase from

IPR2013-00540 (Patent 6,233,314) IPR2013-00541 (Patent 5,909,482)  
IPR2013-00542 (Patent 7,319,740) IPR2013-00543 (Patent 7,555,104)  
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IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
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Ryan uses the word “trained.” Further, a reference need not satisfy an *ipsissimis verbis* test to anticipate, *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009), so Mr. Occhiogrosso’s acknowledgment that the specific word “trained” does not appear in Ryan does not contradict his testimony in the IPRs that Ryan describes software “trained to the voice of the call assistant,” as recited in the claims at issue.

Second, Patent Owner argues that Mr. Occhiogrosso’s district court testimony regarding his definition of “designing software” is inconsistent with his opinion before the Board that Ryan’s disclosure of software “specifically designed to recognize the voice of particular relay agents” teaches software trained to the voice of the call assistant. PO Br. 29–30 (citing Ex. 2032, 78:14–79:2). Again, the cited trial testimony does not show an inconsistency. As Petitioner points out, Mr. Occhiogrosso earlier provided the same definition of “designing software” during a deposition for the first eight IPR proceedings, including the six with unpatentability grounds based on Ryan. *See* Pet. Br. 22 (citing, *e.g.*, IPR540, Ex. 2007, 270:13–19). We fail to see how Mr. Occhiogrosso’s agreement with that definition during his cross-examination at trial can be the basis for an inconsistency with his testimony in the proceedings before us when the definition in the question posed to Mr. Occhiogrosso was taken directly from his IPR deposition testimony.

Moreover, Mr. Occhiogrosso characterized that definition of “designing software” as just “one variation of software design.” Ex. 2032, 78:14–79:2. Significantly, he did not apply the definition directly to Ryan’s

IPR2013-00540 (Patent 6,233,314) IPR2013-00541 (Patent 5,909,482)  
IPR2013-00542 (Patent 7,319,740) IPR2013-00543 (Patent 7,555,104)  
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IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
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disclosure of software that is “specifically designed.” Because Mr. Occhiogrosso’s trial testimony regarding a definition of “designing software” is not tied to the disclosure of Ryan itself, the testimony does not reveal an inconsistency with Mr. Occhiogrosso’s IPR testimony that Ryan teaches software trained to the voice of the call assistant. Indeed, immediately after providing that definition in his IPR testimony, Mr. Occhiogrosso turned to Ryan and confirmed that software “specifically designed” as disclosed means that the developers “built into the software the ability to recognize the voice of a particular agent,” which would be achieved with “whatever speaker-dependent speech recognition algorithm that they elected to adopt and . . . codify into software.” *E.g.*, IPR540, Ex. 2007, 270:20–271:9.

Finally, Patent Owner argues that with his answers to the last two questions in the trial testimony passage quoted above (Ex. 2032, 79:3–10), Mr. Occhiogrosso admitted that speaker-dependent software is not “*predesigned* to recognize the voice.” PO Br. 29 (emphasis added). Patent Owner apparently contends this testimony contradicts Mr. Occhiogrosso’s opinion in the IPRs that Ryan’s disclosure of software “specifically designed to recognize the voice of particular relay agents” teaches software “trained to the voice of the call assistant,” as recited in the claims. *See id.* at 31. As with the preceding excerpt, however, this trial testimony does not address Ryan’s disclosure of “specifically designed” software, and therefore is not inconsistent with Mr. Occhiogrosso’s IPR testimony that Ryan describes software trained to the voice of a call assistant. *See, e.g.*, IPR540, Ex. 1053

IPR2013-00540 (Patent 6,233,314) IPR2013-00541 (Patent 5,909,482)  
IPR2013-00542 (Patent 7,319,740) IPR2013-00543 (Patent 7,555,104)  
IPR2013-00544 (Patent 8,213,578) IPR2013-00545 (Patent 6,594,346)  
IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
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¶ 41. Furthermore, portions of Mr. Occhiogrosso’s district court testimony that do specifically address Ryan corroborate his testimony in the IPRs that the claimed voice recognition software “trained to the voice of the call assistant” is met by Ryan’s disclosure of software “specifically designed to recognize the voice of particular relay agents.” Ex. 2031, 65:17–66:7 (providing opinion that Ryan satisfies the claim language); Ex. 2033, 21:10–22:6 (explaining that a person of ordinary skill in the art would understand Ryan specifically designed software to include speaker-dependent speech recognition software that has been trained).

For these reasons, we conclude that the passage from Mr. Occhiogrosso’s trial testimony quoted above (Ex. 2032, 78:3–79:10) does not conflict with his IPR testimony. Accordingly, there is no impact of these alleged inconsistencies concerning Ryan on the Final Written Decisions in IPR540, IPR541, IPR542, IPR543, IPR544, and IPR545. We find that Mr. Occhiogrosso’s testimony before us remains credible with regard to Ryan’s teaching of voice recognition software that can be trained to the voice of the call assistant.

### *C. Testimony Regarding Software Location*

Patent Owner contends that Mr. Occhiogrosso’s trial testimony concerning whether the claims require, and whether the prior art references Ryan and Yamamoto disclose, voice recognition software stored at the call assistant workstation conflicts with his IPR testimony. PO Br. 34–46. Patent Owner asserts Mr. Occhiogrosso’s trial testimony regarding software



IPR2013-00540 (Patent 6,233,314) IPR2013-00541 (Patent 5,909,482)  
 IPR2013-00542 (Patent 7,319,740) IPR2013-00543 (Patent 7,555,104)  
 IPR2013-00544 (Patent 8,213,578) IPR2013-00545 (Patent 6,594,346)  
 IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
 IPR2014-00780 (Patent 6,603,835)

location conflicts with his testimony in IPR540 and IPR541 involving the following challenges:

Case	Patent	Reference(s)	Basis	Claim(s)
IPR540	6,233,314	Ryan	§ 102(e)	1 and 2
IPR541	5,909,482	Ryan	§ 102(e)	1 and 5
IPR541	5,909,482	Wycherley and Yamamoto	§ 103(a)	1 and 5
IPR541	5,909,482	Wycherley, Yamamoto, and Liebermann	§ 103(a)	6

PO Br. 34–46.

Having reviewed the parties’ arguments and evidence, we find that there is no inconsistency in Mr. Occhiogrosso’s trial and IPR testimony regarding whether the prior art discloses voice recognition software stored at the call assistant workstation. We also find that there is no inconsistency in Mr. Occhiogrosso’s trial and IPR testimony regarding whether the claims require such a limitation. In our analysis below, we first address Patent Owner’s contentions regarding Ryan, then Patent Owner’s contentions regarding Yamamoto, and finally Patent Owner’s contentions regarding claim scope.

### 1. *Testimony Concerning Ryan*

Patent Owner contends that at the district court trial Mr. Occhiogrosso acknowledged that Ryan does not disclose voice recognition software stored at the call assistant workstation. PO Br. 34 (citing Ex. 2032, 49:14–52:8, 56:25–58:13, 63:2–22), 38–39 (quoting Ex. 2032, 56:25–57). According to Patent Owner, Mr. Occhiogrosso testified at trial that Ryan discloses voice recognition software stored at the call agent’s telephone device (Ryan’s

IPR2013-00540 (Patent 6,233,314) IPR2013-00541 (Patent 5,909,482)  
 IPR2013-00542 (Patent 7,319,740) IPR2013-00543 (Patent 7,555,104)  
 IPR2013-00544 (Patent 8,213,578) IPR2013-00545 (Patent 6,594,346)  
 IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
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Device 20), not at the relay agent’s terminal. PO Br. 34 (citing Ex. 2032, 49:14–52:8, 56:25–58:13, 63:2–22), 38–39 (quoting Ex. 2032, 56:25–58:13). But, according to Patent Owner, Mr. Occhiogrosso testified the opposite in the IPR testimony—that Ryan discloses voice recognition software stored at the call assistant workstation. PO Br. 34–35 (citing IPR540, Ex. 1014 ¶¶ 28, 32, 44; IPR541, Ex. 1014 ¶¶ 28, 32, 44). For the reasons explained below, we find no inconsistency between Mr. Occhiogrosso’s district court trial and IPR testimony.

*a. Trial Testimony*

In the district court trial, under cross-examination, Mr. Occhiogrosso testified that voice recognition software stored in Ryan “could be employed at Device 20,” which, according to Mr. Occhiogrosso, Ryan characterizes as the relay agent phone device. Ex. 2032, 56:25–57:17; PO Br. 38–39 (quoting Ex. 2032, 56:25–58:13). Notably, when asked to agree that Device 20 was not a workstation of a call assistant, Mr. Occhiogrosso did not agree, but equivocated that “one possibility” was that Device 20 was “just a phone” and not a call assistant workstation. Ex. 2032, 57:14–22<sup>10</sup>; PO Br. 38–39 (quoting Ex. 2032, 56:25–58:13).

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<sup>10</sup> Ex. 2032, 57:14–22 (“Q. Do you know what Device 20 is? . . . A. Device 20 is the agent device. Q. It’s a telephone, isn’t it? A. . . . yes, that’s how it is characterized in the patent, agent phone device. Q. That’s not a workstation of a call assistant, is it? A. Well, agent phone device, I mean, it could be, but I think the term *phone* may suggest that it’s just a phone. That’s one possibility.”).

IPR2013-00540 (Patent 6,233,314) IPR2013-00541 (Patent 5,909,482)  
IPR2013-00542 (Patent 7,319,740) IPR2013-00543 (Patent 7,555,104)  
IPR2013-00544 (Patent 8,213,578) IPR2013-00545 (Patent 6,594,346)  
IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
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Moreover, Mr. Occhiogrosso testified at trial about another embodiment in Ryan in which a single composite terminal performs the functions of the relay agent's telephone (Device 20, which stores voice recognition software) and the functions of Terminal 12 (which, according to Petitioner, corresponds to the call assistant workstation required by the claims). Ex. 2032, 58:2–6<sup>11</sup>; *see* Ex. 2032, 59:10–11; PO Br. 39 (quoting Ex. 2032, 56:25–58:13); Pet. Br. 34–35 (citing Ex. 2032, 59:5–23). Mr. Occhiogrosso agreed with Patent Owner's counsel that Ryan does not disclose that voice recognition software is saved on the composite terminal. Ex. 2032, 58:7–13,<sup>12</sup> 59:12–15.<sup>13</sup>

*b. IPR Testimony*

Patent Owner and Petitioner both recognize, as do we, that in Mr. Occhiogrosso's reply declaration in the IPRs, he testified unequivocally

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<sup>11</sup> Ex. 2032, 58:2–6 (“Well, I’m going to just interject that, you know, essentially in Ryan there is a passage that contemplates another embodiment where he reads, ‘Of course a single composite terminal could be utilized to perform the functions of both Device 20 and Terminal 12.’”); Ex. 2032, 59:10–11 (Mr. Occhiogrosso testifying that “I also indicated that the passage in Ryan discloses that one could have a composite terminal.”).

<sup>12</sup> Ex. 2032, 58:7–13 (“Q. But [Ryan] doesn’t say the voice recognition software is saved on that combination terminal, does it? A. Ryan doesn’t say that, but that’s obvious to a person of ordinary skill that I could combine those two capabilities and essentially have – I mean, with all due respect, that’s not rocket science to put those two boxes together.”).

<sup>13</sup> Ex. 2032, 59:12–15 (“Q. But [Ryan] does not disclose that the voice recognition software is saved on the terminal, correct? A. Well, that’s my implication. Okay. Let me read it again.”).

IPR2013-00540 (Patent 6,233,314) IPR2013-00541 (Patent 5,909,482)  
 IPR2013-00542 (Patent 7,319,740) IPR2013-00543 (Patent 7,555,104)  
 IPR2013-00544 (Patent 8,213,578) IPR2013-00545 (Patent 6,594,346)  
 IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
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that Ryan discloses voice recognition software stored at the relay agent’s terminal. IPR540, Ex. 1053 ¶ 40; IPR541, Ex. 1053 ¶ 40; Pet. Br. 37 (citing IPR540, Ex. 1053 ¶ 40; IPR541, Ex. 1053 ¶ 40); PO Br. 37 (citing IPR540, Ex. 1053 ¶ 40; IPR541, Ex. 1053 ¶ 40). In his reply declaration, Mr. Occhiogrosso indicates that he “understand[s] that Patent Owner additionally asserts that Ryan fails to disclose that the relay agent’s computer contains voice recognition software.” IPR540, Ex. 1053 ¶ 40 (citing IPR540, Paper 30 (Patent Owner’s Response), 25–26); *see also* IPR541, Ex. 1053 ¶ 40. Addressing Patent Owner’s assertion, Mr. Occhiogrosso testifies that “Ryan clearly discloses that software located at the relay is in fact contained in ‘terminal 12,’ the relay agent’s terminal.” IPR540, Ex. 1053 ¶ 40 (citing Ex. 1004, 2:49–51); *see also* IPR541, Ex. 1053 ¶ 40. Mr. Occhiogrosso supports this testimony by relying on a passage in Ryan not discussed in his trial testimony. IPR540, Ex. 1053 ¶ 40 (citing Ex. 1004, 2:49–51); *see also* IPR541, Ex. 1053 ¶ 40. According to Mr. Occhiogrosso, Ryan discloses, in column two, that a relay terminal may include voice recognition software. IPR540, Ex. 1053 ¶ 40 (citing Ex. 1004, 2:49–51); *see also* IPR541, Ex. 1053 ¶ 40. Specifically, Mr. Occhiogrosso testifies:

I understand that Patent Owner additionally asserts that Ryan fails to disclose that the relay agent’s computer contains voice recognition software. PO Response, pp. 25-26. However, Ryan clearly discloses that software located at the relay is in fact contained in “terminal 12,” the relay agent’s terminal. Ex. 1004, 2:49-51 (“The computer program may analyze the words prior to transmission to the TDD (if the

IPR2013-00540 (Patent 6,233,314) IPR2013-00541 (Patent 5,909,482)  
IPR2013-00542 (Patent 7,319,740) IPR2013-00543 (Patent 7,555,104)  
IPR2013-00544 (Patent 8,213,578) IPR2013-00545 (Patent 6,594,346)  
IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
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program resides at the relay terminal)” (emphasis added)).  
Indeed, Patent Owner’s argument appears to rest entirely on the assertion that the terminal referenced in the revoicing embodiment could be a different terminal than the one uniformly referred to through the patent, which is remote from the relay agent. PO Response, p. 24.

IPR540, Ex. 1053 ¶ 40; *see also* IPR541, Ex. 1053 ¶ 40.

*c. Analysis*

We do not find any inconsistency between Mr. Occhiogrosso’s trial and IPR testimony regarding Ryan’s disclosure of voice recognition software stored at a call assistant workstation. During the IPR proceedings, Mr. Occhiogrosso testified that Ryan discloses voice recognition software stored on “terminal 12.” Patent Owner cites no trial testimony in which Mr. Occhiogrosso stated that voice recognition software is not stored on Ryan’s “terminal 12.” Rather, Patent Owner cites Mr. Occhiogrosso’s testimony, during cross-examination at trial, that (i) Ryan expressly discloses voice recognition software at Device 20; (ii) Ryan expressly discloses a composite terminal that combines the functions of Device 20 and Terminal 12; (iii) but that Ryan has no express statements that voice recognition software is located on the composite terminal.

The fact that Mr. Occhiogrosso testified in the IPRs that Ryan discloses in another passage that voice recognition software is being stored on Terminal 12 does not conflict with his trial testimony that was limited to other passages in Ryan and that never directly indicated that voice recognition software was not stored in Terminal 12. Moreover, Patent Owner fails to address Mr. Occhiogrosso’s testimony concerning a

IPR2013-00540 (Patent 6,233,314) IPR2013-00541 (Patent 5,909,482)  
 IPR2013-00542 (Patent 7,319,740) IPR2013-00543 (Patent 7,555,104)  
 IPR2013-00544 (Patent 8,213,578) IPR2013-00545 (Patent 6,594,346)  
 IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
 IPR2014-00780 (Patent 6,603,835)

composite terminal having the functions of Device 20 and Terminal 12, which was given in the context of Mr. Occhiogrosso’s trial testimony about Device 20. This further undermines Patent Owner’s contentions of inconsistency.

## 2. *Testimony Concerning Yamamoto*

Patent Owner contends that Mr. Occhiogrosso provided district court trial testimony inconsistent with his IPR testimony when at trial he testified that Section 3.2 of Yamamoto “does not disclose anything about where voice recognition software is stored.” PO Br. 40–41 (citing Ex. 2032, 63:2–22); Ex. 2032, 63:2–13.<sup>14</sup>

Regarding Mr. Occhiogrosso’s IPR testimony, Patent Owner acknowledges that Mr. Occhiogrosso did not address in his reply declaration the issue of whether Yamamoto discloses where voice recognition software is stored. PO Br. 37 (citing IPR540, Ex. 1053 ¶¶ 54–62; IPR541, Ex. 1053 ¶¶ 54–62). Patent Owner, however, contends that, in the IPR proceedings, Mr. Occhiogrosso testified “that it was ‘apparent’ to one of ordinary skill in the art that Yamamoto disclosed ‘speaker-dependent voice recognition’ software at the ‘operator system.’”) PO Br. 42 (citing IPR540, Ex. 1014 ¶ 41; IPR541, Ex. 1014 ¶ 41).

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<sup>14</sup> Ex. 2032, 63:2–13 (“Q. And I’ve got some language here from Section 3.2 of Yamamoto. . . . And this section of Yamamoto does not disclose anything about where voice recognition software is stored, correct? A. From my one reading of it, I would say that that statement that you had made is correct.”).

IPR2013-00540 (Patent 6,233,314) IPR2013-00541 (Patent 5,909,482)  
IPR2013-00542 (Patent 7,319,740) IPR2013-00543 (Patent 7,555,104)  
IPR2013-00544 (Patent 8,213,578) IPR2013-00545 (Patent 6,594,346)  
IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
IPR2014-00780 (Patent 6,603,835)

The portion of Mr. Occhiogrosso’s IPR testimony cited by Patent Owner, however, does not support Patent Owner’s position.

Mr. Occhiogrosso testified that Yamamoto discloses “using voice recognition on the voice ‘of an operator repeating the question from the user’” (referred to in many of the IPRs as “revoicing”) and, though not expressly described in Yamamoto, that such a revoicing system would benefit from training the voice recognition system to the voice of the operator. IPR540, Ex. 1014 ¶ 41; IPR541, Ex. 1014 ¶ 41. Thus, this testimony concerns revoicing and the benefits of speaker-dependent voice recognition over speaker-independent voice recognition for an operator assistance system (as opposed to a fully automated voice recognition system). Mr. Occhiogrosso’s testimony discusses revoicing functionality, not the location where voice recognition software is stored. We, therefore, do not agree that Mr. Occhiogrosso testifies in paragraph 41, as Patent Owner alleges, that “Yamamoto necessarily required speaker-dependent voice recognition software at the operator system.” PO Br. 36 (citing IPR540, Ex. 1014 ¶ 41; IPR541, Ex. 1014 ¶ 41).

Because Patent Owner has not identified IPR testimony, and we are unaware of any, in which Mr. Occhiogrosso opined that Yamamoto discloses voice recognition software stored on the operator system, we do not perceive any IPR testimony that conflicts with Mr. Occhiogrosso’s trial testimony that Yamamoto in Section 3.2 does not disclose where voice recognition software is stored.

IPR2013-00540 (Patent 6,233,314) IPR2013-00541 (Patent 5,909,482)  
IPR2013-00542 (Patent 7,319,740) IPR2013-00543 (Patent 7,555,104)  
IPR2013-00544 (Patent 8,213,578) IPR2013-00545 (Patent 6,594,346)  
IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
IPR2014-00780 (Patent 6,603,835)

### 3. *Testimony Concerning Claim Scope*

Patent Owner points to Mr. Occhiogrosso’s trial testimony concerning the scope of certain claims as being inconsistent with his IPR testimony. PO Br. 34, 37–38 (citing Ex. 2032, 49:14–25, 50:12–51:3, 52:1–8). Patent Owner may be arguing that Mr. Occhiogrosso’s trial testimony concerning whether the claims require voice recognition software stored at the call assistant workstation is inconsistent with Mr. Occhiogrosso’s IPR testimony. *See* PO Br. 37 (indicating “[Mr.] Occhiogrosso testified at trial that the claims-at-issue require voice recognition software at the call assistant workstation and that neither Ryan nor Yamamoto disclose that element”); PO Br. 34, 37–38. But Patent Owner does not identify any IPR testimony that purportedly is inconsistent. Thus, we find that Mr. Occhiogrosso’s trial testimony concerning the scope of the claims is not inconsistent with any IPR testimony concerning claim scope.

Patent Owner further contends that Mr. Occhiogrosso’s conclusions in the IPRs that Ryan anticipates the claims and the claims would have been obvious over Yamamoto (in combination with other references) is “fundamentally contradictory and cannot be reconciled” with his trial testimony that “neither Ryan nor Yamamoto disclosed this element.” PO Br. 34 (“At trial, Mr. Occhiogrosso agreed with [Patent Owner’s] assessment” that the claims required voice recognition software at the call assistant workstation, and “further acknowledged that neither Ryan nor Yamamoto disclosed the element.”) (citing Ex. 2032, 49:14–52:8, 56:25–58:13, 63:2–22).



IPR2013-00540 (Patent 6,233,314) IPR2013-00541 (Patent 5,909,482)  
IPR2013-00542 (Patent 7,319,740) IPR2013-00543 (Patent 7,555,104)  
IPR2013-00544 (Patent 8,213,578) IPR2013-00545 (Patent 6,594,346)  
IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
IPR2014-00780 (Patent 6,603,835)

We understand Patent Owner to contend that concluding claims of the '314 patent and the '482 patent are anticipated by Ryan or would have been obvious over Yamamoto (in combination with other references) in the IPRs requires Mr. Occhiogrosso to conclude that Ryan and Yamamoto disclose voice recognition software stored at the call assistant workstation. PO Br. 34–35. And, as we understand Patent Owner, this position is inconsistent with his trial testimony that neither Ryan nor Yamamoto discloses voice recognition software located at the call assistant workstation in the IPRs. PO Br. 34–35.

We disagree. First, for the reasons discussed above, we do not agree with Patent Owner's broad conclusion that Mr. Occhiogrosso testified at trial that Ryan does not disclose voice recognition software stored at the call assistant workstation. Rather, at trial, Mr. Occhiogrosso testified concerning two passages in Ryan.

Second, we disagree that Mr. Occhiogrosso testified that Yamamoto does not disclose voice recognition software stored at the call assistant workstation. Rather, Mr. Occhiogrosso's trial testimony identified by Patent Owner was limited to a particular section of Yamamoto (Section 3.2). PO Br. 34 (citing Ex. 2032, 63:2–22). Mr. Occhiogrosso himself limited his testimony to the particular section of Yamamoto.<sup>15</sup>

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<sup>15</sup> Ex. 2032, 63:18–25 (“Q. And this section of Yamamoto [Section 3.2] does not disclose anything about where the voice recognition software is stored, correct? A. From my one reading of it, I would say that that statement that you ha[ve] made is correct. Q. And so in regard to the '482 patent and the '314 patent, I believe you had obviousness grounds that were based on

IPR2013-00540 (Patent 6,233,314) IPR2013-00541 (Patent 5,909,482)  
IPR2013-00542 (Patent 7,319,740) IPR2013-00543 (Patent 7,555,104)  
IPR2013-00544 (Patent 8,213,578) IPR2013-00545 (Patent 6,594,346)  
IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
IPR2014-00780 (Patent 6,603,835)

Third, in its Brief, as in the IPRs, Patent Owner asserts that the claims require voice recognition software stored at the call assistant workstation.

PO Br. 34. In our Final Written Decisions in IPR540 and IPR541, we concluded that the claims of the '314 and '482 patents do not require voice recognition software to be located at the call assistant workstation. IPR540, Paper 78, 10; IPR541, Paper 76, 12. Our conclusion was based on the plain language of the claims that require a computer only to use a voice recognition computer software package trained to the voice of the call assistant and do not expressly require the voice recognition computer software package to be stored on the call assistant's workstation, which is only one of various devices involved in the relay system. IPR540, Paper 78, 8–10; IPR541, Paper 76, 10–12. We also explained that

neither Patent Owner nor Mr. Ludwick [Patent Owner's expert] addresses sufficiently how a person of ordinary skill in the art would understand the limitation “the computer programmed *to use*” a software package to require the software package to be stored on the computer programmed to use the software package.

Thus, we will not construe “computer programmed to use a voice recognition computer software package trained to the voice of the call assistant” as requiring the software package to be stored on the computer programmed to use the software.

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Yamamoto, correct? A. Yes. Q. And so to the extent that the claims of those patents require voice recognition software resident on a call assistant's workstation, the combinations involving Yamamoto would be missing this element, correct? A. With the citation to this paragraph only, yes. I think I would need to look at the remainder of Yamamoto to see if in fact there were other citations that were applicable . . .”).

IPR2013-00540 (Patent 6,233,314) IPR2013-00541 (Patent 5,909,482)  
IPR2013-00542 (Patent 7,319,740) IPR2013-00543 (Patent 7,555,104)  
IPR2013-00544 (Patent 8,213,578) IPR2013-00545 (Patent 6,594,346)  
IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
IPR2014-00780 (Patent 6,603,835)

IPR540, Paper 78, 9 (emphasis in original); *see* IPR541, Paper 76, 11–12 (similar conclusion in the context of the claim language of the ’482 patent).

Thus, because the broadest reasonable construction of the claims does not require storage of voice recognition software at the call assistant workstation, we do not agree with Patent Owner that Mr. Occhiogrosso’s conclusion in the IPRs that the claims were anticipated by Ryan and would have been obvious over Yamamoto (and other references) “necessarily requires him to have concluded that Ryan and Yamamoto did disclose this element,” requiring voice recognition software to be stored on the call assistant workstation. PO Br. 34–35 (citing IPR540, Ex. 1014 ¶¶ 28, 32, 44; IPR541, Ex. 1014 ¶¶ 28, 32, 44).

#### *4. Conclusion on Mr. Occhiogrosso’s Testimony Regarding Software Location*

For these reasons, we conclude that Mr. Occhiogrosso’s trial testimony concerning whether the claims require, and whether the prior art references Ryan and Yamamoto disclose, voice recognition software stored at the call assistant workstation does not conflict with his IPR testimony. Accordingly, there is no impact of these alleged inconsistencies concerning software location on the Final Written Decisions in IPR540 or IPR541. We find that Mr. Occhiogrosso’s testimony before us remains credible with regard to software location.

#### *D. Conclusion Regarding Mr. Occhiogrosso’s Testimony*

We have admitted and considered Mr. Occhiogrosso’s district court testimony. Upon consideration, as explained above, we have found that

IPR2013-00540 (Patent 6,233,314) IPR2013-00541 (Patent 5,909,482)  
IPR2013-00542 (Patent 7,319,740) IPR2013-00543 (Patent 7,555,104)  
IPR2013-00544 (Patent 8,213,578) IPR2013-00545 (Patent 6,594,346)  
IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
IPR2014-00780 (Patent 6,603,835)

Mr. Occhiogrosso’s district court testimony is consistent with his testimony offered in these proceedings. Accordingly, we determine that the admitted district court testimony has no effect on Mr. Occhiogrosso’s credibility as a whole across all the proceedings.

We also have found that the alleged inconsistencies have no impact on the Final Written Decisions in IPR540, IPR541, IPR542, IPR543, IPR544, IPR545, and IPR550, the specific cases alleged by Patent Owner to involve inconsistent testimony from Mr. Occhiogrosso. *See* PO Br. 22–25, 31–34, 42–44. Our reasons in support of those findings are set forth in the analysis above.

Two cases remain unaddressed: IPR549 and IPR780. These cases do not involve McLaughlin, Ryan, or Yamamoto. Patent Owner does not allege, nor do we see, how the allegedly inconsistent district court testimony is implicated in these cases, aside from its applicability to the general credibility of Mr. Occhiogrosso. To that point, however, we have found Mr. Occhiogrosso to be a credible witness based on our above review.

Furthermore, in IPR549, our reliance on Mr. Occhiogrosso is limited to supplementing our findings that are supported by other evidence of record. We cite to Mr. Occhiogrosso’s testimony as a backup to our citations to Liebermann itself, finding that “Liebermann discloses a device having one telephone line between the hearing user and the assisted user, without a relay interposing on that line.” IPR549, Paper 71, 17 (citing Liebermann as support for that finding, with Mr. Occhiogrosso’s testimony cited as a “*see also*” cite). We then discussed how we did not find Patent

IPR2013-00540 (Patent 6,233,314) IPR2013-00541 (Patent 5,909,482)  
IPR2013-00542 (Patent 7,319,740) IPR2013-00543 (Patent 7,555,104)  
IPR2013-00544 (Patent 8,213,578) IPR2013-00545 (Patent 6,594,346)  
IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
IPR2014-00780 (Patent 6,603,835)

Owner's arguments or the testimony of its declarant, Mr. Steel, persuasive because they were in contrast to the specific teachings of Liebermann. *Id.* at 18.<sup>16</sup> Only after discussing why Patent Owner's arguments and its declarant's testimony were not persuasive in view of Liebermann itself did we discuss Mr. Occhiogrosso's testimony. But there, we merely state that his testimony is consistent with Liebermann and that Mr. Steel's testimony was not consistent with Liebermann (which we had just discussed). Thus, we have found Mr. Occhiogrosso's testimony reliable and trustworthy, but even if we had not, it would not affect the outcome of IPR549.

Similarly, Patent Owner does not allege, nor do we see, how the allegedly inconsistent testimony in Exhibits 2031, 2032, and 2033 is implicated in IPR780, aside from its applicability to the general credibility of Mr. Occhiogrosso. To that point, however, we have found Mr. Occhiogrosso to be a credible witness based on our above review. In addition, as Petitioner correctly notes, in IPR780 Patent Owner had the opportunity as a matter of right to enter, and had the opportunity to cross-examine Mr. Occhiogrosso during routine discovery on, the testimony we now consider in Exhibits 2031, 2032, and 2033. Pet. Br. 6–7. Patent Owner declined to do so.

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<sup>16</sup> Patent Owner argued that Liebermann disclosed a “switch,” but we found “Liebermann does not use or imply those words.” *Id.* at 18. Then we discussed Patent Owner's arguments and Mr. Steel's testimony directed to the diagram in Figure 2 with further discussion of Liebermann. *Id.* Then we again addressed Patent Owner's “party call” argument with further citations to Liebermann regarding two cellular connections. *Id.*

IPR2013-00540 (Patent 6,233,314) IPR2013-00541 (Patent 5,909,482)  
IPR2013-00542 (Patent 7,319,740) IPR2013-00543 (Patent 7,555,104)  
IPR2013-00544 (Patent 8,213,578) IPR2013-00545 (Patent 6,594,346)  
IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
IPR2014-00780 (Patent 6,603,835)

Furthermore, our reliance on Mr. Occhiogrosso in IPR780 is limited to a single passage where we bolster our existing finding that the proposed combination would have been predictable (based on Mukherji), with further testimony from Mr. Occhiogrosso. IPR780, Paper 35, 36–37 (relying on Mukherji to respond to Patent Owner’s argument), 37 (relying on “the disclosure of Mukherji itself” as evidence, and then, “[i]n addition,” citing to Occhiogrosso). Accordingly, we have found Mr. Occhiogrosso’s testimony reliable and trustworthy, but even if we had not, it would not affect the outcome of IPR780.

### III. CONCLUSION

Upon remand, we were ordered to “admit and consider” the district court testimony of Mr. Occhiogrosso and “[i]f the Board finds he gave inconsistent testimony,” to “consider the impact on the specific patents at issue in the trial testimony *as well as* on his credibility as a whole.” *Ultratec*, 872 F.3d at 1275. As we have explained above, we do not find Mr. Occhiogrosso to have given inconsistent testimony, and we find him to remain a credible witness as a whole. We have thus discharged our duty on remand, and find that no changes to our prior decisions are warranted. Accordingly, our prior Final Written Decisions stand, in conjunction with this Decision on Remand, as our Final Written Decisions for these proceedings.

IPR2013-00540 (Patent 6,233,314) IPR2013-00541 (Patent 5,909,482)  
IPR2013-00542 (Patent 7,319,740) IPR2013-00543 (Patent 7,555,104)  
IPR2013-00544 (Patent 8,213,578) IPR2013-00545 (Patent 6,594,346)  
IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
IPR2014-00780 (Patent 6,603,835)

#### IV. ORDER

In view of the foregoing, it is hereby

ORDERED that our Final Written Decisions in IPR2013-00540, IPR2013-00541, IPR2013-00542, IPR2013-00543, IPR2013-00544, IPR2013-00545, IPR2013-00549, IPR2013-00550, and IPR2014-00780 are hereby modified to include this Decision, but are otherwise not modified upon remand; and

FURTHER ORDERED that this is a final written decision under 35 U.S.C. § 318(a) and parties to the proceeding seeking judicial review of this Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2013-00540 (Patent 6,233,314)	IPR2013-00541 (Patent 5,909,482)
IPR2013-00542 (Patent 7,319,740)	IPR2013-00543 (Patent 7,555,104)
IPR2013-00544 (Patent 8,213,578)	IPR2013-00545 (Patent 6,594,346)
IPR2013-00549 (Patent 6,603,835)	IPR2013-00550 (Patent 7,003,082)
IPR2014-00780 (Patent 6,603,835)	

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CAPTIONCALL, L.L.C.,  
Petitioner,

v.

ULTRATEC, INC.,  
Patent Owner.

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Cases IPR2013-00540 (Patent 6,233,314),  
IPR2013-00541 (Patent 5,909,482), IPR2013-00542 (Patent 7,319,740),  
IPR2013-00543 (Patent 7,555,104), IPR2013-00544 (Patent 8,213,578),  
IPR2013-00545 (Patent 6,594,346), IPR2013-00549 (Patent 6,603,835),  
IPR2013-00550 (Patent 7,003,082), IPR2014-00780 (Patent 6,603,835)<sup>1</sup>

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

PETTIGREW, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
*37 C.F.R. §§ 42.5*

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<sup>1</sup> This Order addresses issues that are the same in all identified cases. We exercise our discretion to issue one Order to be filed in each case.

IPR2013-00540 (Patent 6,233,314),  
IPR2013-00541 (Patent 5,909,482), IPR2013-00542 (Patent 7,319,740),  
IPR2013-00543 (Patent 7,555,104), IPR2013-00544 (Patent 8,213,578),  
IPR2013-00545 (Patent 6,594,346), IPR2013-00549 (Patent 6,603,835),  
IPR2013-00550 (Patent 7,003,082), IPR2014-00780 (Patent 6,603,835)

## INTRODUCTION

These proceedings are on remand from the United States Court of Appeals for the Federal Circuit. The court issued its decision vacating the Board’s final written decisions and remanding these cases to the Board on August 28, 2017. *Ultratec, Inc. v. CaptionCall LLC*, 872 F.3d 1267 (Fed. Cir. 2017). In its opinion, the Federal Circuit provided the following instructions regarding the remand of these proceedings: “On remand, the Board shall admit and consider Mr. Occhiogrosso’s trial testimony [from *Ultratec, Inc. v. Sorenson Communications, Inc.*, No. 13-CV-00346 (W.D. Wis.)]. If the Board finds he gave inconsistent testimony, the Board shall consider the impact on the specific patents at issue in the trial testimony *as well as* on his credibility as a whole.” *Ultratec*, 872 F.3d at 1275. The Federal Circuit mandates issued on October 19, 2017. Ex. 3003.<sup>2</sup>

After the parties notified the Board they were in the process of conferring regarding their respective proposals on the conduct of remand proceedings, we instructed the parties to send a joint e-mail to the Board identifying any agreed-upon proposals as well as points not agreed upon. We received such an e-mail on December 5, 2017. *See* Ex. 3004.

On December 13, 2017, we held a conference call to discuss the parties’ proposals regarding remand proceedings. Counsel for CaptionCall, L.L.C. (“Petitioner”), counsel for Ultratec, Inc. (“Patent Owner”), and

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<sup>2</sup> Exhibit 3003 in the record of each case is the mandate for the appeal from the final written decision in that proceeding.

IPR2013-00540 (Patent 6,233,314),  
IPR2013-00541 (Patent 5,909,482), IPR2013-00542 (Patent 7,319,740),  
IPR2013-00543 (Patent 7,555,104), IPR2013-00544 (Patent 8,213,578),  
IPR2013-00545 (Patent 6,594,346), IPR2013-00549 (Patent 6,603,835),  
IPR2013-00550 (Patent 7,003,082), IPR2014-00780 (Patent 6,603,835)

Judges Saindon, Benoit, and Pettigrew participated in the call. Patent Owner arranged for a court reporter to be on the call and submitted a transcript of the call on December 28, 2017. *See* IPR2013-00540, Ex. 2029.<sup>3</sup>

## DISCUSSION

The Board’s Standard Operating Procedure 9 provides guidance regarding the procedure for handling cases remanded from the Federal Circuit. *See* PTAB SOP 9 (“Procedure for Decisions Remanded from the Federal Circuit for Further Proceedings”). Under SOP 9, “the panel shall consider procedures proposed by the parties,” but “ultimately will decide the procedures to be followed on remand.” *Id.* at 5 (App’x 2). SOP 9 further provides that “[t]he panel will consider the scope of the remand, as determined from the reasoning and instructions provided by the Federal Circuit, as well as ‘the effect . . . on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings.’” *Id.* at 6 (App’x 2) (quoting 35 U.S.C. §§ 316(b), 326(b)). With regard to additional briefing, SOP 9 states that it “will normally be limited to the specific issues raised by the remand.” *Id.* (citing *Microsoft Corp. v. Proxyconn, Inc.*, Case No. IPR2012-00026 (Paper 77) (PTAB Sept. 1, 2015); *Dell Inc., v. Accelaron, LLC*, Case No. IPR2013-00440 (Paper 46) (PTAB May 26, 2016)). SOP 9 also

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<sup>3</sup> For convenience, we cite the exhibit entered in IPR2013-00540. Patent Owner also submitted the transcript from the call in the other eight proceedings.

IPR2013-00540 (Patent 6,233,314),  
IPR2013-00541 (Patent 5,909,482), IPR2013-00542 (Patent 7,319,740),  
IPR2013-00543 (Patent 7,555,104), IPR2013-00544 (Patent 8,213,578),  
IPR2013-00545 (Patent 6,594,346), IPR2013-00549 (Patent 6,603,835),  
IPR2013-00550 (Patent 7,003,082), IPR2014-00780 (Patent 6,603,835)

provides guidance regarding supplementation of the evidentiary record on remand. *Id.* at 6–7 (App’x 2).

With this guidance in mind, we have considered the parties’ proposals in determining the procedures to be followed on remand, as set forth below.

### *Scope of Remand and Briefing*

Petitioner submits that the remand from the Federal Circuit is narrow and is limited to consideration of Mr. Occhiogrosso’s district court trial testimony as directed by the Federal Circuit. Ex. 2029, 5:24–6:8; Ex. 3004, 1–2. In particular, Petitioner asserts that the Board should determine as a threshold issue whether Mr. Occhiogrosso gave inconsistent testimony, and then if, and only if, the Board determines he did, the Board should determine whether such inconsistent testimony impacts the patents at issue in these proceedings and Mr. Occhiogrosso’s credibility as a whole. Ex. 3004, 1–2. Petitioner proposes that briefing by the parties should address both issues. *Id.* at 2.

Patent Owner proposes that several topics should be briefed by the parties and considered by the Board on remand. First, Patent Owner requests briefing to identify and explain alleged inconsistencies in Mr. Occhiogrosso’s testimony as they span topically across the proceedings and to explain the impact of Mr. Occhiogrosso’s credibility on the outcome of the proceedings. Ex. 2029, 12:21–13:20; Ex. 3004, 2. Patent Owner’s proposal regarding Mr. Occhiogrosso’s testimony is similar to Petitioner’s proposal described above.

IPR2013-00540 (Patent 6,233,314),  
IPR2013-00541 (Patent 5,909,482), IPR2013-00542 (Patent 7,319,740),  
IPR2013-00543 (Patent 7,555,104), IPR2013-00544 (Patent 8,213,578),  
IPR2013-00545 (Patent 6,594,346), IPR2013-00549 (Patent 6,603,835),  
IPR2013-00550 (Patent 7,003,082), IPR2014-00780 (Patent 6,603,835)

Patent Owner also seeks to bring additional issues into the scope of the remanded proceedings. In light of the recent expiration of the subject patents, Patent Owner proposes that the parties have the opportunity to brief what claim constructions, if any, would change under the standard set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), and the impact of any revised constructions. Ex. 2026, 14:9–16:20; Ex. 3004, 2. Patent Owner further proposes that it be permitted to submit, along with accompanying trial testimony, documentary evidence related to secondary considerations that had been designated under the district court’s protective order but has been unsealed since briefing closed in the original *inter partes* review proceedings. Ex. 2029, 16:21–19:14, 20:13–15; Ex. 3004, 2. Patent Owner also requests briefing to explain the impact of such additional evidence on these proceedings. Ex. 3004, 2. Finally, Patent Owner seeks targeted additional discovery and briefing on the issue of whether Petitioner identified all the real parties-in-interest. Ex. 2029, 20:22–24:8; Ex. 3004, 2. Patent Owner proposes a first round of briefing to address all topics except identification of real parties-in-interest, which Patent Owner proposes to address in a second round of briefing overlapping with the first. Ex. 3004, 1.

Mindful of the Federal Circuit’s remand instructions as well as the Board’s SOP 9 governing remand procedures, at this time we authorize briefing directed only to whether Mr. Occhiogrosso’s district court trial testimony was inconsistent with his testimony in these *inter partes* review proceedings and the impact of any inconsistency. Specifically, we authorize Patent Owner to file a brief that (i) identifies with particularity portions of

IPR2013-00540 (Patent 6,233,314),  
IPR2013-00541 (Patent 5,909,482), IPR2013-00542 (Patent 7,319,740),  
IPR2013-00543 (Patent 7,555,104), IPR2013-00544 (Patent 8,213,578),  
IPR2013-00545 (Patent 6,594,346), IPR2013-00549 (Patent 6,603,835),  
IPR2013-00550 (Patent 7,003,082), IPR2014-00780 (Patent 6,603,835)

Mr. Occhiogrosso's district court trial testimony that Patent Owner alleges is inconsistent and explains how it is inconsistent with specific testimony provided by Mr. Occhiogrosso in these proceedings, and (ii) explains how the allegedly inconsistent testimony impacts specific unpatentability determinations in the Board's final written decisions in these proceedings as well as how it impacts Mr. Occhiogrosso's credibility as a whole. Patent Owner is to prepare a single brief addressing these issues with respect to all of the proceedings and submit that brief in each proceeding. The brief may cite to the record in any of the nine cases, making clear the proceeding in which any particular paper or exhibit was entered.<sup>4</sup> Patent Owner's brief is limited to 10,000 words and shall be filed no later than February 2, 2018.

Petitioner is authorized to file a single responsive brief addressing the same issues as Patent Owner's brief. Petitioner may cite additional portions of Mr. Occhiogrosso's trial testimony to counter Patent Owner's allegations of inconsistency. Like Patent Owner, Petitioner shall submit the same brief in each proceeding and may cite to the record in any of the nine cases. Petitioner's brief is limited to 10,000 words and shall be filed no later than March 5, 2018. Patent Owner is not authorized to file a reply brief.

At this time, the parties are not authorized to file briefs addressing any other issues. If we determine based on the parties' initial remand briefs that Mr. Occhiogrosso provided inconsistent testimony and that any

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<sup>4</sup>For example, a cite to "IPR2013-00540, Ex. 1001, 2-3" would be understood to cite to pages 2 through 3 of Exhibit 1001 in IPR2013-00540.

IPR2013-00540 (Patent 6,233,314),  
IPR2013-00541 (Patent 5,909,482), IPR2013-00542 (Patent 7,319,740),  
IPR2013-00543 (Patent 7,555,104), IPR2013-00544 (Patent 8,213,578),  
IPR2013-00545 (Patent 6,594,346), IPR2013-00549 (Patent 6,603,835),  
IPR2013-00550 (Patent 7,003,082), IPR2014-00780 (Patent 6,603,835)

inconsistency impacted in a material way our unpatentability determinations regarding the patents at issue or Mr. Occhiogrosso's credibility as a whole, we will consider at that time whether to authorize briefing directed to the additional issues identified by Patent Owner. Otherwise, in following the guidance of SOP 9, which directs us to limit briefing "to the specific issues raised by the remand," no supplemental briefing will be authorized.

We are aware that the *Phillips* standard of claim construction generally applies to patents that have expired. Patent Owner cites two cases in support of its position that it should have the opportunity at this juncture to address the effect of any claim constructions that might change under the *Phillips* standard. Ex. 2029, 14:17–15:12 (citing *In re CSB-System Int'l, Inc.*, 832 F.3d 1335, 1340–41 (Fed. Cir. 2016); *Facebook, Inc. v. Pragmatus AV, LLC*, 582 Fed. App'x 864, 869 (Fed. Cir. 2014)). In *CSB-System*, the Federal Circuit held that when a patent expires during an appeal from an examiner's final rejection in an ex parte reexamination, the Board must apply a *Phillips* claim construction. 832 F.3d at 1341. In *Facebook*, the Federal Circuit construed claim terms under *Phillips* when patents subject to *inter partes* reexamination expired during the pendency of the appeal of the Board's decisions to the Federal Circuit. 582 Fed. App'x at 868–69. These cases are not particularly on point because neither one involves an *inter partes* review proceeding or addresses whether the Board in a remand proceeding necessarily must reinterpret under a *Phillips* framework any previously construed claim terms when a patent expires during the pendency of the remand.

IPR2013-00540 (Patent 6,233,314),  
IPR2013-00541 (Patent 5,909,482), IPR2013-00542 (Patent 7,319,740),  
IPR2013-00543 (Patent 7,555,104), IPR2013-00544 (Patent 8,213,578),  
IPR2013-00545 (Patent 6,594,346), IPR2013-00549 (Patent 6,603,835),  
IPR2013-00550 (Patent 7,003,082), IPR2014-00780 (Patent 6,603,835)

Petitioner cites *Personal Web Technologies, LLC v. Apple, Inc.*, 848 F.3d 987 (Fed. Cir. 2017), in support of its position that we should not allow briefing on how claim terms would be construed under *Phillips*. See Ex. 2029, 26:18–27:14. In that case, a patent subject to *inter partes* review expired after the Board’s final written decision but while a rehearing request was pending before the Board. *Personal Web*, 848 F.3d at 990. On appeal to the Federal Circuit, the parties disputed whether the Board properly applied a broadest reasonable interpretation standard in construing claim terms at issue, with the Director of the Patent and Trademark Office arguing in support of the Board’s approach. *Id.* The court, however, determined that it need not resolve the dispute because the Board’s construction was correct under either standard. *Id.* Thus, although Petitioner contends that *Personal Web* presents a situation similar to the one here, the Federal Circuit ultimately did not address the issue.

Thus, the parties have not identified, and we are not aware of, any authority requiring us to reconsider on remand all of our earlier unpatentability determinations just because the patents have since expired. Through its reasoning and explicit instructions to consider Mr. Occhiogrosso’s trial testimony and the impact of any inconsistencies on the challenged patents and Mr. Occhiogrosso’s credibility, the Federal Circuit carefully delineated the scope of the remand in these proceedings. If we determine in the course of following the court’s remand instructions that inconsistencies in Mr. Occhiogrosso’s testimony require us to reevaluate the patentability of any claims, we will at that point consider Patent Owner’s



IPR2013-00540 (Patent 6,233,314),  
IPR2013-00541 (Patent 5,909,482), IPR2013-00542 (Patent 7,319,740),  
IPR2013-00543 (Patent 7,555,104), IPR2013-00544 (Patent 8,213,578),  
IPR2013-00545 (Patent 6,594,346), IPR2013-00549 (Patent 6,603,835),  
IPR2013-00550 (Patent 7,003,082), IPR2014-00780 (Patent 6,603,835)

requests for additional briefing on specific topics, including claim construction under the *Phillips* standard.

### *Supplementing the Evidentiary Record*

The Federal Circuit directed us to “admit and consider Mr. Occhiogrosso’s trial testimony” but did not specify whether all of Mr. Occhiogrosso’s district court trial testimony, or only portions of it, should be admitted. *Ultratec*, 872 F.3d at 1275. Petitioner proposes that Patent Owner be permitted to supplement the evidentiary record with the portions of Mr. Occhiogrosso’s district court trial testimony on cross-examination that Patent Owner alleges is inconsistent with his testimony in these *inter partes* reviews. Ex. 2029, 10:2–15; Ex. 3004, 4. Petitioner further proposes that Petitioner be permitted to supplement the record with additional trial testimony from Mr. Occhiogrosso as necessary to counter Patent Owner’s allegations of inconsistency. Ex. 2029, 10:16–25; Ex. 3004, 4. Patent Owner proposes that it be permitted to supplement the record with Mr. Occhiogrosso’s allegedly inconsistent testimony and additional testimony as needed for context, or all of Mr. Occhiogrosso’s trial testimony if the Board believes it would be helpful. Ex. 2029, 24:16–22.

Having considered the parties’ proposals and the Federal Circuit’s remand instructions, we are of the view that it would be beneficial to have all of Mr. Occhiogrosso’s trial testimony entered into the record of these proceedings. Accordingly, Patent Owner shall submit a transcript of all of Mr. Occhiogrosso’s district court trial testimony as an exhibit or exhibits in each of these proceedings, which both parties shall cite.

IPR2013-00540 (Patent 6,233,314),  
IPR2013-00541 (Patent 5,909,482), IPR2013-00542 (Patent 7,319,740),  
IPR2013-00543 (Patent 7,555,104), IPR2013-00544 (Patent 8,213,578),  
IPR2013-00545 (Patent 6,594,346), IPR2013-00549 (Patent 6,603,835),  
IPR2013-00550 (Patent 7,003,082), IPR2014-00780 (Patent 6,603,835)

The parties are not authorized to submit any other new evidence at this time. If later we authorize additional briefing as described above, we will consider at that time whether to authorize further supplementation of the record.

### ORDER

Accordingly, it is:

ORDERED that Patent Owner is authorized to file a brief that (i) identifies with particularity portions of Mr. Occhiogrosso's district court trial testimony that Patent Owner alleges is inconsistent and explains how it is inconsistent with specific testimony provided by Mr. Occhiogrosso in these proceedings, and (ii) explains how the allegedly inconsistent testimony impacts specific unpatentability determinations in the Board's final written decisions in these proceedings as well as how it impacts Mr. Occhiogrosso's credibility as a whole;

FURTHER ORDERED that Patent Owner's brief is limited to 10,000 words and shall be filed no later than February 2, 2018;

FURTHER ORDERED that Petitioner is authorized to file a responsive brief addressing the same issues;

FURTHER ORDERED that Petitioner's brief is limited to 10,000 words and shall be filed no later than March 5, 2018;

FURTHER ORDERED that Patent Owner, at its earliest convenience, but no later than February 2, 2018, shall submit as an exhibit or exhibits in each proceeding a transcript of all of Mr. Occhiogrosso's trial testimony in

IPR2013-00540 (Patent 6,233,314),  
IPR2013-00541 (Patent 5,909,482), IPR2013-00542 (Patent 7,319,740),  
IPR2013-00543 (Patent 7,555,104), IPR2013-00544 (Patent 8,213,578),  
IPR2013-00545 (Patent 6,594,346), IPR2013-00549 (Patent 6,603,835),  
IPR2013-00550 (Patent 7,003,082), IPR2014-00780 (Patent 6,603,835)

*Ultratec, Inc. v. Sorenson Communications, Inc.*, No. 13-CV-00346 (W.D. Wis.); and

FURTHER ORDERED that no other issues shall be briefed and no other new evidence shall be submitted at this time.

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Paper 66  
Entered: March 3, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CAPTIONCALL, L.L.C.,  
Petitioner,

v.

ULTRATEC, INC.,  
Patent Owner.

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Case IPR2013-00542  
Patent 7,319,740 B2

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

PETTIGREW, *Administrative Patent Judge*.

FINAL WRITTEN DECISION  
*35 U.S.C. § 318(a) and 37 C.F.R. § 42.73*

I. INTRODUCTION

We have jurisdiction to hear this *inter partes* review under 35 U.S.C. § 6(c). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed herein, Petitioner has shown by a preponderance of the evidence that claims 1 and 2 of U.S. Patent No. 7,319,740 B2 (Ex. 1001, “the ’740 patent”) are unpatentable.

IPR2013-00542  
Patent 7,319,740 B2

### A. *Procedural History*

Petitioner, CaptionCall, L.L.C., filed a Petition for *inter partes* review of claims 1 and 2 of the '740 patent. Paper 1 (“Pet.”). Patent Owner, Ultratec, Inc., did not file a Preliminary Response. On March 5, 2014, pursuant to 35 U.S.C. § 314, we instituted an *inter partes* review for claims 1 and 2 of the '740 patent on the ground of obviousness under 35 U.S.C. § 103(a) over McLaughlin and Ryan.<sup>1</sup> Paper 6 (“Inst. Dec.”).

Subsequent to institution, Patent Owner filed a Patent Owner Response (Paper 20, “PO Resp.”), and Petitioner filed a Reply to Patent Owner’s Response (Paper 33, “Reply”). Patent Owner also filed a Motion to Exclude Evidence. Paper 42 (“PO Mot. to Exc.”). Petitioner filed an Opposition (Paper 49, “Pet. Opp. to Mot. to Exc.”) to Patent Owner’s Motion, and Patent Owner filed a Reply to Petitioner’s Opposition (Paper 50, “PO Reply to Opp. to Mot. to Exc.”).

An oral hearing was held on November 19, 2014.<sup>2</sup>

### B. *Related Proceedings*

Petitioner represents that Patent Owner asserted the '740 patent against Petitioner’s parent company in the following district court proceeding: *Ultratec, Inc. v. Sorenson Communications, Inc.*, No. 13-CV-00346 (W.D. Wis.). Pet. 3. Petitioner also represents that in the same

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<sup>1</sup> U.S. Patent No. 6,181,736 B1, issued Jan. 30, 2001 (Ex. 1009, “McLaughlin”); U.S. Patent No. 5,809,112, issued Sept. 15, 1998 (Ex. 1004, “Ryan”).

<sup>2</sup> This proceeding and IPR2013-00540, IPR2013-00541, IPR2013-00543, IPR2013-00544, IPR2013-00545, IPR2013-00549, and IPR2013-00550 involve the same parties and similar issues. The oral arguments for all eight reviews were merged and conducted at the same time. A transcript of the oral hearing is included in the record as Paper 65.

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district court proceeding, Patent Owner asserted the following patents at issue in related *inter partes* reviews: U.S. Patent No. 6,233,314 (Case IPR2013-00540), U.S. Patent No. 5,909,482 (Case IPR2013-00541), U.S. Patent No. 7,555,104 (Case IPR2013-00543), U.S. Patent No. 8,213,578 (Case IPR2013-00544), U.S. Patent No. 6,594,346 (Case IPR2013-00545), U.S. Patent No. 6,603,835 (Case IPR2013-00549), and U.S. Patent No. 7,003,082 (Case IPR2013-00550). Pet. 3.

### *C. The '740 Patent*

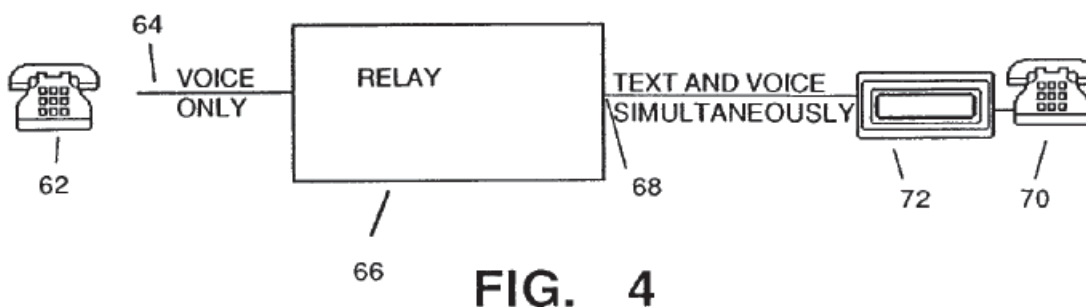
The '740 patent describes a system that assists deaf, hard of hearing, or otherwise hearing-impaired individuals in using telephones. Ex. 1001, 1:26–29. A conventional system uses a device that includes a keyboard, a display, and a specific type of modem, and is known as a telecommunication device for the deaf (TDD), a text telephone (TT), or a teletype (TTY). *Id.* at 1:37–43. When a hearing person who does not have access to a TDD wishes to communicate with a hearing-impaired person who uses a TDD, the parties may utilize a relay system, in which a human intermediary, known as a “call assistant,” communicates with the hearing user by voice and with the hearing-impaired user by using a TDD. *Id.* at 1:66–2:11. In a conventional relay system, the call assistant types, at a TDD keyboard, the words spoken by the hearing user and voices to the hearing user the words received on the TDD from the hearing-impaired user. *Id.* at 2:11–16.

The '740 patent relates to an improved system and method for providing a captioned telephone service using a relay. *Id.* at 2:40–56. Instead of typing the hearing user’s words, the call assistant re-voices those words into a microphone that transmits the voice of the call assistant to a computer with voice recognition software trained specifically to the voice of

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the call assistant. *Id.* at 6:18–37. Using the voice recognition software, the computer translates the words of the call assistant to digital text, which is sent to a display of the hearing-impaired user. *Id.* at 6:50–57.

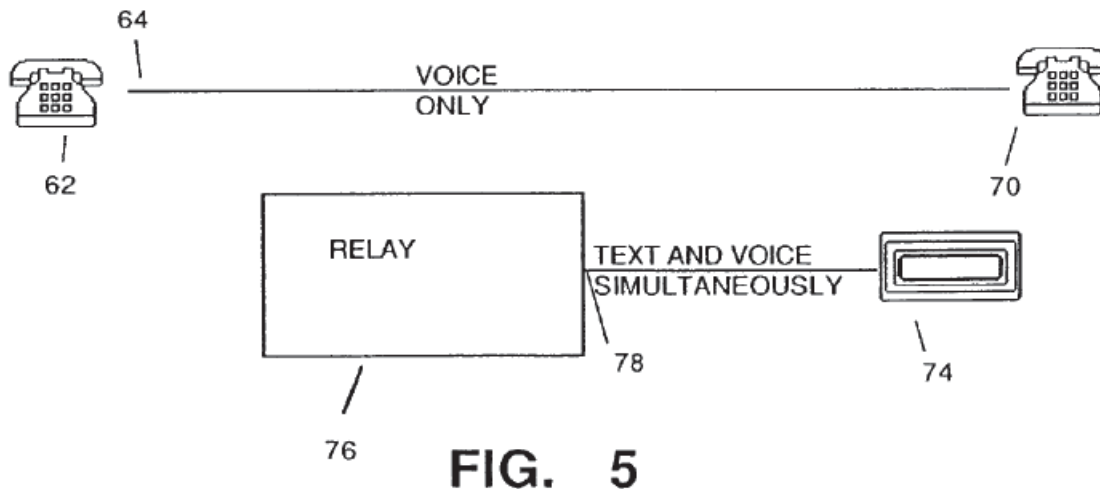
The '740 patent also describes a captioned telephone device at the site of the assisted user. *Id.* at 9:18–10:4. Figure 4, reproduced below, illustrates the setup of a telephone call involving captioned telephone device 72:



As shown in Figure 4, a hearing user at telephone 62 communicates with relay 66 through telephone line 64. *Id.* at 9:20–22. The relay communicates both the voice of the hearing user and a transcription of the text of the conversation through telephone line 68 to an assisted user. *Id.* at 9:22–23. At the assisted user's site are captioned telephone device 72, which includes a display for text, and conventional telephone 70. *Id.* at 9:23–27. The functions of captioned telephone device 72 and telephone 70 may be combined into a single device. *Id.* at 9:36–43.

Figure 5, reproduced below, illustrates an alternative, two-line embodiment described in the '740 patent:

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As shown in Figure 5, this embodiment utilizes voice-only telephone line 64 between telephone 62 of the hearing user and telephone 70 at the assisted user's location, and a separate connection—telephone line 78—carrying text and voice between relay 76 and captioned telephone device 74 at the assisted user's location. *Id.* at 9:44–54. The voice of the hearing user is received at telephone 70 and transferred to telephone line 78 for transmission to relay 76, which converts the spoken words to a text stream to be returned to the assisted user via telephone line 78. *Id.* at 9:54–57, 10:16–21.

#### *D. Claims*

Claims 1 and 2 are the only claims of the '740 patent and are both independent. Those claims read:

1. A system for providing captioned telephone service to an assisted user, the system comprising
  - a captioned telephone device at the site of the assisted user, the captioned telephone device capable of connection to an [I]nternet [P]rotocol connection to receive text and voice



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signals and capable of displaying the text for the assisted user;  
and

a relay for converting voice to text, the relay including a computer with voice recognition software and operated by a call assistant, the voice recognition software of the relay trained to the voice of the call assistant to create a text stream of the words spoken by a remote user, the text stream being sent by [I]nternet [P]rotocol to the captioned telephone.

2. A method of operating a captioned telephone service, the method comprising the steps of

arranging a telephone call between an assisted user and a remote user so that words spoken by the remote user are also transmitted to a relay;

at the relay, a call assistant listening to the words spoken by the remote user and re-voicing the words into a computer with voice recognition software trained to the voice of the call assistant to create a text stream of the words spoken by the remote user, the relay transmitting the text stream by [I]nternet [P]rotocol to the assisted user; and

the assisted user using a captioned telephone device that receives the text stream from the relay by [I]nternet [P]rotocol and displays the text on a visually readable display for the assisted user.

*Id.* at 12:22–51.

## II. ANALYSIS

### A. *Claim Construction*

In an *inter partes* review, we construe claim terms in an unexpired patent according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *see also In re Cuozzo Speed Techs., LLC*, No. 2014-1301, slip op. at 11–19 (Fed. Cir. Feb. 4, 2015). Consistent with the broadest reasonable construction, claim terms are presumed to have their ordinary and customary meaning, as

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understood by a person of ordinary skill in the art, in the context of the entire patent disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). An inventor may provide a meaning for a term that is different from its ordinary meaning by defining the term in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

We construe the claim language below in accordance with these principles. No other terms require express construction.

*1. “captioned telephone device”*

Claims 1 and 2 recite a “captioned telephone device.” Ex. 1001, 12:24, 12:48. The ordinary meaning of “telephone” is “[a]n instrument that converts voice and other sound signals into a form that can be transmitted to remote locations and that receives and reconverts waves into sound signals.”<sup>3</sup> In the context of voice communication, a “caption” is text that communicates dialogue.<sup>4</sup> Thus, according to its ordinary meaning, a captioned telephone device is a device that transmits and receives voice signals and displays text.

The ’740 patent uses the term “captioned telephone device” in a way that is consistent with this ordinary meaning. Independent claim 1 recites “a

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<sup>3</sup> THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 1846 (3d ed. 1992); THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 1779 (4th ed. 2006).

<sup>4</sup> THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 286 (3d ed. 1992) (defining “caption” in relevant part as “2. A subtitle in a motion picture.”); THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 278 (4th ed. 2006) (defining “caption” in relevant part as “2. A series of words . . . that communicate dialogue to the hearing-impaired or translate foreign dialogues.”).

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*captioned telephone device* at the site of the assisted user . . . capable of connection to an [I]nternet [P]rotocol connection to receive text and voice signals and capable of displaying the text for the assisted user.” *Id.* at 12:24–28 (emphasis added). Independent claim 2 recites “the assisted user using a *captioned telephone device* that receives the text stream from the relay by [I]nternet [P]rotocol and displays the text on a visually readable display for the assisted user.” *Id.* at 12:48–53 (emphasis added). The written description of the ’740 patent describes a captioned telephone device as a device that receives both voice signals and text information and displays the text information to an assisted user. *Id.* at 9:26–31 (“The captioned telephone device 72 is constructed to accomplish two objectives. One objective is to filter, or separate, the digital signals carrying the text information from the voice signal. The other objective is to take the digital signals and create a visual display of the text information for the assisted user.”); *see also id.* at Fig. 4 (showing a simultaneous text and voice connection between captioned telephone device 72 and relay 66). Note that a captioned telephone device need not output any audio signals to the assisted user. *See id.* at 9:36–38 (stating that a captioned telephone device may be a stand-alone device separate from a telephone at an assisted user’s location); *id.* at Figs. 4, 5 (illustrating captioned telephone device and telephone as two separate devices).

In light of the use of “captioned telephone device” in the ’740 patent and the ordinary meaning of the term, we construe “captioned telephone device” as a device that transmits and receives voice signals, receives text information, and displays text to an assisted user.

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2. “*trained to the voice of the call assistant*”

Neither party expressly proposes a construction for “trained to the voice of the call assistant,” which appears in both claims 1 and 2. *See* Pet. 5–6; PO Resp. 11–16; Reply 2. In their dispute over the teachings of the asserted prior art, however, the parties articulate different views as to how the term should be construed. Patent Owner construes “trained to the voice of the call assistant” to require training to recognize individual voices, PO Resp. 29, presumably trained to the voice of one, and only one, call assistant and to preclude training for a type of speech used by a group of people (such as a regional accent) that could apply to more than one call assistant. Patent Owner also seeks to construe “trained to the voice of the call assistant” as having a temporal constraint so as to preclude training at the time when the voice recognition computer software package is “designed in advance of implementation at the source code level.” *Id.* (emphasis omitted). According to Patent Owner, “trained to the voice of the call assistant” precludes software that is “built” to recognize the voice of a particular agent. *Id.* at 30. Petitioner disagrees. Reply 7–8.

The ’740 patent does not set forth a special definition for “training.” In the “Brief Summary of the Invention,” however, the ’740 patent refers to “a speech recognition computer program which has been trained to the voice *pattern* of the call assistant.” Ex. 1001, 2:45–47 (emphasis added). In the context of describing a relay, the written description explains that “the call assistant operates at a computer terminal which contains a copy of a voice recognition software package which is specifically trained to the voice of that *particular* call assistant.” *Id.* at 6:34–37 (emphasis added). Thus, the ’740 patent contemplates software trained to “a voice *pattern* of the call

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assistant” as well as software “specifically trained to the voice of [a] *particular* call assistant.” Neither description of training, however, indicates when or how the training occurs. Patent Owner, relying on its declarants Mr. James A. Steel, Jr. and Mr. Paul W. Ludwick, asserts that a person of ordinary skill in the art would not have understood software that is “designed” in advance to recognize the voice of particular agents to be software that is “trained to recognize individual voices,” because such technology was not used in telecommunications relay service in 1994. PO Resp. 29–30 (citing Ex. 2001 ¶¶ 30–31; Ex. 2003 ¶¶ 22–26). We note that technology available in 1994 has little probative value here because the earliest date of invention for claims of the ’740 patent is 2001.

We give claim language its broadest reasonable construction in light of the specification of the patent in which it appears. Thus, we will not limit “trained to the voice of the call assistant” to require training to the voice of one particular call assistant, because the claim language encompasses the invention as disclosed in the written description of the ’740 patent—software trained to a voice *pattern* of a call assistant. Ex. 1001, 2:45–47 (“Summary of the Invention”). Nor will we limit “trained to the voice of the call assistant” to a particular time at which training must occur or to a particular manner of training that is not found in the claims or the written description of the ’740 patent.

### *B. Principles of Law*

To prevail in challenging Patent Owner’s claims, Petitioner must demonstrate by a preponderance of the evidence that the claims are unpatentable. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). A claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the

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claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time of the invention to a person having ordinary skill in the art. *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). The level of ordinary skill in the art is reflected by the prior art of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995).

*C. Patent Owner's Motion to Exclude Testimony by Mr. Occhiogrosso*

Patent Owner seeks to exclude the testimony of Mr. Benedict Occhiogrosso (Exs. 1018, 1040, 2008, 2009, and 2014) on the theory that he is not qualified as an expert under Federal Rule of Evidence 702 (“FRE 702”).<sup>5,6</sup> PO Mot. to Exc.; PO Resp. 7–11. FRE 702 provides that a witness qualified as an expert by knowledge, skill, experience, training, or education may testify in the form of an opinion if (a) the expert's knowledge

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<sup>5</sup> Patent Owner also seeks to *exclude* Mr. Occhiogrosso's testimony under 37 C.F.R. § 42.65. PO Mot. to Exc. 1. Rule 42.65, however, addresses (a) the weight given to expert testimony that does not disclose underlying facts or data on which the opinion is based, (b) the showing required if a party seeks to rely on a technical test or data from such a test, and (c) the exclusion of expert testimony on United States patent law or patent examination practice. As such, Rule 42.65 does not apply to a determination whether to exclude Mr. Occhiogrosso's testimony.

<sup>6</sup> With some enumerated exceptions, the Federal Rules of Evidence apply to an *inter partes* review. 37 C.F.R. § 42.62.

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will help the trier of fact to understand the evidence or to determine a fact in issue, (b) the testimony is based upon sufficient facts or data, (c) the testimony is the product of reliable principles and methods, and (d) the witness has applied the principles and methods reliably to the facts of the case. Testimony on the issue of unpatentability proffered by a witness who is not “qualified in the pertinent art” generally is not admissible under FRE 702. *Sundance, Inc. v. DeMonte Fabricating Ltd.*, 550 F.3d 1356, 1363–64 (Fed. Cir. 2008). In determining who is qualified in the pertinent art under FRE 702, we need not find a complete overlap between the witness’s technical qualifications and the problem confronting the inventor or the field of endeavor. *See SEB S.A. v. Montgomery Ward & Co., Inc.*, 594 F.3d 1360, 1372–73 (Fed. Cir. 2010) (upholding admission of the testimony of an expert who admittedly lacked expertise in the design of the patented invention, but had experience with materials selected for use in the invention); *Mytee Prods., Inc. v. Harris Research, Inc.*, 439 Fed. App’x 882, 886–87 (Fed. Cir. 2011) (non-precedential) (upholding admission of the testimony of an expert who “had experience relevant to the field of the invention,” despite admission that he was not a person of ordinary skill in the art).

Patent Owner contends that, to qualify as an expert under FRE 702, Mr. Occhiogrosso must be a person of ordinary skill in the art, and that Mr. Occhiogrosso is not a person of ordinary skill in the art because he does not have “general knowledge and understanding of the telecommunications needs of the deaf and HOH [(hard of hearing)]” or “experience with the development of assistive telecommunications technology for such individuals.” PO Mot. to Exc. 1–4; *see also id.* at 5–7 (discussing

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Mr. Occhiogrosso’s experience with respect to these areas). Petitioner responds that Patent Owner’s definition of the level of ordinary skill in the art conflates a requirement for skill in the relevant technical art (“telecommunications systems [having] voice-to-text transcription”) with skill in one particular commercial sector that applies that technical art (“telecommunications services *specifically* designed for the deaf or hard of hearing”). Pet. Opp. to Mot. to Exc. 1–2.

Patent Owner’s arguments are unpersuasive at the outset because, to testify as an expert under FRE 702, a person need not be a person of ordinary skill in the art, but rather “qualified in the pertinent art.” *Sundance*, 550 F.3d at 1363–64; *see SEB*, 594 F.3d at 1372–73; *Mytee*, 439 Fed. App’x at 886–87. Patent Owner’s arguments are also unpersuasive because they attempt to constrict the “pertinent art,” i.e., the pertinent technology, to a particular subset of individuals who use the pertinent technology, rather than the pertinent technology itself. *See* Pet. Opp. to Mot. to Exc. 4–5 (arguing that the problems in the pertinent art are not “uniquely related” to the deaf and hard-of-hearing).

The technology at issue in the ’740 patent “relates to the general field of telephone communications.” Ex. 1001, 1:25–26. The ’740 patent focuses on a particular application of that technology: people who need assistance in using telecommunications devices. *Id.* at 1:25–2:36 (describing various prior art assistive technologies to help characterize the evolution of assistive technologies). The ’740 patent also summarizes the invention as the use of a speech recognition computer program trained to the voice of the call assistant to translate promptly the words spoken by an intermediary call assistant into a “high speed digital communication message [that] is then



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transmitted electronically promptly by telephone to a visual display accessible to the” hearing-assisted user. *Id.* at 2:46–52. Thus, we determine the pertinent art to be telecommunications systems, because any communications technology would be pertinent art to the ’740 patent. Although assistive technology may be more pertinent, and assistive technology for the deaf and hearing impaired, using voice-to-text relays, may be most pertinent, anything in the telecommunications technology field would be pertinent to the inventors when considering their problem.

The qualifications of Mr. Occhiogrosso, as summarized in his curriculum vitae (Ex. 1019), qualify him to give expert testimony on the subject of telecommunication technologies. He possesses a Bachelor of Science in Electrical Engineering and a Master of Science in Electrical Engineering. Ex. 1019, 2. Mr. Occhiogrosso testifies that he has more than thirty years of experience in the field of telecommunications and information technology, and he has planned, designed, implemented, and managed large scale projects involving wired and wireless communication systems, including transmission of voice and data. Ex. 1018 ¶ 7; *see also* Ex. 1019, 2–6 (detailing Mr. Occhiogrosso’s enterprise consulting engagements, research and development, and wireless experience).

Moreover, to the extent Mr. Occhiogrosso is more familiar with general telecommunications technology and less familiar with voice-to-text or its application to the deaf or hearing-impaired, or to the extent that Mr. Occhiogrosso’s testimony is inconsistent or unsupported, we weigh Mr. Occhiogrosso’s testimony accordingly, taking into account the extent of his expertise in these areas. *See, e.g., Yorkey v. Diab*, 601 F.3d 1279, 1284 (Fed. Cir. 2010) (holding the Board has discretion to give more weight to

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one item of evidence over another “unless no reasonable trier of fact could have done so”); *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.”).

Patent Owner also contends that Mr. Occhiogrosso’s testimony fails to identify the level of skill in the art in his declaration (Ex. 1018), fails to give any consideration to what one of ordinary skill in the art would have known or not known, is unsupported and unreliable, and does not consider secondary considerations. PO Mot. to Exc. 8; PO Resp. 9–10; PO Reply to Opp. to Mot. to Exc. 4. Petitioner counters that Mr. Occhiogrosso “consistently applied his definition of a [person of ordinary skill in the art] throughout his testimony” and, in a supplemental declaration, “made explicit the level of ordinary skill he applied” in his first declaration. Pet. Opp. to Mot. to Exc. 15.

Patent Owner’s argument goes more to the weight we should accord Mr. Occhiogrosso’s testimony, rather than its admissibility. It is within our discretion to assign the appropriate weight to the testimony offered by Mr. Occhiogrosso. *See, e.g., Yorkey*, 601 F.3d at 1284. Moreover, Mr. Occhiogrosso provided a supplemental declaration identifying the level of skill in the art and confirming his opinion presented in the earlier declaration in view of the level of skill in the art. *See* Ex. 1040 ¶¶ 12–17, 19. Mr. Occhiogrosso’s testimony also confirmed his legal understanding of obviousness, including secondary considerations. *See id.* ¶¶ 20–26.

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Under the totality of these circumstances, we decline to exclude the testimony of Mr. Occhiogrosso. Accordingly, Patent Owner's Motion to Exclude Mr. Occhiogrosso's testimony is *denied*.

*D. Asserted Ground of Obviousness over McLaughlin and Ryan*

Petitioner contends that claims 1 and 2 are unpatentable under 35 U.S.C. § 103(a) as obvious over McLaughlin and Ryan, relying on declaration testimony of Mr. Occhiogrosso. Pet. 26–39 (citing Ex. 1018). Patent Owner responds, relying on declaration testimony of Mr. Steel and Mr. Ludwick. PO Resp. 17–59 (citing Exs. 2001, 2003). Having considered the parties' contentions and supporting evidence, we determine that Petitioner has demonstrated by a preponderance of the evidence that claims 1 and 2 are unpatentable for obviousness over McLaughlin and Ryan.

*1. Summary of McLaughlin*

McLaughlin describes a simultaneous voice and data (SVD) modem used in connection with a relay service in which an operator mediates communications between a hearing person and a hearing-impaired person. Ex. 1009, 30:13–31:63. In one embodiment described in McLaughlin, the hearing-impaired user has an answering device or system, comprising two SVD modems, connected to two communication links, Line A and Line B. *Id.* at 30:59–63, 32:17–19. These communication links may use local area network (LAN), wide area network (WAN), or Internet communications over analog lines or digital lines, such as Integrated Services Digital Network (ISDN) or digital subscriber line (DSL) technology. *Id.* at 30:46–53. When a voice call from the hearing user arrives on Line A, the answering device sets up an SVD link with the relay service on Line B. *Id.* at 31:35–40. Voice sounds received from the hearing user on Line A are

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sent to the relay operator on Line B. *Id.* at 31:41–43. The relay operator translates the voice sounds into text, which is sent over Line B to appear on the screen of the hearing-impaired user’s answering device. *Id.* at 31:43–47. The hearing-impaired user also types responses back to the relay operator over Line B. *Id.* at 31:47–49. The relay operator voices the text, and the relay operator’s voice sounds are carried on Line B to the hearing-impaired user’s answering device and passed over to Line A to be heard by the hearing user. *Id.* at 31:49–52. Conversation among all three parties is “full duplex,” so that all parties may talk or type simultaneously. *Id.* at 31:55–62.

## 2. Summary of Ryan

Ryan describes a relay interface system for communication between a standard telephone set used by a hearing user and a TDD used by a hearing-impaired person. Ex. 1004, Abstract, 1:6–10. Figure 1 of Ryan is set forth below:

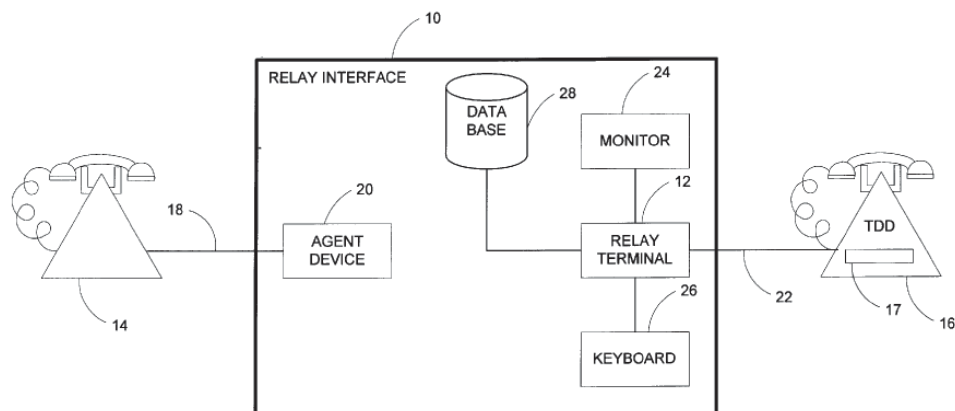


FIG. 1

As shown in Figure 1, Ryan’s relay interface 10 includes operator/relay terminal 12 and connects standard telephone set 14 with TDD 16 having associated display 17. *Id.* at 3:43–48. Telecommunications link 18 connects telephone 14 with relay interface 10 through agent

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device 20, and telecommunications link 22 connects TDD 16 with relay interface 10 through relay terminal 12. *Id.* at 3:48–52. An operator or relay agent typically is responsible for manipulating relay terminal 12 using keyboard 26 to relay messages between telephone 14 and TDD 16.

*Id.* at 4:19–21. Ryan indicates, however, that speech recognition software could be used to automate the relay function so that an operator or relay agent would not be required. *Id.* at 4:21–24. Ryan specifically describes using speech recognition software at agent device 20 to interpret a voice message from a caller at telephone 14 and convert the message from a voice format to a data format. *Id.* at 4:24–27. Ryan further indicates:

If the software is specifically designed to recognize the voice of particular relay agents, the accuracy of the relay service may be improved by having one of these agents listen to the caller and repeat the voice message into a terminal adapted to convert the agent’s voice message into a data message.

*Id.* at 4:33–38.

### 3. Claims 1 and 2

Claim 1 is a system claim reciting (i) a captioned telephone device at the site of an assisted user, and (ii) a relay with voice recognition software trained to the voice of a call assistant and operated by a call assistant to create a text stream of the words spoken by a remote user, the text stream being sent by Internet Protocol (IP) to the captioned telephone device.

Claim 2 is a method claim reciting the steps of (i) arranging a telephone call between an assisted user and a remote user so that words spoken by the remote user are also transmitted to a relay, (ii) a call assistant at a relay re-voicing the remote user’s words into voice recognition software trained to the voice of the call assistant to create a text stream and transmitting the text

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stream by IP to the assisted user, and (iii) the assisted user using a captioned telephone device that receives and displays the text stream.

Petitioner asserts that McLaughlin teaches the captioned telephone device and “arranging a telephone call” limitations with its description of an assisted user’s answering device that receives voice sounds from a hearing user on Line A, transmits those sounds to the relay operator on Line B, and receives text from the relay operator on Line B. Pet. 29–31, 34–36, 38–39 (citing Ex. 1009, 31:41–62, 32:41–52). Petitioner also asserts that McLaughlin teaches the use of IP for transmitting text. Pet. 33, 37–38 (citing Ex. 1009, 1:31–36, 30:46–53).

For the relay and re-voicing limitations, Petitioner relies on Ryan’s relay interface system in which a relay agent is responsible for relaying messages between phone 14 and TDD 16. Pet. 32, 36–37 (citing Ex. 1004, 4:19–38). Specifically, Petitioner relies on Ryan’s description of “speech recognition software . . . employed at [relay agent] device 20 [and] specifically designed to recognize the voice of particular relay agents” and Ryan’s indication that “the accuracy of the relay service may be improved by having one of these agents listen to the caller and repeat the voice message into a terminal adapted to convert the agent's voice message into a data message.” Pet. 32 (citing Ex. 1004, 4:19–38).

We find that Petitioner has shown by a preponderance of the evidence that the combination of McLaughlin and Ryan teaches all the claim limitations and has articulated sufficient reasoning for combining the references. For the reasons explained below, we are not persuaded by Patent Owner’s arguments to the contrary. *See* PO Resp. 19–57.

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*a. “captioned telephone device”*

Patent Owner argues that McLaughlin does not teach a captioned telephone device because (i) McLaughlin’s answering device does not play audio of the remote user’s voice to the assisted user, and (ii) McLaughlin does not teach a device located at an assisted user’s station that performs all the functions of a captioned telephone device. PO Resp. 19–24. We find Patent Owner’s arguments unpersuasive. First, the claim language does not require providing audio of the remote user’s voice to the assisted user. Claim 1, for example, only requires the captioned telephone device to *receive* voice signals. Similarly, our construction of “captioned telephone device” only requires a device that receives and transmits voice signals, not one that makes the received voice signals audible to the assisted user. *See supra* II.A.1. Second, McLaughlin teaches an answering device that receives voice on Line A and transmits voice and receives text on line B using SVD modems, and also includes a screen for displaying text to a hearing-impaired user, thereby meeting the requirements of a captioned telephone device as we have construed the term. Ex. 1009, 30:46–48, 30:59–63, 31:41–47; 32:41–52. On this point, based on our review of McLaughlin, we credit the testimony of Petitioner’s declarant, Mr. Occhiogrosso, over that of Patent Owner’s declarant, Mr. Steel. *See* Ex. 1018 ¶¶ 28–31; Ex. 2001 ¶¶ 48–50.

*b. “voice recognition software trained to the voice of the call assistant”*

Patent Owner contends that Ryan does not disclose a relay with “voice recognition software *trained* to the voice of the call assistant” because Ryan’s software is “designed” to recognize the voice of particular

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relay agents. PO Resp. 29–31. According to Patent Owner, software *designed* in advance of implementation at the source code level is not the same as *trained* software. *Id.* at 29. As discussed previously, *see supra* II.A.2, we do not agree with Patent Owner that trained voice recognition software, as recited in the claims, precludes software that is trained during the design phase, which Patent Owner contends is disclosed by Ryan. *See* PO Resp. 30. Thus, we are not persuaded by Patent Owner’s argument, which is premised on an incorrect claim construction. Moreover, Patent Owner relies on testimony from Mr. Steel and Mr. Ludwick, which we do not find persuasive because it is grounded in the state of the art in 1994, *see id.* (citing Ex. 2001 ¶ 31; Ex. 2003 ¶¶ 22–26), rather than at the time of invention of the ’740 patent, which is no earlier than 2001, the filing date of related U.S. Patent No. 6,594,346.<sup>7</sup> *See* Pet. 9; Reply 2.

Next, relying on Mr. Ludwick’s testimony, Patent Owner contends that Ryan does not disclose the recited “voice recognition software trained to the voice of the call assistant,” because Ryan’s “voice recognition software is written specifically to recognize the voices of a collection or group of people, rather than a particular, individual call assistant.” PO Resp. 31 (citing Ex. 2003 ¶ 19). For the reasons discussed previously, we do not agree that the claim language is limited to voice recognition software trained to one, and only one, call assistant. *See supra* II.A.2. Thus, even if Ryan’s software is trained to recognize the voices of a group of people rather than an individual call assistant, we are not persuaded by Patent Owner’s argument, which is premised on an incorrect claim construction.

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<sup>7</sup> The ’346 patent is the subject of related IPR2013-00545.



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Patent Owner also contends that, at most, Ryan is ambiguous as to the disclosure of a call assistant re-voicing the words spoken by the remote user into a computer to create a text stream of those words. PO Resp. 32–40. In particular, Patent Owner contends that Ryan discloses a relay agent using re-voicing as an error correction mechanism for individual, unrecognized letters of a word. *Id.* at 34–40; *see* Ex. 1004, Abstract. We do not read Ryan’s disclosure so narrowly. *See* Ex. 1004, 4:19–38.

Ryan’s technology is intended to “overcome[] the problem associated with existing telecommunications relay services by providing a system and method for correcting mistakes before the message is displayed at the end user’s TDD.” *Id.* at 2:35–38 (Summary of the Invention). Ryan describes ways to do so using speech recognition software. *Id.* at 4:19–38. One way is automating the relay function so as to eliminate the need for a human operator. *Id.* at 4:19–24. Ryan describes using speech recognition software to convert the voice message from a caller to text “while providing an error correction feature for words not recognized by the software.” *Id.* at 4:24–28. Ryan further describes the error correction feature as having two forms—phonetic spelling of the unrecognized word by the speech recognition software or prompting the caller to spell the unrecognized word. *Id.* at 4:29–33.

Ryan describes another way to improve the accuracy of a relay system before the text is displayed at the TDD—if the speech recognition software is designed specifically to recognize the voice of particular relay agents, a relay agent “listen[s] to the caller and repeat[s] the voice message into a terminal adapted to convert the agent’s voice message into a data message.” *Id.* at 4:33–38. In contrast to Ryan’s description of the error correction by

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the *caller* spelling letters of an unrecognized word, here Ryan unambiguously describes a call agent repeating the voice message of the caller and using speech recognition software designed specifically to recognize the voice of the relay agent to convert the agent's voice message into a data message.

Finally, we are not persuaded by Patent Owner's argument that Ryan must be read narrowly in view of the state of the telecommunications relay art in 1994, the effective filing date of Ryan. *See* PO Resp. 40–43. A proper obviousness analysis considers the prior art from the perspective of a person having ordinary skill in the art at the time of the invention, which in this case is no earlier than 2001. *See* 35 U.S.C. § 103(a); Pet. 9; Reply 2. As Petitioner indicates, a person of ordinary skill in the art in 2001 would have had in his possession related U.S. Patent No. 5,909,482 (“the ’482 patent”), filed in 1997.<sup>8</sup> Reply 10. The ’482 patent expressly discloses the use of a commercial software package, Dragon Naturally Speaking, for re-voicing a remote user's voice into voice recognition software trained to the voice of a call assistant. Ex. 1002, 5:50–57; *see* Reply 10. With this background, a person of ordinary skill in the art in 2001 would have viewed Ryan as teaching voice recognition software trained to the voice of the call assistant.

*c. “arranging a telephone call between an assisted user  
and a remote user”*

Patent Owner contends that McLaughlin does not teach this limitation of claim 2 because McLaughlin discloses a relay that interrupts the communication path from a hearing user to a deaf user, so there is no call

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<sup>8</sup> The ’482 patent is the subject of related IPR2013-00541.

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between an assisted user and a remote user. PO Resp. 44. According to Patent Owner, Petitioner and its declarant, Mr. Occhiogrosso, have misinterpreted the disclosure of McLaughlin. *Id.* As indicated with respect to the “captioned telephone device” limitation, based on our review of McLaughlin, we credit the testimony of Mr. Occhiogrosso over that of Patent Owner’s declarant, Mr. Steel, as to the teachings of McLaughlin. *See* Ex. 1018 ¶¶ 28–31; Ex. 2001 ¶¶ 48–50; Ex. 1040 ¶¶ 38–39. Specifically, we find that McLaughlin teaches a voice call from a remote user arriving on Line A at an assisted user’s answering device, which then sends the remote user’s voice to the relay on Line B. *See* Ex. 1009, 30:31:41–47; Ex. 1018 ¶ 28; Ex. 1040 ¶ 39. Thus, McLaughlin teaches “arranging a telephone call between an assisted user and a remote user,” as recited in claim 2.

*d. Reasons to Combine McLaughlin and Ryan*

Petitioner also has articulated sufficient reasoning with some rational underpinning to support the legal conclusion that the subject matter of the claims would have been obvious to one of ordinary skill in the art in view of the teachings of McLaughlin and Ryan as combined in the manner proposed by Petitioner. *See KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)); Pet. 26–27 (citing Ex. 1018 ¶¶ 36–37); Reply 11–13 (citing Ex. 1040 ¶¶ 53–55). McLaughlin teaches a captioned telephone device configured to connect to a relay. McLaughlin, however, does not teach re-voicing the remote user’s words at the relay using voice recognition software trained to the voice of the call assistant, as recited in the claims. Instead, McLaughlin describes a relay service with a call assistant, but also indicates that a relay may use automated equipment. Ex. 1009, 29:20–22.

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Ryan teaches using speech recognition software to automate the relay function, but further teaches that the accuracy of the relay may be improved if a call assistant re-voices the remote user's words into voice recognition software designed to recognize the call assistant's voice. Ex. 1004, 4:33–38. We are persuaded that a person of ordinary skill in the art would have looked to Ryan for ways to automate the relay function in McLaughlin's system and would have recognized that Ryan's intermediate re-voicing solution—using voice recognition software trained to the call assistant's voice—would perform better than speaker-independent voice recognition applied directly to the remote user's voice. *See* Pet. 27; Ex. 1018 ¶ 36.

Patent Owner contends that one of ordinary skill in the art would not have wanted to use McLaughlin's "specialized equipment" in a traditional relay like that taught by Ryan because such an arrangement would require an expensive overhaul of Ryan's system. PO Resp. 51. An obviousness determination, however, does not require an actual, physical substitution of elements, but instead focuses on what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). As discussed, we are persuaded that a person of ordinary skill in the art would have combined the teachings of McLaughlin and Ryan in the manner proposed by Petitioner.

Patent Owner also argues that McLaughlin teaches away from the use of trained voice recognition software. PO Resp. 55–57. In particular, Patent Owner submits that McLaughlin explains the shortcomings of automated speech recognition technology. *Id.* (citing Ex. 1009, 26:54–62). McLaughlin's statement, however, involves the application of speech

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recognition to voice messages left by callers, not voice recognition software trained to the voice of a call assistant, i.e., speaker-dependent voice recognition. McLaughlin, therefore, does not criticize, discredit, or discourage the combination of Ryan's re-voicing technique with McLaughlin's system. *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

#### 4. Secondary Considerations

Factual inquiries for an obviousness determination include secondary considerations based on evaluation and crediting of objective evidence of nonobviousness. *Graham*, 383 U.S. at 17–18. Notwithstanding what the teachings of the prior art would have suggested to one with ordinary skill in the art at the time of the invention, the totality of the evidence submitted, including objective evidence of nonobviousness, may lead to a conclusion that the challenged claims would not have been obvious to one with ordinary skill in the art. *In re Piasecki*, 745 F.2d 1468, 1471–72 (Fed. Cir. 1984). Secondary considerations may include any of the following: long-felt but unsolved need, failure of others, unexpected results, commercial success, copying, licensing, and praise. *See Graham*, 383 U.S. at 17; *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007).

To be relevant, evidence of nonobviousness must be commensurate in scope with the claimed invention. *In re Kao*, 639 F.3d 1057, 1068 (Fed. Cir. 2011). Thus, to be accorded substantial weight, there must be a nexus between the merits of the claimed invention and the evidence of secondary considerations. *GPAC*, 57 F.3d at 1580. “Nexus” is a legally and factually sufficient connection between the objective evidence and the claimed invention, such that the objective evidence should be considered in

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determining nonobviousness. *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988). The burden of showing that there is a nexus lies with the Patent Owner. *Id.*; *Paulsen*, 30 F.3d at 1482.

Patent Owner alleges “substantial praise for the inventions claimed in [Patent Owner’s] patents, including the ’740 Patent, the long-felt but unresolved need of the deaf and hard of hearing community, the commercial success of the products and services embodying the invention, and the failure of others to provide a relay service or other solution that provided the benefits of the claimed inventions.” PO Resp. 58. For support, Patent Owner proffers declarations by Ms. Brenda Battat (Ex. 2006) and Ms. Constance Phelps (Ex. 2007) describing general innovations of Patent Owner’s CapTel Service and its CapTel phone and their benefits to the deaf and hard of hearing community. PO Resp. 58–59. In an attempt to establish the requisite nexus, Patent Owner relies on a declaration of Mr. Ludwick (Ex. 2004) asserting that his expert declaration “explain[s], on a feature by feature basis, the nexus between those secondary considerations and the claimed design” and “illustrates, in chart form, that the CapTel system and various models of CapTel phones embody the claims of the present invention.” PO Resp. 58–59.

Patent Owner’s Response contains no substantive arguments. *Id.* Instead, Patent Owner merely lists various common forms of secondary considerations evidence, without exposition. This does not provide sufficient analysis for us to determine whether Patent Owner has provided adequate evidence of secondary considerations and a nexus between any such evidence and the merits of the claimed invention. Thus, Patent

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Owner's broad contentions regarding secondary considerations in its Patent Owner Response do not demonstrate nonobviousness.

Moreover, Patent Owner's declarations fail to establish a nexus between the merits of the claimed invention and the evidence of secondary considerations. To show a nexus, Patent Owner relies on Mr. Ludwick's declaration, which describes his visit to CapTel, Inc.'s relay center in Madison, Wisconsin. Ex. 2004 ¶ 54. Mr. Ludwick's chart presents his conclusions based on personal observation that the CapTel Service meets each claim limitation of the '740 patent. Ex. 2004 ¶ 55 (pp. 44–47). For example, regarding “a relay for converting voice to text, the relay including a computer with voice recognition software and operated by a call assistant, the voice recognition software of the relay trained to the voice of the call assistant to create a text stream of the words spoken by a remote user, the text stream being sent by [I]nternet [P]rotocol to the captioned telephone,” recited in claim 1, Mr. Ludwick asserts:

I personally observed that the CapTel Service meets this claim element. I inspected a CapTel relay call center and saw that call assistants use voice recognition software and send resulting text via IP connections to CapTel phones. I further confirmed that the voice recognition software is trained to the voice of the call assistants based on discussions with CapTel and my own knowledge of CapTel Service. This feature of the CapTel Service relay is present when the Service is used with each of the CapTel Phones and has always been included as part of the CapTel Service.

Ex. 2004 ¶ 55 (p. 45).

Because Mr. Ludwick's conclusions are based on personal observations, without sufficient supporting facts or data, his testimony has little probative value. *See Am. Acad. of Sci.*, 367 F.3d at 1368 (“[T]he Board

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is entitled to weigh the declarations and conclude that the lack of factual corroboration warrants discounting the opinions expressed in the declarations.”); *see also* Fed. R. Evid. 702 (providing one may testify in the form of an opinion if the testimony is based on sufficient facts or data). As such, Mr. Ludwick’s conclusory assertions do not provide a sufficient connection between objective evidence and the claimed invention, and so do not establish the requisite nexus between the merits of the claimed invention and the evidence of secondary considerations.

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

### III. CONCLUSION

Based on the evidence and arguments, Petitioner has demonstrated by a preponderance of the evidence that claims 1 and 2 of the ’740 patent are unpatentable under 35 U.S.C. § 103(a) for obviousness over McLaughlin and Ryan.



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#### IV. ORDER

Accordingly, it is:

ORDERED that claims 1 and 2 of U.S. Patent No. 7,319,740 B2 are unpatentable; and

FURTHER ORDERED that Patent Owner's Motion to Exclude Mr. Occhiogrosso's testimony is *denied*.

This is a final decision. Parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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Paper 68  
Entered: December 1, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CAPTIONCALL, L.L.C.,  
Petitioner,

v.

ULTRATEC, INC.,  
Patent Owner.

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Case IPR2013-00542  
Patent 7,319,740 B2

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

PETTIGREW, *Administrative Patent Judge*.

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

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## I. INTRODUCTION

Petitioner, CaptionCall, L.L.C., filed a Petition requesting an *inter partes* review of claims 1 and 2 of U.S. Patent No. 7,319,740 B2 (Ex. 1001, “the ’740 patent”). Paper 1 (“Pet.”). We instituted an *inter partes* review for claims 1 and 2. Paper 6. In our Final Written Decision, we determined that Petitioner had shown, by a preponderance of the evidence, that claims 1 and 2 were unpatentable. Paper 66 (“Final Dec.” or “Final Decision”). Patent Owner, Ultratec, Inc., requests a rehearing of the Final Decision by an expanded panel. Paper 67 (“Req.” or “Request”). Having considered Patent Owner’s Request, we grant the Request for Rehearing for the limited purpose of modifying our analysis regarding the rationale for combining the Ryan and McLaughlin references. We deny the Request for Rehearing in all other respects.

## II. DISCUSSION

The party challenging a decision in a request for rehearing bears the burden of showing the decision should be modified. 37 C.F.R. § 42.71(d). A request for rehearing “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed.” *Id.*

### A. *Combination of McLaughlin and Ryan*

In its Request for Rehearing, Patent Owner contends we misapprehended the law regarding motivation to combine references in our discussion of obviousness of claims 1 and 2 of the ’740 patent based on

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McLaughlin<sup>1</sup> and Ryan.<sup>2</sup> Req. 1–3. Patent Owner also contends we misapprehended the law regarding “teaching away” and overlooked arguments why a person of ordinary skill in the art would not have considered McLaughlin. *Id.* at 3–8. Although we disagree that we misapprehended the law or overlooked arguments, we grant Patent Owner’s request for the purpose of modifying our analysis (Final Dec. 24–26) as described below. As in our Final Decision, we conclude that Petitioner has articulated sufficient reasoning with some rational underpinning to support the legal conclusion that the subject matter of the claims would have been obvious to one of ordinary skill in the art in view of the teachings of McLaughlin and Ryan. *See KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007); Pet. 26–27; Reply 11–13; Ex. 1018 ¶¶ 36–37; Ex. 1040 ¶¶ 54–56. The remainder of this section replaces Section II.D.3.d at pages 24–26 of the Final Decision.

McLaughlin teaches a captioned telephone device configured to connect to a relay. McLaughlin, however, does not teach re-voicing the remote user’s words at the relay using voice recognition software trained to the voice of the call assistant, as recited in the claims. Instead, McLaughlin describes a relay service in which a call assistant or automated equipment mediates telephone calls between a speaking person and a deaf person. Ex. 1009, 29:20–22. McLaughlin also identifies computerized speech recognition as one type of automated equipment for translating voice to text, although McLaughlin acknowledges the limitations of speech recognition

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<sup>1</sup> U.S. Patent No. 6,181,736 B1, issued Jan. 30, 2001 (Ex. 1009).

<sup>2</sup> U.S. Patent No. 5,809,112, issued Sept. 15, 1998 (Ex. 1004).

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software in recognizing certain kinds of speech, including conversational speech. *Id.* at 26:59–62.

Ryan teaches using speech recognition software to automate the relay function. Ex. 1004, 4:19–28. According to Mr. Occhiogrosso, whose testimony we credit on this point, it was well known in the field of speech recognition at the time of the invention that speaker-dependent speech recognition (e.g., trained to the voice of a particular speaker) performed better than untrained, speaker-independent speech recognition. Ex. 1018 ¶¶ 22, 36; Ex. 1040 ¶ 56. This is reflected in Ryan’s teaching that the accuracy of a relay that uses speech recognition software may be improved if a call assistant re-voices the remote user’s words into a terminal with voice recognition software designed to recognize the call assistant’s voice. Ex. 1004, 4:33–38.

Thus, McLaughlin teaches the use of automated equipment at a relay, Ex. 1009, 29:20–22, and Ryan teaches a computer with speech recognition software as one form of automated equipment that can be used at a relay, Ex. 1004, 4:33–38. McLaughlin also notes the use of computerized speech recognition in another context, i.e., translation of voice mail messages from voice to text. Ex. 1009, 26:59–62. A person of ordinary skill in the art would have recognized that Ryan’s intermediate re-voicing solution—using voice recognition software trained to the voice of a call assistant at a relay—would address the shortcomings of applying voice recognition directly to a remote caller’s voice, acknowledged by McLaughlin. *See* Pet. 26–27; Ex. 1018 ¶ 36; Ex. 1040 ¶ 62. As Mr. Occhiogrosso explains, combining the teachings of McLaughlin and Ryan to achieve the claimed invention involves nothing more than directing the captioned telephone device of

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McLaughlin to connect to a re-voicing relay, as taught in Ryan, rather than a conventional relay. Ex. 1040 ¶ 55; *see* Reply 11. For these reasons, we are persuaded that a person of ordinary skill in the art would have combined the teachings of McLaughlin and Ryan, using Ryan’s re-voicing relay in place of McLaughlin’s relay, along with McLaughlin’s captioned telephone device.

Patent Owner contends that one of ordinary skill in the art would not have considered McLaughlin because not all relay services and users had simultaneous voice and data (SVD) modems like those used in McLaughlin’s system. Paper 20, 46 (“PO Resp.”). Patent Owner also contends that one of ordinary skill in the art would not have wanted to use McLaughlin’s “specialized equipment” in a relay like that taught by Ryan because such an arrangement would require an expensive overhaul of Ryan’s system. *Id.* at 51. An obviousness determination, however, does not require an actual, physical substitution of elements, but instead focuses on what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). As discussed, we are persuaded that a person of ordinary skill in the art would have combined the *teachings* of McLaughlin and Ryan in the manner proposed by Petitioner.

Patent Owner argues further that one of ordinary skill in the art would not have considered McLaughlin because it is directed to an internal company telephone system rather than the functionality of a relay service. PO Resp. 47. Patent Owner, however, has not cited persuasive evidence that McLaughlin’s teachings are limited to an intra-company system. *See id.* In

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addition, Patent Owner argues that McLaughlin discloses connecting to a traditional, text-only TDD<sup>3</sup>-based relay, and any increased speed offered by adding re-voicing and voice recognition would not have met an important design incentive for true TDD-based relay. *Id.* Patent Owner, however, does not identify specifically what “design incentive” would not be met, asserting only that deaf users are not concerned with the speed of captions. *Id.* We are not persuaded this is a reason a person of ordinary skill in the art would not have considered McLaughlin when developing the relay system of the ’740 patent.

Finally, Patent Owner argues that McLaughlin teaches away from the use of trained voice recognition software. *Id.* at 55–57. In particular, Patent Owner submits that McLaughlin acknowledges the shortcomings of automated speech recognition technology and, therefore, would have discouraged one of ordinary skill in the art from attempting to design the relay claimed in the ’740 patent. *Id.* at 55 (citing Ex. 1009, 26:54–62). McLaughlin, however, refers to the limitations of speech recognition in the context of translating voice mail messages to text for deaf users, not in connection with relay services discussed in another section of McLaughlin. *See* Ex. 1009, 26:54–62. Moreover, as discussed previously, we credit the testimony of Mr. Occhiogrosso that it was well known in the field of speech recognition at the time of the invention that speaker-dependent speech recognition (e.g., trained to the voice of a particular speaker), such as that used in Ryan’s re-voicing technique, performed better than untrained, speaker-independent speech recognition, such as would be used in the voice mail application described in McLaughlin. *See* Ex. 1018 ¶¶ 22, 36; Ex. 1040

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<sup>3</sup> “TDD” stands for “telecommunication device for the deaf.” Final Dec. 3.



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¶ 56. On the facts presented here, we are not persuaded that McLaughlin’s statement regarding limitations of speech recognition technology sufficiently teaches away from the combination of Ryan’s re-voicing scheme with McLaughlin’s relay system to establish nonobviousness. *See In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

### *B. Claim Construction*

Because the parties articulated different views on how “trained to the voice of the call assistant” should be interpreted relative to the asserted prior art, we analyzed Patent Owner’s implied constructions of the term and Patent Owner’s declarant’s testimony concerning the same. Final Dec. 9–10. In its Request for Rehearing, Patent Owner argues that we “misapprehended claim construction law” in determining software “trained to the voice of the call assistant” was not limited to training to the voice of one and only one particular call assistant and did not preclude voice recognition software that is designed or built in advance of implementation at the source code level to the voice of a call assistant. Req. 8–12.

First, Patent Owner contends that we erroneously relied on the disclosure in the ’740 patent of “voice pattern.” *Id.* at 8–11. We disagree that our reliance on the “Brief Summary of the Invention,” which refers to “a speech recognition computer program which has been trained to the voice *pattern* of the call assistant,” was improper. *See* Final Dec. 9 (quoting Ex. 1001, 2:45-47 (emphasis added)). Rather, in our Final Decision, we determined that the ’740 patent contemplated software trained to a “voice *pattern* of the call assistant,” as set forth in the “Brief Summary of the Invention,” as well as software “specifically trained to the voice of [a] *particular* call assistant,” as described in the context of a particular relay

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embodiment shown in Figure 1. Final Dec. 9–10 (quoting Ex. 1001, 2:45–47, 6:34–37).

Based on the evidence in the written description (including the disclosure of “voice pattern”), we determined that the ’740 patent did not indicate expressly how training occurs. *Id.* at 10. Giving the claim language its broadest reasonable construction in light of the specification, we concluded we would not limit “trained to the voice of the call assistant” to require training to the voice of one particular call assistant. *Id.*

We turn next to Patent Owner’s argument in its Request for Rehearing that we erred in concluding that “trained to the voice of the call assistant” does not include a temporal constraint that precludes voice recognition software that is designed or built in advance of implementation at the source code level to the voice pattern of a call assistant. Req. 12 (citing Final Dec. 9). Patent Owner asserts that we overlooked an alleged admission at the Hearing by Petitioner that the claim language inherently includes a temporal constraint that precludes training when the software is designed in advance of implementation at the source code level. Req. 12 (citing Paper 65 (Hearing Transcript), 17:3–5). We are not persuaded that we did so. Rather, we considered Petitioner’s statement at the Hearing in light of the evidence of record.

In our Final Decision, we determined that the written description discloses that the voice recognition software package is trained but does not indicate when or how the training occurs. Final Dec. 10. We rejected Patent Owner’s argument, relying on its declarant, that software “designed” is not software that is “trained to recognize individual voices” because we found insufficient support for Patent Owner’s contention. *Id.* (citing PO Resp. 29–

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30). As we explained in our Final Decision, Patent Owner’s declarant testified that a person of ordinary skill in the art would not have understood “trained” software to include “designed” software because technology to train software to recognize individual voices did not exist in 1994 and was not used in telecommunications relay service at that time. *Id.* (citing PO Resp. 29–30; Ex. 2001 ¶¶ 30–31; Ex. 2003 ¶¶ 22–26). We weighed this testimony, which relied on capabilities of technology available in 1994, and concluded this testimony had little probative value of the understanding of one of ordinary skill in the art at the time of invention because the earliest date of invention for claims of the ’740 patent was 2001. *Id.*

Moreover, Petitioner’s declarant indicates that one of ordinary skill in the art would have understood that Ryan describes speech recognition software trained to the voice of a call assistant. Ex. 1040 ¶¶ 45–46. The testimony of Petitioner’s declarant is supported further by prior art of record that indicates voice recognition software trained to a particular user in relay systems was known. *See id.* ¶ 46 (citing Ex. 1026, 4:37–49). This testimony further undermines Patent Owner’s position.

Thus, we do not agree with Patent Owner that we erred by not considering Petitioner’s purported “admission” made at the Hearing. Rather, we considered Petitioner’s statement in determining that Ryan’s description of benefits provided by voice recognition software that “is specifically designed to recognize the voice of particular relay agents” (Ex. 1004, 4:33–38) discloses the trained software recited in both claims of the ’740 patent. *See Final Dec.* 20–23.

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For the reasons given, we are not persuaded that we misapprehended claim construction law in our construction of “trained to the voice of the call assistant.”

*C. Secondary Considerations*

Patent Owner alleges that we improperly made a determination of obviousness before separately analyzing Patent Owner’s evidence of secondary considerations. Req. 14. We disagree. Rather, in Section II.D of our Final Decision, we determined the scope and content of the asserted prior art (Final Dec. 16–18); discussed the claimed subject matter relative to the asserted prior art, which included identifying differences between the claimed subject matter and the prior art in the context of the ordinary level of skill in the art (Final Dec. 18–24); determined Petitioner, with support of its declarant, had articulated sufficient reasoning to support a conclusion of obviousness based on the combined references (Final Dec. 24–26); and analyzed Patent Owner’s secondary considerations of nonobviousness (Final Dec. 26–29). *See KSR*, 550 U.S. at 418; *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). Only after that fourteen-page discussion in Section II.D did we discuss the ultimate conclusion of obviousness of the claimed subject matter by weighing the evidence on both sides:

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

Final Dec. 29.

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Patent Owner further contends we refused to consider Patent Owner's secondary considerations evidence. Req. 14. This is incorrect. We considered the arguments and evidence presented in Patent Owner's Response. Final Dec. 27–28. We concluded Patent Owner did “not provide sufficient analysis for us to determine whether Patent Owner has provided adequate evidence of secondary considerations and a nexus between any such evidence and the merits of the claimed invention.” *Id.* at 27.

In its Request, Patent Owner seems to suggest that we should have reviewed and analyzed the entirety of each of three declarations submitted by Patent Owner in support of its secondary considerations contention (Exs. 2004, 2006, and 2007). Req. 14–15. This also is incorrect because, in its Patent Owner Response, Patent Owner merely cited each declaration in its entirety without citing with particularity portions of these declarations. PO Resp. 58 (citing “declarations by Brenda Battat (Ex. 2006) and Constance Phelps (Ex. 2007)” and “declaration of Paul Ludwick (Ex. 2004)”). We will not scour the 155 pages of declaration evidence submitted by Patent Owner and generally serve as an advocate for Patent Owner by finding evidence of secondary considerations in the voluminous exhibits submitted. *Cf. DeSilva v. DiLeonardi*, 181 F.3d 865, 866–67 (7th Cir. 1999) (“A brief must make all arguments accessible to the judges, rather than ask them to play archaeologist with the record.”); *Ernst Haas Studio, Inc. v. Palm Press, Inc.*, 164 F.3d 110, 111–12 (2d Cir. 1999) (“Appellant's Brief is at best an invitation to the court to scour the record, research any legal theory that comes to mind, and serve generally as an advocate for appellant. We decline the invitation.”).

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*D. Panel Composition*

Patent Owner requests rehearing before an expanded panel and additionally asserts we exceeded our authority by issuing a Final Written Decision that did not include a judge that was on the panel of administrative patent judges who decided to institute the review. Req. 1, 12–14. Panel composition for an *inter partes* review is specified in 35 U.S.C. § 6(c), which states “[e]ach . . . inter partes review shall be heard by at least 3 members of the Patent Trial and Appeal Board, who shall be designated by the Director.” The Director’s authority under 35 U.S.C. § 6 to designate panels has been delegated to the Chief Judge. *See* Patent Trial and Appeal Board Standard Operating Procedure 1 (Rev. 14) (May 8, 2015) (“PTAB SOP 1”).

As acknowledged by Patent Owner (Req. 13), the Final Decision was decided by three administrative patent judges, who are members of the Board. *See* 35 U.S.C. § 6(a) (indicating that administrative patent judges, along with various members of the United States Patent and Trademark Office, constitute the Patent Trial and Appeal Board). The three administrative patent judges were designated by the Chief Judge according to PTAB SOP 1, titled “Assignment of Judges to Merits Panels, Interlocutory Panels, and Expanded Panels.” The Board, therefore, complied with the statutory requirements for panel composition. Accordingly, we did not issue the Final Decision with less than a “full panel,” as Patent Owner contends.

Moreover, the Chief Judge has discretion to designate judges to decide *inter partes* reviews. *See* PTAB SOP 1 at 2 (§ II.D) (“In general, the Chief Judge will designate a judge or judges, as appropriate, for all matters

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for AIA reviews.”); *see also AOL Inc. v. Coho Licensing LLC*, Case IPR2014-00771, slip op. at 2 (PTAB Mar. 24, 2015) (Paper 12) (informative) (setting forth that the designation of panel members is within the sole authority of the Chief Judge, as delegated by the Director). Patent Owner’s Request, therefore, does not show the composition of the panel that issued the Final Decision was arbitrary, capricious, or an abuse of discretion by the Board.

Patent Owner suggests an expanded panel is warranted to decide the Request in view of the panel composition and various allegations that we misapprehended the law. Req. 1. For the reasons given, Patent Owner does not persuade us that we misapprehended the law or the panel of three judges was deficient. Further, the Board’s procedures provide examples of reasons for expanding a panel, none of which apply here. PTAB SOP 1 at 3 (§ III.A). For example, an expanded panel may be appropriate when “serious questions have been raised about the continuing viability of an apparently applicable precedential decision of the Board, or a panel of the Board renders a decision that conflicts with a precedential decision of the Board or an authoritative decision of the Board’s reviewing courts.” *Id.* Patent Owner’s Request does not show a conflict or other reason that weighs in favor of panel expansion. Even so, the panel informed the Chief Judge, who has authority to expand a panel, of Patent Owner’s request, and the Chief Judge declined to expand the panel. *See* PTAB SOP 1 at 4 (§ III.C). (“The Chief Judge will determine when an expanded panel is to be designated.”); *see also Apple Inc. v. Rensselaer Polytechnic Inst.*, Case IPR2014-00319, slip op. at 2 n.1 (PTAB Dec. 12, 2014) (Paper 20)

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(indicating only the Chief Judge, acting on behalf of the Director, may act to expand a panel and panels do not authorize panel expansion).

### III. ORDER

For the reasons given, it is

ORDERED that Patent Owner's Request for Rehearing is *granted* for the limited purpose of modifying our analysis regarding the rationale for combining McLaughlin and Ryan as explained herein;

FURTHER ORDERED that Patent Owner's Request for Rehearing is *denied* in all other respects; and

FURTHER ORDERED that, as determined in our Final Decision, claims 1 and 2 of U.S. Patent No. 7,319,740 B2 are unpatentable.



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Patent 7,319,740 B2

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Paper 66  
Entered: March 3, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CAPTIONCALL, L.L.C.,  
Petitioner,

v.

ULTRATEC, INC.,  
Patent Owner.

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Case IPR2013-00543  
Patent 7,555,104 B2

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

PETTIGREW, *Administrative Patent Judge*.

FINAL WRITTEN DECISION  
*35 U.S.C. § 318(a) and 37 C.F.R. § 42.73*

I. INTRODUCTION

We have jurisdiction to hear this *inter partes* review under 35 U.S.C. § 6(c). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed herein, Petitioner has shown by a preponderance of the evidence that claims 1 and 2 of U.S. Patent No. 7,555,104 B2 (Ex. 1002, “the ’104 patent”) are unpatentable.

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Patent 7,555,104 B2

### A. Procedural History

Petitioner, CaptionCall, L.L.C., filed a Petition for *inter partes* review of claims 1 and 2 of the '104 patent. Paper 1 (“Pet.”). Patent Owner, Ultratec, Inc., did not file a Preliminary Response. On March 5, 2014, pursuant to 35 U.S.C. § 314, we instituted an *inter partes* review for claims 1 and 2 of the '104 patent on the ground of obviousness under 35 U.S.C. § 103(a) over Ryan and McLaughlin.<sup>1</sup> Paper 6 (“Inst. Dec.”).

Subsequent to institution, Patent Owner filed a Patent Owner Response (Paper 20, “PO Resp.”), and Petitioner filed a Reply to Patent Owner’s Response (Paper 33, “Reply”). Patent Owner also filed a Motion to Exclude Evidence. Paper 42 (“PO Mot. to Exc.”). Petitioner filed an Opposition (Paper 49, “Pet. Opp. to Mot. to Exc.”) to Patent Owner’s Motion, and Patent Owner filed a Reply to Petitioner’s Opposition (Paper 50, “PO Reply to Opp. to Mot. to Exc.”).

An oral hearing was held on November 19, 2014.<sup>2</sup>

### B. Related Proceedings

Petitioner represents that Patent Owner asserted the '104 patent against Petitioner’s parent company in the following district court proceeding: *Ultratec, Inc. v. Sorenson Communications, Inc.*, No. 13-CV-00346 (W.D. Wis.). Pet. 4. Petitioner also represents that in the same

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<sup>1</sup> U.S. Patent No. 5,809,112, issued Sept. 15, 1998 (Ex. 1005, “Ryan”); U.S. Patent No. 6,181,736 B1, issued Jan. 30, 2001 (Ex. 1012, “McLaughlin”).

<sup>2</sup> This proceeding and IPR2013-00540, IPR2013-00541, IPR2013-00542, IPR2013-00544, IPR2013-00545, IPR2013-00549, and IPR2013-00550 involve the same parties and similar issues. The oral arguments for all eight reviews were merged and conducted at the same time. A transcript of the oral hearing is included in the record as Paper 65.

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district court proceeding, Patent Owner asserted the following patents at issue in related *inter partes* reviews: U.S. Patent No. 6,233,314 (Case IPR2013-00540), U.S. Patent No. 5,909,482 (Case IPR2013-00541), U.S. Patent No. 7,319,740 (Case IPR2013-00542), U.S. Patent No. 8,213,578 (Case IPR2013-00544), U.S. Patent No. 6,594,346 (Case IPR2013-00545), U.S. Patent No. 6,603,835 (Case IPR2013-00549), and U.S. Patent No. 7,003,082 (Case IPR2013-00550). Pet. 4.

### *C. The '104 Patent*

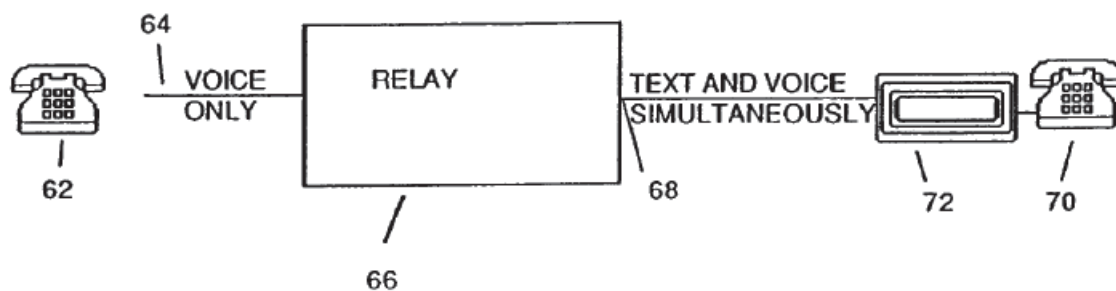
The '104 patent describes a system that assists deaf, hard of hearing, or otherwise hearing-impaired individuals in using telephones. Ex. 1002, 1:23–26. A conventional system uses a device that includes a keyboard, a display, and a specific type of modem, and is known as a telecommunication device for the deaf (TDD), a text telephone (TT), or a teletype (TTY). *Id.* at 1:34–39. When a hearing person who does not have access to a TDD wishes to communicate with a hearing-impaired person who uses a TDD, the parties may utilize a relay system, in which a human intermediary, known as a “call assistant,” communicates with the hearing user by voice and with the hearing-impaired user by using a TDD. *Id.* at 1:62–2:7. In a conventional relay system, the call assistant types, at a TDD keyboard, the words spoken by the hearing user and voices to the hearing user the words received on the TDD from the hearing-impaired user. *Id.* at 2:7–11.

The '104 patent relates to a relay system to improve performance of voice-to-text interpretation for translating between hearing-impaired and hearing users. *Id.* at 3:54–56. Instead of typing the hearing user’s words, the call assistant speaks those words into a microphone that transmits the voice of the call assistant to a computer with voice recognition software

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trained specifically to the voice of the call assistant. *Id.* at 6:3–20. Using the voice recognition software, the computer translates the words of the call assistant to digital text, which is sent to a display of the hearing-impaired user. *Id.* at 6:32–39.

The '104 patent also describes a captioned telephone device at the site of the assisted user. *Id.* at 8:52–9:3. Figure 4, reproduced below, illustrates the setup of a telephone call involving captioned telephone device 72:



**FIG. 4**

As shown in Figure 4, a hearing user at telephone 62 communicates with relay 66 through telephone line 64. *Id.* at 8:55–56. The relay communicates both the voice of the hearing user and a transcription of the text of the conversation through telephone line 68 to an assisted user. *Id.* at 8:56–58. At the assisted user's site are captioned telephone device 72 and conventional telephone 70. *Id.* at 8:58–60. Captioned telephone device 72 is constructed to accomplish two objectives: filtering, or separating, the voice signal from the digital signals carrying text information, and creating a visual display of the text information for the assisted user. *Id.* at 8:60–66. The captioned telephone device assists “the user to understand a greater portion of the conversation by providing a visually readable transcription of

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the text of the telephone conversation so that the assisted user can read any words that he or she cannot hear properly.” *Id.* at 8:66–9:3.

#### *D. Illustrative Claim*

Claims 1 and 2 are the only claims of the ’104 patent and are both independent. Claim 1 is illustrative:

1. A relay system using a call assistant for facilitating communication between a hearing user and an assisted user, the system comprising

a relay at the location of the call assistant, the relay including a personal computer with voice recognition software trained to the voice of the call assistant to translate the words spoken by the call assistant into a digital text stream containing the words spoken by the call assistant;

a captioned telephone device within sight of the assisted user and including a display visible to the assisted user; and

communication connections between the hearing user and the relay and between the assisted user and the relay, the communication connections independently selected from the group consisting of wired telephone connection, wireless telephone connection, PCS connection and [I]nternet connection;

the system connected such that if the call assistant repeats the words spoken by the hearing user, the digital text stream created by the relay causes the words spoken by the hearing user to appear on the display of the captioned telephone device.

*Id.* at 9:35–10:17.

## II. ANALYSIS

### *A. Claim Construction*

In an *inter partes* review, we construe claim terms in an unexpired patent according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *see*

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*also In re Cuozzo Speed Techs., LLC*, No. 2014-1301, slip op. at 11–19 (Fed. Cir. Feb. 4, 2015). Consistent with the broadest reasonable construction, claim terms are presumed to have their ordinary and customary meaning, as understood by a person of ordinary skill in the art, in the context of the entire patent disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). An inventor may provide a meaning for a term that is different from its ordinary meaning by defining the term in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

We construe the claim language below in accordance with these principles. No other terms require express construction.

*1. “captioned telephone device”*

Claim 1 recites “a *captioned telephone device* within sight of the assisted user and including a display visible to the assisted user.” Ex. 1002, 10:4–5 (emphasis added). Claim 2 recites “a *captioned telephone device* at the location of the assisted user and including a display visible to the assisted user.” *Id.* at 10:27–28 (emphasis added). Petitioner does not propose a construction for “captioned telephone device,” but suggests a captioned telephone device may not need to be capable of receiving the voice of the hearing user in addition to a text transcription of the spoken words. *See, e.g.*, Pet. 25 (“*Ryan* discloses a TDD within sight of the assisted user and including a display visible to the assisted user. To the extent that the ’104 Patent requires a captioned telephone device to be a device capable of receiving both voice and text of the hearing user, *McLaughlin* discloses such a device.”).

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The ordinary meaning of “telephone” is “[a]n instrument that converts voice and other sound signals into a form that can be transmitted to remote locations and that receives and reconverts waves into sound signals.”<sup>3</sup> In the context of voice communication, a “caption” is text that communicates dialogue.<sup>4</sup> Thus, according to its ordinary meaning, a captioned telephone device is a device that transmits and receives voice signals and displays text.

The ’104 patent uses the term “captioned telephone device” in a way that is consistent with this ordinary meaning. The written description of the ’104 patent describes a captioned telephone device as a device that receives both voice signals and text information and displays the text information to an assisted user. Ex. 1002, 8:60–66 (“The captioned telephone device 72 is constructed to accomplish two objectives. One objective is to filter, or separate, the digital signals carrying the text information from the voice signal. The other objective is to take the digital signals and create a visual display of the text information for the assisted user.”); *see also id.* at Fig. 4 (showing a simultaneous text and voice connection between captioned telephone device 72 and relay 66). Note that a captioned telephone device need not output any audio signals to the assisted user. *See id.* at 8:58–60 (describing a captioned telephone device and telephone at an assisted user’s

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<sup>3</sup> THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 1846 (3d ed. 1992); THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 1779 (4th ed. 2006).

<sup>4</sup> THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 286 (3d ed. 1992) (defining “caption” in relevant part as “2. A subtitle in a motion picture.”); THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 278 (4th ed. 2006) (defining “caption” in relevant part as “2. A series of words . . . that communicate dialogue to the hearing-impaired or translate foreign dialogues.”).



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location as two separate devices); *id.* at Fig. 4 (illustrating captioned telephone device 72 and telephone 70 as two separate devices).

In light of the use of “captioned telephone device” in the ’104 patent and the ordinary meaning of the term, we construe “captioned telephone device” as a device that transmits and receives voice signals, receives text information, and displays text to an assisted user.

2. “*trained to the voice of the call assistant*”

Neither party expressly proposes a construction for “trained to the voice of the call assistant,” which appears in both claims 1 and 2. *See* Pet. 11–12; PO Resp. 11–16; Reply 3. In their dispute over the teachings of the asserted prior art, however, the parties articulate different views as to how the term should be construed. Patent Owner construes “trained to the voice of the call assistant” to require training to recognize individual voices, PO Resp. 27, presumably trained to the voice of one, and only one, call assistant and to preclude training for a type of speech used by a group of people (such as a regional accent) that could apply to more than one call assistant. Patent Owner also seeks to construe “trained to the voice of the call assistant” as having a temporal constraint so as to preclude training at the time when the voice recognition computer software package is “designed in advance of implementation at the source code level.” *Id.* (emphasis omitted). According to Patent Owner, “trained to the voice of the call assistant” precludes software that is “built” to recognize the voice of a particular agent. *Id.* at 28. Petitioner disagrees. Reply 8–9.

The ’104 patent does not set forth a special definition for “training.” In the “Brief Summary of the Invention,” however, the ’104 patent refers to “a speech recognition computer program which has been trained to the voice

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*pattern* of the call assistant.” Ex. 1002, 2:54–56 (emphasis added). In the context of describing a relay, the written description explains that “the call assistant operates at a computer terminal which contains a copy of a voice recognition software package which is specifically trained to the voice of that *particular* call assistant.” *Id.* at 6:17–20 (emphasis added). Thus, the ’104 patent contemplates software trained to “a voice *pattern* of the call assistant” as well as software “specifically trained to the voice of [a] *particular* call assistant.” Neither description of training, however, indicates when or how the training occurs. Patent Owner, relying on its declarants Mr. James A. Steel, Jr. and Mr. Paul W. Ludwick, asserts that a person of ordinary skill in the art would not have understood software that is “designed” in advance to recognize the voice of particular agents to be software that is “trained to recognize individual voices,” because such technology was not used in telecommunications relay service in 1994. PO Resp. 27–28 (citing Ex. 2001 ¶ 32; Ex. 2003 ¶¶ 19, 21–26). We note that technology available in 1994 has little probative value here because the earliest date of invention for claims of the ’104 patent is 2001.

We give claim language its broadest reasonable construction in light of the specification of the patent in which it appears. Thus, we will not limit “trained to the voice of the call assistant” to require training to the voice of one particular call assistant, because the claim language encompasses the invention as disclosed in the written description of the ’104 patent—software trained to a voice *pattern* of a call assistant. Ex. 1002, 2:54–56 (“Summary of the Invention”). Nor will we limit “trained to the voice of the call assistant” to a particular time at which training must occur or to a

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particular manner of training that is not found in the claims or the written description of the '104 patent.

*B. Principles of Law*

To prevail in challenging Patent Owner's claims, Petitioner must demonstrate by a preponderance of the evidence that the claims are unpatentable. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). A claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time of the invention to a person having ordinary skill in the art. *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). The level of ordinary skill in the art is reflected by the prior art of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995).

*C. Patent Owner's Motion to Exclude Testimony by Mr. Occhiogrosso*

Patent Owner seeks to exclude the testimony of Mr. Benedict Occhiogrosso (Exs. 1019, 1036, 2008, 2009, and 2014) on the theory that he is not qualified as an expert under Federal Rule of Evidence 702

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(“FRE 702”).<sup>5,6</sup> PO Mot. to Exc.; PO Resp. 7–11. FRE 702 provides that a witness qualified as an expert by knowledge, skill, experience, training, or education may testify in the form of an opinion if (a) the expert’s knowledge will help the trier of fact to understand the evidence or to determine a fact in issue, (b) the testimony is based upon sufficient facts or data, (c) the testimony is the product of reliable principles and methods, and (d) the witness has applied the principles and methods reliably to the facts of the case. Testimony on the issue of unpatentability proffered by a witness who is not “qualified in the pertinent art” generally is not admissible under FRE 702. *Sundance, Inc. v. DeMonte Fabricating Ltd.*, 550 F.3d 1356, 1363–64 (Fed. Cir. 2008). In determining who is qualified in the pertinent art under FRE 702, we need not find a complete overlap between the witness’s technical qualifications and the problem confronting the inventor or the field of endeavor. *See SEB S.A. v. Montgomery Ward & Co., Inc.*, 594 F.3d 1360, 1372–73 (Fed. Cir. 2010) (upholding admission of the testimony of an expert who admittedly lacked expertise in the design of the patented invention, but had experience with materials selected for use in the invention); *Mytee Prods., Inc. v. Harris Research, Inc.*, 439 Fed. App’x 882, 886–87 (Fed. Cir. 2011) (non-precedential) (upholding admission of the

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<sup>5</sup> Patent Owner also seeks to *exclude* Mr. Occhiogrosso’s testimony under 37 C.F.R. § 42.65. PO Mot. to Exc. 1. Rule 42.65, however, addresses (a) the weight given to expert testimony that does not disclose underlying facts or data on which the opinion is based, (b) the showing required if a party seeks to rely on a technical test or data from such a test, and (c) the exclusion of expert testimony on United States patent law or patent examination practice. As such, Rule 42.65 does not apply to a determination whether to exclude Mr. Occhiogrosso’s testimony.

<sup>6</sup> With some enumerated exceptions, the Federal Rules of Evidence apply to an *inter partes* review. 37 C.F.R. § 42.62.

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testimony of an expert who “had experience relevant to the field of the invention,” despite admission that he was not a person of ordinary skill in the art).

Patent Owner contends that, to qualify as an expert under FRE 702, Mr. Occhiogrosso must be a person of ordinary skill in the art, and that Mr. Occhiogrosso is not a person of ordinary skill in the art because he does not have “general knowledge and understanding of the telecommunications needs of the deaf and HOH [(hard of hearing)]” or “experience with the development of assistive telecommunications technology for such individuals.” PO Mot. to Exc. 1–4; *see also id.* at 5–7 (discussing Mr. Occhiogrosso’s experience with respect to these areas). Petitioner responds that Patent Owner’s definition of the level of ordinary skill in the art conflates a requirement for skill in the relevant technical art (“telecommunications systems [having] voice-to-text transcription”) with skill in one particular commercial sector that applies that technical art (“telecommunications services *specifically* designed for the deaf or hard of hearing”). Pet. Opp. to Mot. to Exc. 1–2.

Patent Owner’s arguments are unpersuasive at the outset because, to testify as an expert under FRE 702, a person need not be a person of ordinary skill in the art, but rather “qualified in the pertinent art.” *Sundance*, 550 F.3d at 1363–64; *see SEB*, 594 F.3d at 1372–73; *Mytee*, 439 Fed. App’x at 886–87. Patent Owner’s arguments are also unpersuasive because they attempt to constrict the “pertinent art,” i.e., the pertinent technology, to a particular subset of individuals who use the pertinent technology, rather than the pertinent technology itself. *See* Pet. Opp. to Mot. to Exc. 4–5 (arguing

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that the problems in the pertinent art are not “uniquely related” to the deaf and hard-of-hearing).

The technology at issue in the ’104 patent “relates to the general field of telephone communications.” Ex. 1002, 1:22–23. The ’104 patent focuses on a particular application of that technology: people who need assistance in using telecommunications devices. *Id.* at 1:22–2:45 (describing various prior art assistive technologies to help characterize the evolution of assistive technologies). The ’104 patent also summarizes the invention as the use of a speech recognition computer program trained to the voice of the call assistant to translate promptly the words spoken by an intermediary call assistant into a “high speed digital communication message [that] is then transmitted electronically promptly by telephone to a visual display accessible to the” hearing-assisted user. *Id.* at 2:53–60. Thus, we determine the pertinent art to be telecommunications systems, because any communications technology would be pertinent art to the ’104 patent. Although assistive technology may be more pertinent, and assistive technology for the deaf and hearing impaired, using voice-to-text relays, may be most pertinent, anything in the telecommunications technology field would be pertinent to the inventor when considering his problem.

The qualifications of Mr. Occhiogrosso, as summarized in his curriculum vitae (Ex. 1020), qualify him to give expert testimony on the subject of telecommunication technologies. He possesses a Bachelor of Science in Electrical Engineering and a Master of Science in Electrical Engineering. Ex. 1020, 2. Mr. Occhiogrosso testifies that he has more than thirty years of experience in the field of telecommunications and information technology, and he has planned, designed, implemented, and managed large

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scale projects involving wired and wireless communication systems, including transmission of voice and data. Ex. 1019 ¶ 7; *see also* Ex. 1020, 2–6 (detailing Mr. Occhiogrosso’s enterprise consulting engagements, research and development, and wireless experience).

Moreover, to the extent Mr. Occhiogrosso is more familiar with general telecommunications technology and less familiar with voice-to-text or its application to the deaf or hearing-impaired, or to the extent that Mr. Occhiogrosso’s testimony is inconsistent or unsupported, we weigh Mr. Occhiogrosso’s testimony accordingly, taking into account the extent of his expertise in these areas. *See, e.g., Yorkey v. Diab*, 601 F.3d 1279, 1284 (Fed. Cir. 2010) (holding the Board has discretion to give more weight to one item of evidence over another “unless no reasonable trier of fact could have done so”); *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.”).

Patent Owner also contends that Mr. Occhiogrosso’s testimony fails to identify the level of skill in the art in his declaration (Ex. 1019), fails to give any consideration to what one of ordinary skill in the art would have known or not known, is unsupported and unreliable, and does not consider secondary considerations. PO Mot. to Exc. 8; PO Resp. 9–10; PO Reply to Opp. to Mot. to Exc. 4. Petitioner counters that Mr. Occhiogrosso “consistently applied his definition of a [person of ordinary skill in the art] throughout his testimony” and, in a supplemental declaration, “made explicit the level of ordinary skill he applied” in his first declaration. Pet. Opp. to Mot. to Exc. 15.

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Patent Owner's argument goes more to the weight we should accord Mr. Occhiogrosso's testimony, rather than its admissibility. It is within our discretion to assign the appropriate weight to the testimony offered by Mr. Occhiogrosso. *See, e.g., Yorkey*, 601 F.3d at 1284. Moreover, Mr. Occhiogrosso provided a supplemental declaration identifying the level of skill in the art and confirming his opinion presented in the earlier declaration in view of the level of skill in the art. *See* Ex. 1036 ¶¶ 12–17, 19. Mr. Occhiogrosso's testimony also confirmed his legal understanding of obviousness, including secondary considerations. *See id.* ¶¶ 20–25.

Under the totality of these circumstances, we decline to exclude the testimony of Mr. Occhiogrosso. Accordingly, Patent Owner's Motion to Exclude Mr. Occhiogrosso's testimony is *denied*.

*D. Asserted Ground of Obviousness over Ryan and McLaughlin*

Petitioner contends that claims 1 and 2 are unpatentable under 35 U.S.C. § 103(a) as obvious over Ryan and McLaughlin, relying on declaration testimony of Mr. Occhiogrosso. Pet. 23–33 (citing Ex. 1019). Patent Owner responds, relying on declaration testimony of Mr. Steel and Mr. Ludwick. PO Resp. 17–57 (citing Exs. 2001, 2003). Having considered the parties' contentions and supporting evidence, we determine that Petitioner has demonstrated by a preponderance of the evidence that claims 1 and 2 are unpatentable for obviousness over Ryan and McLaughlin.

*1. Summary of Ryan*

Ryan describes a relay interface system for communication between a standard telephone set used by a hearing user and a TDD used by a hearing-impaired person. Ex. 1005, Abstract, 1:6–10. Figure 1 of Ryan is set forth below:



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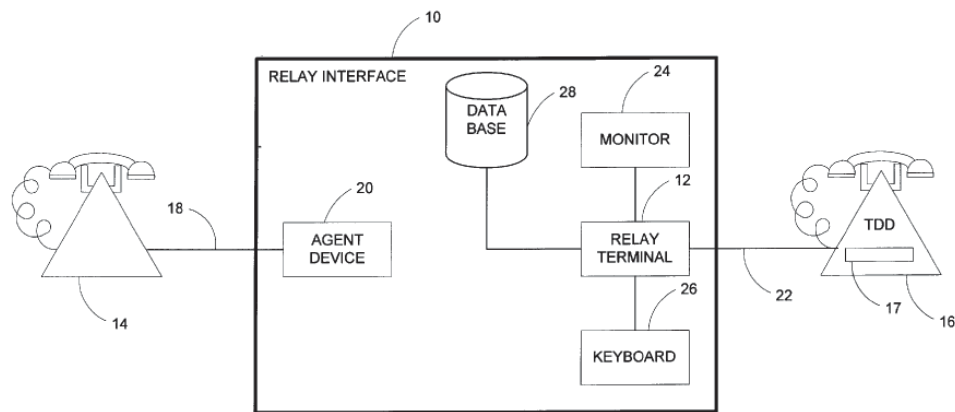


FIG. 1

As shown in Figure 1, Ryan's relay interface 10 includes operator/relay terminal 12 and connects standard telephone set 14 with TDD 16 having associated display 17. *Id.* at 3:43–48. Telecommunications link 18 connects telephone 14 with relay interface 10 through agent device 20, and telecommunications link 22 connects TDD 16 with relay interface 10 through relay terminal 12. *Id.* at 3:48–52. An operator or relay agent typically is responsible for manipulating relay terminal 12 using keyboard 26 to relay messages between telephone 14 and TDD 16. *Id.* at 4:19–21. Ryan indicates, however, that speech recognition software could be used to automate the relay function so that an operator or relay agent would not be required. *Id.* at 4:21–24. Ryan specifically describes using speech recognition software at agent device 20 to interpret a voice message from a caller at telephone 14 and convert the message from a voice format to a data format. *Id.* at 4:24–27. Ryan further indicates:

If the software is specifically designed to recognize the voice of particular relay agents, the accuracy of the relay service may be improved by having one of these agents listen to the caller and repeat the voice message into a terminal adapted to convert the agent's voice message into a data message.

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*Id.* at 4:33–38.

## 2. *Summary of McLaughlin*

McLaughlin describes a simultaneous voice and data (SVD) modem used in connection with a relay service in which an operator mediates communications between a hearing person and a hearing-impaired person. Ex. 1012, 30:13–31:63. In one embodiment described in McLaughlin, the hearing-impaired user has an answering device or system, comprising two SVD modems, connected to two communication links, Line A and Line B. *Id.* at 30:59–63, 32:17–19. These communication links may use local area network (LAN), wide area network (WAN), or Internet communications over analog lines or digital lines, such as Integrated Services Digital Network (ISDN) or digital subscriber line (DSL) technology. *Id.* at 30:46–53. When a voice call from the hearing user arrives on Line A, the answering device sets up an SVD link with the relay service on Line B. *Id.* at 31:35–40. Voice sounds received from the hearing user on Line A are sent to the relay operator on Line B. *Id.* at 31:41–43. The relay operator translates the voice sounds into text, which is sent over Line B to appear on the screen of the hearing-impaired user’s answering device. *Id.* at 31:43–47. The hearing-impaired user also types responses back to the relay operator over Line B. *Id.* at 31:47–49. The relay operator voices the text, and the relay operator’s voice sounds are carried on Line B to the hearing-impaired user’s answering device and passed over to Line A to be heard by the hearing user. *Id.* at 31:49–52. Conversation among all three parties is “full duplex,” so that all parties may talk or type simultaneously. *Id.* at 31:55–62.

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### 3. *Claims 1 and 2*

Claim 1 is directed to a relay system using a call assistant for facilitating communication between a hearing user and an assisted user. The claim recites (i) a relay with voice recognition software trained to the voice of the call assistant to translate words spoken by the call assistant into a digital text stream, (ii) a captioned telephone device within sight of the assisted user, including a display visible to the assisted user, (iii) communication connections between the hearing user and relay and between the assisted user and relay, which may be wired, wireless, or Internet connections, and (iv) the system connected so that if the call assistant repeats (i.e., re-voices) the words spoken by the hearing user, the digital text stream created by the relay appears on the display of the captioned telephone device. Claim 2 is similar, but with a captioned telephone device “at the location of the assisted user” and Internet Protocol connections between the hearing user and relay and between the assisted user and relay.

Petitioner asserts that Ryan teaches the relay and re-voicing limitations, relying on Ryan’s relay interface system in which a relay agent is responsible for relaying messages between phone 14 and TDD 16. Pet. 24, 28–30, 32–33 (citing Ex. 1005, 4:19–38). Specifically, Petitioner relies on Ryan’s description of “speech recognition software . . . employed at [relay agent] device 20 [and] specifically designed to recognize the voice of particular relay agents” and Ryan’s indication that “the accuracy of the relay service may be improved by having one of these agents listen to the caller and repeat the voice message into a terminal adapted to convert the agent's voice message into a data message.” *Id.* (citing Ex. 1005, 4:19–38).

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Petitioner also asserts that Ryan teaches wired communication connections. Pet. 27 (citing Ex. 1005, 1:14–18, 3:43–52).

For the captioned telephone device limitations, Petitioner relies on McLaughlin’s description of an assisted user’s answering device that receives voice sounds from a hearing user on Line A, transmits those sounds to the relay operator on Line B, and receives text from the relay operator on Line B to be displayed on the answering device’s screen. Pet. 26, 31 (citing Ex. 1012, 31:41–62). Petitioner also asserts that McLaughlin teaches the use of Internet or IP connections. Pet. 27, 32 (citing Ex. 1012, 1:31–36, 30:46–53).

We find that Petitioner has shown by a preponderance of the evidence that the combination of Ryan and McLaughlin teaches all the claim limitations and has articulated sufficient reasoning for combining the references. For the reasons explained below, we are not persuaded by Patent Owner’s arguments to the contrary. *See* PO Resp. 19–55.

*a. “captioned telephone device”*

Patent Owner argues that McLaughlin does not teach a captioned telephone device because (i) McLaughlin’s answering device does not play audio of the remote user’s voice to the assisted user, and (ii) McLaughlin does not teach a device located at an assisted user’s station that performs all the functions of a captioned telephone device. PO Resp. 21–25. We find Patent Owner’s arguments unpersuasive. First, the claim language does not require providing audio of the remote user’s voice to the assisted user. Similarly, our construction of “captioned telephone device” only requires a device that receives and transmits voice signals, not one that makes the received voice signals audible to the assisted user. *See supra* II.A.1.

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Second, McLaughlin teaches an answering device that receives voice on Line A and transmits voice and receives text on line B using SVD modems, and also includes a screen for displaying text to a hearing-impaired user, thereby meeting the requirements of a captioned telephone device as we have construed the term. Ex. 1012, 30:46–48, 30:59–63, 31:41–47; 32:41–52. On this point, based on our review of McLaughlin, we credit the testimony of Petitioner’s declarant, Mr. Occhiogrosso, over that of Patent Owner’s declarant, Mr. Steel. See Ex. 1036 ¶¶ 28–38; Ex. 2001 ¶¶ 25–27.

*b. “voice recognition software trained to the voice of the call assistant”*

Patent Owner contends that Ryan does not disclose a relay with “voice recognition software *trained* to the voice of the call assistant” because Ryan’s software is “designed” to recognize the voice of particular relay agents. PO Resp. 26–28. According to Patent Owner, software *designed* in advance of implementation at the source code level is not the same as *trained* software. *Id.* at 27. As discussed previously, *see supra* II.A.2, we do not agree with Patent Owner that trained voice recognition software, as recited in the claims, precludes software that is trained during the design phase, which Patent Owner contends is disclosed by Ryan. See PO Resp. 27. Thus, we are not persuaded by Patent Owner’s argument, which is premised on an incorrect claim construction. Moreover, Patent Owner relies on testimony from Mr. Steel and Mr. Ludwick, which we do not find persuasive because it is grounded in the state of the art in 1994, *see id.* at 27–28 (citing Ex. 2001 ¶ 32; Ex. 2003 ¶¶ 19, 21–26), rather than at the

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time of invention of the '104 patent, which is no earlier than 2001, the filing date of related U.S. Patent No. 6,594,346.<sup>7</sup> *See* Pet. 6–10; Reply 3.

Next, relying on Mr. Ludwick's testimony, Patent Owner contends that Ryan does not disclose the recited "voice recognition software trained to the voice of the call assistant," because Ryan's "voice recognition software is written specifically to recognize the voices of a collection or group of people, rather than a particular, individual call assistant." PO Resp. 29 (citing Ex. 2003 ¶ 19). For the reasons discussed previously, we do not agree that the claim language is limited to voice recognition software trained to one, and only one, call assistant. *See supra* II.A.2. Thus, even if Ryan's software is trained to recognize the voices of a group of people rather than an individual call assistant, we are not persuaded by Patent Owner's argument, which is premised on an incorrect claim construction.

Patent Owner also contends that, at most, Ryan is ambiguous as to the disclosure of a call assistant re-voicing the words spoken by the remote user into a computer to create a text stream of those words. PO Resp. 30–38. In particular, Patent Owner contends that Ryan discloses a relay agent using re-voicing as an error correction mechanism for individual, unrecognized letters of a word. *Id.* at 32–38; *see* Ex. 1005, Abstract. We do not read Ryan's disclosure so narrowly. *See* Ex. 1005, 4:19–38.

Ryan's technology is intended to "overcome[] the problem associated with existing telecommunications relay services by providing a system and method for correcting mistakes before the message is displayed at the end user's TDD." *Id.* at 2:35–38 (Summary of the Invention). Ryan describes ways to do so using speech recognition software. *Id.* at 4:19–38. One way

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<sup>7</sup> The '346 patent is the subject of related IPR2013-00545.

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is automating the relay function so as to eliminate the need for a human operator. *Id.* at 4:19–24. Ryan describes using speech recognition software to convert the voice message from a caller to text “while providing an error correction feature for words not recognized by the software.” *Id.* at 4:24–28. Ryan further describes the error correction feature as having two forms—phonetic spelling of the unrecognized word by the speech recognition software or prompting the caller to spell the unrecognized word. *Id.* at 4:29–33.

Ryan describes another way to improve the accuracy of a relay system before the text is displayed at the TDD—if the speech recognition software is designed specifically to recognize the voice of particular relay agents, a relay agent “listen[s] to the caller and repeat[s] the voice message into a terminal adapted to convert the agent’s voice message into a data message.” *Id.* at 4:33–38. In contrast to Ryan’s description of the error correction by the *caller* spelling letters of an unrecognized word, here Ryan unambiguously describes a call agent repeating the voice message of the caller and using speech recognition software designed specifically to recognize the voice of the relay agent to convert the agent’s voice message into a data message.

Finally, we are not persuaded by Patent Owner’s argument that Ryan must be read narrowly in view of the state of the telecommunications relay art in 1994, the effective filing date of Ryan. *See* PO Resp. 38–41. A proper obviousness analysis considers the prior art from the perspective of a person having ordinary skill in the art at the time of the invention, which in this case is no earlier than 2001. *See* 35 U.S.C. § 103(a); Pet. 6–10; Reply 3. As Petitioner indicates, a person of ordinary skill in the art in 2001 would have

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had in his possession related U.S. Patent No. 5,909,482 (“the ’482 patent”), filed in 1997.<sup>8</sup> Reply 11. The ’482 patent expressly discloses the use of a commercial software package, Dragon Naturally Speaking, for re-voicing a remote user’s voice into voice recognition software trained to the voice of a call assistant. Ex. 1003, 5:50–57; *see* Reply 10. With this background, a person of ordinary skill in the art in 2001 would have viewed Ryan as teaching voice recognition software trained to the voice of the call assistant.

*c. Reasons to Combine Ryan and McLaughlin*

Petitioner also has articulated sufficient reasoning with some rational underpinning to support the legal conclusion that the subject matter of the claims would have been obvious to one of ordinary skill in the art in view of the teachings of Ryan and McLaughlin as combined in the manner proposed by Petitioner. *See KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)); Pet. 23 (citing Ex. 1019 ¶¶ 28–29); Reply 11–13 (citing Ex. 1036 ¶¶ 53–55). McLaughlin teaches a captioned telephone device configured to connect to a relay. McLaughlin, however, does not teach re-voicing the remote user’s words at the relay using voice recognition software trained to the voice of the call assistant, as recited in the claims. Instead, McLaughlin describes a relay service with a call assistant, but also indicates that a relay may use automated equipment. Ex. 1012, 29:20–22. Ryan teaches using speech recognition software to automate the relay function, but further teaches that the accuracy of the relay may be improved if a call assistant re-voices the remote user’s words into voice recognition software designed to recognize the call assistant’s voice. Ex. 1005, 4:33–38.

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<sup>8</sup> The ’482 patent is the subject of related IPR2013-00541.



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We are persuaded that a person of ordinary skill in the art would have looked to Ryan for ways to automate the relay function in McLaughlin’s system and would have recognized that Ryan’s intermediate re-voicing solution—using voice recognition software trained to the call assistant’s voice—would perform better than speaker-independent voice recognition applied directly to the remote user’s voice. *See* Ex. 1036 ¶ 55.

Patent Owner contends that one of ordinary skill in the art would not have considered Ryan when developing the relay system of the ’104 patent “because the bulk of the disclosure of Ryan was nothing more than the known TDD architecture.” PO Resp. 49–51. Patent Owner also contends that one of ordinary skill would not have considered McLaughlin because its system requires use of specialized modems and it discloses connecting to a traditional relay, not a relay with voice recognition. *Id.* at 52–53. These arguments focus on isolated teachings of the references, rather than whether the claimed subject matter as a whole would have been obvious to one of ordinary skill in the art in view of the combined teachings of the references. *See* 35 U.S.C. § 103(a); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). As discussed, we are persuaded that a person of ordinary skill in the art would have combined the teachings of Ryan and McLaughlin in the manner proposed by Petitioner.

Patent Owner also argues that McLaughlin teaches away from the use of trained voice recognition software. PO Resp. 54–55. In particular, Patent Owner submits that McLaughlin explains the shortcomings of automated speech recognition technology. *Id.* at 54 (citing Ex. 1012, 26:54–62). McLaughlin’s statement, however, involves the application of speech recognition to voice messages left by callers, not voice recognition software

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trained to the voice of a call assistant, i.e., speaker-dependent voice recognition. McLaughlin, therefore, does not criticize, discredit, or discourage the combination of Ryan's re-voicing technique with McLaughlin's system. *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

#### 4. *Secondary Considerations*

Factual inquiries for an obviousness determination include secondary considerations based on evaluation and crediting of objective evidence of nonobviousness. *Graham*, 383 U.S. at 17–18. Notwithstanding what the teachings of the prior art would have suggested to one with ordinary skill in the art at the time of the invention, the totality of the evidence submitted, including objective evidence of nonobviousness, may lead to a conclusion that the challenged claims would not have been obvious to one with ordinary skill in the art. *In re Piasecki*, 745 F.2d 1468, 1471–72 (Fed. Cir. 1984). Secondary considerations may include any of the following: long-felt but unsolved need, failure of others, unexpected results, commercial success, copying, licensing, and praise. *See Graham*, 383 U.S. at 17; *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007).

To be relevant, evidence of nonobviousness must be commensurate in scope with the claimed invention. *In re Kao*, 639 F.3d 1057, 1068 (Fed. Cir. 2011). Thus, to be accorded substantial weight, there must be a nexus between the merits of the claimed invention and the evidence of secondary considerations. *GPAC*, 57 F.3d at 1580. “Nexus” is a legally and factually sufficient connection between the objective evidence and the claimed invention, such that the objective evidence should be considered in determining nonobviousness. *Demaco Corp. v. F. Von Langsdorff Licensing*

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*Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988). The burden of showing that there is a nexus lies with the Patent Owner. *Id.*; *Paulsen*, 30 F.3d at 1482.

Patent Owner alleges “substantial praise for the inventions claimed in [Patent Owner’s] patents, including the ’104 Patent, the long-felt but unresolved need of the deaf and hard of hearing community, the commercial success of the products and services embodying the invention, and the failure of others to provide a relay service or other solution that provided the benefits of the claimed inventions.” PO Resp. 56. For support, Patent Owner proffers declarations by Ms. Brenda Battat (Ex. 2006) and Ms. Constance Phelps (Ex. 2007) describing general innovations of Patent Owner’s CapTel Service and its CapTel phone and their benefits to the deaf and hard of hearing community. PO Resp. 56–57. In an attempt to establish the requisite nexus, Patent Owner relies on a declaration of Mr. Ludwick (Ex. 2004) asserting that his expert declaration “explain[s], on a feature by feature basis, the nexus between those secondary considerations and the claimed design” and “illustrates, in chart form, that the CapTel system and various models of CapTel phones embody the claims of the present invention.” PO Resp. 56–57.

Patent Owner’s Response contains no substantive arguments. *Id.* at 55–57. Instead, Patent Owner merely lists various common forms of secondary considerations evidence, without exposition. This does not provide sufficient analysis for us to determine whether Patent Owner has provided adequate evidence of secondary considerations and a nexus between any such evidence and the merits of the claimed invention. Thus, Patent Owner’s broad contentions regarding secondary considerations in its Patent Owner Response do not demonstrate nonobviousness.

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Moreover, Patent Owner's declarations fail to establish a nexus between the merits of the claimed invention and the evidence of secondary considerations. To show a nexus, Patent Owner relies on Mr. Ludwick's declaration, which describes his visit to CapTel, Inc.'s relay center in Madison, Wisconsin. Ex. 2004 ¶ 54. Mr. Ludwick's chart presents his conclusions based on personal observation that the CapTel Service meets each claim limitation of the '104 patent. Ex. 2004 ¶ 55 (pp. 47–50). For example, regarding “the system connected such that if the call assistant repeats the words spoken by the hearing user, the digital text stream created by the relay causes the words spoken by the hearing user to appear on the display of the captioned telephone device,” recited in claim 1, Mr. Ludwick asserts:

I personally observed that the CapTel Service meets this claim element. During my visit to the CapTel relay, I saw call assistants repeat hearing user's words, which resulted in captions displaying on CapTel Phones. This aspect of the relay system is included when the Service is used with each of the CapTel Phones and has always been included as part of the CapTel Service.

Ex. 2004 ¶ 55 (p. 48).

Because Mr. Ludwick's conclusions are based on personal observations, without sufficient supporting facts or data, his testimony has little probative value. *See Am. Acad. of Sci.*, 367 F.3d at 1368 (“[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.”); *see also* Fed. R. Evid. 702 (providing one may testify in the form of an opinion if the testimony is based on sufficient facts or data). As such, Mr. Ludwick's conclusory assertions do not provide a sufficient

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connection between objective evidence and the claimed invention, and so do not establish the requisite nexus between the merits of the claimed invention and the evidence of secondary considerations.

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

### III. CONCLUSION

Based on the evidence and arguments, Petitioner has demonstrated by a preponderance of the evidence that claims 1 and 2 of the '104 patent are unpatentable under 35 U.S.C. § 103(a) for obviousness over Ryan and McLaughlin.

### IV. ORDER

Accordingly, it is:

ORDERED that claims 1 and 2 of U.S. Patent No. 7,555,104 B2 are unpatentable; and

FURTHER ORDERED that Patent Owner's Motion to Exclude Mr. Occhiogrosso's testimony is *denied*.

This is a final decision. Parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CAPTIONCALL, L.L.C.,  
Petitioner,

v.

ULTRATEC, INC.,  
Patent Owner.

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Case IPR2013-00543  
Patent 7,555,104 B2

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

PETTIGREW, *Administrative Patent Judge*.

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

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## I. INTRODUCTION

Petitioner, CaptionCall, L.L.C., filed a Petition requesting an *inter partes* review of claims 1 and 2 of U.S. Patent No. 7,555,104 B2 (Ex. 1002, “the ’104 patent”). Paper 1 (“Pet.”). We instituted an *inter partes* review for claims 1 and 2. Paper 6. In our Final Written Decision, we determined that Petitioner had shown, by a preponderance of the evidence, that claims 1 and 2 were unpatentable. Paper 66 (“Final Dec.” or “Final Decision”). Patent Owner, Ultratec, Inc., requests a rehearing of the Final Decision by an expanded panel. Paper 67 (“Req.” or “Request”). Having considered Patent Owner’s Request, we grant the Request for Rehearing for the limited purpose of modifying our analysis regarding the rationale for combining the Ryan and McLaughlin references. We deny the Request for Rehearing in all other respects.

## II. DISCUSSION

The party challenging a decision in a request for rehearing bears the burden of showing the decision should be modified. 37 C.F.R. § 42.71(d). A request for rehearing “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed.” *Id.*

### A. *Combination of Ryan and McLaughlin*

In its Request for Rehearing, Patent Owner contends we misapprehended the law regarding motivation to combine references in our discussion of obviousness of claims 1 and 2 of the ’104 patent based on



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Ryan<sup>1</sup> and McLaughlin.<sup>2</sup> Req. 1–3. Patent Owner also contends we misapprehended the law regarding “teaching away” and overlooked arguments why a person of ordinary skill in the art would not have considered McLaughlin. *Id.* at 3–8. Although we disagree that we misapprehended the law or overlooked arguments, we grant Patent Owner’s request for the purpose of modifying our analysis (Final Dec. 23–25) as described below. As in our Final Decision, we conclude that Petitioner has articulated sufficient reasoning with some rational underpinning to support the legal conclusion that the subject matter of the claims would have been obvious to one of ordinary skill in the art in view of the teachings of Ryan and McLaughlin. *See KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007); Reply 11–13; Ex. 1036 ¶¶ 53–55. The remainder of this section replaces Section II.D.3.d at pages 23–25 of the Final Decision.

McLaughlin teaches a captioned telephone device configured to connect to a relay. McLaughlin, however, does not teach re-voicing the remote user’s words at the relay using voice recognition software trained to the voice of the call assistant, as recited in the claims. Instead, McLaughlin describes a relay service in which a call assistant or automated equipment mediates telephone calls between a speaking person and a deaf person. Ex. 1012, 29:20–22. McLaughlin also identifies computerized speech recognition as one type of automated equipment for translating voice to text, although McLaughlin acknowledges the limitations of speech recognition software in recognizing certain kinds of speech, including conversational speech. *Id.* at 26:59–62.

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<sup>1</sup> U.S. Patent No. 5,809,112, issued Sept. 15, 1998 (Ex. 1005).

<sup>2</sup> U.S. Patent No. 6,181,736 B1, issued Jan. 30, 2001 (Ex. 1012).

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Ryan teaches using speech recognition software to automate the relay function. Ex. 1005, 4:19–28. According to Mr. Occhiogrosso, whose testimony we credit on this point, it was well known in the field of speech recognition at the time of the invention that speaker-dependent speech recognition (e.g., trained to the voice of a particular speaker) performed better than untrained, speaker-independent speech recognition. Ex. 1019 ¶¶ 23, 25; Ex. 1036 ¶ 55. This is reflected in Ryan’s teaching that the accuracy of a relay that uses speech recognition software may be improved if a call assistant re-voices the remote user’s words into a terminal with voice recognition software designed to recognize the call assistant’s voice. Ex. 1005, 4:33–38.

Thus, McLaughlin teaches the use of automated equipment at a relay, Ex. 1009, 29:20–22, and Ryan teaches a computer with speech recognition software as one form of automated equipment that can be used at a relay, Ex. 1005, 4:33–38. McLaughlin also notes the use of computerized speech recognition in another context, i.e., translation of voice mail messages from voice to text. Ex. 1012, 26:59–62. A person of ordinary skill in the art would have recognized that Ryan’s intermediate re-voicing solution—using voice recognition software trained to the voice of a call assistant at a relay—would address the shortcomings of applying voice recognition directly to a remote caller’s voice, acknowledged by McLaughlin. *See* Ex. 1036 ¶ 55. As Mr. Occhiogrosso explains, combining the teachings of Ryan and McLaughlin to achieve the claimed invention involves nothing more than directing the captioned telephone device of McLaughlin to connect to a re-voicing relay, as taught in Ryan, rather than a conventional relay. Ex. 1036 ¶ 54; *see* Reply 12. For these reasons, we are persuaded that a person of

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ordinary skill in the art would have combined the teachings of Ryan and McLaughlin, using Ryan's re-voicing relay in place of McLaughlin's relay, along with McLaughlin's captioned telephone device.

Patent Owner contends that one of ordinary skill in the art would not have considered Ryan when developing the relay system of the '104 patent "because the bulk of the disclosure of Ryan was nothing more than the known TDD architecture."<sup>3</sup> Paper 20, 49–51 ("PO Resp."). Patent Owner further contends that one of ordinary skill in the art would not have considered McLaughlin because not all relay services and users had simultaneous voice and data (SVD) modems like those used in McLaughlin's system. *Id.* at 52. Patent Owner also contends that one of ordinary skill in the art would not have wanted to use McLaughlin's "specialized equipment" in a relay like that taught by Ryan because such an arrangement would require an expensive overhaul of Ryan's system. *Id.* at 45. These arguments focus on isolated teachings of the references, rather than whether the claimed subject matter as a whole would have been obvious to one of ordinary skill in the art in view of the combined teachings of the references. *See* 35 U.S.C. § 103(a); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). Furthermore, an obviousness determination does not require an actual, physical substitution of elements, but instead focuses on what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012); *Keller*, 642 F.2d at 425. As discussed, we are persuaded that a person of ordinary skill in the art would have combined the *teachings* of Ryan and McLaughlin in the manner proposed by Petitioner.

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<sup>3</sup> "TDD" stands for "Telecommunication device for the deaf." Final Dec. 3.

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Patent Owner argues further that one of ordinary skill in the art would not have considered McLaughlin because it is directed to an internal company telephone system rather than the functionality of a relay service. PO Resp. 52. Patent Owner, however, has not cited persuasive evidence that McLaughlin's teachings are limited to an intra-company system. *See id.* In addition, Patent Owner argues that McLaughlin discloses connecting to a traditional, text-only TDD-based relay, and any increased speed offered by adding re-voicing and voice recognition would not have met an important design incentive for true TDD-based relay. *Id.* at 53. Patent Owner, however, does not identify specifically what "design incentive" would not be met, asserting only that deaf users are not concerned with the speed of captions. *Id.* We are not persuaded this is a reason a person of ordinary skill in the art would not have considered McLaughlin when developing the relay system of the '104 patent.

Finally, Patent Owner argues that McLaughlin teaches away from the use of trained voice recognition software. *Id.* at 54–55. In particular, Patent Owner submits that McLaughlin acknowledges the shortcomings of automated speech recognition technology and, therefore, would have discouraged one of ordinary skill in the art from attempting to design the relay claimed in the '104 patent. *Id.* at 54 (citing Ex. 1012, 26:54–62). McLaughlin, however, refers to the limitations of speech recognition in the context of translating voice mail messages to text for deaf users, not in connection with relay services discussed in another section of McLaughlin. *See* Ex. 1012, 26:54–62. Moreover, as discussed previously, we credit the testimony of Mr. Occhiogrosso that it was well known in the field of speech recognition at the time of the invention that speaker-dependent speech

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recognition (e.g., trained to the voice of a particular speaker), such as that used in Ryan’s re-voicing technique, performed better than untrained, speaker-independent speech recognition, such as would be used in the voice mail application described in McLaughlin. *See* Ex. 1019 ¶¶ 23, 25; Ex. 1036 ¶ 55. On the facts presented here, we are not persuaded that McLaughlin’s statement regarding limitations of speech recognition technology sufficiently teaches away from the combination of Ryan’s re-voicing scheme with McLaughlin’s relay system to establish nonobviousness. *See In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

### *B. Claim Construction*

Because the parties articulated different views on how “trained to the voice of the call assistant” should be interpreted relative to the asserted prior art, we analyzed Patent Owner’s implied constructions of the term and Patent Owner’s declarant’s testimony concerning the same. Final Dec. 8–10. In its Request for Rehearing, Patent Owner argues that we “misapprehended claim construction law” in determining software “trained to the voice of the call assistant” was not limited to training to the voice of one and only one particular call assistant and did not preclude voice recognition software that is designed or built in advance of implementation at the source code level to the voice of a call assistant. Req. 8–12.

First, Patent Owner contends that we erroneously relied on the disclosure in the ’104 patent of “voice pattern.” *Id.* at 8–11. We disagree that our reliance on the “Brief Summary of the Invention,” which refers to “a speech recognition computer program which has been trained to the voice *pattern* of the call assistant,” was improper. *See* Final Dec. 8–9 (quoting Ex. 1002, 2:54–56 (emphasis added)). Rather, in our Final Decision, we

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determined that the '104 patent contemplated software trained to a “voice *pattern* of the call assistant,” as set forth in the “Brief Summary of the Invention,” as well as software “specifically trained to the voice of [a] *particular* call assistant,” as described in the context of a particular relay embodiment shown in Figure 1. Final Dec. 9 (quoting Ex. 1002, 2:54–56, 6:17–20).

Based on the evidence in the written description (including the disclosure of “voice pattern”), we determined that the '104 patent did not indicate expressly how training occurs. *Id.* Giving the claim language its broadest reasonable construction in light of the specification, we concluded we would not limit “trained to the voice of the call assistant” to require training to the voice of one particular call assistant. *Id.*

We turn next to Patent Owner’s argument in its Request for Rehearing that we erred in concluding that “trained to the voice of the call assistant” does not include a temporal constraint that precludes voice recognition software that is designed or built in advance of implementation at the source code level to the voice pattern of a call assistant. Req. 12 (citing Final Dec. 9–10). Patent Owner asserts that we overlooked an alleged admission at the Hearing by Petitioner that the claim language inherently includes a temporal constraint that precludes training when the software is designed in advance of implementation at the source code level. Req. 12 (citing Paper 65 (Hearing Transcript), 17:3–5). We are not persuaded that we did so. Rather, we considered Petitioner’s statement at the Hearing in light of the evidence of record.

In our Final Decision, we determined that the written description discloses that the voice recognition software package is trained but does not

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indicate when or how the training occurs. Final Dec. 9. We rejected Patent Owner's argument, relying on its declarant, that software "designed" is not software that is "trained to recognize individual voices" because we found insufficient support for Patent Owner's contention. *Id.* (citing PO Resp. 27–28). As we explained in our Final Decision, Patent Owner's declarant testified that a person of ordinary skill in the art would not have understood "trained" software to include "designed" software because technology to train software to recognize individual voices did not exist in 1994 and was not used in telecommunications relay service at that time. *Id.* (citing PO Resp. 27–28; Ex. 2001 ¶ 32; Ex. 2003 ¶¶ 19, 21–26). We weighed this testimony, which relied on capabilities of technology available in 1994, and concluded this testimony had little probative value of the understanding of one of ordinary skill in the art at the time of invention because the earliest date of invention for claims of the '104 patent was 2001. *Id.*

Moreover, Petitioner's declarant indicates that one of ordinary skill in the art would have understood that Ryan describes speech recognition software trained to the voice of a call assistant. Ex. 1036 ¶¶ 44–45. The testimony of Petitioner's declarant is supported further by prior art of record that indicates voice recognition software trained to a particular user in relay systems was known. *See id.* ¶ 45 (citing Ex. 1009, 4:37–49). This testimony further undermines Patent Owner's position.

Thus, we do not agree with Patent Owner that we erred by not considering Petitioner's purported "admission" made at the Hearing. Rather, we considered Petitioner's statement in determining that Ryan's description of benefits provided by voice recognition software that "is specifically designed to recognize the voice of particular relay agents" (Ex. 1005, 4:33–

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38) discloses the trained software recited in both claims of the '104 patent. *See* Final Dec. 20–23.

For the reasons given, we are not persuaded that we misapprehended claim construction law in our construction of “trained to the voice of the call assistant.”

### *C. Secondary Considerations*

Patent Owner alleges that we improperly made a determination of obviousness before separately analyzing Patent Owner’s evidence of secondary considerations. Req. 14. We disagree. Rather, in Section II.D of our Final Decision, we determined the scope and content of the asserted prior art (Final Dec. 15–17); discussed the claimed subject matter relative to the asserted prior art, which included identifying differences between the claimed subject matter and the prior art in the context of the ordinary level of skill in the art (Final Dec. 18–23); determined Petitioner, with support of its declarant, had articulated sufficient reasoning to support a conclusion of obviousness based on the combined references (Final Dec. 23–25); and analyzed Patent Owner’s secondary considerations of nonobviousness (Final Dec. 25–28). *See KSR*, 550 U.S. at 418; *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). Only after that fourteen-page discussion in Section II.D did we discuss the ultimate conclusion of obviousness of the claimed subject matter by weighing the evidence on both sides:

Accordingly, Patent Owner fails to provide sufficient credible evidence to support its allegations of nonobviousness based on secondary considerations. When we balance Petitioner’s evidence of obviousness against Patent Owner’s asserted objective evidence of nonobviousness, we determine that a preponderance of the evidence supports Petitioner’s



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position that claims 1 and 2 would have been obvious over Ryan and McLaughlin.

Final Dec. 28.

Patent Owner further contends we refused to consider Patent Owner's secondary considerations evidence. Req. 14. This is incorrect. We considered the arguments and evidence presented in Patent Owner's Response. Final Dec. 26. We concluded Patent Owner did "not provide sufficient analysis for us to determine whether Patent Owner has provided adequate evidence of secondary considerations and a nexus between any such evidence and the merits of the claimed invention." *Id.*

In its Request, Patent Owner seems to suggest that we should have reviewed and analyzed the entirety of each of three declarations submitted by Patent Owner in support of its secondary considerations contention (Exs. 2004, 2006, and 2007). Req. 14–15. This also is incorrect because, in its Patent Owner Response, Patent Owner merely cited each declaration in its entirety without citing with particularity portions of these declarations. PO Resp. 56 (citing "declarations by Brenda Battat (Ex. 2006) and Constance Phelps (Ex. 2007)" and "declaration of Paul Ludwick (Ex. 2004)"). We will not scour the 155 pages of declaration evidence submitted by Patent Owner and generally serve as an advocate for Patent Owner by finding evidence of secondary considerations in the voluminous exhibits submitted. *Cf. DeSilva v. DiLeonardi*, 181 F.3d 865, 866–67 (7th Cir. 1999) ("A brief must make all arguments accessible to the judges, rather than ask them to play archaeologist with the record."); *Ernst Haas Studio, Inc. v. Palm Press, Inc.*, 164 F.3d 110, 111–12 (2d Cir. 1999) ("Appellant's Brief is at best an invitation to the court to scour the record, research any

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legal theory that comes to mind, and serve generally as an advocate for appellant. We decline the invitation.”).

#### *D. Panel Composition*

Patent Owner requests rehearing before an expanded panel and additionally asserts we exceeded our authority by issuing a Final Written Decision that did not include a judge that was on the panel of administrative patent judges who decided to institute the review. Req. 1, 12–14. Panel composition for an *inter partes* review is specified in 35 U.S.C. § 6(c), which states “[e]ach . . . inter partes review shall be heard by at least 3 members of the Patent Trial and Appeal Board, who shall be designated by the Director.” The Director’s authority under 35 U.S.C. § 6 to designate panels has been delegated to the Chief Judge. *See* Patent Trial and Appeal Board Standard Operating Procedure 1 (Rev. 14) (May 8, 2015) (“PTAB SOP 1”).

As acknowledged by Patent Owner (Req. 13), the Final Decision was decided by three administrative patent judges, who are members of the Board. *See* 35 U.S.C. § 6(a) (indicating that administrative patent judges, along with various members of the United States Patent and Trademark Office, constitute the Patent Trial and Appeal Board). The three administrative patent judges were designated by the Chief Judge according to PTAB SOP 1, titled “Assignment of Judges to Merits Panels, Interlocutory Panels, and Expanded Panels.” The Board, therefore, complied with the statutory requirements for panel composition. Accordingly, we did not issue the Final Decision with less than a “full panel,” as Patent Owner contends.

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

Patent Owner suggests an expanded panel is warranted to decide the Request in view of the panel composition and various allegations that we misapprehended the law. Req. 1. For the reasons given, Patent Owner does not persuade us that we misapprehended the law or the panel of three judges was deficient. Further, the Board’s procedures provide examples of reasons for expanding a panel, none of which apply here. PTAB SOP 1 at 3 (§ III.A). For example, an expanded panel may be appropriate when “serious questions have been raised about the continuing viability of an apparently applicable precedential decision of the Board, or a panel of the Board renders a decision that conflicts with a precedential decision of the Board or an authoritative decision of the Board’s reviewing courts.” *Id.* Patent Owner’s Request does not show a conflict or other reason that weighs in favor of panel expansion. Even so, the panel informed the Chief Judge, who has authority to expand a panel, of Patent Owner’s request, and the Chief Judge declined to expand the panel. See PTAB SOP 1 at 4 (§ III.C). (“The Chief Judge will determine when an expanded panel is to be

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designated.”); *see also Apple Inc. v. Rensselaer Polytechnic Inst.*,

Case IPR2014-00319, slip op. at 2 n.1 (PTAB Dec. 12, 2014) (Paper 20)

(indicating only the Chief Judge, acting on behalf of the Director, may act to expand a panel and panels do not authorize panel expansion).

### III. ORDER

For the reasons given, it is

ORDERED that Patent Owner’s Request for Rehearing is *granted* for the limited purpose of modifying our analysis regarding the rationale for combining Ryan and McLaughlin as explained herein;

FURTHER ORDERED that Patent Owner’s Request for Rehearing is *denied* in all other respects; and

FURTHER ORDERED that, as determined in our Final Decision, claims 1 and 2 of U.S. Patent No. 7,555,104 B2 are unpatentable.

IPR2013-00543  
Patent 7,555,104 B2

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Paper 87  
Entered: April 10, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CAPTIONCALL, L.L.C.,  
Petitioner,

v.

ULTRATEC, INC.,  
Patent Owner.

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Cases

IPR2013-00540 (Patent 6,233,314 B1)  
IPR2013-00541 (Patent 5,909,482)  
IPR2013-00542 (Patent 7,319,740 B2)  
IPR2013-00543 (Patent 7,555,104 B2)  
IPR2013-00544 (Patent 8,213,578 B2)  
IPR2013-00545 (Patent 6,594,346 B2)  
IPR2013-00549 (Patent 6,603,835 B2)  
IPR2013-00550 (Patent 7,003,082 B2)  
IPR2014-00780 (Patent 6,603,835 B2)

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

PER CURIAM.

DECISION ON REMAND  
*35 U.S.C. § 318(a); 35 U.S.C. § 144*

IPR2013-00540 (Patent 6,233,314) IPR2013-00541 (Patent 5,909,482)  
 IPR2013-00542 (Patent 7,319,740) IPR2013-00543 (Patent 7,555,104)  
 IPR2013-00544 (Patent 8,213,578) IPR2013-00545 (Patent 6,594,346)  
 IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
 IPR2014-00780 (Patent 6,603,835)

## II. ANALYSIS

As mentioned above, Patent Owner alleges that Petitioner’s expert, Mr. Occhiogrosso, gave inconsistent testimony regarding the McLaughlin, Ryan, and Yamamoto references. We first address the testimony regarding McLaughlin, then the testimony regarding Ryan’s disclosure on voice recognition software, and finally the testimony regarding software location, the latter of which involves Ryan and Yamamoto.

### A. Testimony Regarding McLaughlin

Patent Owner states that “[a] central issue in these proceedings is whether *McLaughlin* discloses a captioned telephone device that provides both voice and text.” PO Br. 12. Patent Owner states that, in IPR550, we “relied on Occhiogrosso’s testimony that *McLaughlin* disclosed all of the claim elements in a ‘single system.’” *Id.* at 13. That the claim elements be disclosed in a single system is relevant because our holding in IPR550 is one of anticipation.<sup>4</sup> According to Patent Owner, Mr. Occhiogrosso testified

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<sup>4</sup> Anticipation prohibits the combination of distinct embodiments of a single reference. *See, e.g., Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008) (“[I]t is not enough that the prior art reference . . . includes multiple, distinct teachings that [an ordinary] artisan might somehow combine to achieve the claimed invention.”). Our analysis in the Final Written Decision in IPR550 uses the phrase “single system,” which should be understood to mean a disclosure describing a device arranged as claimed, sufficient for purposes of anticipation. IPR550, Paper 57, 20 (“McLaughlin’s disclosure . . . is describing options for a single system, not separate embodiments.”); *see also Net MoneyIN*, 545 F.3d at 1369 n.5 (“[C]ourts are not constrained to proceed example-by-example when

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IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
IPR2014-00780 (Patent 6,603,835)

before us that McLaughlin disclosed a single system described in multiple sections of McLaughlin’s specification, but “undermined that position at [the district court] trial.” *Id.* at 15; *see also id.* at 18–19 (listing the three passages Patent Owner believes support its position). Patent Owner concludes that Mr. Occhiogrosso cited to different sections of McLaughlin as if they disclosed a single system before us, but allegedly testified that they were different at the district court trial. *Id.* at 20.

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reviewing an allegedly anticipating prior art reference. Rather, the court must, while looking at the reference as a whole, conclude whether or not that reference discloses all elements of the claimed invention arranged as in the claim.”). Further, we distinguish between the features of a single system (i.e., a collection of components that operate together) and the features housed inside a single, contiguous box. In our Final Written Decision in IPR550, when we construed “captioned telephone device,” we noted that the specification of the ’082 patent made clear that various features of the device could be located in separate physical structures. IPR550, Paper 57, 9 (pointing out that the audio function may be separate from the text function (citing Ex. 1001, 9:20–32, 9:15–20, 10:67–11:3, and Figs. 4–6)). We reiterated that position in our Decision on Rehearing. IPR550, Paper 59, 4 (“[T]here was no requirement for all features of the claims to be found in one housing or a ‘single device.’”). Thus, when we say McLaughlin discloses a “single system,” we mean that McLaughlin discloses a collection of components that operate together. Contrary to Patent Owner’s allegations, we are not referring to the combination of multiple *embodiments*. *See* PO Br. 23–24. This distinction is relevant because in our Final Decision, the testimony of Mr. Occhiogrosso, and the arguments of Patent Owner may each use the word “system” slightly differently in different contexts, and it is that context that must be considered to understand the meaning.



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 IPR2013-00544 (Patent 8,213,578) IPR2013-00545 (Patent 6,594,346)  
 IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
 IPR2014-00780 (Patent 6,603,835)

implications of this analysis on the Final Written Decisions in which we determined claims were unpatentable on grounds based at least in part on McLaughlin.

### 1. *Trial Testimony, Passage 1*

Patent Owner alleges that Mr. Occhiogrosso testified in district court that Section A of McLaughlin discloses a one-modem system while Section B discloses a two-modem system. PO Br. 18 (citing Ex. 2033, 39:19–40:8; Ex. 2032, 89:22–90:10). Petitioner responds that Mr. Occhiogrosso explains (at the portion immediately prior to Patent Owner’s cite) that he understands McLaughlin to be discussing the same device in those different sections. Pet. Br. 10–11 (citing Ex. 2032, 89:10–21). Reviewing these passages, it is clear to us that Mr. Occhiogrosso’s testimony is not inconsistent, and Patent Owner is only arguing semantics.

In the passage reproduced by Patent Owner at page 18 of its brief, Mr. Occhiogrosso is asked whether the Section A disclosure “is discussing a system in which the user *uses* one SVD modem.” Ex. 2033, 39:19–21 (emphasis added). Mr. Occhiogrosso answers in the affirmative. *Id.* at 39:22. Similarly, Mr. Occhiogrosso is asked about “the *use* of two SVD modems” in Section B, to which he answers in the affirmative again. *Id.* at 40:6–8 (emphasis added). The *use* of a system is different than its structure—a system must have at least the structure used, but it may have

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“Hearing/Speaking Persons Calling Deaf and/or Speech Impaired Persons.”  
 See *supra* Section I.A.2.

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IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
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other structures not used in that particular passage. There is nothing in the above testimony that indicates that Mr. Occhiogrosso believes that sections A and B describe separate embodiments having different numbers of modems; he merely describes how many modems are *used* by the system in each section. This is entirely consistent with his testimony throughout the district court trial that McLaughlin teaches a single system having many features:

Q. Do you know, as you're sitting there right now, whether this system disclosed in section b) *New Techniques For Hearing/Speaking Persons to Call . . . Deaf and/or Speech Impaired Persons*, do you know whether this section is disclosing a different system than the other two sections that you cited?

A. My understanding of the specification is it's a versatile device that is capable of operating in a number of configurations, so it was my interpretation of the specifications that it's the same device.

Ex. 2032, 89:10–21.

Q. And you can't tell me, as you sit here right now, whether you cited two different sections?

A. Oh, no. They're clearly different sections.

Q. Are they different systems?

A. I don't believe they're different systems. They're a system deployed in a different context, one in a LAN/WAN, one in a WAN with two SVD links connected to it. So I couldn't categorically say they're two different systems. I don't think that was your earlier question perhaps or maybe I misunderstood it.

*Id.* at 87:24–88:8.

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IPR2014-00780 (Patent 6,603,835)

Q. Do you understand -- do you have an understanding as to whether those are separate devices?

A. My understanding is it's an integrated device.

Q. An integrated device that what?

A. May have different operating modes.

Q. Would you turn, please, to page 006 of Exhibit 1913, which is column 3, lines 47 through 50? This is also a text in the McLaughlin patent?

A. Yes.

Q. Would you read that first sentence there in that paragraph?

A. "Different embodiments of the invention may include some but not others of the various modes and features."

Q. As a person of ordinary skill in the art, would you have read that section or that line before you read section 4?

A. Yes.

Ex. 2033, 24:3–19.

Q. This was a system in which there were two users who were connected directly to one another on a LAN or WAN connection, correct?

A. That's what's posited here, yes.

Q. So this is a different system than the system in section b) and a different system than the system in section a), correct?

A. No, I don't see that. In other words, to me it's another operating mode.

*Id.* at 40:19–41:2.

In IPR550, we based our finding that McLaughlin teaches a single system at least in part on Mr. Occhiogrosso's testimony before us, consistent

IPR2013-00540 (Patent 6,233,314) IPR2013-00541 (Patent 5,909,482)  
IPR2013-00542 (Patent 7,319,740) IPR2013-00543 (Patent 7,555,104)  
IPR2013-00544 (Patent 8,213,578) IPR2013-00545 (Patent 6,594,346)  
IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
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with his testimony before the district court, that McLaughlin teaches a single system having many features. IPR550, Paper 57, 20.

## 2. Trial Testimony, Passage 2

Patent Owner alleges that Mr. Occhiogrosso “admitted that the Section A one-modem system discloses a traditional [Voice Carry Over] call, which uses a one-line arrangement.” PO Br. 19 (citing Ex. 2032, 90:7–19). Petitioner correctly points out that Mr. Occhiogrosso was not asked about McLaughlin’s system here, but rather was asked a hypothetical question about a “traditional VCO call.” Pet. Br. 11. The relevant portion of the testimony is reproduced below:

Q. In a VCO call, *in a traditional VCO call*, that’s a one-line arrangement, correct?

A. Yes.

Q. So the deaf user is connected on one line to the relay, correct?

A. *In a traditional VCO*, yes.

Ex. 2032, 90:14–19 (emphasis added).

We find no admission here regarding McLaughlin; Patent Owner is attempting to re-characterize Mr. Occhiogrosso’s discussion of a hypothetical *traditional VCO* system into a discussion of McLaughlin’s system. As additional evidence that Mr. Occhiogrosso’s testimony is consistent, we note that Mr. Occhiogrosso also expresses confusion over Patent Owner’s attempts to conflate McLaughlin’s disclosure of the “use” of certain components of the system in different sections with disclosures of multiple systems. When asked whether Section A “only us[es] one SVD

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IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
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modem,” Mr. Occhiogrosso responds that the singular word is used, but then expresses confusion as to why Patent Owner thinks this is important. Mr. Occhiogrosso responds that the use of a single modem does not mean that there are not more modems, and pushes back on Patent Owner’s attempts to elicit a different response. The entire discussion is reproduced below:

Q. Do you know, as you’re sitting there right now, whether this system disclosed in section b) *New Techniques For Hearing/Speaking Persons to Call . . . Deaf and/or Speech Impaired Persons*, do you know whether this section is disclosing a different system than the other two sections that you cited?

A. My understanding of the specification is it’s a versatile device that is capable of operating in a number of configurations, so it was my interpretation of the specifications that it's the same device.

Q. Okay. We just talked about how, in section a) *VCO/HCO With SVD Modems*, that system uses a relay. And then I think you agreed, over on column 33, the section c) *New Techniques For VCO/HCO Access*, that system does not use a relay, correct?

A. Correct.

Q. Now, let’s compare that with section a) in column 29, *VCO/HCO With SVD Modems*. That section discloses the user is only using one SVD modem; isn’t that correct?

A. I see it is singular word, “a SVD modem.” But I fail to, what’s the word I’m looking for, appreciate the depth of your question; in other words, what’s the big deal to equip the device with one or two modems.

Q. In a VCO call, in a traditional VCO call, that’s a one-line arrangement, correct?

A. Yes.

IPR2013-00540 (Patent 6,233,314) IPR2013-00541 (Patent 5,909,482)  
IPR2013-00542 (Patent 7,319,740) IPR2013-00543 (Patent 7,555,104)  
IPR2013-00544 (Patent 8,213,578) IPR2013-00545 (Patent 6,594,346)  
IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
IPR2014-00780 (Patent 6,603,835)

Q. So the deaf user is connected on one line to the relay, correct?

A. In a traditional VCO, yes.

Q. So doesn't that inform us here that when McLaughlin is talking about a VCO call, he's talking about one connection and therefore one SVD modem?

A. I suppose you could have the two-line architecture still talk to the relay.

Q. That's not what McLaughlin says in section a) though, correct?

A. He really doesn't say. Where do you see where he says that?

Ex. 2032, 89:10–91:3.

Taking this discussion in context, Mr. Occhiogrosso testifies that the specification describes “the same device,” and then is asked about whether the device uses various components in various modes, to which Mr. Occhiogrosso answers in a manner consistent with his “same device” opinion. Mr. Occhiogrosso does not understand “what’s the big deal” with one or two modems because *using* a certain number of modems in one mode is different from *having* a certain number of modems.<sup>6</sup> Mr. Occhiogrosso later clarifies this when he responds that use of the VCO mode would only require one of the two modems (“I suppose you could have the two-line architecture still talk to the relay.”). In sum, the testimony of Mr.

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<sup>6</sup> Patent Owner argues that this “what’s the big deal” statement undermines Mr. Occhiogrosso’s position (PO Br. 21), but Patent Owner again conflates the description of a device using certain components with a device being limited only to those components, and also conflates Mr. Occhiogrosso’s confusion with Patent Owner’s questions with lack of understanding the technology.

IPR2013-00540 (Patent 6,233,314) IPR2013-00541 (Patent 5,909,482)  
IPR2013-00542 (Patent 7,319,740) IPR2013-00543 (Patent 7,555,104)  
IPR2013-00544 (Patent 8,213,578) IPR2013-00545 (Patent 6,594,346)  
IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
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Occhiogrosso is that McLaughlin discloses a single device and, in his opinion, the silence of McLaughlin as to what to do with an unused modem in one mode that does not need that modem is not itself important.

### 3. *Trial Testimony, Passage 3*

Patent Owner alleges “Occhiogrosso admitted that Section A and Section C disclose ‘different systems’ because one discloses a relay and one does not.” PO Br. 19 (citing Ex. 2032, 88:9–15). Petitioner responds that Occhiogrosso makes clear, immediately prior to Patent Owner’s cited portion of the testimony, that he does not believe they are independent embodiments but rather different sections addressing the features of a multi-featured system. Pet. Br. 13–14. We reproduce the testimony cited by both parties below:

Q. And you can’t tell me, as you sit here right now, whether you cited two different sections?

A. Oh, no. They’re clearly different sections.

Q. Are they different systems?

A. I don’t believe they’re different systems. They’re a system deployed in a different context, one in a LAN/WAN, one in a WAN with two SVD links connected to it. So I couldn’t categorically say they’re two different systems. I don’t think that was your earlier question perhaps or maybe I misunderstood it.

Q. Does the system spanning -- that’s described in the paragraph spanning column 29 to 30 use a relay?

A. Yes.

Q. So looking back to your slide, this morning you cited two different systems, one that uses a relay and one that doesn’t, correct?

IPR2013-00540 (Patent 6,233,314) IPR2013-00541 (Patent 5,909,482)  
IPR2013-00542 (Patent 7,319,740) IPR2013-00543 (Patent 7,555,104)  
IPR2013-00544 (Patent 8,213,578) IPR2013-00545 (Patent 6,594,346)  
IPR2013-00549 (Patent 6,603,835) IPR2013-00550 (Patent 7,003,082)  
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A. I would have to say you are correct.

...

Q. Let's turn to McLaughlin and look at where those citations fall. Let's just start with column 31, line 43 to 47. And then let's trace back up column 31 and back up column 30 to column 30, lines 13 to 14. Do you see that your citations on this slide are to yet a third different system disclosed in McLaughlin?

A. What makes you believe this is a third different system?

Q. Do you know, as you're sitting there right now, whether this system disclosed in section b) *New Techniques For Hearing/Speaking Persons to Call . . . Deaf and/or Speech Impaired Persons*, do you know whether this section is disclosing a different system than the other two sections that you cited?

A. My understanding of the specification is it's a versatile device that is capable of operating in a number of configurations, so it was my interpretation of the specifications that it's the same device.

Ex. 2032, 87:24–89:21.

Just as in the prior passages, Mr. Occhiogrosso is consistent in his testimony that McLaughlin discloses a single system that uses the appropriate components when operating in different contexts. The testimony regarding “one [system] that uses a relay and one that doesn't” is not inconsistent with his position because Mr. Occhiogrosso is again testifying as to which components are *used*. That Mr. Occhiogrosso uses the word “system” as a stand-in for what he had previously called “context[s]” is merely arguing semantics. The substance of what Mr. Occhiogrosso is saying is clear based on the surrounding testimony, where he states that McLaughlin discloses a system having multiple features. *E.g.*, Ex. 2032,



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18–21 (“My understanding of the specification is it’s a versatile device that is capable of operating in a number of configurations, so it was my interpretation of the specifications that it’s the same device.”). That Mr. Occhiogrosso possibly used a word imprecisely once during the day of oral testimony does not change his repeated statements that McLaughlin has a single device having certain features, even if some of them are not described as being used at the same time as other features.

#### 4. *Conclusion on Occhiogrosso’s Testimony Regarding McLaughlin*

Reviewing the arguments and evidence before us, we find that Mr. Occhiogrosso provided consistent testimony regarding McLaughlin in the district court and before us in the IPRs. Thus, we find that his testimony before us remains credible with regard to McLaughlin. Furthermore, contrary to Patent Owner’s arguments, we explain below why any alleged inconsistencies, even if they existed, do not impact the Final Written Decisions in IPR542, IPR543, IPR544, and IPR550, the only decisions addressing grounds based on McLaughlin.

##### *a. IPR2013-00542, IPR2013-00543, and IPR2013-00544*

In our Final Written Decisions in IPR542, IPR543, and IPR544, we determined that claims 1 and 2 of the ’740 patent, claims 1 and 2 of the ’104 patent, and claims 8–11 of the ’578 patent are unpatentable as obvious over the combination of McLaughlin and Ryan. IPR542, Paper 66, 29; IPR543, Paper 66, 28; IPR544, Paper 74, 54.<sup>7</sup> In each of these decisions, we

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<sup>7</sup> On rehearing, we modified our analysis regarding the rationale for

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Entered: March 3, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CAPTIONCALL, LLC,  
Petitioner,

v.

ULTRATEC, INC.,  
Patent Owner

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Case IPR2013-00550  
Patent 7,003,082 B2

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

SAINDON, *Administrative Patent Judge*.

DECISION

Final Written Decision  
*35 U.S.C. § 318(a) and 37 C.F.R. § 42.73*

IPR2013-00550  
US 7,003,082 B2

## I. INTRODUCTION

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a).

With respect to the grounds asserted in this trial, we have considered the papers submitted by the parties and the evidence cited therein. For the reasons discussed below, we determine that Petitioner has shown, by a preponderance of the evidence, that the subject matter of claim 1 of U.S. Patent No. 7,003,082 B2 (Ex. 1021, “the ’082 patent”) is unpatentable.

### A. Procedural History

CaptionCall, LLC (“Petitioner”) filed a Petition requesting an *inter partes* review of claim 1 of the ’082 patent. Paper 1 (“Pet.”). Petitioner included a Declaration of Mr. Benedict J. Occhiogrosso. Ex. 1010. Ultratec, Inc. (“Patent Owner”) did not file a Preliminary Response to the Petition.

In our Decision Instituting *Inter Partes* Review, we granted review as to claim 1 of the ’082 patent. Paper 6 (“Inst. Dec.”). Patent Owner filed a Response to the Petition (Paper 19, “PO Resp.”), which included a declaration by Mr. James A. Steel, Jr. (Ex. 2001). Petitioner filed a Reply to the Response (Paper 23, “Pet. Reply”), which included a Supplemental Declaration of Mr. Occhiogrosso (Ex. 1030).

On November 19, 2014, all parties were present for an oral hearing.

This Decision includes our decision on Patent Owner’s Motion to Exclude Evidence (Occhiogrosso) (Paper 30, “PO Mot. Excl.”). Petitioner filed an opposition to Patent Owner’s motion (Paper 36, “Pet. Opp. Mot. Excl.”), and Patent Owner filed a reply (Paper 37, “PO Reply Mot. Excl.”).

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### *B. Related Matters*

Petitioner stated that, at the time it filed the Petition, the '082 patent was asserted against its parent company, Sorenson Communications, Inc., in *Ultratec, Inc. v. Sorenson Communications, Inc.*, No. 13-CV-00346 (W.D. Wis.). Pet. 2–3. Petitioner stated that the lawsuit includes certain other patents asserted against its parent company and that Petitioner has filed concurrently other petitions for *inter partes* review. *Id.*

The concurrently filed petitions are as follows:

Case	Patent
IPR2013-00540	US 6,233,314
IPR2013-00541	US 5,909,482
IPR2013-00542	US 7,319,740
IPR2013-00543	US 7,555,104
IPR2013-00544	US 8,213,578
IPR2013-00545	US 6,594,346
IPR2013-00549	US 6,603,835

### *C. Technology Background*

A teletype (TTY), or telecommunications device for the deaf (TDD), is a device having a keyboard and display that permits a deaf person to communicate over telephone lines. Ex. 1021 at 1:33–43. If the deaf person is to communicate with a hearing person, a relay service is utilized. With a relay service, a relay operator voices the deaf user's typed words to the hearing user, and types the hearing user's voiced words to the deaf person's TTY. *Id.* at 1:64–2:13. Traditionally, the relay service maintains a separate telephone connection with both the hearing and assisted users, with the relay service acting, as the name implies, as a relay. A traditional relay service is

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found in Figure 2 of U.S. Patent No. 5,724,405 (Ex. 1005, “Engelke ’405 patent”). Figure 2 of Engelke ’405 is depicted below:

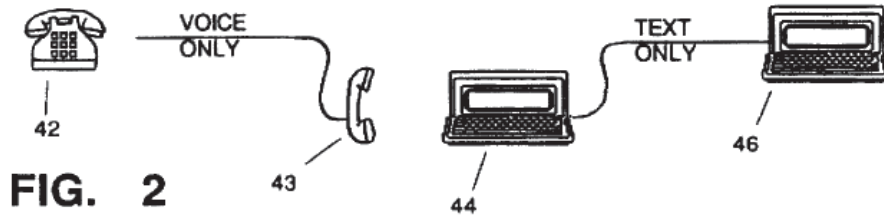


Figure 2 of Engelke ’405 depicts a traditional relay service arrangement in which a hearing caller speaks with a relay operator over one telephone line while the relay operator types back and forth with the assisted user over a second telephone line, using a TTY machine. Ex. 1005, 6:11–14.

*D. The ’082 Patent*

The ’082 patent describes another way to provide a relay service. In particular, the ’082 patent describes two separate connections: one between the assisted and non-assisted user, and one between the assisted user and the relay service. Ex. 1021, 9:33–43, Fig. 5. Figure 5 depicts this arrangement:

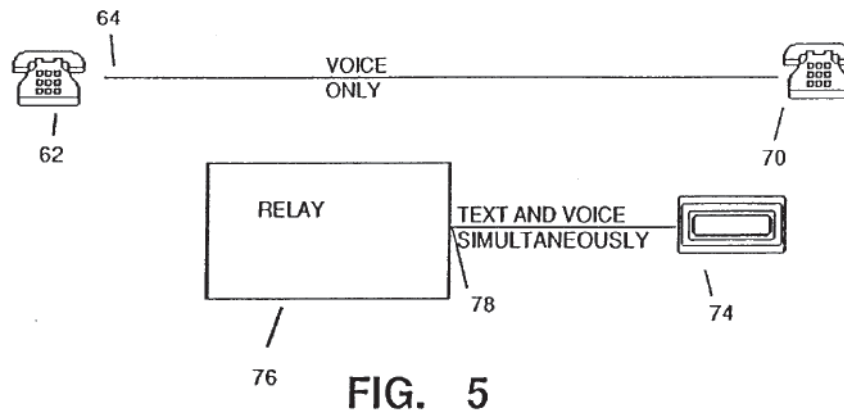


Figure 5 of the ’082 patent depicts a typical, voice-only connection between the hearing user and assisted user, with a second, simultaneous text and voice connection between the assisted user and the relay service. *Id.* at

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9:33–43. The relay service and the hearing user are connected at the assisted user’s location to allow the relay operator to hear the hearing user’s spoken words and to voice the assisted user’s typed words. *Id.* at 9:43–60. Notably, the hearing and assisted users are connected directly over a telephone connection, whereas the hearing user and the relay service are connected indirectly, by way of the assisted user’s separate connection to the relay service. *Id.* at 9:37–43.

*E. Illustrative Claim*

Independent claim 1 is the only claim challenged and is the only claim in the ’082 patent. Claim 1 is reproduced below.

1. A captioned telephone device for providing captioned telephone service to an assisted user communicating with a hearing user through a telephone connection using a relay having speech to text translation capability, the hearing user speaking words in voice, the device comprising:
  - a microphone;
  - a speaker;
  - a visually readable display;
  - circuitry to support connection to two telephone lines; and
  - a microprocessor programmed to operate the device to:
    - receive a telephone call over a first telephone line directly between the assisted user and the hearing user;
    - initiate a telephone connection over a second telephone line to the relay;
    - transmit the voice of the hearing user over the second telephone line to the relay so that the relay can convert[] the words spoken by the hearing user into text and transmit the text created

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by the relay back to the device over the second telephone line; and display the text on the display within sight of the assisted user such that captioning of the communication session is provided to the assisted user.

#### *F. Asserted Ground and Prior Art*

We instituted an *inter partes* review on the ground of anticipation of claim 1 of the '082 patent by U.S. Patent No. 6,181,736 B1, issued Jan. 30, 2001 to McLaughlin (Ex. 1006).

## II. ANALYSIS

### *A. 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); *see also In re Cuozzo Speed Techs., LLC*, No. 2014-1301, slip op. at 11–19 (Fed. Cir. Feb. 4, 2015). 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).

#### *1. Assisted User / Hearing User*

We previously construed “assisted user” as “the individual making use of the transcribed text, regardless of the individual’s actual hearing

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abilities.” Inst. Dec. 7. We previously construed “hearing user” as “the individual in communication with the assisted user.” *Id.* at 7–8.

These constructions have not been challenged. Although these terms are not at issue in this Decision, their constructions are useful in understanding the claimed subject matter.

## 2. *Directly Between*

Claim 1 recites a microprocessor programmed to operate a device to “receive a telephone call over a first telephone line directly between the assisted user and the hearing user.” We previously construed this phrase to mean “receiving a telephone call over a first telephone line between the assisted user and the hearing user without the relay intervening on that line.” Inst. Dec. 8–9. We maintain this construction; it has not been challenged.

## 3. *Captioned Telephone Device*

The preamble of claim 1 recites:

[a] captioned telephone device for providing captioned telephone service to an assisted user communicating with a hearing user through a telephone connection using a relay having speech to text translation capability, the hearing user speaking words in voice, the device comprising:

....

We did not construe previously the term “captioned telephone device” in this proceeding. Patent Owner notes that we did construe this term in related proceeding IPR2013-00542. PO Resp. 13. Patent Owner notes we “construed this term in the context of related patents which share the same specification.” *Id.* In IPR2013-00542, we construed this term to mean “a device that transmits and receives voice signals and text information and



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displays text to an assisted user.” *CaptionCall, Ltd. v. Ultratec, Inc.*, Case IPR2013-00542, slip op. at 8–10 (Paper 6) (PTAB Mar. 5, 2014).<sup>1</sup> Patent Owner appears to accept to this construction. PO Resp. 14–18 (arguing that Petitioner’s position fails under Patent Owner’s interpretation of our construction of “captioned telephone device”). Further, Patent Owner argues that the preamble is limiting because it provides an antecedent basis for the “device” referenced in the body of the claim.” *Id.* at 13. Petitioner states that the preamble of claim 1 is not limiting because the claim sets forth “a structurally complete invention in the claim body.” Pet. 20–21 (citing *Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997)); Pet. Reply 2.

The preamble of claim 1 is limiting in that it requires a “captioned telephone device.” This is because it provides antecedent basis for the term “the device” later in the body of the claim, and thus serves “as a necessary component of the claimed invention.” *Eaton Corp. v. Rockwell Int’l Corp.*, 323 F.3d 1332, 1339 (Fed. Cir. 2003). Notwithstanding, Petitioner is correct in that the claim sets forth all of the elements of a captioned telephone device. Accordingly, claim 1 is limited to a “captioned telephone device,” but the body of the claim recites a complete device; the preamble adds no further limitation. Our reasoning follows.

First, we must distinguish between a captioned telephone *device* and a captured telephone *service*. “Captioned telephone service,” also known as text-assisted telephone, is a telephone service that allows an assisted user to

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<sup>1</sup> In the Final Written Decision in IPR2013-00542, we clarified that, consistent with the specification, the device need only receive text. *Id.*, Case IPR2013-00542, Paper 66 at 8 (PTAB Mar. 3, 2015) (construing this term as “a device that transmits and receives voice signals, receives text information, and displays text to an assisted user.”).

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receive captions of the words spoken by a hearing user as well as the voice of the hearing user. Ex. 1021, 3:11–28. A “captioned telephone device,” on the other hand, is a device that is used in providing captioned telephone service. The ’082 patent makes clear, however, that the captioned telephone device need not provide all aspects of captioned telephone service. For example, the relay is not part of the captioned telephone device. *Id.* at 9:40–43 (“assisted user then uses a personal interpreter/captioned telephone (‘PICT’) device 74 to connect to a relay 76 over a second telephone line”); Figs. 4, 5. In addition, the captioned telephone device displays text but need not output any audio signals to the assisted user. *Id.* at 9:20–32 (“the captioned telephone device . . . is illustrated as a separate stand-alone device from the telephone”), 9:15–20 (stating a captioned telephone device filters out text signals from voice signals and displays text), 10:67–11:3 (stating a captioned telephone device may be “a stand-alone appliance” from the telephone), Figs. 4–6 (depicting the telephone as a separate entity from the captioned telephone device). Accordingly, we are not persuaded by Patent Owner’s argument that a “captioned telephone device” *must* provide an audio output to the assisted user, because the ’082 patent makes clear that audio output is an *optional feature* for a captioned telephone device. *See* PO Resp. 14.

In view of the above, we construe “captioned telephone device” as we do in the Final Written Decision in related proceeding IPR2013-00542: “a device that transmits and receives voice signals, receives text information, and displays text to an assisted user.”

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*B. The Testimony of Mr. Occhiogrosso is not Excluded*

Patent Owner seeks to exclude the testimony of Mr. Benedict Occhiogrosso (Exs. 1010, 1030, 2003, 2004, and 2007) on the theory that he is not qualified as an expert under Federal Rule of Evidence 702 (“FRE 702”).<sup>2,3</sup> PO Mot. Excl. 1. FRE 702 permits expert testimony if a witness is qualified, “by [his or her] knowledge, skill, experience, training, or education,” and if his or her testimony “will help the trier of fact to understand the evidence or to determine a fact at issue,” *inter alia*. Testimony on the issue of unpatentability proffered by a witness who is not “qualified in the pertinent art” generally is not admissible under FRE 702. *Sundance, Inc. v. DeMonte Fabricating Ltd.*, 550 F.3d 1356, 1363–64 (Fed. Cir. 2008).<sup>4</sup> In determining who is “qualified in the pertinent art” under

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<sup>2</sup> Patent Owner also seeks to *exclude* Mr. Occhiogrosso’s testimony under 37 C.F.R. § 42.65. PO Mot. Excl., 1. Rule 42.65, however, addresses (a) the weight given to expert testimony that does not disclose underlying facts or data on which the opinion is based, (b) the showing required if a party seeks to rely on a technical test or data from such a test, and (c) the exclusion of expert testimony on United States patent law or patent examination practice. As such, Rule 42.65 does not apply to a determination whether to exclude Mr. Occhiogrosso’s testimony.

<sup>3</sup> With some enumerated exceptions, the Federal Rules of Evidence apply to an *inter partes* review. 37 C.F.R. § 42.62.

<sup>4</sup> In *Sundance*, the court was concerned with allowing improper testimony in jury trials. *Sundance*, 550 F.3d at 1365, n.8. The Board, on the other hand, sitting as a non-jury tribunal with administrative and technical expertise, is well-positioned to determine and assign appropriate weight to evidence presented. *Gnosis S.P.A. v. S. Alabama Medical Science Foundation*, IPR2013-00118, slip op. at 43 (PTAB June 20, 2014) (Paper 64); *see also Donnelly Garment Co. v. NLRB*, 123 F.2d 215, 224 (8th Cir. 1941) (“One who is capable of ruling accurately upon the admissibility of evidence is equally capable of sifting it accurately after it has been received.”).

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FRE 702, we need not find a complete overlap between the witness’s technical qualifications and the problem confronting the inventor or the field of endeavor for a witness to qualify as an expert. *SEB S.A. v. Montgomery Ward & Co., Inc.*, 594 F.3d 1360, 1372–73 (Fed. Cir. 2010) (upholding admission of the testimony of an expert who admittedly lacked expertise in the design of the patented invention, but had experience with materials selected for use in the invention); *Mytee Prods., Inc. v. Harris Research, Inc.*, 439 Fed. App’x 882, 886–87 (Fed. Cir. 2011) (non-precedential) (upholding admission of the testimony of an expert who “had experience relevant to the field of the invention,” despite admission that he was not a person of ordinary skill in the art).

Patent Owner contends that, to qualify as an expert under FRE 702, Mr. Occhiogrosso must be a person of ordinary skill in the art, and that Mr. Occhiogrosso is not a person of ordinary skill in the art because he does not have “general knowledge and understanding of the telecommunications needs of the deaf and HOH [(hard of hearing)]” or “experience with the development of assistive telecommunications technology for such individuals.” *Id.* at 1–4; *see also id.* at 5–7 (discussing Mr. Occhiogrosso’s experience with respect to these factors).

Petitioner responds that Patent Owner’s definition of the level of ordinary skill in the art conflates a requirement for skill in the relevant technical art (“telecommunications systems [having] voice-to-text transcription”) with skill in one particular commercial sector that applies that technical art (“telecommunications services *specifically* designed for the deaf or hard of hearing”). Pet. Opp. Mot. Excl. 1, 4. Petitioner also points out that, even if we were to adopt Patent Owner’s proposed level of ordinary

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skill in the art, Mr. Occhiogrosso has experience with developing a telecommunications system for the deaf and hard of hearing. *Id.* at 12–13.

Patent Owner’s arguments are unpersuasive at the outset because, to testify as an expert under FRE 702, a person need not be a person of ordinary skill in the art, but rather simply “qualified in the pertinent art.” *Sundance*, 550 F.3d at 1363–64; *SEB*, 594 F.3d at 1372–73; *Mytee*, 439 Fed. App’x at 886–87. Notwithstanding, for the reasons we express below in Section II.C, we find Mr. Occhiogrosso to be qualified to testify as to the level of ordinary skill in the art. Patent Owner’s arguments are also unpersuasive because they attempt to constrict the “pertinent art,” i.e., the pertinent technology, to a particular subset of individuals who use the pertinent technology, rather than the pertinent technology itself. *See also* Pet. Opp. Mot. Excl. 4–5 (arguing that the problems in the pertinent art are not “uniquely related to . . . the deaf and hard-of-hearing”).

The technology at issue in the ’082 patent “relates to the general field of telephone communications.” Ex. 1021, 1:21–22. The ’082 patent focuses on a particular application of that technology: people who need assistance in using telecommunications devices. *Id.* 1:21–2:28 (describing various prior art assistive technologies to help frame the evolution of assistive technologies). Patent Owner would have us define the pertinent art in the narrowest way: “telecommunications technology *for the deaf and hard of hearing.*” PO Mot. Excl. 3 (emphasis added); *see also id.* (additionally characterizing the technology as “assistive telecommunications technology”). The Federal Circuit in *Sundance*, however, used the phrase “qualified in the pertinent art,” however, and did not set forth a rule requiring an expert in the specific technological solution recited in the

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claims or the particular motivation behind the inventors' invention.

*Sundance*, 550 F.3d at 1363–64. We determine the pertinent art to be telecommunications systems, because any communications technology would be pertinent art to the '082 patent. While assistive technology may be more pertinent, and assistive technology for the deaf and hearing impaired, using voice-to-text relays, may be most pertinent, anything in the telecommunications technology field would be pertinent to the inventors when considering their problem.

Mr. Occhiogrosso has established that he has knowledge, experience, and education in the field of telecommunications systems. Ex. 1010 ¶¶ 5–10; Ex. 1030 ¶¶ 4–11. As such, Mr. Occhiogrosso is qualified sufficiently in the pertinent art to testify under FRE 702 in this proceeding, because his testimony helps us to understand aspects of telecommunications technology used in the '082 patent.

Moreover, to the extent Mr. Occhiogrosso is more familiar with general telecommunications technology and less familiar with voice-to-text or its application to the deaf or hearing-impaired, or to the extent that Mr. Occhiogrosso's testimony is inconsistent or unsupported, we will weigh Mr. Occhiogrosso's testimony accordingly, taking into account the extent of his expertise in these areas. *See, e.g., Yorkey v. Diab*, 601 F.3d 1279, 1284 (Fed. Cir. 2010) (holding the Board has discretion to give more weight to one item of evidence over another “unless no reasonable trier of fact could have done so”); *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.”); *see also* PO Mot. Excl. 5–7 and PO Reply

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Mot. Excl. 2–4 (arguing Mr. Occhiogrosso does not have sufficient experience with the deaf or hearing impaired); PO Mot. Excl. 8 and PO Reply Mot. Excl. 4–5 (arguing that Mr. Occhiogrosso’s statements are unsupported and unreliable).

Under the totality of these circumstances, we decline to exclude the testimony of Mr. Occhiogrosso. Accordingly, Patent Owner’s Motion to Exclude to Mr. Occhiogrosso’s testimony is *denied*.

*C. Mr. Occhiogrosso Is Qualified to Testify as to the Level of Ordinary Skill in the Art*

The hypothetical person of ordinary skill in the art is attributed with knowledge “of all prior art in the field of the inventor’s endeavor and of prior art solutions for a common problem even if outside that field.” *In re Nilssen*, 851 F.2d 1401, 1403 (Fed. Cir. 1988). As we explained above in Section II.B, the pertinent art is telecommunication systems. Thus, a person of ordinary skill in the art is a person familiar with at least that technology, by way of background and/or experience. The prior art in the record before us is highly indicative of the level of ordinary skill in this art. *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (holding that the prior art itself can reflect the appropriate level of skill in the art).

Patent Owner argues that Mr. Occhiogrosso has no particular experience in telecommunication relay services (“TRS”) for the deaf and hard of hearing and, as such, is not qualified to testify as to the level of ordinary skill in the art. PO Resp. 7–8. Petitioner replies that Mr. Occhiogrosso has “comprehensive industry experience” that includes experience “relating to each of the component technologies at issue” as well

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as “applications for the deaf and hard-of-hearing.” Pet. Reply 1 (citing Ex. 1030 ¶¶ 4–11).

Patent Owner’s argument is, essentially, that Mr. Occhiogrosso is not qualified sufficiently in this field because he has insufficient experience with a particular intended end user of the claimed invention. PO Resp. 7–8. Although those end users may be a large segment of users of this technology, the same technology is used in other contexts, such as translation of spoken languages and captioning of voices, and Mr. Occhiogrosso has experience in those contexts. Ex. 1030 ¶¶ 9–11. Thus, Patent Owner’s argument is unpersuasive. Moreover, Mr. Occhiogrosso testifies he has experience with voice-to-text technology specifically for deaf and hard-of-hearing persons. *Id.* ¶ 11.

Reviewing the testimony of Mr. Occhiogrosso and his supporting documentation (Exs. 1010, 1011, 1030, 2003, 2004, and 2007), we are persuaded that he is qualified to testify as to the level of ordinary skill in the art in this proceeding.

#### *D. The McLaughlin Ground*

Petitioner asserts that McLaughlin anticipates the subject matter of claim 1. Pet. 20–26. We first discuss the relevant disclosures in McLaughlin, and then we move element-by-element through Petitioner’s ground and Patent Owner’s arguments.

##### *1. McLaughlin*

The McLaughlin device is configured to receive a telephone call over a line directly between the assisted user and the hearing user. Ex. 1006, 30:37–39 (“An object of the invention is to allow a hearing/speaking person



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to call the phone number of a deaf and/or speech impaired person directly.”). Subsequently, the device initiates a second telephone call to the relay service. *Id.* at 30:59–63 (denoting “Line A” for the direct connection and “Line B” for the relay connection), 31:35–40 (“[T]he answering device will set up a . . . link with the relay service on Line B. The voice caller will now be informed that the call can proceed.”). The device transmits the voice of the hearing user to the relay, which in turn operates to convert the words of the hearing caller into text for display on the assisted user’s device. *Id.* at 31:41–47 (“[V]oice sounds from the voice caller on Line A are sent over to the Line B . . . line,” then “[t]he operator can translate these voice sounds into text and type back . . . causing this text to appear on the screen of the . . . device of the deaf user.”).

McLaughlin also discloses features that allow an assisted user’s voice to carry over to the hearing user (“voice carry over” or “VCO”) and a hearing user’s voice to carry over to the assisted user (“hearing carry over” or “HCO”). *Id.* at 29:28–44.

2. *McLaughlin describes “[a] captioned telephone device”*

Petitioner asserts that, although the preamble of claim 1 is not limiting, McLaughlin describes a device that provides the text of a hearing user’s voice. Pet. 20–21; *id.* at 22 (citing Ex. 1006, 31:41–52). Patent Owner argues that the preamble serves as an antecedent basis for later references in the claim to “the device” and, as such, is limiting. PO Resp. 13. Patent Owner then argues that McLaughlin does not describe a “captioned telephone device” because “it does not disclose any device or service that enables an assisted user to receive both voice and captions.” *Id.* at 14. By arguing that McLaughlin does not “receive [a] voice,” Patent

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Owner means that McLaughlin’s device does not “provide the audio of the hearing user’s voice to the deaf user in addition to the text.” *Id.* at 14–15; *see also id.* at 15–18 (making similar arguments).

We agree with Patent Owner that the preamble is limiting, but only insofar as claim 1 requires a captioned telephone device. It is not limiting insofar as requiring telephone lines connected to that device, the relay, or any other structure or thing that is not the captioned telephone device or otherwise required by the claim. These aspects of the preamble merely describe the environment in which the captioned telephone device operates. As we explained in our claim construction section, a captioned telephone device is only one piece of a captioned telephone service, and the ’082 patent clearly delineates between the captioned telephone device versus these other things the device operates in conjunction with to provide the captioned telephone service.

Patent Owner’s argument is that a captioned telephone device must provide the audio of the hearing user’s voice to the assisted user. A captioned telephone device, however, need not provide the audio of the hearing user’s voice, for the reasons we discussed in our claim construction of the term. Tellingly, claim 1 recites a microprocessor programmed to operate the captioning device, but does not include a step of transmitting the voice of the hearing user to the assisted user. Accordingly, we consider the omission in a claim of an explicitly optional feature to mean that that feature is not required by the claim.

While claim 1 does require a speaker, it does not require programming to provide the voice of the hearing user to the assisted user. Claim 1 thus reads on a captioned telephone device that provides the voice of the hearing

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user to the assisted user *as well as* a captioned telephone device that does not provide the voice of the hearing user. Accordingly, we do not render the speaker redundant by not reading in the optional, unclaimed voice transmission feature.

Moreover, we understand that, at a broader level, Patent Owner is arguing that McLaughlin does not provide captioning service because McLaughlin allegedly does not provide both the hearing user's voice as well as the relay's captions to the assisted user at the same time. Even assuming, *arguendo*, that McLaughlin did not provide both voice and caption, we made clear above and in our claim construction section that claim 1 is directed to a captioned telephone *device*; it does not require provision of a complete captioned telephone *service*. That is, a captioned telephone device, as claimed and understood in view of the '082 patent, need not provide the voice of the hearing user to the assisted user. Thus, claim 1 only requires those things set forth in claim 1; it does not require all aspects of the captioned telephone service to be provided.

In view of the above, we are not persuaded by Patent Owner's arguments that McLaughlin does not describe a "captioned telephone system" in the manner required by the preamble of claim 1.

3. *McLaughlin describes "a microphone," "a speaker," and "a visually readable display"*

McLaughlin discloses a microphone and a speaker because it describes a device that has both VCO and HCO modes, which require a microphone and a speaker, respectively. Ex. 1006, 30:4–12. McLaughlin also discloses that, if the two users are conversing over the internet, they "both have audio circuitry or sound cards . . . with *microphones and/or*

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*speakers.” Id.* at 33:61–64 (emphasis added). McLaughlin discloses a display allowing a user to view text converted from the hearing user’s voice. *Id.* at 31:43–47, 33:42–46.

Patent Owner does not argue explicitly in its Response that McLaughlin does not describe a display as required by claim 1. Patent Owner argues, however, that a VCO mode only requires a microphone, and a HCO mode only requires a speaker, such that McLaughlin’s disclosure of VCO and HCO modes only describes one of these structures, but not both. PO Resp. 18–19. Patent Owner’s declarant, Mr. Steel, testifies that, while McLaughlin discloses “services to a deaf person who can speak” and “to a hearing person who cannot speak,” McLaughlin does not disclose a service for a person that “can both hear and speak, but needs captions to supplement his or her hearing.” Ex. 2001 ¶ 21.

Patent Owner’s argument is unpersuasive because it does not focus on whether the claims read on McLaughlin. Claim 1 is anticipated by McLaughlin if it discloses a device arranged in the manner required by the claim. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772 (Fed. Cir. 1983) (“[I]t is only necessary that the claims under attack, as construed by the court, ‘read on’ something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or ‘fully met’ by it.”). Reviewing Petitioner’s asserted ground, we find the microphone, speaker, and display limitations properly read on the device described in McLaughlin. *See* Pet. 22–23.

To the extent Patent Owner is arguing that the VCO and HCO modes in McLaughlin are strictly mutually exclusive, e.g., if a user had a VCO model it would have a microphone but not a speaker, we consider this

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argument unpersuasive as well. McLaughlin describes a device for the deaf and/or speech impaired. *See, e.g.*, Ex. 1006, 29:18–19. As Petitioner’s declarant, Mr. Occhiogrosso testifies, “[i]t would be illogical” for McLaughlin to be implying three separate devices when it states “and/or.” Ex. 1030 ¶ 23. We are persuaded by Mr. Occhiogrosso’s testimony that a person of ordinary skill in the art would consider McLaughlin to be disclosing a device capable of all of the HCO/VCO features described therein. *Id.* ¶¶ 23–24. In other words, McLaughlin’s disclosure, when describing a device for a hearing user to call an assisted user (*e.g.*, Ex. 1006, cols. 29–34), is describing options for a single system, not separate embodiments. *See Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 n.5 (Fed. Cir. 2008) (“[C]ourts are not constrained to proceed example-by-example when reviewing an allegedly anticipating prior art reference. Rather, the court must, while looking at the reference as a whole, conclude whether or not that reference discloses all elements of the claimed invention arranged as in the claim.”). Thus, McLaughlin discloses a device capable of both HCO and VCO, and such a device has a speaker and a microphone.

In view of the above, we are persuaded that McLaughlin describes “a microphone,” “a speaker,” and “a visually readable display.”

*4. McLaughlin describes “circuitry to support connection to two telephone lines”*

McLaughlin labels the line between the hearing user and the assisted user as “Line A” and the line between the assisted user and the relay as “Line B.” Ex. 1006, 30:46–63, 31:37–40. McLaughlin states that “voice sounds from the voice caller on Line A are sent over to the Line B [and] can be heard by the relay operator.” *Id.* at 31:41–43. Specifically, “the Line A

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SVD modem digitizes the sounds of [the hearing user’s] voice and ships this digital stream over to the Line B SVD modem, either directly in a single modem enclosure [or] through a bus, serial or parallel ports of a personal computer.” *Id.* at 32:41–46. In one option of the described embodiment, “two SVD modems are attached to a personal computer, and no specialized hardware is required.” *Id.* at 32:33–35.

Patent Owner argues that there are other optional configurations in McLaughlin where the modems may be located in different locations and that “McLaughlin is silent as to where the two lines are connected.” PO Resp. 19–21. Patent Owner and its declarant, Mr. Steel, attempt to characterize McLaughlin as “ambiguous” for this reason. *Id.*; Ex. 2001 ¶¶ 27–31.

Reviewing McLaughlin, we do not find ambiguity but rather a description of a device that can be configured according to several enumerated possibilities. Although there may be other options in McLaughlin wherein the modems are in different locations (assuming, *arguendo*, that the claims preclude such a configuration), the option that Petitioner relies on for this limitation states that the modems for Line A and Line B are digitally connected in a single modem enclosure. Ex. 1006, 32:41–46. Accordingly, McLaughlin describes modems located in the same digital device.

In view of the above, we are persuaded that McLaughlin describes “circuitry to support connection to two telephone lines.”

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5. *McLaughlin describes “a telephone call over a first telephone line directly between the assisted user and the hearing user”*

McLaughlin describes that an advantage of its device is to allow a hearing user to directly call an assisted user, i.e., without having to call a relay. Ex. 1006, 33:50–52. McLaughlin calls this first telephone line “Line A.” *See, e.g., id.* at 30:61–63.

Patent Owner argues that there is ambiguity as to where the modems are located in McLaughlin, and that McLaughlin merely teaches two telephone lines “but certainly does not teach that there is a direct line between the hearing user and the deaf user.” PO Resp. 21–22; *see also* Ex. 2001 (Mr. Steel testifying along these lines).

Patent Owner fails to address to our satisfaction the explicit statement in McLaughlin that its system is set up to allow a hearing user “to directly call” an assisted user. Ex. 1006, 33:50–52. Mr. Steel characterizes Lines A and B of McLaughlin as simply two “telephone lines[] that can be used by the assisted user.” Ex. 2001 ¶ 33. This testimony, however, is undermined by the explicit disclosure of McLaughlin just cited.

We are persuaded that McLaughlin describes the functions of the two lines: Line A is the line from the hearing user to the assisted user, and Line B is the line from the assisted user to the relay. Ex. 1006, 30:37–39, 30:59–63, 31:41–52, 32:41–65, 33:50–52. The relay is on Line B, such that the line between the hearing user and assisted user (Line A) does not have a relay and is, therefore, a direct connection between the two users.

In view of the above, we are persuaded that McLaughlin describes “a microprocessor programmed to operate the device to: receive a telephone

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call over a first telephone line directly between the assisted user and the hearing user.”

6. *McLaughlin describes “a telephone connection over a second telephone line to the relay”*

McLaughlin describes two lines, wherein Line B is a telephone line to the relay. Ex. 1006, 31:41–52, 32:41–61. Patent Owner’s arguments with respect to this limitation are largely similar to its arguments with respect to the first telephone line limitation. *See* PO Resp. 22–23. Those arguments are unpersuasive for similar reasons.

Patent Owner additionally argues that McLaughlin does not teach “the call to the relay on second Line B is initiated by the assisted user’s device.” *Id.* at 23. This argument is unpersuasive because McLaughlin describes that, upon receiving a call on Line A from a hearing user, “*the answering device will set up a SVD link with the relay service on Line B.*” Ex. 1006, 31:37–40 (emphasis added). Patent Owner’s argument does not address cogently this disclosure in McLaughlin.

In view of the above, we are persuaded that McLaughlin describes “a microprocessor programmed to operate the device to: initiate a telephone connection over a second telephone line to the relay.”

7. *McLaughlin describes “converting the words spoken by the hearing user into text” and “display[ing] the text on the display”*

McLaughlin describes that the hearing user’s voice is sent along Line B to be transcribed at the relay and subsequently converted into text at the relay for display on the user’s device. Ex. 1006, 31:41–47. That text is for



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the assisted user to read, such that it would be displayed by a display in sight of the assisted user. *Id.*

Patent Owner does not address these limitations explicitly in its Response. Reviewing the Petition and the evidence cited therein, we are persuaded that McLaughlin describes these limitations.

### *E. Conclusion*

We have reviewed the papers submitted by the parties and the evidence cited therein. Upon our review, we determine that Petitioner has established, by a preponderance of the evidence, that McLaughlin describes each element of claim 1 of the '082 patent in the manner prescribed by the claim. Accordingly, we find that McLaughlin anticipates claim 1.

### III.ORDER

In view of the foregoing, it is hereby:

ORDERED that Petitioner has shown by a preponderance of the evidence that claim 1 of the '082 patent is unpatentable; and

FURTHER ORDERED that this is a final written decision and that parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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Paper 59  
Entered: December 1, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CAPTIONCALL, LLC,  
Petitioner,

v.

ULTRATEC, INC.,  
Patent Owner.

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Case IPR2013-00550  
Patent 7,003,082 B2

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

SAINDON, *Administrative Patent Judge*.

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

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## I. INTRODUCTION

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

### A. Applicable Standard of Review

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

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

### B. Analysis

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

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

### *1. Anticipation*

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

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

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

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

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

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

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

## 2. Panel Composition

Patent Owner asserts we exceeded our authority by issuing a Final Written Decision “with less than a full panel.” Req. 11–13. Panel composition for an *inter partes* review is specified in 35 U.S.C. § 6(c), which states “[e]ach . . . inter partes review shall be heard by at least 3 members of the Patent Trial and Appeal Board, who shall be designated by the Director.” The Director’s authority under 35 U.S.C. § 6 to designate panels has been delegated to the Chief Judge. *See* Patent Trial and Appeal Board Standard Operating Procedure 1 (Rev. 14) (May 8, 2015) (“PTAB SOP 1”).

As acknowledged by Patent Owner (Req. 11–12), the Final Decision was decided by three administrative patent judges, who are members of the Board. *See* 35 U.S.C. § 6(a) (indicating that administrative patent judges, along with various members of the United States Patent and Trademark Office, constitute the Patent Trial and Appeal Board). The three administrative patent judges were designated by the Chief Judge according to PTAB SOP 1, titled “Assignment of Judges to Merits Panels, Interlocutory Panels, and Expanded Panels.” The Board, therefore,

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complied with the statutory requirements for panel composition.

Accordingly, we did not issue the Final Decision with less than a “full panel,” as Patent Owner contends.

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

### 3. *Written Record*

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



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

#### *4. Request for Expanded Panel*

Patent Owner suggests an expanded panel is warranted to decide the Request in view of the panel composition and various allegations that we misapprehended the law. Req. 1. For the reasons given, Patent Owner does not persuade us that we misapprehended the law or the panel of three judges was deficient. Further, the Board's procedures provide examples of reasons for expanding a panel, none of which apply here. PTAB SOP 1 at 3 (§ III.A). For example, an expanded panel may be appropriate when "serious questions have been raised about the continuing viability of an apparently applicable precedential decision of the Board, or a panel of the Board renders a decision that conflicts with a precedential decision of the Board or an authoritative decision of the Board's reviewing courts." *Id.* Patent Owner's Request does not show a conflict or other reason that weighs in favor of panel expansion. Even so, the panel informed the Chief Judge, who has authority to expand a panel, of Patent Owner's request, and the Chief Judge declined to expand the panel. *See* PTAB SOP 1 at 4 (§ III.C).

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

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

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(“The Chief Judge will determine when an expanded panel is to be designated.”); *see also Apple Inc. v. Rensselaer Polytechnic Inst.*, Case IPR2014-00319, slip op. at 2 n.1 (PTAB Dec. 12, 2014) (Paper 20) (indicating only the Chief Judge, acting on behalf of the Director, may act to expand a panel and panels do not authorize panel expansion).

*C. Conclusion*

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

II. ORDER

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

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