

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 IPR2013-00544  
Patent 8,213,578 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*

## I. INTRODUCTION

Petitioner, CaptionCall, L.L.C., filed a Petition requesting an *inter partes* review of claims 7–11 of U.S. Patent No. 8,213,578 B2 (Ex. 1001, “the ’578 patent”). Paper 1 (“Pet.”). We instituted an *inter partes* review for claims 7–11. Paper 6. In our Final Written Decision, we determined that Petitioner had shown, by a preponderance of the evidence, that claims 7–11 were unpatentable. Paper 74 (“Final Dec.” or “Final Decision”). Patent Owner, Ultratec, Inc., requests a rehearing of the Final Decision by an expanded panel. Paper 75 (“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. Status of Ryan as Prior Art

In the Final Decision, in response to Patent Owner’s argument that Ryan<sup>1</sup> did not qualify as prior art because it was not enabled (Paper 27, 15–23 (“PO Resp.”)), we determined that Ryan was enabled prior to the date of

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<sup>1</sup> U.S. Patent No. 5,809,112 (Ex. 1004).

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invention of the challenged patent in 1997 and, therefore, qualified as prior art to the challenged claims. Final Dec. 21–25.

In its Request for Rehearing, Patent Owner argues, as it did in its Patent Owner Response, that for a patent to serve as prior art the patent must be enabled as to its own earliest claimed effective filing date in 1994. Req. 1–4; PO Resp. 15–22. We addressed this argument in the Final Decision and additionally examined the evidence of record as to whether Ryan would have enabled one of ordinary skill in the art to make the invention without undue experimentation prior to the date of invention of the challenged patent. Final Dec. 22–25. We are not persuaded that we overlooked or misapprehended Patent Owner’s prior argument or made an erroneous interpretation of law.

Patent Owner additionally argues that our consideration of Ryan as prior art as of the date of invention of the challenged patent (1997), was “substantially different than the adopted ground” at issue in the *inter partes* review because the Petition (Paper 1) did not discuss this issue. Req. 4 (“The Petition only discussed potential priority dates in 1994 and 1996, not 1997.”). We disagree. As noted in our Decision to Institute, *inter partes* review was instituted for “[c]laim 7 as anticipated under 35 U.S.C. § 102 by Ryan.” Paper 6, 21 (IV. ORDER). During the *inter partes* review, Patent Owner argued, in its Patent Owner Response, that Ryan did not anticipate claim 7 (PO Resp. 15–35), including a challenge to the prior art status of Ryan (*id.* at 15–23). The Final Decision discussed the instituted ground of anticipation by Ryan and addressed Patent Owner’s assertions, including those regarding the prior art status of Ryan. Final Dec. 19–29.

In a similar vein, Patent Owner argues it should have received express notice “that enablement would be assessed in 1997” so it could submit evidence concerning enablement in 1997. Req. 5. We are not persuaded by this argument. First, Patent Owner expressly argued this issue its Patent Owner Response. PO Resp. 21 (“Even if the Board determines that Petitioner may show that Ryan was enabled at any point before the date of invention for the claimed use of revoicing in a telecommunications relay service, Petitioner will be unable to make that showing.”); *see id.* at 22 (asserting the date of invention of June 23, 1997). Thus, Patent Owner submitted arguments concerning enablement in 1997, the very issue about which Patent Owner now contends it was not informed and so missed the opportunity to submit relevant evidence. Moreover, as noted in our Final Decision, Patent Owner and Petitioner did not dispute that the “re-voicing limitation” was enabled on June 23, 1997, with the release of commercial voice recognition software to the public. Final Dec. 22 (citing PO Resp. 22; Reply 3; Exs. 2011, 2012, 2013). As noted in our Final Decision, public availability of the commercial voice recognition software as of 1997 is corroborated by U.S. Patent No. 5,909,482, incorporated by reference into the challenged patent. *Id.* (quoting Ex. 1002, 5:51–57).

Patent Owner further asserts we overlooked evidence that the invention was conceived and diligently reduced to practice before Ryan was enabled. Req. 4 (citing Exs. 2011, 2012, 2013). We did not overlook this evidence. Rather, we examined this evidence in our Final Decision and found the evidence insufficient. Final Dec. 22 (“Patent Owner’s earliest proffered evidence dates back only to August 5, 1997, not to June 23, 1997,”

when Ryan was enabled); *see id.* at 21–22 (analyzing Patent Owner’s evidence offered in Exhibits 2011, 2012, and 2013).

For these reasons, we are not persuaded that we overlooked or misapprehended Patent Owner’s prior argument or made an erroneous interpretation of law concerning the availability of Ryan as prior art to the challenged claims.

### *B. Yamamoto Transcript*

Patent Owner contends we circumvented our own rules in admitting the transcript<sup>2</sup> of a videotaped interview with Mr. Seiichi Yamamoto, the first named author of the Yamamoto reference.<sup>3</sup> Req. 5–7. The interview was conducted in connection with a related district court proceeding between the parties. *See* Final Dec. 31. In the district court proceeding, the parties stipulated that the Yamamoto transcript—a stenographic record of the English portion of the interview (questions from both parties and an interpreter’s translation of Mr. Yamamoto’s testimony)—would be treated as sworn deposition testimony in the district court proceeding and, “[w]ith respect to other proceedings, the stenographic record will be treated as a sworn deposition taken in [the district court proceeding] at which both parties appeared and had the opportunity to question the witness.” Ex. 1067 ¶ 5 (Stipulation Regarding Seiichi Yamamoto). As explained in our Final Decision, we granted Petitioner’s motion to submit the Yamamoto transcript as supplemental information under 37 C.F.R. § 42.123(b) relating to the

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<sup>2</sup> Ex. 2017 (Videoconference Deposition of Seiichi Yamamoto, Aug. 20, 2014) (“Yamamoto transcript”).

<sup>3</sup> Yamamoto is a Japanese language document—Seiichi Yamamoto and Masanobu Fujioka, *New Applications of Voice Recognition*, Proc. JASJ Conf. (March 1996) (Ex. 1006; Ex. 1007 (English language translation)).

prior art status of Yamamoto and, after supplemental briefing by the parties, determined the Yamamoto transcript was admissible. Final Dec. 31–35.

Patent Owner argues in its Request for Rehearing that the Yamamoto transcript is inadmissible because it does not satisfy the requirements that all testimony, other than uncompelled direct testimony, must be in the form of a deposition transcript, 37 C.F.R. § 42.53(a), and that the witness shall be sworn, 37 C.F.R. § 42.53(f)(1). Req. 5. Therefore, according to Patent Owner, the Yamamoto transcript was “not taken, sought, or filed in accordance with these regulations [and] is not admissible.” *Id.* (citing 37 C.F.R. § 42.61(a)). Rule 42.53, however, is titled “Taking Testimony,” and applies only to testimony taken “during a testimony period set by the Board” for purposes of a particular review proceeding. 37 C.F.R. § 42.53(b); *see also* 37 C.F.R. § 42.53(c) (providing time limits set by the Board); *id.* § 42.53(d) (providing notice requirements). As stated in our Final Decision, Petitioner sought to admit the Yamamoto transcript as a deposition taken in the district court proceeding, not as deposition testimony taken in this *inter partes* proceeding. Final Dec. 32. And based on the parties’ stipulation in district court, we treated the Yamamoto transcript as sworn deposition testimony taken in the district court. *Id.* at 32–33 (citing Ex. 1067 ¶ 5). Petitioner filed the Yamamoto transcript as supplemental information under 37 C.F.R. § 42.123(b), establishing that the Yamamoto transcript reasonably could not have been obtained earlier and that its consideration was in the interests of justice. Paper 59, 7–8. Therefore, Petitioner’s filing of the Yamamoto transcript complied with Board rules, and we properly relied on it in determining the public accessibility of Yamamoto. *See* Final Dec. 35–38.

Having reviewed Patent Owner's Request, we are not persuaded we misapprehended or overlooked any matter relating to the admissibility of the Yamamoto transcript.

### *C. 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. 11–13. 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. 7–10.

First, Patent Owner contends that we erroneously relied on the disclosure in the '578 patent of “voice pattern.” *Id.* at 7–9. 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. 12 (quoting Ex. 1001, 2:44–46 (emphasis added)). Rather, in our Final Decision, we determined that the '578 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. 12 (quoting Ex. 1001, 2:44–46; Ex. 1002, 5:44–47).

Based on the evidence in the written description (including the disclosure of “voice pattern”), we determined that the ’578 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. 9–10 (citing Final Dec. 11). 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. 10 (citing Paper 75 (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. 12. 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. 24). 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. 2010 ¶¶ 21–22). 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 ’578 patent was 1997. *Id.* The weight we gave to the testimony of Patent Owner’s declarant reflected the parties’ agreement that commercial software that could be trained to recognize individual voices was available in 1997, as discussed previously. *See* Final Dec. 22 (citing PO Resp. 22; Reply 3; Exs. 2011, 2012, 2013). In other words, the understanding of one of ordinary skill as of 1997 was crucial given the shift in technology at that time, and the testimony of Patent Owner’s declarant was only reflective of the understanding prior to this shift.

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. 1057 ¶¶ 51–52. 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.* ¶ 52 (citing Ex. 1005, 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 the claims of the ’578 patent. *See* Final Dec. 25–29.

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.”

#### *D. 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 8–11 of the ’578 patent based on Ryan and McLaughlin.<sup>4</sup> Req. 10–12. Although we disagree that we misapprehended the law, we grant Patent Owner’s request for the purpose of modifying our analysis regarding the rationale for combining Ryan and McLaughlin (Final Dec. 52–54) 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); Pet. 43–44; Reply 9–10; Ex. 1030 ¶¶ 61–62; Ex. 1057 ¶¶ 60–62. The remainder of this section replaces the three paragraphs of the Final Decision addressing the rationale for combining Ryan and McLaughlin, beginning on page 52 and continuing through the first two lines on page 54.

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<sup>4</sup> U.S. Patent No. 6,181,736 B1, issued Jan. 30, 2001 (Ex. 1009).

McLaughlin teaches most of the limitations of claims 8–11, including a two-line captioned telephone device. 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 independent claim 7. 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 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. 1030 ¶¶ 22, 61; Ex. 1057 ¶ 62. 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, but similar, 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. 44; Reply 9–10; Ex. 1030 ¶ 61; Ex. 1057 ¶ 62. 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. 1057 ¶ 61; *see* Reply 10. For these reasons, we are persuaded that a person of 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 two-line captioned telephone device.

Patent Owner contends that the claims would not have been obvious over Ryan and McLaughlin because combining Ryan and McLaughlin would require a substantial redesign of McLaughlin and change its principle of operation. PO Resp. 46. We disagree and credit the testimony of Mr. Occhiogrosso that such a combination would not be difficult for a person of ordinary skill in the art to implement. *See* Reply 10; Ex. 1057 ¶ 61. Moreover, McLaughlin focuses on a network configuration that uses simultaneous voice and data (SVD) modems in conjunction with a relay, not the details of how a relay translates voice to text during a call between a remote user and an assisted user. *See* Ex. 1009, 30:13–31:63. Thus, we are not persuaded that McLaughlin’s principle of operation is “the use of a

conventional relay for typed transactions,” as Patent Owner asserts. *See* PO Resp. 46.

Patent Owner also argues that McLaughlin teaches away from the use of trained voice recognition software. *Id.* at 46–47. 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 ’578 patent. *Id.* (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. 1030 ¶¶ 22, 61; Ex. 1057 ¶ 62. On the facts presented here, we are not persuaded that McLaughlin’s statement regarding the 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).

#### *E. Secondary Considerations*

Patent Owner alleges that by “balancing” evidence of obviousness against secondary considerations evidence, we effectively determined the

claimed invention would have been obvious before considering secondary considerations. Req. 14 (citing Final Dec. 47). We disagree. Rather, in analyzing obviousness based on Wycherley and Yamamoto in our Final Decision, we determined the scope and content of the asserted prior art (Final Dec. 38–39); 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. 39–42); determined Petitioner, with support of its declarant, had articulated sufficient reasoning to support a conclusion of obviousness based on the combined references (Final Dec. 41–44); and analyzed Patent Owner’s secondary considerations of nonobviousness (Final Dec. 44–47). See *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). Only after that analysis did we address 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 claim 7 would have been obvious over Wycherley and Yamamoto.

Final Dec. 47. We performed a similar analysis for obviousness based on the combination of Ryan and McLaughlin. *Id.* at 47–54.

Patent Owner further contends we refused to consider Patent Owner’s secondary considerations evidence. Req. 12. This is incorrect. We considered the arguments and evidence presented in Patent Owner’s Response. Final Dec. 45–46. We concluded Patent Owner did “not provide

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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. 2002, 2004, and 2005). Req. 12–13. 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. 45 (citing “declarations by Brenda Battat (Ex. 2004) and Constance Phelps (Ex. 2005)” and “declaration of Paul Ludwick (Ex. 2002)”). We will not scour the 137 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.”).

#### *F. 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, 15. Panel

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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”).

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. *See* Req. 15.

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



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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) (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 Petitioner'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 Petitioner's Request for Rehearing is *denied* in all other respects; and

FURTHER ORDERED that, as determined in our Final Decision, claims 7–11 of U.S. Patent No. 8,213,578 B2 are unpatentable.

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