

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAPTIONCALL, L.L.C.,
Petitioner,

v.

ULTRATEC, INC.,
Patent Owner.

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

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

McLaughlin¹ and Ryan.² 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

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

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

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

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

addition, Patent Owner argues that McLaughlin discloses connecting to a traditional, text-only TDD³-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

³ “TDD” stands for “telecommunication device for the deaf.” Final Dec. 3.

¶ 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

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–

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.

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.

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.”).

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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