

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., and  
SORENSEN COMMUNICATIONS, INC.,  
Petitioner,

v.

ULTRATEC, INC.,  
Patent Owner.

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Case IPR2015-00637  
Patent 8,908,838 B2

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

SAINDON, *Administrative Patent Judge*.

DECISION

Final Written Decision  
Denying Patent Owner's Motion to Amend  
Granting Patent Owner's Motions to Seal  
Granting-in-Part Petitioner's Motion to Exclude  
*37 C.F.R. §§ 42.73, 42.121, 42.54, 42.64*

## 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) and 37 C.F.R. § 42.73.

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 claims 1–30 of U.S. Patent No. 8,908,838 B2 (Ex. 1001, “the ’838 patent”) is unpatentable. Furthermore, we deny Patent Owner’s Motion to Amend, grant in part Petitioner’s Motion to Exclude, and grant Patent Owner’s Motions to Seal.

### A. *Procedural History*

CaptionCall, L.L.C., and Sorenson Communications, Inc. (collectively, “Petitioner”) filed a Petition to institute an *inter partes* review (Paper 1, “Pet.”) of claims 1–30 of the ’838 patent. Pet. 1. Ultratec, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). We instituted an *inter partes* review of all challenged claims. Paper 8 (“Dec. on Inst.”). Patent Owner then filed its Response to the Petition (Paper 15, “PO Resp.”), to which Petitioner filed its Reply (Paper 23, “Pet. Reply”). An oral hearing was held on July 14, 2015. Paper 90 (“Tr.”).

This Decision also addresses several outstanding motions. Patent Owner filed a Contingent Motion to Amend (Paper 16, “Mot. Amend”), to which Petitioner filed an Opposition (Paper 24, “Opp. Mot. Amend”) and Patent Owner filed a Reply (Paper 54, “Reply Mot. Amend”). Petitioner filed a Motion to Exclude Evidence (Paper 64, “Mot. Exclude”), to which Patent Owner filed an

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Opposition (Paper 75, “Opp. Mot. Exclude”)<sup>1</sup> and Petitioner filed a Reply (Paper 78, “Reply Mot. Exclude”). Patent Owner filed several unopposed Motions to Seal and modifications to the Motions to Seal (Papers 29, 42, 48, 57, 67, 80, and 85). Petitioner filed a Motion for Observations (Paper 65), to which Patent Owner filed an Opposition (Paper 73). Patent Owner filed a Motion for Observations (Paper 66), to which Petitioner filed a Reply (Paper 74).<sup>2</sup>

### *B. Related Matters*

The ’838 patent claims priority to U.S. Patent No. 6,603,835 B2 (Ex. 1003, “the ’835 patent”), which was the subject of two *inter partes* reviews, *CaptionCall, LLC v. Ultratec, Inc.*, Case IPR2013-00549 (PTAB) (Final Written Decision issued March 3, 2015, finding claims 1–5 and 7 unpatentable; notice of appeal has been filed) and *CaptionCall, LLC v. Ultratec, Inc.*, Case IPR2014-00780 (PTAB) (Final Written Decision issued December 1, 2015, finding claims 6 and 8 unpatentable; notice of appeal has been filed). *See* Pet. 3; Paper 4.

The Petition in this case was filed concurrently with another petition challenging U.S. Patent No. 8,917,822 B2 (Ex. 1002), which also claims priority to the ’835 patent. Pet. 3 (directing our attention to IPR2015-00636). A number of other *inter partes* reviews involving related patents are in various stages of review. *See* Paper 4.

The parties are involved in a pending lawsuit involving the ’838 patent, *Ultratec, Inc. v. Sorenson Communications, Inc.*, No. 14-CV-00847 (W.D. Wis.).

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<sup>1</sup> Patent Owner filed an original opposition as Paper 71, but later filed Paper 75 as a corrected opposition.

<sup>2</sup> The contents of the motions for observations have been considered but do not require any ruling.

Pet. 2; Paper 4. The parties are involved in another lawsuit involving the above-mentioned related patents, *Ultratec, Inc. v. Sorenson Communications, Inc.*, Case No. 3:13-CV-00346 (W.D. Wis.).

### *C. The '838 Patent*

The '838 patent “relates to the general field of telephone communications” and, in particular, “relates to systems to assist telephone communications by those persons who are deaf, hard of hearing, or otherwise have impaired hearing capability.” Ex. 1001, 1:23–27. In traditional telecommunication devices for the deaf (TDD, TT, or TTY), a relay provides a service whereby a person serves as a human intermediary between the hearing and deaf user, typing the hearing user’s spoken words for display at the deaf user’s machine, and speaking the deaf user’s typed words for transmission to the hearing user’s telephone. *Id.* at 1:31–40, 2:1–15.

The '838 patent describes a system with more features than the traditional TDD, by extending the TDD device to users who are not deaf but are hard-of-hearing, and who may use the relay service to supplement what they hear. *Id.* at 2:17–21. This is achieved by providing the hard-of-hearing person with the voice of the hearing user as well as a text transcription of the hearing user’s spoken words. *See id.* at Abstract. This is called text-assisted telephone, or captioned telephone. *Id.* at 3:14–17. Another feature claimed in the '838 patent is directed to an “activator” that allows the relay to be dialed in on demand, such that the call may begin as a voice-only call, but when a user decides hearing assistance is needed, he or she may activate, using the activator, the relay service while the call is in progress. *Id.* at 7:13–20.

*D. Exemplary Claim*

Petitioner challenges all claims of the '838 patent, of which claims 1, 12, and 19 are independent. Claim 1 is exemplary:

1. A system for providing text captioned telephony services to an assisted user communicating with a hearing person, the system comprising:
    - a relay;
    - an assisted user's captioned device comprising:
      - (1) a captioned device processor linkable to first and second communication links;
      - (2) a visual display linked to the captioned device processor;
      - (3) a microphone linked to the captioned device processor for receiving voice signals from the assisted user using the assisted user's captioned device;
      - (4) a speaker linked to the captioned device processor for broadcasting voice signals received by the captioned device to the ear of the assisted user as voice signals from the hearing person are received at the captioned device;
      - (5) an activator linked to the captioned device processor, the activator controllable by the assisted user to invoke a captioning service;
- the captioned device processor configured to perform the steps of:
- (i) establishing-the first communication link between the assisted user's captioned device and the hearing person;
  - (ii) obtaining voice signals from the assisted user via the microphone;
  - (iii) transmitting the assisted user's voice signals from the captioned device to the hearing person via the first communication link;
  - (iv) receiving voice signals from the hearing person via the first communication link;
  - (v) broadcasting the voice signals from the hearing person via the speaker to the assisted user as the voice signals

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