

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAPTIONCALL, L.L.C.,
Petitioner,

v.

ULTRATEC, INC.,
Patent Owner.

Case IPR2015-01355
Patent 5,974,116

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

BENOIT, *Administrative Patent Judge*.

DECISION
Final Written Decision
37 C.F.R. § 42.73

I. INTRODUCTION

This *inter partes* review, instituted pursuant to 35 U.S.C. § 314, challenges the patentability of certain claims of U.S. Patent No. 5,974,116 (Ex. 1001, “the ’116 patent” or “the challenged patent”), owned by Ultratec, Inc. (“Patent Owner”). We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

For the reasons discussed below, Petitioner has shown by a preponderance of the evidence that claims 1–13, 15, and 18 (“the challenged claims”) of the ’116 patent are unpatentable. Furthermore, we deny Patent Owner’s Motion to Exclude and grant Patent Owner’s Motions to Seal.

A. Procedural History

CaptionCall, L.L.C. (“Petitioner”) filed a Petition for *inter partes* review of claims 1–18 of the ’116 patent. Paper 1 (“Pet.”). Patent Owner filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). We instituted an *inter partes* review of claims 1–13, 15, and 18 of the ’116 patent as unpatentable under 35 U.S.C. § 103(a)¹ over the following references. Paper 9 (“Institution Decision” or “Dec.”).

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), revised 35 U.S.C. §§ 102 and 103, effective March 16, 2013. Because the challenged patent was filed before March 16, 2013, we refer to the pre-AIA version of §§ 102 and 103 in this decision.

References	Claims Challenged
Liebermann ² and Aronow ³	1–3, 5, 9, 10, and 18
Liebermann, Aronow, and O’Toole ⁴	4, 6, 11–13, and 15
Liebermann, Aronow, and McLaughlin ⁵	7 and 8

Id. at 33.

Subsequent to institution, Patent Owner filed a Patent Owner Response to the Petition (Paper 46, “PO Resp.”), to which Petitioner filed a Reply (Paper 56, “Pet. Reply”). Patent Owner also filed a Motion to Exclude (Paper 63, “Mot. Exc.”) certain exhibits, to which Petitioner filed an Opposition (Paper 68, “Opp. Exc.”). In turn, Patent Owner filed a Reply (Paper 70, “Reply Exc.”). Patent Owner further filed observations on deposition testimony of Mr. Benedict J. Occhiogrosso (Paper 64), to which Petitioner filed a Response (Paper 67).

No oral argument was held, at the request of the parties. Paper 74.

B. Related Matters

The Petition was filed concurrently with three other petitions challenging patents owned by Patent Owner: IPR2015-01357 (U.S. Patent 6,934,366), IPR2015-01358 (U.S. Patent 7,006,604), and IPR2015-01359 (U.S. Patent 6,493,426). Pet. 4. These patents are related to a number of Patent Owner’s patents upon which Petitioner also has filed a petition,

² U.S. Patent No. 5,982,853, issued Nov. 9, 1999 (Ex. 1002, “Liebermann”).

³ U.S. Patent No. 5,521,960, issued May 28, 1996 (Ex. 1003, “Aronow”).

⁴ U.S. Patent No. 5,889,856, issued Mar. 30, 1999 (Ex. 1004, “O’Toole”).

⁵ U.S. Patent No. 6,181,736 B1, filed Mar. 18, 1998, issued Jan. 30, 2001 (Ex. 1005, “McLaughlin”).

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including IPR2013-00540–545, 549, 550, IPR2014-00780, and IPR2015-00636 and 637. *Id.*; Paper 6. We have issued Final Written Decisions in each of those cases.

The parties are involved in several lawsuits involving patents covering related subject matter: *Ultratec, Inc. v. Sorenson Communications, Inc.*, No. 13-CV-00346 (W.D. Wis.), *Ultratec, Inc. v. Sorenson Communications, Inc.*, No. 14-CV-00066 (W.D. Wis.), and *Ultratec, Inc. v. Sorenson Communications, Inc.*, No. 14-CV-00847 (W.D. Wis.). Pet. 3; Paper 6.

C. The '116 Patent

The challenged patent relates to ways to assist communications between hearing impaired individuals and normally hearing individuals. Ex. 1001, 1:13–18. Conventional assistance uses a device having a keyboard and display, which may be called a text telephone (TT), a teletype (TTY), or a telecommunication device for the deaf (TDD). *Id.* at 1:29–39. A human intermediary facilitates communication between a hearing user and a hearing impaired user by communicating by voice with the hearing user and using a TDD to communicate with the hearing impaired user. *Id.* at 1:66–2:4. The system of voice-to-TDD communication used by the human intermediary (called an operator or call assistant) is referred to as a relay. *Id.*

The challenged patent describes a small, hand-held or portable device, with a microphone, a keyboard, and a display, that a hearing impaired person can carry and use to facilitate a conversation between himself or herself and a person with normal hearing. *Id.* at 3:31–60. The challenged patent explains that “the current state of the art in electronic miniaturization and

voice recognition does not yet permit the design of a totally integrated and self-sufficient portable interpreter” that others have “predicted . . . might be available someday.” *Id.* at 3:37–39.

According to the challenged patent, “the key to making this truly portable device available with current technology is to base the operation of this device on the presently available relay system to provide the actual voice to text conversion” of the hearing person’s voice. *Id.* at 3:42–45. The challenged patent terms such as a device “a personal interpreter” and further describes that it uses “a telephone function” to communicate with the relay. *Id.* at 3:34–37, 3:45; *see id.* at Abstract (“By using a wireless telephone connection, the device is made portable.”). “By using the relay system, the personal interpreter can provide effective and accurate voice to text interpretation for the deaf user with, to all outward appearances, a totally portable and small device.” *Id.* at 3:45–48.

Figure 1 of the challenged patent, set forth below, shows an illustration of “a personal interpreter constructed in accordance with the present invention.” *Id.* at 3:21–22.



FIG. 1

Personal interpreter 10 shown in Figure 1 is described as “a small, self-contained, portable hand held device typically the size of a hardbound book,” having a “keyboard of minimal size but useable by a deaf person”

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