

App. 1

NOTE: This disposition is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

ULTRATEC, INC.,
Appellant

v.

CAPTIONCALL, LLC,
Appellee

**ANDREI IANCU, UNDER SECRETARY OF
COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES
PATENT AND TRADEMARK OFFICE,**
Intervenor

2019-1998, 2019-1999, 2019-2001, 2019-2002

Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2013-00540, IPR2013-00541, IPR2013-00544, IPR2013-00545.

JUDGMENT

(Filed Oct. 14, 2020)

App. 2

KRISTIN GRAHAM NOEL, Quarles & Brady, LLP, Madison, WI, argued for appellant. Also represented by MARTHA JAHN SNYDER, ANTHONY ALLEN TOMASELLI.

PRATIK A. SHAH, Akin Gump Strauss Hauer & Feld LLP, Washington, DC, argued for appellee. Also represented by Z.W. JULIUS CHEN, RACHEL J. ELSBY; MICHAEL P. KAHN, CAITLIN ELIZABETH OLWELL, MICHAEL NASSER PETEGORSKY, New York, NY; RUBEN H. MUNOZ, Philadelphia, PA.

FRANCES LYNCH, Office of the Solicitor, United States Patent and Trademark Office, Alexandria, VA, argued for intervenor. Also represented by THOMAS W. KRAUSE, FARHEENA YASMEEN RASHEED, MOLLY R. SILFEN.

THIS CAUSE having been heard and considered, it is
ORDERED and ADJUDGED:

PER CURIAM (PROST, *Chief Judge*, LOURIE and MOORE, *Circuit Judges*).

AFFIRMED. See Fed. Cir. R. 36.

ENTERED BY ORDER OF THE COURT

October 14, 2020
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

App. 3

NOTE: This disposition is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

ULTRATEC, INC.,
Appellant

v.

CAPTIONCALL, LLC,
Appellee

**ANDREI IANCU, UNDER SECRETARY OF
COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES
PATENT AND TRADEMARK OFFICE,**
Intervenor

2019-2000, 2019-2005, 2019-2006

Appeals from the United States Patent and
Trademark Office, Patent Trial and Appeal Board in
Nos. IPR2013-00542, IPR2013-00543, IPR2013-00550.

JUDGMENT

(Filed Oct. 14, 2020)

KRISTIN GRAHAM NOEL, Quarles & Brady, LLP,
Madison, WI, argued for appellant. Also represented by
MARTHA JAHN SNYDER, ANTHONY ALLEN TOMASELLI.

App. 4

PRATIK A. SHAH, Akin Gump Strauss Hauer & Feld LLP, Washington, DC, argued for appellee. Also represented by Z.W. JULIUS CHEN, RACHEL J. ELSBY; MICHAEL P. KAHN, CAITLIN ELIZABETH OLWELL, MICHAEL NASSER PETEGORSKY, New York, NY; RUBEN H. MUNOZ, Philadelphia, PA.

FRANCES LYNCH, Office of the Solicitor, United States Patent and Trademark Office, Alexandria, VA, argued for intervenor. Also represented by THOMAS W. KRAUSE, FARHEENA YASMEEN RASHEED, MOLLY R. SILFEN.

THIS CAUSE having been heard and considered, it is
ORDERED and ADJUDGED:

PER CURIAM (PROST, *Chief Judge*, LOURIE and MOORE, *Circuit Judges*).

AFFIRMED. See Fed. Cir. R. 36.

ENTERED BY ORDER OF THE COURT

October 14, 2020
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

App. 5

NOTE: This disposition is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

ULTRATEC, INC.,
Appellant

v.

CAPTIONCALL, LLC,
Appellee

**ANDREI IANCU, UNDER SECRETARY OF
COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES
PATENT AND TRADEMARK OFFICE,**
Intervenor

2019-2003, 2019-2004

Appeals from the United States Patent and
Trademark Office, Patent Trial and Appeal Board in
Nos. IPR2013-00549, IPR2014-00780.

JUDGMENT

(Filed Oct. 14, 2020)

KRISTIN GRAHAM NOEL, Quarles & Brady, LLP,
Madison, WI, argued for appellant. Also represented by
MARTHA JAHN SNYDER, ANTHONY ALLEN TOMASELLI.

App. 6

PRATIK A. SHAH, Akin Gump Strauss Hauer & Feld LLP, Washington, DC, argued for appellee. Also represented by Z.W. JULIUS CHEN, RACHEL J. ELSBY; MICHAEL P. KAHN, CAITLIN ELIZABETH OLWELL, MICHAEL NASSER PETEGORSKY, New York, NY; RUBEN H. MUNOZ, Philadelphia, PA.

FRANCES LYNCH, Office of the Solicitor, United States Patent and Trademark Office, Alexandria, VA, argued for intervenor. Also represented by THOMAS W. KRAUSE, FARHEENA YASMEEN RASHEED, MOLLY R. SILFEN.

THIS CAUSE having been heard and considered, it is
ORDERED and ADJUDGED:

PER CURIAM (PROST, *Chief Judge*, LOURIE and MOORE, *Circuit Judges*).

AFFIRMED. See Fed. Cir. R. 36.

ENTERED BY ORDER OF THE COURT

October 14, 2020
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

App. 7

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Paper 108
Entered: April 10, 2019

UNITED STATES PATENT
AND TRADEMARK OFFICE

BEFORE THE PATENT
TRIAL AND APPEAL BOARD

CAPTIONCALL, L.L.C.,
Petitioner,

v.

ULTRATEC, INC.,
Patent Owner.

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)

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

PER CURIAM.

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

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

App. 9

claims were unpatentable. IPR540, Paper 78, 53 (Final Written 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

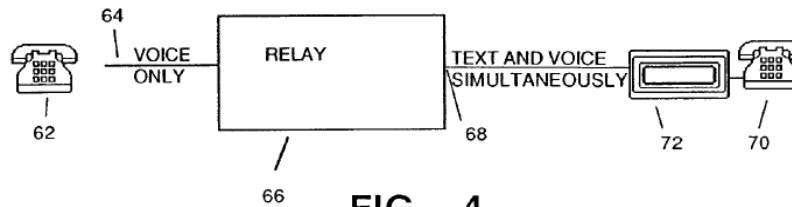
App. 10

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 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:

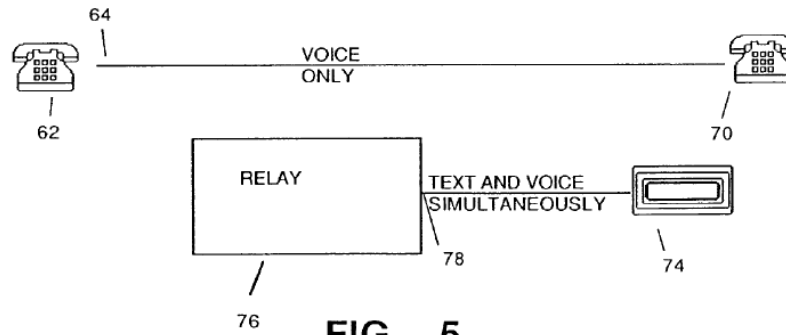
App. 11



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. 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.

App. 12



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

App. 13

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.

“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:

App. 14

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) ¹	§ 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

¹ Ex. 1005 is in Japanese; Ex. 1006 is a certified English translation.

App. 15

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) ²	§ 103	7
	Ryan and McLaughlin (Ex. 1009)	§ 103	7–11

² Ex. 1006 is in Japanese; Ex. 1007 is a certified English translation.

App. 16

IPR/Patent	Reference(s)	Basis	Claim(s)
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, 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

App. 17

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 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.

App. 18

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:

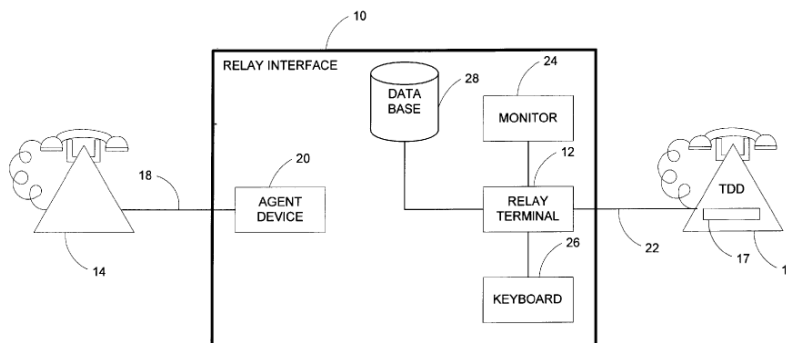


FIG. 1

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 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).

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

App. 21

cross examination that Patent Owner alleges is inconsistent with his testimony in these *inter partes* reviews. Remand Order 9 (citing Ex. 2029, 10:2–15; Ex. 3004, 4).³ 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).

³ Citations in the Remand Order are to exhibits in IPR540 unless otherwise noted.

2. *Authorized Briefing*

Regarding briefing during the post-remand proceeding, Petitioner indicated that the remand from the Federal Circuit was narrow and was 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 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. Occhiosso’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 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 *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. Pragmatius 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, 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* 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 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.

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.⁴ According to

⁴ 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 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,

Patent Owner, Mr. Occhiogrosso testified 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.

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

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.

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.⁵ We then address the 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

⁵ 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 “Hearing/Speaking Persons Calling Deaf and/or Speech Impaired Persons.” *See supra* Section I.A.2.

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 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.

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

App. 35

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 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 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.

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.⁶ 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. 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.

⁶ 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.

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?

App. 41

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, 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, 54.⁷ In each of these decisions, we 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

⁷ On rehearing, we modified our analysis regarding the rationale for 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).

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. 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."⁸ PO Br. 22–23 (citing IPR542, Paper 66, 20,

⁸ 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

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 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*

Decision. *See e.g.*, IPR544, Paper 74, 51 (citing Ex. 2010 ¶¶ 32–34).

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 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,⁹ that Ryan describes voice recognition software “trained to the voice of the call assistant,” as required by the claims at issue in those

⁹ IPR540, IPR541, IPR542, IPR543, IPR544, and IPR545.

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 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 *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 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 ¶ 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

App. 52

IPR testimony. PO Br. 34–46. Patent Owner asserts Mr. Occhiogrosso’s trial testimony regarding software 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 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

App. 54

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, 57:14–22¹⁰; PO Br. 38–39 (quoting Ex. 2032, 56:25–58:13).

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, 58:2–6¹¹; 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

¹⁰ 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.”).

¹¹ 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.”).

that voice recognition software is saved on the composite terminal. Ex. 2032, 58:7–13,¹² 59:12–15.¹³

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 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.

¹² 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.”).

¹³ 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.”).

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 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 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, 63:2–13.¹⁴

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).

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

¹⁴ 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.”).

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.

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).

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.¹⁵

¹⁵ 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

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.

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. . . .”).

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.

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 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 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 18.¹⁶ 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

¹⁶ 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.*

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.

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.

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.

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App. 69

**United States Court of Appeals
for the Federal Circuit**

ULTRATEC, INC.,
Appellant

v.

CAPTIONCALL, LLC,
Appellee

**JOSEPH MATAL, PERFORMING THE
FUNCTIONS & DUTIES OF THE UNDER
SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND
DIRECTOR, U.S. PATENT &
TRADEMARK OFFICE, UNITED STATES,**
Intervenors

2016-1706, 2016-1707, 2016-1710, 2016-1712

Appeals from the United States Patent and
Trademark Office, Patent Trial and Appeal Board in
Nos. IPR2013-00540, IPR2013-00541, IPR2013-00544,
IPR2013-00545.

App. 70

ULTRATEC, INC.,
Appellant

v.

CAPTIONCALL, LLC,
Appellee

**JOSEPH MATAL, PERFORMING THE
FUNCTIONS & DUTIES OF THE UNDER
SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND
DIRECTOR, U.S. PATENT &
TRADEMARK OFFICE, UNITED STATES,**
Intervenors

2016-1708, 2016-1709, 2016-1715

Appeals from the United States Patent and Trade-
mark Office, Patent Trial and Appeal Board in Nos.
IPR2013-00542, IPR2013-00543, IPR2013-00550.

ULTRATEC, INC.,
Appellant

v.

CAPTIONCALL, LLC,
Appellee

**JOSEPH MATAL, PERFORMING THE
FUNCTIONS & DUTIES OF THE UNDER
SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND**

App. 71

**DIRECTOR, U.S. PATENT &
TRADEMARK OFFICE, UNITED STATES,**
Intervenors

2016-1713, 2016-2366

Appeals from the United States Patent and Trade-
mark Office, Patent Trial and Appeal Board in Nos.
IPR2013-00549, IPR2014-00780.

Decided: August 28, 2017

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MARK R. FREEMAN, Appellate Staff, Civil Division, United States Department of Justice, Washington, DC, for intervenor United States. Also represented by SARAH CARROLL.

Before NEWMAN, LINN, and MOORE, *Circuit Judges*.

MOORE, *Circuit Judge*.

The present appeals arise from a series of inter partes reviews (“IPRs”) between Ultratec, Inc. (“Ultratec”) and CaptionCall, LLC (“CaptionCall”). Ultratec owns U.S. Patent Nos. 5,909,482 (“the ’482 patent”), 6,233,314 (“the ’314 patent”), 6,594,346 (“the ’346 patent”), 6,603,835 (“the ’835 patent”), 7,003,082 (“the ’082 patent”), 7,319,740 (“the ’740 patent”), 7,555,104 (“the ’104 patent”), and 8,213,578 (“the ’578 patent”). The patents disclose and claim systems for assisting deaf or hard-of-hearing users to make phone calls. CaptionCall petitioned for IPR of certain claims of Ultratec’s patents. The Patent Trial and Appeal Board (“the Board”) held that all challenged claims were either anticipated or would have been obvious in light of a variety of prior art references. Ultratec appealed to our court. The United States Patent and Trademark Office and the Department of Justice (collectively, “the PTO”) intervened to defend the Board’s decisions. Because the Board failed to consider material evidence

and failed to explain its decisions to exclude the evidence, we vacate and remand.

BACKGROUND

Ultratec and CaptionCall are currently litigating in both district court and before the Board. Ultratec sued CaptionCall and its parent company for infringement in the Western District of Wisconsin. The case proceeded to trial, where the jury found the patents valid and infringed and awarded damages of \$44.1 million. Five months after the verdict, the Board issued final written decisions holding all challenged claims of Ultratec's patents were either anticipated or would have been obvious. The district court subsequently stayed all post-judgment proceedings pending final resolution of the IPRs.

CaptionCall retained the same invalidity expert—Mr. Benedict Occhiogrosso—in the district court litigation and the IPRs. In some instances, Mr. Occhiogrosso testified about the same issues and references in both proceedings. Ultratec sought to introduce the trial testimony into the IPRs, alleging that Mr. Occhiogrosso's trial testimony conflicted with written declarations he made in the IPRs.

Ultratec moved to supplement the record with the inconsistent Occhiogrosso trial testimony. Because Ultratec had not first requested authorization to file the motion with the inconsistent testimony, the Board expunged the motion from the record. PTO Br. at 10 n.8. The Board's regulations require that a party

seeking to introduce supplemental evidence more than one month after institution first request authorization to file a motion to submit the evidence. 37 C.F.R. § 42.123(b). As the PTO explained to Ultratec, with regard to its request to file a motion to supplement the record, “[n]o evidence is permitted to be filed,” and the briefing “must not include a discussion of the contents or types of the particular documents sought to be entered.” PTO Br. at 10 n.8. On October 30, 2014, within a week of the jury trial, Ultratec requested authorization to file a motion to submit portions of Mr. Occhiogrosso’s trial testimony to the Board. Ultratec alleged that Mr. Occhiogrosso’s trial testimony addressing a prior art reference was inconsistent with his IPR declarations on that same point.¹ On November 4, 2014, the Board held a conference call to consider Ultratec’s request for authorization to file a motion to supplement the IPR record with Mr. Occhiogrosso’s trial testimony. The Board did not review the testimony when deciding whether it could be admitted. J.A. 9005; *see* PTO Br. 10 n.8. It denied Ultratec’s request during the call and indicated a written order would follow. The Board never issued any such order. On November 19, 2014, two weeks after the conference call,

¹ *See* J.A. 6818 (“For example, the type of testimony Patent Owners were proffering included Mr. Occhiogrosso testifying generally in agreement with Patent Owner’s points above that traditional VCO is a one-line arrangement, and that there are differences between the embodiments in Sections 4(a), 4(b), and 4(c) of *McLaughlin*.”).

the Board conducted a short oral hearing on the Ultratec patents.²

The Board issued final written decisions, holding that every challenged claim was either anticipated or would have been obvious. These final written decisions rely heavily on the Board's belief that Mr. Occhiogrosso was a credible witness. *See, e.g.*, J.A. 11,206 ("It is within our discretion to assign the appropriate weight to the testimony offered by Mr. Occhiogrosso."). The Board cited Mr. Occhiogrosso's testimony over thirty times to support its findings, including at least once for each of the eight patents on appeal.³ In some instances,

² The PTO at times refers to the IPR proceedings as a "trial." PTO Br. 5. Very seldom do IPR proceedings have the hallmarks of what is typically thought of as a trial. *See* Joanna Shepherd, *Disrupting the Balance: The Conflict Between Hatch-Waxman and Inter Partes Review*, 6 NYU J. INTELL. PROP. & ENT. L. 14, 37 (2016) ("In contrast to the expansive discovery and witness testimony that is common in district court litigation, discovery is significantly restricted and live testimony is rarely allowed in IPR proceedings."); Eric Cohen, *A Primer on Inter Partes Review, Covered Business Method Review, and Post-Grant Review Before the Patent Trial and Appeal Board*, 24 FED. CIR. B.J. 1, 5 n.40 (2014) (noting that in the first two years of IPRs, the Board allowed live testimony once). In this case, the IPR proceeding itself was limited to a brief argument by the lawyers for each side, and there was no live testimony by any witness.

³ *See, e.g.*, -1706 appeal J.A. 27, 49, 53 (addressing the '314 patent); J.A. 3644, 3648, 3655, 3660, 3664 (addressing the '482 patent); J.A. 7393, 7395, 7403, 7405 (addressing the '578 patent); J.A. 7419, 7420, 7421 (addressing the '578 patent on rehearing); J.A. 11,195, 11,205, 11,206 (addressing the '346 patent); -1708 appeal J.A. 23, 27 (addressing the '740 patent); J.A. 38, 40 (addressing the '740 patent on rehearing); J.A. 3224 (addressing the '104 patent); J.A. 3237, 3239 (addressing the '104 patent on

the Board explicitly found Mr. Occhiogrosso more credible than Ultratec's expert. *See* J.A. 23 (“We credit the testimony of Mr. Occhiogrosso over that of Mr. Steel on this issue. . . .”); J.A. 3660 (“Weighing Mr. Occhiogrosso’s testimony against Mr. Ludwick’s testimony, we credit Mr. Occhiogrosso’s testimony. . . .”); J.A. 7403 (“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. Ludwick.”). In other instances, the Board found Mr. Occhiogrosso credible on the very issue Ultratec alleges he contradicted at trial. *See* J.A. 6383 (“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.”); *see also* J.A. 23, 27, 7403.

Ultratec moved for reconsideration on a variety of grounds, including that the Board failed to consider Mr. Occhiogrosso’s trial testimony and failed to explain its decision to exclude the new evidence. *See* J.A. 6818–20. The Board denied the motion to reconsider. It reasoned:

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

rehearing); J.A. 6383 (addressing the ’082 patent); -1713 appeal J.A. 23, 24, 3262 (addressing the ’835 patent).

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 [sic] 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 was necessary. To the extent Patent Owner wishes its denial of authorization to file late evidence to be further memorialized, this paper serves such purpose.

J.A. 6394–95 (emphasis in original).

Ultratec filed a motion to supplement the appellate record, requesting that the Board make part of the record Ultratec’s request for authorization to file a motion to supplement the record with Mr. Occhiogrosso’s trial testimony and the Board’s denial of that request. J.A. 9002–03. The Board held that “the records would be adequately supplemented” by adding only two documents: Ultratec’s motion for rehearing of the final written decision, and the Board’s denial of that motion. J.A. 9003. Ultratec then filed a second motion to supplement the appellate record. This time, Ultratec requested the Board include Ultratec’s October 30, 2014 email to the Board requesting a conference call to address its request for authorization to file a motion. The Board denied the motion. It explained the “emails

requesting conference calls are intended to be administrative in nature; it is improper for substantive arguments to be made in emails requesting conference calls.” J.A. 9046 n.3.

Ultratec appealed to our court. The PTO intervened to defend the Board’s decision. We have jurisdiction pursuant to 28 U.S.C. § 1295(a)(4)(A).

DISCUSSION

We review the Board’s decision of how it manages its permissive rules of trial proceedings for abuse of discretion. *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 442 (Fed. Cir. 2015). The Board abuses its discretion if the decision: (1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact findings; or (4) involves a record that contains no evidence on which the Board could rationally base its decision. *Id.* (quoting *Abrutyn v. Giovanniello*, 15 F.3d 1048, 1050–51 (Fed. Cir. 1994)).

Congress gave the PTO authority to “prescribe regulations establishing procedures for the submission of supplemental information after the petition is filed.” 35 U.S.C. § 316(a)(3). Under the PTO’s regulations, a party seeking to submit supplemental information more than one month after the date an IPR is instituted must request authorization to file a motion to submit the information. 37 C.F.R. § 42.123(b). The request to submit new information must show: (1) why the supplemental information reasonably could not

have been obtained earlier, and (2) that consideration of the supplemental information would be in the interests of justice. *Id.* The PTO considers the interests of justice as slightly higher than good cause:

Good cause and interests-of-justice are closely related standards, but the interests-of-justice standard is slightly higher than good cause. While a good cause standard requires a party to show a specific factual reason to justify the needed discovery, under the interests-of-justice standard, the Board would look at all relevant factors. Specifically, to show good cause, a party would be required to make a particular and specific demonstration of fact. Under the interests-of-justice standard, the moving party would also be required to show that it was fully diligent in seeking discovery and that there is no undue prejudice to the non-moving party.

77 Fed. Reg. 48,719 (Aug. 14, 2012). The Board's Patent Trial Practice Guide explains that when a party desires to request authorization to file a motion, it should institute a conference call with the Board. 77 Fed. Reg. 48,762–63 (Aug. 14, 2012). The Guide explains that:

Typically, the Board will decide procedural issues raised in a conference call during the call itself or shortly thereafter, thereby avoiding the need for additional briefing. The Board has found that this practice simplifies a proceeding by focusing the issues early, reducing

costs and efforts associated with motions that are beyond the scope of the proceeding.

Id.

This record affords but one reasonable conclusion: Ultratec satisfied both of § 42.123(b)'s requirements for allowing Ultratec to file a motion to admit Mr. Occhiogrosso's trial testimony. First, the evidence could not have been obtained earlier. Ultratec emailed the Board requesting authorization to file a motion to supplement the record the week after the jury trial concluded. This is not evidence that could have been located earlier through a more diligent or exhaustive search; it did not exist during the IPR discovery period. The fact that Ultratec could have, but did not, depose *and* obtain inconsistent testimony from Mr. Occhiogrosso during the IPR itself is not a basis for concluding otherwise. Ultratec argues that during cross examination at trial in front of the jury Mr. Occhiogrosso offered testimony that is inconsistent with his IPR testimony. That inconsistent testimony did not exist sooner and thus could not have been proffered to the Board sooner.

The Board offers no reasoned basis why it would not be in the interest of justice to consider sworn inconsistent testimony on the identical issue. Ultratec sought to offer recent sworn testimony of the same expert addressing the same patents, references, and limitations at issue in the IPRs. A reasonable adjudicator would have wanted to review this evidence. If Mr. Occhiogrosso gave conflicting testimony on

cross-examination, this would be highly relevant to both the Board's analysis of the specific issues on which he gave inconsistent testimony and to the Board's overall view of his credibility. Mr. Occhiogrosso's testimony was critical to the Board's fact findings in this case, as the opinions' repeated reliance on it establishes. Under such circumstances, no reasonable fact finder would refuse to consider evidence of inconsistent sworn testimony. Moreover, any such inconsistencies would likely bear on the overall credibility of the expert.

Admitting and reviewing Mr. Occhiogrosso's trial testimony would have placed minimal additional burden on the Board. Live testimony is rare in IPR hearings, which typically last only about an hour. *See* 77 Fed. Reg. at 48,762. The Board—as it did in these IPRs—makes credibility determinations based only on written declarations. Ultratec sought to introduce more written testimony. This is the exact type of evidence the Board routinely relies upon to determine credibility. There would have been very little administrative burden to reviewing more on-point testimony from the same expert on the same exact issues. Had the testimony been inconsistent, a reasonable fact finder would consider the inconsistencies. Had the testimony been consistent, the Board would not have had to spend any more time on the issue.⁴

⁴ The PTO speculates on appeal that the Board denied the request for authorization because it was too late in the proceedings to admit new evidence. PTO Br. 19. Section 42.123(b) expressly contemplates late submission of supplemental information and articulates the two factors to be assessed in determining its

A number of problems with the Board's procedures contributed to its errors in this case. First, the Board lacked the information necessary to make a reasoned decision. According to the Board, the movant cannot submit for consideration the evidence it seeks to admit into the record, and its briefing "must not include a discussion of the contents or types of the particular documents sought to be entered." PTO Br. at 10 n.8. In this case, the Board denied a request to admit evidence without ever seeing the evidence it was denying; it never reviewed Mr. Occhiogrosso's testimony because Ultratec was not allowed to submit that evidence with its request to file a motion to supplement the record. The Board's only exposure to the disputed testimony was the parties' competing characterizations of it during the conference call for which there exists no record.

Second, the Board's procedures allowed it to make significant evidentiary decisions without providing an explanation or a reasoned basis for its decisions. *See Motor Vehicle Mfs. Ass'n of U.S. v. State Farm Mut. Auto. Ins. Co.*, 463 U.S. 29, 43 (1983) ("[T]he agency must examine the relevant data and articulate a satisfactory explanation for its action including a rational

admissibility. It thus cannot be the case that the late filing alone precludes consideration of the evidence. Ultratec requested to supplement the record three weeks prior to the IPR hearings. This would normally give the Board sufficient time to review the supplemental testimony and prepare any necessary questions for oral argument. Moreover, the same statute that imposes a one-year deadline for the Board to make its final determination gives it the ability to extend the deadline if good cause is shown. *See* 35 U.S.C. § 316(a)(11).

connection between the facts found and the choice made.” (internal quotation marks omitted)).

Third, the Board’s procedures impede meaningful appellate review of the agency decision-making. “[W]e will uphold a decision of less than ideal clarity if the agency’s path may reasonably be discerned, but we may not supply a reasoned basis for the agency’s action that the agency itself has not given.” *Rovalma, S.A. v. Bohler-Edelstahl GmbH & Co.*, 856 F.3d 1019, 1024 (Fed. Cir. 2017) (internal quotation marks omitted). “For judicial review to be meaningfully achieved within these strictures, the agency tribunal must present a full and reasoned explanation of its decision.” *In re Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002). The agency does not have unfettered discretion in these matters, and we cannot affirm agency decision-making where the agency fails to provide a reasoned basis for its decision. *See SEC v. Chenery Corp.*, 318 U.S. 80, 94 (1943) (“[T]he orderly functioning of the process of review requires that the grounds upon which the administrative agency acted b[e] clearly disclosed and adequately sustained.”); *SEC v. Chenery Corp.*, 332 U.S. 194, 196 (1947) (“That rule is to the effect that a reviewing court, in dealing with a determination or judgment which an administrative agency alone is authorized to make, must judge the propriety of such action solely by the grounds invoked by the agency. If those grounds are inadequate or improper, the court is powerless to affirm the administrative action by substituting what it considers to be a more adequate or proper basis.”). There is no Board order explaining why

it denied Ultratec's request to file a motion to supplement the record. Nor is there any Board explanation capable of review from the conference call.⁵ We are also prohibited from viewing Mr. Occhiogrosso's testimony because it is not part of the record. In district court litigation, a party dissatisfied with a ruling excluding evidence is allowed to make an offer of proof to preserve error. Fed. R. Evid. 103. Parties in IPRs are not given similar protections.⁶ In this case, the PTO forbade even a "discussion of the contents or types of the particular documents sought to be entered." PTO Br. at 10 n.8. And it refused to permit the record to include Ultratec's email requesting authorization to file a motion to supplement the record. Excluding such discussion from the record contributes to the unreviewability of the Board's decision-making.

CaptionCall and the PTO argue Ultratec bore the responsibility to memorialize the conference call if it

⁵ The PTO indicated that the Board typically utilizes conference calls to address issues such as requests for extensions or requests to extend page limits. Oral Arg. at 54:45, 1:02:00. We do not address whether the Board can decide these types of minor procedural issues during conference calls. We hold that when the Board makes a substantive evidentiary ruling, it is required to explain its decision.

⁶ During oral argument, CaptionCall argued that although Mr. Occhiogrosso's trial testimony was not part of the IPR record, it is publicly available as part of the district court record, and therefore we could take judicial notice of the testimony and determine in the first instance whether it was consistent with his IPR declarations. Oral Arg. at 40:30-43:25. Our court does not have authority, as CaptionCall urges, to review evidence not considered by the agency and make factual determinations about the substance of that evidence.

desired a written record. CaptionCall Br. 28; PTO Br. 25. There are, however, no statutes, regulations, statements in the Patent Trial Practice Guide, nor even notes on the PTO's website informing parties that they have the right to hire a stenographer to transcribe conference calls. We find no burden on the patentee to memorialize agency action or reasoning. It is the agency that has the obligation to fulfill its APA duty to provide a "satisfactory explanation for its action." *See Motor Vehicle Mfs. Ass'n*, 463 U.S. at 43.

The only reason there is any written record of the dispute is because Ultratec raised the issue in a motion for rehearing. The Board addressed the issue in its order denying rehearing, but it did not explain why it denied the request for authorization. *See* J.A. 6394–95. The Board noted that a conference call occurred, but it never stated what was discussed on the call. J.A. 6394. Nor did the Board address the substance of Mr. Occhiogrosso's trial testimony. *Id.* And although the Board cited the interests of justice provision of 37 C.F.R. § 42.123(b), it never explained why its actions were in the interests of justice. *Id.* The Board explained that it was not obligated to provide an explanation in the first place. The Board reasoned that "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 [sic] 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 was necessary." *Id.* If the APA requires the Board

to explain a denial of a motion then it likewise requires the Board to explain the denial of a request to make a motion. To the extent the Board views the two-step process it created to file motions as insulating it from its APA obligations, this is incorrect.

The Board abused its discretion when it refused to admit and consider Mr. Occhiogrosso's trial testimony and when it refused to explain its decision. Because the Board relied on Mr. Occhiogrosso's credibility in every IPR, we vacate every decision. *See In re Van Os*, 844 F.3d 1359, 1362 (Fed. Cir. 2017) (“[W]hen the Board’s action is potentially lawful but insufficiently or inappropriately explained, we have consistently vacated and remanded for further proceedings.” (internal quotation marks omitted)). On remand, the Board shall admit and consider Mr. Occhiogrosso's trial testimony. 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.

CONCLUSION

The Board's final written decisions are *vacated* and *remanded*.

VACATED AND REMANDED

COSTS

Costs to Ultratec.

App. 87

NOTE: This order is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

ULTRATEC, INC.,
Appellant

v.

CAPTIONCALL, LLC,
Appellee

**ANDREI IANCU, UNDER SECRETARY OF
COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES
PATENT AND TRADEMARK OFFICE,**
Intervenor

2019-1998, 2019-1999, 2019-2001, 2019-2002

Appeals from the United States Patent and Trade-
mark Office, Patent Trial and Appeal Board in Nos.
IPR2013-00540, IPR2013-00541, IPR2013-00544,
IPR2013-00545.

**ON PETITION FOR PANEL REHEARING AND
REHEARING EN BANC**

(Filed Jan. 5, 2021)

App. 88

Before PROST, *Chief Judge*, NEWMAN, LOURIE, DYK,
MOORE, O'MALLEY, REYNA, WALLACH, TARANTO, CHEN,
HUGHES, and STOLL, *Circuit Judges*.

PER CURIAM.

ORDER

Appellant Ultratec, Inc. filed a combined petition for panel rehearing and rehearing en banc. The petition was referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc was referred to the circuit judges who are in regular active service.

Upon consideration thereof,

IT IS ORDERED THAT:

The petition for panel rehearing is denied.

The petition for rehearing en banc is denied.

The mandate of the court will issue on January 12, 2021.

FOR THE COURT

January 5, 2021
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

App. 89

NOTE: This order is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

ULTRATEC, INC.,
Appellant

v.

CAPTIONCALL, LLC,
Appellee

**ANDREI IANCU, UNDER SECRETARY OF
COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES
PATENT AND TRADEMARK OFFICE,**
Intervenor

2019-2000, 2019-2005, 2019-2006

Appeals from the United States Patent and Trade-
mark Office, Patent Trial and Appeal Board in Nos.
IPR2013-00542, IPR2013-00543, IPR2013-00550.

**ON PETITION FOR PANEL REHEARING AND
REHEARING EN BANC**

(Filed Jan. 5, 2021)

Before PROST, *Chief Judge*, NEWMAN, LOURIE, DYK,
MOORE, O'MALLEY, REYNA, WALLACH, TARANTO, CHEN,
HUGHES, and STOLL, *Circuit Judges*.

App. 90

PER CURIAM.

ORDER

Appellant Ultratec, Inc. filed a combined petition for panel rehearing and rehearing en banc. The petition was referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc was referred to the circuit judges who are in regular active service.

Upon consideration thereof,

IT IS ORDERED THAT:

The petition for panel rehearing is denied.

The petition for rehearing en banc is denied.

The mandate of the court will issue on January 12, 2021.

FOR THE COURT

January 5, 2021
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

App. 91

NOTE: This order is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

ULTRATEC, INC.,
Appellant

v.

CAPTIONCALL, LLC,
Appellee

**ANDREI IANCU, UNDER SECRETARY OF
COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES
PATENT AND TRADEMARK OFFICE,**
Intervenor

2019-2003, 2019-2004

Appeals from the United States Patent and Trade-
mark Office, Patent Trial and Appeal Board in Nos.
IPR2013-00549, IPR2014-00780.

**ON PETITION FOR PANEL REHEARING AND
REHEARING EN BANC**

(Filed Jan. 5, 2021)

Before PROST, *Chief Judge*, NEWMAN, LOURIE, DYK,
MOORE, O'MALLEY, REYNA, WALLACH, TARANTO, CHEN,
HUGHES, and STOLL, *Circuit Judges*.

App. 92

PER CURIAM.

ORDER

Appellant Ultratec, Inc. filed a combined petition for panel rehearing and rehearing en banc. The petition was referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc was referred to the circuit judges who are in regular active service.

Upon consideration thereof,

IT IS ORDERED THAT:

The petition for panel rehearing is denied.

The petition for rehearing en banc is denied.

The mandate of the court will issue on January 12, 2021.

FOR THE COURT

January 5, 2021
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

U. S. Const. amend. V.

No person shall be held to answer for a capital, or otherwise infamous crime, unless on a presentment or indictment of a grand jury, except in cases arising in the land or naval forces, or in the militia, when in actual service in time of war or public danger; nor shall any person be subject for the same offense to be twice put in jeopardy of life or limb; nor shall be compelled in any criminal case to be a witness against himself, nor be deprived of life, liberty, or property, without due process of law; nor shall private property be taken for public use, without just compensation.

FEDERAL CIRCUIT RULE 36

Entry of Judgment

(a) Judgment of Affirmance Without Opinion.

The court may enter a judgment of affirmance without opinion, citing this rule, when it determines that any of the following conditions exist and an opinion would have no precedential value:

- (1) the judgment, decision, or order of the trial court appealed from is based on findings that are not clearly erroneous;
- (2) the evidence supporting the jury's verdict is sufficient;
- (3) the record supports summary judgment, directed verdict, or judgment on the pleadings;
- (4) the decision of an administrative agency warrants affirmance under the standard of review in the statute authorizing the petition for review; or
- (5) a judgment or decision has been entered without an error of law.

(b) Separate Judgment.

The clerk of court will not prepare a separate judgment when a case is disposed of by order without opinion. The order of the court serves as the judgment when entered.

App. 95

28 U.S.C § 2071(a), enacted Nov. 19, 1988, Pub.L. 100-702, Title IV, § 403(a)(1), 102 Stat. 4650, provides:

(a) The Supreme Court and all courts established by Act of Congress may from time to time prescribe rules for the conduct of their business. Such rules shall be consistent with Acts of Congress and rules of practice and procedure prescribed under section 2072 of this title.

35 U.S.C. § 6. Patent Trial and Appeal Board

(a) In General. – There shall be in the Office a Patent Trial and Appeal Board. The Director, the Deputy Director, the Commissioner for Patents, the Commissioner for Trademarks, and the administrative patent judges shall constitute the Patent Trial and Appeal Board. The administrative patent judges shall be persons of competent legal knowledge and scientific ability who are appointed by the Secretary, in consultation with the Director. Any reference in any Federal law, Executive order, rule, regulation, or delegation of authority, or any document of or pertaining to the Board of Patent Appeals and Interferences is deemed to refer to the Patent Trial and Appeal Board.

(b) Duties. – The Patent Trial and Appeal Board shall –

(1) on written appeal of an applicant, review adverse decisions of examiners upon applications for patents pursuant to section 134(a);

App. 96

- (2) review appeals of reexaminations pursuant to section 134(b);
- (3) conduct derivation proceedings pursuant to section 135; and
- (4) conduct inter partes reviews and post-grant reviews pursuant to chapters 31 and 32.

(c) 3-Member Panels. – Each appeal, derivation proceeding, post-grant review, and 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. Only the Patent Trial and Appeal Board may grant rehearings.

(d) Treatment of Prior Appointments. – The Secretary of Commerce may, in the Secretary's discretion, deem the appointment of an administrative patent judge who, before the date of the enactment of this subsection, held office pursuant to an appointment by the Director to take effect on the date on which the Director initially appointed the administrative patent judge. It shall be a defense to a challenge to the appointment of an administrative patent judge on the basis of the judge's having been originally appointed by the Director that the administrative patent judge so appointed was acting as a de facto officer.

App. 97

35 U.S.C. § 141. Appeal to Court of Appeals for the Federal Circuit

(a) **Examinations.** – An applicant who is dissatisfied with the final decision in an appeal to the Patent Trial and Appeal Board under section 134(a) may appeal the Board’s decision to the United States Court of Appeals for the Federal Circuit. By filing such an appeal, the applicant waives his or her right to proceed under section 145.

(b) **Reexaminations.** – A patent owner who is dissatisfied with the final decision in an appeal of a reexamination to the Patent Trial and Appeal Board under section 134(b) may appeal the Board’s decision only to the United States Court of Appeals for the Federal Circuit.

(c) **Post-Grant and Inter Partes Reviews.** – A party to an inter partes review or a post-grant review who is dissatisfied with the final written decision of the Patent Trial and Appeal Board under section 318(a) or 328(a) (as the case may be) may appeal the Board’s decision only to the United States Court of Appeals for the Federal Circuit.

(d) **Derivation Proceedings.** – A party to a derivation proceeding who is dissatisfied with the final decision of the Patent Trial and Appeal Board in the proceeding may appeal the decision to the United States Court of Appeals for the Federal Circuit, but such appeal shall be dismissed if any adverse party to such derivation proceeding, within 20 days after the appellant has filed notice of appeal in accordance with section 142, files

App. 98

notice with the Director that the party elects to have all further proceedings conducted as provided in section 146. If the appellant does not, within 30 days after the filing of such notice by the adverse party, file a civil action under section 146, the Board's decision shall govern the further proceedings in the case.

35 U.S.C. § 144 – Current & Prior Versions

35 U.S.C. § 144, effective November 2, 2002, provides:

The United States Court of Appeals for the Federal Circuit shall review the decision from which an appeal is taken on the record before the Patent and Trademark Office. Upon its determination the court shall issue to the Director its mandate and opinion, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case.

35 U.S.C.A. § 144, effective March 29, 2000 to November 1, 2002, provides:

The United States Court of Appeals for the Federal Circuit shall review the decision from which an appeal is taken on the record before the Patent and Trademark Office. Upon its determination the court shall issue to the Director its mandate and opinion, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case.

App. 99

35 U.S.C.A. § 144, enacted Nov. 8, 1984, Pub.L. 98-620, Title IV, § 414(a), 98 Stat. 3363, effective to March 28, 2000, provides:

The United States Court of Appeals for the Federal Circuit shall review the decision from which an appeal is taken on the record before the Patent and Trademark Office. Upon its determination the court shall issue to the Commissioner its mandate and opinion, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case.

—

35 U.S.C. § 261. Ownership; assignment

Subject to the provisions of this title, patents shall have the attributes of personal property. The Patent and Trademark Office shall maintain a register of interests in patents and applications for patents and shall record any document related thereto upon request, and may require a fee therefor.

Applications for patent, patents, or any interest herein, shall be assignable in law by an instrument in writing. The applicant, patentee, or his assigns or legal representatives may in like manner grant and convey an exclusive right under his application for patent, or patents, to the whole or any specified part of the United States.

A certificate of acknowledgment under the hand and official seal of a person authorized to administer oaths within the United States, or, in a foreign country, of a

App. 100

diplomatic or consular officer of the United States or an officer authorized to administer oaths whose authority is proved by a certificate of a diplomatic or consular officer of the United States, or apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States, shall be prima facie evidence of the execution of an assignment, grant or conveyance of a patent or application for patent.

An interest that constitutes an assignment, grant or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent and Trademark Office within three months from its date or prior to the date of such subsequent purchase or mortgage.

35 U.S.C. § 282 – Current & Prior Versions

35 U.S.C. § 282(a), effective September 16, 2012, provides in pertinent part:

(a) In General. – A patent shall be presumed valid. Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims; dependent or multiple dependent claims shall be presumed valid even though dependent upon an invalid claim. The burden of establishing invalidity of a

App. 101

patent or any claim thereof shall rest on the party asserting such invalidity.

35 U.S.C.A. § 282, effective September 16, 2011 to September 15, 2012, provides in pertinent part:

A patent shall be presumed valid. Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims; dependent or multiple dependent claims shall be presumed valid even though dependent upon an invalid claim. Notwithstanding the preceding sentence, if a claim to a composition of matter is held invalid and that claim was the basis of a determination of nonobviousness under section 103(b)(1), the process shall no longer be considered nonobvious solely on the basis of section 103(b)(1). The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.

35 U.S.C.A. § 282, effective November 2, 2002 to September 15, 2011, provides in pertinent part:

A patent shall be presumed valid. Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims; dependent or multiple dependent claims shall be presumed valid even though dependent upon an invalid claim. Notwithstanding the preceding sentence, if a claim to a composition of matter is held invalid and that claim

App. 102

was the basis of a determination of nonobviousness under section 103(b)(1), the process shall no longer be considered nonobvious solely on the basis of section 103(b)(1). The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.

35 U.S.C.A. § 282, effective May 29, 2000 to November 1, 2002, provides in pertinent part:

A patent shall be presumed valid. Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims; dependent or multiple dependent claims shall be presumed valid even though dependent upon an invalid claim. Notwithstanding the preceding sentence, if a claim to a composition of matter is held invalid and that claim was the basis of a determination of nonobviousness under section 103(b)(1), the process shall no longer be considered nonobvious solely on the basis of section 103(b)(1). The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.

35 U.S.C.A. § 282, effective March 29, 2000 to May 28, 2000, provides in pertinent part:

A patent shall be presumed valid. Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims; dependent or

App. 103

multiple dependent claims shall be presumed valid even though dependent upon an invalid claim. Notwithstanding the preceding sentence, if a claim to a composition of matter is held invalid and that claim was the basis of a determination of nonobviousness under section 103(b)(1), the process shall no longer be considered nonobvious solely on the basis of section 103(b)(1). The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.

35 U.S.C.A. § 282, enacted Nov. 1, 1995, Pub.L. 104-41, § 2, 109 Stat. 352, effective to March 28, 2000, provides in pertinent part:

A patent shall be presumed valid. Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims; dependent or multiple dependent claims shall be presumed valid even though dependent upon an invalid claim. Notwithstanding the preceding sentence, if a claim to a composition of matter is held invalid and that claim was the basis of a determination of nonobviousness under section 103(b)(1), the process shall no longer be considered nonobvious solely on the basis of section 103(b)(1). The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.

App. 104

35 U.S.C. § 311. Inter partes review

(a) In General. – Subject to the provisions of this chapter, a person who is not the owner of a patent may file with the Office a petition to institute an inter partes review of the patent. The Director shall establish, by regulation, fees to be paid by the person requesting the review, in such amounts as the Director determines to be reasonable, considering the aggregate costs of the review.

(b) Scope. – A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.

(c) Filing Deadline. – A petition for inter partes review shall be filed after the later of either –

(1) the date that is 9 months after the grant of a patent; or

(2) if a post-grant review is instituted under chapter 32, the date of the termination of such post-grant review.

35 U.S.C. § 314. Institution of inter partes review

(a) Threshold. – The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable

likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

(b) **Timing.** – The Director shall determine whether to institute an inter partes review under this chapter pursuant to a petition filed under section 311 within 3 months after –

(1) receiving a preliminary response to the petition under section 313; or

(2) if no such preliminary response is filed, the last date on which such response may be filed.

(c) **Notice.** – The Director shall notify the petitioner and patent owner, in writing, of the Director’s determination under subsection (a), and shall make such notice available to the public as soon as is practicable. Such notice shall include the date on which the review shall commence.

(d) **No Appeal.** – The determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable.

35 U.S.C. § 315. Relation to other proceedings or actions

(a) **Infringer’s Civil Action.** –

(1) **Inter partes review barred by civil action.** – An inter partes review may not be instituted if, before the date on which the petition for such a review is filed, the petitioner or real party in interest

App. 106

filed a civil action challenging the validity of a claim of the patent.

(2) Stay of civil action. – If the petitioner or real party in interest files a civil action challenging the validity of a claim of the patent on or after the date on which the petitioner files a petition for inter partes review of the patent, that civil action shall be automatically stayed until either –

(A) the patent owner moves the court to lift the stay;

B) the patent owner files a civil action or counterclaim alleging that the petitioner or real party in interest has infringed the patent; or

(C) the petitioner or real party in interest moves the court to dismiss the civil action.

(3) Treatment of counterclaim. – A counterclaim challenging the validity of a claim of a patent does not constitute a civil action challenging the validity of a claim of a patent for purposes of this subsection.

(b) Patent Owner's Action. – An inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent. The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).

(c) Joinder. – If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

(d) Multiple Proceedings. – Notwithstanding sections 135(a), 251, and 252, and chapter 30, during the pendency of an inter partes review, if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the inter partes review or other proceeding or matter may proceed, including providing for stay, transfer, consolidation, or termination of any such matter or proceeding.

(e) Estoppel. –

(1) Proceedings before the Office. – The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

(2) Civil actions and other proceedings. – The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not

App. 108

assert either in a civil action arising in whole or in part under section 1338 of title 28 or in a proceeding before the International Trade Commission under section 337 of the Tariff Act of 1930 that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

35 U.S.C. § 316. Conduct of inter partes review

(a) Regulations. – The Director shall prescribe regulations –

- (1) providing that the file of any proceeding under this chapter shall be made available to the public, except that any petition or document filed with the intent that it be sealed shall, if accompanied by a motion to seal, be treated as sealed pending the outcome of the ruling on the motion;
- (2) setting forth the standards for the showing of sufficient grounds to institute a review under section 314(a);
- (3) establishing procedures for the submission of supplemental information after the petition is filed;
- (4) establishing and governing inter partes review under this chapter and the relationship of such review to other proceedings under this title;
- (5) setting forth standards and procedures for discovery of relevant evidence, including that such discovery shall be limited to –

App. 109

- (A) the deposition of witnesses submitting affidavits or declarations; and
 - (B) what is otherwise necessary in the interest of justice;
- (6) prescribing sanctions for abuse of discovery, abuse of process, or any other improper use of the proceeding, such as to harass or to cause unnecessary delay or an unnecessary increase in the cost of the proceeding;
 - (7) providing for protective orders governing the exchange and submission of confidential information;
 - (8) providing for the filing by the patent owner of a response to the petition under section 313 after an inter partes review has been instituted, and requiring that the patent owner file with such response, through affidavits or declarations, any additional factual evidence and expert opinions on which the patent owner relies in support of the response;
 - (9) setting forth standards and procedures for allowing the patent owner to move to amend the patent under subsection (d) to cancel a challenged claim or propose a reasonable number of substitute claims, and ensuring that any information submitted by the patent owner in support of any amendment entered under subsection (d) is made available to the public as part of the prosecution history of the patent;
 - (10) providing either party with the right to an oral hearing as part of the proceeding;

App. 110

(11) requiring that the final determination in an inter partes review be issued not later than 1 year after the date on which the Director notices the institution of a review under this chapter, except that the Director may, for good cause shown, extend the 1-year period by not more than 6 months, and may adjust the time periods in this paragraph in the case of joinder under section 315(c);

(12) setting a time period for requesting joinder under section 315(c); and

(13) providing the petitioner with at least 1 opportunity to file written comments within a time period established by the Director.

(b) Considerations. – In prescribing regulations under this section, the Director shall consider the effect of any such regulation 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 instituted under this chapter.

(c) Patent Trial and Appeal Board. – The Patent Trial and Appeal Board shall, in accordance with section 6, conduct each inter partes review instituted under this chapter.

(d) Amendment of the Patent. –

(1) In general. – During an inter partes review instituted under this chapter, the patent owner may file 1 motion to amend the patent in 1 or more of the following ways:

App. 111

- (A) Cancel any challenged patent claim.
 - (B) For each challenged claim, propose a reasonable number of substitute claims.
- (2) Additional motions. – Additional motions to amend may be permitted upon the joint request of the petitioner and the patent owner to materially advance the settlement of a proceeding under section 317, or as permitted by regulations prescribed by the Director.
- (3) Scope of claims. – An amendment under this subsection may not enlarge the scope of the claims of the patent or introduce new matter.
- (e) Evidentiary Standards. – In an inter partes review instituted under this chapter, the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.

35 U.S.C. § 319. Appeal

A party dissatisfied with the final written decision of the Patent Trial and Appeal Board under section 318(a) may appeal the decision pursuant to sections 141 through 144. Any party to the inter partes review shall have the right to be a party to the appeal.

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WISCONSIN

Ultratec, Inc. and
CapTel, Inc.

Plaintiffs,

v.

Sorenson Communications,
Inc. and CaptionCall, LLC

Defendants.

JUDGMENT IN A
CIVIL CASE

(Filed Nov. 3, 2014)

Case No. 13-cv-346-bbc

This action came before the court and a jury with U.S. District Judge Barbara B. Crabb presiding. The issues have been tried and the jury has rendered its verdict.

IT IS ORDERED AND ADJUDGED that judgment is entered in favor of plaintiffs on the Jury Verdict of Liability with respect to infringement of claims 6 of the '482 patent, claims 1 and 2 of the '314 patent, claim 1 of the '346 patent, claims 7 and 8 of the '835 patent, claim 2 of the '740 patent and claim 2 of the '104 patent. Damages are awarded in the amount of \$44,126,822.00.

On October 23, 2014, the Court granted defendants' motion for judgment of no willful infringement as a matter of law.

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WISCONSIN

ULTRATEC, INC. and
CAPTEL, INC.,

Plaintiffs,

v.

SORENSEN COMMUNICA-
TIONS, INC. and CAPTION-
CALL, LLC,

Defendants.

SPECIAL VERDICT:
LIABILITY

(Filed Oct. 23, 2014)

13-cv-346-bbc

We, the jury, for our special verdict, find as follows:

Infringement

Question No. 1: Did defendants literally infringe any of the following asserted patent claims?

Answer "Yes" or "No" for each claim.

Patent Claim	YES	NO
Claim 6 of the '482 Patent	✓	
Claim 1 of the '314 Patent	✓	
Claim 2 of the '314 Patent	✓	

Patent Claim	YES	NO
Claim 1 of the '346 Patent	✓	
Claim 7 of the '835 Patent	✓	
Claim 8 of the '835 Patent	✓	
Claim 2 of the '740 Patent	✓	

If you answered “Yes” with respect to any claim, then in answering Question No. 2, do not answer Question No. 2 with respect to those claims. If you answered “No” with respect to claim 6 of the '482 patent, claim 1 of the '314 patent or claim 2 of the '314 patent, answer Question No. 2 with respect to those claims.

Question No. 2: Did defendants infringe any of the following asserted patent claims under the doctrine of equivalents?

Patent Claim	YES	NO
Claim 6 of the '482 Patent	✓	
Claim 1 of the '314 Patent	✓	
Claim 2 of the '314 Patent	✓	

Regardless how you answered any of the above questions, answer Question No. 3.

Question No. 3: Did defendants infringe claim 2 of the '104 patent under the doctrine of equivalents?

yes
 Answer “Yes” or “No”

Invalidity—Anticipation

Question No. 4: Are any of the following patent claims invalid as anticipated?

Answer “Yes” or “No” for each claim.

Patent Claim	YES	NO
Claim 1 of the ‘482 Patent		✓
Claim 1 of the ‘314 Patent		✓
Claim 2 of the ‘314 Patent		✓
Claim 1 of the ‘082 Patent		✓
Claim 7 of the ‘578 Patent		✓

Invalidity—Obviousness

Question No. 5: Are any of the following patent claims invalid because they were obvious to one of ordinary skill in the field of invention?

Answer “Yes” or “No” for each claim.

Patent Claim	YES	NO
Claim 1 of the ‘482 Patent		✓
Claim 6 of the ‘482 Patent		✓
Patent Claim	YES	NO
Claim 1 of the ‘314 Patent		✓
Claim 2 of the ‘314 Patent		✓
Claim 1 of the ‘346 Patent		✓

App. 117

Claim 7 of the '835 Patent		✓
Claim 8 of the '835 Patent		✓
Claim 1 of the '082 Patent		✓
Claim 2 of the '740 Patent		✓
Claim 2 of the '104 Patent		✓
Claim 7 of the '578 Patent		✓
Claim 8 of the '578 Patent		✓
Claim 11 of the '578 Patent		✓

Regardless how you answered any of the above questions, sign and date this form.

/s/ Rebecca L. Luckus
Presiding Juror

Madison, Wisconsin

Date: 10/23/14

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WISCONSIN

ULTRATEC, INC. and
CAPTEL, INC.,

Plaintiffs,

v.

SORENSEN COMMUNICA-
TIONS, INC. and CAPTION-
CALL, LLC,

Defendants.

SPECIAL VERDICT:
DAMAGES

(Filed Oct. 24, 2014)

13-cv-346-bbc

We, the jury, for our special verdict, find as follows:

Question No. 1: What amount have plaintiffs proven by a preponderance of the evidence that defendants should pay as a reasonable royalty for their infringement?

\$ 44,126,822.00

/s/ Jeffrey Farnsworth
Presiding Juror

Madison, Wisconsin

Date: 10/24/2014

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

-----X
ULTRATEC, INC., : Case Nos.
Appellant, : 2019-1998
 : 2019-2000
v. : 2019-2003
CAPTIONCALL, LLC, :
Appellee, : Appeals from the
 : US Patent Office,
ANDREI IANCU, UNDER- : Patent Trial
SECRETARY OF COMMERCE : Appeal Board Nos.
FOR INTELLECTUAL : IRP2013-00540
PROPERTY AND DIRECTOR : IRP2013-00542
OF THE UNITED STATES : IRP2013-00549
PATENT AND TRADEMARK :
OFFICE, :
Intervenor. :
-----X

ORAL ARGUMENT

Washington, DC

Friday, October 9, 2020

Job No.: 376384

Pages: 1 – 57

Transcribed by: Molly Bugher

Oral arguments held October 9, 2020 before:

THE HONORABLE KIMBERLY A. MOORE
Chief Circuit Judge

App. 120

THE HONORABLE ALAN D. LOURIE
Circuit Judge

THE HONORABLE SHARON PROST
Circuit Judge

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App. 121

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CONTENTS

ARGUMENT	PAGE
By Ms. Noel	7, 53
By Mr. Shah	25
By Ms. Lynch	46

[7] PROCEEDINGS

THE COURT OFFICER: The United States Court of Appeals for the Federal Circuit is now open and in session. God save the United States and this Honorable Court.

JUDGE MOORE: Good morning. We begin this morning with three cases which have been

consolidated for argument today. They are 19-1998, Ultratec vs. CaptionCall, 19-2000, Ultratec vs. CaptionCall, and 19-2003, Ultratec vs. CaptionCall.

Ms. Noel, whenever you're ready.

MS. NOEL: Thank you, Your Honor, and may it please the Court, Kristin Noel on behalf of Ultratec. At issue in these appeals is ability of eight patents that collectively cover the invention of captioned telephone and service. This was not an incremental improvement to a widget, but the invention of –

JUDGE LOURIE: Ms. Noel, this is Judge Lourie. Am I correct that what you have is a limited remand on the question of whether Mr. [8] Occhiogrosso's trial testimony and his Board testimony were inconsistent. And the Board decided that there was no inconsistency. And isn't that the end of your cases?

MS. NOEL: Your Honor, we were on a limited remand, but that is not the end to our cases because this Court has never in the first instance addressed our appellate argument. Only –

JUDGE LOURIE: In other words, there is something yet to be decided. But these other issues in your briefs are really not before us, are they not?

MS. NOEL: Respectfully, Your Honor, I disagree. All of the issues are properly before the Court. And the only issues that weren't in our original brief are not outside the mandate because the mandate rule

doesn't preclude issues that could not had been raised either below before the final written decision or as part of our first appeal.

So for example, all of the patents in [9] this case have expired. They been expired for three years now. But that expiration happened after this Court heard the last appeal.

So when the patents were remanded back down to the Board, it was incumbent upon the Board before re-issuing final written decision to construe the patents under Phillips. If the Court disagrees with us on that, certainly, as this Court's president has been when this Court hears an appeal from a final written decision when the patents expire even post final written decision claims construction must be done using the Philips standard.

JUDGE LOURIE: Proceed.

MS. NOEL: Thank you, Your Honor. So –

JUDGE MOORE: Counsel, this is Judge Moore. As a housekeeping matter before you get into the details of your claim construction argument, can I ask you about these constitutional arguments? You sort of basically said everything is unconstitutional. So we're [10] throwing in every provision I can think of.

My question is, aren't most of your arguments, if not all of them, already resolved by this Court, for example, by the case of Celgene or OSI Pharm? Are these things that are properly before this panel for

resolution by this panel? Or are you making these arguments to preserve them in an attempt to seek en banc review?

MS. NOEL: It would be the latter, Your Honor. We certainly acknowledge that the Court has issued decisions like the Celgene decision before and you've subsequently sent – our briefs that have been filed have reaffirmed that standard. And so Ultratec makes its arguments to preserve them either for en banc review or a petition to the Supreme Court. But we do acknowledge this Court has decided the constitutional issues.

JUDGE PROST: Thank you. Please proceed.

MS. NOEL: Thank you. Reflective of [11] these inventions six years ago, a jury found the asserted claims valid and infringed by the Petitioner awarding Ultratec and its affiliate CapTel \$44.1 million in damages, a judgment that was later stayed. Ultratec raises a number of issues with the Board's handling of the IPRs.

Time permitting, I would like to cover two. Objective indicia of nonobviousness and more specifically, the proof of actual nexus, the direct proof to the claimed inventions and their benefits as that is pertinent to claims in seven of the patents, and the construction and the application of train to the voice of the call assistant because that term is recited in six of the patents.

But for all of our issues on appeal, those two included, we note that the Board did not act as a neutral, but rather advocated for invalidity including in almost every single issue, making decisions based on arguments that the petitioner itself did not advocate below. And that practice was squarely rejected by this [12] Court in SAS and (inaudible) rule.

Turning to objective indicia; Ultratec presented strong evidence that the inventions themselves and the direct benefits that they conferred, which this Court ruled in *Rambus v. Rea* is appropriate to consider with secondary considerations, but they received overwhelming praise by consumers, by the industry; they also met the needs of the deaf and hard of hearing community and they were a tremendous commercial success.

We demonstrated nexus by having our technical expert review the patent, explain the claim features on the benefits that they – use of those inventions conferred. He also provided undisputed evidence of how CapTel embodied the invention. Mr. Ludwick testified as to the tremendous commercial success that CapTel achieved and how the features and the benefits drove that success.

Importantly, this testimony was corroborated by hard of hearing advocates Brenda [13] Patat (phonetic) and Connie Phelps, who provided evidence of what the consumers themselves said contemporaneously about the demand, not just for CapTel generally, but for the

specific features and benefits identified by Mr. Ludwick.

JUDGE MOORE: Well Counsel, do we review this question first, substantial evidence; is that correct?

MS. NOEL: That's correct, Your Honor.

JUDGE MOORE: And didn't CapTel point out that Mr. Occhiogrosso testified that he – it was his opinion that unclaimed features or prior art features are what drove CapTel's actual sales? And that Ultratec's initial dominant market position and growth of the hard of hearing industry, hard of hearing population, drove the commercial success?

So didn't the Board have in front of it expert testimony that contradicted your expert in terms of whether or not it was the claimed features as opposed to unclaimed, or prior art features, which actually resulted in a secondary [14] consideration of evidence that you presented?

MS. NOEL: Respectfully, Your Honor, I will disagree. They didn't actually provide any affirmative evidence, Mr. Occhiogrosso. He just tried to point out what he believed Mr. Ludwick did and did not consider. And Mr. Ludwick's declaration somewhat belies that he did look at unclaimed features and compared them to the claimed features and explained why they drove success.

CaptionCall also pointed to something, for example, that it entered the market and minutes of use went

up. But what they failed to recognize, is that a jury found that their product and service infringed all eight of these patents. So that doesn't undercut commercial success, it in fact bolsters it.

Patat and Phelps reviewed hundreds of comments that consumers submitted to the FCC advocating that the FCC make captioned telephone a compensable service so they could continue to use captioned telephone. These comments were not [15] just that CapTel was life-changing, and many of them reflect that, but they identified specifically what it was about the product and service that change their lives.

The speed and accuracy of the caption, which we know is afforded by revoicing. The naturalness of the call afforded by having the ability to use their own voice on the phone, use whatever visual hearing they had, and to have the captions help keep up with the conversation. That is the method of providing captioned telephone service with voice and revoice text.

And they also had, and complemented the ability to have others call them directly instead of having to call a relay on a different number. And the security that they could know that they could call 911 and not have to choose between having captions so they can understand the operator, or have the 911 operator lose their location. As Mr. Ludwick confirmed, this was the result of the two line functionality with captioned telephone.

[16] Now we know why CapTel was commercially successful, because the consumers themselves told us.

Patat and Phelps also testified how these specific benefits met the long felt needs of the deaf and hard of hearing community. Indeed, Ms. Patat testified how CapTel was quote, life-changing; quote, life altering and life-saving.

JUDGE MOORE: Counsel, one of the problems the Board seems to have had – I mean, you are pointing to a lot of evidence right now. But one of the problems the Board seems to have had is that it said, for example on page 118, that your response itself contains none of these arguments.

At one point, and I don't remember where in the Board's opinion, they said you pointed to like 137 pages of declaration as though we, the Board, are supposed to go on some fishing expedition looking for the kernels of evidence that may or may not substantiate your argument.

And so what the Board – even if there [17] were evidence in the record that you are now pointing to, if you hadn't pointed to that evidence with particularity to the Board and if their concern was your allegations as argued to them were conclusory and you just dumped tons of evidence on them without particularity or pointing to anything specific, should we really fault them?

Should we reverse them under those circumstances? The fact that you now step in here and are making a much better argument to us than you made to them, is that a basis for us to reverse them?

MS. NOEL: Yes, Your Honor. And I do take issue with the Board's characterization of the presentation of the evidence. In some of the responses, secondary considerations detail 13 pages of arguments and summary of the evidence. We can't – could not have possibly put all of the evidence of secondary consideration into the brief.

But we made the arguments and we cited [18] to the declaration. And if you review the declaration, they are actually not that voluminous, but collectively there are three. And they are very well set out with headings and subheadings and they give actual evidence and detail to support the argument which is made in the response.

And the Board said that it wants – and it considered this evidence. And its real justification for not giving it any weight was this claim of lack of embodiment. Embodiment wasn't disputed by CapTel. Let me be clear about this. Of the 37 claims across the eight patents, CaptionCall did not present, even though they had two experts, did not present evidence of a single element of any of those 37 claims that they assert was not embodied in the CapTel phone.

So the Board took it upon itself, acted as an advocate on an argument not made by CapTel. And that is something that violates the *In Re Magnum* precedent from this court.

JUDGE MOORE: Well, who had the burden [19] on – who had the burden on that question? Either the burden of production or the burden of persuasion

on that to show the connection, the nexus being drawn between the second consideration and the (inaudible)?

MS. NOEL: We – I'm sorry, Your Honor.

JUDGE MOORE: Oh, go ahead.

MS. NOEL: We have the burden of showing nexus. And as this Court has observed in *Polaris* and other cases, when we present undisputed evidence that the other side does not dispute and does not present any evidence to contradict, is an error of the Board to disregard it.

Moving on to train to the voice of the call assistant, our argument -

JUDGE MOORE: I'm sorry. Can I just get a – sort of a logistical question? And that is the argument you just made with respect to secondary consideration, does that apply equally to each of the three separate appeals we've got in front of us?

[20] MS. NOEL: Yes, Your Honor.

JUDGE MOORE: Okay, thank you.

MS. NOEL: And in fact, I will note the last appeal on claim six and eight of the 835 patent, the Board actually did, not only deny nexus, but also held that the minutes of use were not captioned telephone service because they looked at the FCC's minute data, saw the words CTS VCO and assumed – took it upon themselves to say that was the prior art. And so they discounted commercial success. That was an argument

once again not made by CaptionCall because it is not true.

JUDGE MOORE: Counsel, you suggested that the Board erred in response to my prior question when it said, Patent owner's response contains no substantive argument, instead Patent Owner merely lists various common forms of secondary consideration evidence without expedition.

Can you tell me where in the appendix I can find Patent Owner's response? And in [21] particular where in that response you believe that you had, in a detailed fashion, articulated the arguments the Board should have addressed?

MS. NOEL: Yes, Your Honor. For example in the 2003 (inaudible).

JUDGE MOORE: You have to say it by appendix number for me.

MS. NOEL: Yes, Your Honor, but we have three appendices. So in 2003, I would look for example at appendix 512 and then I would also look at appendix – starting at 4124, 4125, and it goes on for some 13 pages outlining the evidence.

JUDGE MOORE: Okay. I don't –

MS. NOEL: On train to the voice, Your Honor, I think our conception is fairly well laid out in our brief. I will say that, so it doesn't get lost in the briefing, the most important for the Court to consider when looking at the single lone sentence in Ryan is to

understand what was the state of the art of voice recognition software at the time of the invention.

And specifically I would direct the [22] Court to appendix 3131, which is from the McAllister patent in the 2000 case, Your Honor with –

(Technical problem; missing audio)

Thank you, Your Honor. In the 2003 appendix for example, I would direct the Court to appendix 511 through 513 and pertinently on page 12. I would go direct the Court to appendix 4214 through 37. And –

JUDGE MOORE: I can (inaudible).

MS. NOEL: Thank you.

THE COURT: Okay, thank you.

MS. NOEL: I'm sorry, Your Honor. I misread it. It's 4124 through 4137.

Turning to train to the voice, which is claim term used in six of the patents, I think the claims construction, particularly now that we are on the Philips standard, is very clear and direct. The only issue with the Board –

JUDGE MOORE: Counsel, I'm sorry to derail you, but we can't find any document with the page number 4124 to 4137 in the 03 appendix. [23] I'm trying to actually look carefully at what you're telling me to look at, but I don't see those documents.

MS. NOEL: My apologies, Your Honor. I'm looking at a Bates stamped copy, which is the Patent Owner response from patent number 6603835, which is one of the patents at issue. And I will have my colleague double check the record if – with leave of Court I'll move on.

On train to the voice under the Phillips standard in particular, the Board's holding that train to the voice of the call assistant can mean train to the voice of a group is clearly erroneous. The only basis the Court gave for this is a lone recitation of a line in the patent that refers to train to the voice of the voice pattern of the call assistant.

Once again, this is an argument that was not presented by CaptionCall. The Board took it upon itself to make this argument. But it also holds no water. It plainly refers to a single call system. Mr. Occhiogrosso himself [24] construed this to refer to a single call assistant.

Moving on to Ryan, what I don't like –

JUDGE MOORE: Wait, before you move on, I need to understand something. Are you suggesting that the Board isn't permitted to look at the claim language or the specification and come to its own conclusion if the opposing party didn't make that specific argument? I mean, the term is in dispute. So isn't the Board supposed to look to the intrinsic record to understand the meaning of the term?

MS. NOEL: Certainly the Board should look at the intrinsic record, but I do believe that it's this Court's precedents that in IPRs in particular that the Board is not to take it upon itself to make arguments and hold positions that the petitioner itself has not put forward. I believe that in the *In Re: Magnum* decision. Also it's just – it's plainly wrong. Their expert agrees. Our expert agrees.

And if you read the specification in [25] this patent, you cannot walk away with the understanding that this means trained, much less designed to a group of call assistants. The patent itself teaches that it is a limitation of the software that you that you have to use voice recognition software that is trained to the voice of the particular call assistant.

So the reference that is cited against us, the Ryan reference, has a lone sentence designed to recognize the voice of the particular relay agent. And I think in light of the lack of exposition in Ryan we need to read that literally. And very importantly, we have to understand the state of the art at the time.

JUDGE MOORE: But when you look at things like the 314 patent column 2, lines 45 to 49, it says, speech recognition computer program trained to the voice pattern of the call assistant. And then it gives an e.g., an accent. So I mean, I'm not going to suggest that all Southerners speak with the exact same accent, but certainly more than one person – I'm from [26] Baltimore and everyone in my family says it with a D instead of a T, it's an accent. So why isn't that relevant?

MS. NOEL: Your Honor, with respect, and I turned to the 314 patent and it doesn't say e.g. accent. It says, trained to the voice pattern of the call assistant. I have a voice pattern. Your Honor as a voice pattern. Mr. Shah has a voice pattern. We all have voice patterns.

That certainly cannot, just because a group can have a shared voice pattern – and I would agree with you that a group can have a shared voice pattern. You can't trump the teaching of the specifications, which it is limited to that speech recognition software like Dragon Naturally Speaking. But the word "pattern" doesn't mean a group.

Now very importantly, there was also at the time voice recognition software as Your Honor described. It was not speaker dependent, meaning you couldn't take it off the shelf and have it [27] learn your particular voice. It was hardcoded, but it was coded to recognize the shared, singular voice of a group of people like an accent, like Your Honor just recognized.

And if you look, for example, in the 2000 –

JUDGE LOURIE: Please finish your thought.

MS. NOEL: Thank you. If you look at the McAllister reference found in the 2000 appendix at 3123 through 3137, and in particular at column four, lines 58 through 67, you will see a description of existing (inaudible) speech recognition technology, which included universal, which is speaker independent voice

recognition software created using speech models for samples of accents.

And in particular the line, for example, if the models are created using speech samples from New Englanders, then the model will tend to exclude voices with southern accents or voices with Hispanic accents. That is voice [28] recognition software that is designed to recognize the singular voice of multiple people. That is literally what is the line disclosure in Ryan. Thank you, Your Honor.

JUDGE LOURIE: Thank you. We'll reserve the remainder of your time for rebuttal. And it's time to hear from Mr. Shah.

MR. SHAH: May it please the Court, Patek Shah for Appellee, CaptionCall. The last time these appeals were before this Court, Ultratec secured a remand in an attempt to discredit CaptionCall's expert, Mr. Occhiogrosso, but that gambit failed. Occhiogrosso's expert testimony, according to Ultratec itself, provided material evidentiary support for the PTAB's unpatentability determinations.

Now that the PTAB is squarely reaffirmed the consistency and credibility of that testimony, Ultratec can no longer plausibly argue a lack of substantial evidence underlying the unpatentability determination. This Court –

JUDGE MOORE: Counsel, in the final [29] remand – this is Judge Moore. In the final reman, can

you remind me, was claim construction at issue on appeal?

MR. SHAH: In the prior – in the first appeal, yes, Your Honor, it was.

JUDGE MOORE: And did we actually resolve any of those questions of claim construction?

MR. SHAH: No, Your Honor. You just remanded on that narrow issue. So those are –

JUDGE MOORE: Okay.

MR. SHAH: We would agree that those are before you now.

JUDGE MOORE: But the claim construction is now before us. And one thing that has happened between the time when the Board issued its claim construction and now when we are reviewing it, is the patents have expired. Doesn't that de facto push us into Phillips territory?

MR. SHAH: So, Your Honor certain –

JUDGE MOORE: So I want to (inaudible) [30] forget about whether the Board used Phillips or not.

MR. SHAH: Sure. Sure.

JUDGE MOORE: Forget about whether the Board was proper with regard to the scope of the reman. Aren't we, our Court, now clearly in Phillips territory in light of our Court's precedent?

MR. SHAH: Your Honor, yes. This Court's precedent that seem to indicate that it is applying Phillips on there. I think there are distinctions to be drawn here just because of the unique procedural posture of this case and that if it had been decided on the merits the first time it was here, in that first opinion before the expiration, it would have been BRI. But for that kind of narrow remand on the procedural issue, which really didn't change anything because it came back up finding that testimony consistent, we are now back here in that posture.

So I think there are distinctions to be drawn just based on the unique procedural [31] posture. It's not implicating some of the policy interest that underlie the switch from BRI to Phillips. The other side has never tried to amend, even though you had the same adverse constructions now for several years.

So I think there is a basis to continue to review under BRI. But assuming this Court were to apply Phillips, I'm happy to address why we think the result should not change with respect to the claim constructions that are now issue – at issue on appeal.

And if you let me start there, I'm happy to start there.

JUDGE PROST: Well, I would like you to – this is Judge Proust.

MR. SHAH: (Inaudible)

JUDGE PROST: Where I would like you to start a is, your friend's – a theme throughout your

friend's argument it seemed to me was the lack of neutrality by the Board in the way it handled various issues in this case, making arguments not made by petitioner, it cited our [32] case in *In Re: Magnum*. So I would like you to somewhere respond to those – that seem and those arguments if you would.

MR. SHAH: Sure. Sure, Your Honor. I would disagree with that characterization. We vigorously disputed virtually all of these issues before the PTAB. There are 750 pages of decisions now standing this appeal to an initial decision, then a rehearing, and then a remand. And at each step of the – at each step the argument changed slightly. And then we came back with counter arguments as the arguments evolved. There is nothing unusual about the Board looking at all of the evidence and looking at all of the arguments and coming to what it thought was the best decision.

We submit we made virtually all of these arguments. But to the extent the Board wanted to look at the patents itself and the prior art itself and parse them on its own and not just follow the experts on both sides, of course the Board is entitled to do that. The [33] Board wasn't acting as an advocate in any way. It was acting as a decision-maker just as courts do all the time. It looks at both sides' argument that it may have a third way of resolving the case.

And I think it's helpful to do this in the context of the specific argument. I'm happy to even start with the claim construction or the secondary considerations issue. I can start with the secondary considerations issue

since that's where the other side started, if it's helpful. And I think there is some important things to keep in mind here based upon what happened before the Board.

One, as Chief Judge Proust said it's Ultratec's burden on nexus to show, to prove nexus even if we had not submitted any evidence to the contrary. And we did and I will walk through that. Even if we didn't, it's still their burden to show nexus and the Board can hold them to that burden.

Now what the Board said is that they [34] failed to show nexus on two independent grounds. The first one is the one that Judge Moore, you mentioned, the procedural ground. They provided, as the Board said at page 118 – here's what the Board said. It reviewed the documents.

It says, Patent owner's response contains no substantive argument. And this is on the secondary – this is on the nexus point. Instead, Patent Owner merely lists various common forms of secondary consideration evidence without exposition. This does not provide sufficient analysis for us to determine whether the Patent Owner has provided adequate evidence of secondary consideration and a nexus between any such evidence in the merits of the claimed invention. Thus, Patent Owner's broad contentions regarding secondary consideration do not demonstrate nonobviousness.

Now, if you look at what it did, when you asked the other side, Ms. Noel, for the citations to their argument, she gave you the only citation from the last IPR,

the ninth IPR [35] when they finally remedied that error and provided more than two pages.

In the first eight IPRs, and the Board notes this, in the first eight IPRs, it has the same language that I cited you in the first eight. They only made two pages of cursory argument. She didn't cite you those pages. That's JA-786 to 787 and then this corresponding cite. For the first eight IPRs they failed to meet the substantive argument.

And if that was not enough, on rehearing, they tried to re-issue that's make the same argument in the first eight IPRs and at page – appendix page A-440, and this is of the 1998 appeal appendix. Here's what the Board said. So after the Board said, look, you've only given us less than two pages. And by the way, their counsel at oral argument in front of the Board said, you are right, Your Honor, we only gave you a page and a happy we should have done more.

Now, on rehearing they argued, well look, we cited the declarations. And even though [36] we didn't make the arguments in our brief, you can read the declarations and figure it out.

Here's what the Board said on rehearing in response to that at page A-440. And again, this is repeated through the first eight of the nine IPRs. Every patent except claims six and eight of the 835 patent, here's what they say. And this is – I'm quoting from appendix page 440.

In its request, Patent Owner seems to suggest that we should have reviewed and analyzed the entirety of each of the three declarations submitted by Patent Owner in support of its secondary consideration contention. Patent Owner merely cited each declaration in its entirety without citing with particularity portions of these decorations. We will not scour –

JUDGE MOORE: Yes Counsel, this is where the 137 page thing comes up, right?

MR. SHAH: Exactly. That's the next line. We will not scour the 137 pages of declaration evidence submitted by Patent Owner and generally serve as an advocate for Patent [37] Owner. So this is where the Board is saying we're not going to serve as an advocate for them, Chief Judge Proust, to get to your question about being an advocate.

So it's not the Board's job to look at a page and a half boilerplate argument about secondary considerations and then read 137 pages of declaration and try to put together the argument that Ms. Noel has made quite nicely here this morning about how –

JUDGE MOORE: Counsel?

MR. SHAH: Yeah.

JUDGE MOORE: You suggested that – and I understand and this is very helpful as for IPRs. But you suggested in the ninth IPR, they finally cured –

MR. SHAH: Yeah.

JUDGE MOORE: Did the PTO treat it differently, in light –

MR. SHAH: Yes, it absolutely did, Your Honor. And that was going to be my next point. When they finally made something more than the [38] cursory argument, and I acknowledge they did in the last IPR. So that's 835 patent claim, six and eight only. Then in the final written decision corresponding to that IPR, and that's at the 2003 appendix, pages A-224 to 238, the Board give a 14-page response not just on the procedural forfeiture, but actually on the merits.

And then here's what they said on the merits. Of course you can stop at the procedural forfeit for the first eight IPRs. For the ninth one, when you reach the merits, they said look, we looked at the declaration you cited and the Ludwick declaration, which is the only declaration that goes to nexus, what they did is they provided a claim chart to lineup the patents claims with the CapTel service. And those claim charts, Your Honor, I encourage you to look at them. They are at page – for example in the 1998 appendix, they are page 3169. They start there. They are two page claim charts for each of the patents.

[39] Your Honors I'm sure are familiar with the sort of claim charts, but PTAB is certainly familiar with these sort of claim charts. They are usually dozens, dozens of pages that go through the manuals, the pictures, the documentation, the lineup, the experts analysis, not just including personal observation, but going through that in detail. Here you have a

conclusory statement in each one that says I observed these matters here. The PTAB said that's not enough.

And in fact, Your Honor, we provide a cite in our brief. You can contrast that claim chart. Once they got these adverse PTAB decisions and the further Ultratec appeals that are not before you, what we call Ultratec 4, we provided a cite there. They did a claim chart. It's 190 pages. These are two page claim charts conclusory.

And the reason why, Your Honor, that matters here is because CapTel is not a monolithic service. It's not just one phone or [40] one product over this 10 years. There were modifications. There were different models use. And so is not enough to simply say based on your observation during a visit that happened at the time of this litigation to say that this is always encompassed all of the claims at least not without providing documentation, going through the manuals, going through each and every model. They don't do it model by model. They treat it as monolithic.

And the PTAB, and this is at 2003, appendix 229, page 229 in the A-35 appeal where they finally made the arguments and not just forfeited it, there the PTAB calls them out on this and they say, look, this is not a monolithic service. And in fact, the model 100, the first phone that was at issue here, did not have two line service.

So there were three features that Ultratec pointed to as the breakthrough features, the two line architecture, the revoicing, and the simultaneous delivery of voice and text. So two [41] line architecture wasn't

there. So it wasn't fact coextensive. It was both under-inclusive and overinclusive.

And Judge Moore, this goes to your point. There was in fact expert testimony by our expert, not the PTAB, but our expert submitted a declaration, which is a pages A-2569 to page A-2576 of the 1998 appendix.

JUDGE MOORE: Hey counsel?

MR. SHAH: Yeah.

JUDGE MOORE: I appreciate your very clearly, amazing, detailed understanding of every single page of nine appendices. How about you move on to claim construction? Because my eyes are glazing over with all these page cites.

MR. SHAH: Okay. Sorry, Your Honor.

Okay. To claims construction. So on Ryan, Your Honor, I think let me start there with that claims construction. I'm happy to walk through the three claims construction issues. On Ryan, I think it's helpful just to take a step back.

Ultratec's actual claimed invention is [42] not the software itself. It's not claiming an invention of a voice recognition software. It's invention is on the relay method of using a call agent to do real time revoicing using commercially available speaker dependent software. That is exactly what Ryan discloses, using, in the words of Ryan, an agent to listen to the caller and repeat the voice message using, quote, specific software

specifically designed to recognize the voice of particular relay agents.

Now as Ultratec concedes, by the time of this patent, the speaker dependent speech recognition software that allowed one-to-one tailoring was already there on the market. And so this is not an invention even though they would like to try to claim it as software that only does this after-the-fact training. The invention is about real time revoicing here. And that's precisely what Ryan discloses.

Now, Your Honor, on the particular claims, there is – they talk about the one agent. I think, we've already made arguments in our [43] brief as to why the PTAB did not err, and I don't think they erred even if you apply Phillips.

But even if you have doubt, probably the easiest way for this Court to resolve this issues is say fine, even if you accept Ultratec's claim construction that their patent, despite the language that you point to Judge Moore about talking about a voice pattern and an accent, even if you accept *arguendo* that their claim was limited to one specific agent, at page A-95, sorry to give you another cite, but here is what the Board does. At page A-95 of the 1998 appendix, and this is the final written decision of the Board that I'm quoting from, here's what it says, it argues – it addressed to the construction and the alternative. And here's what it found.

Moreover, we are not persuaded by Patent Owner that a person of ordinary skill in the art would interpret Ryan as only disclosing

software written specifically for a group of people.

[44] So you have a finding by the Board at page A-95 that even under Ultratec's claim construction, Ryan discloses it.

And there is ample expert testimony. This is not the Board acting as an advocate, Chief Judge Proust. JA – again, I will give you the JA cites because that's where expert testimony is. Specifically on this point, JA, and this is in the first 1998 appendix, 3557 – these cites, by the way are all in our brief. But JA-3557 Occhiogrosso says when Ryan says particular relay agent, that means, quote, one specific agent. Again, there is another cite, JA-2554 in the 1998 appendix where again, substantial evidence, the expert says yes, this refers – Ryan discloses voice recognition trained to one call assistant.

So the Board made the finding at A-95 that even under Ultratec's claim construction, Ryan discloses that there is ample expert evidence to support that. Our expert says exactly that. Now once you accept that, if you [45] accept that it means one agent, then Ultratec itself argues – this is their own reply brief at page 12 of the reply brief. And I will just read you what they wrote at page 12.

Indeed, CaptionCall does not contest that if this court finds that the software must be trained to individual voices, and that's the argument I'm saying, I'm happy to accept for purposes of this argument that it's an individual voice, here is what Ultratec says, quote,

the software must likewise be trained after development. So what Ultratec says is a logical matter. If you agree that either the patent or Ryan discloses that it reads on just one agent, then as a logical matter, of course the training has to happen after the fact.

So Ryan necessarily discloses, because it reads on one agent, it necessarily has to disclose the sort of training that Ultratec says its claimed. So again, you can accept Ultratec's claim construction that the training, even though the patent doesn't say it, the training has to [46] happen after the fact. Even if you accept that that, well then again, we have expert testimony –

JUDGE PROST: (Inaudible).

MR. SHAH: I'm sorry, Your Honor.

JUDGE PROST: Just finished your sentence because the bell has rung.

MR. SHAH: Oh, okay. I'm sorry. I will just give you the cites so you can see them. It's at 1998 JA-2554, 3553 to 3554, those are the cites from Ultratec's – or I'm sorry, our expert saying how trading happens after the fact because this Ryan discloses speaker dependent software that has an algorithm that allows for training after the fact.

JUDGE PROST: Thank you.

MR. SHAH: Thank you, Your Honor.

JUDGE PROST: Ms. Lynch, were you here just to argue specific issues with respect to the constitutional other questions?

MS. LYNCH: Yes, Your Honor. The scope of the remand as well.

THE COURT: Okay, proceed.

[47] MS. LYNCH: This Court – may it please the Court. This Court’s remand order was narrowly tailored. First, the Board was to determine whether Mr. Occhiogrosso’s testimony was inconsistent. And if it was, the Board was then to consider the impact of that testimony.

JUDGE MOORE: Counsel, even if we agreed that the remand was limited, don’t – what is the PTO’s position on what our case law demands we apply in this current appeal as to the standard of review?

So forget about whether the agency erred by not redoing claim construction. This is our first time reviewing claim construction, and the patents have expired. What do our precedents say the standard is we ought to apply?

MS. LYNCH: So, Your Honor, in the *Apple v. Andre* case, this Court did use the Phillips claim construction when the patent expired on appeal. But in that case, unlike here, the parties had agreed the claim construction would be the same under Phillips or [48] BRI. And so respectfully, as a reviewing court we believe this court should review the Board’s BRI claim construction to see if it’s correct.

JUDGE MOORE: And you think that’s true anytime a patent expires between when the Board

renders its decision and when this Court hears the appeal? You believe that we should still be reviewing under BRI even though the patent expired?

MS. LYNCH: Well yes, Your Honor. And obviously, if you review the Board's BRI and you find it's incorrect, then we think the Court should apply Phillips. But in the first instance, as a reviewing court, we think you should review the Board's claim construction.

JUDGE PROST: I don't understand what your answer just was. So you don't – you are saying if we look at BRI and we say they shouldn't apply BRI? Or would you say that the construction was erroneous and then they get a second bite under Phillips? I'm not clear on what you're saying.

[49] MS. LYNCH: Right. The second, Your Honor. So as a reviewing court, we think if the Board used BRI and if it correctly use BRI because the patent hadn't expired at that time, with think that you should review the Board's BRI construction to determine if it's correct. If you find that the Board's BRI construction is erroneous, then going forward this Court, because the patent has now expired, would use a Phillips construction.

JUDGE MOORE: So Ms. Lynch, I've got to be honest. I thought that this was pretty well-settled and I thought that, you know, it's understood that if the patents expired at any time during the process, everybody flips over to to the Phillips standard. Even in our CFB case the Board itself recognized that and the

Board had in front of it a patent which had been reviewed under BRI. But then the Board on rehearing turned around and redid it under Phillips, recognizing that if the patent expires at any time during the process, people should [50] pivot towards Phillips.

I guess I got to be honest. I thought this was such a well-settled point. But if the PTO really believes that we have to review BRI even when the patent expires in between, maybe there's a reason for a precedential decision in this case because that just seems to me completely inconsistent with all of our – with our approach consistently applied to a number of cases on this general point. What are your thoughts about that?

MS. LYNCH: So we agree, Your Honor, that at the Agency when the patent expires before it gets to the Board, before a Board final written decision or during re-examination, the Agency will apply BRI. But like we said, as a reviewing court if at the time the Agency applies BRI, it was the correct standard to apply, then we think of the first instance this Court should review to see if that BRI analysis was correct or not.

JUDGE LOURIE: In other words, we are [51] reviewing the decision that was rendered?

MS. LYNCH: Correct. Correct, Your Honor.

THE PROUST: Can I just – could I just ask you a practical question?

MS. LYNCH: Sure.

JUDGE PROST: I don't recall the dates. You may have them offhand when the PTO switched course and went to the Phillips standard. So I'm wondering how much is left in the pipeline that would implicate this question. Do you have any sense of that?

MS. LYNCH: I know it's been a while, Your Honor. So I don't know how much is in the pipeline, but I agree with you. There is less and less as time goes on.

JUDGE MOORE: But Ms. Lynch, I'm just troubled, because when you look at the *Apple v. Andrea* case, we didn't caveat it when we entered the following holding. This is the holding.

When this Court reviews the claim construction of a patent claim term in an IPR [52] appeal after the patent has expired, such as in this case, we apply the standard establishing Phillips, not the broadest reasonable construction.

It doesn't seem to me that we put any caveats at all on that clear, broad statement in *Apple*. I mean, I'm honestly kind of surprised. I'm not surprised that you argued to me that your remand was limited, but I'm generally surprised that you think it still somehow an open question as to what standard we ought to be applying right now.

MS. LYNCH: So, Your Honor, I agree. That is the language of *Apple v. Andrea*. But you know, there is another precedential case. It's the *Celgene* case and the patent has expired before the decision; that got brought up in the briefing. The Court didn't address it

in its decision that the patent had expired. But in that case, the Court did review the Board's BRI construction de novo.

JUDGE PROST: Can I ask – I'm sorry to [53] prolong this, but I just have to go back to one point you made, which I was just confused by.

MS. LYNCH: Okay.

MS. PROUST: In a normal IPR, if we disagree with the Board's BRI construction, is it your – is it the office's view that we then have to alternatively say, well, it would have held up over Phillips? Or are you saying that because of the posture in this case, even though you don't agree with us, as Judge Moore said, that you should be applying Phillips, that there is something different about this so you get two bites of the apple in this circumstance and not one?

MS. LYNCH: I'm sorry, Your Honor. I'm not sure I completely understand that question. Could you repeat it?

JUDGE PROST: Okay. Actually, given the interest of time, I will just drop it and conclude your argument there. Thank you.

Ms. Noel, you have some rebuttal time.

MS. NOEL: Thank you, Your Honor. A [54] couple of quick points. Responded to Mr. Shah, I did give you two citations from the Patent Owner responses. One was from one of the first eight and the

last was from the ninth. So I take issue with his characterization of what I represented to the Court.

Secondly, all this discussion about Mr. –

JUDGE MOORE: This is Judge Moore. The first one you gave us was just really page 512. And I agree with the Agency that that one, which is the one that was not in the last one, is completely conclusory. It's amounts to literally one paragraph in which you say nothing other than objective consideration, you know, support nonobvious, and including commercial success, failure of others, long felt need, – there's no particularity of any kind of argument on page 512.

That was why I was pushing hard to look at the other pages, which I still don't seem to be able to locate in the appendix that you say [55] they're in. But because this, page 512, even if it appeared in all of the first date, is completely conclusory and I could not fault the PTO for its position.

MS. NOEL: Your Honor, if I may address that. We view this as a roadmap to the declarations. And you look at the declarations, they all have headings and subheadings and they very clearly articulate the evidence here.

Mr. Shah seemed to indicate that we cured in the ninth IPR and that the Board then delved into the evidence and the Board came up with the same conclusions of the ninth – 13 pages. It still wasn't enough for them because it wasn't the arguments and the

response so much that they didn't like the conclusory nature of Mr. Ludwick's testimony and his claim charts.

All of that, by the way Your Honor, goes to embodiment. Embodiment is undisputed in this case. They had two experts inspect everything about CapTel. They haven't come up with a single limitation, a single element that [56] is not embodied. Embodiment is not contested.

And as this case – this Court held in Polaris, observations by Mr. Ludwick, you know, is there a headset? Do captions appear on the screen? I don't need a manual for that. And you can't have a manual for the whole system. He observed how it worked. He'd worked in the industry for decades. And they don't point to anything he was wrong on.

Turning to Ryan, there is a fundamental disagreement here. When you are talking about voice recognition software that is trained, it has to be to an individual. And Mr. Occhiogrosso agreed with that. We agree with that. The Patent Owners talked that in the specifications. When you are talking about designing software, you can design to the shared voice or dialect of a group of people. That is what is in McAllister and that's what's disclosed in Ryan. Thank you.

JUDGE LOURIE: Thank you. We thank both sides and the cases are submitted.

(Off the record.)

[57] CERTIFICATE OF TRANSCRIBER

I, Molly Bugher, do hereby certify that the foregoing transcript is a true and correct record of the recorded proceedings; that said proceedings were transcribed to the best of my ability from the audio recording and supporting information; and that I am neither counsel for, related to, nor employed by any of the parties to this case and have no interest, financial or otherwise, in its outcome.

/s/ Molly Bugher
Molly Bugher, CDLT-161

DATE: May 27, 2021
