

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CAPTIONCALL, LLC  
Petitioner

v.

ULTRATEC, INC.  
Patent Owner

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Case IPR2013-00549  
Patent 6,603,835 B2

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

SAINDON, *Administrative Patent Judge*.

DECISION  
CaptionCall's Request for Rehearing  
*37 C.F.R. § 42.71*

## INTRODUCTION

The Board instituted an *inter partes* review of claims 1-5 and 7 of U.S. Patent No. 6,603,835 (“the ’835 patent”). Paper 7 (“Dec.”). In its decision, the Board declined to institute review of challenged claims 6 and 8. *Id.* at 19-24. In its request for rehearing (Paper 12, “Req.”), Petitioner contends that: (1) the Board overlooked portions of Petitioner’s reasoning for combining Mukherji with (a) Liebermann and Engelke ’405 and (b) McLaughlin and Engelke ’405<sup>1</sup> and (2) the Board exclusively focused on a particular citation from *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007), to the exclusion of other portions of that decision that support Petitioner’s rationale to combine. Req. 3-4. For the reasons set forth below, Petitioner’s request for rehearing is *denied*.

## DISCUSSION

When rehearing a decision on institution, the Board reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). In pertinent part, 37 C.F.R. § 42.71(d) states:

The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

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<sup>1</sup> The prior art asserted in the Petition and germane to this request for rehearing is:

Engelke ’405	US 5,724,405	(Ex. 1005)
McLaughlin	US 6,181,736 B1	(Ex. 1006)
Liebermann	US 5,982,853	(Ex. 1008)
Mukherji	US 7,117,152 B1	(Ex. 1009)

*Petitioner's First Contention—Reason to Combine*

The Board did not abuse its discretion in determining that Petitioner did not present an articulated reason with a rational underpinning to combine the cited prior art references in the Liebermann-Engelke '405-Mukherji and McLaughlin-Engelke '405-Mukherji grounds. In its petition, Petitioner offered the following reason for combination:

Although the technical problem that compromised voice communication in *Mukherji* (e.g., lost voice packets) was different than the technical problem that compromised voice communication in *Liebermann* and *Engelke '405* (e.g., lost or attenuated hearing), the basic concept of using text to assist compromised voice communications in all three patents is the same. *See* Ex. 1010, Occhiogrosso Decl., ¶ 45. Thus it would have been obvious to combine the mechanism by which *Muk[h]erji* initiated and controlled the text assistance into the communication system taught by the combination of *Liebermann* and *Engelke '405*. *See id.*

Pet. 51-52. The cited portion of the declaration of Mr. Occhiogrosso repeats the above-quoted text. Ex. 1010 ¶ 45. In the Board's decision, with respect to the reason for combination offered in the petition, the Board stated:

Petitioner states that all three references have “the basic concept of using text to assist compromised voice communications.” *Id.* at 52 (citing Ex. 1010 ¶ 45). Based solely on this statement, Petitioner asserts, “it would have been obvious to combine the mechanism by which *Mukherji* initiated and controlled the text assistance into the communication system taught by the combination of *Liebermann* and *Engelke '405*.” *Id.*

Dec. 21. Petitioner contends that the Board “may have overlooked additional statements of Petitioner and its expert when articulating a motivation to combine.” Req. 5. Petitioner states that it provided support by citing to the declaration of Mr. Occhiogrosso. Req. 6-7. However, as shown in the excerpt from the decision above, the Board made clear it considered the cited paragraph of the declaration of Mr. Occhiogrosso. Dec. 21. The testimony in the declaration largely mirrors the language of the petition, aside from a statement not tied to the offered rationale, such that the Board had no reason to discuss the declaration in detail.<sup>2</sup> In view of the above, Petitioner has not persuaded us that the Board abused its discretion or overlooked any position articulated in the petition with respect to the expressed reason to combine Liebermann, Engelke ’405, and Mukherji. Likewise, we are not persuaded with respect to the McLaughlin, Engelke ’405, and Mukherji combination, for similar reasons. *See also* Pet. 56 (providing that the rationale for this combination is “the same reasons as explained in [the Liebermann-Engelke ’405-Mukherji combination]”).

Petitioner then goes on to state that other paragraphs and/or positions of Mr. Occhiogrosso’s declaration support its position. Req. 7-9. However, as evident above, only paragraph 45 was discussed in its petition in support of the reason to combine. Pet. 52. Similarly, Petitioner now indicates that it was Petitioner’s contention that “a person of ordinary skill in the art would have

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<sup>2</sup> The additional assertion was the declarant’s opinion that the proposed combination would have had a benefit. Ex. 1010 ¶ 45. In and of itself, this assertion is not a sufficient reason for combination and, in any case, the particular rationale offered in the petition (same “basic concept”) did not rely on benefits or any recognition of such by one of ordinary skill in the art.

recognized that because all three references dealt with a similar problem with the same solution, it would have been obvious that the solutions and benefits of the references could be combined to improve one another.” Req. 6. The Petitioner now contends that it was on that basis that the Petitioner concluded it would have been obvious to combine the references. *Id.* However, as evident above, Petitioner’s contentions are new, as the conclusion in the petition did not contend that the references could be combined to improve one another. *See* Pet. 51-52.

A request for rehearing is not an opportunity to present new arguments or evidence that could have been presented in the petition. 37 C.F.R. § 42.71(d). The petitioner has the burden to identify and explain the specific evidence that supports its arguments in the petition. 35 U.S.C. § 314(a). Thus, the *petition itself* must identify “[h]ow the construed claim is unpatentable” and must identify “specific portions of the evidence that support the challenge.” 37 C.F.R. § 42.104(b)(4)-(5) (“The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge.”). Petitioner should not expect the Board to search the record and piece together any evidence or arguments that may support Petitioner’s ultimate conclusion. *Cf. DeSilva v. DiLeonardi*, 181 F.3d 865, 866-67 (7th Cir 1999) (“A brief must make all arguments accessible to the judges, rather than ask them to play archaeologist with the record.”).

*Petitioner’s Second Contention—Citation to KSR*

In its decision, the Board made the following statement with respect to the rationale offered by Petitioner in the petition:

We agree with Patent Owner that the petition falls short of providing an articulated reasoning with rational underpinning for combining the teachings of Mukherji with Liebermann. *See KSR*, 550 U.S. at 418 (“a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art”).

Dec. 21. Petitioner contends that “other pertinent portions of the *KSR* decision support Petitioner’s proposed motivation to combine.” Req. 10. Given that Petitioner did not cite to, or otherwise rely on, *KSR* in its reason for combination, it is not clear how the Board abused its discretion or overlooked Petitioner’s position with respect to *KSR*. Petitioner has the burden of showing, in its petition, a reasonable likelihood that it would prevail. 35 U.S.C. § 314(a). That reasonable likelihood is measured by considering the analysis offered by Petitioner. 37 C.F.R. § 42.104(b) (setting forth the requirements of a petition, including specificity and identification of support). The reason articulated by Petitioner (that the references share a “basic concept”) was determined to be insufficient by the Board. The Board considers the reasons *articulated by Petitioner*; Petitioner should not expect the Board to search the record and piece together additional evidence that may support Petitioner’s position, or to insert its own reason for combination. *Id.*; *see DeSilva*, 181 F.3d at 866-67.

### CONCLUSION

For the foregoing reasons, Petitioner has not shown that the Board abused its discretion when declining to institute *inter partes* review of claims 6 and 8 of the ’835 patent on the Liebermann-Engelke ’405-Mukherji and McLaughlin-Engelke ’405-Mukherji grounds.

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Petitioner's request for rehearing is *denied*.

For PETITIONER:

Brian W. Oaks  
Bryant C. Boren Jr.  
BAKER BOTTS L.L.P.  
[brian.oaks@bakerbotts.com](mailto:brian.oaks@bakerbotts.com)  
[Bryant.c.boren@bakerbotts.com](mailto:Bryant.c.boren@bakerbotts.com)

For PATENT OWNER:

Michael Jaskolski  
Martha Snyder  
QUARLES & BRADY LLP  
[michael.jaskolski@quarles.com](mailto:michael.jaskolski@quarles.com)  
[martha.snyder@quarles.com](mailto:martha.snyder@quarles.com)