

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAPTIONCALL, LLC,
Petitioner,

v.

ULTRATEC, INC.,
Patent Owner.

Cases IPR2013-00540 (Patent 6,233,314)¹
IPR2013-00541 (Patent 5,909,482)
IPR2013-00544 (Patent 8,213,578)

Before WILLIAM V. SAINDON and BARBARA A. BENOIT,
Administrative Patent Judges.

BENOIT, *Administrative Patent Judge.*

DECISION

Petitioner's Motion to Submit Supplemental Information
37 C.F.R. § 42.123(b)

¹ This Order addresses overlapping issues in the above-identified cases. Therefore, we issue one order to be filed in all cases.

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We authorized Petitioner to file a motion to submit supplemental information and Patent Owner to file an opposition. Petitioner moves to submit supplemental information under 37 C.F.R. § 42.123(b). Paper 52.² Patent Owner opposes. Paper 57. The supplemental information consists of (i) a transcript of an interview with Dr. Yamamoto (Ex. 2017) and associated stipulation (Ex. 1062) and (ii) a revised certificate (Ex. 1064), which includes language specified in 37 C.F.R. § 1.68 (“the penalty of perjury language”) regarding the translation of the Yamamoto reference.³ Upon consideration of the documents and the parties’ arguments, and for the reasons stated below, Petitioner’s motion is granted.

To submit evidence later more than one month after the institution of an *inter partes* review, 37 C.F.R. § 42.123(b) requires: (i) that the information reasonably could not have been obtained earlier, and (ii) that consideration of the supplemental information would be in the interests of justice.

² For purposes of clarity and expediency, we treat IPR2013-00540 as representative, all citations are to IPR2013-00540 unless otherwise noted.

³ Yamamoto is a Japanese language document—Seiichi Yamamoto and Masanobu Fujioka, New Applications of Voice Recognition, Proc. JASJ Conf. (March 1996). Ex. 1005. Petitioner provided an English language translation (Ex. 1006) and an affidavit attesting to the accuracy of the translation without including the penalty of perjury language (Ex. 1016). *See* 37 C.F.R. § 42.63(b).

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Transcript and Associated Stipulation

On August 20, 2013, Petitioner filed eight petitions.⁴ We instituted an *inter partes* review in each of the proceedings on March 5, 2014 and synchronized the trial schedules for all eight proceedings. Paper 8 (Decision on Institution), Paper 9 (Scheduling Order). In several of the eight proceedings, at least one of the instituted grounds of unpatentability is based on the Yamamoto reference. *See* IPR2013-00540, Paper 8 at 15; IPR2013-00541, Paper 6 at 30-31; IPR2013-00544, Paper 6 at 21. Petitioner asserted, in its Petition, that Yamamoto qualifies as prior art to the challenged patent under 35 U.S.C. § 102(b). Paper 1 at 11.

On March 19, 2014, Patent Owner challenged the public availability of the Yamamoto reference and, hence, its prior art status. Paper 22 at 4; Ex. 1063 (Petitioner's chronology showing Patent Owner's evidentiary objections under 35 C.F.R. § 42.64(b)(1)). In response, Petitioner timely served Patent Owner supplemental evidence, including a declaration from Akihito Nakamachia, within ten business days of service of the objection under 37 C.F.R. § 42.64(b)(2). Paper 14 at 5; Paper 22 at 4; *see, e.g.*, IPR2013-00541, Ex. 1034 at 23-24 (Akihito Nakamachia declaration). Patent Owner objected to the sufficiency of that evidence to show the

⁴ IPR2013-00540 (Patent 6,233,314), IPR2013-00541 (Patent 5,909,482), IPR2013-00542 (Patent 7,319,740), IPR2013-00543 (Patent 7,555,104), IPR2013-00544 (Patent 8,213,578), IPR2013-00545 (Patent 6,594,346), IPR2013-00549 (Patent 6,603,835), and IPR2013-00550 (Patent 7,003,082).

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Yamamoto reference was publicly available and, therefore, prior art to the challenged patent. Paper 14 at 5. In response to Patent Owner’s challenge, Petitioner, after obtaining an extension of time for serving supplemental evidence (Paper 22), provided Patent Owner with a certification (Ex. 1035; “the JIST certification”) from the Japan Science and Technology Agency—an independent administrative agency under the Ministry of Education, Culture, Sports, Science and Technology in Japan—attesting to the date on which the Yamamoto reference was publicly available at the agency, and translation of the JIST certification (Ex. 1036). Petitioner represents it served the JIST certification on Patent Owner on April 11, 2014. Ex. 1063 (Chronology).

Patent Owner filed its response under 37 C.F.R. § 42.120 on May 30, 2014. Paper 30. Notably, the Patent Owner Response did not challenge the sufficiency of Petitioner’s evidence demonstrating the public availability of the Yamamoto reference, or otherwise contend that the Yamamoto reference was not prior art under 35 U.S.C. § 102(b) to the challenged patent. *See generally id.*

Rather, Patent Owner waited an additional three months, until August 26, 2014 in its Motion to Exclude Evidence, to challenge the sufficiency of Petitioner’s evidence provided on April 11, 2014, regarding the public availability of the Yamamoto reference. Paper 46.

In its Motion to Exclude, Patent Owner argues that Petitioner failed to establish that the Yamamoto reference is a printed publication and, therefore, is not a prior art publication. *Id.* at 3. Specifically, Patent Owner

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contends that Petitioner did not establish that Yamamoto was disseminated or was indexed. *Id.* at 3-7. With its Motion to Exclude, Patent Owner, in compliance with its duty of candor, filed a transcript (Ex. 2017) of an interview of Dr. Yamamoto on August 20, 2014 that, according to the stipulation of the parties, was to be treated the same as sworn deposition testimony in *Ultratec, Inc. v. Sorenson Communication, Inc. and Captioncall, LLC*, No. 13-cv-00346 (W.D. Wis.), a proceeding that also includes the patent challenged in this *inter partes* review and in which the Yamamoto reference is at issue (Paper 2 at 2). *See* Paper 57 at 5. Notably, attorneys representing Petitioner and Patent Owner involved in this proceeding participated in that interview. Ex. 2017 at 3. The transcript of Dr. Yamamoto's interview includes Dr. Yamamoto's answers to questions concerning presentation of his article at a conference in March 1996, as well as other information relevant to the public accessibility of the Yamamoto reference. *See, e.g.*, Ex. 2017 at 6:8-7:1, 7:23-8:11.

Petitioner contends that the transcript of Dr. Yamamoto's interview reasonably could not have been obtained earlier because (i) it was reasonable for Petitioner to believe the sufficiency challenge to the Yamamoto reference was settled by the JIST certification and (ii) only with the filing of Patent Owner's Motion to Exclude on August 26, 2014 did Petitioner become aware that Patent Owner was maintaining its challenge of the sufficiency of the Yamamoto reference as prior art. Paper 52 at 2-3. Petitioner contends (*id.* at 4-6) that allowing the introduction of the transcript of Dr. Yamamoto's interview and the stipulation concerning the

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same is in the interests of justice because of its relevance to the issue of the public availability of the Yamamoto reference, which its relevance presumably also is recognized by the Patent Owner who filed the deposition transcript to fulfill its duty of candor under 37 C.F.R. § 42.11.

Patent Owner opposes the introduction of the transcript of Dr. Yamamoto's interview and associated stipulation. Paper 57. Patent Owner contends that the issue of public accessibility of the Yamamoto reference was raised in its objections to evidence served March 19, 2014 on Petitioner and Petitioner could have, and should have, deposed Dr. Yamamoto in a timely fashion. *Id.* at 3; *see also* Paper 17. Patent Owner further contends that whether a reference is prior art is an evidentiary issue and "addressing the *admissibility* of the Yamamoto reference" in its Motion to Exclude was the proper procedure. Paper 57 at 2-3.

Whether a reference qualifies as a printed publication under 35 U.S.C. § 102(b) "is a legal conclusion based on underlying factual determinations." *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1377 (Fed. Cir. 2006) (quoting *Cooper Cameron Corp. Kvaerner Oilfield Prods.*, 291 F.3d 1317, 1321 (Fed. Cir. 2002)). Thus, the issue of whether evidence is *sufficient* to demonstrate, by the preponderance of evidence, that the Yamamoto reference is a printed publication under 35 U.S.C. § 102(b) should have been presented in Patent Owner's Response under 37 C.F.R. § 42.120 filed May 30, 2014. Addressing *admissibility* of evidence (e.g., authenticity or hearsay) underlying factual determinations of a legal conclusion whether the Yamamoto reference is a printed publication, however, is properly the

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subject of a motion to exclude. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48767 (Aug. 14, 2012) (“A motion to exclude must explain why the evidence is not admissible (*e.g.*, relevance or hearsay) but may not be used to challenge the sufficiency of the evidence to prove a particular fact.”).

Petitioner reasonably concluded, based on the absence in Patent Owner’s Response under 37 C.F.R. § 42.120 filed May 30, 2014, of a challenge to the prior art status of the Yamamoto reference, that Patent Owner was no longer challenging the prior art status of the Yamamoto reference and only became aware of Patent Owner’s continued challenge when Patent Owner improperly challenged the sufficiency of evidence in Patent Owner’s Motion to Exclude Evidence (Paper 46) filed on August 26, 2014.

Thus, we find Petitioner’s reason for the late submission of Dr. Yamamoto’s transcript to be credible. We further note that the transcript was for a video conference interview of Dr. Yamamoto on August 20, 2014 (Ex. 2017), during which Dr. Yamamoto was not sworn but the parties agreed that the stenographic record “will be treated the same as sworn U.S. deposition testimony in the Western District of Wisconsin proceedings between the parties.” Ex. 1062 (Stipulation Regarding Seiichi Yamamoto) ¶¶ 1, 5. We agree that the transcript of Dr. Yamamoto’s interview (Ex. 2017) and associated stipulation (Ex. 1062) reasonably could not have been obtained earlier.

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We also determine that the submission of Dr. Yamamoto's interview transcript (Ex. 2017) and associated stipulation (Ex. 1062) is in the interests of justice because counsel for Petitioner and Patent Owner were able to ask questions of the author of the Yamamoto reference concerning facts related to the public availability of the Yamamoto reference, on which at least one of the instituted grounds of unpatentability in each of IPR2013-00540, IPR2013-00541, and IPR2013-00544 is based. *See* Ex. 1062 ¶ 1. The stipulation between the parties also contemplated the use and admissibility of the stenographic record in other proceedings, as permitted by rules governing other proceedings. *See* Ex. 1062 ¶ 5.

To mitigate any potential prejudice to Patent Owner, we will reset the date of the Oral Hearing to November 19, 2014; otherwise, the Oral Hearing Order (Paper 50) remains unchanged. Additionally, to provide Patent Owner a full and fair opportunity to respond to Petitioner's contentions regarding the public accessibility of the Yamamoto reference based on the supplemental information, we will allow additional briefing. As such, if Petitioner wishes to rely on the sufficiency of the transcript of the Yamamoto interview to support its contention that Yamamoto is a printed publication and, therefore, is prior art to the challenged patents, Petitioner may file, no later than October 3, supplemental briefing of up to seven pages regarding public accessibility of the Yamamoto reference, including any observations on the transcript of Dr. Yamamoto's interview (Ex. 2017). Patent Owner may file, no later than October 14, 2014, a response to Petitioner's supplemental briefing of up to ten pages concerning public

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accessibility of the Yamamoto reference, including any observations on the transcript of Dr. Yamamoto's interview (Ex. 2017) and any arguments concerning the admissibility of the transcript of Dr. Yamamoto's interview. Petitioner may file, no later than October 20, 2014, a reply of up to three pages addressing only admissibility contentions, if any, raised in Patent Owner's response. The parties are reminded of the Board's prohibition against incorporating arguments from one document to another document. 37 C.F.R. § 42.6(a)(3).

Translation Certification

Petitioner also requested a revised certificate (Ex. 1064), which includes the penalty of perjury language specified in 37 C.F.R. § 1.68 regarding the translation of the Yamamoto reference, be permitted to be filed as supplemental information. Previously, Petitioner filed a certification (Ex. 1016) attesting to the accuracy of the translation (Ex. 1006) of the Yamamoto reference (Ex. 1005), as required by 37 C.F.R. § 42.63(b). That certification, however, did not include the required penalty of perjury language specified in 37 C.F.R. § 1.68. As noted by Petitioner (Paper 52 at 6), Patent Owner does not contest the accuracy of the translations.

Because (i) the revised certification (Ex. 1064), which includes the penalty of perjury language concerning the translation of the Yamamoto reference, on which at least one of the instituted grounds of unpatentability in each of IPR2013-00540, IPR2013-00541, and IPR2013-00544 is based, provides a more complete record of the proceeding, (ii) Patent Owner does

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not contest the accuracy of the translation, and (iii) Patent Owner would not be prejudiced by the introduction of the revised certification, we determine the submission of the revised certification (Ex. 1064) is in the interests of justice, and we waive the requirement of 37 C.F.R. § 42.123(b) which requires that the supplemental information reasonably could not have been obtained earlier. *See* 37 C.F.R. § 42.5(b) (permitting the Board to waive or suspend a requirement of parts 1, 41, and 42).

ORDER

Accordingly, it is

ORDERED that Petitioner's motion for leave to file supplemental evidence regarding Yamamoto (Paper 52) is granted;

FURTHER ORDERED that Exhibits 2017, 1062, and 1064 be, and hereby are, entered into the record of IPR2013-00540;

FURTHER ORDERED that Exhibits 2018, 1062, and 1064 be, and hereby are, entered into the record of IPR2013-00541;

FURTHER ORDERED that Exhibits 2017, 1067, and 1069 be, and hereby are, entered into the record of IPR2013-00544;

FURTHER ORDERED that DUE DATE 7 (Oral Hearing) is reset to November 19, 2014 and that the Order (Paper 50) regarding the trial hearing otherwise remains in effect;

FURTHER ORDERED that, if Petitioner wishes to rely on the sufficiency of the transcript of the Yamamoto interview to support its contention that Yamamoto is a printed publication and, therefore, is prior art

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to the challenged patents, Petitioner may file, no later than October 3, 2014, supplemental briefing of up to seven pages regarding public accessibility of the Yamamoto reference, including any observations on the transcript of Dr. Yamamoto's interview (Ex. 2017);

FURTHER ORDERED that Patent Owner may file no later than October 14, 2014 a response to Petitioner's supplemental briefing of up to ten pages concerning public accessibility of the Yamamoto reference, including any observations on the transcript of Dr. Yamamoto's interview (Ex. 2017) and any arguments concerning the admissibility of the transcript; and

FURTHER ORDERED that Petitioner may file no later than October 20, 2014 a reply of up to three pages addressing only admissibility contentions, if any, raised in Patent Owner's response.

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