

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAPTIONCALL, LLC and
SORENSEN COMMUNICATIONS, INC.
Petitioner

v.

ULTRATEC, INC.
Patent Owner

Case IPR2015-00637
U.S. Patent 8,908,838 B2

PATENT OWNER ULTRATEC INC.'S NOTICE OF APPEAL

Director of the United States Patent and Trademark Office
c/o Office of the General Counsel
Madison Building East, 10B20
600 Dulany Street
Alexandria, VA 22314-5793

Patent Owner Ultratec, Inc. hereby gives notice, pursuant to 37 C.F.R. § 90.2(a), that it is appealing to the United States Court of Appeals for the Federal Circuit from the Final Written Decision entered on September 7, 2016 (Paper 98) (“Final Written Decision”) and such other orders and rulings as set forth below.

In accordance with 37 C.F.R. § 90.2(a)(3)(ii), Patent Owner further indicates that the issues on appeal include:

1. Whether the Patent Trial and Appeal Board (“PTAB”) erred in finding that the Petitioner had proved by a preponderance of the evidence that claims 1-9, 11-17, 19-25, and 27-29 of U.S. Patent No. 8,908,838 (“‘838 Patent”) are unpatentable as being obvious under 35 U.S.C. § 103 over the *Liebermann* reference (U.S. Patent No. 5,982,853), the *Engelke ‘405* reference (U.S. Patent No. 5,724,405), and the *Mukherji* reference (U.S. Patent No. 7,117,152 B1).
2. Whether the PTAB erred in finding that the Petitioner had proved by a preponderance of the evidence that claims 10, 18, 26, and 30 of ‘838 Patent are unpatentable as being obvious under 35 U.S.C. § 103 over the *Liebermann*

reference, the *Engelke* '405 reference, the *Mukherji* reference, and the *Engelke* '482 reference (U.S. Patent No. 5,909,482).

3. Whether the PTAB erred in construing the terms of claims 1-30 of the '838 Patent and proposed substitute claims 31-36, including, for example, the following terms: “wherein the captioned device processor is linked to the first communication link”; “the captioned device processor is further programmed to maintain the second communication link directly between the relay and the captioned device and the first communication link directly between the captioned device and the hearing user”; “the captioned device processor is further programmed to provide the captioning service to the assisted user without making the hearing person aware that captioning from the relay is being used, for both incoming and outgoing calls”; and “wherein the captioned device processor is linked to the first communication link and the second communication link such that use of the captioning service by the assisted user is transparent to the hearing person for both incoming and outgoing calls.”
4. Whether the PTAB erred in granting in-part Petitioner’s Motion to Exclude, and specifically finding that Exhibits 2045, 2046, 2048, and 2062 are hearsay without any exception.

5. Whether the PTAB erred in finding the elements of claims 1-30 of the '838 Patent present in the prior art both individually and in combination, for purposes of a finding of obviousness under 35 U.S.C. § 103.
6. Whether the PTAB erred in determining that a person of ordinary skill in the art would have had a motivation or rationale for combining the cited references.
7. Whether the PTAB erred, procedurally and substantively, in its analysis of Patent Owner's evidence of secondary considerations of non-obviousness, including by first finding claims 1-30 of the '838 Patent to be obvious and the subject matter of those claims to be in the prior art, then discounting secondary considerations on such basis, and further by discounting the testimony of Patent Owner's expert based on the PTAB's misapplication of law and procedure.
8. Whether the PTAB exceeded its statutory and regulatory authority in making its factual findings supporting the ultimate conclusion of obviousness, including but not limited to whether the PTAB improperly conducted independent research and/or relied on arguments and evidence not addressed by either party, and/or improperly shifted the burden of proof on factual issues to Patent Owner.

9. Whether the PTAB erred in denying Patent Owner's Motion to Dismiss (Paper No. 96), including whether the proceedings should have been dismissed, because the Petitioner failed to identify all real parties in interest, including as required under 35 U.S.C. § 312(a)(2) and related regulations, and consequently whether the PTAB lacked authority to proceed in rendering the Final Written Decision.
10. Whether the PTAB erred in denying Patent Owner's Motion for Additional Discovery concerning whether Petitioner properly identified the real parties in interest (Paper 43) and Patent Owner's Request for Rehearing on the PTAB's denial of Patent Owner's Motion for Additional Discovery (Paper 88).
11. Whether the PTAB erred in denying Patent Owner's Request to file a Motion for Additional Discovery regarding facts and materials relied upon by Petitioner's Declarant, Mr. Occhiogrosso (Paper 21).
12. Whether the PTAB erred in denying Patent Owner's Contingent Motion to Amend, including whether the PTAB erred in finding proposed substitute claims 31-36 unpatentable under 35 U.S.C. § 112(a) for lack of written description support, whether the PTAB erred in finding proposed substitute claim 36 unpatentable under 35 U.S.C. § 112(b) as indefinite, and whether the PTAB erred in placing the burden of persuasion and/or production on Patent

Owner regarding the patentability of the proposed substitute claims (*see, e.g., In re Aqua Products, Inc.*, No. 2015-1177, 2016 WL 4375651 (Fed. Cir. August 12, 2016) (granting Aqua Product’s petition for rehearing *en banc* the same).

13. Whether the *Inter Partes* Review proceedings in general, and this case in particular, are unconstitutional and in violation of principles of administrative agency authority, including to the extent the PTAB is empowered (including under 35 U.S.C. §§ 311 and 316) to invalidate, cancel, and/or render unpatentable an issued patent without affording any deference or presumption of validity to the issued claims, and to the extent the PTAB is further empowered to preclude patent owners from seeking to amend claims without first satisfying unduly restrictive and prohibitive threshold requirements via motion (*see, e.g., 37 C.F.R. § 42.121; Idle Free Systems, Inc. v. Bergstrom, Inc.*, Case IPR2012-00027 (PTAB June 11, 2013) (Paper 26) (setting forth requirements for motions to amend, and designated “informative” by the PTAB)).

14. Whether 35 U.S.C. § 318(b) violates Article III of the United States Constitution, including because it empowers an executive agency tribunal to assert judicial power cancelling a private property right amongst private parties embroiled in a private federal dispute of a type known in the common

law courts of 1789, rather than merely issue an advisory opinion as an adjunct to a trial court (*see e.g., Cooper v. Square, Inc.*, No. 16-76 (S. Ct. *petition for cert. filed* July 13, 2016));

Simultaneous with this submission, a copy of this Notice of Appeal is being filed with the Patent Trial and Appeal Board. In addition, three copies of this Notice of Appeal, along with the required docketing fees, are being filed with the Clerk's Office for the United States Court of Appeals for the Federal Circuit.

Respectfully submitted,

QUARLES & BRADY LLP

Date: November 8, 2016

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CERTIFICATE OF FILING AND SERVICE

Filed Electronically via PTAB E2E

The undersigned hereby certifies that the foregoing PATENT OWNER ULTRATEC, INC.'S NOTICE OF APPEAL was filed with the Patent Trial and Appeal Board on November 8, 2016, using the PTAB E2E System pursuant to 37 C.F.R. § 42.6(b)(1).

The undersigned further certifies that on November 8, 2016, a copy of the foregoing PATENT OWNER ULTRATEC, INC.'S NOTICE OF APPEAL and the Final Written Decision (along with the fee set forth in Federal Circuit Rule 52), were electronically filed with the Federal Circuit using the Court's CM/ECF System.

The undersigned further certifies that on November 8, 2016, a copy of the foregoing PATENT OWNER ULTRATEC, INC.'S NOTICE OF APPEAL and the Final Written Decision were filed by hand delivery with the Director of the United States Patent and Trademark Office, at the following address:

Michelle K. Lee
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The undersigned further certifies that on November 8, 2016, a copy of the foregoing PATENT OWNER ULTRATEC, INC.'S NOTICE OF APPEAL was served via UPS Next Day Air on lead counsel for Petitioner and via email on all counsel for Petitioner:

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