IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAPTIONCALL, LLC

Petitioner

v.

ULTRATEC, INC.

Patent Owner

Case IPR2013-00541

Patent 5,909,482

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 Decision on Remand entered on April 10, 2019 (Paper 106) ("Decision on Remand"),[1] the Order on Conduct of the Proceeding on remand entered on January 3, 2018 (Paper 102) ("Order on Remand Proceeding"), the original Final Written Decision entered on March 3, 2015 (Paper 76) ("Final Written Decision"), the Decision Denying Patent Owner's Request for Rehearing entered on December 1, 2015 (Paper 78) ("Denial of Rehearing"), 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

[1] The Board ordered that the Decision on Remand is a final written decision for purposes of 35 U.S.C. § 318(a) and serves to modify the original Final Written Decision (*see* Paper 106, 55), but Patent Owner identifies them separately herein for clarity.

and 5 of U.S. Patent No. 5,909,482 ("'482 Patent") are unpatentable as being anticipated by the *Ryan* reference (Ex. 1004 (U.S. Patent No. 5,809,112)) under 35 U.S.C. § 102(e));

2. Whether the PTAB erred in finding that the Petitioner had proved by a preponderance of the evidence that claims 1-15 of the '482 Patent are unpatentable as being obvious under 35 U.S.C. § 103 in view of the various cited combinations of prior art references;
3. Whether the PTAB erred by continuing to apply the broadest reasonable interpretation standard in construing the terms of claims 1-15 of the '482 Patent even after it expired;
4. Whether the PTAB erred in construing the claim terms;
5. Whether the PTAB erred on remand in refusing to consider—or even allow briefing on—claim construction after the '482 Patent expired;
6. Whether the PTAB erred in finding the elements of the claims were present in the prior art: (1) as arranged in the claim, for purposes of a finding of anticipation under § 102(e); and/or (2) both individually and in combination, for purposes of a finding of obviousness under § 103;
7. 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;

8. Whether the PTAB erred in determining the relevant field of art and, consequently, the views and motivations of a person of ordinary skill in the art in that field, and further erred by failing to find a rationale for combining prior art references commensurate with the scope of the claims;
9. Whether the PTAB erred in its consideration of objective indicia of non-obviousness;
10. Whether the PTAB erred in refusing to accept and consider—or even allow Patent Owner to file a motion regarding—previously sealed evidence from the parties' federal court litigation;
11. Whether the PTAB erred in finding that the testimony from Petitioner's expert given during the federal court litigation did not contradict and/or undermine his testimony offered during these proceedings;
12. Whether the PTAB erred in holding that it would revisit the merits of the proceedings only if it found that the expert testimony from the litigation contradicted the expert's testimony from these proceedings;
13. Whether the PTAB erred in refusing on remand to allow briefing or submissions on issues other than the inconsistent testimony of Petitioner's expert;
14. Whether the PTAB exceeded its statutory and regulatory authority in making its factual findings supporting the ultimate conclusions of

anticipation and obviousness, including whether the PTAB improperly shifted the burden of proof on such issues to Patent Owner;

15. Whether the PTAB erred in denying Patent Owner's motions to exclude evidence, erred in treating Petitioner's expert as a person of ordinary skill in the art, erred by permitting Petitioner's expert to testify, and erred by relying on Petitioner's expert's opinions;

16. Whether the PTAB's practice of requiring parties to initiate conference calls to request leave to file motions and evidence (e.g., without permitting the parties to submit briefing or copies of the proposed motions and evidence) is unconstitutional and against applicable administrative law;

17. Whether the PTAB's decisions denying Patent Owner's requests for leave to file relevant evidence were erroneous and unlawful;

18. Whether the *Inter Partes* Review proceedings in general, and this case in particular, constitute an unconstitutional delegation of judicial power to an executive agency, particularly when, as here, a U.S. District Court found some of the claims to be valid through summary judgment and/or jury verdict;

19. Whether the PTAB lacked authority to proceed in rendering the Final Written Decision, Denial of Rehearing and Decision on Remand, and 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;

20. Whether the PTAB erred in refusing to allow Patent Owner to seek discovery on and file a motion contesting Petitioner's Real Party-in-Interest disclosure;

21. Whether the *Inter Partes* Review proceedings in general, and this case in particular, are unconstitutional and/or 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; and

22. Whether *Inter Partes* Review proceedings in general, and this case in particular, result in unconstitutional takings and/or violations of due process.

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

Respectfully submitted,

Date: June 7, 2019

s/*Martha Jahn Snyder/*

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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 June 7, 2019, using the PTAB E2E System pursuant to 37 C.F.R. § 42.6(b)(1). In addition, a copy of the foregoing Notice of Appeal (along with the fee set forth in Federal Circuit Rule 52) was electronically filed with the Federal Circuit using the Court's CM/ECF System.

The undersigned further certifies that on June 7, 2019, the original version of the foregoing Notice of Appeal was filed by Express Mail with the Director of the United States Patent and Trademark Office, at the following address:

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

The undersigned further certifies that on June 7, 2019, a copy of the foregoing Notice of Appeal was served via email on all counsel of record for Petitioner and also by UPS Next Day Air on Lead Counsel for Petitioner:

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