

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SECURUS TECHNOLOGIES, INC.,
Petitioner,

v.

GLOBAL TEL*LINK CORPORATION,
Patent Owner.

Case IPR2015-00153
Patent 7,783,021 B2

Before KEVIN F. TURNER, BEVERLY M. BUNTING, and
PATRICK M. BOUCHER, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

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On October 24, 2014, Securus Technologies, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 1–23¹ of U.S. Patent No. 7,783,021 B2 (“the ’021 patent”). Global Tel*Link Corporation (“Patent Owner”) filed a Preliminary Response (Paper 10, “Prelim. Resp.”) on February 5, 2015. Applying the standard set forth in 35 U.S.C. § 314(a), which requires demonstration of a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim, we deny the Petition and decline to institute an *inter partes* review.

I. BACKGROUND

A. *The ’021 Patent*

The application for the ’021 patent was filed on January 28, 2005, and relates to telephone communication systems in penal institutions or similar facilities. Ex. 1001, col. 1, ll. 6–8. Figure 1 of the ’021 patent is reproduced below.

¹ The Petition’s statement at page 1 that Petitioner “requests *inter partes* review of claims 1-27” (emphasis added) appears to be a typographical error. The ’021 patent only has 23 claims.

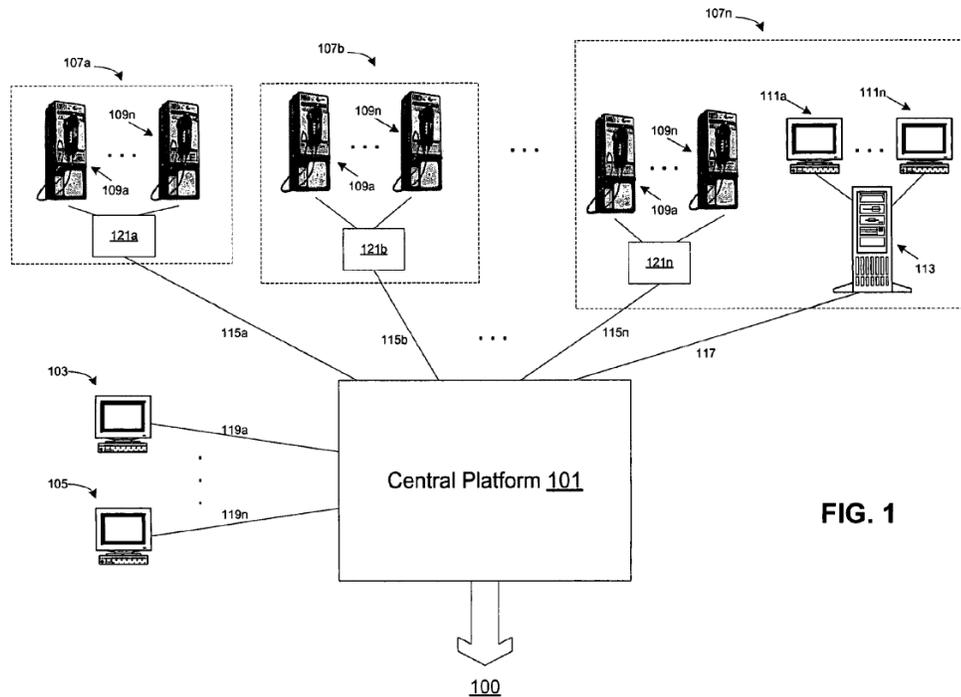


FIG. 1

Figure 1 is a block diagram illustrating a centralized setup of a call-management system over a public switched telephone network (“PSTN”). *Id.* at col. 15, ll. 59–62. Central call platform 101 connects to routers 121a–n at sites 107a–n via connections 115a–n. *Id.* at col. 15, ll. 62–64. Sites 107a–n contain telephonic instruments 109a–n and may contain workstations 111a–n connected to server 113 as illustrated for site 107n. *Id.* at col. 15, l. 65 – col. 16, l. 2. In addition to other functions, administrative workstation 105 can use a live operator or software to monitor calls without detection. *Id.* at col. 17, ll. 8–22. Investigative workstation 103 controls monitoring and security features. *Id.* at col. 17, ll. 38–40.

B. Illustrative Claim

Claim 1 of the '021 patent is illustrative of the claims at issue:

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1. An inmate telecommunication call processing system comprising:

a plurality of trunk lines of a Public Switched Telephone Network (PSTN);

at least one telephone terminal for making a telephone call, wherein said telephone terminal is located onsite at an institution;

a central platform coupled to said plurality of trunk lines and coupled to said at least one telephone terminal for said telephone call,

wherein said central platform is located offsite from said institution, and

further wherein said central platform comprises one or more apparatuses for processing said telephone call;

an administrative workstation for connecting to a said telephone terminal to monitor conversations between said institution without detection by said user; and

at least one routing means coupled to said telephone terminal and said central platform;

wherein said one or more apparatuses controls telephonic communication between said at least one telephone terminal and said plurality of trunk lines,

wherein said one or more apparatuses records said conversations in said telephone call between a user associated with said at least one telephone terminal and an external party, and

further wherein said one or more apparatuses digitizes audio and stores said audio for caller identification at said institution, and

further wherein said one or more apparatuses communicates with an administrative workstation for billing regarding said telephone call originating from said institution.

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C. Asserted Ground of Unpatentability

Petitioner challenges claims 1–23 as anticipated by U.S. Patent No. 7,881,446 B1 (Ex. 1002, “Apple”).

D. Related Proceedings

Petitioner states that the ’021 patent is the subject of the following civil action: *Global Tel*Link Corp. v. Securus Technologies, Inc.*, Civil Action 3:14-cv-0829-K (N.D. Tex.). Pet. 1. In addition, Petitioner identified additional petitions challenging the patentability of a certain subset of claims in the following patents owned by Patent Owner: U.S. Patent No. 7,551,732 (Case IPR2015-00156) and U.S. Patent No. 7,853,243 (Case IPR2015-00155). *Id.*

II. ANALYSIS

The first, and dispositive, question we must resolve is whether Petitioner establishes that the disclosure of Apple relied upon to prove anticipation is prior art. Apple was filed on September 2, 2005, and claims the benefit of the filing date of several provisional applications under 35 U.S.C. § 119(e): (1) Appl. No. 60/607,447, filed September 3, 2004; (2) Appl. No. 60/676,155, filed April 29, 2005; (3) Appl. No. 60/676,153, filed April 29, 2005; (4) Appl. No. 60/676,151, filed April 29, 2005; (5) Appl. No. 60/676,154, filed April 29, 2005; and (6) Appl. No. 60/676,152, filed April 29, 2005. *Id.* at col. 1, ll. 6–20. Of these six provisional applications, only one—Appl. No. 60/607,447 (Ex. 1005, “the ’447 application”)—was

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filed before the January 28, 2005, filing date of the '021 patent.

Accordingly, Apple is prior art only to the extent that its content is supported by disclosure of the '447 application in a manner that complies with 35 U.S.C. § 112, first paragraph. *See* 35 U.S.C. §§ 102(e), 119(e)(1); *see Ex parte Yamaguchi*, 88 USPQ2d 1606, 1609 (BPAI 2008) (precedential); *see Square, Inc. v. REM Holdings 3, LLC*, Case IPR2014-00312, slip op. at 20–21 (PTAB July 10, 2014) (Paper 12).

Petitioner asserts that “[a]ll subject matter of [Apple] is supported by [the '447 application].” Pet. 9 (citing Ex. 1003 ¶ 56). Petitioner provides no analysis to support this assertion, but cites the declaration testimony of Dr. Robert Akl, who attests that “[b]ased on my review, all subject matter of [Apple] is supported by [the '447 application].” Ex. 1003 ¶ 56. Dr. Akl neither explains the criteria he applied in making that determination nor provides any analysis to support his conclusion.

Petitioner’s analysis of its challenge against claims 1–23 relies solely on the disclosure of Apple, without explaining how the specific disclosures it relies upon are supported by the '447 application. Indeed, as Patent Owner correctly observes, “the Petition does not provide a single citation to the '447 [application].” Prelim. Resp. 7. We agree with Patent Owner that Petitioner has the burden of demonstrating that Apple qualifies as prior art under 35 U.S.C. § 102(e). *See id.* 8–9 (citing 37 C.F.R. § 42.20(c); *Cisco Sys., Inc. v. Constellation Techs. LLC*, Case IPR2014-00914, slip op. at 23 (PTAB Jan. 2, 2015) (Paper 11); *Marvell Semiconductor, Inc. v. Intellectual Ventures I LLC*, Case IPR2014-00547, slip op. at 10 (PTAB Dec. 3, 2014)

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(Paper 17); *Butamax Advanced Biofuels LLC v. Gevo, Inc.*, Case IPR2013-00539, slip op. at 18 (PTAB Mar. 4, 2014) (Paper 9)). We do not credit Dr. Akl's testimony that all subject matter of Apple is supported by the '447 application. That testimony is conclusory in nature and entitled to little, if any, weight.

Patent Owner observes that the '447 application includes 34 pages of text, 10 sheets of drawings, and over 600 pages of exhibits, while Apple includes 19 sheets of drawings and more than 42 columns of text. Prelim. Resp. 13. "Of the drawings, FIGS. 10-18 of Apple were not disclosed in the '447 [application]." *Id.* Although it is not a requirement that the drawings be reproduced in identical form, neither the Petition nor the testimony of Dr. Akl explains how the content of those drawings is otherwise supported by the '447 application.

In addition, our review of Petitioner's analysis raises specific concerns regarding the accuracy of Dr. Akl's conclusion when applied to particular claim limitations. For example, independent claim 1 recites "an administrative workstation for connecting to a said telephone terminal to monitor conversations between said institution without detection by said user." Independent claims 7, 16, and 20 include similar limitations. Dr. Akl identifies Figure 5 of Apple, as "explained further in the specification," as disclosing the limitations. Ex. 1003 ¶ 83. The paragraph at column 8, lines 35–44 of Apple is among those relied on by Dr. Akl as providing such further explanation. *Id.* at ¶ 84. The Petition repeats the same analysis. Pet. 26–27. The cited paragraph does not appear to be reproduced verbatim

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in the '447 application, and Petitioner does not explain what portions of the '447 application provide specific support.

It is incumbent upon Petitioner to “specify where each element of the claim is found in the prior art patents or printed publications relied upon.” 37 C.F.R. § 42.104(b)(4). When the qualification of a reference as prior art depends on the existence of adequate support in another reference, this mandate requires that Petitioner explain where such support for its challenge can be found. “A brief must make all arguments accessible to the judges, rather than ask them to play archaeologist with the record.” *DeSilva v. DiLeonardi*, 181 F.3d 865, 867 (7th Cir. 1999).

Because Petitioner fails to demonstrate that all parts of Apple relied on for its challenge to claims 1–23 are prior art to the '021 patent, we conclude that Petitioner has not demonstrated a reasonable likelihood of prevailing on that challenge.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied* and no *inter partes* review is instituted.

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