

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 IPR2016-00267
Patent 7,256,816 B2

Before KEVIN F. TURNER, BARBARA A. BENOIT, and
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

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

I. INTRODUCTION

Securus Technologies (“Petitioner”) filed a Petition for *inter partes* review of claims 1–55 of U.S. Patent No. 7,256,816 B2 (Ex. 1001, “the ’816 Patent”). Paper 2 (“Pet.”). Patent Owner, Global Tel*Link Corporation, filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

Upon consideration of the Petition and the Preliminary Response, we conclude the information presented does not show that there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of any one of claims 1–55.

A. *Related Matters*

Both parties identify the district court proceeding *Securus Tech., Inc. v. Global Tel*Link Corp.*, Case No. 3:14-cv-04233-M (N.D. Tex.), as possibly affecting or being affected by the instant proceeding. Pet. 59; Paper 4, 2.

B. *The ’816 Patent*

As Petitioner indicates, “[t]he ’816 patent describes a system for conducting video visits between two participants, such as prison inmates and outside visitors.” Pet. 2 (citing Ex. 1001, 5:15–21). The ’816 Patent discloses that each endpoint of the system, serving the visitors and the

inmate, has an audio/video terminal connected through a data center, where the data center also houses equipment to schedule and conduct the video visits. *Id.* at 4:19–22, 6:12–14. The system also has an overseer’s terminal or station that is used to monitor the video visits, and is capable of displaying multiple sets of participants at one time, each selectable so that the visit can be observed. *Id.* at 8:58–9:2. The ’816 Patent also discusses prior art systems, including their apparent lack of synchronicity between data connections during the conference creating latency, and how those deficiencies are overcome by the ’816 Patent. *Id.* at 2:25–3:3.

C. Illustrative Claim

Claims 1 and 30 of the ’816 Patent are independent. Claim 1 is illustrative of the claimed subject matter:

1. A method of *monitoring a video visit* between at least a first participant and a second participant located at distinct endpoints, the method comprising:
 - establishing a first data connection from a data center and the first participant at a scheduled time;
 - establishing a second data connection from the data center and the second participant at the scheduled time, the first and second participants visiting via the first and second data connections;
 - capturing video and audio as original communications data from the first and second participants;
 - transmitting the original communications data to and from the first and second participants across a computer network via the data center;
 - splitting along the first or second data connection either the communications data transmitted from one of the first and

second participants to the data center, or the communications data transmitted to the one of the first and second participants from the data center, to create a copy of the video and audio communications data from the original video and audio communications data; and

monitoring the video visit by receiving the copy of the communications data at a monitoring station substantially simultaneously with the transmitting of the original communications data to and from the one of the first and second participants.

Ex. 1001, 16:21–47 (emphases added).

D. Asserted Grounds of Unpatentability

Petitioner contends that claims 1–55 of the '816 Patent are unpatentable based on the following specific grounds (Pet. 12–58):

Claims Challenged	Basis	References
1–15, 18–21, 25–44, 47–50, 54, and 55	§ 103	Bulriss ¹ and Hesse ²
16, 17, 22–24, 45, 46, and 51–53	§ 103	Bulriss, Hesse, and Rae ³

¹ US Patent No. 7,061,521 B2, filed December 16, 2003, issued June 13, 2006 (Ex. 1005, “Bulriss”).

² US Patent No. 7,046,779 B2, filed February 15, 2002, issued May 16, 2006 (Ex. 1006, “Hesse”).

³ US Patent No. 7,899,167 B1, filed August 15, 2003, issued March 1, 2011 (Ex. 1007, “Rae”).

II. DISCUSSION

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *see In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1278–79 (Fed. Cir. 2015), *cert. granted sub nom. Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 890 (mem.) (2016). Under that standard, claim terms are presumed to be given their ordinary and customary meaning as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

Petitioner asserts that “multiplexing means” and “transmitting means,” recited in certain claims, are means-plus-function limitations, and describes the recited functions and the corresponding structures provided in the Specification of the ’816 Patent. Pet. 7–12. Patent Owner argues that the Petition can be denied without considering Petitioner’s proposed claim constructions, but nonetheless also argues that Petitioner’s proposed constructions are deficient. Prelim. Resp. 4–9. We agree with Patent Owner that neither claim limitation needs to be construed specifically herein.

As such, for purposes of this Decision, we are not persuaded that any specific claim construction must be made in this decision to determine the efficacy of Petitioner’s grounds of unpatentability.

*B. Asserted Grounds of Obviousness over Bulriss, Hesse, and Rae
Claims 1–55*

Petitioner asserts that claims 1–15, 18–21, 25–44, 47–50, 54, and 55 are unpatentable under 35 U.S.C. § 103 as obvious over Bulriss and Hesse, and that claims 16, 17, 22–24, 45, 46, and 51–53 are unpatentable under 35 U.S.C. § 103 as obvious over Bulriss, Hesse, and Rae. Pet. 12–58. To support its contentions, Petitioner relies on the declaration testimony of Mr. Ivan Zatkovich. Ex. 1002. Patent Owner argues that the cited combinations fail to disclose all of the limitations of the claims, and also teach away from the claims of the '816 Patent. Prelim. Resp. 9–17, 21–25.

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)); *see also Intelligent Bio-Systems, Inc. v Illumina Cambridge Ltd.*, No. 2015-1693, 2016 WL 2620512, at *6 (Fed. Cir. May 9, 2016) (“It was [Petitioner]’s burden to demonstrate both that a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so.”) (internal quotation marks removed). Thus, Petitioner must explain how the combinations of Bulriss, Hesse, and Rae would have rendered the challenged claims unpatentable. For the reasons that follow, we determine that Petitioner has not done so.

1. Bulriss

Bulriss is entitled: “Video Conference System Providing Private and Attorney-Client Privileged Communications.” Ex. 1005, [54]. We note that the title of a patent may be used to aid in the understanding of the invention disclosed and claimed. *See, e.g., Exxon Chem. Patents, Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1557 (Fed. Cir. 1995); *Titanium Metals Corp. of Am. v. Banner*, 778 F.2d 775, 780 (Fed. Cir. 1985). Bulriss describes a conference system with two conference stations, one for the attorney and one for the attorney’s client. Ex. 1005, Abs. The stations are connected by at least one communications link, having a single processor for routing signals and a control panel that controls signals between the stations “so that the attorney and the attorney’s client are permitted to engage in a private communication without vitiating the attorney-client privilege.” *Id.*

Bulriss also discloses that in prior art systems, “to facilitate a private conference between an attorney and an inmate, it has been necessary to establish a separate telephone connections between the defense attorney and the inmate in the prison,” usually requiring a recess. *Id.* at 2:33–43. Bulriss also discloses that the attorney-client sidebar station may operate in both a public and a privacy mode, and when operating in the public mode, “the A/V signals are generated by the camera/microphone/monitor 170 and travel through the two-way communications link 164.” *Id.* at 15:35–38, 16-26–29.

Bulriss also discloses that judge’s control panel selects the inputs displayed on the display devices, including the prosecuting attorney, the defense attorney, the inmate and the judge, and allows for the parties to be recorded by a recording device. *Id.* at 17:4–12. In addition:

When the attorney-client sidebar feature is activated, the courtroom station 48 and the inmate's station 62, 172 *are the only two A/V IO devices that remain active. No other device connected to the system 10 participates in the attorney-client conversation.* All of the devices are "locked out" of the attorney-client privileged communication.

Id. at 18:2–8 (emphasis added). Bulriss also details that its system can be used at remote visitation facilities where family members can visit inmates via video conference, but no discussion of monitoring is made. *Id.* at 11:51–57. Petitioner points out that Bulriss identifies Hesse as a prior art video conferencing system. Pet. 16–17 (citing Ex. 1005, 3:55–58).

2. *Hesse*

Hesse is directed to a video conference system that provides reliable video conferencing involving prisoners and their visitors. Ex. 1006, 8:53–55. The system can have multiple stations, including a central site, a court, a visiting center, and a jail, with the central site having a conference control station, including a recorder. *Id.* at 8:56–9:3. A schedule conference process creates, revises, and deletes conference plans, identifies equipment and configurations, and provides notice of upcoming conferences. *Id.* at 6:56–67, 7:30–33.

3. *Analysis of Petitioner's Contentions*

Petitioner contends that “[o]ne of ordinary skill in the art at the time of the ’816 patent’s filing would have considered the teachings of *Bulriss* and *Hesse* and would have been motivated to combine them to address the problems allegedly solved by the ’816 patent.” Pet. 18. We note Petitioner has alleged that problems discussed in the ’816 patent would have served as a rationale to combine Bulriss and Hesse, but Petitioner has not shown that

those problems were actually known in the relevant timeframe. *See In re Nomiya*, 509 F.2d 566, 573 (CCPA 1975) (If there is no evidence of record that a person of ordinary skill in the art would have expected the problem to exist at all, it is not proper to conclude that the invention which solves this problem would have been obvious to that hypothetical person of ordinary skill in the art); *see also KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 420 (2007) (“Under the correct analysis, any need or problem *known in the field of endeavor at the time of the invention* and addressed by the patent can provide a reason for combining the elements in the manner claimed.”) (emphasis added). Additionally, Patent Owner points out that even if the disclosed problems of latency were known, Bulriss does not explicitly address latency in such systems, so that one of ordinary skill in the art would have had no reason to look to Bulriss to address those problems. Prelim. Resp. 27–28.

Nonetheless, Petitioner contends that because Bulriss does not expressly disclose establishing connections at a scheduled time, one of ordinary skill in the art would have been motivated to find and use prior art teachings to disclose the same, with one such teaching being Hesse. Pet. 20. Petitioner argues that the use of Hesse’s centralized conference management system would have been desirable to decrease cost and improve scalability. *Id.* at 21.

4. *Analysis of Patent Owner’s Contentions*

Patent Owner argues that the combination of Bulriss and Hesse fails to disclose monitoring of communications data between first and second participants, as required by independent claims 1 and 30, and additionally

teaches away from monitoring any such communications. Prelim. Resp. 9–10. Patent Owner further argues that Petitioner relies on Bulriss to satisfy the limitations of the independent claims that pertain to the capturing and monitoring of “communications data” between two participants of a video visit. *Id.* at 11–12 (citing Pet. 22–25, 31–33). Patent Owner contends that the communication in Bulriss referred to is attorney-client privileged communication, and although it may be initiated by the judge, it is not monitored and is private. *Id.* at 12–13. We agree.

With respect to the preambles of claims 1 and 30, Petitioner argues that “[i]n the courtroom, an attorney communicates with an inmate using a ‘courtroom attorney-client sidebar station 48,’” and this is equivalent to the “video visit” recited. Pet. 22. Petitioner continues that “[i]n the Bulriss system, a video visit between the attorney and inmate can be monitored by a judge (and the rest of the courtroom) using control panel 44 and display devices 96.” Pet. 23 (citing Ex. 1005, 17:4–12). The cited section of Bulriss, however, does not detail monitoring by the judge or anyone else. If the “visit” claimed is the specific communication between the attorney and the inmate only, it will not be monitored without vitiating the attorney-client privilege. In other words, if utilized in “privacy” mode, as discussed above, all other devices would be “locked out,” and the attorney-client sidebar stations would not be monitored.

In Bulriss, if the communication is used in “public mode,” then it is not clear that this would be the communication between the inmate and attorney that Petitioner relies upon. If it is general communication between the inmate and the judge or one of the attorneys, it does not include the

specific use of the attorney-client sidebar station relied upon by Petitioner. Such general communication would necessarily have more than those two participants, and although it could include exchanges between the inmate and his or her attorney, it is not the communication relied upon by Petitioner. Additionally, although it is possible that a “video visit” may encompass more than communications between the inmate and attorney (*see* Ex. 1001, 5:21–38), Petitioner has not relied upon more in its Petition.

Additionally, with respect to the monitoring step of claim 1, and the equivalent recitations of claim 30, Petitioner argues that “*Bulriss’s* system allows a judge and jury to monitor a video conference between a defense attorney and an inmate” (Pet. 32), but does not cite to any specific portion of *Bulriss* for the proposition that the specific communications between defense attorney and an inmate are monitored. Rather, Petitioner states that the Judge’s control panel “receives a copy of the audio/visual data from control interface device 42” (*id.*), but that does not equate to monitoring. Again, *Bulriss* is clear that based on the type of communications, those communications may not be monitored.

Similarly, Petitioner also alleges that *Bulriss’s* display devices 96 can also constitute a “monitoring station” or a “third terminal,” so that “the conduct of each of the parties [can] be displayed to the jury” (Pet. 32–33 (citing Ex. 1005, 17:4–12)), but Petitioner fails to explain how the communication between the attorney and the inmate using the attorney-client sidebar station, relied upon as the “video visit,” would be part of the “conduct of each of the parties.” As explained above, the specific communication between the inmate and his or her attorney would not be the

same as the simultaneous depiction of all parties on the display devices. As such, we are persuaded by Patent Owner's arguments that the combination of Bulriss and Hesse fails to disclose "monitoring of communications data between first and second participants," as recited in the challenged claims.

Patent Owner also argues that the combination of Bulriss and Hesse teaches away from establishing connections at a scheduled time because doing so would impede or delay court proceeding. Prelim. Resp. 21–25. As Patent Owner explains, the scheduling of visits to resolve issues during a court proceeding would cause unnecessary delay to those same proceedings, because at the time that the judge determines that such communications are needed, per Bulriss, they would not be scheduled as described in Hesse. *Id.* at 22–23. Patent Owner also points out that the subject communications arise *ad hoc*, they need to be addressed without delay, and are not amenable to scheduling. *Id.* at 23. Lastly, Patent Owner emphasizes that Bulriss is concerned with such delays and would teach away from the scheduling provided in Hesse. *Id.* at 24–25 (citing Ex. 1005, 2:33–67, 5:51–64, 6:4–10).

We agree with Patent Owner that one of ordinary skill in the art would not have been motivated to provide scheduling of video visits, per claims 1 and 30, in the context of Bulriss, in view of Hesse, for the reasons supplied by Petitioner. *See* Pet. 20–21 (citing Ex. 1002 ¶¶ 74, 86). Thus, for this additional reason, we are persuaded that Petitioner has not made a sufficient showing that Bulris and Hesse would have rendered claims 1 and 30 obvious.

5. Conclusion

On the present record, Petitioner has not made a sufficient showing that the combination of Bulriss and Hesse would have conveyed to one of ordinary skill in the art the limitations of the claims 1 and 30. Similarly, we determine that Petitioner does not establish a reasonable likelihood that it would prevail in showing claims 2–29 and 31–55, dependent on claims 1 and 30, are unpatentable for obviousness over combinations of Bulriss, Hesse, and Rae.

III. CONCLUSION

For the foregoing reasons, we determine based on the Petition and the Preliminary Response, that Petitioner has not demonstrated a reasonable likelihood that it will prevail on its challenges of claims 1–55 of the '816 Patent.

IV. ORDER

After due consideration of the record before us, and for the foregoing reasons, it is:

ORDERED that the Petition is *denied* as to all challenged claims and no trial is instituted.

IPR2016-00267
Patent 7,256,816 B2

PETITIONER:

Erika H. Arner
Jason E. Stach
Andrew G. Strickland
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP
erika.arner@finnegan.com
jason.stach@finnegan.com
Andrew.Strickland@finnegan.com

PATENT OWNER:

Michael D. Specht
Michael B. Ray
Lauren C. Schleh
Brian Lee
STERNE, KESSLER, GOLDSTEIN & FOX PLLC
mspecht-PTAB@skgf.com
mray-PTAB@skgf.com
lschleh-PTAB@skgf.com
blee-PTAB@skgf.com