

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 IPR2016-00996
Patent 9,143,609 B2

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

TURNER, *Administrative Patent Judge*.

DECISION
Final Written Decision
35 U.S.C. § 318(a) and 37 C.F.R. §§ 42.73

I. INTRODUCTION

This *inter partes* review, instituted pursuant to 35 U.S.C. § 314, challenges the patentability of certain claims of U.S. Patent No. 9,143,609 B2 (Ex. 1001, “the ’609 Patent”), owned by Global Tel*Link Corporation (“Patent Owner”). We have jurisdiction under 35 U.S.C. § 6(b). This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

For the reasons discussed below, Petitioner has not shown by a preponderance of the evidence that claims 1–20 of the ’609 Patent are unpatentable.

A. Procedural History

Securus Technologies, Inc. (“Petitioner”) filed a Petition for *inter partes* review of claims 1–20 of the ’609 Patent. Paper 2 (“Pet.”). Patent Owner did not file a Preliminary Response.

We instituted an *inter partes* review of claims 1–20 (“the instituted claims”) of the challenged patent as unpatentable under 35 U.S.C. § 103(a)¹ over the following references. Paper 6 (“Institution Decision” or “Inst. Dec.”).

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), revised 35 U.S.C. §§ 102, 103, effective March 16, 2013. Because the challenged patent has an effective filing date before March 16, 2013, we refer to the pre-AIA version of §§ 102, 103 in this Decision.

References	Claims Challenged
Hodge ² , Spadaro ³ , and Rae ⁴	1–10
Rae	11–20

Inst. Dec. 17.

Subsequent to institution, Patent Owner filed a Patent Owner Response to the Petition (Paper 12, “PO Resp.”), to which Petitioner filed a Reply (Paper 16, “Reply”). Patent Owner also filed a Motion to Strike (Paper 22, “Mot. to Strike”) the Reply, alleging that the arguments in Petitioner’s Reply are not responsive to the Patent Owner Response, and raise new theories of unpatentability. Thereafter, Petitioner filed an Opposition (Paper 23) thereto.

An oral hearing was held on June 1, 2017. A transcript of the hearing has been entered into the record. Paper 31 (“Tr.”).

B. Related Matters

Petitioner identified U.S. Application No. 14/831,533, a continuation of the patent application from which the ’609 Patent issued, as well as U.S. Patent No. 7,783,021 (“the ’021 Patent”), of which the ’609 Patent is a continuation therefrom. Pet. 68. The ’021 Patent is indicated as being the subject of a patent infringement lawsuit, brought by Patent Owner, captioned *Global Tel*Link Corp. v. Securus Techs., Inc.*, No. 3:14-cv-00829-K (N.D.

² US 2004/0029564 A1, published February 12, 2004 (Ex. 1006, “Hodge”).

³ U.S. Patent No. 7,505,406 B1, filed July 13, 2001, issued March 17, 2009 (Ex. 1007, “Spadaro”).

⁴U.S. Patent No. 7,899,167 B1, filed August 15, 2003, issued March 1, 2011 (Ex. 1005, “Rae”).

Tex.). *Inter partes* review of the '021 Patent was previously sought and denied in *Securus Techs., Inc. v. Global Tel*Link Corp.*, IPR2015-00153, Decision Denying Institution of Inter Partes Review, Paper 12 (PTAB May 1, 2015).

C. The '609 Patent

The '609 Patent relates to telephone communication systems in penal institutions or similar facilities. Ex. 1001, 1:16–18. Figure 1 of the '609 Patent is reproduced below.

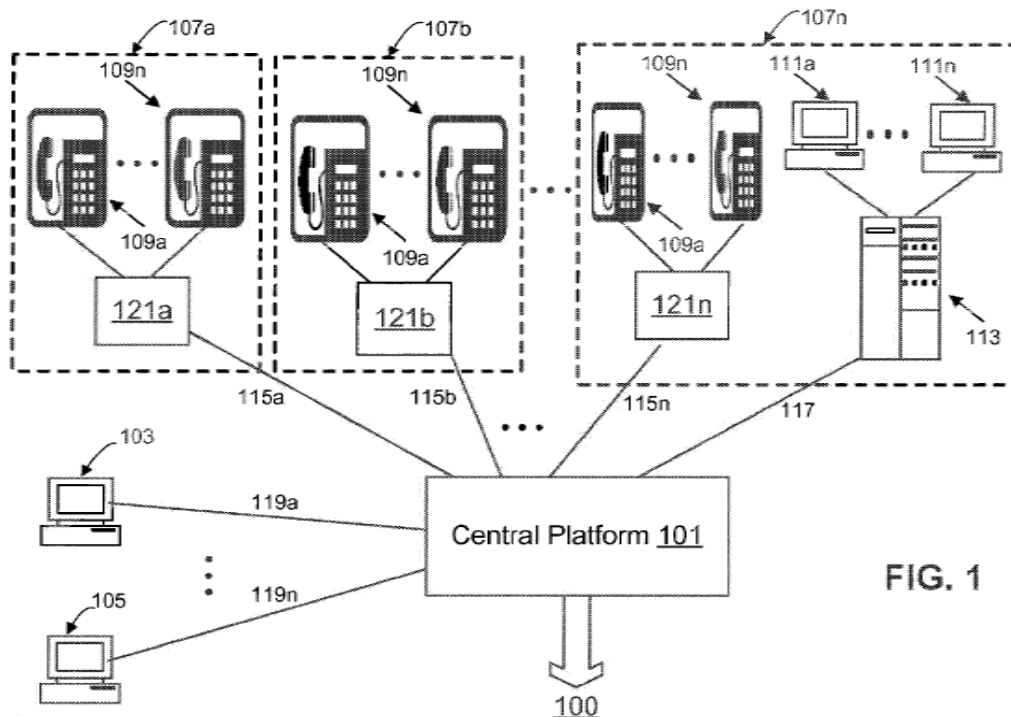


Figure 1 is a block diagram illustrating a centralized setup of a call-management system over a public switched telephone network (“PSTN”). *Id.* at 16:1–4. Central call platform 101 connects to routers 121a–n at sites 107a–n via connections 115a–n. *Id.* at 16:4–6. Sites 107a–n contain

telephonic instruments 109a–n and may contain workstations 111a–n connected to server 113 as illustrated for site 107n. *Id.* at 16:1–11. In addition to other functions, administrative workstation 105 can use a live operator or software to monitor calls without detection. *Id.* at 17:24–27. Investigative workstation 103 controls monitoring and security features. *Id.* at 17:42–49.

D. Illustrative Claim

Claims 1 and 11 of the '609 Patent are independent. Claim 1 is illustrative of the claimed subject matter:

1. An inmate telecommunication call processing system, comprising:
 - at least one telephone terminal at an institution for making a telephone call;
 - a central platform located in the institution for connecting the telephone call to an external party remotely located;
 - a server configured to receive the telephone call and telephone call data of the telephone data from the central platform, the server configured to log and record the telephone call data of the telephone call for a predetermined period of time;
 - an administrative workstation connected to the central platform via the server; and
 - a router configured to receive telephone signals generated by the telephone terminal and to transmit the telephone signals to a network using an internet protocol,wherein the administrative workstation monitors a conversation in the telephone call without detection by the user.

Ex. 1001, 18:57–19:7.

II. DISCUSSION

A. Claim Construction

In an *inter partes* review, the Board interprets claims in an unexpired patent using the “broadest reasonable construction in light of the specification of the patent in which [they] appear[.]” 37 C.F.R. § 42.100(b); see *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) (upholding the use of broadest reasonable construction standard). Consistent with the broadest reasonable construction standard, claim terms are presumed to have their ordinary and customary meaning as understood by one of ordinary skill in the art in the context of the entire patent disclosure at the time of the invention. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). An inventor may provide a meaning for a term that is different from its ordinary meaning by defining the term in the specification with “reasonable clarity, deliberateness, and precision.” *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). Moreover, limitations are not to be read from the specification into the claims. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993). In addition, the Board may not “construe claims during [an *inter partes* review] so broadly that its constructions are unreasonable under general claim construction principles.” *Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1298 (Fed. Cir. 2015). We construe the challenged claims according to these principles.

Although Petitioner asserted that one particular claim term does require some specific construction (Pet. 9 (citing Ex. 1009, 5–6)), we were not persuaded that any claim term requires express construction. In both

Patent Owner's Response and in Petitioner's Reply, no claim terms were proffered for explicit construction. *See generally* PO Resp.; Reply. As such, we interpret the claims in the instant decision according to the broadest reasonable construction in light of the specification without explicit claim constructions of any terms.

B. Principles of Law

To prevail in challenging Patent Owner's claims, Petitioner must demonstrate by a preponderance of the evidence that the claims are unpatentable. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). "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"))). The burden of persuasion never shifts to Patent Owner. *See Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)) (discussing the burden of proof in *inter partes* review). Furthermore, Petitioner cannot satisfy its burden of proving obviousness by employing "mere conclusory statements." *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

Petitioner has asserted each of the claims in the '609 Patent is unpatentable under 35 U.S.C. § 103(a) over various references. A claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the

claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time of the invention to a person having ordinary skill in the art. *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). “A determination of whether a patent claim is invalid as obvious under § 103 requires consideration of all four *Graham* factors, and it is error to reach a conclusion of obviousness until all those factors are considered.” *Apple v. Samsung Elecs. Co.*, 839 F.3d 1034, 1048 (Fed. Cir. 2016), *petition for cert. filed*, 85 U.S.L.W. 3460 (U.S. Mar. 10, 2017) (No.16-1102) (citations omitted). “This requirement is in recognition of the fact that each of the *Graham* factors helps inform the ultimate obviousness determination.” *Id.*

C. Level of Ordinary Skill

In determining whether an invention would have been obvious at the time it was made, 35 U.S.C. § 103 requires us to resolve the level of ordinary skill in the pertinent art at the time of the invention. *Graham*, 383 U.S. at 17. “The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991). The person of ordinary skill in the art is a hypothetical person who is presumed to have known the relevant art at the time of the invention. *In re GPAC*,

Inc., 57 F.3d 1573, 1579 (Fed. Cir. 1995). In some cases, the level of ordinary skill in the art is reflected by the prior art of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001). Factors that may be considered in determining the level of ordinary skill in the art include, but are not limited to, the types of problems encountered in the art, the sophistication of the technology, and educational level of active workers in the field. *Id.* In a given case, one or more factors may predominate. *Id.* Generally, it is easier to establish obviousness under a higher level of ordinary skill in the art. *Innovation Toys, LLC v. MGA Entm't, Inc.*, 637 F.3d 1314, 1323 (Fed. Cir. 2011) (“A less sophisticated level of skill generally favors a determination of nonobviousness . . . while a higher level of skill favors the reverse.”).

Petitioner’s declarant, Stuart J. Lipoff, testifies that one of ordinary skill in the art “would have held at least a Bachelor’ Degree in Electrical Engineering, Computer Engineering, or an equivalent and two or more years of industry experience in a relevant field, or the academic equivalent thereof.” Ex. 1002 ¶ 36; *see* Pet. 8 (citing Ex. 1002 ¶ 36) (asserting level of ordinary skill in the art). Mr. Lipoff also testifies that “[a]s of the priority date of the application for the ’609 patent, I was at least a person of ordinary skill in the art,” without providing an actual date of that priority date. *Id.* at ¶ 37. Patent Owner adopts that the definition of the level of skill in the art for purposes of this proceeding. PO Resp. 4.

We have considered the level of ordinary skill in the art as reflected by the prior art of record. We conclude that one of ordinary skill in the art

would have a bachelors-level degree in electrical engineering, computer engineering, or an equivalent or related field, with at least two years of industry experience, or experience comparable thereto.

*D. Asserted Ground of Obviousness of Claims 1–10
over Hodge, Spadaro, and Rae*

Petitioner asserts that challenged claims 1–10 are unpatentable under 35 U.S.C. § 103 as obvious over Hodge, Spadaro, and Rae. To support its contentions and relying on the declaration testimony of Mr. Stuart J. Lipoff, Petitioner provides analysis explaining how the cited references would have conveyed to one of ordinary skill in the art the claim limitations and provides reasons why one of ordinary skill in the art would have combined and/or modified the teachings of the references, where applicable. Pet. 9–38 (citing Ex. 1002).

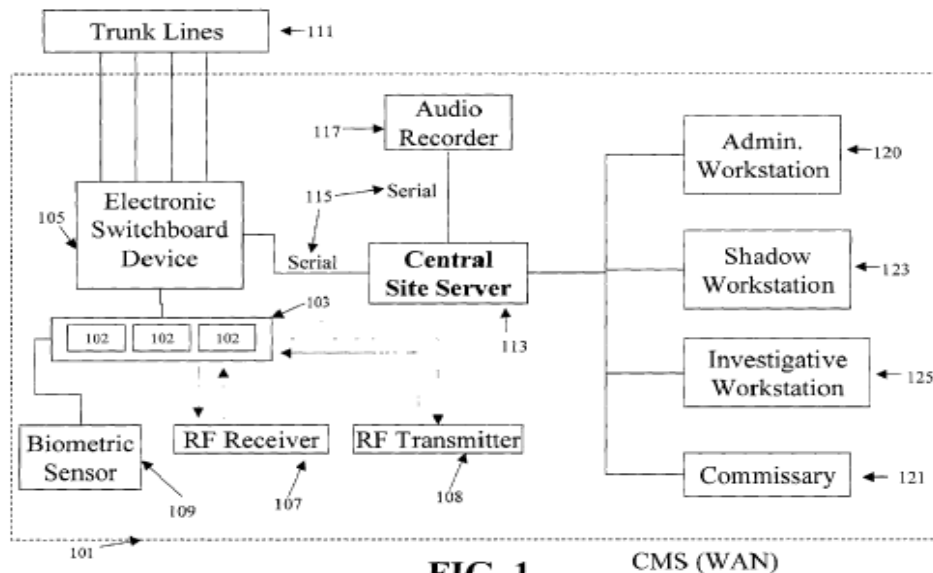
With support of the declarations of Dr. Leonard J. Forys (Ex. 2002) and Mr. Stephen Lee Hodge⁵ (Ex. 2003), Patent Owner challenges Petitioner’s contentions with respect to claims 1–10, arguing that Petitioner has failed to demonstrate that Hodge is prior art with respect to those claims. PO Resp. 4–28. In reply, Petitioner maintains its position that Hodge is prior art with respect to claims 1–10. Reply 3–19. We begin with a discussion of the references, then next we discuss the proffered rationale to combine, and finally we discuss Patent Owner’s arguments against this ground of unpatentability, along with Petitioner’s reply.

⁵ As discussed below, Mr. Hodge is listed as the inventor of the ’609 patent, as well the Hodge reference discussed herein.

1. Summaries of Asserted Prior Art

a. Summary of Hodge

Hodge discloses a computer-based telecommunications system “with the capacity to allow an institution to control, record, monitor, and report usage and access to a telephone network.” Ex. 1006 ¶ 1. Figure 1 of Hodge, reproduced below, illustrates a call management system for use in a penal institution.



Hodge discloses a “site server” that has the ability to “log and record details of all telephone calls placed through the system and store them for a period of time defined by the institution.” *Id.* ¶ 45. Hodge also discloses an administrative workstation that can “modify call restrictions for individual users in addition to all telecommunication activity of the institution.” *Id.* ¶ 133. Hodge’s “electronic switchboard device” performs a number of functions central to the operation of call management system 101, such as “regulat[ing] calls and connect[ing] them to the proper outgoing trunk line

111,” “perform[ing] the voice prompts heard by the inmate and the recipient of the call allowing the parties to respond to the menu selections,” “test[ing] outgoing trunk lines as calls are placed” and “digitiz[ing] telephone audio for recording and/or biometric voice identification purposes.” *Id.* ¶¶ 128, 130.

Hodge also discloses serial port connection 115 between electronic switchboard 105 and central site server 113 that “is designed to allow firmware driven systems, such as electronic switchboard device 105, to interface with software-based systems, such as a PC designed system operating as a site server.” *Id.* ¶ 131. Hodges further discloses that user call information may be digitized for efficient data transfer and efficient record keeping, and that calls may processed over either analog or digital trunks as required by call management system 101. *Id.* ¶¶ 128, 130. Hodges explains that “trunk lines 111 may be analog, digital, or any other type of trunk lines not yet contemplated,” and that “[t]runk lines 111 may interface the network on direct digital T1 circuits, analog circuits, or other like network interfaces.” *Id.* ¶¶ 128, 143.

Petitioner acknowledges that Hodge does not disclose expressly transmitting calls using an Internet protocol, such as VoIP, but argues that implementing a VoIP packet switched network for carrying voice calls in place of a circuit switched network was well-known, and is demonstrated by Spadaro, discussed below. Pet. 12.

b. Summary of Spadaro

Spadaro describes monitoring and controlling public telephone usage by inmates at a prison, where lower cost and efficiency can be obtained by operating the system over Ethernet and VoIP networks. Ex. 1007, 2:38–42, 3:58–62. Spadaro discloses that control computer 12, as illustrated in Figure 1, selectively connects inmate telephones 10 with voice over IP gateway 26, which connects the telephones “to the off-site switch telephone network 16 over an Internet Protocol (IP) network 18.” *Id.* at 3:1–8. The programmable control computer performs several functions for a prison environment that are similar to electronic switchboard 105 of Hodge. For example, Spadaro discloses that “programmable computer 12 at the site is provided for switching, accessing, routing, timing, billing, and the control of the telephones 10 at the site.” *Id.* at 2:45–48. Control computer 12, also stores restrictions on telephone usage associated with a PIN that is associated with a user, indicated at item 28 in Figure 1. *See id.* at 3:32–37.

c. Summary of Rae

Rae is directed to telecommunications systems that allows for communication with external parties using a centralized call processing system. Ex. 1005, Abs., 5:53–56. Figure 1 of Rae is reproduced below illustrating an exemplary embodiment of its centralized call processing system.

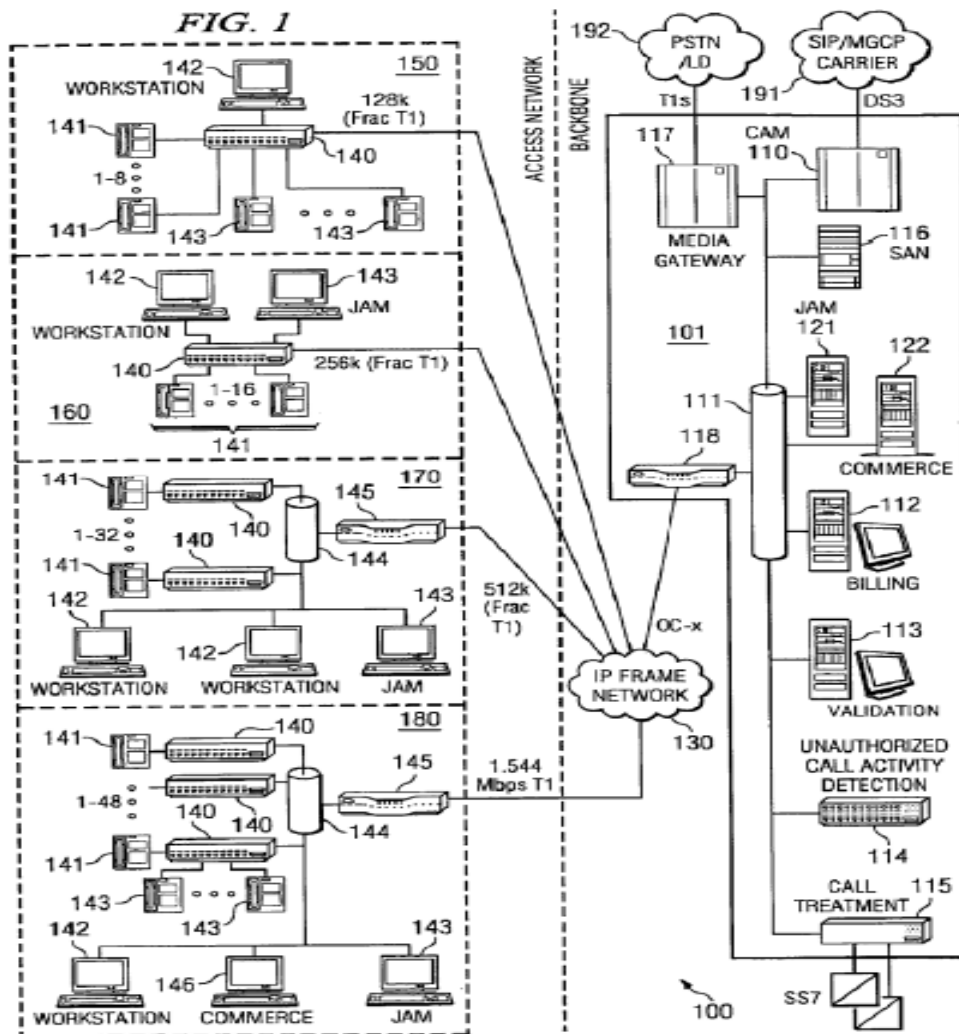


Figure 1 shows call processing system 100 implementing centralized call processing platform 101 in communication with facilities 150–180, which may be jails or prison facilities, via network 130. *Id.* at 5:41–44, 54–56. Calls may originate from each of the illustrated facilities through telephone terminals 141, visitation telephones 143, or other devices. The call signaling is routed through call processing gateways 140, which may “provide conversion of analog signals associated with telephone terminals

141 and visitation telephones 143 and digital data packets of the switched network to provide a VoIP gateway.” *Id.* at 6:10–14. Network router 145 can also be used to send signals through network 130, with that router transmitting telephone signals received from processing gateway 140 to an IP network using an internet protocol, such as Voice over Internet Protocol (“VoIP”). *Id.* at 6:44–47.

The signals are routed to central call processing platform 101 through router/switch 118. *Id.* at 7:40–44. Via network 111, call application management system 110, billing system 112, validation system 113, unauthorized call activity detection system 114, call treatment system 115, call recording system 116, and media gateway 117 are then used in various combinations to provide primary calling services. *Id.* at 7:53–58. Call application management system 110 of the call processing platform 101 can control completing a call between a party using any one of telephone terminals 141 or visitation telephones 143 and another party, such as an external telephone user via PSTN 192. *Id.* at 8:9–19.

2. The Parties’ Contentions

a. Petitioner’s Contentions

Petitioner asserts that a person of ordinary skill in the art would have been motivated to modify Hodge in view of Spadaro and Rae to incorporate IP telephony technologies in an inmate call processing system. Pet. 16. Petitioner alleges that Hodge discloses every element of claim 1 pertaining to conventional inmate telecommunications systems, but does not disclose transmitting inmate telephone signals to a network using an internet

protocol. *Id.* Petitioner alleges that Spadaro and Rae fill this void by expressly disclosing conversion of inmate calls for transmission on an IP network using VoIP and a router network element in an inmate VoIP communication system. *Id.* Petitioner contends that the references are in the same field, each address similar problems, and offer similar technical solutions. *Id.* (citing Ex. 1002 ¶¶ 59–61). Petitioner also argues that, as Spadaro discloses, implementing VoIP capabilities would achieve lower cost, better efficiency, and the ability to integrate the facility into a data network easily. *Id.* at 17. Petitioner further asserts that because of the similarity of the systems in Spadaro and Rae, one of ordinary skill in the art would have looked to Rae’s disclosure of VoIP networking elements to supplement Spadaro’s system. *Id.* at 18.

Specifically, with respect to claim 1, Petitioner contends that Hodge teaches most of the elements of claim 1. *Id.* at 19–30. With respect to the limitation of “the server configured to log and record the telephone call data of the telephone call for a predetermined period of time,” Petitioner asserts that Hodge’s central site server is “configured to receive the telephone call and the telephone call data of the telephone data from the central platform,” and is “configured to log and record the telephone call data of the telephone call for a predetermined period of time.” *Id.* at 23–24 (citing Ex. 1002 ¶¶ 83–84).

Petitioner also explains that the “server” recited in claim 1 is not limited so as to be located inside or outside of the institution, and that Hodge teaches embodiments with the server co-located at the same institution, and

outside of the institution. *Id.* at 24–25. Petitioner acknowledges that Hodge does not disclose “transmit[ing] the telephone signals to a network using an internet protocol,” per claim 1, but argues that Spadaro discloses routing telephone signals generated by inmate telephones to a network using an internet protocol, as discussed above. *Id.* at 27. Similarly, Petitioner argues that it would have been obvious to supplement the system of Hodge and Spadaro with the router disclosed in Rae, to meet the “router” limitation of claim 1. *Id.* at 28–29.

b. Prior Art Status of Hodge

Patent Owner argues that Hodge is not prior art to the ’609 Patent under 35 U.S.C. § 102(b) because the claims of the ’609 Patent are entitled to a priority date of January 28, 2005, and Hodge was published on February 12, 2004, which is less than one year before the Patent Owner’s asserted priority date of the claims. PO Resp. 4. As well, Patent Owner argues that Hodge cannot be prior art to the instant claims under 35 U.S.C. §§ 102(a) or (e) because they have the same inventive entity, namely Hodge. *Id.* Patent Owner asserts that the claims are entitled to the January 28, 2005 priority date under 35 U.S.C. § 120, providing support under 35 U.S.C. § 112(a) for each element of claims 1–10. *Id.* at 5–26.

In response, Petitioner argues that claims 1–10 are not entitled to the priority date of January 28, 2005, because one of ordinary skill in the art would not have understood the inventor of the ’609 Patent to have been in possession of “at least the ‘router’ features of claims 1–10.” Reply 4–5. Based on the content of the Petition, however, we are not persuaded that

Petitioner has asserted such a ground relying on Hodge being prior art under 35 U.S.C. § 102(b).

The second page of the Petition makes clear that Petitioner asserts that Hodge is “prior art under at least pre-AIA 35 U.S.C. § 102(a) and (e).”

Pet. 2. At no point does Petitioner contest the priority date of the ’609 Patent, nor suggest that the patent’s claimed priority date was not clear or was uncertain. *See id.* at 3–8. We are persuaded that the Petition does not demonstrate an intent to apply Hodge under 35 U.S.C. § 102(b), nor does it otherwise suggest any dispute regarding the priority claim of the ’609 Patent.

An *inter partes* review trial before the Board is a formal adjudication under the Administrative Procedure Act; as such, the parties to the trial are guaranteed certain procedural protections. *See Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1080 (Fed. Cir. 2015) (“A patent owner . . . is undoubtedly entitled to notice of and a fair opportunity to meet the grounds of rejection.”). Significant among these protections is that parties must be given notice of the “matters of fact and law asserted,” and the opportunity to meaningfully respond. *Id.* For this reason, the United States Court of Appeals for the Federal Circuit has held that we may not base our patentability decision on late-arising factual assertions or theories. *See Dell Inc. v. Acceleron, LLC*, 818 F.3d 1293, 1301 (Fed. Cir. 2016). In *Dell*, “an opportunity to respond was needed when the petitioner, to make its anticipation showing, newly pointed to a previously unmentioned portion of the allegedly anticipatory prior-art patent, even though it had earlier focused

extensively on other portions of that prior-art patent.” *In re Nuvasive Inc.*, 841 F.3d 966, 972 (Fed. Cir. 2016) (discussing *Dell*, 818 F.3d at 1301).

Petitioner, at oral hearing, referenced a Board decision, wherein “in the Petition the Petitioner alleged that a reference was prior art under 102(b) and then in the Reply they switch it to 102(a), and the Board found that this is no new theory of unpatentability.” Tr. 9 (discussing *Hughes Network Sys., LLC v. Cal. Inst. of Tech.*, Case IPR2015-00059, slip op. at 33–36 (PTAB Apr. 21, 2016) (Paper 42)). *See also* Paper 23, 4 (same argument). That decision, however, explicitly states that “Petitioner correctly notes that the Decision to Institute did not limit Petitioner to arguing any particular portion of § 102,” and that the patent owner in that proceeding “had clear notice as to the basis for [the] challenge.” *Hughes* at 36. In the instant case, Petitioner explicitly provided that Hodge was prior art under specific subsections of § 102, and provided no notice that Petitioner intended to question the priority claim of the ’609 Patent.

Petitioner also provides that “[n]othing in the prosecution history of the ’609 patent suggests that the Patent Office has fully considered Patent Owner’s entitlement to an earlier priority.” Reply 17. We do not find that persuasive in light of the explicit priority claim found in the ’609 Patent. *See* Ex. 1001, [63], 1:7–11. Petitioner also cites to the Information Disclosure Statement (“IDS”) submitted during the prosecution of the ’609 Patent, alleging that it provided an indication that Patent Owner was treating Hodge as prior art. Reply 18 (citing Ex. 1004, 222). At oral hearing, however, Petitioner was unable to provide any relevant legal authority that

supported the IDS as an admission of prior art status. *See* Tr. 11–12.

Therefore, contrary to Petitioner’s arguments, we find that Petitioner seeks to raise this ground over Hodge, Spadaro, and Rae in a new manner and as a new theory of unpatentability. Thus, we decline to consider this new theory not presented in the Petition.

Furthermore, even if we were persuaded that the prior art status of Hodge should be considered under 35 U.S.C. § 102(b), we are not persuaded that Petitioner has demonstrated that the ’609 Patent is not entitled to the priority claimed by the patent. Petitioner argues that the “router” of claim 1 is “configured to receive telephone signals generated by the telephone terminal and to transmit the telephone signals to a network using an internet protocol,” where the “telephone signals” must be analog signals and that any router would be required to convert those analog signals into digital signals that can be transmitted over a network using an internet protocol. Reply 5 (citing Ex. 1015 ¶¶ 13–14). Petitioner continues that the priority documents only disclose a system whereby telephone signals are first converted into a digital data stream, which is sent to the a router, so that the router disclosed in the priority documents never receives “telephone signals generated by the telephone terminal.” *Id.* at 5–6 (citing Ex. 1015 ¶ 15). We do not agree.

“It is highly disfavored to construe terms in a way that renders them void, meaningless, or superfluous.” *Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.*, 853 F.3d 1272, 1288 n.10 (Fed. Cir. 2017). If the limitation is construed in the manner proposed by Petitioner, then it is meaningless because Petitioner has not demonstrated any router that would receive

analog signals from a telephone terminal. Petitioner has pointed us to no definition of “router” that would act to route signals based on analog signals inputted thereto. Petitioner’s stance, that the signals must be transferred, unaltered, to the router, does not appear to be supported by the disclosure of ’609 Patent. Even assuming that telephone terminal only produces analog telephone signals, Petitioner’s implicit claim construction does not comport with the specification of the ’609 Patent that provides no support for the router receiving analog signals. As such, demonstrating that an improper construction of a claim is not supported by the priority documents provides insufficient persuasive evidence.

Based on the analysis provided in the Petition, Petitioner has not shown by preponderance of the evidence that the combination of Hodge, Spadaro, and Rae would have taught or suggested to one of ordinary skill in the art each limitation recited in claim 1, because Hodge is not applicable against that claim as prior art. The prior art status of Hodge remains the determining factor as to whether claim 1 is determined to be obvious, with dependent claims 2–10 standing with claim 1 is not being demonstrated as being unpatentable.

*E. Asserted Ground of Obviousness of Claims 11–20
over Rae*

Petitioner asserts that challenged claims 11–20 are unpatentable under 35 U.S.C. § 103 as obvious over Rae. To support its contentions and relying on the declaration testimony of Mr. Lipoff, Petitioner provides analysis explaining how the cited reference would have conveyed to one of ordinary

skill in the art the claim limitations and provides reasons why one of ordinary skill in the art would have combined and/or modified the teachings of the references, where applicable. Pet. 38–65 (citing Ex. 1002).

With the support of the declaration of Dr. Forsys (Ex. 2002), Patent Owner challenges Petitioner’s contentions with respect to claims 11–20, arguing that Petitioner has failed to demonstrate that Rae teaches or suggests the claimed “server,” recited in independent claim 11. PO Resp. 28–42. In reply, Petitioner maintains its mapping of claim 11 onto the disclosure of Rae demonstrates the obviousness of that claim. Reply 19–25. With reference to the discussion of Rae above, *see* Section II.D.c, we discuss the proffered rationale to modify Rae, and then discuss Patent Owner’s arguments against this ground of unpatentability, along with Petitioner’s reply.

1. Independent Claim 11

With respect to claim 11, Petitioner contends that Rae teaches or suggests every element of independent claim 11. Pet. 38. Petitioner finds support for the “inmate telecommunication call processing system,” and the “plurality of institution sites,” based on the above-discussed disclosure of Rae. *Id.* at 38–40. Petitioner also finds support in Rae for “a telephone terminal configured to place a telephone call to an external party based on user input,” and “a gateway connected to the telephone terminal,” through Rae’s telephone terminal 141 or visitation terminal 143 (Ex. 1005, Fig. 1), and Rae’s call processing gateway 140. *Id.* at 40–42. With respect to claim 11’s recitation of “a central site remotely located from the plurality of

institution sites,” Petitioner asserts that this aspect is taught by Rae’s “call processing platform 101 [being] in communication with facilities 150–180 via network 130.” *Id.* at 42–44 (citing Ex. 1005, 20:24–30; Fig. 1).

Petitioner continues that based on the connection utilizing VoIP to carry calls from a location to a centralized platform, one of ordinary skill in the art would have understood that centralized platform 101 may be remotely located from the plurality of institution sites. *Id.* at 43–44. With respect to claim 11’s “server” and its being configured to “log and record the telephone call data of the telephone call for a predetermined time,” Petitioner relies on Rae’s call recording system 116 that may store the content of the call or ancillary call information, including calling or called party, calling and called number, dialed number information service, time of the call, duration of the call, account information, and entity responsible for billing the call. *Id.* at 44 (citing Ex. 1005, 9:53–62).

Petitioner also asserts that “[n]othing in *Rae* precludes one of ordinary skill in the art from implementing its centralized system while also limiting call recording to a predetermined period of time that is less than the full call length.” *Id.* at 49 (citing Ex. 1002 ¶ 162). Petitioner further asserts that one of ordinary skill in the art would have understood that Rae’s call recording system 116 may be implemented using a server. *Id.* at 50 (citing Ex. 1002 ¶ 163). Lastly, Petitioner asserts that one of ordinary skill in the art would understand that call processing gateway 140 of Rae transmits the telephone call to call processing platform 101 using an internet protocol, such as VoIP. *Id.* at 52 (Ex. 1002 ¶ 168).

2. The Parties' Contentions

Patent Owner argues that claims 11–20 are not obvious over Rae because Rae fails to teach or suggest a “server configured to log and record the telephone call data of the telephone call for a predetermined period of time,” per claim 11. PO Resp. 28. Patent Owner continues that Petitioner’s analysis of Rae focuses on the duration of a telephone call that Rae’s system records, and does not address retaining telephone call data for a predetermined time. *Id.* at 28–30.

Petitioner responds that Patent Owner’s reading of claim 11 demonstrates the breadth of the claims, and show that the claims “could reasonably be read to encompass both Petitioner’s interpretation and Patent Owner’s.” Reply 19–20. Petitioner asserts that Rae discloses that its “call recording system 116” not only stores the audio portion of a call, but also stores information that may include at least “ancillary call information, such as identification of the calling and/or called party, calling number (e.g., automatic number information (ANI)), called number (e.g., dialed number information service (DNIS)).” *Id.* at 21 (citing Pet. 46, quoting Ex. 1005, 9:49–62). We agree with Petitioner that Rae teaches or suggests recording telephone call data.

With respect to logging and recording for a “predetermined period of time,” Petitioner acknowledges that the ’609 Patent discloses that the site server “has the ability to log and record details of all telephone calls placed through the system and store them for a period of time defined by the institution.” *Id.* at 21–22 (quoting Ex. 1001, 10:3–6). Petitioner asserts that

storing such information according to a policy defined by an institution was a common practice known to those skilled in the art. *Id.* at 21 (citing Ex. 1015 ¶¶ 48–49). Petitioner acknowledges that the Petition only discusses this in the context of one of skill in the art would have limited the time period for recordings based on limited storage space, but argues that limiting the duration of call data would have been “consistent.” *Id.* at 22–23 (citing Pet. 47–49; Ex. 102 ¶¶ 159–161). We do not agree with Petitioner.

Similar to the discussion above, we are persuaded that Petitioner seeks to alter the ground of unpatentability. The cited language of claim 11, namely, a “server configured to log and record the telephone call data of the telephone call for a predetermined period of time,” is clear. Petitioner’s assertions that the language could encompass multiple interpretations is not persuasive. The Petition primarily relied on identifying that one could record a telephone call, the audio portion of it, for a predetermined period of time which could be less than the full length of the call. *See* Pet. 47–49; Reply 22. This is not what is recited in the claim limitation. The Petition is devoid of any specific claim interpretation of the claim terms in claim 11, to support that a different interpretation was contemplated.

The fact Petitioner now asserts that the claim limitation is obvious, with the support of new declarations, is not dispositive. The Petition’s analysis focuses on whether “predetermined period of time” requires logging and recording for some period of time less than the full call length, which is different than the clear language of claim 11. Additionally, claim 11 makes clear that the telephone call and the telephone call data are different

elements of the claim, such that finding a partial or limited recording of one does not necessarily teach such recording of the other.

Accordingly, we determine that Petitioner has not demonstrated by a preponderance of the evidence that the subject matter of claim 11 would have been obvious over Rae.

3. Dependent Claims 12–20

We determine that Petitioner has not demonstrated by a preponderance of the evidence that Rae teaches or suggests the elements of claims 12–20, based at least on the dependence of those claims on claim 11. Accordingly, we determine that Petitioner has not demonstrated that the subject matter of claims 12–20 would have been obvious over Rae.

III. MOTION TO STRIKE

As discussed above, Patent Owner filed a Motion to Strike (Paper 22) the Reply, to which Petitioner filed an Opposition (Paper 23). At oral hearing, Patent Owner acknowledged that should all of the claims be found to be patentable over the proffered grounds of the Petition, “[t]his would render the Motion to Strike moot.” We agree, and deny Patent Owner’s Motion to Strike as moot.

IV. CONCLUSION

Petitioner has not demonstrated by a preponderance of the evidence that (i) the subject matter of claims 1–10 of the ’609 Patent would have been

obvious over Hodge, Spadaro, and Rae; and (ii) the subject matter of claims 11–20 of the '609 patent would have been obvious over Rae.

V. ORDER

Accordingly, it is:

ORDERED that claims 1–20 of U.S. Patent No. 9,143,609 B2 have *not* been shown to be unpatentable;

FURTHER ORDERED that Patent Owner's Motion to Strike is *denied* as moot; and

FURTHER ORDERED that, because this is a final written decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2016-00996
Patent 9,143,609 B2

PETITIONER:

Erika H. Arner
Jason Stach
Brandon S. Bludau
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP
erika.arner@finnegan.com
jason.stach@finnegan.com
brandon.bludau@finnegan.com

PATENT OWNER:

Michael Specht
Michael B. Ray
Lauren Schleh
Richard Bemben
Ross Hicks
STERNE, KESSLER, GOLDSTEIN & FOX PLLC
mspecht-PTAB@skgf.com
mray-PTAB@skgf.com
lschleh-PTAB@skgf.com
rbemben-PTAB@skgf.com
rhicks-PTAB@skgf.com