

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 IPR2017-01177
Patent 9,521,250 B2

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

TURNER, *Administrative Patent Judge*.

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

I. INTRODUCTION

Securus Technologies, Inc. (“Petitioner”) filed a Petition for *inter partes* review of claims 1–20 of U.S. Patent No. 9,521,250 B2 (Ex. 1001, “the ’250 Patent”). Paper 2 (“Pet.”). Global Tel*Link Corporation (“Patent Owner”) filed a Preliminary Response (Paper 6). 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 shows there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of claims 1–20.

A. *Related Matters*

The ’250 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. 3:16-cv-01338-K (N.D. Tex.). Pet. 67. Petitioner also lists currently-pending U.S. patent applications and issued U.S. patents that claim priority to one or more of the applications in the priority chain of the ’250 Patent. *Id.*; accord Paper 4, 1–2; Paper 5, 1.

B. The '250 Patent

The '250 Patent relates to implementation of a speaker verification system to control access to a secure telephone call management system. Ex. 1001, Abstract. Figure 1 of the '250 Patent is reproduced below.

FIG. 1

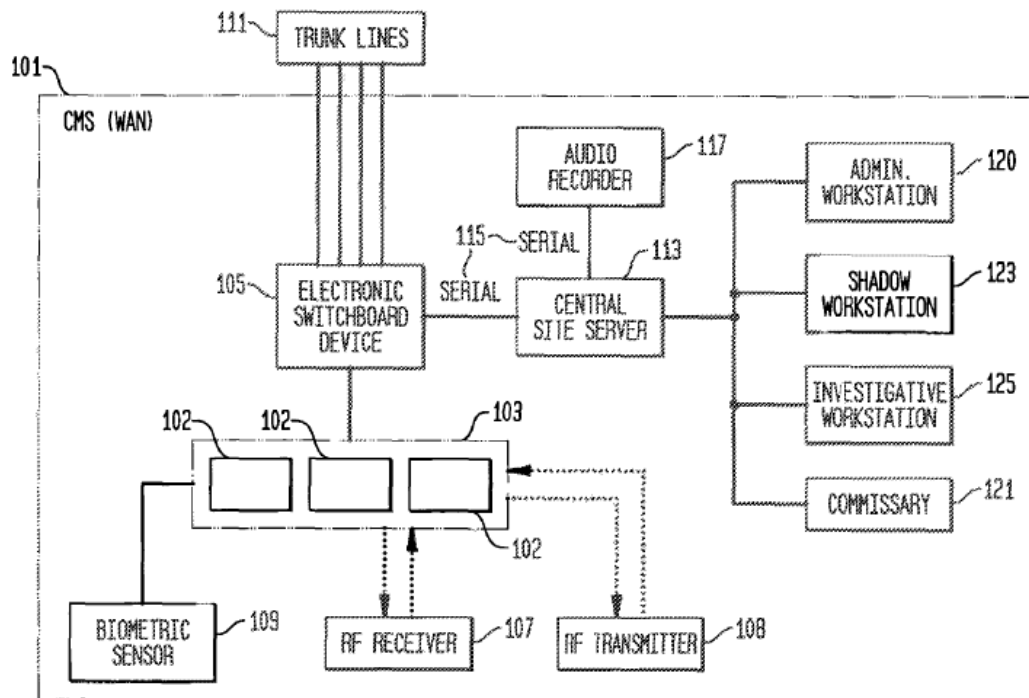


Figure 1 is a schematic view of the call management system configured to operate on a wide area network. *Id.* at 16:42–44. The '250 Patent describes a “telephone call management system using improved identification means including biometric identification,” such as through biometric sensor 109. *Id.* at 9:55–57, 18:65–19:4. The system includes means for identifying and authenticating the calling party, as well as the called party. *Id.* at 10:1–3, 12:56–57. This authentication may be accomplished by using a combination

of biometric data and personal information to determine whether an unknown user attempting to access a telephone system is actually the same person as a known user who previously registered with the system. *Id.* at 48:46–64.

C. Illustrative Claim

Claims 1, 10, and 16 of the '250 Patent are independent. Claim 1 is illustrative of the claimed subject matter:

1. A system, comprising:
 - a database;
 - a control platform configured to:
 - receive biometric data related to a user;
 - store the biometric data in the database;
 - receive identifying information related to the user; and
 - store the identifying information in the database in correspondence with the biometric data of the user; and
 - an authentication module configured to:
 - receive second biometric data related to a second user;
 - receive second identifying information related to the second user;
 - find in the database third identifying information that substantially matches the second identifying information received from the second user;
 - retrieve from the database third biometric data associated with the third identifying information;
 - compare the second biometric data received from the user with the third biometric data retrieved from the database; and
 - authenticate the second user based on the comparison.

Ex. 1001, 54:11–32.

D. Asserted Grounds of Unpatentability

Petitioner contends that claims 1–20 of the ’609 Patent are unpatentable based on the following grounds (Pet. 19–67):

Challenged Claims	Basis	Reference(s)
1–6 and 8–15	§ 103	Otto ¹
7 and 16–20	§ 103	Otto, Gainsboro ² , and San Martin ³
7 and 16–20	§ 103	Otto and Hogg ⁴

II. DISCUSSION

A. Claim Construction / Level of Ordinary Skill in the Art

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); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (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). An inventor may provide a meaning for a

¹ U.S. Patent No. 6,389,397 B1, filed December 23, 1998, issued May 14, 2002 (Ex. 1005, “Otto”).

² U.S. Patent No. 5,655,013, filed August 2, 1995, issued August 5, 1997 (Ex. 1006, “Gainsboro”).

³ U.S. Patent No. 6,681,205 B1, filed December 17, 1999, issued January 20, 2004 (Ex. 1007, “San Martin”).

⁴ U.S. Publication No. 2008/0118042 A1, filed November 22, 2006, published May 22, 2008 (Ex. 1008, “Hogg”).

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). In the absence of such a definition, limitations are not to be read from the specification into the claims. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

Additionally, courts may rely on dictionary definitions when construing claim terms, so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents. *See Advanced Fiber Tech. (AFT) Trust v. J & L Fiber Servs., Inc.*, 674 F.3d 1365, 1374–75 (Fed. Cir. 2012) (internal citations omitted).

Petitioner alleges that “substantially matches,” recited in independent claims 1, 10, and 16, is not defined expressly in the intrinsic record and does not otherwise appear in the ’250 Patent outside of the claims. Pet. 7–8. Because of this, Petitioner interprets the claim limitation “substantially matches” as encompassing at least the matching process disclosed in the specification of the ’250 Patent. *Id.* Patent Owner disputes Petitioner’s characterization, further discussed below, but does not offer an alternative construction. Prelim. Resp. 8–12.

Patent Owner argues specifically that Petitioner’s proposed construction of “substantially matches” could essentially read out the term “substantially.” *Id.* at 11. If we understood Petitioner to be espousing that “substantially matches” is equivalent to “matches,” we would agree; however, Petitioner’s argument is that “substantially matches” *encompasses* at least the described matching. We also agree with Petitioner, that

“substantially” appears only in the claims of the ’250 Patent, and that most of the discussion of matching (Ex. 1001, 11:60–65, 12:52–55, 53:65–54:1) applies to matching a PIN, that would likely be exacting matching. Pet. 7–8. The likely relevant section applicable to the subject claim limitation is recited in the specification as follows: “[i]f the supplied information matches the stored information, the user is authenticated and can use the call system call management system.” Ex. 1001, 48:57–60. Not finding explicit description of the claim limitation in the ’250 Patent, we may turn to extrinsic sources to determine how the claim term would have been understood by one of ordinary skill in the art.

With respect to the level of ordinary skill in the art, Petitioner asserts that such a person “would have held at least a bachelor’s degree in electrical engineering, computer engineering, or a similar field, and had at least two years of experience (or the academic equivalent) working with speaker-dependent voice recognition in the context of telecommunications.” Pet. 7 (citing Ex. 1002 ¶¶ 38–41). Patent Owner does not offer an alternate characterization at this time. As such, we adopt Petitioner’s statement of the level of ordinary skill in the art for purposes of this decision.

Hence, we determine that “match” would have been understood as determining whether two data items are identical or finding a data item that is identical to a key. *See* Ex. 3001. Furthermore, we determine that “substantially” would have been understood as to a great or significant extent, or for the most part or essentially. *See* Ex. 3002. Therefore, we determine that the broadest reasonable construction, consistent with and in

the context of the specification, of “substantially matches” is “determining whether two data items are for the most part or essentially identical.” *See also Verve v. Crane Cams*, 311 F.3d 1116, 1120 (Fed. Cir. 2002) (“Expressions such as “substantially” are used in patent documents when warranted by the nature of the invention, in order to accommodate the minor variations that may be appropriate to secure the invention.”)); *see, e.g., Ecolab Inc. v. Envirochem, Inc.*, 264 F.3d 1358, 1367 (Fed. Cir. 2001) (explaining that “like the term ‘about,’ the term ‘substantially’ is a descriptive term commonly used in patent claims to avoid a strict numerical boundary to the specified parameter”) (citation omitted).

Although Petitioner does not proffer an explicit construction for the claim term “substantially matches,” Petitioner does argue that the prior art discloses “both exact matches and matches that deviate from exact matches by predetermined amounts.” Pet. 29 (citing Ex. 1002 ¶ 74). Therefore, we are persuaded that Petitioner is implicitly applying a claim construction of “substantially matches” that comports with the broadest reasonable construction determined herein.

B. Patent Owner’s Arguments Regarding Petition

Patent Owner raises arguments *about* the grounds raised in the Petition, but does not address the substantive teachings of the cited references nor the arguments regarding obviousness presented in Petitioner’s grounds. *See* Prelim. Resp. Rather, Patent Owner argues 1) that the first two grounds should be denied under 35 U.S.C. § 325(d); 2) that the Petition impermissibly challenges the claims under 35 U.S.C. § 112; 3) that the

grounds rely on a speculative claim construction; and 4) that the Petition’s “intermediate preamble” theory lacks legal authority and fails to set forth its challenge to claim 1 “with particularity.” *Id.* at 4–16. We address each in turn, prior to addressing substantively the proffered grounds of unpatentability to determine whether the Petitioner has met the threshold for institution.

1. 35 U.S.C. § 325(d)

Patent Owner argues that “[t]he Board should exercise its discretion under 35 U.S.C. § 325(d) to deny Grounds 1 and 2 of the Petition because ‘the same or substantially the same prior art or arguments previously were presented to the Office.’” Prelim. Resp. 4.

Petitioner acknowledges that Otto and Gainsboro were cited “among the over 360 ‘References Cited’ in the ’250 patent” but that “there is no evidence the Examiner substantively addressed either of these references during prosecution of the ’250 patent.” Pet. 65 (citing Ex. 1001, [56] “References Cited”; Ex. 1004 (Prosecution history of the application that issued as the ’250 patent)). Petitioner also acknowledges that the Examiner “cited San Martin as an anticipatory reference under § 102(3) for various then-pending claims.” *Id.* at 65–66 (citing Ex. 1004, 217). Petitioner contends that the Examiner withdrew the § 102(e) rejection in view of Applicant’s amendments, including the addition of a new claim that would become issued claim 7. *Id.* at 66 (citing Ex. 1004, 289). Moreover, Petitioner contends that, in contrast to the Examiner’s reliance on San Martin during prosecution, Petitioner here “cites San Martin in the context

of claims 7 and 16–20 to demonstrate that one of ordinary skill would have understood at the time of the alleged invention how to advantageously refine a voiceprint with samples of higher confidence.” *Id.* Petitioner concludes that its asserted “grounds are not cumulative of issues previously presented and considered by the Office.” *Id.*

Patent Owner argues that Petitioner has acknowledged that the Office has previously considered most of the proffered prior art, as well as having applied San Martin in an anticipation rejection, and that Petitioner’s reasons to reconsider the prior art are flawed. *Id.* (citing Pet. 4, 65–66; Ex. 1004, 217). Patent Owner disputes that the Examiner did not consider the instant prior art references during prosecution, as well as disputing that the arguments presented in the grounds of unpatentability are entirely different from the arguments considered by the examiner, because Otto is cumulative with San Martin. *Id.* at 4–7. We do not agree.

As quoted by Patent Owner, 35 U.S.C. § 325(d) addresses whether “the same or substantially the same prior art or arguments previously were presented to the Office.” To evaluate this criterion, we examine what arguments and art were presented to and considered by the Examiner during prosecution. Although Otto was considered by the Examiner (Ex. 1004, 243 indicates Otto was included in an Information Disclosure Statement by the Applicant), the Examiner did not rely on Otto in any rejection of the issued claims in view of Otto. We are further persuaded that the Examiner has not been shown to have considered Otto in the instant context, i.e., with claims

being argued as being obvious over Otto and with declaration testimony opining that the claims would have been obvious over Otto (Ex. 1002).

Patent Owner also faults Petitioner for not distinguishing Otto from San Martin (Prelim. Resp. 7), but it is not necessarily incumbent on a petitioner to distinguish the disclosures of newly applied and previously applied prior art references. Patent Owner points out similarities in the disclosures of Otto and San Martin (*id.* at 6–7), but does not demonstrate what similar portions of Otto and San Martin would have been considered in finding certain claims allowable. *See* Ex. 1004, 219. Such a consideration is important because Patent Owner incorporated the allowable subject matter into the independent claims to gain allowance. *See* Ex. 1004, 290. At this stage of the proceedings, we are persuaded that that there is a reasonable likelihood that Petitioner would prevail in showing the subject matter of the independent claims are taught or suggested by Otto, and as discussed below, we are not persuaded that the disclosures of Otto and San Martin are necessarily cumulative.

2. Alleged Challenges Under 35 U.S.C. § 112

Patent Owner also argues that Petitioner impermissibly challenges the claims under § 112, which is outside the scope of the instant proceeding, and that “the Board is unable to properly assess the scope of the claims, and is therefore ill-equipped to assess the validity of the claims under § 102 or § 103.” Prelim. Resp. 9. Patent Owner continues that “Petitioner’s admitted failure to identify the scope and meaning of the claims demonstrates that the Petition’s grounds of unpatentability are fatally flawed because they ‘rely[]

on what at best are speculative assumptions as to the meaning of the claims.’” *Id.* at 9–10 (citing *In re Steele*, 305 F.2d 859, 863 (C.C.P.A. 1962)). We do not agree.

As discussed above, we are not persuaded that Petitioner is arguing that the claims be found to be indefinite, as a part of this proceeding, and we are persuaded that Petitioner has applied a consistent construction of the disputed claim term. Although Petitioner cites to *Nautilus, Inc. v. Biosig Instruments, Inc.* 134 S. Ct. 2120, 2129 (2014) (Pet. 8), we are persuaded that the proper criterion for determining definiteness is that “[a] claim is indefinite when it contains words or phrases whose meaning is unclear,” or that “claims are required to be cast in clear — as opposed to ambiguous, vague, indefinite — terms.” *See Ex parte McAward*, Appeal No. 2015-006416, slip op. at 11 (PTAB Aug. 25, 2017) (precedential) (citing *In re Packard*, 751 F.3d 1310, 1314, 1313 (Fed. Cir. 2014)). Based on the claim construction proffered above, we are not persuaded that the claim limitation “substantially matches” renders the claims indefinite. Similarly, we do not agree that the grounds of unpatentability are “fatally flawed,” as argued by Patent Owner.

3. Alleged Speculative Claim Construction

Patent Owner argues, similar to its arguments discussed above, that we should deny the Petition “because the Petition’s grounds of unpatentability rely on a speculative claim construction of the term ‘substantially matches,’ which is recited in each of the independent claims.” Prelim. Resp. 10. As discussed above, we are not persuaded that the Petition

relies upon speculations and assumptions, that would provide an unreliable base for findings of unpatentability over prior art. Rather, we are persuaded that Petitioner has applied a consistent construction of the disputed claim term, without the alleged speculation.

4. The Petition's "Intermediate Preamble" Theory / Mapping

Patent Owner also argues that a petition must identify with particularity how a challenged claims is to be construed, and the instant Petition fails in that regard because it fails to properly construe “a database,” “a control platform,” and “an authentication module.” Prelim. Resp. 12. Patent Owner argues that the Petition refers to particular claim elements as “intermediate preamble[s],” and does not provide a clear mapping of the subject claim elements to Otto, reading multiple claim elements onto the same disclosed portion of Otto’s system. *Id.* at 13–16. We are not persuaded that either argument is fatal to the Petition.

Although we have reviewed Petitioner’s discussion of “intermediate preamble[s],” we are not persuaded that elements of claim 1 must be considered as such. We evaluate each element of claim 1 as an element of the claims, and not as a preamble, upon which any determination need to be made if it is limiting. In addition, the Petition provides alternative disclosures for the elements its considers “intermediate preamble[s]” (Pet. 15–16, 23–25), such that we consider those disclosures below in determining the efficacy of the ground of unpatentability. As well, as discussed below, we are persuaded that the Petition has mapped claim 1 adequately onto the disclosures of Otto. With respect to any overlap, at this stage of the

proceeding, we are persuaded by Petitioner’s discussion of overlapping functions and how they would lend themselves to implementation with similar or the same hardware. Pet. 24–25. Thus, we are not persuaded that either argument is fatal to the Petition.

C. Asserted Ground of Obviousness over Otto

Petitioner asserts that claims 1–6 and 8–15 are unpatentable under 35 U.S.C. § 103 over Otto. Pet. 9–43. To support its contentions and relying on the declaration testimony of Mr. Stuart J. 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 modified the teachings, where applicable. *Id.* (citing Ex. 1002). We begin with a discussion of Otto, and then discuss the proffered rationales to modify Otto to reach the subject claims.

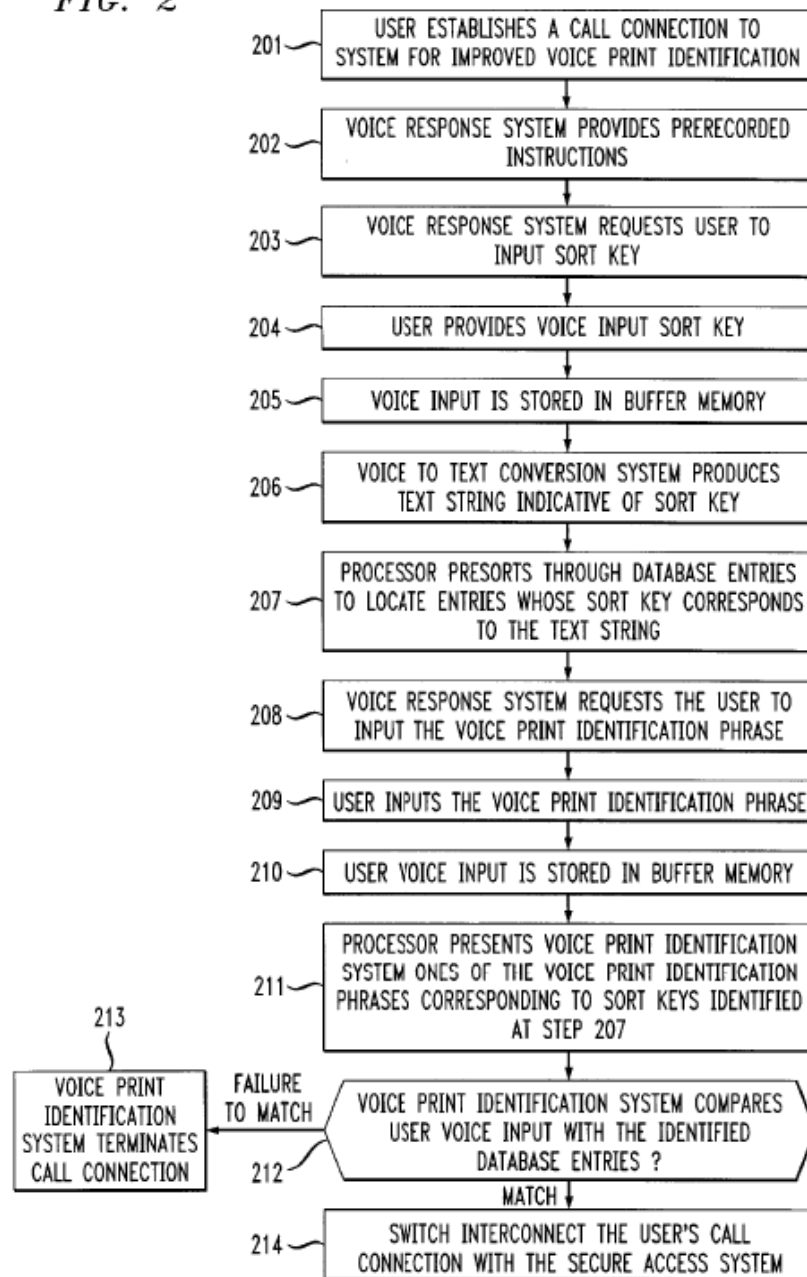
1. Otto

Otto is directed to a speaker verification system that uses a user’s voiceprint in addition to a name and/or Personal Identification Number (PIN) to verify the user before granting access to a secure system. Ex. 1005, Abs. The system first requires a registration process, where a user inputs the required “user identification data,” which can be in the form of a name or PIN and are used thereafter as a sort key. *Id.* at 4:46–53, 5:18–23, 5:66–6:3. The data also include the voiceprint of the user, referred to as a “voice print identifying phrase,” where both the sort key and the voiceprint identifying

phrase are indexed together and stored in a database. *Id.* at 4:48–53, 5:18–20, Figs. 2–3.

When a user wants to remotely access the secure telephone system, the system determines whether to grant the user access using a process that begins with a user establishing a call connection to the secure system. The user then provides either a single voice input, which consists of both the sort key and a voice print identifying phrase, or separately provides a sort key and voice print identifying phrase. *Id.* at 2:27–30, Fig. 2. This process is illustrated in Figure 2, reproduced below.

FIG. 2



Otto discloses that the spoken words are “converted by a voice to text conversion system into a text string” and used as a sort key. *Id.* at 2:30–32, Fig. 2. The text string is then used to sort through the stored voice print data

to locate the one, or a small subset thereof, of the stored voice print identification phrases that use the sort key. *Id.* at 2:32–36, Fig. 2. Finally, the system uses the voice print identification phrase to “verify” the identity of the user by comparing the stored phrase with the user’s voiceprint to determine if there is a match. *Id.* at 2:36–38, 5:52–56, Fig. 2.

Otto also explains that the database lookup process seeks both exact matches and phonetically close entries:

The processor 105 typically would not only look for exact matches between the stored sort keys and the text string output by the voice to text conversion system 112, but also phonetically close entries, to compensate for any inaccuracy in the text generation process. Thus, all sort key entries that differ from the text string by less than a predetermined amount are candidates for the voice print identification process. The accuracy of this presort operation can be regulated by adjusting the [cl]oseness of the match that is required for a sort key to be classified as a match candidate. This would still produce only a limited number of matches and serve the purpose of the system for improved voice print identification 100. If no match is determined, the process can either be repeated with a less distinct text comparison, or default to the processing of the voice print identification phrase without presorting the database entries.

Id. at 5:27–38.

2. *Consideration and Modification of Otto*

With respect to claim 1, Petitioner argues that several portions of claim 1 are “intermediate preamble[s]” that do not limit the claim because they “merely provide[] a descriptive name for a set of claim limitations.” Pet. 15. *See also* Pet. 23 (with respect to the “authentication module” limitation). As discussed above, we are not persuaded that we need to

consider Petitioner's theory because Petitioner has provided support for the subject limitations being taught or suggested by Otto. *Id.* We prefer to view each element of the claim as limiting, and thus, do not endorse Petitioner's treatment of "intermediate preamble[s]."

With respect to the limitation "control platform" of claim 1, Petitioner argues that one of ordinary skill would have understood that the "control platform" comprises "at least the elements of the voice print identification system that allows a user to input biometric data and identifying information, and that stores both the biometric data and identifying information in the database." *Id.* at 16. Petitioner contends that the system of Otto includes all of the features necessary for providing the relevant control aspects of a control platform, pointing to input ports 101, buffer 114, database 113, processor 105, and voice-to-text conversion 112, illustrated in Fig. 1. *Id.* We are persuaded that these aspects of Otto's system are sufficient to demonstrate a "control platform," as recited in claim 1, for purposes of institution.

With respect to the limitation "authentication module" of claim 1, Petitioner argues that one of ordinary skill would have understood that the "authentication module" comprises the elements of the voiceprint identification system that allow a user to perform all of the steps necessary to authenticate a user. *Id.* at 24. Petitioner contends that the system of Otto includes all of the features necessary for providing the relevant authentication features, pointing to input ports 101, switch 106, buffer 114, database 113, processor 105, voice print identification 111, and voice-to-text

conversion 112, illustrated in Fig. 1. *Id.* We are persuaded that these aspects of Otto's system are sufficient to demonstrate an "authentication module," as recited in claim 1, for purposes of institution.

Also with respect to claim 1, Petitioner argues that Otto discloses obtaining the user's name, which can be used as a sort key, and that one of ordinary skill in the art would have understood that the "user identification data," provided during registration, include at least the user's name. Pet. 20 (citing Ex. 1005, 4:62–5:11; Ex. 1002 ¶ 63). Petitioner makes similar arguments for provision of the PIN. *Id.* We agree with Petitioner that it would have been obvious and beneficial to collect the user's name and PIN at registration for sake of efficiency. *See id.* at 20–22.

Petitioner also argues that although Otto focuses on the user's name as a sort key, it would have been an obvious modification to use the PIN as a sort key because Otto does not limit its sort keys to only user names. *Id.* at 29 (citing Ex. 1005, 4:62–64; 1002 ¶ 75). We agree with Petitioner that one of ordinary skill in the art would have been motivated to sort based on a user's PIN because it is often less subject to overlap than names. *See id.* at 29–30.

After review of Petitioner's assertions with respect to claim 1, we are persuaded that the current record supports Petitioner's assertions and we are satisfied there is a reasonable likelihood that the Petitioner would prevail with respect to showing the obviousness of claim 1 over Otto, for purposes of institution. With respect to dependent claims 2–6, 8, and 9, we have reviewed Petitioner's assertions and arguments regarding the claim

limitations and the disclosure Otto, and we are persuaded that the current record supports Petitioner's assertions and we are satisfied there is a reasonable likelihood that the Petitioner would prevail with respect to showing the obviousness of claims 2–6, 8, and 9, for purposes of institution. *See id.* at 35–40.

With respect to independent claim 10, Petitioner demonstrates correspondences between the elements of claims 1 and 10, and argues that the same proof of unpatentability applied to claim 1 is applicable to claim 10. *Id.* at 40–41. We agree and we are satisfied there is a reasonable likelihood that the Petitioner would prevail with respect to showing the obviousness of claim 10 over Otto. With respect to dependent claims 11–15, Petitioner demonstrates the similarities of those claims to dependent claims 2–6, and we are persuaded that there is a reasonable likelihood that the Petitioner would prevail with respect to showing the obviousness of claims 11–15. *See id.* at 41–43.

3. Conclusion

On the present record and for purposes of institution, Petitioner has made a sufficient showing that Otto as modified would have conveyed to one of ordinary skill in the art the limitations of the claims 1–6 and 8–15, and has provided a sufficient reason one of ordinary skill in the art would have modified Otto to teach or suggest the limitations of the claims. For the foregoing reasons, we determine that the information presented in the current record, Petitioner establishes a reasonable likelihood that it would

prevail in showing claims 1–6 and 8–15 are unpatentable for obviousness over Otto.

D. Asserted Ground of Obviousness over Otto, Gainsboro, and San Martin

Petitioner asserts that claims 7 and 16–20 are unpatentable under 35 U.S.C. § 103 over Otto, Gainsboro, and San Martin. Pet. 43–54. 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 modified the teachings, where applicable. *Id.* (citing Ex. 1002). We begin with a discussions of Gainsboro and San Martin, and then discuss the proffered rationales to modify Otto and combine the teachings of Otto, Gainsboro, and San Martin to reach the subject claims.

1. Gainsboro

Gainsboro is directed to a method and apparatus for managing institutional telephone activity, including call restrictions and privileges and call recording. Ex. 1006, Abs. Gainsboro seeks to “ensure that no unauthorized callers are participating in a call, and to ensure that inmates are not sharing or selling relatively liberal calling privileges associated with a particular PIN or inmate account to other inmates that are subject to more limited calling privileges.” *Id.* at 5:24–29. Gainsboro uses biometric voice verification to prevent authorized inmates from being forced to provide calling privileges. *Id.* at 5:29–37. Gainsboro also details that “biometric monitoring may also be used in a passive call monitoring mode, wherein

periodic samples of the caller's voice are provided . . . to ensure that no unauthorized callers are participating in a call.” *Id.* at 5:22–25.

2. *San Martin*

San Martin is directed to a method and apparatus for enrolling a user for voice recognition that utilizes multiple inputs by a speaker to further refine the user's voiceprint. Ex. 1007, Abs. San Martin provides that “[i]f the extracted voiceprint matches with sufficient confidence . . . , the extracted voiceprint may be optionally used to refine 422 the stored voiceprint for the matching account number and the refined voiceprint is stored in place of it.” *Id.* at 11:18–22. San Martin discloses that this process allows for more secure and accurate speak verification. *Id.* at 2:14–19.

3. *Proposed Combination of Otto, Gainsboro, and San Martin*

Petitioner argues that one of ordinary skill also would have had a reasonable expectation of success in combining the monitoring system of Gainsboro with the speaker verification system of Otto. Pet. 45. Petitioner argues that the same hardware would be used by both, and the benefits of Gainsboro's monitoring of audio during the phone call through periodic sampling would accrue to the combined system.

With respect to San Martin, Petitioner argues that one of ordinary skill would have understood that the ability to further refine a voiceprint and improve the accuracy of the speaker verification process would improve the security of the system derived from the combination of Otto and Gainsboro and its ability to control access to a telephone system. *Id.* at 46 (citing Ex. 1002 ¶ 110).

Claim 7 recites, in part, that “the biometric data is received during a call, and the second biometric data is received during the same call.” Independent claim 16 recites a similar limitation, with the step of “monitoring audio information of a telephone call wherein the audio information contains the speech of a user,” and subsequently obtaining biometric data therefrom. Petitioner acknowledges that Otto does not disclose the highlighted features of claims 7 and 16, but argues that a system formed through combination of Otto, Gainsboro, and San Martin would operate to monitor a call through multiple voice samples, with refinement of biometric data stored in a database. *Id.* at 47–51.

With respect to the remaining limitations of claim 16 and dependent claims 17–20, Petitioner relies on its analysis of claim 1 and other dependent claims. *Id.* at 52–54. After review of Petitioner’s assertions with respect to claims 7 and 16–20, we are persuaded that the current record supports Petitioner’s assertions that one of ordinary skill in the art would have been motivated to combine the teachings of Otto, Gainsboro, and San Martin, for purposes of institution. Additionally, we are satisfied at this stage of the proceeding that there is a reasonable likelihood Petitioner would prevail with respect to showing the obviousness of claims 7 and 16–20 over Otto, Gainsboro, and San Martin.

4. Conclusion

On the present record and for purposes of institution, Petitioner has made a sufficient showing that the combination of Otto, Gainsboro, and San Martin would have conveyed to one of ordinary skill in the art the

limitations of the claims 7 and 16–20, and has provided a sufficient reason one of ordinary skill in the art would have combined the references. For the foregoing reasons, we determine that the information presented by Petitioner establishes a reasonable likelihood that it would prevail in showing claims 7 and 16–20 are unpatentable for obviousness over the cited references.

E. Additional Ground

As discussed above, Petitioner also proffers an additional ground over claims 7 and 16–20, specifically claims 7 and 16–20 being obvious under 35 U.S.C. § 103 over Otto and Hogg. Pet. 4, 55–65. This ground is proffered based on a later priority date than the earliest priority claimed by the '250 Patent. Ex. 1001, 1:9–17 (claiming the benefit of an application filed on August 8, 2002). Petitioner proffers this ground because “at least claims 7 and 16-20 of the '250 patent are entitled to priority no earlier than November 22, 2010, which is the date Patent Owner filed a continuation-in-part application adding new matter relevant to those claims.” *Id.* at 3. We need not address any potential priority date for claims 7 and 16–20 at this stage of the proceeding, given the institution of grounds discussed above, so that we are not persuaded that this additional ground is necessary.

Additionally, we have broad discretion to institute an *inter partes* review as to some asserted grounds and not others. 37 C.F.R. § 42.108(a) (“the Board may authorize the review to proceed . . . on all or some of the grounds of unpatentability asserted for each claim”); *see also* 35 U.S.C. § 314(a) (authorizing institution of an *inter partes* review under particular

circumstances, but not requiring institution under any circumstances). Indeed, the United States Court of Appeals for the Federal Circuit recognized our discretion in this regard when it stated that “under [37 C.F.R. § 42.108], it is clear that the Board may choose to institute some grounds and not institute others as part of its comprehensive institution decision.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1368 (Fed. Cir. 2016).

This discretion is consistent with the requirement that the statutory provisions governing an *inter partes* review proceeding take into account “the efficient administration of the Office” and “the ability of the Office to timely complete [instituted] proceedings” (35 U.S.C. § 316(b)), as well as the regulatory provisions that mandate these proceedings be “construed to secure the just, speedy, and inexpensive resolution of every proceeding” (37 C.F.R. § 42.1(b)). Accordingly, faced with this record, we exercise our discretion and do not institute an *inter partes* review as to the remaining ground asserted by Petitioner for reasons of administrative necessity and to ensure timely completion of this proceeding.

III. CONCLUSION

For the foregoing reasons, we conclude that there is a reasonable likelihood that Petitioner would prevail in showing that claims 1–20 of the ’250 Patent are unpatentable. The Board has not made a final determination with respect to the patentability of these claims. The Board’s final determination will be based on the record as developed fully during trial.

IV. ORDER

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

ORDERED that pursuant to 35 U.S.C. § 324, an *inter partes* review is hereby instituted as to claims 1–20 of the '250 Patent on the following grounds of unpatentability:

Claims 1–6 and 8–15 under 35 U.S.C. § 103 as being unpatentable over Otto;

Claims 7 and 16–20 under 35 U.S.C. § 103 as being unpatentable over Otto, Gainsboro, and San Martin; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4 notice is hereby given of the institution of a trial, which commences on the entry date of this Order.

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