

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GLOBAL TEL\*LINK CORPORATION,  
Petitioner,

v.

SECURUS TECHNOLOGIES, INC.,  
Patent Owner.

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Case IPR2014-00785  
Patent 6,636,591 B1

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

BRADEN, *Administrative Patent Judge*.

FINAL WRITTEN DECISION  
*35 U.S.C. § 318 and 37 C.F.R. § 42.73*

## I. INTRODUCTION

We have jurisdiction to hear this *inter partes* review under 35 U.S.C. § 6(c). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons that follow, we determine that Petitioner has not shown by a preponderance of the evidence that claims 1–10 of U.S. Patent No. 6,636,591 B1 (Ex. 1001, iss. Oct. 21, 2003, “the ’591 patent”) are unpatentable. We also address the Petitioner’s Motion to Exclude and Patent Owner’s Motion for Observation Regarding Cross-Examination Testimony.

### A. Procedural History

Global Tel\*Link Corporation (“Petitioner”) filed a Corrected Petition (Paper 4, “Pet.”) to institute an *inter partes* review of claims 1–10 of the ’591 patent. Securus Technologies, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 9, “Prelim. Resp.”). Pursuant to 35 U.S.C. § 314, we instituted an *inter partes* review of claims 1–10 under 35 U.S.C. § 103(a) as unpatentable in view of Karacki<sup>1</sup> and Gainsboro ’843<sup>2</sup>. See Paper 10 (“Dec. to Inst.”), 22.

After institution of trial, Patent Owner filed a Patent Owner Response (Paper 15, “PO Resp.”), to which Petitioner filed a Reply (Paper 21, “Reply”). In addition, Petitioner filed a Motion to Exclude. Paper 26 (“Pet. Mot. Exclude”). Patent Owner filed an Opposition to Petitioner’s Motion to

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<sup>1</sup> Loren Karacki & Robert B. Levinson, REWARDS IN AN INSTITUTION FOR YOUTHFUL OFFENDERS IN THE HOWARD JOURNAL OF PENOLOGY AND CRIME PREVENTION 20–30 (1970) (Ex. 1012, “Karacki”).

<sup>2</sup> U.S. Patent No. 7,106,843 B1, issued Sept. 12, 2006 (Ex. 1004, “Gainsboro ’843”).

Exclude (Paper 34, “PO Exclude Opp.”), and Petitioner filed a Reply (Paper 35, “Pet. Exclude Reply”). Patent Owner also filed observations on the cross-examination of Petitioner’s declarant (Paper 29), to which Petitioner filed a response (Paper 33).

An oral argument was held on June 3, 2015. A transcript (“Tr.”) of the oral argument is included in the record.<sup>3</sup> Paper 40.

*B. Related Proceedings*

The parties inform us that there are no matters related to the ’591 patent. Pet. 2; Paper 7, 1; Paper 17, 1.

*C. The ’591 Patent*

The ’591 patent relates to a method of “affecting inmate conduct through providing discounted telephone rates based on certain criteria.” Ex. 1001, 1:9–11. The method requires a correctional facility to set predetermined criteria for obtaining discounted telephone rates. *Id.* at 2:38–40. The criteria can be based on any type of measurement of behavior and points are awarded or deducted based on inmate behavior. *Id.* at 2:45–47. When an inmate obtains and maintains a predetermined number of points for a predetermined period of time, the inmate is rewarded with the privilege of discounted telephone calls. *Id.* at 1:58–2:18. According to the ’591 patent, “[w]hen an inmate receives a reduced rate for his or her telephone calls

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<sup>3</sup> The parties each filed Objections to Demonstrative Exhibits. Papers 38, 39. In this Final Written Decision, we rely directly on the arguments presented properly in the parties’ briefs and the evidence of record. The demonstrative exhibits were only considered to the extent they are consistent with those arguments and evidence, therefore, the objections are overruled.

based on good behavior, the inmate will have an incentive to maintain his or her good behavior.” *Id.* at 2:52–55.

Figure 1 of the '591 patent is reproduced below.

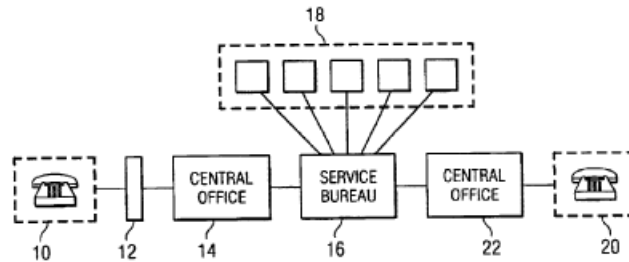


Figure 1 is a schematic of a telephone network connecting originating telephone 10 and destination telephone 20, and connected to one or more databases 18. *Id.* at 3:1–19. The originating telephone 10 is connected to premises-based telecommunications system 12. *Id.* at 3:3–5. An outside call made by originating telephone 10 is received by central office 14 and routed to service bureau 16. *Id.* at 3:10–14. Service bureau 16 is linked to one or more databases 18 and can route the call to destination telephone 20 via central office 22. *Id.* at 3:14–20. According to the '591 patent, databases 18 contain information that can be used to (i) determine if an inmate qualifies for a discounted telephone rate and apply such rate to any call purchased by the inmate, or (ii) associate a discounted telephone rate with a PIN number or a predetermined destination number and apply such discounted rate to the PIN or destination number. *Id.* at 3:42–56.

#### *D. Illustrative Claims*

As noted above, an *inter partes* review was instituted as to claims 1–10 of the '591 patent, of which claims 1 and 9 are the only independent claims. Claims 1 and 9 are illustrative of the challenged claims and are reproduced below (with paragraphing):

1. A method of affecting inmate behavior within a correctional facility comprising the steps of:
  - providing an identification for each inmate;
  - establishing a discount telephone rate;
  - establishing a measurement of conduct during incarceration for the inmates, wherein said measurement is a predetermined point total;
  - reducing the telephone call charge rate for inmates that meet the measurement of conduct during incarceration for a predetermined period of time;
  - maintaining a record of inmate behavior for each inmate according to said identification;
  - awarding points to each inmate based on particular behavior;
  - and
  - deducting points from each inmate based on particular behavior.
  
9. A method of affecting inmate behavior within a correction facility comprising the steps of:
  - establishing a discount telephone rate;
  - establishing a measurement of conduct during incarceration for the inmates, wherein said measurement is a predetermined point total;
  - reducing the telephone call charge rate for inmates that meet the measurement of conduct during incarceration for a predetermined period of time;
  - associating the reduced charge rate with at least one predetermined destination number;
  - maintaining records of inmate behavior for each inmate according to an inmate identifier;
  - awarding points to inmates based on particular behavior; and
  - deducting points from inmates based on particular behavior.

Ex. 1001, 4:29–46, 4:65–6:4.

## 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

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