

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*.

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

## I. INTRODUCTION

### A. Background

Global Tel\*Link Corporation (“Petitioner”) filed a Corrected Petition (Paper 4, “Pet.”) to institute an *inter partes* review of claims 1–10 of U.S. Patent No. 6,636,591 B1 (Ex. 1001, iss. Oct. 21, 2003, “the ’591 patent”). Securus Technologies, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 9, “Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted “unless . . . 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 Patent Owner’s Preliminary Response, we conclude Petitioner has established a reasonable likelihood it would prevail with respect to at least one of the challenged claims. Accordingly, for the reasons that follow, we institute an *inter partes* review of claims 1–10 of the ’591 patent.

### B. Related Proceedings

Petitioner informs us that there are no matters related to the ’591 patent. Pet. 2.

### 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 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.

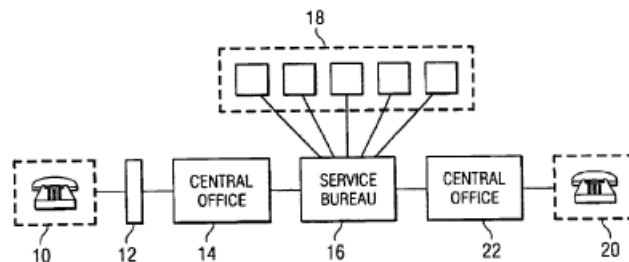


Figure 1 is a schematic of a telephone network connecting originating telephone 10 and destination telephone 20, and connected to one or more databases 18. *Id.* at 3:1–19. The originating telephone 10 is connected to premises-based telecommunications system 12. *Id.* at 3:3–5. An outside call made by 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, Petitioner challenges 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:

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.

*E. The Evidence of Record*

Petitioner relies upon the following references, as well as the Declaration of Leonard J. Forys, Ph.D. (Ex. 1010):

Reference	Patent/Printed Publication	Date	Exhibit
Wormith	J. S. Wormith. "The Development of a Prison Incentive System: A Case Illustration," <i>The First Annual Corrections Research Forum</i> , pp.77–93, March 1989	Mar. 1989	1002
Hennessy	U.S. Patent No. 5,991,376	Nov. 23, 1999	1003
Gainsboro '843	U.S. Patent No. 7,106,843 B1	Sept. 12, 2006	1004
Byers	U.S. Patent No. 5,570,417	Oct. 29, 1996	1005
Gainsboro '013	U.S. Patent No. 5,655,013	Aug. 5, 1997	1006
Hird	U.S. Patent No. 4,933,966	June 12, 1990	1009
Karacki	L. Karacki et al., "Rewards in an Institution for Youthful Offenders," <i>The Howard Journal of Penology and Crime Prevention</i> , vol. XIII, No. 1, pp. 20–30, 1970	1970	1012

*F. The Asserted Grounds of Unpatentability*

Petitioner challenges the patentability of claims 1–10 of the '591 patent based on the following grounds:

References	Basis	Claims Challenged
Karacki and Gainsboro '843	§ 103	1–10
Wormith and Hennessy	§ 103	1–3, 9, and 10
Wormith, Hennessy, and Gainsboro '843	§ 103	1–10
Wormith and Byers	§ 103	1–3, 9, and 10

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