

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

PATENT OWNER PRELIMINARY RESPONSE

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Patent Trial and Appeal Board
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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I. Securus’ Petition is based on a combination of references that not only fails to disclose all of the limitations but also teaches away from the claims of the ’816 Patent, and therefore the Petition should be denied. 1

II. Although the Petition construes two means-plus-function limitations, their constructions are unnecessary in concluding that the Petition is deficient.4

 A. Contrary to Securus’ contention, the ’816 Patent discloses a software algorithm for the “multiplexing means.”6

 B. Contrary to Securus’ contention, the ’816 Patent discloses additional structure for “transmitting means.”8

III. The combination of *Bulriss* and *Hesse* fails to disclose and teaches away from at least two limitations of the independent claims of the ’816 Patent and accordingly, both of the Petition’s proposed Grounds 1 and 2 of invalidity fail.....9

 A. The combination of *Bulriss* and *Hesse* fails to disclose and teaches away from monitoring “communications data” between a first and a second participant, as required by the independent claims of the ’816 Patent.9

 B. The combination of *Bulriss* and *Hesse* fails to disclose and teaches away from “establishing” a “data connection” at a “scheduled time” as required by the independent claims of the ’816 Patent.....17

IV. The Petition’s rationale for combining *Bulriss* and *Hesse* is not valid, and for that reason as well, the Petition’s proposed Grounds 1 and 2 of invalidity fail.25

V. For at least all of the aforementioned reasons, Securus’ Petition is deficient and should be denied.28

I. Securus' Petition is based on a combination of references that not only fails to disclose all of the limitations but also teaches away from the claims of the '816 Patent, and therefore the Petition should be denied.

The Board should deny Securus' Petition because each of its proposed Grounds 1 and 2 of invalidity is premised on a combination of references that fails to disclose every limitation of the challenged claims and, in fact, teaches away from the claims of the '816 Patent.

Both of Securus' proposed Grounds 1 and 2 of invalidity depend on the combination of *Bulriss* and *Hesse* rendering obvious the independent claims of the '816 Patent, as summarized in the table below:

Proposed Ground	References Combined ¹	Independent Claims Challenged	Dependent Claims Challenged (each depends from one of the Independent Claims 1 and 30)
1	<i>Bulriss</i> , <i>Hesse</i>	1, 30	2-15, 18-21, 25-29, 31-44, 47-50, 54, 55
2	<i>Bulriss</i> , <i>Hesse</i> , <i>Rae</i>	(none)	16, 17, 22-24, 45, 46, 51-53

(Petition at 2.) Hence, Securus predicates both of its proposed Grounds of invalidity on the proposition that the combination of *Bulriss* and *Hesse* renders obvious both independent claims 1 and 30 of the '816 Patent.

The Petition acknowledges that independent claims 1 and 30 of the '816

¹ References combined in the Petition are: *Bulriss* (Ex. 1005), *Hesse* (Ex. 1006), and *Rae* (Ex. 1007).

Patent require monitoring a communication between two participants, but the combination of *Bulriss* and *Hesse* would never lead to such monitoring because doing so in the combination would cause infringement upon a communication protected by the attorney-client privilege. (*Infra* III.A.) The Petition identifies in the combination of *Bulriss* and *Hesse* a private video conference during trial between an attorney and her incarcerated client as the claimed “communications data” of the independent claims of the ’816 patent. (*Id.*) The combination of *Bulriss* and *Hesse* not only fails to disclose monitoring of such communications, but, in fact, teaches away from monitoring such attorney-client privileged communications because *Bulriss* is aimed squarely at maintaining such communications “in confidence” so as not to lose “its protected status under ... the attorney-client privilege.” (*Id.*; Ex. 1005 at 1:8-14.)

Additionally, the Petition acknowledges that independent claims 1 and 30 of the ’816 Patent require that a “data connection” be established at a scheduled time to facilitate transmission of the claimed “communications data” between the two participants, but the “communications data” identified in the Petition is not amenable to scheduling in the future. (*Infra* III.B.) As noted above, the Petition identifies in the combination of *Bulriss* and *Hesse* a private video conference during trial between an attorney and her incarcerated client as the claimed “communications data” of the independent claims of the ’816 Patent. (*Id.*) The

need for such attorney-client privileged communications at trial would undoubtedly be *ad-hoc* and would need to be handled immediately to keep the trial progressing forward. Hence, the alleged claimed “communications data” in *Bulriss* and *Hesse* is not susceptible to scheduling, and the combination of *Bulriss* and *Hesse* teaches away from the requirement of the claims of the ’816 Patent that the claimed “data connection” associated with the claimed “communications data” be established at a scheduled time in the future.

Furthermore, the Petition alleges that one of skill in the art would have been motivated to combine *Bulriss* with *Hesse* because *Bulriss* is allegedly directed to resolving network latency issues identified in the ’816 Patent, but Securus provides no credible support that *Bulriss* is directed to resolving such issues. In fact, *Bulriss* is devoid of any discussions on network latencies and is directed instead to enabling “private communication between an attorney and his incarcerated client during trial such that the private communication is maintained in confidence.” (Ex. 1005 at 1:10-14.) Accordingly, the Petition fails to provide any credible rationale for one of skill in the art to consider *Bulriss* or to combine it with another reference such as *Hesse* to arrive allegedly at the claims of the ’816 Patent.

Although it is inexplicable why Securus would submit a Petition challenging the claims of the ’816 Patent based on a supposed combination of references – *Bulriss* and *Hesse* – that fails to disclose and instead teaches away from the claims

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