UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SECURUS TECHNOLOGIES, INC.,
Petitioner,

v.

GLOBAL TEL*LINK CORPORATION,
Patent Owner.

_____

Case  IPR2016-00267
Patent 7,256,816 B2

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

TURNER, *Administrative Patent Judge*.

DECISION
Denying Request for Rehearing
*37 C.F.R. §§ 42.71*

# I.  INTRODUCTION

Securus Technologies ("Petitioner") filed a Request for Rehearing (Paper 9, "Reh'g Req.") of the decision denying institution (Paper 8, "Dec."), in which the Board concluded that Petitioner was not reasonably likely to prevail in demonstrating that at least one of the challenged claims of U.S. Patent No. 7,256,816 B2 (Ex. 1001, "the '816 Patent") is not patentable, based on the Petition. Dec. 2.  Specific to the instant Rehearing Request, we found that Petitioner did not demonstrate a reasonable likelihood of prevailing in establishing that challenged claims were unpatentable as obvious over Bulriss, Hesse and Rae.  *Id*. at 13.

In its request, Petitioner argues that "the Board mistakenly relied on the privacy-mode description of non-monitored attorney-client communications as the basis for denying institution" and those descriptions are not applicable to "the public mode described in the reference and presented throughout the Petition." Reh'g Req. 1.  Although we consider Petitioner's arguments below, the Request for Rehearing is *denied.*

# II.  ANALYSIS

When rehearing a decision on institution, the Board will review the decision for an abuse of discretion.  37 C.F.R. § 42.71(c).  An abuse of discretion may be determined if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors.  *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P'ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000).

Petitioner contends that the prior art reference Bulriss discloses two modes of operation —public and privacy.  Reh'g Req. 2.  According to Petitioner, it exclusively relied on the public mode disclosure for teaching the disputed claim limitation.  *Id*. at 3–5; *see, e.g.,* Reh'g Req. 1 ("The public-mode disclosure—exclusively relied on by Securus—teaches the claimed communications monitoring . . . .").  Petitioner argues that we erred because we followed Patent Owner's lead and "overlooked or misapprehended [Petitioner's] public-mode arguments and evidence when denying institution."  *Id.* at 2.  We do not agree.

The first recitation of the term "mode" in this proceeding occurred in the Decision Denying Institution, in a discussion of Bulriss.  Dec. 7.  Bulriss discusses private and public modes (Ex. 1005, 15:35–36), and Patent Owner analyzes the types of communication recited in Bulriss (Prelim. Resp. 13–17), but neither party discussed the public and privacy modes in the Petition or Preliminary Response.  Recitations of "private," "privacy," "public," and "mode" in the Petition (Paper 2) and Dr. Zatkovich's declaration (Ex. 1002) are provided in the table below:

| Subject word | Petition [Paper 2] | Zatkovich Declaration [Exhibit 1002] |
| --- | --- | --- |
| "private" | p. 12: "enables *private* communication," "*private* communication is maintained" | ¶ 2: "virtual *private* networks (VPNs);" ¶ 51: "communicate *privately*," ¶ 91: "*private* communication mode;" claim chart element 1.pre: "*private* communications;" claim chart element 1.e: "*private* location;" claim chart element 3: "semi-*private* location" |
| "privacy: | none | none |
| "public" | pp. 13, 23: "*public* exchange device" | ¶ 2, claim chart element 16: "*public* switched telephone networks (PSTN);" ¶¶ 45, 92, 95, claim chart elements 1.a, |

| | | 1.b, 9, and 30.a: "*public* exchange device;" ¶ 78: "central *public* exchange 'PBX' device" |
|---|---|---|
| "mode" | none | ¶ 91: "private communication *mode*" |

As such, it is not clear how Petitioner could have relied *solely* on the public mode of Bulriss when neither the public nor the privacy modes are acknowledged in the Petition.  If an understanding of the public mode of Bulriss was important in the context of Petitioner's case against the claims of the '816 Patent, no such import or discussion of the public mode was provided in the Petition.

The Board is tasked with determining whether a petitioner would be reasonably likely to prevail in demonstrating that at least one of the challenged claims is not patentable in view of the *petition* filed.  35 U.S.C. § 314(a).  It is the Petitioner, in its Petition, that must demonstrate whether there is a reasonable likelihood that at least one claim is unpatentable under the assert ground.  *See* 37 C.F.R. § 42.108(c).  "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")).  This burden 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).

Petitioner further argues that it "relied [up]on Bulriss's public mode, where communications between an attorney and inmate are displayed for a judge and jury to monitor," and provides citations from the Petition to those specific communications in Bulriss. Reh'g Req. 4–5. The cited communications, however, are not recited explicitly in Bulriss as occurring only in the "public mode," where Bulriss provides specific recitations of the use of portions of the system in different modes, i.e., recites "in a public mode," etc. *See* Ex. 1005 15:37–38, 16:26–31, 33–40. As well, Bulriss makes clear that attorney-client sidebar station 48 operates both in the usual video conference mode and in a private mode (*id*. at 15:20–22), but the Petition does not refer to (or acknowledge) this portion of Bulriss.

Petitioner's Request for Rehearing is replete with references to Bulriss's "public mode," including specific citations, namely "Ex. 1005 at 16:24-31; 18:2-8." *See* Reh'g Req. 7. Those citations fall short, however, because they were not provided in the Petition. The closest citation provided by Petitioner is "Ex. 1005 at 16:54-17:3," at page 41 of the Petition. The Board could not have overlooked a detailed explanation or analysis not presented in the Petition. A rehearing request is not a supplemental petition. The petition, itself, must identify "specific portions of the evidence that support the challenge." 37 C.F.R. § 42.104(b)(5). "The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge." *Id*. Petitioner has the responsibility to identify and explain in the petition specific evidence that supports its arguments. We must make our determination regarding institution based on what the Petition actually presented and not what it could have reasonably contained had it been reformulated. *In re*

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