

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.

JOHN D. PROFANCHIK, SR.,  
Patent Owner.

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Case IPR2016-00268  
Patent 8,315,367 B2

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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), and 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 shown by a preponderance of the evidence that claims 1–20 of U.S. Patent No. 8,315,367 B2 (Ex. 1001, “the ’367 patent”) are unpatentable.

### A. Procedural History

Securus Technologies, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) to institute an *inter partes* review of claims 1–20 of the ’367 patent. On the cover of its Petition for *inter partes* review, Petitioner indicated that Global Tel\*Link Corporation was the patent owner. Global Tel\*Link Corporation, however, informed the Board that John D. Profanchik, Sr. is the patent owner and real party-in-interest. Paper 4, 2; Paper 5, 1. John D. Profanchik, Sr. (“Patent Owner”) timely filed a Preliminary Response (Paper 5, “Prelim. Resp.”). In its Preliminary Response, Patent Owner pointed out citation errors in the Petition. Petitioner then filed a Corrected Petition. Paper 7.<sup>1</sup> Based on Petitioner’s filing of a Corrected Petition after the filing of Patent Owner’s Preliminary Response, Patent Owner filed a pleading responsive to the Corrected Petition. Papers 9 (Board’s Order authorizing Patent Owner’s responsive pleading), 10 (Patent Owner’s Responsive Pleading).

Pursuant to 35 U.S.C. § 314(a), we instituted an *inter partes* review of (1) claims 1–7, 9–17, 19, and 20 as unpatentable under 35 U.S.C. § 102(e) in

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<sup>1</sup> All citations in this Decision are to the Corrected Petition, Paper 7.

view of Polozola<sup>2</sup>; (2) claim 3 and 13 unpatentable under 35 U.S.C. § 103(a) in view of Polozola and Csabai<sup>3</sup>; (3) claim 4, 8, 14, and 18 unpatentable under 35 U.S.C. § 103(a) in view of Polozola and Hansen<sup>4</sup>; (4) claims 1–3, 5–7, 9–13, 15–17, 19, and 20 under 35 U.S.C. § 103(a) as unpatentable over Reinhold<sup>5</sup>, Csabai, and Polozola; and (5) claims 4, 8, 14, and 18 under 35 U.S.C. § 103(a) as unpatentable over Reinhold, Csabai, Polozola, and Hansen. *See* Paper 11 (“Dec. to Inst.”), 40.<sup>6</sup>

After institution of trial, Patent Owner indicated that it would not file a Patent Owner’s Response or otherwise continue participating in this proceeding. *See* Paper 14 (Conduct of Proceeding Order). Under the particular circumstances of this case, the Board, however, has considered Patent Owner’s arguments from its Preliminary Response during the deliberations and decision-making for this Final Written Decision. Oral argument was not requested by either party.

#### *B. Related Proceedings*

The parties inform us that no other related matters would affect or be affected by this proceeding. Pet. 59; *see* Paper 4 (Patent Owner’s Mandatory Notices), 2–3.

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<sup>2</sup> US Patent No. 8,031,052 B2 (filed Nov. 22, 2006) (“Polozola,” Ex. 1005).

<sup>3</sup> WO 2006/097775 A1 (filed July 21, 2005) (“Csabai,” Ex. 1007).

<sup>4</sup> US Pub. No. 2006/0180647 A1 (filed Feb. 11, 2005) (“Hansen,” Ex. 1008).

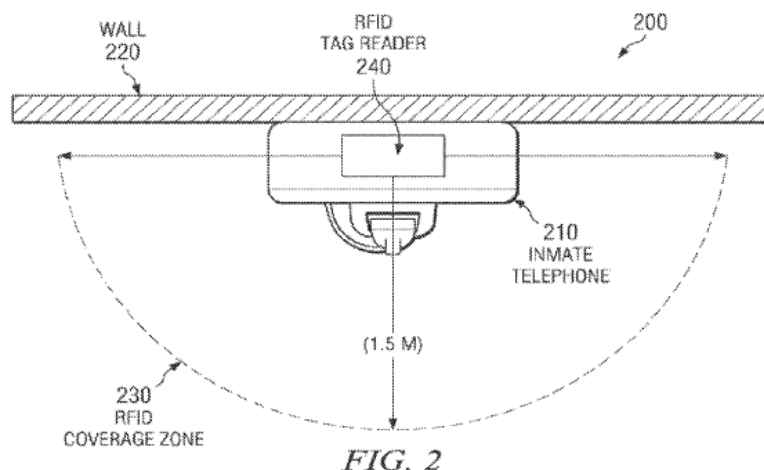
<sup>5</sup> US Patent No. 7,494,061 B2 (filed June 30, 2006) (“Reinhold,” Ex. 1006).

<sup>6</sup> The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. § 100 et seq. effective on March 16, 2013. The ’367 patent issued from an application filed before March 16, 2013, therefore, we apply the pre-AIA versions of the statutory bases for unpatentability.

*C. The '367 Patent*

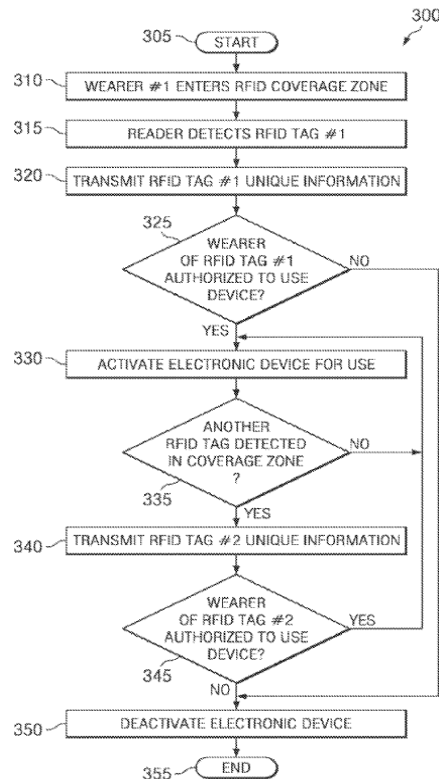
The '367 patent discloses “systems and methods for preventing unauthorized persons from using an electronic device within a facility.” Ex. 1001, Abst. The '367 patent teaches a radio frequency identification (RFID) system that identifies prison inmates within an RFID coverage zone during use of the telephone. The system determines whether the phone call can continue to proceed based on the proximity of one or more inmates to the telephone. *Id.* at 1:49–53, 2:16–20.

One embodiment of the '367 patent provides an RFID access system that includes RFID tags having unique identification information associated with wearers of the RFID tags. *Id.* at 2:39–41. The RFID tag “having unique identification information associated with a wearer of the RFID tag,” which may be contained in “a non-removable item worn by the wearer, such as a bracelet.” *Id.* at 2:40–43. RFID tags may be constructed such that they cannot be removed and are tamperproof. *Id.* at 5:26–28. The RFID system includes a reader having an RFID coverage zone for detecting RFID tags within the zone. *Id.* at 2:43–45. One embodiment of an RFID tag reader and RFID coverage zone is illustrated in Figure 2, reproduced below.



As shown above in Figure 2 of the '367 patent, system 200 includes inmate telephone 210, RFID coverage zone 230, and RFID tag reader 240. *Id.* at 5:36–38, Fig. 2. In this specific embodiment, RFID coverage zone 230 is generated around telephone 210 by RFID reader 240, which is integrated within telephone 210. *Id.* at 5:37–39.

Another embodiment of the '367 patent provides a call management system that connects the reader and determines whether wearers in the coverage zone are authorized to use the electronic device (*e.g.*, a telephone) based on a detected RFID tag's unique identification information. *Id.* at 2:45–50, 7:19–21, claim 1, Fig. 3. An example of a process by which an RFID-based access management system may be used to ensure only authorized persons use an electronic device in a facility is shown in Figure 3, reproduced below.



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