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 IPR2017-00758
Patent 8,515,031 B2
_____

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

TURNER, *Administrative Patent Judge*.

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

I.   INTRODUCTION

A. Background

Securus Technologies, Inc. ("Petitioner") filed a Petition (Paper 2, "Pet.") to institute an *inter partes* review of claims 1–20 of U.S. Patent No. 8,515,031 B2 (Ex. 1001, "the '031 Patent"). Global Tel*Link Corporation ("Patent Owner") filed a Preliminary Response (Paper 6, "Prelim. Resp.") thereto. 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." *See also* 37 C.F.R § 42.4(a) (delegating authority to the Board).

Upon consideration of the Petition, the Preliminary Response and both parties' evidence, we conclude Petitioner has not established a reasonable likelihood it would prevail with respect to at least one of the challenged claims. Accordingly, for the reasons that follow, we deny institution of an *inter partes* review.

B. Related Proceedings

Petitioner informs us that the '031 Patent is the subject of a patent infringement suit brought by Patent Owner captioned *Securus Techs., Inc. v. Global Tel*Link Corp.*, Case No. 3:16-cv-01338 (N.D. Tex.), upon which Patent Owner concurs. Pet. 1, Paper 5, 1. In addition, the parties list U.S. Patent Nos. 8,243,891 and 9,282,188, as being related, as well as related applications U.S. App. Nos. 14/626,781, 14/626,804, and 14/946,361. *Id*.

C. The '031 Patent

The '031 Patent is directed to a voice message exchange system and method for improving communication between an inmate and a third party

by enabling the inmate to leave a message when a call is not answered. Ex. 1001, Abstract. Third parties that receive the message can reply with a message, as well as other outside parties that meet the institution's requirements. *Id.* Figure 2 of the '031 Patent provides a flow chart of the preferred process of the disclosed voice message exchange system, and is reproduced below:
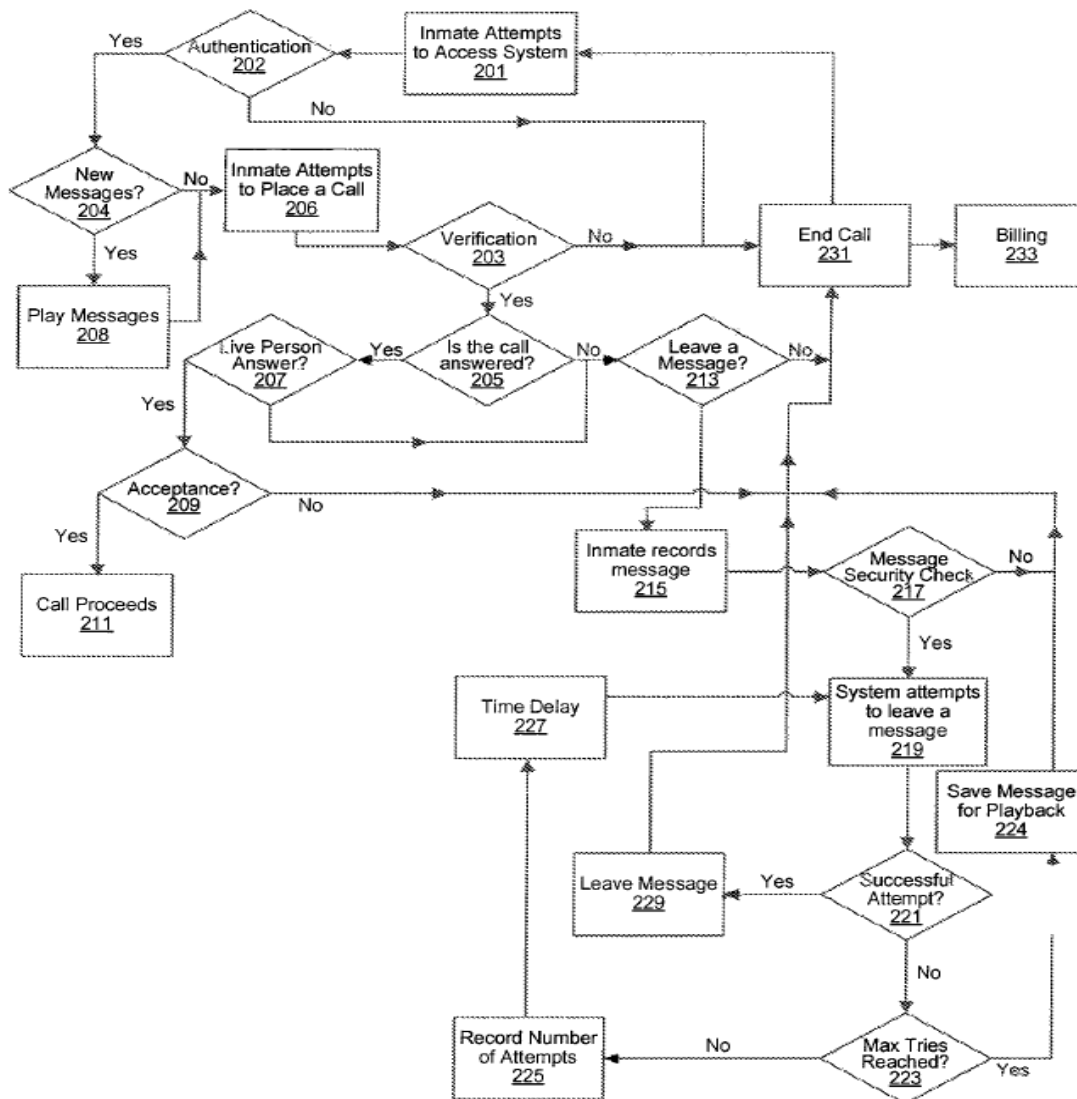

FIG. 2

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The identity of the inmate is authenticated at step 202, and the inmate dials the desired telephone number at step 206. *Id.* at 12:29–31, 40–42. The system verifies that the user is authorized to call the number that was dialed (step 203), and if authorized, the call is placed. *Id.* at 11:42–45. If "after a set number of rings the call remains unanswered," then the inmate may leave a message at step 213. *Id.* at 12:50–52. To leave the message, the inmate records a message (step 215) and the system then dials the desired number (step 219). *Id.* at 12:1–4; 13:16–18, 20–25.

If the system does not reach the calling party, then the call attempt is repeated periodically. *Id.* at 13:20–40. "[W]hen the call is answered by a live person," the recorded message is played (step 229), and the system bills for phone usage to an appropriate party, i.e., either the calling party or the called party (step 233). *Id.* at 13:25–30.

D. Illustrative Claim

As noted above, Petitioner challenges claims 1–20, with claims 1 and 11 being independent claims. Claims 1 is illustrative of the challenged claims and is reproduced below:

> 1. A computer implemented method for regulating unanswered phone calls placed by a registered user of a phone system serving a secured premises, comprising:
>
> verifying whether a unique access identifier provided by the registered user of the phone system is authorized to place *a phone call* to a destination associated with a phone number entered by the registered user;
>
> attempting to connect the phone call to an end user associated with the authorized destination for the phone number entered by the registered user;

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recording a message provided by the registered user of the phone system for the end user associated with the authorized destination for the phone number entered by the registered user *when an attempt to connect the phone call to the end user fails*;

storing the recorded message provided by the registered user in a site server located within a telecom platform that supports the secure premises;

dialing the phone number entered by the registered user based on periodic intervals *until the phone call is connected to the end user*;

playing the recorded message provided by the registered user that is retrieved from the site server for the end user when the phone call is connected to the end user; and

billing an account associated with the unique access identifier provided by the registered user when the recorded message provided by the registered user is played for the end user.

Ex. 1001, 14:56–15:16 (emphases added).

E. *The Asserted Grounds of Unpatentability*

Petitioner challenges the patentability of claims of the '031 Patent based on the following grounds under 35 U.S.C. § 103 (Pet. 4–5):

References	Basis	Claims Challenged
Falcone[1] and Hodge[2]	§ 103	1, 2, 7, 8, 11, 12, 17, and 18

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[1] U.S. Patent No. 7,561,680 B1 (filed Aug. 13, 2003) (issued Jul. 14, 2009) (Ex. 1004, "Falcone").
[2] U.S. Patent Publication No. 2004/0029564 A1 (filed Aug. 8, 2002) (published Feb. 12, 2004) (Ex. 1005, "Hodge").

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