

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GLOBAL TEL*LINK CORPORATION,
Petitioner,

v.

SECURUS TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2017-01437
Patent 7,916,845 B2

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

BENOIT, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review
35 U.S.C. § 314(a) and 37 C.F.R. § 42.108

I. INTRODUCTION

Global Tel*Link Corporation (“Petitioner”) filed a Petition for *inter partes* review of claims 1–41 of U.S. Patent No. 7,916,845 B2 (Ex. 1001, “the ’845 patent” or “the challenged patent”). Paper 2 (“Pet.”). Securus Technologies, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). Institution of an *inter partes* review is authorized by statute when “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a); *see* 37 C.F.R. § 42.108 (regarding institution of *inter partes* review); 37 C.F.R. § 42.4(a) (delegating authority to institute trial to the Board). Upon consideration of the Petition and the Preliminary Response, we conclude that the information presented shows that there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of at least one of the challenged claims of the ’845 patent.

A. Related Matters

The parties inform us that the challenged patent is the subject of a district court proceeding in the Northern District of Texas, captioned *Securus Technologies, Inc. v. Global Tel*Link Corp.*, No. 3:16-cv-01338-K (N.D. Tex.). Pet. 68; Paper 3, 2 (Patent Owner’s Mandatory Notices); *see* 37 C.F.R. § 42.8(b)(2) (requiring parties to identify “other judicial or administrative matter that would affect, or be affected by, a decision in the proceeding”).

B. The ’845 Patent

The ’845 patent is titled “Unauthorized Call Activity Detection and Prevention Systems and Methods for a Voice over Internet Protocol

Environment.” Ex. 1001, [54]. The patent issued on March 29, 2011 from an application filed on April 13, 2006. *Id.* at [45], [22]. Although the patent identifies and incorporates by reference other commonly owned applications, the patent does not include a claim to an earlier filing date. *Id.* at 1:6–25. The patent describes techniques that relate to detecting three-way calls in a Voice over Internet Protocol (“VoIP”) environment, particularly in a prison (or another type of controlled environment) that monitors and controls the use of telephones. *Id.* at 5:28–29, 6:23–26.

1. The Written Description

The ’845 patent explains that telephone systems at correctional facilities or other controlled-environment facilities purposefully prevent inmates or residents from contacting unauthorized parties. Ex. 1001, 1:40–46. The patent describes the problem that the inmate may call an authorized party and, then be “connected to a third party at an unauthorized number via the three-way call feature by a party at the authorized number.” *Id.* at 1:51–57. The challenged patent describes the process for connecting such a call:

A three-way call may be initiated when the originally called party (e.g. an authorized party outside the private telephone system) depresses the hook switch on the telephone, generating a hook flash signal. This signals the telephone central office to put the resident on hold and provide a dial tone to the originally called party. On receipt of the dial tone, the originally-called party dials the number of an unauthorized third party, and when the connection is completed, the resident and the unauthorized third party can communicate through the connection established outside the private system.

Id. at 2:1–11. One method of detecting a three-way call is to monitor the telephone signals of a call to detect a hook flash. *Id.* at 2:12–14. To do so,

the frequency bands used in the telephone signal may be monitored for “energies about a selected threshold.” *Id.* at 2:15–22.

The '845 patent describes particular problems that arise for detecting three-way calls in a VoIP environment. *Id.* at 5:28–29. One such problem is that “a packetized VoIP environment” may not pass a hook flash or silence that may be used to detect a three-way call. *Id.* at 5:32–34.

The patent further indicates that “when sound drops below some threshold level it is deemed to be silence and not transmitted.” *Id.* at 5:38–40. The patent continues by explaining that “VoIP data transmission bandwidth usage may be minimized through the use of Voice Activation Detection (VAD), or other methods. VAD allows a data network carrying voice traffic over the Internet to detect the absence of audio and conserve bandwidth by preventing the transmission of ‘silent packets’ over the network.” *Id.* at 5:40–46. “[S]ince conventional three-way call detection may analyze different ‘thresholds of silence’ to determine whether or not a caller is ‘away’ setting up a three-way call, conventional three-way call detection in VoIP calls is problematic.” *Id.* at 5:60–64.

Figure 1 of the challenged patent is set forth below:

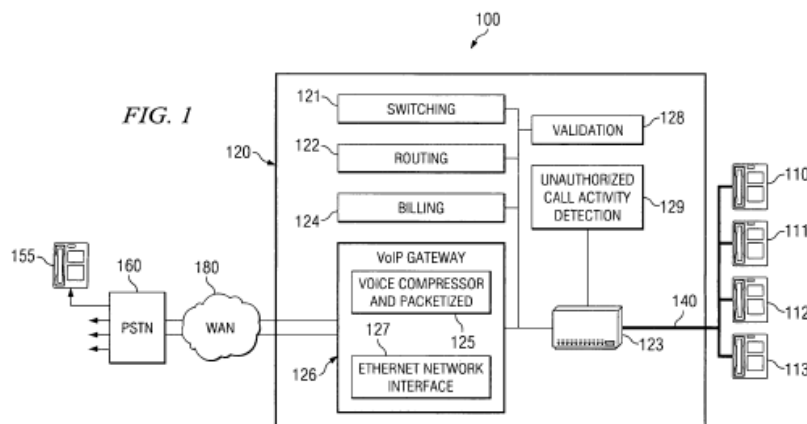


Figure 1 shows a telephone communication system 100 that includes telephone terminals 110–113 located at a prison or other controlled-environment facility. *Id.* at 6:18–26. Telephone terminals 110–113, which may be VoIP telephones or may be conventional analog telephones, are connected to “processor-based call processing system 120.” *Id.* at 6:40–41, 43–46, 62–63. “Line interface 123 provides interfacing between the signals native to terminals 110-113 and a processor or processors of call processing system 120.” *Id.* at 6:63–65.

VoIP gateway 126 provides voice connectivity via WAN 180, which may be any data network—such as an intranet, an extranet, the Internet, a public network, or a private network. *Id.* at 6:66–7:2. VoIP gateway 126 includes compressor and packetizer 125, which produces compressed data packets from the telephony signals. *Id.* at 7:21–24. “These packets are processed in [Ethernet] network interface 127” and sent over “WAN 180 to corresponding VoIP gateway” (not shown). *Id.* at 7:24–26. VoIP gateway 126 may also decompress and depacketize incoming VoIP data packets to provide telephony signals to terminals 110–113. *Id.* at 7:25–30.

The patent explains that a corresponding VoIP gateway may be “disposed at an edge of WAN 180 and coupled to PSTN 160, or otherwise associated with WAN 180 and/or PSTN 160.” *Id.* at 7:12–15. This VoIP gateway receives, decompresses, depacketizes, and distributes the telephone signals to a public switch of PSTN 160. *Id.* at 7:26–28. In this way, telephone terminal 155 connected to PSTN 160 may be connected with telephone 110. *Id.* at 7:10–14.

The call processing system 120 also includes “unauthorized call activity detection control block” 129 that provides “real-time intelligence”

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