

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

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Case CBM2017-00034  
U.S. Patent 7,783,021 B2

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**PATENT OWNER'S PRELIMINARY RESPONSE**

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### **EXHIBIT LIST**

<b>Exhibit No.</b>	<b>Description</b>
<b>2001</b>	Complaint for Patent Infringement, <i>Global Tel*Link Corporation v. Securus Technologies, Inc.</i> , Civil Action No. 3:13-cv-00713-JRS (VAED), filed October 21, 2013.
<b>2002</b>	Proof of Service, <i>Global Tel*Link Corporation v. Securus Technologies, Inc.</i> , Civil Action No. 3:13-cv-00713-JRS (VAED), October 25, 2013.
<b>2003</b>	Petition for <i>Inter Partes</i> Review of U.S. Patent No. 7,783,021, <i>Securus Technologies, Inc. v. Global Tel*Link Corporation</i> , Case No. IPR2015-00153 (P.T.A.B.), filed October 24, 2014.
<b>2004</b>	Patent Owner's Preliminary Response, <i>Securus Technologies, Inc. v. Global Tel*Link Corporation</i> , Case No. IPR2015-00153 (P.T.A.B.), filed February 5, 2015.
<b>2005</b>	Decision Denying Institution of <i>Inter Partes</i> Review, <i>Securus Technologies, Inc. v. Global Tel*Link Corporation</i> , Case No. IPR2015-00153 (P.T.A.B.), issued May 1, 2015.
<b>2006</b>	Order, <i>Global Tel*Link Corporation v. Securus Technologies, Inc.</i> , Civil Action No. 3:14-cv-00829-K (TXND), issued August 17, 2015.
<b>2007</b>	Patent Owner's Preliminary Response, <i>Global Tel*Link Corporation v. Securus Technologies, Inc.</i> , Case No. IPR2014-00785 (P.T.A.B.), filed August 29, 2014.
<b>2008</b>	Patent Owner's Preliminary Response, <i>Global Tel*Link Corporation v. Securus Technologies, Inc.</i> , Case No. IPR2014-00825 (P.T.A.B.), filed September 9, 2014.
<b>2009</b>	U.S. Patent Application Publication No. 2007/0041545 A1 to Gainsboro, published February 22, 2007.

<b>2010</b>	“Class 370, Multiplex Communications,” U.S.P.T.O. Patent Classification Definitions, January 2011.
<b>2011</b>	Definition of “analogous”, Oxford Dictionaries, accessible at <a href="https://en.oxforddictionaries.com/definition/analogous">https://en.oxforddictionaries.com/definition/analogous</a> [last accessed March 14, 2017].

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## **I. Introduction**

The Board should not institute covered business method (“CBM”) review of claims 1-23 of U.S. Patent No. 7,783,021 (Exhibit 1001) (“’021 patent”). The instant Petition (Paper 2) is a follow-on petition that presents challenges only under 35 U.S.C. § 103, and would typically be filed as an *Inter Partes* Review (“IPR”) petition. However, the instant Petition has been filed as a CBM petition, presumably to circumvent 35 U.S.C. § 315(b)’s prohibitions that prevent Securus from filing an IPR petition. Nonetheless, despite this attempted end-around, three independent grounds for denial exist.

First, the Board should deny the Petition under 35 U.S.C. § 325(d). All eight *Blue Coat* factors favor denial. The Petition does not address any of the *Blue Coat* factors. Nor does the Petition even disclose that Securus filed an unsuccessful IPR petition that challenged the ’021 patent claims on October 24, 2014—more than *thirty months ago*.

Second, the Board should deny the Petition because the ’021 patent is not eligible for CBM review. The Petition fails to demonstrate that billing for telecommunication services is a financial product or service, as opposed to being an incidental or complementary activity to receiving telecommunication services. The Petition also fails to demonstrate that the ’021 patent is not a technological invention. The ’021 patent provides a technical solution to a technical problem by

combining in a novel, non-obvious manner hardware and sophisticated software that solves technical problems associated with controlling and monitoring without detection usage of an institutional telephone system.

Third, the Board should deny the Petition because it fails to demonstrate how the applied references render obvious any of the '021 patent claims. The Petition presents muddled positions that are largely incomprehensible and fails to show how features of the references map to elements of the '021 patent claims. The Petition also does not provide a sufficient motivation to combine the references, fails to address numerous elements of the claims, and impermissibly incorporates large portions of the Akl declaration (Exhibit 1002). In sum, the Petition is fatally flawed and should be denied.

## **II. The Board should deny the Petition under § 325(d).**

The Board should exercise its discretion under 35 U.S.C. § 325(d) to deny the Petition. The Board considers the following factors (“*Blue Coat* factors”) when deciding whether to exercise its discretion not to institute review:

- (1) the finite resources of the Board;
- (2) the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than one year after the date on which the Director notices institution of review;
- (3) whether the same petitioner previously filed a petition directed to the same claims of the same patent;

- (4) whether, at the time of filing the earlier petition, the petitioner knew of the prior art asserted in the later petition or should have known of it;
- (5) whether, at the time of filing the later petition, the petitioner had already received the patent owner's preliminary response to the earlier petition or received the Board's decision on whether to institute review in the earlier petition;
- (6) the length of time that elapsed between the time the petitioner learned of the prior art asserted in the later petition and the filing of the later petition;
- (7) whether the petitioner provides adequate explanation for the time elapsed between the filing dates of multiple petitions directed to the same claims of the same patent; and
- (8) whether the same or substantially the same prior art arguments previously were presented to the Office.

*Blue Coat Sys., Inc., v. Finjan, Inc.*, IPR2016-01441, Paper 14 at 8-9 (P.T.A.B. Jan. 23, 2017); *see also LG Electronics Inc. v. Core Wireless Licensing S.A.R.L.*, IPR2016-00986, Paper 12 at 6-7 (P.T.A.B. Aug. 22, 2016); *NVIDIA Corp. v. Samsung Electronics Co., Ltd.*, IPR2016-00134, Paper 9 at 6-7 (P.T.A.B. May 4, 2016); *Xactware Solutions, Inc. v. Eagle View Technologies, Inc.*, IPR2017-00034, Paper 9 at 7-11 (P.T.A.B. Apr. 13, 2017); *Akamai Tech's, Inc. v. Limelight*

*Networks, Inc.*, IPR2017-00358, Paper 9 at 8-9 (P.T.A.B. May 2, 2017).<sup>1</sup> “[N]ot all factors need be present, and [the Board] need not give equal weight to each factor in reaching [its] decision.” *Blue Coat*, IPR2016-01441, Paper 14 at 10.

The *Blue Coat* factors weigh heavily in favor of denying institution. More than three years ago, GTL sued Securus for infringing the ’021 patent. (Exhibit 2001.) Nearly twelve months later and twenty-seven months before the filing of the instant Petition, Securus filed an IPR petition (“’153 Petition”) against the ’021 patent. (Exhibit 2003.) The Board denied institution of the ’153 Petition on May 1, 2015. (Exhibit 2005 at 5.)

Securus now seeks to circumvent the 35 U.S.C. § 315(b) prohibitions preventing it from filing an additional IPR by filing the present CBM Petition using references that were known to Securus well before it filed the ’153 Petition.

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<sup>1</sup> Each of these cases consider similar factors and tests to evaluate whether a subsequent petition for P.T.A.B. review of a patent should be denied. The *Blue Coat* decision appears to provide the most comprehensive set of factors, and therefore GTL applies the *Blue Coat* factor analysis. However, GTL believes that under any of the factor tests of these cases, the present Petition should be denied. GTL also notes that decisions outlining these factors, such as *LG Electronics*, IPR2016-00986, Paper 12 (dated August 22, 2016), issued well before Securus filed the instant Petition.

And, Securus inappropriately uses information gained from the underlying litigation and previously denied IPR petition to shape its arguments. Furthermore, Securus does not address the *Blue Coat* factors, nor does it mention the previously denied IPR petition. Under such circumstances, the Board should deny the present, follow-on Petition.

**A. *Blue Coat* factors (1) and (2) favor denial: the Board’s finite resources should be expended on initial petitions, not follow-on petitions.**

Factors (1) and (2) weigh in favor of denying institution. In general, “[t]he Board’s resources would be more fairly expended on initial petitions, rather than on follow-on petitions, such as the Petition in this case.” *Alarm.com Inc. v. Vivint, Inc.*, IPR2016-01091, Paper 11 at 13 (P.T.A.B. Nov. 23, 2016). And, the Board must manage its limited resources to meet the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than one year after the date on which the Director notices institution of review. When deciding whether to institute follow-on petitions, the “relevant question is whether that additional expenditure is a worthwhile use of limited Board resources, a question which can be answered, for example, by evaluating the other factors.” *Great W. Cas. Co. v. Intellectual Ventures II LLC*, IPR2016-01534, Paper 13 at 24-25 (P.T.A.B. Feb. 15, 2017). Here, the answer is no. As discussed in more detail below, factors (3)-(8)

weigh *heavily* in favor of denying Securus' follow-on Petition. Securus provides no argument or evidence to the contrary.

**B. *Blue Coat* factor (3) favors denial: Securus previously filed an unsuccessful IPR petition against the '021 patent; now, it improperly seeks to exploit CBM review to circumvent § 315(b) and to delay the underlying litigation.**

Factor (3) weighs *heavily* in favor of denying institution. Securus previously filed an unsuccessful IPR petition that challenged the same claims (*i.e.*, claims 1-23) of the '021 patent in *Securus Tech's, Inc. v. Global Tel\*Link Corp.*, IPR2015-00153. (Exhibit 2003) ("153 Petition"). But the underlying dispute began about one year before Securus filed the '153 Petition.

On October 21, 2013, GTL filed a complaint in the District Court for the Eastern District of Virginia alleging that Securus infringes the '021 patent. (Exhibit 2001.)<sup>2</sup> The complaint was served on Securus on October 25, 2013 (Exhibit 2002), setting the one-year period for Securus to file an IPR petition against the '021 patent to expire on October 25, 2014. 35 U.S.C. § 315(b) (prohibiting institution of an IPR petition that "is filed more than 1 year after the date on which the petitioner . . . is served with a complaint alleging infringement of the patent").

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<sup>2</sup> On March 5, 2014, the U.S. District Court for the Eastern District of Virginia transferred the case to the Northern District of Texas. *See Global Tel\*Link Corp. v. Securus Technologies, Inc.*, No. 3:14-cv-00829-K (N.D. Tex.)

Although AIA trials have been available since 2012, Securus waited until October 24, 2014—one day before the § 315(b)'s one-year period was set to expire—to file the '153 Petition. (Exhibit 2003 at 56.) Securus knew or should have known that if the '153 Petition was denied, it would be time-barred from filing another IPR petition at a later date. Nevertheless, Securus decided to wait until the 11th hour to file the '153 Petition, and decided to advance only a single ground of invalidity. (Exhibit 2003 at 9.)

Even though Securus knew of or should have known of at least two of the four references it asserts in its follow-on Petition, as discussed below, the '153 Petition alleged that the '021 patent claims are anticipated by U.S. 7,881,446 to Apple. (*Id.*) GTL and the Board disagreed. On February 5, 2015, GTL filed a POPR explaining that Apple did not qualify as prior art. (Exhibit 2004 at 7-17.) And on May 1, 2015, the Board denied institution of the '153 Petition because Securus failed to demonstrate that Apple qualified as prior art. (Exhibit 2005 at 5-8.) Notably, Securus did not request rehearing of the Board's decision denying institution.

Fast forward more than two years since it filed the '153 Petition, Securus now attempts to exploit the CBM review program as a vehicle to circumvent 35 U.S.C. § 315(b)'s one-year statutory bar. Significantly, Securus' follow-on Petition challenges the '021 patent claims only under § 103; not under § 101 or

§ 112. (Petition at 4-5.) This demonstrates that Securus is merely using the CBM review program because it is barred from seeking further IPR review. The Federal Circuit recently explained that Congress did not intend the CBM review program to be used in this manner:

Congress carefully set out limits on the *inter partes* review (“IPR”) program for review of patents after issuance. Persons sued for infringement had no more than one year to petition for IPR, and were restricted to presenting only certain §§ 102 and 103 grounds of unpatentability, thus excluding grounds based on, for example, § 101 or § 112. It is not sensible to read AIA § 18(d)(1) as obliterating these important limits for review. . . .

*Secure Access, LLC, v. PNC Nat’l Bank Ass’n*, Appeal No. 2016-1353, slip op. at 15 (Fed. Cir. Feb. 21, 2017).

Securus’s use of the CBM review program will likely (and improperly) cause further delay in the underlying litigation, which is stayed pending the outcome of IPRs that Securus filed against the two other GTL patents involved in the litigation. (Exhibit 2006.) In each of those proceedings, at least some claims that are asserted from each patent in the litigation survived the IPRs. (*See* IPR2015-00155 and IPR2015-00156.) The oral hearings in the Federal Circuit appeals of those proceedings are set for June 7, 2017. Thus, the patentability of claims of those patents will likely be finally determined well before a final disposition in the present case (should institution occur).

In short, Securus made the strategic decisions—more than two years ago—to wait until the 11th hour to file the '153 Petition and to advance only a single ground of invalidity based on Apple. Securus chose the timing and the reference of its previous challenge, which was unsuccessful. The Board should not permit Securus to use the CBM review program as a surrogate for IPR review—a program that Securus is now barred from using to challenge the '021 patent. Nor should the Board permit Securus to use the CBM review program to inject further delay into the underlying litigation.

Compounding the case for denial, Securus knew of or should have known of at least two of the four references it asserts in the instant Petition—Gainsboro and Cree—before it filed the '153 Petition.

**C. *Blue Coat* factor (4) favors denial: Securus knew of or should have known of Gainsboro and Cree before it filed the '153 Petition, and fails to explain why Joseph and Kung were not available to it at that time.**

Factor (4) also weighs *heavily* in favor of denying institution. The instant Petition's obviousness challenges rely on four references: Gainsboro, Kung, Cree, and Joseph. (Petition at 4-5.) Gainsboro is the primary reference. (*Id.*) Securus knew of or should have known of at least Gainsboro and Cree before it filed the '153 Petition. And, Securus presents “no argument or evidence that [Kung and Joseph] were not known or available to it at the time of filing” the '153 Petition.

*Unilever, Inc. v. Proctor & Gamble Co.*, IPR2014-00506, Paper 17 at 6 (P.T.A.B. Jul. 7, 2014) (informative).

Securus knew of or should have known of Gainsboro before it filed the '153 Petition because the '021 patent lists Gainsboro on its front page. ('021 patent, (56).) At the very least, this listing put Securus on notice of Gainsboro before it challenged the '021 patent in the '153 Petition. And, Gainsboro is a continuation of and thus cumulative with U.S. Patent No. 5,655,013 (Gainsboro, (63)), which Securus knew of before it filed the '153 Petition. On August 29, 2014, about two months before it filed the '153 Petition, Securus filed a POPR that discussed U.S. Patent No. 5,655,013 in *Global Tel\*Link Corp. v. Securus Tech's, Inc.*, IPR2014-00785. (Exhibit 2007 at 11.) *See also Akamai*, IPR2017-00358, Paper 9 at 9-10 (finding that petitioner knew of the Devanneaux reference under similar circumstances). Further, the '021 patent lists U.S. Patent No. 5,655,013 on its front page. ('021 patent, (56).)

Securus also knew of Cree before it filed the '153 Petition. On September 9, 2014, more than one month before it filed the '153 Petition, Securus filed a POPR that discussed Cree in *Global Tel\*Link Corp. v. Securus Tech's, Inc.*, IPR2014-00825. (Exhibit 2008 at 11-12.) *See also Akamai*, IPR2017-00358, Paper 9 at 9-10.

Securus does not (and cannot) assert that it was unaware of Gainsboro and Cree when it filed the '153 Petition. Nor does it assert that Kung and Joseph “were

not known or available to it at the time of filing” the ’153 Petition. *Unilever*, IPR2014-00506, Paper 17 at 6; *see also LG Electronics*, IPR2016-00986, Paper 12 at 11 (“Petitioner does not indicate when or how it first became aware of Byers and Rochkind, and does not represent that either Byers or Rochkind reasonably was unavailable to Petitioner at the time of filing of its first petition.”). Nor does Securus assert that it could not have found Kung or Joseph exercising reasonable diligence. Indeed, Kung is classified in the same class as Gainsboro and Cree, *i.e.*, class 379. (Gainsboro, (52); Kung, (52); Cree, (52).) And Joseph is classified in the related class 370. (Joseph at (52); Exhibit 2010 at 1 (Section II, subsection B).)

These facts indicate that Securus knew of, should have known of, or could have found all of the references it now asserts *before* it filed the ’153 Petition. Under these circumstances, permitting Securus’ serial attack is unjust:

[T]he potential inequity based on a petitioner’s filing of serial and similar attacks against the same claims of the same patent, while having the opportunity to adjust litigation positions along the way . . . is real and cannot be ignored. That is especially so if petitioner, at the time of the filing of the earlier petition was aware or should have been aware of the prior art references newly cited and applied in the later petition.

*Great W. Cas. Co.*, IPR2016-01534, Paper 13 at 23.

Additionally, Securus had also received GTL’s POPR in IPR2015-00153, the Board’s decision denying the ’153 Petition, and certain GTL litigation

positions long before it filed the instant Petition. Securus' access to this critical information before filing its follow-on Petition compounds the inequity of this serial attack.

**D. *Blue Coat* factor (5) favors denial: Securus received GTL's POPR, the Board's decision denying the '153 Petition, and certain GTL litigation positions long before it filed the instant Petition.**

Compounding on factors (3) and (4), factor (5) also weighs *heavily* in favor of denying institution. Securus received GTL's POPR in IPR2015-00153 about two years before it filed the instant Petition, and it received the Board's decision denying the '153 Petition about 20 months before it filed the instant Petition. (Exhibit 2003 at 56 (Securus filed the '153 Petition on October 25, 2014); Exhibit 2004 at 27 (GTL filed its POPR in IPR2015-00153 on February 5, 2015); Exhibit 2005 at 1 (the Board issued its decision denying the '153 Petition on May 1, 2015).) And again, the instant Petition fails to mention IPR2015-00153.

So not only does Securus conceal its previous, unsuccessful attempt to invalidate the '021 patent, it unjustly applies what it learned from IPR2015-00153 *and* the underlying litigation in its follow-on attack. For example, Securus adjusts its invalidity positions (*i.e.*, asserting a different statutory ground of invalidity and different references) in response to the Board's decision denying the '153 Petition. (*Compare* Exhibit 2003 at 3, *with*, Petition at 4-5.)

Securus also adjusts its claim construction position in response to GTL's POPR in IPR2015-00153 and to GTL's July 2015 Supplemental Claim Construction Brief. (*Compare* Exhibit 2003 at 8 (no claims construed), *with*, Petition at 9-14 (construing certain terms and citing GTL's Supplemental Claim Construction Brief, Exhibit 1005).) The '153 Petition did not propose any constructions. (Exhibit 2003 at 8.) Indeed, in its POPR in IPR2015-00153, GTL argued that the '153 Petition "fails to construe claim terms that Securus asserts invoke § 112, ¶ 6" in violation of 37 C.F.R. § 42.104(b)(3). (Exhibit 2004 at 4-7.) Taking its cues from GTL's previous arguments, the instant Petition proposes claim constructions for certain terms, including constructions under § 112, ¶ 6. (Petition at 9-14.) Securus provides no explanation for this about-face, but all signs indicate that Securus modified its positions in response to GTL's previous filings.

In sum, Securus received a wealth of information *after* it filed the '153 Petition and took no action for over two years. *See also Akamai*, IPR2017-00358, Paper 9 at 10-11 (finding that a petitioner that had a preliminary response for four months and institution decision for one month had "ample time to take advantage of those materials in crafting its arguments" in a follow-on petition). Securus now seeks to use it as a blueprint to cure the deficiencies of its previous attack. But "[a] decision to institute review . . . should not act as an entry ticket, and a how-to guide, for the same Petitioner who . . . is outside of the one-year statutory period,

for filing a second petition to challenge those claims which it unsuccessfully challenged in the first petition.” *ZTE Corp. v. ContentGuard Holdings, Inc.*, IPR2013-00454, Paper 12 at 6 (P.T.A.B. Sep. 25, 2013) (informative); *see also Xactware Solutions*, IPR2017-00034, Paper 9 at 7 fn.5 (“We view the more relevant delay to be that between when Petitioner had the First Petition feedback, and the filing of the Second Petition. That delay affords Petitioner the unfair advantage of adjusting its litigation positions based on the Patent Owner’s and the Board’s responses to the First Petition.”).

**E. *Blue Coat* factor (6) favors denial: More than 27 months have elapsed between Securus learning of Gainsboro and Cree and Securus filing the instant Petition.**

Factor (6) builds on factor (4) and also weighs *heavily* in favor of denying institution. As explained above, Securus knew of or should have known of at least Gainsboro and Cree before it filed the ’153 Petition, *i.e.*, more than 27 months before it filed the instant Petition. *See NVIDIA*, IPR2016-00134, Paper 9 at 11-12 (denying institution under § 325(d) when the time elapsed between petitioner learning of the asserted reference and filing the follow-on petition was about five months). And, Securus presents “no argument or evidence that [Kung and Joseph] were not known or available to it at the time of filing” the ’153 Petition. *Unilever*, IPR2014-00506, Paper 17 at 6.

**F. *Blue Coat* factor (7) favors denial: Securus provides no explanation for the 27 months that elapsed between filing the '153 Petition and the instant Petition.**

Factor (7) also weighs *heavily* in favor of denying institution. Securus provides no explanation for the 27 months—from October 24, 2014, to January 27, 2017—that have elapsed between its filing of the '153 Petition and the instant Petition. (Exhibit 2003 at 56; Petition at 92.) Nor does Securus account for the fact that, before it filed the '153 Petition, it knew of or should have known of references that are essential to its current challenge. In fact, the instant Petition does not even mention the IPR2013-00153 or the '153 Petition.

Securus' silence should be fatal to the instant Petition. Securus carries “the burden . . . to justify institution in view of [the § 325(d)] factors, because petitioner cannot expect automatic institution on multiple petitions submitted for consideration, especially if they are against the same claims of the same patent.” *Great W. Cas. Co.*, IPR2016-01534, Paper 13 at 24; *see also Butamax Advanced Biofuels LLC v. Gevo, Inc.*, IPR2014-00581, Paper 8 at 13 (P.T.A.B. Oct. 14, 2014) (“Allowing similar, serial challenges to the same patent, by the same petitioner, risks harassment of patent owners and frustration of Congress’s intent in enacting the Leahy-Smith America Invents Act.”). In this case, Securus has not analyzed any of the § 325(d) factors or made any attempt to justify institution.

**G. *Blue Coat* factor (8) favors denial: The Office asserted Gainsboro’s child application in the first Office Action and considered Gainsboro during original prosecution, which the instant Petition fails to mention.**

Finally, factor (8) also weighs in favor of denying the instant Petition. In the first Office Action during original prosecution of the ’021 patent, the Examiner rejected the then-pending claims as allegedly obvious using U.S. Pub. No. 2007/0041545 as the primary reference. (Exhibit 1004 at 146-47.) U.S. Pub. No. 2007/0041545 is a continuation-in-part of Gainsboro. (Exhibit 2009 at (63).) U.S. Pub. No. 2007/0041545 is a 106-page publication that is generally directed to the same topic and is in the same patent family as Gainsboro. (*See, e.g., id.* at ¶2 (“The present invention relates generally to the fields of telecommunications and penal institution management.”).) And, on the same day that the Examiner issued the first Office Action, he considered Gainsboro and several other Gainsboro patents that were cited by the applicant. (Exhibit 1004 at 153.)

The instant Petition fails to mention in its section “Summary of the Relevant Prosecution File History” that the Office asserted Gainsboro’s child during original prosecution. (*See* Petition at 6-8.) Nor does the instant Petition acknowledge the applicant cited and the Examiner considered Gainsboro before issuing the first Office Action. (*See id.*) Again, Securus’ silence cuts against institution.

\* \* \*

In sum, the *Blue Coat* factors weigh *heavily* in favor of denying the instant Petition. Securus presents no argument or evidence as counterweight. “These facts suggest this is a case of undesirable incremental-petitioning, where a petitioner relies on a Board decision in a prior proceeding involving the same parties, the same patent, and the same claim[s], to mount a second attack against [the claims] after an unsuccessful first attack . . . .” *LG Electronics*, IPR2016-00986, Paper 12 at 11. Thus, the Board should exercise its discretion and deny the instant Petition under § 325(d).

### **III. Overview of the ’021 patent**

The ’021 patent is generally directed to a telecommunications call management system that can be used in a penal institution, among other places. (’021 patent, title; 1:6-12.) The disclosed system “allow[s] an institution to control, record, monitor, and report usage and access to a telephone network.” (*Id.* at 1:8-12.) In one disclosed embodiment, the system allows an investigator to covertly monitor an inmate’s conversation for suspicious activity. (*Id.* at 17:15-33 (“without detection”); *see also id.* at independent claims 1, 7, 16, and 20.)

### **IV. The ’021 patent is not eligible for CBM review.**

The ’021 patent is not eligible for CBM review because the Petition fails to establish that the ’021 patent is a CBM patent. A “covered business method” patent is a patent that “claims a method or corresponding apparatus for performing data

processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions.” AIA § 18(d)(1).

The Federal Circuit recently clarified the test for determining whether a patent claims a covered business method in *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 1376 (Fed. Cir. 2016). *See also Secure Axxess, LLC v. PNC Bank National Ass’n*, Appeal No. 2016-1353 (Fed. Cir. Feb. 21, 2017). A patent that merely claims activities incidental to or complementary to a financial activity is not a covered business method patent. *Unwired*, 841 F.3d at 1382. The Court emphasized that “it is not enough that a sale has occurred or may occur” to confer CBM jurisdiction. *Id.* Indeed, “[a]ll patents, at some level, relate to potential sale of a good or service.” *Id.*

In this case, the Petition fails to demonstrate that the claimed “billing” for the use of a telephone system is a financial service, as opposed to an incidental or complementary activity to the telecommunication service. And, the ’021 patent claims a technological invention. Thus, it is not eligible for CBM review.

**A. Billing for the use of a telephone system is not a financial service; at best, it is merely an incidental or a complementary activity to the telecommunication service.**

The Petition fails to establish that the ’021 patent is a CBM patent. It does not allege that the ’021 patent claims a financial product. Rather, it asserts that the

claimed “billing” constitutes a financial service. (Petition, 15-16.) But the Petition fails to explain why billing for the use of a telephone system is a financial service. Securus bears the burden of demonstrating that the ’021 patent is a covered business method patent. 37 C.F.R. § 42.304(a). It fails to do so.

And billing for use of a telephone system is not a financial service that confers CBM jurisdiction. As the Federal Circuit stated, “it is not enough that a sale has occurred or may occur.” *Unwired*, 841 F.3d at 1382. At best, billing for use of a telephone system is merely an incidental or a complementary activity for receipt of telecommunication services. The Petition fails to demonstrate otherwise.

The Petition alleges that “statements in the specification” demonstrate that the ’021 patent is a CMB patent. (Petition at 16-17.) This approach was soundly rejected by the *Unwired* court. “CBM patents are limited to those *with claims* that are directed to methods and apparatuses of particular types and with particular uses ‘in the practice, administration, or management of a financial product or service.’” *Unwired*, 841 F.3d at 1382 (emphasis added). Indeed, even if “the specification speculates . . . a potential sale might occur,” that is not enough to render a patent a covered business method patent eligible for review. *Id.*

The Petition also alleges that “a person of ordinary skill [would have understood] that each user, as a calling or called party, is a ‘customer’ of the institution.” (Petition at 17.) This argument also fails. First, the claims do not recite

the term “customer.” And, even if they did, that would not be enough to confer CBM jurisdiction. *Google Inc. v. HBAC Matchmaker Media, Inc.*, CBM2016-00097, Paper 16 at 21 (P.T.A.B. Feb. 27, 2017).

Because the Petition fails to explain why billing for the use of a telephone system is a financial service, as opposed to an incidental or complementary activity to the telecommunication service, the Petition fails to demonstrate that the ’021 patent is a CBM patent.

**B. The ’021 patent claims a technological invention.**

The ’021 patent claims a technological invention. A patent claims a technological invention if “the claimed subject matter as a whole recites a technological feature that is novel and unobvious over the prior art; and solves a technical problem using a technical solution.” 37 C.F.R. § 42.301(b). The ’021 patent satisfies both prongs of this test.

First, the ’021 patent’s “claimed subject matter as a whole recites a technological feature that is novel and unobvious over the prior art.” *Id.* For example, each of the independent claims includes “an administrative workstation” that monitors conversations or connects to a call “without detection.” As discussed below, the Petition fails to demonstrate that Gainsboro’s live or passive call monitoring discloses, teaches, suggests, or otherwise renders obvious this element.

And, this technological feature is not the mere recitation of known computer hardware or software, as the Petition alleges. (Petition at 19.) Rather, the '021 patent explains that this feature is the combination of hardware and inventive software that can identify and prevent abuses of the telephone system. ('021 patent, 17:15-21.) The inventive software “provides a means for patching into a call using circuitry *without alerting the user or called party to the operator’s presence.*” (*Id.* at 17:18-21 (emphasis added).) Again, the Petition, which relies on Gainsboro to disclose the claimed “administrative workstation,” fails to demonstrate that this technological feature was known or obvious.

Second, the '021 patent claims “solve[] a technical problem using a technical solution.” 37 C.F.R. § 42.301(b). The '021 patent identifies a technical problem as “the need to monitor, control, record and provide detailed records of the usage of a telephone system in a controlled institutional environment,” such as a penal institution. ('021 patent, 1:15-23.) It describes a variety of ways in which inmates circumvent known monitoring and control mechanisms, such as gaining unauthorized access to another inmate’s PIN. (*Id.* at 2:55-3:8.) It also describes a variety of ways that inmates abuse the telephone system, such as using it to harass individuals related to their incarceration and using it to plan criminal activities. (*Id.* at 3:20-46.) The technical solution, which is recited in different forms in the independent claims, is an inventive combination of hardware and novel software

that can monitor, control, and/or record usage of the telephone system. (*See id.* at claims 1, 7, 16, and 20.)

\* \* \*

In sum, the Petition fails to establish that the '021 patent is a CBM patent. And, the '021 patent claims a technological invention. Thus, it is not eligible for CBM review.

**V. Claims 1-23 are not obvious.**

The Petition fails to demonstrate that claims 1-23 are more likely than not obvious for at least at least four reasons: *First*, the Petition fails to articulate its obviousness challenge with sufficient clarity. *Second*, the Petition fails to demonstrate that Gainsboro teaches or suggests an “administrative workstation” that monitors conversations or connects to a call “without detection,” as recited in each independent claim. *Third*, the Petition fails to demonstrate that element 1H (the claimed “routing means”) is obvious over Gainsboro and Kung. And *fourth*, the Petition fails to address elements 7G and 7E.

**A. The Petition fails to articulate its obviousness challenges with sufficient clarity.**

The Petition fails to articulate its obviousness challenges with sufficient clarity. A CBM petition must “identif[y], *in writing and with particularity*, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C.

§ 322(a)(3) (emphasis added). It must also “specify where *each element of the claim* is found in the prior art.” 37 C.F.R. § 42.304(b)(4) (emphasis added).

The Petition fails to satisfy these requirements. *See Intelligent Bio-Systems, Inc. v. Illumnia Cambridge, Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (“It is of the utmost importance that petitioners . . . adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’”). First, the Petition fails to provide a clear mapping of the claim elements to the asserted references. Second, it fails to address all of the elements of independent claims 7, 16, and 20. Third, it impermissibly incorporates by reference large portions of Dr. Akl’s declaration. And finally, the Petition’s alleged motivations to combine are unclear because it fails to first determine the scope and content of the asserted references.

Because of these deficiencies, Securus improperly shifts the burden to the Board and Patent Owner to sift through the Petition and accompanying evidence to piece together Securus’ flawed arguments. The Board should not undertake this task. *DeSilva v. DiLeonardi*, 181 F.3d 865, 866-67 (7th Cir. 1999) (“A brief must make all arguments accessible to the judges, rather than ask them to play archaeologist with the record.”); *United States v. Dunkel*, 927 F.2d 955, 956 (7th Cir. 1991) (per curiam) (“Judges are not like pigs, hunting for truffles buried in briefs”). Rather, it should deny the Petition.

**1. The Petition fails to provide a clear mapping of the claim elements to the asserted references.**

The Petition's obviousness challenges fail because the Petition does not provide a clear mapping of the claim elements to the asserted references. In some cases, the Petition maps *different* features of an asserted reference to the *same* claim element; in other cases, it maps the *same* feature of an asserted reference to *different* claim elements. As a result, the Petition's obviousness analysis is a moving target that fails to "specify where each element of the claim is found in the prior art." 37 C.F.R. § 42.304(b)(4).

The Petition's analysis of claim 1's "administrative workstation" and "central platform" is a poignant example. The Petition asserts that Gainsboro discloses these elements of claim 1. (Petition at 33; 38-40; 45-47.) Within the same subsection of the Petition, the Petition maps each of Gainsboro's CCU, TMU, and administrative terminals to claim 1's "administrative workstation." (*Id.* at 45-47.) On page 45, it suggests "us[ing] Gainsboro's CCU or TMU as an 'administrative workstation.'" On page 46, it suggests that Gainsboro's "CCU or administrative terminals [labeled 5a and 5b in Figure 1 of Gainsboro] would have been utilized . . . as an administrative workstation." And then on page 47, the Petition suggests "tap[ping] into the conversation via line 41a" of Figure 4 of Gainsboro, which depicts Gainsboro's TMU. (Gainsboro, 5:55.) Thus, the Petition maps different

features of Gainsboro (CCU, TMU, and administrative terminals) to the same claim element (claim 1's "administrative workstation").

Compounding the confusion, the Petition also maps the combination of Gainsboro's CCU and TMU to claim 1's "central platform": "It would have been understood that the TMU connected to the CCU provides a 'central platform' through which users, such as inmates at the inmate telephones, can access outside telephone lines and other services provided by the call management system." (Petition at 39; *see also id.* at 62.) Alternatively, addressing claim 2, the Petition asserts that Gainsboro's CCU *alone* is the claimed "central platform": "In an embodiment where Gainsboro's CCU is the claimed central platform..." (*Id.* at 55.) Thus, in addition to inconsistently mapping the features of Gainsboro to the claimed "central platform," the Petition maps the same aspects of Gainsboro (CCU and/or TMU) to different claim elements (claim 1's "administrative workstation" and "central platform").

The Petition provides no explanation for these glaring inconsistencies. It simply mixes and matches features of the references and elements of the claims when convenient, demonstrating that Securus has failed to present its challenge "in writing and *with particularity*." 35 U.S.C. § 322(a)(3) (emphasis added). Because the Petition relies on its flawed analysis of claim 1's "administrative workstation"

and “central platform” to address those of independent claims 7, 16, and 20 (*see* Petition at 61-62; 74; 82-84), the flawed analysis infects all of the claims.

**2. The Petition fails to address all of the elements of independent claims 7, 16, and 20.**

The Petition takes a shortcut when addressing independent claims 7, 16, and 20. (Petition at 61-62; 74; 82-84.) Despite the differences in the language and requirements of claims 1, 7,<sup>3</sup> 16, and 20, the Petition baldly adopts much of its obviousness analysis of claim 1 (and certain dependent claims) when addressing claims 7, 16, and 20. (*Id.*) Indeed, it provides independent analysis for only two elements of claim 7 (*id.* at 62-66), three elements of claim 16 (*id.* at 74-78), and three elements of claim 20 (*id.* at 84-89).

In so doing, the Petition fails to address all of the elements of independent claims 7, 16, and 20. *See* 37 C.F.R. § 42.304(b)(4) (“the petition must specify where each element of the claim is found in the prior art”). It admits that certain

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<sup>3</sup> The '021 patent applicant did not admit during prosecution that “claim 7 covers the same subject matter as claim 1,” as the Petition alleges. (Petition at 61.) The applicant stated that certain “limitations of claim 7 are *analogous* to those . . . for claim 1.” (Exhibit 1004 at 68 (emphasis added).) “Analogous” does not mean “the same as”; it means “[c]omparable in certain respects, typically in a way which makes clearer the nature of the things compared.” (Exhibit 2011.)

elements of claims 7, 16, and 20 are “variants”—i.e., different in some way—than the elements of claim 1 and certain dependent claims. (Petition at 62; 74; 83-84.) Specifically, it asserts that the elements of claims 7, 16, and 20 are “the same *or obvious variants*” of the elements of claim 1 and certain dependent claims. (*Id.* (emphasis added).) But the Petition does not identify which elements of claims 7, 16, and 20 are “variants.” Nor does the Petition explain why the “variants” are obvious or which of the asserted references (or combination of asserted references) allegedly renders the “variants” obvious.

The Petition’s admission that certain elements are different (*i.e.*, variants) coupled with its failure to address those differences is fatal to its obviousness challenges of independent claims 7, 16, and 20.

To put the rubber to the road, consider the Petition’s treatment of independent claim 7. In addition to conceding that many of claim 7’s elements are different than (*i.e.*, variants of) claim 1’s elements, the Petition admits that “[c]laim 7 has slight differences” in four specific claim elements, which it labels 7B, 7D, 7E, and 7G. (*Id.* at 61-62). But after making this admission, the Petition completely fails to address two of those elements: elements 7E and 7G. (*See id.* at 61-66 (addressing only elements 7B and 7D).)

The Petition’s treatment of independent claims 16 and 20 is equally flawed. (Petition at 74; 83-84.) For example, claim 16 recites: “identifying a local user-

attempting access to a telephone call management system.” (’021 patent, 20:22-23.) As best understood, the Petition refers to this element as element 16B. (*See* Akl Decl. ¶ 245 (page 143).) According to Dr. Akl, element 16B is an obvious variant of claim 3 (*id.*), which recites: “wherein said local user is only granted access to place a telephone call if an authentication means verifies identification information as indicative of a valid user” (’021 patent, 19:18-21). In other words, Dr. Akl admits that element 16B is different than claim 3, which is confirmed by the claim language. (Akl Decl. ¶ 245 (page 143).) But the Petition does not explain why the admitted difference is obvious or which asserted reference (or combination of asserted references) renders the admitted difference obvious.

It is not enough to baldly allege that claims 7, 16, and 20 are obvious variants of claim 1 and certain dependent claims. The Petition must address each element, particularly when the Petition admits that there are differences amongst the claim elements. 37 C.F.R. § 42.304(b)(4). Because the Petition fails to address all of the elements of independent claims 7, 16, and 20, the Board should deny institution of these claims and their dependent claims.

**3. The Petition impermissibly incorporates by reference large portions of Dr. Akl’s declaration.**

The Petition’s shortcut approach is further deficient because it impermissibly incorporates by reference analysis from Dr. Akl’s declaration in the form of lengthy paragraphs and charts. Addressing claim 7, it incorporates ¶ 215 of Dr.

Akl's declaration, which spans pages 120-24. (*Id.* at 62.) Addressing claim 16, it incorporates ¶¶ 245-256 and 258-269 of Dr. Akl's declaration, which span pages 142-63 and include lengthy claim charts. (*Id.* at 74-78.) And addressing claim 20, the Petition incorporates ¶¶ 148-49, 280-82, and 284 of Dr. Akl's declaration. (*Id.* at 83-84.) Because "[a]rguments must not be incorporated by reference from one document into another document," 37 C.F.R. § 42.6(3), the Board should not turn to Dr. Akl's declaration to cure the Petition's deficient obviousness analysis of independent claims 7, 16, and 20. *See, e.g., Cisco Sys., Inc., v. C-Cation Tech's, LLC*, IPR2014-00454, Paper 12 at 7-10 (P.T.A.B. Aug. 29, 2014) (informative) (refusing to "consider arguments that are not made in the Petition, but are instead incorporated by reference" from an expert's declaration); *Fidelity Nat'l Info. Servs., Inc. v. Datatransury Corp.*, IPR2014-00490, Paper 9 at 9-11 (P.T.A.B. Aug. 13, 2014) (same).

**4. The Petition's alleged motivations to combine are unclear because it fails to first determine the scope and content of the asserted references.**

The Petition presents its obviousness analysis out of order, requiring the Board and Patent Owner to engage in additional archeology to piece together Securus' flawed arguments. *DeSilva*, 181 F.3d at 866-67 ("A brief must make all arguments accessible to the judges, rather than ask them to play archaeologist with the record."). Before it attempts to determine the scope and content of the asserted

references, the Petition launches into a confused discussion of why a person of ordinary skill in the art would have allegedly combined the asserted references. (Petition at 25-32; 81-82.) By employing this approach, the Petition provides no context for evaluating whether its stated motivations to combine include the requisite “rational underpinnings” to support the alleged obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“... there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”).

Securus carries the burden of demonstrating that it is entitled to review. 37 C.F.R. § 42.20(c). The Petition’s confused motivation-to-combine analysis compounds the deficiencies discussed above, and provides yet another reason that Securus has failed to meet its burden.

**B. The Petition fails to demonstrate that Gainsboro teaches or suggests an “administrative workstation” that monitors conversations or connects to a call “without detection,” as recited in each independent claim.**

The Petition fails to demonstrate that Gainsboro discloses, teaches, suggests, or otherwise renders obvious “an administrative workstation” that monitors conversations or connects to a call “without detection.” This feature is recited in each of the independent claims:

- Claim 1 recites, “an administrative workstation for connecting to said telephone terminal to monitor conversations between said institution without detection by said user.” (’021 patent, 18:63-65.)

- Claim 7 recites, “an administrative workstation for connecting to a telephonic communication between said at least one telephone terminal and at least one gateway without detection by said at least one telephone terminal.” (*Id.* at 19:42-45.)
- Claim 16 recites, “wherein said central platform connects with an administrative workstation for connecting to a call placed from said institution without detection by said local user.” (*Id.* at 20:44-46.)
- Claim 20 recites, “wherein said central platform is coupled to an administrative workstation for monitoring conversations in said telephone call made from said telephone terminal without detection.” (*Id.* at 21:9-12.)

Even though claims 1, 7, 16, and 20 use different language, the Petition provides analysis for the administrative workstation of claim 1 only, adopting this analysis for claims 7, 16, and 20. (Petition at 45-47 (addressing “Element 1G”); 61-66 (failing to address “Element 7E”); 74-78 (addressing claim 16); 82-89 (failing to address “Element 20F”).) Thus, the analysis that follows focuses on independent claim 1, but applies equally to independent claims 7, 16, and 20.

The Petition asserts that Gainsboro discloses the claimed “administrative workstation” that monitors conversations or connects to a call “without detection.”

(Petition 45-47.) It does not rely on any of the other asserted references. (*Id.*) The Petition is wrong for at least two reasons.

First, as explained above, the Petition fails to specify with sufficient clarity where the claimed “administrative workstation” is allegedly found in Gainsboro. 37 C.F.R. § 42.304(b)(4). On page 45, the Petition suggests “us[ing] Gainsboro’s CCU or TMU as an ‘administrative workstation.’” On page 46, it suggests that Gainsboro’s “CCU or the administrative terminals [labeled 5a and 5b in Figure 1 of Gainsboro] would have been utilized . . . as an administrative workstation.” And then on page 47, the Petition suggests “tap[ping] into the conversation via line 41a” of Figure 4 of Gainsboro, which depicts Gainsboro’s TMU. (Gainsboro, 5:55.) So, within the same section, the Petition maps each of Gainsboro’s CCU, TMU, and administrative terminals to the claimed “administrative workstation.” (Petition at 45-47.)

The Petition’s failure to specify with the requisite clarity where the claimed “administrative workstation” is allegedly found in Gainsboro impermissibly shifts the burden to the Board and Patent Owner to sift through the Petition and piece together its flawed arguments. Again, the Board should not undertake this task. *DeSilva*, 181 F.3d at 866-67 (“A brief must make all arguments accessible to the judges, rather than ask them to play archaeologist with the record.”); *Dunkel*, 927 F.2d at 956 (“Judges are not like pigs, hunting for truffles buried in briefs”).

Second, the Petition fails to demonstrate that Gainsboro teaches or suggests the claimed “monitor[ing] . . . without detection.” As the Petition points out, Gainsboro discloses both live call monitoring and passive call monitoring. (Petition at 45 (citing Gainsboro, 2:65-67; 4:60-65; 6:38-42).) In Gainsboro, live call monitoring is where a person, such as a prison official, “listen[s] in on [a] call in progress.” (Gainsboro, 4:63-65.) Passive call monitoring is different from live call monitoring, i.e., a person does not listen in on a call in progress, such as for attorney-client calls. (*Id.* at 2:59-3:4.) Thus, Gainsboro’s call monitoring techniques are about whether a third party listens in on a call in progress.

By contrast, the ’021 patent describes a technique about whether the parties to the call know that their call is being monitored. It explains that the administrative workstation allows “a live operator to monitor calls *without detection*.” (’021 patent, 17:15-16 (emphasis added).) Software associated with the administrative workstation “provides a means for patching into calls using circuitry *without alerting the user or called party to the operator’s presence*.” (*Id.* at 17:18-21 (emphasis added).) The Petition fails to explain how Gainsboro’s active and passive monitoring, which determine whether a call is monitored, also monitor a call without detection.

As best understood, the Petition incorrectly equates Gainsboro’s passive call monitoring to monitoring without detection. (Petition at 45 (“ . . . passively monitor

inmate's phone conversations *i.e., without detection* to avoid tipping off the inmates. . . .") (emphasis added.) As explained above, the Petition fails to demonstrate that Gainsboro's passive call monitoring is the same as monitoring without detection. And neither the Petition nor Dr. Akl explains why Gainsboro's passive call monitoring is the same as monitoring without detection. (*See* Petition at 34; Akl Decl. at ¶¶ 162-64.)

Alternatively, the Petition suggests that "it also would have been obvious to tap into the conversation via line 41a [of Figure 4 of Gainsboro] without detection by the user." (Petition at 47.) This suggestion is pure speculation motivated by hindsight, as indicated by the preceding sentence in the Petition. There, the Petition states that "it would have been understood from the circuit of Figure 4 [of Gainsboro], *that it would not have likely been configured to provide audio listening only.*" (*Id.* (emphasis added).) First, it is not clear what this statement means. Regardless, "it would not have likely been configured to" is bald speculation, and not the proper standard for determining obviousness. Second, neither the Petition nor Dr. Akl points to any disclosure in Gainsboro or anything else to substantiate this speculation. Nor do they explain, for example, (i) what it means to "tap" the TMU of Figure 4, (ii) how "tap[ping] into the conversation" would have been achieved "without detection" by the parties to the call, or (iii) why a person of ordinary skill in the art would have been motivated to "tap" the TMU (*i.e.*, Figure

4 of Gainsboro), which is the *institution's own equipment*. (See Petition at 40 (admitting that “the TMU is ‘located in the telephone room’” of the institution); Gainsboro, Figure 1.) The Board should reject the Petition’s speculative, hindsight-driven analysis, which infects the Petition’s obviousness challenge of each independent claim.

Additionally, the Petition does not address the differences in the language and requirements between claim 1’s “administrative workstation” and those recited in claims 7, 16, and 20. The Petition refers to claim 7’s “administrative workstation” as element 7E. (Petition at 61.) As explained above, the Petition admits claim 7’s “administrative workstation” is different than claim 1’s, but completely fails to address element 7E. (*Id.* at 61-66.) And because claims 1 and 7 use different language and have different requirements, the Petition cannot rely on its analysis of claim 1’s “administrative workstation” for element 7E.

Claim 7’s administrative workstation is “for connecting to a telephonic communication between said at least one telephone terminal *and at least one gateway* without detection. . . .” (’021 patent, 19:42-45 (emphasis added).) By contrast, claim 1’s administrative workstation is not required to connect between a telephone terminal *and at least one gateway*. (See *id.* at 18:63-65.) Consequently, the Petition’s analysis of claim 1 (*i.e.*, element 1G)—which relies exclusively on Gainsboro (Petition at 45-47)—fails to explain how Gainsboro (or a combination

of the asserted references) teaches or suggests the specific connection recited in element 7E. Indeed, the Petition admits that Gainsboro does not even disclose a gateway. (*Id.* at 26; *see also id.* at 65-66 (relying on Kung to allegedly teach claim 7's gateway).)

Claim 16 recites that the “central platform connects with” the administrative workstation ('021 patent, 20:44-45), and claim 20 recites that the “central platform is coupled to” the administrative workstation (*id.* at 21:9-10). The Petition fails to address these features. Indeed, in order to address these aspects of claims 16 and 20, the Petition would have to delineate the features of Gainsboro that allegedly correspond to the claimed “administrative workstation” and to the claimed “central platform.” As discussed above, the Petition fails to do so.

In sum, the Petition fails to demonstrate that Gainsboro teaches or suggests an “administrative workstation” that monitors conversations or connects to a call “without detection.” Because this feature is recited in each of the independent claims, the Board should deny institution of the Petition.

**C. The Petition fails to demonstrate that element 1H (the claimed “routing means”) is obvious over Gainsboro and Kung.**

The Petition fails to demonstrate that element 1H is obvious because its stated reason to combine Gainsboro and Kung fails. Element 1H recites: “at least one routing means coupled to said telephone terminal and said central platform.” ('021 patent, 18:66-67.) The Petition admits that Gainsboro does not disclose this

element (Petition at 26), but asserts that Kung's broadband residential gateway (BRG) meets the claimed "routing means" (*id.* at 49). It further asserts that a person of ordinary skill in the art would have been motivated to use Kung's BRG in Gainsboro's system to obtain "the benefit of decoding DTMF and selectively connecting inmate phones with remote parties." (*Id.*)

But the Petition's stated motivation to combine fails because Gainsboro's TMU already provides this functionality: "a trunk management unit (TMU) for *selectively connecting* the institutional telephones to one or more outside telephone lines, wherein the TMU includes means for *decoding DTMF tones* generated by the institutional telephones or received from the outside telephone lines." (Gainsboro, 4:10-15 (emphasis added)). The Petition fails to explain why a person of ordinary skill in the art would have modified Gainsboro's system to include another piece of equipment to perform the same function as the TMU. Indeed, because the TMU already performs the decoding and selectively connecting functions, a person of ordinary skill would have had no need to look to Kung to obtain these alleged "benefit[s]." (Petition at 49.)

**D. The Petition fails to address elements 7G and 7E.**

Again, the Petition fails to address elements 7G and 7E. It concedes that "[c]laim 7 has slight differences" in four specific claim elements, which it labels 7B, 7D, 7E, and 7G. (Petition at 61.) But after making this admission, the Petition

fails to address elements 7E and 7G. (*See id.* at 61-66 (addressing only elements 7B and 7D).) Consequently, the Board should not institute review of independent claim 7 and its dependent claims.

\* \* \*

In sum, the Petition's obviousness challenges suffer from many incurable procedural and substantive deficiencies. Securus has not demonstrated that any of the independent claims are more likely than not obvious over the Gainsboro combinations. Thus, the Board should not institute review.

## **VI. Conclusion**

For the reasons set forth above, the Board should not institute CBM review of claims 1-23 of U.S. Patent No. 7,783,021.

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**CERTIFICATION OF SERVICE**

The undersigned hereby certifies that the foregoing **PATENT OWNER'S PRELIMINARY RESPONSE** and associated Exhibits 2001-2011 were served electronically via e-mail on May 5, 2017, in their entireties on the following Attorneys for Petitioner:

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**CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATION,  
TYPEFACE REQUIREMENTS, AND TYPE STYLE REQUIREMENTS**

1. This Patent Owner Preliminary Response complies with the type-volume limitation of 18,700 words, comprising 8,834 words, excluding the parts exempted by 37 C.F.R. § 42.24(a)(1).

2. This Patent Owner Preliminary Response complies with the general format requirements of 37 C.F.R. § 42.6(a) and has been prepared using Microsoft® Word 2010 in 14 point Times New Roman.

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