

Case IPR2014-00824

Patent 8,340,260

Filed on behalf of Securus Technologies, Inc.

By: Justin B. Kimble (jkimble@bcpc-law.com)

Jeffrey R. Bragalone (jbragalone@bcpc-law.com)

Bragalone Conroy P.C.

2200 Ross Ave.

Suite 4500 – West

Dallas, TX 75201

Tel: 214.785.6670

Fax: 214.786.6680

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 IPR2014-00824

U.S. Patent No. 8,340,260

**PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR
INTER PARTES REVIEW OF U.S. PATENT NO. 8,340,260**

Mail Stop PATENT BOARD

Patent Trial and Appeal Board

U.S. Patent & Trademark Office

P.O. Box 1450

I. INTRODUCTION

Patent Owner Securus Technologies, Inc. (“Securus” or “Patent Owner”) hereby files this preliminary response (“Preliminary Response”) to the Petition for *Inter Partes* Review of U.S. Patent No. 8,340,260 (the “Petition”) in IPR2014-00824 filed by Global Tel*Link Corporation (“GTL” or “Petitioner”).

The PTAB should deny the Petition’s request to institute an *inter partes* review (“IPR”) of U.S. Patent No. 8,340,260 (the “’260 patent”) because the grounds in the Petition do not demonstrate a reasonable likelihood of any claims being invalid.

To explain the insufficiencies of the grounds in the Petition, the Preliminary Response first provides an introduction that outlines (1) the Grounds themselves, (2) the ’260 patent and its technology, (3) the prior art references relied upon in the Grounds, and (4) claim construction issues.

This Response is timely under 35 U.S.C. § 313 and 37 C.F.R. § 42.107, as it is filed within three months of the June 9, 2014, date of the Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response. (Paper No. 3.) Patent Owner has limited its identification of deficiencies in Petitioner’s argument in this Preliminary Response; Patent Owner does not intend to waive any arguments by not addressing them in this Preliminary Response.

A. Grounds in Petition

The Petition includes eight grounds of alleged invalidity – all 103(a) obviousness combinations – spread across the twenty claims of the '260 patent. For the following reasons, which are discussed in more detail in Section II below, none of the grounds demonstrate a reasonable likelihood of any claims being invalid:

Ground 1: Unpatentable under 103(a) as obvious over Spadaro in view of Hodge (Claims 1-4, 6-11, 14, 16, 17, 19, and 20)

- a. The Petition Fails to Establish That the Combination of Spadaro with Hodge Would Have Been Obvious;
- b. No Disclosure of Element 1[A] - “a networking device”;
- c. No Disclosure of Element 1[B] - “an inmate management-system”;
- d. No Disclosure of Element 1[C] - “a call application management system”;
- e. No Disclosure of Element 6[A] – “wherein the plurality of facilities comprise different types of facilities”;
- f. Petitioner’s Claim Chart for Claims 10, 14, 16, 17, 19, and 20 Is Inadequate to Establish the Obviousness of Those Claims;
- g. No Disclosure of Element 10[B2] – “receiving from a second computer terminal at the second facility, second inmate information associated with the inmate”;
- h. No Disclosure of Element 10[B3] – “storing the inmate record in the computer-based system for shared access across to the inmate record computer terminals in the multiple facilities”;
- i. No Disclosure of Element 19[A] – “wherein the multiple facilities comprise different types of facilities”;
- j. No Disclosure of Element 11[A] – “wherein said first inmate information is received upon said inmate’s arrest”.

Ground 2: Unpatentable under 103(a) as obvious over Spadaro in view of Hodge and Boykin (Claims 5 and 12)

- a. The Petition Fails to Establish That the Combination of Spadaro with Hodge and Boykin Would Have Been Obvious;
- b. No Disclosure of Element 5[A] - “wherein said plurality of facilities comprise a mobile police station”;
- c. No Disclosure of Element 12[A] - “wherein said first facility comprises a mobile police station”.

Ground 3: Unpatentable under 103(a) as obvious over Spadaro in view of Hodge and Cree (Claim 13)

- a. The Petition Fails to Establish That the Combination of Spadaro with Hodge and Cree Would Have Been Obvious;
- b. No Disclosure of Element 13[A] - “modifying said inmate record responsive to transferring the inmate from one facility of the multiple facilities to another facility of the multiple facilities”.

Ground 4: Unpatentable under 103(a) as obvious over Spadaro in view of Hodge and Nguyen (Claims 15 and 18)

- a. The Petition Fails to Establish That the Combination of Spadaro with Hodge and Nguyen Would Have Been Obvious;
- b. No Disclosure of Element 18[B] - “establishing another inmate account associated with said third party responsive to transferring the inmate to the other facility”.

Ground 5: Unpatentable under 103(a) as obvious over Bellcore in view of Hodge (Claims 1-4, 6-11, 14, 16, 17, 19, and 20)

- a. The Petition Fails to Establish That the Combination of Bellcore with Hodge Would Have Been Obvious;
- b. No Disclosure of Element 1[B] - “an inmate management-system”;
- c. No Disclosure of Element 1[C] - “a call application management system”;

- d. Petitioner's Claim Chart for Claims 10, 14, 16, 17, 19, and 20 Is Inadequate to Establish the Obviousness of Those Claims;
- e. No Disclosure of Element 6[A] – “wherein the plurality of facilities comprise different types of facilities”;
- f. No Disclosure of Element 10[B2] – “receiving from a second computer terminal at the second facility, second inmate information associated with the inmate for modifying the inmate record”;
- g. No Disclosure of Element 10[B3] – “storing the inmate record in the computer-based system for shared access across to the inmate record computer terminals in the multiple facilities”;
- h. No Disclosure of Element 19[A] – “wherein the multiple facilities comprise different types of facilities”
- i. No Disclosure of Element 11[A] – “wherein said first inmate information is received upon said inmate's arrest”

Ground 6: Unpatentable under 103(a) as obvious over Bellcore in view of Hodge and Boykin (Claims 5 and 12)

- a. The Petition Fails to Establish That the Combination of Bellcore with Hodge and Boykin Would Have Been Obvious;
- b. No Disclosure of Element 5[A] - “wherein said plurality of facilities comprise a mobile police station”;
- c. No Disclosure of Element 12[A] - “wherein said first facility comprises a mobile police station”.

Ground 7: Unpatentable under 103(a) as obvious over Bellcore in view of Hodge and Cree (Claim 13)

- a. The Petition Fails to Establish That the Combination of Bellcore with Hodge and Cree Would Have Been Obvious;
- b. No Disclosure of Element 13[A] - “modifying said inmate record responsive to transferring the inmate from one facility of the multiple facilities to another facility of the multiple facilities”.

Ground 8: Unpatentable under 103(a) as obvious over Bellcore in view of Hodge and Nguyen (Claims 15 and 18)

- a. The Petition Fails to Establish That the Combination of Spadaro with Hodge and Nguyen Would Have Been Obvious;
- b. No Disclosure of Element 18[B] - “establishing another inmate account associated with said third party responsive to transferring the inmate to the other facility”.

B. The '260 Patent – The Patent-at-issue in the Proceeding

The '260 patent is titled “Inmate Management and Call Processing Systems and Methods.” The '260 patent discloses “systems and methods that provide centralized or nodal inmate management and telephone call processing capabilities to controlled environment facilities.” (Ex. 1001 at Abstract.) The '260 patent is a continuation of U.S. Patent 7,529,357 (the “'357 patent”), which is a continuation-in-part of U.S. Patent Number 7,899,167 (the “'167 patent”). The '357 patent and the '167 patent are among a number of Patent Owner’s patents for which Petitioner has filed *inter partes* review requests.

As the '260 patent explains, “[t]he database is shared across the facilities and contains inmate records that may be accessed and modified by each facility as the inmate is transferred among those facilities.” (*Id.*) More specifically, “[e]ach controlled environment facility may utilize the inmate management and call processing system to store, retrieve, and/or modify a record associated with an arrestee or inmate in the inmate information database.” (*Id.* at 3:8-11.) In some embodiments, “Voice over Internet Protocol (VoIP) may be utilized to carry calls

from a location at which calling services are provided to an inmate management and call processing system providing all or substantially all call processing functionality.” (*Id.* at 4:14-21.)

The Petition attempts to characterize the ’260 patent as merely describing a combination of Voice over Internet Protocol technology with centralized call processing. (Petition at pp. 6-7.) As such, the Petition attempts to combine disparate references separately describing VoIP architectures and call processing in a controlled environment. The Petition fails to demonstrate (1) that the combination of such references was obvious to a person of ordinary skill in the art at the time of invention and (2) that the combinations result in the system and methods disclosed by the ’260 patent. As discussed below, the novel aspects of the ’260 patent exceed the mere combination of well-known elements. As the Supreme Court has stated, “inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418-19 (2007). The Petition improperly relies on hindsight to cobble together disparate references in an effort to re-create the novel systems and methods disclosed by the ’260 patent.

Further, the Petition relies on references that the Examiner was aware of during prosecution of the ’260 patent and chose not to cite against the claims of the

'260 patent. The Spadaro and Hodge references were both cited against the '167 patent (parent to the '260 patent) during prosecution, including in combination just as the Petition alleges in Grounds 1-4. Hodge, in particular, is relied upon as a combination reference in *each* of the 8 Grounds alleged by the Petition. Additionally, the Cree reference, which the Petition relies upon in Grounds 3 and 7, was cited against the '357 patent during prosecution. Despite having considered each of these references, the Examiner chose to allow the claims of the '260 patent. Thus, the Petition does not offer any ground for invalidity of the '260 patent that does not rely upon at least one reference considered during prosecution.

C. The Prior Art in the Petition

1. Spadaro - Exhibit 1004 – Primary Reference, Grounds 1-4

United States Patent No. 7,505,406 to Spadaro et al. ("Spadaro"), filed on July 13, 2001 and issued on March 17, 2009, is the primary reference for Grounds 1-4 in the Petition. Spadaro is entitled "Public Telephone Control with Voice Over Internet Protocol Transmission." Spadaro describes a system for "control of public telephones at a given site and the processing of voice telephone calls with the calls being routed over Voice over Internet Protocol networks." (Ex. 1004 at 1:7-10.) The system consists of a programmable computer at the site for switching, accessing, routing, timing, billing and the control of the telephones at the site. (*Id.* at 2:45-48.) The site computer disclosed by Spadaro is often referred to as a control computer or

by its commercial name, the Commander. (*Id.*) The site computer of Spadaro has a modem which establishes a connection to a Public Switched Telephone Network (PSTN) or Private Branch Exchange. (*Id.* at 2:53-67.) Spadaro discloses the use of an Internet Protocol network to connect the site computer to the PSTN via a VoIP gateway. (*Id.* at 3:1-18.) Spadaro discloses a prison facility as an example of a site that may utilize the disclosed system to monitor and control public telephones. (*Id.* at 2:41-45.) While the Spadaro system generally locates the site computer at the prison facility, it also allows for certain control functions such as routing, billing, and PIN checking to be distributed to a remote location over a local area network (LAN) or a wide area network (WAN). (*Id.* at 3:57-4:13.)

2. Bellcore - Exhibit 1006, Primary Reference, Grounds 5-8

SR-4717, Voice Over Packet in Next Generation Networks: An Architectural Framework by Bellcore (“Bellcore”), published in January 1999, is the primary reference in Grounds 5-8 of the Petition. Bellcore discloses various architectures and motivations for transporting voice calls on packet-based data networks. (Ex. 1006 at pp. 1-1 – 1-4.) The Bellcore Special Report “places significant emphasis on the issues that are important for the [Voice Over Packet] solution to be widely deployed in public networks.” (*Id.* at p. 1-3.) To that end, it focuses on “a framework for a VOP network that has parity with the PSTN in terms of features and services, their quality, and reliability.” (*Id.* at p. 1-3.) By its own admission, it does not seek

to define “services that are not currently offered on the PSTN.” (*Id.* at p. 1-4.) “The focus of this SR is on ensuring the support of PSTN services on packet-based networks.” (*Id.* at p. 1-4.) Bellcore makes no mention of using a Voice Over Packet network in a controlled environment, such as a prison, or of the various features and services having specific benefits to such an environment.

3. Hodge - Exhibit 1005, Secondary Reference

U.S. Patent No. 7,333,798 to Hodge (“Hodge”) was filed on August 8, 2002 and issued on February 19, 2008. The Petition uses Hodge as a secondary reference for each of Grounds 1-8. Hodge is titled “Telecommunication Call Management and Monitoring System” and describes a computer-based telecommunication system with the capacity to allow an institution to control, record, monitor, and report usage and access to a telephone network.” (Ex. 1005 at 1:9-12.) Hodge discloses that its main objective is “to provide a telephone call system including a means for identifying and authenticating an institutional calling party.” (*Id.* at 9:54-56.) The system disclosed by Hodge consists of one or more switchboard devices that connect calls placed by a user to the proper outgoing trunk based on the type of call. (*Id.* at 9:62-10:3.) The switchboard devices are connected to a site server that serves as the database location for the telephone management system. (*Id.* at 10:41-45.) Administrative and investigative workstations may be located at each site or centrally. (*Id.* at 10:44-48.) The administrative features of the Hodge system allow

for restrictions and limitations to be placed on individual inmates or applied globally across a division or the entire system. (*Id.* at 10:49-67.) Hodge discloses inmate information and accounts being managed at the site server, but does not disclose making the inmate information accessible from another site. (*See, e.g.*, Ex. 1005 at 42:14-21 (requiring transfer of the inmate’s account information to the separate facility).) Hodge does not discuss the use of Voice over Internet Protocol with the disclosed telecommunications system.

4. Boykin - Exhibit 1007, Tertiary Reference

The Boykin reference is U.S. Patent No. 6,831,556 (“Boykin”), filed on May 16, 2001, and issued on December 14, 2004. The Petition uses Boykin as a tertiary reference for Grounds 2 and 6. Boykin is titled “Composite Mobile Digital Information Systems” and is directed to “a system for use in public and commercial vehicles to capture video, audio, and related information for surveillance and evidentiary purposes.” (Ex. 1007 at 1:7-10.) Boykin is not related to the same subject matter as the ’260 patent; Boykin never discusses controlled environments such as prison facilities, managing inmate information, or call processing.

5. Cree - Exhibit 1008, Tertiary Reference

The Cree reference is U.S. Patent No. 6,665,380 (“Cree”), filed on January 11, 1999, and issued on December 16, 2003. The Petition uses Cree as a tertiary reference for Grounds 3 and 7. Cree is titled “Inmate Messaging System and

Method” and relates to “an inmate messaging system and method for notifying an inmate in a prison facility of messages received from a caller outside the prison facility.” (Ex. 1008 at 1:8-10.) Because Cree is primarily concerned with a messaging system for inmates, it is not concerned with the same subject matter as the ’260 patent; Cree never discusses managing inmate information across multiple sites or call processing.

6. *Nguyen - Exhibit 1009, Tertiary Reference*

The Nguyen reference is U.S. Patent No. 5,861,810 (“Nguyen”), filed on September 27, 1996, and issued on January 19, 1999. The Petition uses Nguyen as a tertiary reference in Grounds 4 and 8. Nguyen is titled “System and Method for Providing Crime Victims Updated Information and Emergency Alert Notices” and discloses a victim notification system and method for notifying a victim of the change of status of an inmate associated with the victim.” (Ex. 1009 at 1:53-55.) Nguyen never discloses managing and modifying inmate information at a central location or call processing.

D. Claim Construction

The claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The Office must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the

specification. *Id.* (citing *In re Bass*, 314 F.3d 575, 577 (Fed. Cir. 2002)). There is a “heavy presumption” that a claim term carries its ordinary and customary meaning. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002).

Petitioner submits a proposed construction for only one claim term: “VoIP Data Packet.” (Petition at pp. 7-8.) But Petitioner provides no reason why this term requires construction and should not be given its ordinary and customary meaning. Petitioner proposes that “VoIP Data Packet” be construed as “data packet containing the voice content of a call.” The Petition provides no support for the proposed construction other than to cite the lone use of this term in the specification of the ’260 patent. But that citation does not present a definition of the term, and in fact, only uses the term in an exemplary manner. Because Petitioner has failed to provide any basis for its proposed construction, the term “VoIP Data Packet” should be given its ordinary and customary meaning. Under its ordinary and customary meaning, “VoIP Data Packet” does not require construction.

The arguments in this response stand despite Petitioner’s proposed construction. This Preliminary Response does not take a position on any other claim constructions. Patent Owner reserves the right to propose its own construction of any and all claim terms in the event the PTAB institutes this IPR.

II. GROUND 1 - SPADARO IN VIEW OF HODGE (CLAIMS 1-4, 6-11, 14, 16, 17, 19, and 20)

A. The Petition Fails to Establish That the Combination of Spadaro with Hodge Would Have Been Obvious

The Petition asserts that a “person of ordinary skill in the art could have combined the functions of Hodge with the system of Spadaro by known methods” and that the “results of the combination would have been predictable to a person of ordinary skill in the art.” (Petition at p. 13.) These statements are conclusory and unsupported by evidence or analysis. The Petition cites to Paragraph 66 of the Forys Declaration as apparent support. But Paragraph 66 of the Forys Declaration merely repeats the conclusory statements of the Petition without additional analysis or explanation. (Ex. 1003 at p. 31.)

Petitioner has failed to establish the prerequisites for demonstrating prima facie obviousness. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). “Although the obviousness analysis should ‘take account of the inferences and creative steps that a person of ordinary skill in the art would employ,’ the Supreme Court emphasized that this evidentiary flexibility does not relax the requirement that, ‘[t]o facilitate review, this analysis should be made explicit.’” *Perfect Web Technologies, Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1330 (Fed. Cir. 2009) (quoting *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007)). The Petition does not provide the “known methods” that would

be used to combine the functions of Hodge with the system of Spadaro. Nor does it explain why the combination would yield “predictable” results. (Petition at p. 13.) The conclusory statements of the Petition and the Forys Declaration lack the “articulated reasoning” required to demonstrate that the combination of Spadaro and Hodge would have been obvious to a person of ordinary skill in the art.

The Petition argues that the motivation to combine Spadaro and Hodge comes from the common field (inmate telecommunications) and problem addressed (control and management of inmate telecommunications) by the references. (Petition at p. 12.) The Petition and the accompanying Forys Declaration argue that “Spadaro’s various centralized functions” would have led a person of ordinary skill in the art to Hodge “which describes how to create and edit inmate information on a centralized call processing system.” (Petition at pp. 12-13.) But these statements are, again, conclusory and provided without articulated reasoning. The fact that Spadaro discloses certain functions that can be implemented either at the prison site or at a central location does not explain the need for a person of ordinary skill in the art to seek the separate teachings of Hodge to understand how to create, edit and/or store information. (*See* Ex. 1004 at 3:57-4:13.)

Because the Petition fails to demonstrate a *prima facie* case that the combination of Spadaro with the teachings of Hodge was obvious, Ground 1 fails for all claims.

B. No Disclosure of Element 1[A] - “a networking device . . .”

Independent Claim 1 of the '260 patent recites the following limitation: “a networking device exchanging Voice over Internet Protocol (VoIP) data packets with call processing gateways at the plurality of facilities over communication links, the call processing gateways processing the VoIP data packets to or from the telephone terminals from transmission over the communication links.” That limitation is referenced as the “networking device” limitation in the Petition and “limitation 1[A]” by the Forys Declaration. (*See, e.g.*, Petition at p. 15; Ex. 1003 at pp. 34-35.)

1. The system shown by Figure A is not disclosed by Spadaro

The Petition relies on Figure A of the Forys Declaration and Figure 2 of Spadaro to demonstrate that Spadaro discloses the “networking device” limitation. But Figure A does not appear in Spadaro. Figure A is a modified diagram combining Figures 3 and 5 of Spadaro. (*See* Petition at pp. 10-11.) The disclosure of Spadaro does not contemplate the system configuration that appears in Figure A and Petitioner’s reliance on this diagram to prove Spadaro discloses the “networking device” of Claim 1 is improper and provided without justification.

More specifically, the Petition identifies the server 48, found in Figure 3 of Spadaro, as the “networking device” of Claim 1. But the Spadaro system of Figure 5 does not include server 48, or one similar, as found in Figure 3. In fact, modified

Figure A positions the server 48 at a location convenient to Petitioner's analysis, but unsupported by Figure 3, Figure 5, or any disclosure in Spadaro. In essence, Petitioner has taken select elements from Figure 3 and placed them amongst the elements of Figure 5 in a manner that is explained only by impermissible hindsight.

It is of important note that Figure 3 is provided as a representation of a prior art system. (*See* Ex. 1004 at 2:25-26.) Figure 5 is a diagram showing one embodiment of the invention disclosed by Spadaro. (*Id.* at 2:29-30.) Thus, the system of Figure 5 is contemplated by Spadaro as an improvement over the prior art (i.e., Figure 3), and Petitioner's modification resulting in the system shown by Figure A was never contemplated by Spadaro and has no support in its disclosure.

At least for this reason, the Petition fails to demonstrate that Spadaro discloses the "networking device" limitation and Claim 1 is not made obvious by the combination of Spadaro with Hodge.

2. The Petition fails to properly identify a "networking device" in Spadaro

The Petition identifies server 48, as disclosed by Spadaro, as the claimed "networking device," but server 48 does not "exchang[e] Voice over Internet Protocol (VoIP) data packets with call processing gateways" as required by Claim 1. Because server 48 is only disclosed by Spadaro as an element of the prior art system of Figure 3 (a system that does not use VoIP), Petitioner's conclusory statement that "the VoIP packets are collected by server 48 and directed to their

destinations” is unsupported and simply incorrect. (Petition at p. 15). In support of this statement, the Petition cites to Paragraph 72 of the Forys Declaration. But the Forys Declaration merely provides more conclusory statements unsupported by Spadaro. Forys states “[s]erver 48 communicates with the Commander units using VoIP.” (Ex. 1003 at p. 35.) In support, the Forys declaration cites to an excerpt from Spadaro that doesn’t mention or refer to server 48: “all of the phones are connected through Commander systems over Voice over Internet Protocol network.” (*Id.* (citing Spadaro at 3:63-65).) Taken in context, this portion of Spadaro is actually referring to an embodiment of the “present invention,” not the prior art system of Figure 3 that includes server 48. (Ex. 1004 at 3:58-65.) Indeed, other than appearing in Figure 3, server 48 is only referenced *once* in the Spadaro specification: “The router 46 routes calls to a server 48 which connects the calls to central office 34.” (Ex. 1004 at 3:55-57.) Thus, the Petition’s contention that Spadaro’s disclosure of server 48 corresponds to a “networking device” that “exchang[es] Voice over Internet Protocol (VoIP) data packets with call processing gateways” is unfounded.

Thus, Petitioner fails to identify a “networking device” as recited by Claim 1. Accordingly, Ground 1 of the Petition fails for Claim 1 and each of its dependent claims.

C. No Disclosure of Element 1[B] - “an inmate management-system . . .”

Independent Claim 1 of the '260 patent recites the following limitation: “an inmate management-system coupled to the networking device for providing shared data access of inmate records to computer terminals at said plurality of facilities, said inmate records created with first inmate information collected from a first computer terminal at a first facility of the plurality of facilities and second inmate information from a second computer terminal at a second facility of the plurality of facilities.” That limitation is referenced as the “inmate management-system” limitation in the Petition and “limitation 1[B]” by the Forys Declaration. (*See, e.g.*, Petition at p. 16; Ex. 1003 at p. 36.)

1. The Petition fails to identify an “inmate management-system” that is coupled to a “networking device”

Because the “inmate management-system” is required to be coupled to the “networking device” of limitation 1[A], Petitioner’s identification of an inmate-management system fails for at least the reason that it has not identified a “networking device” that meets limitation 1[A] as discussed above. (*See* Section II.B *supra*.)

Additionally, the Petition relies on conclusory statements to identify a corresponding “inmate management-system” in Hodge, and therefore, has failed to properly support its position with the requisite evidence and analysis. For example, the Petition identifies the “site server” disclosed by Hodge as the “inmate management-system.” (Petition at pp. 16-17.) But without support, the Petition

concludes that “[a] person of ordinary skill in the art would have found it obvious to couple Hodge’s site server (*inmate management system*) to Spadaro’s server (*networking device*) because the *networking device* accesses inmate information such as PIN information for call authorization functions and because both are centralized.” (Petition at p. 17 (emphasis in original).) The citation to Paragraph 76 of the Forys Declaration offers no support as it merely repeats the language of the Petition. (Ex. 1003 at p. 37.) The lack of support for the statement is evident in that in addition to the statement being conclusory, it is also inaccurate. At no point does Spadaro describe the server as accessing inmate information such as PIN information. (See Ex. 1004.) As discussed above, the server only appears as an element of a prior art system shown in Figure 3 of Spadaro that connects calls from the Commander units to a central office. (Ex. 1004 at 3:55-57.) Petitioner’s assertions under Ground 1 cannot stand when based on conclusory statements and inaccuracies.

2. The Petition ignores limitations of the “inmate management-system”

The Petition again leaps to unsupported conclusions in asserting that the combination of Spadaro and Hodge discloses “said inmate records created with first inmate information collected from a first computer terminal at a first facility of the plurality of facilities and modified responsive to collecting second inmate information from a second computer terminal at a second facility of the plurality of

facilities.” (Petition at pp. 17-18.) Based on the disclosure of Hodge allowing an administrative workstation to be located at every facility and to create, edit and monitor user accounts and telephone calls, the Petition asserts that “a person of ordinary skill in the art would have recognized that data for creating records in the system can be received from multiple ones of the different facilities.” (*Id.*) Not only is this statement unsupported and conclusory—cited Paragraph 77 of the Forys Declaration repeats the language of the Petition and offers more conclusory statements—but it does not address the actual claim language found in Claim 1 of the ’260 patent. (*See* Ex. 1003 at p. 37.) The Petition fails to identify any inmate records disclosed by Hodge that are “created with first inmate information collected from. . . a first facility” and “second inmate information from. . . a second facility” as recited by Claim 1.

The Petition does not properly address the requirements of the claim language, and accordingly have not established a *prima facie* case of obviousness. Ground 1 fails for all claims at least because Petition has not demonstrated that Hodge discloses the “inmate management-system” limitation.

D. No Disclosure of Element 1[C] - “a call application management system . . .”

Independent Claim 1 of the ’260 patent recites the following limitation: “a call application management system connecting a call to or from the telephone terminals over a telephone carrier network responsive to receiving a request for connecting the

call and the call being authorized based on the inmate records provided by the inmate management system.” That limitation is referenced as the “call application management system” limitation in the Petition and “limitation 1[C]” by the Forys Declaration. (*See, e.g.*, Petition at p. 18; Ex. 1003 at p. 38.)

The Petition asserts that the “call application management system” limitation is met by the combination of Spadaro and Hodge, but it does not articulate the elements of either Spadaro or Hodge that would be combined to disclose the limitation. Specifically, the Petition is unclear as to which reference discloses the “being authorized based on the inmate records provided by the inmate management system” limitation. It asserts that Spadaro discloses that a call placed by an inmate is connected in response to the call “being authorized based on the inmate records.” (Petition at p. 19.) But it does not address the requirement that the inmate records are “provided by the inmate management system.” The Petition indicates that the Commander of Spadaro stores the restrictions on telephone usage associated with a PIN, but Petitioner has not previously identified the Commander as the “inmate management system” and could not do so. (*Id.*)

The Petition has previously identified the site server of Hodge as the “inmate management system.” (*See* Petition at pp. 16-17.) But in identifying the “call application management system,” the Petition fails to articulate how the site server of Hodge would be combined with the elements of Spadaro—namely the VoIP

Gateway 26a—to disclose a “call application management system” corresponding to the system required by Claim 1. The call application management system of Claim 1 authorizes calls based on the inmate records *provided by the inmate management system*. But the Petition fails to identify any specific combination of elements from Spadaro or Hodge that would interact to meet this limitation.

For these reasons, the Petition has not established that the “call application management system” limitation is disclosed by Spadaro and/or Hodge. Ground 1 fails for all claims because Petitioner has not made a prima facie case of obviousness.

E. No Disclosure of Element 6[A] – “wherein the plurality of facilities comprise different types of facilities.”

The Petition cites to Hodge as allegedly disclosing this limitation. (Petition at pp. 21-22.) But nothing in Petitioner’s citations show that Hodge discloses a system in which a “plurality of facilities comprise *different types* of facilities.” Hodge’s disclosure that “many types of institutional environments” may find use in such a system does not equate to a system with different types of facilities having shared data access to inmate records. (Petition at p. 21.) Petitioner’s assertion that “it would have been obvious to a person of ordinary skill in the art that multiple types of facilities associated with inmates (e.g., police and Court system) could be served simultaneously by the computer system as these facilities would require access to similar information and call processing functionality” is nothing more than unsupported and conclusory conjecture. (Petition at pp. 21-22.)

F. Petitioner's Claim Chart for Claims 10, 14, 16, 17, 19, and 20 Is Inadequate to Establish the Obviousness of Those Claims

Despite significant differences in the claim language of Claims 10, 14, 16, 17, 19, and 20 from the language of Claims 1, 2, 8, 9, 6, and 7, the Petition alleges obviousness of these claims with only a claim chart entirely devoid of analysis. For each element of Claims 10, 14, 16, 17, 19, and 20, the claim chart consists only of a citation to a previous section of the Petition and brief excerpts from Spadaro and/or Hodge without explanation of how these references combine to disclose the claim elements. Petitioner's only justification for this attempted shortcut is that "Claims 10, 14, 16, 17, 19 and 20 are method claims that include substantially the same limitations as claims 1, 2, 8, 9, 6 and 7, respectively." (Petition at p. 23.) But no comparison between the two sets of claims is provided and no analysis of how the differences in claim language affect the obviousness analysis is offered. Even a cursory examination of the two claim sets reveals substantial differences in the structure and content of the claims.

The Petition's blanket citation to thirty-three paragraphs (covering nineteen pages) of the Forys Declaration offers no help in the analysis because no citation for individual claim elements is provided. Further, under 37 C.F.R. § 42.22(a)(2) the petition must contain a "full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence." The rules also prohibit arguments made in a supporting document from being incorporated by

reference into a petition. *See* 37 C.F.R. § 42.6(a)(3). For that reason, information presented in the Forys Declaration in relation to Claims 10, 14, 16, 17, 19 and 20, wherein the arguments have not been presented sufficiently in the Petition, should not be considered.

On the basis that Petitioner has not provided adequate support for its assertion that the combination of Spadaro with Hodge renders Claims 10, 14, 16, 17, 19 and 20 obvious, Ground 1 should be denied for those claims.

G. No Disclosure of Element 10[B2] – “receiving from a second computer terminal at the second facility, second inmate information associated with the inmate”

The claim chart of the Petition cites to Hodge as allegedly disclosing this limitation. (Petition at p. 25.) But nothing in Petitioner’s citations show that Hodge discloses “receiving . . . at a second facility, second inmate information associated with the inmate.” Specifically, none of the citations to Hodge disclose that inmate information for the *same* inmate is received from both a first facility and a second facility. Section V.A.2.c of the Petition, cited to in the chart, provides no additional support that would establish this element is disclosed by Hodge.

H. No Disclosure of Element 10[B3] – “storing the inmate record in the computer-based system for shared access across to the inmate record computer terminals in the multiple facilities”

The claim chart of the Petition cites to Hodge as allegedly disclosing this limitation. (Petition at p. 26.) The one citation to Hodge provided in the chart as

allegedly disclosing this limitation does not provide any disclosure of “shared access” to the inmate record at “multiple facilities.” As discussed in further detail in Section VI.B.1 of this Preliminary Response, Hodge does not use the term “central” to indicate access to multiple facilities. (*See* Section IV.B.1 *infra.*) Thus, reference to the central site server by Hodge, cannot be used to infer shared data access to multiple facilities. The Petition, thus, fails to cite any portion of Hodge or Spadaro that discloses this claim element. Section V.A.2.c of the Petition, cited to in the chart, provides no additional support that would establish this element is disclosed by Hodge.

I. No Disclosure of Element 19[A] – “wherein the multiple facilities comprise different types of facilities”

The Petition cites to Hodge as allegedly disclosing this limitation. (Petition at p. 29.) But nothing in Petitioner’s lone citation shows that Hodge discloses a system in which a “plurality of facilities comprise *different types* of facilities.” Hodge’s disclosure that “many types of institutional environments” may find use in such a system does not equate to a system with different types of facilities having shared data access to inmate records. Petitioner’s assertion in Section V.A.6 of the Petition that “it would have been obvious to a person of ordinary skill in the art that multiple types of facilities associated with inmates (e.g., police and Court system) could be served simultaneously by the computer system as these facilities would

require access to similar information and call processing functionality” is nothing more than unsupported and conclusory conjecture. (Petition at pp. 21-22.)

J. No Disclosure of Element 11[A] – “wherein said first inmate information is received upon said inmate’s arrest”

The Petition asserts that the combination of Spadaro and Hodge disclose this limitation. But the Petition fails to cite to any portion of Spadaro or Hodge that discloses receiving inmate information into a computer-based system upon an inmate’s arrest. Petitioner attempts to stretch the language of both Spadaro and Hodge to allege disclosure of this element, but fails to demonstrate proper support for its conclusory statements. Providing an inmate with a telephone account upon arrival at a penal institution, is much different than receiving inmate information into a computer-based system *upon arrest*. (See Petition at pp. 29-30.) The Petition’s ultimate conclusion that “a person of ordinary skill in the art would have understood that call processing and data management systems described in Spadaro and Hodge could be used to service a police station or other similar facility, and that a telephone account could be provided to a person upon his “arrival” (e.g., arrest) at that location” is an unsubstantiated leap well beyond the minimal disclosure cited from Spadaro and Hodge. (*Id.* at p. 30.) The cited paragraph of the Forys Declaration, once again, offers no explanation beyond the language of the Petition. (Ex. 1003 at pp. 59-60.)

III. GROUND 2 - SPADARO IN VIEW OF HODGE AND BOYKIN
(CLAIMS 5 and 12)

A. The Petition Fails to Establish That the Combination of Spadaro with Hodge and Boykin Would Have Been Obvious

This Preliminary Response has already demonstrated that the Petition has failed to establish that the combination of Spadaro and Hodge would have been obvious to a person of ordinary skill in the art. (*See* Section II.A *supra*.) This Preliminary Response has also previously demonstrated that the Petition fails to identify disclosure of all elements of Claims 1, 10, and 11 in the combination of Spadaro and Hodge. (*See* Sections II.B-D, F-H, and J *supra*.) Because Ground 2 also alleges the combination of Spadaro and Hodge, and because Claim 5 depends from Claim 1 and Claim 12 depends from Claims 10 and 11, the alleged combination of Ground 2 fails for the same reasons previously provided.

Additionally, the Petition omits any attempt to justify the combination of Boykin with Spadaro and/or Hodge. Without support, it alleges that “[a] person of ordinary skill in the art could have combined the mobile facility of Boykin with the system of Spadaro and Hodge using known networking techniques (e.g. wireless routing).” (Petition at p. 31.) The Forys Declaration provides no additional analysis or support for this conclusion. (Ex. 1003 at p. 66.) The Petition’s statement is conclusory and unsupported by sufficient evidence or analysis.

Petitioner has failed to establish the prerequisites for demonstrating prima facie obviousness in Ground 2. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). No support is provided as a basis for the Petition’s conclusions, including that the addition of a mobile facility to the combined infrastructure of Spadaro and Hodge would have been “routine.” (Petition at p. 31.) The conclusory statements of the Petition and the Fors Declaration lack the “articulated reasoning” required to demonstrate that the combination of Boykin with Spadaro and Hodge would have been obvious to a person of ordinary skill in the art.

Nothing in Boykin would suggest the combination with Spadaro and/or Hodge. Boykin makes no reference to prison facilities, controlled environments, managing inmate information, or call processing. The Petition cites nothing in any of the three references that would lead a person of ordinary skill in the art to seek out one of the other references.

Because the Petition fails to demonstrate a prima facie case that the combination of Boykin with the teachings of Spadaro and Hodge was obvious, Ground 2 fails for all claims.

B. No Disclosure of Element 5[A] - “wherein said plurality of facilities comprise a mobile police station”

The Petition asserts that Boykin discloses this claim element, but the excerpts cited from Boykin establish nothing more than a vehicle having a mobile server for capturing, storing, and transmitting information. (Petition at pp. 30-31.) The vehicle disclosed by Boykin—even if it is a police vehicle—has not been demonstrated to correspond to the mobile police station of Claim 5. The Petition alleges, without basis, that a “police vehicle is a mobile police station.” (*Id.* at p. 31.)

In reaching this strained conclusion, the Petition disregards the limitations Claim 1 places on the “plurality of facilities.” For example, Claim 1 requires “each of the facilities [to have] one or more telephone terminals and computer terminals.” Claim 1 also requires the plurality of facilities to have a “call processing gateway.” The Petition does not address how the police vehicle disclosed by Boykin, and identified as the “mobile police station,” meets these limitations.

Because the Petition fails to properly identify how the combination of Boykin with Spadaro and Hodge discloses the “mobile police station” recited in Claim 5, Ground 2 fails for Claim 5.

C. No Disclosure of Element 12[A] - “wherein said first facility comprises a mobile police station”

For the same reasons provided in Section III.B, the combination of Boykin with Spadaro and Hodge does not disclose this claim element. The Petition again disregards the limitations Claim 10 places on the “first facility.” For example, Claim 10 requires “each facility [to comprise] multiple telephone terminals and computer

terminals.” Claim 10 also requires the first facility to receive “from a first computer terminal first inmate information associated with an inmate for creating an inmate record.” The Petition does not address how the police vehicle disclosed by Boykin, and identified as the “mobile police station,” meets these limitations.

Because the Petition fails to properly identify how the combination of Boykin with Spadaro and Hodge discloses the “mobile police station” recited in Claim 12, Ground 2 fails for Claim 12.

IV. GROUND 3 - SPADARO IN VIEW OF HODGE AND CREE (CLAIM 13)

A. The Petition Fails to Establish That the Combination of Spadaro with Hodge and Cree Would Have Been Obvious

This Preliminary Response has already demonstrated that the Petition has failed to establish that the combination of Spadaro and Hodge would have been obvious to a person of ordinary skill in the art. (*See* Section II.A *supra*.) This Preliminary Response has also previously demonstrated that the Petition fails to identify disclosure of all elements of Claim 10 in the combination of Spadaro and Hodge. (*See* Sections II.F-H *supra*.) Because Ground 3 also alleges the combination of Spadaro and Hodge, and because Claim 13 depends from Claim 10, the alleged combination of Ground 3 fails for the same reasons previously provided.

Additionally, the Petition omits any attempt to justify the combination of Cree with Spadaro and/or Hodge. Without support, it alleges that “[a] person of ordinary

skill in the art could have combined the functions of Spadaro and Hodge with those of Cree for at least the reasons discussed above, and by known data management and networking methods.” (Petition at p. 32.) The identity of the “reasons discussed above” are unclear. And the “known data management and networking methods” are not explained. The Forys Declaration provides no additional analysis or support for this conclusion. (Ex. 1003 at p. 69.) The Petition’s statement is conclusory and unsupported by sufficient evidence or analysis.

Petitioner has failed to establish the prerequisites for demonstrating *prima facie* obviousness in Ground 3. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). No support is provided as a basis for the Petition’s conclusions, including that the combination of Cree with the combined functionality of Spadaro and Hodge would have been “predictable.” (Petition at p. 32.) In fact, the Petition fails to identify which elements of Cree would be necessary to combine with Spadaro and Hodge. Thus, the Petition has not even provided a basis upon which it could be determined if the proposed combination would be predictable. The conclusory statements of the Petition and the Forys Declaration lack the “articulated reasoning” required to demonstrate that

the combination of Cree with Spadaro and Hodge would have been obvious to a person of ordinary skill in the art.

Because the Petition fails to demonstrate a prima facie case that the combination of Cree with the teachings of Spadaro and Hodge was obvious, Ground 3 should be denied.

B. No Disclosure of Element 13[A] - “modifying said inmate record responsive to transferring the inmate from one facility of the multiple facilities to another facility of the multiple facilities”

The Petition asserts that Cree discloses this claim element, but it fails to identify an “inmate record” that is modified responsive to the transfer of the inmate. (Petition at pp. 31-32.) The Petition cites only to one reference in Cree regarding transfer of an inmate: “Preferably, the active list includes a cell block telephone number, which is updated regularly by, for example, a system administrator to account for the release or transfer of inmates.” (*Id.* at p. 32.) But the Petition does not establish that the “active list” being updated is an *inmate record*. In fact, the “active list” refers to a “list of inmates that may be contacted by a remote caller for that account.” (Ex. 1008 at 5:50-53.) Thus, the “active list” is not information associated with an inmate. It is information associated with a *remote caller*. And more specifically, information associated with an account associated with a remote caller. (*Id.*) Thus, the reference in Cree cited to by the Petition does not identify the modification of an “inmate record responsive to transferring the inmate.”

Because the Petition fails to properly identify how the combination of Cree with Spadaro and Hodge discloses the “modifying said inmate record responsive to transferring the inmate” limitation recited in Claim 13, Ground 3 should be rejected.

V. GROUND 4 – SPADARO IN VIEW OF HODGE AND NGUYEN (CLAIMS 15 AND 18)

A. The Petition Fails to Establish That the Combination of Spadaro with Hodge and Nguyen Would Have Been Obvious

This Preliminary Response has already demonstrated that the Petition has failed to establish that the combination of Spadaro and Hodge would have been obvious to a person of ordinary skill in the art. (*See* Section II.A *supra.*) This Preliminary Response has also previously demonstrated that the Petition fails to identify disclosure of all elements of Claim 10 in the combination of Spadaro and Hodge. (*See* Sections II.F-H *supra.*) Because Ground 4 also alleges the combination of Spadaro and Hodge, and because Claims 15 and 18 depend from Claim 10, the alleged combination of Ground 4 fails for the same reasons previously provided.

B. No Disclosure of Element 18[B] - “establishing another inmate account associated with said third party responsive to transferring the inmate to the other facility”

The Petition asserts that Hodge discloses this claim element, but it does not cite any portion of Hodge that discloses “establishing another inmate account . . . responsive to transferring the inmate.” Specifically, the Petition cites to Hodge as stating that “[w]hen an inmate is transferred from one facility to another, only the inmate’s account information, COS, and telephone lists are transferred to that

facility.” (Petition at p. 36.) But this does not indicate or infer that *another* inmate account is established responsive to the transfer. Petitioner has made that inference to reach its conclusion, but it there is no certainty as to how the system of Hodge would actually work. The uncertainty is evident in Petitioner’s statement that “a new account *needs* to be established at the new facility, *presumably* based on the transferred account information.” (*Id.*) Conclusions drawn from such conjecture is merely impermissible hindsight.

Because the Petition fails to properly identify how the combination of Nguyen with Spadaro and Hodge discloses the elements of Claims 15 and 18, Ground 4 must be rejected.

VI. GROUND 5 - BELLCORE IN VIEW OF HODGE (CLAIMS 1-4, 6-11, 14, 16, 17, 19, and 20)

A. The Petition Fails to Establish That the Combination of Bellcore with Hodge Would Have Been Obvious

The Petition asserts that a “person of ordinary skill in the art could have combined the functions of Hodge with the architecture of Bellcore by known methods. The results of the combination would have been predictable to a person of ordinary skill in the art.” (Petition at pp. 40-41.) These statements are conclusory and unsupported by sufficient evidence or analysis. In conjunction with these statements, the Petition cites to Paragraph 168 of the Forys Declaration as apparent

support. But Paragraph 168 of the Forys Declaration merely repeats the conclusory statements of the Petition without additional analysis or support. (Ex. 1003 at p. 80.)

Petitioner has failed to establish the prerequisites for demonstrating prima facie obviousness. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). The Petition does not provide the “known methods” that would be used to combine the functions of Hodge with the architecture of Bellcore. In fact, in making this statement, it doesn’t even specify the particular architecture disclosed by Bellcore that would be combined with Hodge. Nor does it explain why the combination would yield predictable results. (Petition at pp. 40-41.) The conclusory statements of the Petition and the Forys Declaration lack the “articulated reasoning” required to demonstrate that the combination of Bellcore and Hodge would have been obvious to a person of ordinary skill in the art.

Nothing in either Bellcore or Hodge would suggest the combination of these references. The Petition argues that “a person of ordinary skill in the art would understand, just like other customers, prison facilities would also benefit from using VOP services.” (Petition at pp. 38-39.) This statement is not supported by Bellcore or Hodge. Indeed, the Forys Declaration cites Bellcore as stating that the “target customers for VOP include business customers and residential customers,” neither

of which includes institutional facilities. (Ex. 1003 at p. 78.) The requirements of prison facilities are, in fact, very different from businesses and residences. The Petition's suggested combination of Bellcore and Hodge is based on nothing more than unfounded conclusory statements, and would not have been obvious.

As another example, the Petition asserts that the potential customer motivations explained by Bellcore—"to save money" and "for convenient access to new services"—would motivate a person of ordinary skill in the art to "use the VOP architecture of Bellcore with the prison communications functionality of Hodge." (Petition at p. 38 (citing Bellcore, 3-2).) But these statements are, again, conclusory and provided without articulated reasoning. The Petition does not cite to anything in Hodge that would indicate these benefits are important to a prison facility or that such benefits would motivate a person of ordinary skill in the art to combine the architecture of Bellcore with the functionality of Hodge. Hodge never references the use of a packet-based network in conjunction with its prison facility telecommunications system. (*See* Ex. 1005.) Nor does the functionality provided by the shadow and investigative workstations of Hodge correspond with the "need for network-based fraud detection" emphasized by Bellcore, as suggested by the Petition. (Petition at p. 40.) This assertion is offered without a hint of support.

Because the Petition fails to demonstrate a prima facie case that the combination of Bellcore with the teachings of Hodge was obvious, Ground 5 fails for all claims.

B. No Disclosure of Element 1[B] - “an inmate management-system . . .”

Independent Claim 1 of the '260 patent recites the following limitation: “an inmate management-system coupled to the networking device for providing shared data access of inmate records to computer terminals at said plurality of facilities, said inmate records created with first inmate information collected from a first computer terminal at a first facility of the plurality of facilities and second inmate information from a second computer terminal at a second facility of the plurality of facilities.” That limitation is referenced as the “inmate management-system” limitation in the Petition and “limitation 1[B]” by the Forys Declaration. (*See, e.g.*, Petition at p. 45; Ex. 1003 at p. 89.)

1. The Petition fails to identify an “inmate management-system” that is coupled to a “networking device”

The Petition relies on Figure B-2 of the Forys Declaration to demonstrate that the combination of Bellcore and Hodge discloses the “networking device” limitation. But Figure B-2 does not appear in either reference. Figure B-2 is a *twice* modified diagram combining Figures 4-2 and 5-11 of Bellcore with Figure 36 of Hodge. (*See* Ex. 1003 at pp. 75-82.) Neither Bellcore nor Hodge contemplates the system configuration that appears in Figure B-2 and Petitioner’s reliance on this

diagram to prove the combination of Bellcore with Hodge discloses the “inmate management-system” of Claim 1 is improper and provided without justification.

More specifically, the Petition relies on Figure B-2 to allege that the site server of Hodge (inmate management system) can be coupled to the Core Network of Bellcore (networking device). (*See* Petition at p. 46.) But as discussed above, the Petition provides no support for modifying either Bellcore or Hodge in the manner shown in Figure B-2. (*See* Section VI.A *supra*.) The Petition only offers the potential for Hodge’s site server to be “centralized” to explain why “a person of ordinary skill in the art would have found it obvious to couple Hodge’s site server to Bellcore’s Core Network.” (Petition at p. 46.) It provides this conclusion without further citation or support. But in fact, the site server of Hodge is not “centralized” under the meaning the Petition applies to that term to connect Hodge to Bellcore. Figure 36—from which the Petition has borrowed elements to fabricate Figure B-2—only illustrates the site server being accessed by telephones at a *single* facility. (*See* Ex. 1005 at Fig. 36 (noting single telephone bank 103 and contrasting to the placement of multiple telephone banks 103 in Figure B-2).) Despite Hodge labeling the site server as “central site server 113,” the term “central” merely means central *to the facility*. Evidence of Hodge’s use of the term in this manner is found in the description of Figure 36: “It is preferred that telephone bank 103 may be centrally located *within a facility* to allow for *centralized* monitoring.” (Ex. 1005 at 49:36-38

(emphasis added).) Despite the Petition's emphasis on the centralized nature of the Hodge system as a reason for combining Hodge with Bellcore, throughout its sixty-three page specification Hodge only references the use of the site server to connect switchboard devices of multiple institutions *once*. (See Ex. 1005 at 10:41-44.) The remainder of the Hodge disclosure focuses on implementation of the system at a single facility, hence the name "*site* server." (See, e.g., Ex. 1005 at Figure 36 (referencing a WAN, but only illustrating a single site).) The Petition's reliance on the "centralized" systems of Hodge and Bellcore to suggest a combination is misleading and inaccurate. Just as the Petitioner has done in attempting to combine Spadaro and Hodge in Grounds 1-4, it is again guilty of impermissible hindsight in combining Bellcore with Hodge. Nowhere is this more evident than in the use of the twice modified diagram of Figure B-2 to prove disclosure of the elements of Claim 1.

2. The Petition ignores limitations of the "inmate management-system"

Just as the Petition did for Ground 1, it again leaps to unsupported conclusions in asserting that the combination of Bellcore and Hodge discloses "said inmate records created with first inmate information collected from a first computer terminal at a first facility of the plurality of facilities and second inmate information from a second computer terminal at a second facility of the plurality of facilities." (Petition at p. 46-47.) Based on the disclosure of Hodge allowing an administrative

workstation to be located at every facility and to create, edit and monitor user accounts and telephone calls, the Petition asserts that “a person of ordinary skill in the art would have recognized that data for creating records in the system can be received from multiple ones of the different facilities.” (*Id.*) Not only is this statement unsupported and conclusory—cited Paragraph 184 of the Forys Declaration repeats the language of the Petition and offers more conclusory statements—but it does not address the actual claim language found in Claim 1 of the '260 patent. (*See* Ex. 1003 at p. 90.) The Petition fails to identify any inmate records disclosed by Hodge that are “created with first inmate information collected from. . . a first facility” and “second inmate information from. . . a second facility” as recited by Claim 1.

The Petition does not properly address the requirements of the claim language, and accordingly has not established a *prima facie* case of obviousness. Ground 5 fails for all claims at least because Petition has not demonstrated that Hodge discloses the “inmate management-system” limitation.

C. No Disclosure of Element 1[C] - “a call application management system . . .”

Independent Claim 1 of the '260 patent recites the following limitation: “a call application management system connecting a call to or from the telephone terminals over a telephone carrier network responsive to receiving a request for connecting the call and the call being authorized based on the inmate records provided by the inmate

management system.” That limitation is referenced as the “call application management system” limitation in the Petition and “limitation 1[C]” by the Forys Declaration. (*See, e.g.*, Petition at p. 47; Ex. 1003 at p. 91.)

The Petition asserts that the “call application management system” limitation is met by the combination of Bellcore and Hodge. And it further states that the trunk gateway and signaling gateway of Bellcore “provide the functionality of the claimed ‘call application management system.’” (Petition at p. 47.) But it does not articulate the elements of Hodge that would be combined with these elements of Bellcore to disclose the limitation. Specifically, the Petition indicates that Hodge discloses that calls are connected responsive to “being authorized based on the inmate records provided by the inmate management system.” (Petition at p. 48.) But it does not address the requirement that the inmate records are “provided by the *inmate management system*.” The Petition has previously identified the site server of Hodge as the “inmate management system.” (*See* Petition at pp. 45-47.) But in identifying the “call application management system,” the Petition fails to articulate how the site server of Hodge would be combined with the elements of Bellcore—namely the trunk gateway and signaling gateway—to disclose a “call application management system” corresponding to the system required by Claim 1. The call application management system of Claim 1 authorizes calls based on the inmate records *provided by the inmate management system*. But the Petition fails to identify any

specific combination of elements from Bellcore and Hodge that would interact to meet this limitation.

For that reason, the Petition has not established that the “call application management system” limitation is disclosed by Bellcore and Hodge. Ground 5 fails for all claims because Petitioner has not made a prima facie case of obviousness.

D. Petitioner’s Claim Chart for Claims 10, 14, 16, 17, 19, and 20 Is Inadequate to Establish the Obviousness of Those Claims

Despite significant differences in the claim language of Claims 10, 14, 16, 17, 19, and 20 from the language of Claims 1, 2, 8, 9, 6, and 7, the Petition alleges obviousness of these claims with only a claim chart entirely devoid of analysis. For each element of Claims 10, 14, 16, 17, 19, and 20, the claim chart consists only of a citation to a previous section of the Petition and brief excerpts from Bellcore and/or Hodge without explanation of how these references combine to disclose the claim elements. Petitioner’s only justification for this attempted shortcut (as provided in connection with Ground 1) is that “Claims 10, 14, 16, 17, 19 and 20 are method claims that include substantially the same limitations as claims 1, 2, 8, 9, 6 and 7, respectively.” (Petition at p. 23.) But no comparison between the two sets of claims is provided and no analysis of how the differences in claim language affect the obviousness analysis is offered. Even a cursory examination of the two claim sets reveals substantial differences in the structure and content of the claims.

The Petition's blanket citation to forty-six paragraphs (covering twenty-three pages) of the Forys Declaration offers no help in the analysis because no citation for individual claim elements is provided. Further, under 37 C.F.R. § 42.22(a)(2) the petition must contain a "full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence." The rules also prohibit arguments made in a supporting document from being incorporated by reference into a petition. *See* 37 C.F.R. § 42.6(a)(3). For that reason, the information presented in the Forys Declaration in relation to Claims 10, 14, 16, 17, 19 and 20, wherein the arguments have not been presented sufficiently in the Petition, should not be considered.

On the basis that Petitioner has not provided adequate support for its assertion that the combination of Bellcore with Hodge renders Claims 10, 14, 16, 17, 19 and 20 obvious, Ground 5 should be denied for those claims.

E. No Disclosure of Element 6[A] – “wherein the plurality of facilities comprise different types of facilities.”

The Petition cites to Hodge as allegedly disclosing this limitation. (Petition at pp. 49-50.) But nothing in Petitioner's lone citation shows that Hodge discloses a system in which a "plurality of facilities comprise different types of facilities." Hodge's disclosure that "many types of institutional environments" may find use in such a system does not equate to a system with different types of facilities having shared data access to inmate records. Petitioner's assertion in Section V.A.6 of the

Petition that “it would have been obvious to a person of ordinary skill in the art that multiple types of facilities associated with inmates (e.g., police and Court system) could be served simultaneously by the computer system as these facilities would require access to similar information and call processing functionality” is nothing more than unsupported and conclusory conjecture. (Petition at pp. 21-22.)

F. No Disclosure of Element 10[B2] – “receiving from a second computer terminal at the second facility, second inmate information associated with the inmate”

The claim chart of the Petition cites to Hodge as allegedly disclosing this limitation. (Petition at p. 52.) But nothing in Petitioner’s citations show that Hodge discloses “receiving . . . at a second facility, second inmate information associated with the inmate.” Specifically, none of the citations to Hodge discloses that inmate information for the *same* inmate is received from both a first facility and a second facility. Section V.E.1.c of the Petition, cited to in the chart, provides no additional support that would establish this element is disclosed by Hodge.

G. No Disclosure of Element 10[B3] – “storing the inmate record in the computer-based system for shared access across to the inmate record computer terminals in the multiple facilities”

The claim chart of the Petition cites to Hodge as allegedly disclosing this limitation. (Petition at p. 53.) The only citation to Hodge provided in the chart as allegedly disclosing this limitation does not provide any disclosure of “shared access” to the inmate record at “multiple facilities.” As discussed in further detail

in Section VI.B.1 of this Preliminary Response, Hodge does not use the term “central” to indicate access to multiple facilities. (*See* Section IV.B.1 *supra*.) Thus, reference to the central site server by Hodge, cannot be used to infer shared data access to multiple facilities. The Petition, thus, fails to cite any portion of Hodge or Bellcore that discloses this claim element. Section V.E.1.c of the Petition, cited to in the chart, provides no additional support that would establish this element is disclosed by Hodge.

H. No Disclosure of Element 19[A] – “wherein the multiple facilities comprise different types of facilities”

The Petition cites to Hodge as allegedly disclosing this limitation. (Petition at p. 56.) But nothing in Petitioner’s lone citation shows that Hodge discloses a system in which a “plurality of facilities comprise *different types* of facilities.” Hodge’s disclosure that “many types of institutional environments” may find use in such a system does not equate to a system with different types of facilities having shared data access to inmate records. Petitioner’s assertion in Section V.A.6 of the Petition that “it would have been obvious to a person of ordinary skill in the art that multiple types of facilities associated with inmates (e.g., police and Court system) could be served simultaneously by the computer system as these facilities would require access to similar information and call processing functionality” is nothing more than unsupported and conclusory conjecture. (Petition at pp. 21-22.)

I. No Disclosure of Element 11[A] – “wherein said first inmate information is received upon said inmate’s arrest”

The Petition asserts that the combination of Bellcore and Hodge disclose this limitation. But the Petition fails to cite to any portion of Bellcore or Hodge that discloses receiving inmate information into a computer-based system upon arrest. Petitioner attempts to stretch the language of Hodge to allege disclosure of this element, but fails to demonstrate proper support for its conclusory statements. Providing an inmate with a telephone account upon arrival at a penal institution, is much different than receiving inmate information into a computer-based system *upon arrest*. (See Petition at p. 57.) The Forys Declaration’s ultimate conclusion that “a person of ordinary skill in the art would have understood that call processing and data management systems described in Spadaro [sic] and Hodge could be used to service a police station or other similar facility, and that a telephone account could be provided to a person upon his “arrival” (e.g., arrest) at that location” is an unsubstantiated leap well beyond the minimal disclosure cited from Hodge. (Ex. 1003 at p. 110.)

VII. GROUND 6 - BELLCORE IN VIEW OF HODGE AND BOYKIN (CLAIMS 5 and 12)

A. The Petition Fails to Establish That the Combination of Bellcore with Hodge and Boykin Would Have Been Obvious

This Preliminary Response has already demonstrated that the Petition has failed to establish that the combination of Bellcore and Hodge would have been

obvious to a person of ordinary skill in the art. (*See* Section VI.A *supra.*) This Preliminary Response has also previously demonstrated that the Petition fails to identify disclosure of all elements of Claims 1, 10, and 11 in the combination of Bellcore and Hodge. (*See* Sections VI.B-D, F-G, and I *supra.*) Because Ground 6 also alleges the combination of Bellcore and Hodge, and because Claim 5 depends from Claim 1 and Claim 12 depends from Claims 10 and 11, the alleged combination of Ground 6 fails for the same reasons previously provided.

Additionally, the Petition omits any attempt to justify the combination of Boykin with Bellcore and/or Hodge. In fact, by abbreviating its analysis into a claim chart for proving the combination of Spadaro, Hodge, and Boykin, it has ignored all discussion of the factors that might lead a person of ordinary skill in the art to combine Bellcore with Hodge and Boykin. Thus, Petitioner has failed to establish the prerequisites for demonstrating *prima facie* obviousness in Ground 6.

In fact, nothing in Boykin would suggest the combination with Bellcore and/or Hodge. Boykin makes no reference to VOP networks, prison facilities, controlled environments, managing inmate information, or call processing. The Petition cites nothing in any of the three references that would lead a person of ordinary skill in the art to seek out one of the other references.

Because the Petition fails to demonstrate a prima facie case that the combination of Boykin with the teachings of Bellcore and Hodge was obvious, Ground 6 fails for all claims.

B. No Disclosure of Element 5[A] - “wherein said plurality of facilities comprise a mobile police station”

The Petition asserts that Boykin discloses this claim element, but the cited excerpts from Boykin establish nothing more than a vehicle having a mobile server for capturing, storing, and transmitting information. (Petition at pp. 57-58.) The vehicle disclosed by Boykin—even if it is a police vehicle—has not been demonstrated to correspond to the mobile police station of Claim 5. The Petition alleges, without basis, that a “police vehicle is a mobile police station.” (*Id.* at p. 31.)

In reaching this strained conclusion, the Petition disregards the limitations Claim 1 places on the “plurality of facilities.” For example, Claim 1 requires “each of the facilities [to have] one or more telephone terminals and computer terminals.” Claim 1 also requires the plurality of facilities to have a “call processing gateway.” The Petition does not address how the police vehicle disclosed by Boykin, and identified as the “mobile police station,” meets these limitations.

Because the Petition fails to properly identify how the combination of Boykin with Spadaro and Hodge discloses the “mobile police station” recited in Claim 5, Ground 6 fails for Claim 5.

C. No Disclosure of Element 12[A] - “wherein said first facility comprises a mobile police station”

For the same reasons provided in Section VII.B, the combination of Boykin with Bellcore and Hodge does not disclose this claim element. The Petition again disregards the limitations Claim 10 places on the “first facility.” For example, Claim 10 requires “each facility [to comprise] multiple telephone terminals and computer terminals.” Claim 10 also requires the first facility to receive “from a first computer terminal first inmate information associated with an inmate for creating an inmate record.” The Petition does not address how the police vehicle disclosed by Boykin, and identified as the “mobile police station,” meets these limitations.

Because the Petition fails to properly identify how the combination of Boykin with Bellcore and Hodge discloses the “mobile police station” recited in Claim 12, Ground 6 fails for Claim 12.

VIII. GROUND 7 - BELLCORE IN VIEW OF HODGE AND CREE (CLAIM 13)

A. The Petition Fails to Establish That the Combination of Bellcore with Hodge and Cree Would Have Been Obvious

This Preliminary Response has already demonstrated that the Petition has failed to establish that the combination of Bellcore and Hodge would have been obvious to a person of ordinary skill in the art. (*See* Section VI.A *supra.*) This Preliminary Response has also previously demonstrated that the Petition fails to identify disclosure of all elements of Claim 10 in the combination of Bellcore and

Hodge. (*See* Sections VI.D, F, and G *supra*.) Because Ground 7 also alleges the combination of Bellcore and Hodge, and because Claim 13 depends from Claim 10, the alleged combination of Ground 7 fails for the same reasons previously provided.

Additionally, the Petition omits any attempt to justify the combination of Cree with Bellcore and/or Hodge. It merely references the discussion regarding the combination of Spadaro, Hodge, and Cree, to explain why “person having ordinary skill in the art would have combined Bellcore and Hodge with Cree.” (Petition at p. 59.) But in doing so, the Petition ignores any discussion of the factors that would lead a person of ordinary skill in the art to combine *Bellcore* with Hodge and Cree. And as discussed previously, Section V.C of the Petition provides nothing but conclusory statements unsupported by any evidence or analysis sufficient to justify the combination of references.

Petitioner has failed to establish the prerequisites for demonstrating prima facie obviousness in Ground 7. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). No reasoning or support is provided for the Petition’s combination of Bellcore with Hodge and Cree.

Because the Petition fails to demonstrate a prima facie case that the combination of Cree with the teachings of Bellcore and Hodge was obvious, Ground 7 should be denied.

B. No Disclosure of Element 13[A] - “modifying said inmate record responsive to transferring the inmate from one facility of the multiple facilities to another facility of the multiple facilities”

The Petition asserts that Cree discloses this claim element, but it fails to identify an “inmate record” that is modified responsive to the transfer of the inmate. (Petition at p. 58.) The Petition cites only to one reference in Cree regarding transfer of an inmate: “Preferably, the active list includes a cell block telephone number, which is updated regularly by, for example, a system administrator to account for the release or transfer of inmates.” (*Id.*) But the Petition does not establish that the “active list” being updated is an *inmate record*. In fact, the “active list” refers to a “list of inmates that may be contacted by a remote caller for that account.” (Ex. 1008 at 5:50-53.) Thus, the “active list” is not information associated with an inmate. It is information associated with a *remote caller*. And more specifically, information associated with an account associated with a remote caller. (*Id.*) Thus, the reference in Cree cited to by the Petition does not identify the modification of an “inmate record responsive to transferring the inmate.”

Because the Petition fails to properly identify how the combination of Cree with Bellcore and Hodge discloses the “modifying said inmate record responsive to transferring the inmate” limitation recited in Claim 13, Ground 7 should be rejected.

IX. GROUND 8 – BELLCORE IN VIEW OF HODGE AND NGUYEN (CLAIMS 15 AND 18)

A. The Petition Fails to Establish That the Combination of Spadaro with Hodge and Nguyen Would Have Been Obvious

This Preliminary Response has already demonstrated that the Petition has failed to establish that the combination of Bellcore and Hodge would have been obvious to a person of ordinary skill in the art. (*See* Section VI.A *supra.*) This Preliminary Response has also previously demonstrated that the Petition fails to identify disclosure of all elements of Claim 10 in the combination of Bellcore and Hodge. (*See* Sections VI.D, F, and G *supra.*) Because Ground 8 also alleges the combination of Bellcore and Hodge, and because Claims 15 and 18 depend from Claim 10, the alleged combination of Ground 8 fails for the same reasons previously provided.

B. No Disclosure of Element 18[B] - “establishing another inmate account associated with said third party responsive to transferring the inmate to the other facility”

The Petition asserts that Hodge discloses this claim element, but it does not cite any portion of Hodge that discloses this limitation. Specifically, the Petition cites to Hodge as stating that “[w]hen an inmate is transferred from one facility to another, only the inmate’s account information, COS, and telephone lists are

transferred to that facility.” (Petition at p. 60.) But this does not indicate or infer that *another* inmate account is established responsive to the transfer. Petitioner has made that inference to reach its conclusion, but it there is no certainty as to how the system of Hodge would actually work. The uncertainty is evident in Petitioner’s statement found in Section V.D.2 that “a new account *needs* to be established at the new facility, *presumably* based on the transferred account information.” (*Id.* at p. 36.) Conclusions drawn from such conjecture is merely impermissible hindsight.

Because the Petition fails to properly identify how the combination of Nguyen with Bellcore and Hodge discloses the elements of Claims 15 and 18, Ground 8 must be denied.

X. CONCLUSIONS

This Preliminary Response shows that none of the Grounds proposed in the Petition are reasonably likely to invalidate any of the claims of the ’260 patent. For the reasons contained herein, Patent Owner requests that the PTAB deny the Petition.

Dated: September 9, 2014

Respectfully submitted,

A handwritten signature in blue ink that reads "Justin B. Kimble". The signature is fluid and cursive, with a long horizontal stroke at the end.

Justin B. Kimble
Attorney for Patent Owner
Registration No. 58,591
Bragalone Conroy P.C.
2200 Ross Ave.
Suite 4500 – West
Dallas, TX 75201

CERTIFICATE OF SERVICE

The undersigned hereby certifies that document was served via electronic mail on September 9, 2014, to Petitioner via counsel, Lori A. Gordon and Michael B. Ray, at the email addresses: lgordon-PTAB@skgf.com and mray-PTAB@skgf.com, pursuant to Petitioner's consent in its Petition at p. 3.

A handwritten signature in blue ink that reads "Justin B. Kimble". The signature is fluid and cursive, with a long horizontal stroke at the end.

Justin B. Kimble
Attorney for Patent Owner
Registration No. 58,591
Bragalone Conroy P.C.
2200 Ross Ave.
Suite 4500 – West
Dallas, TX 75201