

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GLOBAL TEL\*LINK CORPORATION,  
Petitioner,

v.

SECURUS TECHNOLOGIES, INC.,  
Patent Owner.

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Case IPR2014-00824  
Patent 8,340,260 B1

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

BENOIT, *Administrative Patent Judge*.

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

## INTRODUCTION

Global Tel\*Link Corporation (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1-20 (the “challenged claims”) of U.S. Patent No. 8,340,260 B1 (Ex. 1001, “the ’260 patent”). Patent Owner, Securus Technologies, Inc., filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

After considering the Petition and the Preliminary Response, we determine that Petitioner has established a reasonable likelihood of prevailing on the claims challenged in the Petition. Accordingly, we institute an *inter partes* review of claims 1-20 of the ’260 patent.

### *A. Related Matters*

Petitioner has requested *inter partes* review of related patents—U.S. Patent No. 7,899,167 B1 (IPR2014-00493), U.S. Patent No. 8,577,003 B2 (IPR2014-00749), and U.S. Patent No. 7,529,357 B1 (IPR2014-00825).

### *B. The ’260 Patent*

The ’260 patent, titled “Inmate Management and Call Processing Systems and Methods,” issued December 25, 2012 from an application that is a continuation of an application filed July 12, 2007, which, in turn, is a continuation-in-part of an application filed on August 15, 2003. The ’260 patent describes providing centralized inmate management and call processing capabilities to controlled-environment facilities, such as prisons.

Ex. 1001, Abstract, 2:62–65. The described techniques, for example, address information management problems that may occur when an inmate is transferred to a different facility. *Id.* at 2:52–59; *see generally id.* at 1:65–2:51. Such problems include gathering information multiple times, processing the same information by multiple facilities, and storing information about an inmate in different systems so that multiple systems must be accessed to obtain information about an inmate. *Id.* at 2:52–59.

Figure 1 of the '260 patent is set forth below:

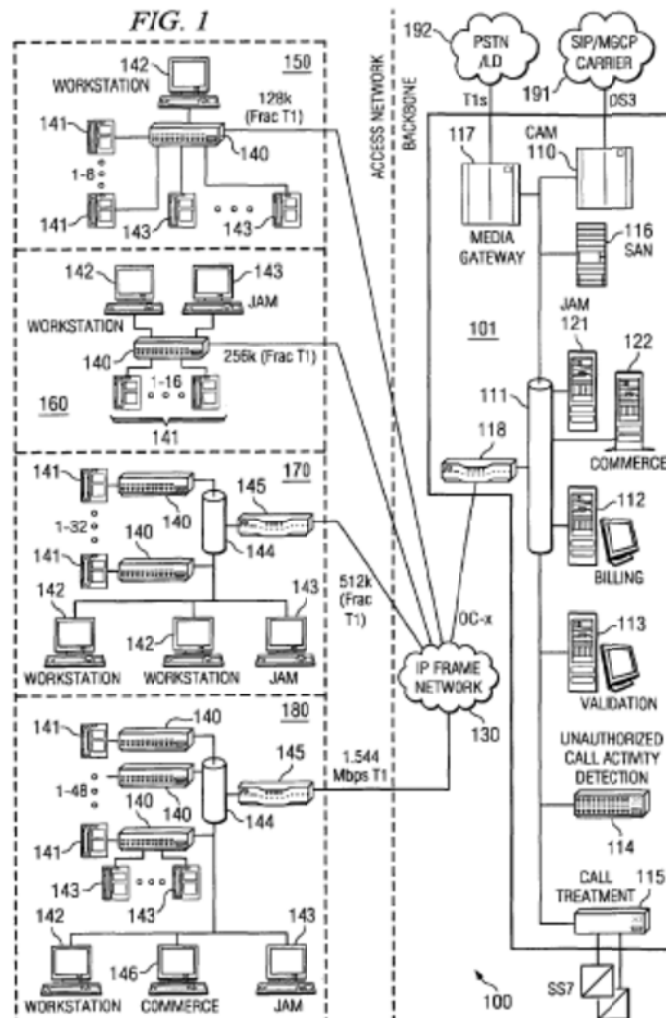


Figure 1 illustrates a centralized inmate management and call processing system 100.

Centralized inmate management and call processing system 100 provides calling services to facilities 150, 160, 170, 180 and includes computer-based platform 101, which communicates with facilities 150, 160, 170, 180 through network 130. *Id.* at 6:37–42, 6:53–55. Call processing gateways 140, at or near sites for which inmate management and calling services are to be provided (i.e., facilities 150, 160, 170, 180), convert analog signals associated with telephone terminals 141 (or visitation telephones 143) to digital data packets sent over network 130. *Id.* at 6:66–7:3, 7:12–16.

Computer-based platform 101 includes, among other components, call application management system 110, which controls completing a call between a party using one of telephone terminals 141 (or visitation telephones 143) and another party using a telephone terminal (not shown), over PSTN 192 or digital network 191. *Id.* at 9:14–21. Call application management system 110 provides a data interface coupling call application management system 110 through network 130 and providing Voice over Internet Protocol (“VoIP”) communication between call application management system 110 and facilities 150, 160, 170, 180. *Id.* at 9:34–38.

Computer-based platform 101 also includes validation system 113 and unauthorized call activity detection system 114 to provide “call intelligence” to determine whether a particular call should be permitted. *Id.* at 10:33–39.

Computer-based platform 101 also includes justice application management system 121, which is an information management system providing data collection and sharing among facilities 150, 160, 170, 180. *Id.* at 8:60–9:9. An inmate management database includes information about inmates and may be managed by justice application management

system 121 or a similar inmate management system. *Id.* at 14:47–53.

Information for an inmate record may include biometric data (such as finger prints, voice prints, and retina scans), information about an inmate’s arrest, visitation records, call records, medical records, and contact information of third parties known to the inmate, who may be notified of an inmate’s transfer between facilities. *Id.* at 16:7–13, 16:30–47, 17:37–42.

Records stored into the inmate management database are accessible to multiple facilities, such as county and municipal jails, state penitentiaries, and federal prisons. *Id.* at 17:15–19. An inmate record created upon arrest or during incarceration at a first facility may be used when the inmate is transferred to a subsequent facility. *Id.* at 18:56–59. The ’260 patent describes an example in which a person is arrested and taken by “a police squad car (or any other mobile police station)” to the police department. *Id.* at 15:28–32. An inmate record is created in the squad car and then transmitted to the inmate management database of computer-based platform 101, from which the information is accessed during a booking procedure at the police department. *Id.* at 15:28–32, 15:45–51.

### *C. Challenged Claims*

Of the challenged claims, claims 1 and 10 are independent. Claims 1 and 10, reproduced below, are illustrative of the claimed subject matter:

1. A computer-based system, at a plurality of facilities, for managing inmate information, each of the facilities having one or more telephone terminals and computer terminals, the computer-based system located remotely from at least one of the plurality of facilities, the system comprising:

- 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 for transmission over the communication links;

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; and

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.

Ex. 1001, 25:32–55.

10. A method for managing inmate information at multiple facilities including a first facility and a second facility, each facility comprising multiple telephone terminals and computer terminals, the method carried out in a computer-based system located remotely from at least one of the multiple facilities, the method comprising:

receiving, from a first computer terminal at the first facility, first inmate information associated with an inmate;

receiving, from a second computer terminal at the second facility, second inmate information associated with the inmate;

generating an inmate record based on the first inmate information and the second inmate information;

storing the inmate record in the computer-based system for shared access across to the inmate record computer terminals in the multiple facilities;

receiving a request from one of the multiple telephone terminals for connection of a call over a telephone carrier network; and

connecting the call from one of the telephone terminals over a telephone carrier network and a communication link responsive to authorizing the call based on the inmate records stored in the computer-based system.

*Id.* at 26:16–39.

#### *D. Asserted Grounds of Unpatentability*

Petitioner contends the challenged claims are unpatentable based on the following grounds (Pet. 3–4):

References	Basis	Claims challenged
Spadaro <sup>1</sup> and Hodge <sup>2</sup>	§ 103	1–4, 6–11, 14, 16, 17, 19, and 20
Spadaro, Hodge, and Boykin <sup>3</sup>	§ 103	5 and 12
Spadaro, Hodge, and Cree <sup>4</sup>	§ 103	13
Spadaro, Hodge, and Nguyen <sup>5</sup>	§ 103	15 and 18
Bellcore <sup>6</sup> and Hodge	§ 103	1–4, 6–11, 14, 16, 17, 19, and 20
Bellcore, Hodge, and Boykin	§ 103	5 and 12
Bellcore, Hodge, and Cree	§ 103	13
Bellcore, Hodge, and Nguyen	§ 103	15 and 18

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<sup>1</sup> U.S. Patent No. 7,505,406 B1, issued Mar. 17, 2009, filed July 13, 2001 (Ex. 1004) (“Spadaro”).

<sup>2</sup> U.S. Patent No. 7,333,798 B2, issued Feb. 19, 2008, filed Aug. 8, 2002 (Ex. 1005) (“Hodge”).

<sup>3</sup> U.S. Patent No. 6,831,556 B1, issued Dec. 14, 2004, filed May 16, 2001 (Ex. 1007) (“Boykin”).

<sup>4</sup> U.S. Patent No. 6,665,380 B1, issued Dec. 16, 2003, filed Jan. 11, 1999 (Ex. 1008) (“Cree”).

<sup>5</sup> U.S. Patent No. 5,861,810, issued Jan. 19, 1999 (Ex. 1009) (“Nguyen”).

<sup>6</sup> BELLCORE, *Voice Over Packet in Next Generation Networks: An Architectural Framework*, Special Report SR-4717, Issue 1 (Jan. 1999) (Ex. 1006) (“Bellcore”).

## ANALYSIS

A ground of unpatentability can be instituted only if the petition supporting the ground demonstrates there is a reasonable likelihood that at least one challenged claim is unpatentable. 37 C.F.R. § 42.108(c). In the analysis that follows, we discuss facts as they have been presented thus far in this proceeding. Any inferences or conclusions drawn from those facts are neither final nor dispositive of any issue related to any ground on which we institute review.

### *A. Claim Construction*

In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their broadest reasonable constructions in light of the specification of the patent in which they appear. *See* 37 C.F.R. § 42.100(b); *see also* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012). Under the broadest reasonable construction standard, claim terms are presumed to be given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

We have considered the claim terms that the parties identify for construction. *See* Pet. 7–8; Prelim. Resp. 12–13. We have determined no terms in the challenged claims require express construction for this decision.

### *B. Obviousness over Spadaro and Hodge*

Petitioner contends claims 1–4, 6–11, 14, 16, 17, 19, and 20 would have been obvious under § 103 over Spadaro and Hodge. Pet. 8–30. Petitioner provides explanations and claim charts specifying where claim limitations purportedly are disclosed or suggested in Spadaro and Hodges, rationale for combining the references, and supporting testimony by



Leonard J. Forys, Ph.D. (Ex. 1003). *Id.* Petitioner asserts both Spadaro and Hodge qualify as prior art to the '260 patent at least under 35 U.S.C.

§ 102(e). *Id.* at 4–5.

We determine Petitioner has demonstrated a reasonable likelihood that claims 1–4, 6–11, 14, 16, 17, 19, and 20 would have been obvious over Spadaro and Hodges for the reasons that follow.

*1. Spadaro*

Spadaro describes monitoring and controlling public telephone usage by inmates at a prison. Ex. 1004, 2:38–42. Telephones are connected to a control computer that establishes a connection to a telephone network, such as a public switched telephone network (“PSTN”). *Id.* at 2:48–57; *see id.* at Fig. 1. The control computer is located at the prison and provides for switching, accessing, routing, timing, billing, and the control of the telephones at the prison. *Id.* at 2:45–49. As a way to control telephone usage, the control computer includes a three-way call detection system and PIN checking to restrict telephone usage based on a PIN associated with a calling card number used to place a call. *Id.* at 3:32–42; *see* Fig. 1.

Spadaro describes a multiple site telephone system in Figure 3, which is set forth below:

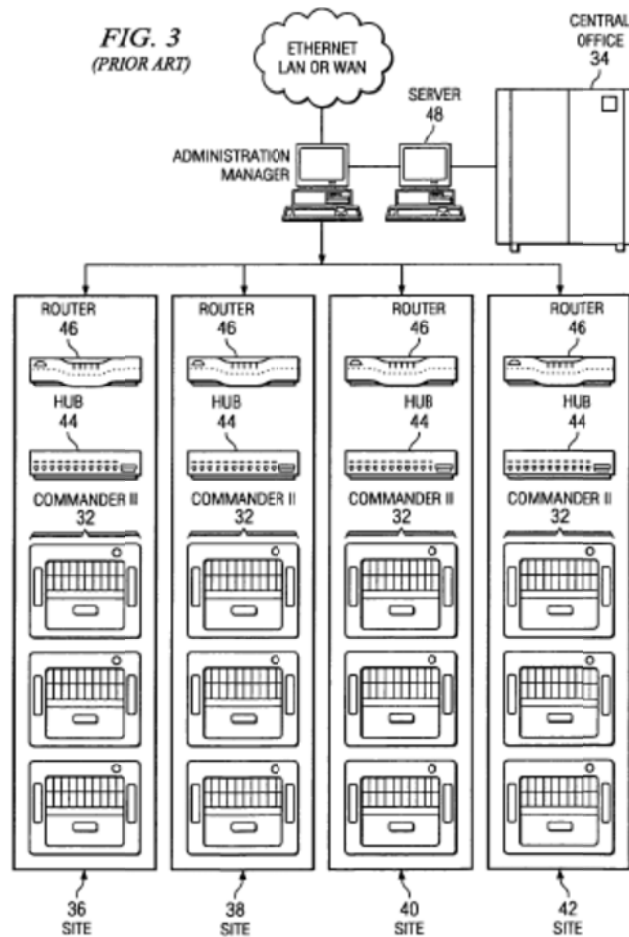


Figure 3 illustrates a multiple site telephone system.

*See* Ex. 1004, 2:25–26. Figure 3 shows four sites 36, 38, 40, 42, each of which has multiple control computers 32 connected through hubs 44 to router 46. *Id.* at 3:53–55. Each of the sites may be a prison in a state-wide prison system. *Id.* at 3:61–62. Calls from each of the four sites are routed from each site’s router 46 to server 48, which connects the calls to central office 34. *Id.* at 3:55–57. Spadaro describes obtaining lower cost and efficiency by operating the system shown in Figure 3 over Ethernet and Voice over Internet Protocol (“VoIP”) networks. *Id.* at 3:58–62.

Spadaro also describes telephone systems in which control functions, including PIN checking, are distributed to a remote location over an Ethernet

network (*id.* at 4:4–10; Fig. 4) and over a network that includes both VoIP and data (*id.* at 2:30–31, Fig. 5). Spadaro’s Figure 5 is set forth below:

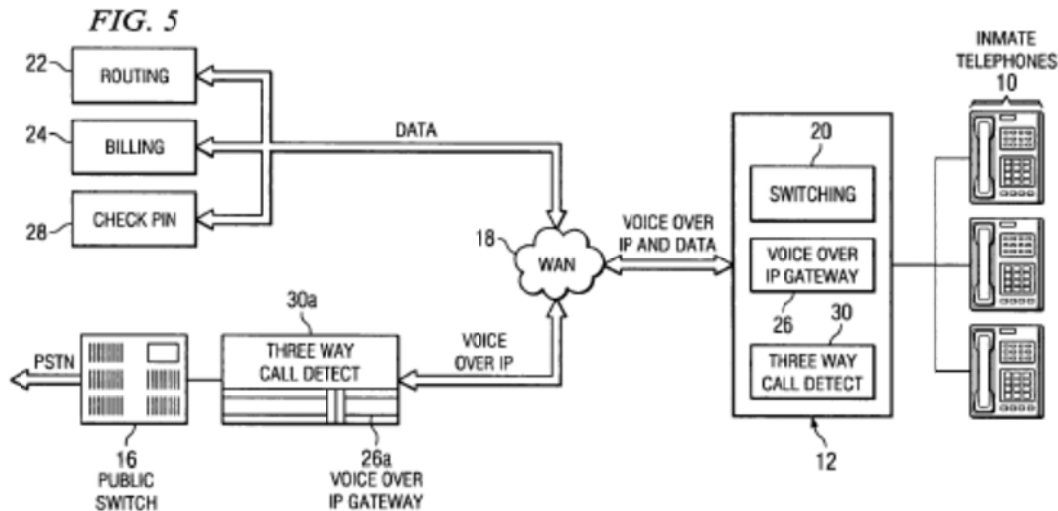


Figure 5 illustrates a telephone system that distributes control functions to a remote location over a VoIP and data network.

Ex. 1004, 2:27–30, 4:4–9, 4:25–27.

Figure 5 shows control functions—routing 22, billing 24, and PIN checking 28—distributed to a location remote from the inmate telephones 10. *Id.* at 4:6–10, 4:25–27. Spadaro explains that an advantage of distributing these functions to a remote location is that “the functions can be centralized with the functions being performed at a central administration location.” *Id.* at 4:10–13.

Also shown in Figure 5, “three-way call detection 30a is moved from the site, i.e. in the control computer 12 as indicated at 30, to a point beyond the VoIP network.” *Id.* at 4:27–30. Spadaro explains that VoIP transmission requires voice compression and packetizing, which are detrimental to the ability to perform three-way call detection. *Id.* at 4:30–32. “Therefore, three way call detection is performed at 30a after the telephony

signals have been decompressed and depacketized by the VoIP gateway 26a.” *Id.* at 4:32–35.

## 2. *Hodge*

Hodge describes a secure telephone call management system for use in penal institutions. Ex. 1005, Abstract, 9:48–53. Hodge describes a site server that is “connected to multiple switchboard devices that are located in separate institutions” and that “serves as the database location for the entire system.” *Id.* at 10:41–44. Administrative workstations are located at the facilities for creating and maintaining user account information. *Id.* at 10:44–46.

## 3. *Claim 1*

### *Petitioner’s and Patent Owner’s Contentions*

Petitioner, with support from its declarant, contends that Spadaro discloses or suggests 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 for transmission over the communication links” (“the networking device limitation”), recited in claim 1. Pet. 15–16.

Specifically, Petitioner relies on Spadaro’s disclosure that server 48 is connected to multiple sites 36, 38, 40, 42 through a router 46 at each site. Pet. 15 (citing Ex. 1004, 3:53–57). As noted by Petitioner, Spadaro’s control computers are located at sites 36, 38, 40, 42, which, according to Spadaro, may be prison facilities. *Id.*; *see* Ex. 1004, 3:53–62.

Petitioner contends Spadaro's server 48 discloses or suggests the recited networking device. Petitioner also contends that Spadaro's control computers (also called "Commander™ units" after a particular model) have "a VoIP gateway and Ethernet capability" and so disclose or suggest the recited call processing gateways. Pet. 15 (citing Ex. 1004, 4:1–2).

For the recited inmate management system, Petitioner relies on Hodge's description of a site server that is "connected to multiple switchboard devices that are located in separate institutions" and that "serves as the database location for the entire system." *Id.* at 16 (citing Ex. 1005, 10:41–45). At the site server, inmate information, including user call information, financial transaction data, call restrictions, personal identification numbers (PINs), and biometric data, is "digitized for efficient data transfer and efficient record keeping." *Id.* at 16–17 (citing Ex. 1005, 19:39–44). Administrative workstations, located at each facility, are used to create, edit, and monitor user accounts and telephone calls. *Id.* at 17 (citing Ex. 1005, 10:35–40).

For the recited call application management system, Petitioner asserts the combination of Spadaro and Hodge disclose or suggest this limitation. Pet. 18–19. Regarding Spadaro, Petitioner relies on VoIP Gateway 26a for disclosing or suggesting the recited "call application management system" for processing outgoing VoIP data packets from prison facilities for transmission to a telephone carrier network. *Id.* As shown in Figure 5 and noted by Petitioner, Spadaro's VoIP Gateway 26a transmits outgoing calls from the telephone terminals in the prison facility to a telephone carrier network (Spadaro's public switch 16). *Id.* (citing Ex. 1004, 4:49–53). Further, according to Petitioner, Spadaro describes restricting telephone

usage associated with a PIN, which discloses or suggests authorizing calls based on inmate records. *Id.* at 19 (citing Ex. 1004, 3:35–37). Relying on support from its declarant, Petitioner asserts that a person of ordinary skill in the art would understand Spadaro’s call connection as being “responsive to receiving a request for connecting a call,” noting the everyday experience of telephone users in which calls are placed responsive to a request by a caller (i.e., dialing a telephone number to be called). *Id.* at 18–19 (citing Ex. 1003 ¶ 81).

Petitioner contends, with support from its declarant, a person of ordinary skill in the art would have looked to Hodge for how to store and manage the centralized information described by Spadaro. *Id.* at 12–13 (citing Ex. 1003 ¶ 64). Petitioner further asserts, again with support from its declarant, that the proposed combination of the functions of Hodge with the system of Spadaro could have been accomplished by known methods and is a predictable variation. *Id.* at 13 (citing Ex. 1003 ¶ 66).

As a general matter, Patent Owner essentially contends that the Board should give deference to the Examiner’s earlier determination of allowability over Spadaro and Hodge, of which the Examiner was aware during prosecution. Prelim. Resp. 7–8. Patent Owner also challenges Petitioner’s reasoning, as conclusory and unsupported by evidence or analysis, why a person of ordinary skill in the art would have combined Spadaro and Hodge in the manner proposed by Petitioner. *Id.* at 14–15. Patent Owner further challenges Petitioner’s proposed combination of Spadaro and Hodge as not disclosing the limitations of claim 1—the networking device limitation, an inmate management system, and a call application management system. *Id.* at 16–23.

*Analysis Regarding Claim 1*

On this record, we are persuaded Petitioner has demonstrated a reasonable likelihood of prevailing in showing that the devices recited in claim 1 and connected in the manner recited in claim 1 would have been obvious over Spadaro and Hodge. For example, Petitioner's proposed combination relies on Spadaro's control computers (as disclosing or suggesting the recited call processing gateways), server 48 (as disclosing or suggesting the recited networking device), VoIP gateway (as disclosing or suggesting the recited call application management system), and PIN checking 38 shown, for example, in Figures 3 and 5 (as disclosing or suggesting authorizing a call based on inmate records provided by the inmate management system). Pet. 15–16, 18–19.

Petitioner's proposed combination also relies on Spadaro's Figure 3, which depicts a “multiple site telephone system” (Ex. 1004, 2:25–26) and which can be “operated over Ethernet and Voice over Internet Protocol networks” to obtain lower cost and efficiency (*id.* at 3:58–61). Pet. 9-11, 15-16. According to Petitioner, Spadaro's multiple site telephone system operating over VoIP discloses or suggests “exchanging [VoIP] data packets with call processing gateways at the plurality of facilities over communication links,” as recited in claim 1.

Petitioner's proposed combination also relies on Spadaro's Figure 5, which shows distributing PIN checking “to a remote location” over a WAN, which “has the advantage that the functions can be centralized with the functions being performed at a central administration location.” Pet. 10–11 (citing Ex. 1004, 4:10–13); *see* Ex. 1004, 2:29–30.

Petitioner further asserts, with support from its declarant, the proposed combination of the functions of Hodge with the system of Spadaro could have been accomplished by known methods and is a predictable variation. *Id.* at 13 (citing Ex. 1003 ¶ 66). Petitioner, relying on its declarant, also provides a reason why one skilled in the art would have combined the references in the manner proposed by Petitioner—because Hodge describes how to create and edit information on a centralized call processing system *Id.* at 12-13 (citing Ex. 1003 ¶ 63).

On this record and for purposes of institution, we are persuaded Petitioner’s proposed combination of Spadaro and Hodge is a predictable variation using prior art elements according to their established functions. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) (“If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.”).

On this record, we are not persuaded by Patent Owner’s contentions that Petitioner fails to have a reasonable likelihood of prevailing. Many of Patent Owner’s arguments amount to an attack on Spadaro or Hodge individually without consideration of what Petitioner’s combination would have suggested to one of ordinary skill in the art, an approach we find unpersuasive. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981) (“[O]ne cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references.”).

More specifically, Patent Owner contends that Petitioner’s proposed combination would not render obvious claim 1, because Spadaro does not disclose the networking device limitation. Prelim. Resp. 16–18. Specifically, Patent Owner contends that (i) the Petition impermissibly relies



on a combination of Spadaro's Figures 3 and 5, as combined by Petitioner's declarant in Petition Figure A, for the networking device limitation and (ii) Spadaro's server 48 does not disclose or suggest the recited networking device because server 48 does not "exchang[e] Voice over Internet Protocol (VoIP) data packets with call processing gateways," as required by claim 1. *Id.*

First, we are persuaded, on the present record, that a person ordinarily skilled in the art would understand the techniques related Spadaro's Figure 3 (depicting centralized call processing used to serve multiple prison facilities) and techniques related to Figure 5 (depicting VoIP technology together with a centralized call processing system) could be used together, as indicated by Petitioner's declarant. Pet. 10 (citing Ex. 1003 ¶ 60).

Second, Spadaro's Figure 3, on which Petitioner relies, shows "four sites" each with control computers ("Commander<sup>TM</sup> units"). Ex. 1004, 3:53–57. Each site has a router 46 that "routes calls to a server 48 which connects the calls to central office 34" (*id.*), as acknowledged by Patent Owner (Prelim. Resp. 18). Petitioner further relies on Spadaro's indication that "lower cost and efficiency are obtained by operating systems such as shown in FIGS. 2 and 3 [which include server 48] over Ethernet and Voice over Internet Protocol networks" (Pet. 15–16 (quoting Ex. 1004, 3:58–61)).

Thus, we are persuaded, on this record, that there is a reasonable likelihood that Petitioner will prevail in showing Spadaro discloses or suggests server 48 uses VoIP and exchanges VoIP data packets with call processing gateways, as required by claim 1.

Patent Owner also contends that the Petition does not identify an inmate management system coupled to a networking device, because there is no disclosure that Spadaro's server 48 accesses inmate information, such as a PIN, for call authorization functions to support Petitioner's declarant's testimony 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)." Prelim. Resp. 19–20 (citing Pet. 17) (emphasis omitted). Patent Owner's contentions focus on the specific structures in the prior art—Spadaro's server 48—and fail to consider sufficiently what the combined teachings of Spadaro's embodiments would have suggested to an ordinarily skilled artisan. *Cf. In re Mouttet*, 686 F.3d 1322, 1333 (Fed. Cir. 2012) (citing *Keller*, 642 F.2d at 425) ("[T]he test for obviousness is what the combined teachings of the references would have suggested to those having ordinary skill in the art.").

Spadaro describes a networking device (server 48) and using a PIN associated with an inmate for restricting telephone access. Hodge describes an inmate management information database storing, among other information, an inmate's PIN. Both Spadaro and Hodge describe centralized administrative processing for prison facilities. On this record, there is a reasonable likelihood that Petitioner will prevail in showing the combination of Spadaro and Hodge would at least suggest to a person of ordinary skill in the art coupling Hodge's inmate management system to the networking device of Spadaro, as Petitioner's declarant testifies.

Further, we do not agree with Patent Owner that the Petition fails to address the limitations "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,” recited in claim 1. Prelim. Resp. 20–21. Specifically, Patent Owner contends Petitioner “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.” *Id.* at 21. Based on Hodge’s description of administrative workstations located at every facility and the use of those workstations to create, edit, and monitor user accounts and telephone calls, Petitioner asserts:

Hodge also teaches the creation of inmate records based on data received from different facilities . . . . Thus, 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 second inmate information from a second computer terminal at a second facility of the plurality of facilities.”

Pet. 17 (citing Ex. 1005, 10:35-46).

Patent Owner further contends that the Petition fails to address a call application management system connecting a call . . . the call being authorized based on the inmate records provided by the inmate management system.” Prelim. Resp. 21–23. As Patent Owner correctly indicates, Petitioner relies on Hodge’s site server as disclosing or suggesting the recited inmate management system call management and relies on Spadaro’s VoIP Gateway 26a for disclosing or suggesting the recited call application management system. *Id.* at 22–23. Patent Owner asserts that “the Petition fails to articulate how the site server of Hodge would be combined with . . . the VoIP Gateway 26a” to interact in a way to meet the limitation “application management system connecting a call . . . the call being

authorized based on the inmate records provided by the inmate management system,” as recited in claim 1. *Id.*

As noted previously, Spadaro describes using a PIN associated with an inmate for restricting telephone access, and Hodge describes an inmate management information database storing, among other information, an inmate’s PIN. Both Spadaro and Hodge describe centralized administrative processing for prison facilities. On this record, there is a reasonable likelihood that Petitioner will prevail in showing the combination of Spadaro and Hodge would at least suggest to a person of ordinary skill in the art authorizing a call to be connected through Spadaro’s VoIP Gateway 26a based on a PIN in inmate records provided by Hodge’s inmate management system that stores an inmate’s PIN. Moreover, to the extent Patent Owner argues that the teaching from Spadaro and Hodge must be combined through a physical substitution of elements from one reference to another, such an argument is not persuasive. *Keller*, 642 F.2d at 425 (“The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference . . .”).

Patent Owner also challenges Petitioner’s reasoning, as conclusory and unsupported by evidence or analysis, why a person of ordinary skill in the art would have combined Spadaro and Hodge in the manner proposed by Petitioner. Prelim. Resp. 14–15. On this record and for purposes of institution, we are persuaded Petitioner’s proposed combination of Spadaro and Hodge is a predictable variation using prior art elements according to their established functions. *See KSR*, 550 U.S. at 417 (“If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.”). Moreover, on this record, we are satisfied that Petitioner’s

reason to combine the references—a person of ordinary skill in the art would have looked to Hodge for how to store and manage the centralized information described by Spadaro (Pet. 12–13)—is supported sufficiently by its declarant’s articulated reasoning with some rational underpinning for this decision on institution (Ex. 1003 ¶ 63).

Patent Owner also contends, essentially, that, because the Examiner was aware of Spadaro and Hodge during prosecution of the application that issued as the ’260 patent but did not cite these references against the claims, the Board should give deference to the earlier determination of allowability over Spadaro and Hodge. Prelim. Resp. 7–8.

There is no presumption of validity as to the challenged claims in an *inter partes* review.<sup>7</sup> Further, under 35 U.S.C. § 325(d), “[i]n determining whether to institute or order a proceeding under . . . chapter 31 [*Inter Partes* Review], the Director *may* take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office” (emphasis added). The permissive language of the statute indicates that we may consider a petition that presents the same prior art or arguments previously presented to the Office.

Moreover, we are not persuaded that all the issues presented by Petitioner’s combination—embodiments related to Spadaro’s Figure 3 (depicting centralized call processing for multiple sites) and Spadaro’s Figure 5 (depicting integration of VoIP and data networks, in which PIN checking 28 is moved to a remote location and three-way call detection 30a

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<sup>7</sup> Whereas a patent is presumed “valid” unless overcome by clear and convincing evidence before a district court, a petitioner’s burden in an *inter partes* review is to prove “unpatentability” by a preponderance of the evidence. *Compare* 35 U.S.C. § 282(a) *with* § 316(e).

is moved to a remote location), equating Spadaro's server 48 with the recited networking device, and equating Hodge's site server with the recited inmate management system—have been considered previously by the Office.

Accordingly, on this record and for purposes of institution, we are satisfied that Petitioner has established a reasonable likelihood it would prevail in showing that claim 1 would have been obvious over Spadaro and Hodge.

#### *4. Claims 6 and 19*

Claim 6 depends from independent claim 1 and additionally recites “wherein the plurality of facilities comprise different types of facilities.” Petitioner relies on Hodge's disclosure that using a telephone system to monitor outgoing telephone connections in many types of institutions—such as penal institutions, military institutions, hospitals, schools, businesses, and specific types of government institutions—was common. Pet. 21 (citing Ex. 1005, 1:19–24). Patent Owner contends Hodge's disclosure “does not equate to a system with different types of facilities having shared data access to inmate records.” Prelim. Resp. 23.

Hodge expressly discloses monitoring telephone calls in different types of facilities was common. Ex. 1005, 1:19–24. Hodge also expressly discloses a site server is “connected to multiple switchboard devices that are located in separate institutions” and that “serves as the database location for the entire system.” *Id.* at 10:41–44. Being mindful that the test for obviousness is “what the combined teachings of the references would have suggested to those of ordinary skill in the art” (*Keller*, 642 F.2d at 425), on this record, we are persuaded that there is a reasonable likelihood that Hodges would suggest to a person of ordinary skill in the art different types

of facilities having shared data access to records and that Petitioner has established a reasonable likelihood it would prevail in showing that claim 6 would have been obvious over Spadaro and Hodge.

Similarly, claim 19 depends from independent claim 10 and additionally recites “the multiple facilities comprise different types of facilities.” Petitioner relies on the same arguments in asserting Spadaro and Hodge disclose or suggest this limitation as Petitioner asserted with regard to claim 6. *Compare* Pet. 29 with Pet. 21–22. Patent Owner also relies on similar contentions regarding claim 19 and claim 6. *Compare* Prelim. Resp. 26–27 with Prelim. Resp. 23.

Thus, for the reasons stated previously with regard to claim 6, we are persuaded that Petitioner has established a reasonable likelihood it would prevail in showing that claim 19 would have been obvious over Spadaro and Hodge.

*5. Adequacy of Petitioner’s Claim Chart  
for Claims 10, 14, 16, 17, 19, and 20*

Petitioner indicates independent claim 10 and its dependent claims 14, 16, 17, 19, and 20 are method claims that include substantially the same limitations as independent claim 1 and its dependent claims 2 and 6–9. Pet. 23. Petitioner presents a claim chart that maps the limitations of claims 10, 14, 16, 17, 19, and 20 to specific portions of Spadaro and Hodge. *Id.* at 23–29. The cited portions of Spadaro and Hodge in the claim chart correspond to portions of Spadaro and Hodge used in Petitioner’s analysis of claims 1, 2, and 6–9 and refer back to previous sections of analysis in the Petition. *Id.*

Patent Owner asserts that this is inadequate to establish obviousness of claims 10, 14, 16, 17, 19, and 20, because 37 C.F.R. § 42.22(a)(2) requires a petition contains a “full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence” and 37 C.F.R. § 42.6(a)(3) prohibits incorporation of arguments from another document. Prelim. Resp. 24–25.

Because the claim chart cites portions of Spadaro or Hodges for each claim limitation in claims 10, 14, 16, 17, 19, and 20 and refers to arguments made earlier in the Petition regarding substantially similar claims 1, 2, and 6–9, we are persuaded that the Petition contains a full statement of the reasons for the relief requested, in compliance with 37 C.F.R. § 42.22(a)(2), and the claim chart itself does not incorporate arguments *from another document*, and, as such, is in compliance with 37 C.F.R. § 42.6(a)(3) (emphasis added).

We, however, agree with Patent Owner that Petitioner’s citation to paragraphs 102–123 and 126–137 of the Declaration of Dr. Forys (Pet. 23 (“*See also* Forys Dec. ¶¶ 102–123 and 126–137”)) is an improper incorporation of arguments from another document under 37 C.F.R. § 42.6(a)(3). Therefore, we will not search over thirty paragraphs in the Declaration to find support for Petitioner’s position expressed in its Petition. *Cf. 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”).

Having decided as a general matter that the claim chart for claims 10, 14, 16, 17, 19, and 20 is adequate for institution, we turn to Patent Owner’s specific arguments regarding particular claim limitations.



*6. Independent Claim 10*

Independent method claim 10 recites various steps that are similar to the functions recited by the independent system claim 1. For example, claim 1 recites “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,” whereas claim 10 recites “receiving, from a first computer terminal at the first facility, first inmate information associated with an inmate; receiving, from a second computer terminal at the second facility, second inmate information associated with the inmate; and generating an inmate record based on the first inmate information and the second inmate information.” In another example, claim 1 recites “an inmate management system . . . for providing shared data access of inmate records to computer terminals at said plurality of facilities,” whereas claim 10 recites “storing the inmate record in the computer-based system for shared access across to the inmate record computer terminals in the multiple facilities.” In yet another example, claim 1 recites “connecting a call . . . responsive to . . . the call being authorized based on the inmate records provided by the inmate management system,” whereas claim 10 recites “connecting the call . . . responsive to authorizing the call based on the inmate records stored in the computer-based system.”

For claim 10, as noted previously, Petitioner relies on cited portions of Spadaro and Hodge that correspond to portions of Spadaro and Hodge used in Petitioner’s analysis of claim 1. Pet. 23–27. For the limitation “receiving, from a second computer terminal at the second facility, second inmate information associated with the inmate,” Petitioner relies on Hodge’s

teaching that (i) its site server serves as the database location for the entire system and (ii) an administrative workstation, which is used to create, edit, and monitor user accounts and telephone calls, is located at every facility.

*Id.* at 25.

Patent Owner asserts that Hodge does not disclose “receiving, from a second computer terminal at the second facility, second inmate information associated with the inmate,” because independent claim 10 requires inmate information for the same inmate to be received from a first facility and from a second facility. Prelim. Resp. 25. We agree with Patent Owner’s interpretation of claim 10. On this record, however, we do not agree that Hodge’s central database does not teach, or at least suggest, inmate information for the same inmate to be received from a first facility and from a second facility. Patent Owner does not address adequately what the reference would have suggested to one of ordinary skill in the art. *Cf. Mouttet*, 686 F.3d at 1333 (citing *Keller*, 642 F.2d at 425) (“[T]he test for obviousness is what the combined teachings of the references would have suggested to those having ordinary skill in the art.”).

For “storing the inmate record in the computer-based system for shared access across to the inmate record computer terminals in the multiple facilities,” recited in claim 10, Petitioner relies on Hodge’s disclosure of a central site server that digitizes user call information for efficient data transfer and efficient record keeping and stores at least financial transaction data for users. Pet. 26 (citing Ex. 1005, 19:37–44; Pet. § V.A.2.c.). As Petitioner also indicates, Hodge discloses administrative workstations may be located “at every facility” and these workstations can “create, edit, and monitor user accounts and telephone calls.” Pet. 17 (corresponding to

Section V.A.2.c cited in claim chart at Pet. 24) (citing Ex. 1005, 10:35–37, 10:41–46).

Patent Owner asserts that Hodge does not disclose “storing the inmate record in the computer-based system for shared access across to the inmate record computer terminals in the multiple facilities,” recited in claim 10, because Hodge’s use of the term “central” does not indicate access to multiple facilities or provide disclosure of “shared access” to an inmate record by multiple facilities also recited in independent claim 10. Prelim. Resp. 25–26.

On this record, we are not persuaded that a person of ordinary skill in the art would not have understood Hodge to disclose or suggest a central site server that can provide shared access to an inmate record by multiple facilities. Patent Owner’s argument is not persuasive, because it unduly focuses on the specific structures present in the prior art and ignores what the reference would have suggested to those of ordinary skill in the art. *Cf. Mouttet*, 686 F.3d at 1333.

Thus, on this record and for purposes of institution, we are persuaded that Petitioner has established a reasonable likelihood it would prevail in showing that claim 10 would have been obvious over Spadaro and Hodge.

### 7. Claim 11

Claim 11 depends from independent claim 10 and additionally recites “said first inmate information is [] received upon said inmate's arrest.” For this additional limitation, Petitioner relies on Hodge’s description of penal institutions providing an inmate a telephone account upon arrival (Ex. 1005, 2:23–25), along with Hodge’s and Spadaro’s description that a centralized call processing system can service multiple different types of facilities

(Ex. 1004, 2:41–45; Ex. 1005, 9:48–53). Pet. 29–30. Petitioner, with support from its declarant, asserts a person of ordinary skill in the art would have understood from these disclosures that “the 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.” *Id.* at 30 (citing Ex. 1003 ¶ 125). Specifically, Petitioner’s declarant testifies that Spadaro describes its call processing system can be used at any site in which public telephones are monitored and a police station where a person is arrested is such a facility where public telephones are monitored. Ex. 1003 ¶ 125 (citing Ex. 1004, 2:41–45). Petitioner’s declarant continues by noting 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 . . . and that a telephone account could be provided to a person upon his ‘arrival’ (e.g., arrest) at that location.” *Id.*

Patent Owner asserts that the combination of Spadaro and Hodge does not disclose the additional limitation recited in claim 11, because “[p]roviding 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*.” Prelim. Resp. 27. Patent Owner, however, does not explain adequately how providing an inmate with a telephone account upon arrival at a penal institution is so different, with regard to receiving inmate information, than receiving inmate information into a computer-based system upon arrest. For purposes of institution and on this record, we are not persuaded that providing a telephone account to an

inmate upon arrival at a penal institution, which would seem to necessitate receiving information, would not at least suggest to one of ordinary skill in the art receiving information upon a person's arrest.

Thus, we are persuaded that Petitioner has established a reasonable likelihood it would prevail in showing that claim 11 would have been obvious over Spadaro and Hodge.

*C. Other Asserted Grounds of Obviousness  
Relying on Spadaro and Hodge*

Petitioner asserts claims 5, 12, 13, 15, and 18 would have been obvious over Spadaro, Hodge, and various other references, as described in more detail below. Claim 5 depends from independent claim 1, and claims 12, 13, 15, and 18 depend from independent claim 10. For the reasons we explained previously, we are persuaded that Petitioner's analysis and supporting evidence has a reasonable likelihood of demonstrating that claims 1–4, 6–11, 14, 16, 17, 19, and 20 would have been obvious over Spadaro and Hodge.

*1. Obviousness over Spadaro, Hodge, and Boykin*

Petitioner asserts that claims 5 and 12 would have been obvious over Spadaro, Hodge, and Boykin. Pet. 30–31. Claims 5 and 12 each require a facility that includes “a mobile police station.”

Boykin describes a surveillance system that captures video, audio, and data information in a vehicle and transmits the information from the vehicle to a second location. Ex. 1007, Abstract. Boykin's surveillance system can be used for “safety, emergency, and evidentiary purposes” and in “police, fire, and rescue vehicles.” *Id.* at 2:13–19.

Petitioner contends that Boykin's police vehicle discloses the recited "mobile police station" and contends, with support from its declarant, that combining Boykin's mobile system with the infrastructure of Spadaro and Hodge would have been routine and the results predictable. Pet. 31 (citing Ex. 1003 ¶ 140).

Patent Owner challenges Petitioner's position that Boykin's police vehicle is a mobile police station and contends Petitioner disregards some limitations regarding the recited "facility," such as how Boykin's police vehicle meets the limitation that a facility includes a call processing gateway. Prelim. Resp. 29–30. Patent Owner also contends that Petitioner's declarant presents conclusory statements, which are inadequate to demonstrate the combination would have been obvious. *Id.* at 28–29.

On this record and for purposes of institution, we are persuaded that Boykin's police vehicle discloses a mobile police station, as required by claims 5 and 12, in view of the '260 patent that describes "a police squad car" as a type of mobile police station. Ex. 1001, 15:29–30 (indicating "a police squad car (or any other mobile police station)").

Moreover, we are not persuaded by Patent Owner's arguments that Petitioner failed to explain how Boykin's police vehicle with a surveillance system includes a call processing gateway, because Patent Owner attacks Boykin individually and fails to take into account what the combined teachings of Spadaro, Hodge, and Boykin would have suggested to those of ordinary skill in the art. *Cf. Keller*, 642 F.2d at 426 ("[O]ne cannot show non-obviousness by attacking references individually where . . . the rejections are based on combinations of references."). Further, we determine, on this record and for purposes of institution, that Petitioner's

position that the combination of Boykin's surveillance system in a police vehicle with Spadaro and Hodge's system would have been a predictable variation is supported sufficiently by Petitioner's declarant. *See KSR*, 550 U.S. at 417 ("If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.").

We determine that Petitioner has demonstrated a reasonable likelihood of prevailing on the ground that claims 5 and 12 would have been obvious over Spadaro, Hodge, and Boykin.

## *2. Obviousness over Spadaro, Hodge, and Cree*

Petitioner asserts that claim 13 would have been obvious over Spadaro, Hodge, and Cree. Pet. 31–32. Claim 13, depends from independent claim 10, and additionally recites "modifying said inmate record responsive to transferring the inmate from one facility of the multiple facilities to another facility of the multiple facilities."

Cree describes an inmate messaging system for notifying an inmate in a prison facility of messages received from a caller outside the prison facility. Ex. 1008, Abstract. Cree also describes "an active list of inmates" that may be contacted by a remote caller. *Id.* at 5:51–52. An active list of inmates is included for each account in an account database. *Id.* at 5: 50–51. The active list is updated regularly "to account for the release or transfer of inmates." *Id.* at 5:55–58.

Petitioner contends that Cree's disclosure of an active list of inmates stored in a database that is updated when inmates are transferred, in combination with Spadaro and Hodge, would have rendered obvious claim 13. Pet. 32.

Patent Owner challenges Petitioner's contention. Patent Owner contends that the Petition "fails to identify which elements of Cree would be necessary to combine with Spadaro and Hodge." Petitioner does not establish that Cree's active list is an inmate record; and Petitioner's declarant is too conclusory to support adequately the obviousness ground. Prelim. Resp. 32–33.

We are mindful that a patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *See KSR*, 550 U.S. at 406. The additional limitation of claim 13 requires modifying the inmate record when an inmate is transferred to a different facility. On this record, we are not persuaded that the testimony presented by Petitioner's Declarant is too conclusory for the purposes of institution.

Also as noted previously, the test of obviousness does not require the features of Cree to be incorporated bodily into the structure of Spadaro and Hodge. We, therefore, are not persuaded that Petitioner failed to establish what structural elements of Cree are necessary to combine with Spadaro and Hodge. *See Keller*, 642 F.2d at 425 ("The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference . . .").

Nor are we persuaded that Cree's active list must be an inmate record, because the test is what Cree's active list would have suggested to one of ordinary skill in the art. *Id.* (The test for obviousness is "what the combined teachings of the references would have suggested to those of ordinary skill



in the art.”). Thus, we are persuaded that Petitioner has a reasonable likelihood of showing that Cree’s description of updating a list of inmates when inmates are transferred discloses or suggests modifying an inmate record when a inmate is transferred to a different facility.

Therefore, on this record, we determine that Petitioner has demonstrated a reasonable likelihood of prevailing on the ground that claim 13 would have been obvious over Spadaro, Hodge, and Cree.

### *3. Obviousness over Spadaro, Hodge, and Nguyen*

Petitioner asserts that claims 15 and 18 would have been obvious over Spadaro, Hodge, and Nguyen. Pet. 33–36. Claims 15 and 18, each depend from independent claim 10, and involve notifying a third party of an inmate’s arrest or when the inmate is transferred to another facility. Claim 18 additionally recites “establishing another inmate account associated with said third party responsive to transferring the inmate to the other facility.”

Nguyen describes techniques for alerting victims of a crime about the change of status of a defendant in the criminal justice system. Ex. 1009, 1:7–9. Nguyen indicates that victims should be alerted to “early release or other changes in [the] status of defendants.” *Id.* at 1:13–17.

Petitioner relies on Nguyen’s description of alerting victims as disclosing or suggesting the notifying a third party limitations in claims 15 and 18. Pet. 33–35. Petitioner relies on Hodge’s description of transferring only certain information to a facility to which an inmate is transferred, as disclosing or suggesting for the establishing another inmate account limitation in claim 18. *Id.* at 36.

Patent Owner contends Hodge description of transferring only certain information when an inmate is transferred “does not indicate or infer that

*another* inmate account is established responsive to the transfer,” as required by the claims. Prelim. Resp. 34–35. Patent Owner’s contentions unduly focus on the specific disclosure of Hodge and fail to consider sufficiently Petitioner’s combination and the capabilities of the ordinarily skilled artisan. The test for obviousness is what the combined teachings of Spadaro’s embodiments would have suggested to an ordinarily skilled artisan. *Cf. Mouttet*, 686 F.3d at 1332 (citing *Keller*, 642 F.2d at 425) (“[T]he test for obviousness is what the combined teachings of the references would have suggested to those having ordinary skill in the art.”).

Therefore, on this record, we determine that Petitioner has demonstrated a reasonable likelihood of prevailing on the ground that claims 15 and 18 would have been obvious over Spadaro, Hodge, and Nguyen.

*D. Asserting Grounds of Obviousness Relying on Bellcore*

The Board has discretion whether to institute a review. *See* 35 U.S.C. § 314(a) (indicating an *inter partes* review may not be instituted *unless* a determination is made that there is a reasonable likelihood that the petitioner would prevail). We exercise our discretion and do not institute a review on the asserted grounds that (i) claims 1–4, 6–11, 14, 16, 17, 19, and 20 would have been obvious over Bellcore and Hodge, (ii) claims 5 and 12 would have been obvious over Bellcore, Hodge, and Boykin; (iii) claim 13 would have been obvious over Bellcore, Hodge, and Cree; and (iv) claims 15 and 18 would have been obvious over Bellcore, Hodge, and Nguyen.

CONCLUSION

For the foregoing reasons, we determine that the information presented in the Petition establishes there is a reasonable likelihood that

Petitioner would prevail in showing that claims 1–20 of the '260 patent are unpatentable. Any discussion of facts in this Decision are made only for the purposes of institution and are not dispositive of any issue related to any ground on which we institute review. The Board has not made a final determination with respect to the patentability of these claims. The Board's final determination will be based on the record as fully developed during trial.

### ORDER

For the foregoing reasons, it is:

ORDERED pursuant to 35 U.S.C. § 314(a), *inter partes* review is hereby instituted as to claims 1–20 of U.S. Patent No. 8,340,260 B1 based on the following grounds of unpatentability:

A. Claims 1–4, 6–11, 14, 16, 17, 19, and 20 are unpatentable for obviousness under 35 U.S.C. § 103 over Spadaro and Hodge;

B. Claims 5 and 12 are unpatentable for obviousness under 35 U.S.C. § 103 over Spadaro, Hodge, and Boykin;

C. Claim 13 is unpatentable for obviousness under 35 U.S.C. § 103 over Spadaro, Hodge, and Cree; and

D. Claims 15 and 18 are unpatentable for obviousness under 35 U.S.C. § 103 over Spadaro, Hodge, and Nguyen;

FURTHER ORDERED that no other grounds of unpatentability alleged in the Petition are authorized for this *inter partes* review; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review of the '260 patent is instituted commencing on the entry date of this Order, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is given of the institution of a trial.

IPR2014-00824  
Patent 8,340,260 B1

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