

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 IPR2014-01278 (Patent 7,860,222 B1)
Case IPR2014-01282 (Patent 7,860,222 B1)
Case IPR2016-01220 (Patent 9,007,420 B1)
Case IPR2016-01333 (Patent 9,094,500 B1)
Case IPR2016-01362 (Patent 9,083,850 B1)
Case IPR2017-01435 (Patent 7,529,357 B1)
Case IPR2017-01436 (Patent 8,340,260 B1)
Case IPR2017-01437 (Patent 7,916,845 B2)
Case CBM2017-00043 (Patent 7,529,357 B1)
Case CBM2017-00044 (Patent 8,340,260 B1)

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GLOBAL TEL*LINK CORPORATION,
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Case PGR2016-00044 (Patent 9,225,838 B2)
Case PGR2017-00005 (Patent 9,307,386 B2)
Case CBM2017-00034 (Patent 7,783,021 B2)
Case IPR2017-01177 (Patent 9,521,250 B2)
Case IPR2017-01279 (Patent 9,509,856 B2)

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SECURUS TECHNOLOGIES, INC.,
Petitioner,

v.

DSI-ITI, LLC,
Patent Owner.

Case IPR2017-01606 (Patent 7,123,704 B2)
Case IPR2017-02169 (Patent 7,826,604 B2)
Case IPR2017-02203 (Patent 6,895,086 B2)

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. §§ 317 & 327 AND 37 C.F.R. §§ 42.72 & 42.74**

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Pursuant to 35 U.S.C. §§ 317 & 327, 37 C.F.R. §§ 42.72 & 42.74, and the Board’s December 4, 2017 e-mail authorizing the filing of this omnibus Motion, Global Tel*Link Corporation and its wholly owned subsidiary DSI-ITI, LLC¹ (collectively “GTL”) and Securus Technologies, Inc. (“Securus”) jointly move to terminate the following proceedings in light of GTL’s and Securus’s (collectively “the parties”) settlement of their patent disputes:

TABLE I

Case No.	Patent No.	Patent Title	Status
PGR2016-00044	9,225,838	System and Method for Detecting Three-Way Call Circumvention Attempts	Trial Instituted
CBM2017-00034	7,783,021	Digital Telecommunications Call Management and Monitoring System	Trial Instituted
IPR2014-01278	7,860,222	Systems and Methods for Acquiring, Accessing, and Analyzing Investigative Information	On Remand from the Federal Circuit
IPR2014-01282	7,860,222	Systems and Methods for Acquiring, Accessing, and Analyzing Investigative Information	On Remand from the Federal Circuit
IPR2016-01220	9,007,420	Verifying Presence of Authorized Persons During an Electronic Visitation	Trial Instituted

¹ See IPR2017-02203, Paper 4 at 1 (“The Patent Owner and real party-in-interest is DSI-ITI, LLC, a wholly-owned subsidiary of Global Tel*Link Corporation.”).

Case No.	Patent No.	Patent Title	Status
IPR2016-01333	9,094,500	Controlled Communication Between Residents of Controlled Environment Facilities	Trial Instituted
IPR2016-01362	9,083,850	Video Blurring in a Secure Environment	Trial Instituted
IPR2017-01177	9,521,250	Telecommunication Call Management and Monitoring System with Voiceprint Verification	Trial Instituted
IPR2017-01279	9,509,856	Telecommunication Revenue Management System	Trial Instituted
PGR2017-00005	9,307,386	Multifunction Wireless Device	Trial Instituted
CBM2017-00043	7,529,357	Inmate Management and Call Processing Systems and Methods	Institution Denied, Rehearing Request Pending
CBM2017-00044	8,340,260	Inmate Management and Call Processing Systems and Methods	Institution Denied, Rehearing Request Pending
IPR2017-01435	7,529,357	Inmate Management and Call Processing Systems and Methods	Pending Institution
IPR2017-01436	8,340,260	Inmate Management and Call Processing Systems and Methods	Pending Institution
IPR2017-01437	7,916,845	Unauthorized Call Activity Detection and Prevention Systems and Methods for a Voice Over Internet Protocol Environment	Trial Instituted
IPR2017-01606	7,123,704	3-Way Call Detection System	Pending Institution
IPR2017-02169	7,826,604	Three-Way Call Detection Using Steganography	Pending Institution
IPR2017-02203	6,895,086	3-Way Call Detection System and Method	Pending Institution

Termination of the proceedings listed in TABLE I is appropriate because the dispute between the parties has been resolved. As required by 35 U.S.C. §§ 317(b) & 327(b), the parties are filing, concurrently herewith, a true copy of their Settlement Agreement as an exhibit in each of the above-listed proceedings.² As outlined in the Settlement Agreement, the parties jointly agreed to terminate the above-listed proceedings. Accordingly, the parties jointly request that the above-listed proceedings be terminated under 35 U.S.C. §§ 317(a) & 327(a) and 37 C.F.R. §§ 42.72 & 42.74. There are no additional collateral agreements or understandings made in connection with, or in contemplation of, termination of these proceedings. The parties have stipulated to dismiss all related litigation involving the patents listed in TABLE I. No litigation or proceeding between the parties involving the patents listed in TABLE I is contemplated in the foreseeable future.

Under 35 U.S.C. §§ 317(a) & 327(a), an inter partes review or a post-grant review “instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination

² The Settlement Agreement has been filed electronically in each proceeding via E2E for “Parties and Board Only” to preserve confidentiality.

is filed.” Under 37 C.F.R. § 42.74, “[t]he parties may agree to settle any issue in a proceeding ...,” and under 37 C.F.R. § 42.72, “[t]he Board may terminate a trial without rendering a final written decision, where appropriate”

TABLE 1 (the “status” column) indicates the stage of trial that each of the above-listing proceedings is in: (1) pending institution, (2) instituted, (3) institution denied but rehearing requested, or (4) on remand from the Federal Circuit.

Regardless of the stage of trial, the PTAB can conserve significant resources by terminating each of the above-listed proceedings:

- For each case pending institution, the Board has not (i) issued a decision on institution, (ii) conducted trial, or (iii) decided the ultimate merits of the proceeding.
- For each case currently in trial, the Board has not (i) issued a final written decision (and thus has not decided the ultimate merits of the proceeding), and (ii) in most instances, has not conducted an oral hearing.
- For each case that has received an institution decision but has a pending rehearing request, the Board has not issued a decision on the rehearing request.
- For each case on remand, the Board has not issued a decision on remand.

Strong public policy considerations favor settlement between the parties to an *inter partes* review proceeding. *See Office Trial Practice Guide*, Fed. Reg., Vol. 77, No. 157 at 48768 (Aug. 14, 2012). Indeed, the Board has granted terminations in cases after oral hearing. *See, e.g., Volusion, Inc. v. Versata Software, Inc.*, CBM2013-00017, Judgment, Termination of the Proceeding, Paper 53 (PTAB Jun. 17, 2014); CBM2013-00018, Judgment, Termination of the Proceeding, Paper 52 (PTAB Jun. 17, 2014) (terminating proceeding following oral argument). The Board has also granted terminations in cases after remand from the Federal Circuit. *See e.g., Respironics, Inc. v. Zoll Med. Corp.*, IPR2013-00322, Termination of Proceeding, Paper 54 (PTAB Dec. 29, 2016); *Medtronic Inc. v. NuVasive Inc.*, IPR2013-00508, Granting Joint Motion to Terminate after Remand from the Court of Appeals for the Federal Circuit, Paper 56 (PTAB May 9, 2017); *ZTE Corp. v. IPR Licensing Inc.*, IPR2014-00525, Decision on Joint Motion to Terminate, Paper 53 (PTAB May 23, 2017).

No public interest or other factors weigh against termination of the proceedings listed in TABLE I.

Further, both Congress and federal courts have expressed a strong interest in encouraging settlement in litigation. *See, e.g., Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) (“The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation.”); *Bergh v. Dep’t of Transp.*, 794 F.2d 1575, 1577 (Fed.

Cir. 1986) (“The law favors settlement of cases.”), *cert. denied*, 479 U.S. 950 (1986). The Federal Circuit places a particularly strong emphasis on settlement. *See Flex-Foot, Inc. v. CRP, Inc.*, 238 F.3d 1362, 1370 (Fed. Cir. 2001); *see also Cheyenne River Sioux Tribe v. United States*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility between parties).

Maintaining review after the parties reach a settlement would discourage future settlements by removing a primary motivation for settlement: eliminating litigation risk by resolving the parties’ disputes and ending the pending proceedings between them. For patent owners, litigation risks include the potential for their patents to be invalidated. If a patent owner knows that a proceeding is likely to continue regardless of settlement, it can create a strong disincentive for the patent owner to settle. Further, one of the primary reasons courts endorse settlement is preservation of judicial resources. Maintaining review after the parties have settled their disputes would waste, rather than conserve, judicial resources.

In each of the proceedings listed in TABLE I, the parties are concurrently filing a joint request, pursuant to 37 C.F.R. § 42.74(c), that the Settlement Agreement be treated as business confidential information and kept separate from the files of the involved patent. For the foregoing reasons, the parties jointly and respectfully request that the above-listed proceedings be terminated.

Omnibus Joint Motion to Terminate

Date: December 6, 2017

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the above-captioned **JOINT MOTION TO TERMINATE PROCEEDING PURSUANT TO 35 U.S.C. §§ 317 & 327 AND 37 C.F.R. §§ 42.72 & 42.74** was served electronically via e-mail on December 6, 2017, in its entirety on the following counsel for Securus Technologies, Inc.:

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Date: December 6, 2017
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