

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

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

BRADEN, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318 and 37 C.F.R. § 42.73

I. INTRODUCTION

We have jurisdiction to hear this *inter partes* review under 35 U.S.C. § 6(c), and this Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 1–36 of U.S. Patent No. 7,860,222 B1 (Ex. 1001, “the ’222 patent”) are unpatentable. We also determine that Patent Owner has not met its burden on its Motion to Amend regarding entry of proposed substitute claims 15–20, and thus, we deny the Motion to Amend.

A. Procedural History

Global Tel*Link Corporation (“Petitioner”) filed a Petition (Paper 1, “Pet.”) to institute an *inter partes* review of claims 1–36 of the ’222 patent pursuant to 35 U.S.C. § 311. Securus Technologies, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 9, “Prelim. Resp.”). Pursuant to 35 U.S.C. § 314(a), we instituted an *inter partes* review of claims 1–36 as on the following grounds:

References	Basis	Claims Challenged
Brown ¹	§ 103	1, 3, 7–10, 14–19, 21, and 31–36
Brown and Gainsboro ²	§ 103	2, 11, 13, and 22–30
Brown and Hong Kong ³	§ 103	4

¹ US Patent Publication No. 2004/0081296 A1, Apr. 29, 2004 (filed Oct. 23, 2002) (Ex. 1007).

² US Patent No. 6,064,963, May 16, 2000 (filed Dec. 17, 1997) (Ex. 1008).

³ Human Rights Watch, *Hong Kong: Prison Conditions in 1997*, March 1, 1997, C905, Mar. 1, 1997 (Ex. 1009).

References	Basis	Claims Challenged
Brown and Mow ⁴	§ 103	5
Brown and Pettay ⁵	§ 103	6
Brown, Gainsboro, and Johnson ⁶	§ 103	12
Brown and Crites ⁷	§ 103	20
Brown and Hodge ⁸	§ 103	7, 9, and 16

See Paper 12 (“Dec. to Inst.”), 25.

After institution of trial, Patent Owner filed a Patent Owner Response (Paper 19, “PO Resp.”), to which Petitioner filed a Reply (Paper 24, “Reply”).

In addition, Patent Owner also filed a Motion to Amend the Claims (Paper 21), to which Petitioner filed an Opposition (Paper 25). Patent Owner then filed a Reply to Petitioner’s Opposition to the Motion to Amend the Claims. Paper 26.

An oral argument was held on October 27, 2015. A transcript of the oral argument is included in the record.⁹ Paper 33, “Tr.”.

⁴ US Patent No. 6,668,045 B1, Dec. 23, 2003 (filed Oct. 30, 2000) (Ex. 1010).

⁵ US Patent No. 7,191,133 B1, Mar. 13, 2007 (filed Feb. 15, 2001) (Ex. 1011).

⁶ US Patent No. 6,141,406, Oct. 31, 2000 (filed May 30, 1997) (Ex. 1012).

⁷ US Patent Publication No. 2003/0126470 A1, July 3, 2003 (filed Dec. 23, 2002) (Ex. 1013).

⁸ US Patent Publication No. 2004/0029564 A1, Feb. 12, 2004 (filed Aug. 8, 2002) (Ex. 1014).

⁹ The parties filed Objections to Demonstrative Exhibits. Papers 31, 32. In this Final Written Decision, we rely directly on the arguments presented

B. Related Proceedings

Petitioner informs us that the '222 patent is the subject of district court case *Securus Technologies, Inc. v. Global Tel*Link Corporation*, 3:13-cv-03009 (N.D. Tex.). Pet. 2. Petitioner also informs us that the '222 patent is the subject of a petition for covered business method review, case CBM2014-00166, and of a concurrently-filed petition for *inter partes* review, case IPR2014-01282. *Id.*; Related Matters (Paper 6).

C. The '222 Patent

The '222 patent discloses systems and methods for providing “an electronic based capability to locate, collect, compile, aggregate, distil, and/or report robust data.” Ex. 1001, 3:2–4. Essentially, the '222 patent relates to information technology (“IT”) management and the collection of data from networks that span a wide range of institutions, including correctional facilities, without regard to which jurisdiction the source of data belongs. *Id.* at 2:62–3:4.

One embodiment of the '222 patent provides an electronic-based capability to locate, collect, compile, aggregate, distil, and/or report robust data. *Id.* at 3:2–4. According to the '222 patent, data can be identified and harvested directly from the IT network, but the system also can spawn extended or indirect data identification, correlation, and/or harvesting of data, such as through recognizing crossing points or confluence of information aspects. *Id.* at 3:4–9. For example, an authorized person may

properly in the parties' briefs and the evidence of record. The demonstrative exhibits were only considered to the extent they are consistent with those arguments and evidence; therefore, the objections are overruled.

perform a word search, e.g., using speech to text technology, across conversations provided via a plurality of call processing systems to identify a confluence or intersection of information beyond that possible with typical investigative tools. *Id.* at 3:35–40. An authorized person also may utilize such systems and methods to perform a national number search to look across a plurality of controlled environment facilities and determine if there are common telephone numbers (or other addresses, e.g., e-mail addresses, physical addresses, and the like) contacted by residents of different controlled environment facilities. *Id.* at 3:40–46.

In other embodiments of the '222 patent, an authorized user may have access to a phone call in real-time, so that in addition to having access to call recordings and call detail records, the authorized user may be able to monitor a live call. *Id.* at 3:56–61. An authorized person also may be able to listen to the call in progress, himself being muted from the call (such as to prevent the calling party and/or calling party being alerted to the monitoring by background noise associated with the investigator). *Id.* at 4:7–11. The authorized person may be provided various controls with respect to the monitored call, such as particular dual-tone multiple frequency (“DTMF”) inputs to control switching from monitoring only (investigator muted) to barging into the call (investigator in duplex communication with one or more parties to the call), disconnecting the call between one or more of the parties to the call, marking positions in the call with “bookmarks” or tags for locating later in the call recording, and disconnecting the investigator from the call. *Id.* at 4:11–19. Various bookmarks may be defined by an investigator, such as by associating particular DTMF inputs with particular notations (e.g., threat, keyword, person of interest, investigator notation

appended, and the like). *Id.* at 4:19–23. In addition to such bookmarks, an authorized person is able to append investigator notations, such as voice and/or text notes, to a recorded monitored call. *Id.* at 4:23–25.

The authorized person is provided with a graphical user interface to review recorded monitored calls in order to visualize where bookmarks and/or notes are appended with respect to the monitored call. *Id.* at 4:26–30. According to the '222 patent, the graphical user interface, such as the one illustrated in Figure 8 below, can be a webpage with access to one or more databases. *Id.* at 30:34–52.

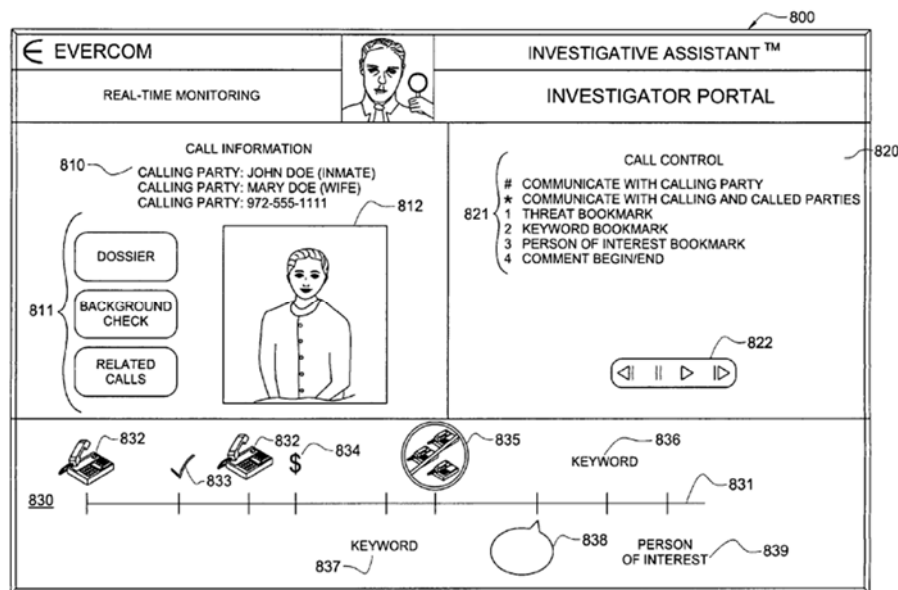


Figure 8 of the '222 patent shows an example of a graphical user interface that can be accessed by an authorized person.

D. Illustrative Claims

As noted above, an *inter partes* review was instituted as to claims 1–36 of the '222 patent, of which claims 1 and 21 are the only independent claims. Claims 1 and 21 are illustrative of the challenged claims and are reproduced below (with paragraphing):

1. A system comprising:

a communication services module operable to provide communications between individuals; and

an investigative tools module in communication with said communication service module operable to allow a user to monitor said communications between individuals and to place event identifiers in association with said communications between individuals, said event identifiers comprise a plurality of bookmarks representing different events of interest; and

said investigative tools module comprises a word search module to identify particular words within said communications between individuals and place event identifiers in association therewith.

Ex. 1001, 34:8–21.

21. A method comprising:

providing communications between individuals;

recording said communications between individuals;

monitoring said communications between individuals, said monitoring comprises logic of a call processing system analyzing content of said communications between individuals; and

placing a plurality of event identifiers in association with a recorded one of said communications between individuals based upon events detected by said monitoring.

Id. at 35:26–35.

II. DISCUSSION

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *see also In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1275–79 (Fed. Cir.

2015 (“Congress implicitly approved the broadest reasonable interpretation standard in enacting the AIA,” and “the standard was properly adopted by PTO regulation.”). Under that standard, and absent any special definitions, we give claim terms their ordinary and customary meaning, as would be understood by one of ordinary skill in the art at the time of the invention. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

In the Decision to Institute, we construed “logic of a call processing system,” which is recited in claim 21. *See* Dec. to Inst. 8–10. During the course of the trial, neither party challenged our construction of this claim term. PO Resp. 5; Tr. 6:9–10. We see no reason to alter the construction as set forth in the Decision to Institute, and we incorporate our previous analysis for purposes of this decision. Therefore, for the reasons set forth in the Decision to Institute, we find the broadest reasonable construction of “logic of a call processing system” encompasses automated processes performed using logic elements and does not encompass processes performed solely by human action.

All other claim terms are given their plain and ordinary meaning.

B. Principles of Law

To prevail in its challenges to the patentability of the claims, a petitioner must establish facts supporting its challenges by a preponderance of the evidence. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). A claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the subject matter sought to be patented 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. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of

obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) objective evidence of nonobviousness, i.e., secondary considerations. *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

We analyze the instituted grounds of unpatentability in accordance with the above-stated principles.

C. Level of Ordinary Skill in the Art

In determining whether an invention would have been obvious at the time it was made, we consider the level of ordinary skill in the pertinent art at the time of the invention. *Graham*, 383 U.S. at 17. “The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991).

Petitioner’s declarant, Dr. Kaza, opines that a person of ordinary skill in the art relevant to the ’222 patent “would have a B.S. degree in Electrical Engineering, Computer Science, or an equivalent field as well as at least 3-5 years of academic or industry experience in telecommunications/information systems, or comparable industry experience.” Ex. 1003 ¶ 19. Patent Owner does not offer any contrary explanation regarding who would qualify as a person of ordinary skill in the art relevant to the ’222 patent (*see generally* PO Resp.) and Patent Owner’s declarant, Dr. Akl uses the level of skill articulated by Dr. Kaza (Ex. 2002 ¶ 33).

Based on our review of the ’222 patent, the types of problems and solutions described in the ’222 patent and cited prior art, and the testimony of Petitioner’s declarant, we adopt and apply Petitioner’s definition of a

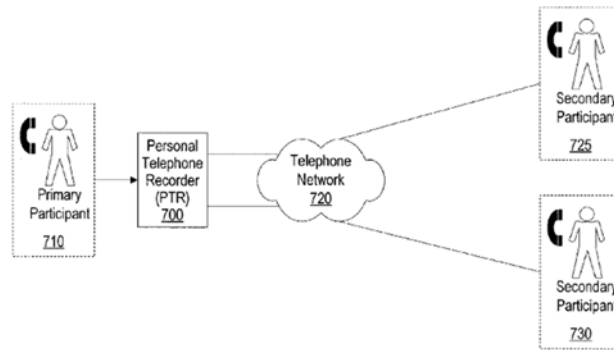
person of ordinary skill in the art at the time of the claimed invention. We note that the applied prior art reflects the appropriate level of skill at the time of the claimed invention. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001).

D. Asserted Obviousness of Claims 1, 3, 7–10, 14–19, 21, and 31–36 in View of Brown

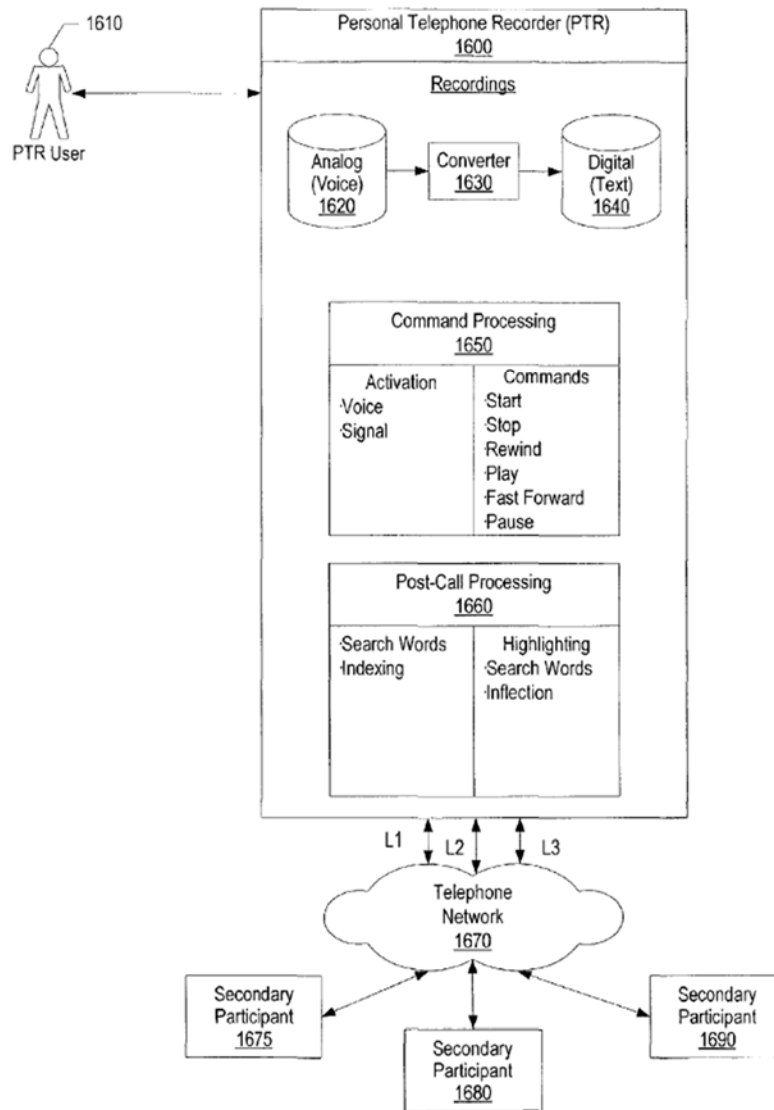
Petitioner contends claims 1, 3, 7–10, 14–19, 21, and 31–36 of the '222 patent are unpatentable under 35 U.S.C. § 103 in view of Brown. Pet. 12–32. Patent Owner disputes Petitioner's position, arguing Petitioner only provides attorney argument (PO Resp. 7) and that the cited reference fails to disclose all the elements required by the challenged claims (*id.* at 8–34). We have reviewed the Petition, the Patent Owner's Response, and Petitioner's Reply, as well as the relevant evidence discussed in those papers. For reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that the challenged claims of the '222 patent would have been obvious in view of Brown.

1. Overview of Brown

Brown discloses a personal telephone recording system that establishes a telephone conference between two or more users. Ex. 1007 ¶¶ 2, 13. The system records a telephone conference and can replay the recording after or during the telephone conference. *Id.* ¶ 13. The conference can be recorded in audio format, text format, or both. *Id.* ¶ 14. Figure 7A, reproduced below, illustrates one embodiment of the system taught in Brown.



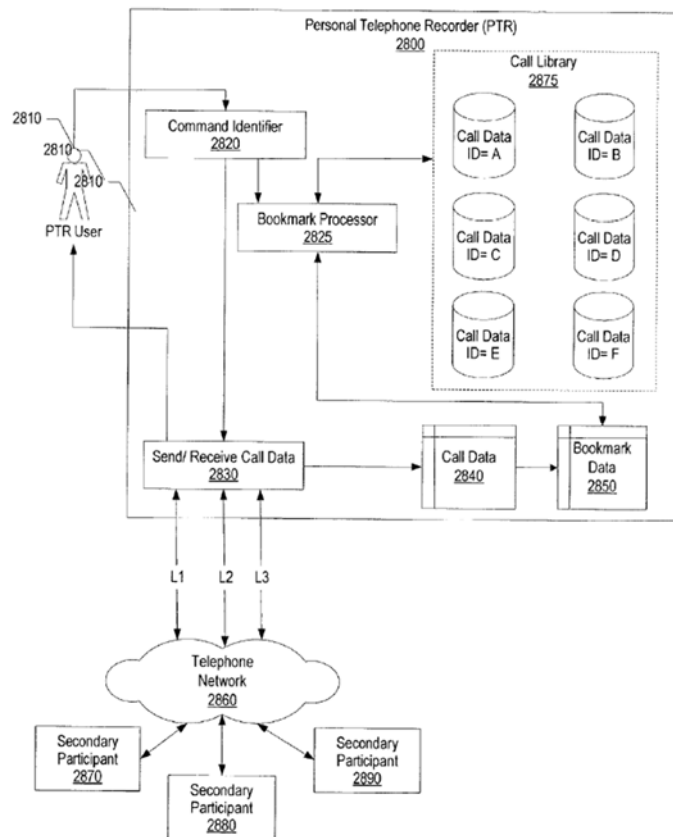
In Figure 7A, a network based personal telephony recorder can provide proxy services to primary and secondary participants connected to the personal telephony recorder through the telephone network. *Id.* ¶ 102. The telephone network provides communication services between individuals, while the network based personal telephony recorder can call participants to join a conference call, or the participants can call into the personal telephony recorder to set up and join conference calls. *Id.* Another embodiment of the system taught in Brown is illustrated in Figure 16, reproduced below.



As shown in Figure 16, the personal telephony recorder can provide enhanced capabilities and recording for the user when communicating with participants (1675, 1680, and 1690) through telephone network 1670. *Id.* ¶ 143. Brown teaches that the personal telephony recorder system also includes voice-to-text converter 1630 for creating text version of call data 1640. *Id.* ¶ 144. The text version of the call data can be used for searching, reporting, and data mining. *Id.* According to Brown, post-call processing 1660 can be performed after a call has ended and includes functions for

searching call data for words and phrases and indexing words found in call data. *Id.* ¶ 146.

One processing feature specifically taught by Brown is the application and use of bookmarks. According to Brown, bookmarks are used to mark locations within call data, so that the identified call data can be retrieved expeditiously. *Id.* ¶¶ 85, 195. Brown explains that the personal telephony recorder user issues commands to add, delete, and modify bookmarks pertaining to either a live call between the user and the participants, or pertaining to a call stored in the call library. *Id.* ¶ 195. Figure 28, reproduced below, illustrates a system for setting and maintaining bookmarks corresponding to voice data.



As shown in Figure 28, command identifier 2820 receives commands from the system user, including bookmark commands. *Id.* The bookmark

commands are sent to bookmark processor 2825 to add, delete, and modify bookmarks. *Id.* Bookmark data for the calls are maintained in bookmark data area 2850. *Id.* Bookmarks are associated with a particular call, such as Call Data ID=A, so that the bookmarks are available after the call for querying, running reports, data mining, forwarding portions of the call (in voice or text format), and the like. *Id.* Nonvolatile storage is used to store voice data, bookmark data (marking places within the voice data), translation data (digital forms of the analog voice data), queries and command that have been requested, and data regarding participants of the calls, such as the participants' names, companies, telephone numbers, and the like. *Id.* ¶ 81; Fig. 2.

2. *Analysis*

a. *Independent Claim 1*

For claim 1, Petitioner contends that Brown discloses a personal telephony recorder system and method that provides communication between individuals, and the system includes a display device that displays, in near real-time fashion, voice data from call between individuals. Pet. 14–15 (citing Ex. 1007 ¶ 76; Fig. 2), 25–28. Petitioner then argues that the system described in Brown allows a user to monitor the communication between individuals because a user can “follow the conference call by reading the data displayed on the display device.” Pet. 14–15 (citing Ex. 1007 ¶ 80).

Petitioner further contends that Brown teaches or suggests a “word search module” as recited by claim 1. Pet. 16–18; Reply 3–9. Petitioner argues that Brown discusses the use of a “[b]ookmarking component 345 [that] is used to allow the personal telephony recorder user the ability to set

bookmarks identifying where in a telephone call **a certain topic** was discussed.” *Id.* at 16 (citing Ex. 1007 ¶ 85); *see also* Reply 7 (“Petition explicitly included the functionality of the bookmarking component 345 within Brown’s ‘word search module.’”). Petitioner then explains that Brown further discusses the “[p]rocessing of the recorded call data may involve, for example, creating an index, annotating the call data, etc.

Annotating the data may involve searching the call data for **keywords and phrases.**” Pet. 17 (citing Ex. 1007 ¶ 237). Petitioner argues that Brown’s disclosure of “annotating” the location of “keywords and phrases” constitutes the identification of “particular words” and “events of interest” as recited in claims 1, which are performed by a “word search module.” Reply 9–10. According to Petitioner, Brown describes all the functionality of the claimed “word search module,” thus, rendering such a module obvious. Reply 4. Petitioner further argues that “Brown explicitly describes that its system functionality can be carried out within a module: ‘**One of the preferred implementations of the invention is an application**, namely a set of instructions (program code) in **a code module.**’” *Id.* at 5. Petitioner notes that in addition to (or in the alternative to) bookmarking data, Brown teaches that “[a]nnotating the data” constitutes the recited “place event identifiers in association therewith,” while Brown’s “keywords and phrases” constitutes the recited “particular words.” Pet. 17; *see* Reply 8–9.

Petitioner also contends that Brown teaches or suggests a “word search module” as part of an “investigative tools module” as recited by claim 1. Pet. 15–18; Reply 7–8. According to Petitioner, Brown’s Figure 2 illustrates that bookmarking component 345, data mining 385, word indexing 390, and querying 395 are all subcomponents of command

processing 340. Reply 7–8. Petitioner argues that command processing 340 is part of Brown’s “investigative tools module” as shown, in part, in Brown’s Figure 2. Pet. 7–17; *see* Ex. 1007, 79–84, Figs. 2, 3.

Patent Owner disagrees with Petitioner’s conclusion that Brown teaches or suggests the limitations of the challenged claims for several reasons. PO Resp. 7–17. First, Patent Owner asserts that Petitioner relies solely on attorney argument to support its challenges to patentability and does not cite to testimony from Petitioner’s Declarant, Dr. Kaza, as evidence of obviousness. According to Patent Owner, because Petitioner does not cite to Dr. Kaza’s testimony, the “Board should not consider the testimony of Dr. Kaza in support of the Petition.” *Id.* at 7 (citing 37 C.F.R. § 42.6(a)).¹⁰

Second, Patent Owner contends Petitioner fails to identify a “word search module.” *Id.* at 8–10. Patent Owner argues that Petitioner identifies various components in Brown that allegedly constitute a “word search module,” but does not identify a specific “word search module” or explain in detail how the components “identify particular words within said communications between individuals,” as required for the “word search module” by the claims. *Id.* at 8. Patent Owner further argues that the “word search module” performs the task to “identify particular words within said communications between individuals,” and it must also “place event identifiers in association therewith.” *Id.* at 8–9 (citing Ex. 2002 ¶ 58). According to Patent Owner, bookmarking component 345 is identified by

¹⁰ Although Petitioner does not cite to specific portions of Dr. Kaza’s testimony Petitioner timely filed the Declaration of Dr. Kaza and lists it as a supporting exhibit. *See* Paper 4, 2; Ex. 1003. We have considered the testimony and have accorded it the appropriate weigh.

Petitioner as the component that performs the task of “identify[ing] particular words” and “plac[ing] event identifier,” but Petitioner never alleges that bookmarking component 345 is part of a word search module. *Id.* at 9. Patent Owner also contends that Petitioner’s obviousness challenge fails because Brown lacks the claimed “word search module” as recited in claim 1 and because Petitioner fails to allege that such a module would be obvious from the functionality described in Brown. *Id.* at 14 (citing Ex. 2002 ¶ 60).

Third, Patent Owner contends Petitioner fails to identify an “investigative tools module” comprising a “word search module.” *Id.* at 10–14. According to Patent Owner, the elements in Brown that Petitioner identifies as the “investigative tools module” are from a different embodiment than the elements Petitioner uses for the “word search module.” *Id.* at 11.

Lastly, Patent Owner contends that Petitioner’s obviousness challenge fails because Brown lacks the claimed “to place event identifiers” with “said event identifiers compris[ing] a plurality of bookmarks representing different events of interest” as recited in claim 1. *Id.* at 14–17. Patent Owner argues that claim 1 requires the identification of both “particular words” and “plac[ing] event identifier,” but Petitioner relies on the same disclosure for both limitations. *Id.* at 14. According to Patent Owner, because the investigative tools module of claim 1 *comprises* the “word search module,” one of ordinary skill in the art would understand the identification of particular words by the word search module to be a subset of a larger set of functionalities for placing event identifiers “representing different events of interest.” *Id.* at 15 (citing Ex. 2002 ¶ 61). Patent Owner

then argues that by citing the same portion of Brown for both of these limitations, Petitioner has failed to establish that Brown discloses both the broader limitation (placing event identifiers “representing different events of interest”) and the more specific limitation (“placing of ‘event identifiers in association . . .’ with identification of ‘particular words.’”). *Id.*

We do not agree with Patent Owner’s positions. Rather, we are persuaded by Petitioner’s argument that the disclosure of Brown, as summarized above, teaches or suggests each limitation of the challenged claims. A challenge to patentability under 35 U.S.C. § 103 requires that all the claim limitations must be taught or suggested by the prior art as gauged in view of the creativity of an ordinarily skilled artisan. Brown specifically teaches a personal telephony recorder that “includes a number of components used to record call data and to provide services to users both during and after a telephone call.” *See* Ex. 1007 ¶ 76. We also are persuaded by the testimony of Dr. Kaza who states that “[v]oice receiver 235, voice receiver 210, command filter 215, analog transmitter 220, and analogic transmitter 240 provide the recited ‘*communication services module operable to provide communications*’ between the call participants.” Ex. 1003 ¶ 50. Although a “module” as claimed may be understood to connote either hardware or software structure that performs a certain function, on the record before us, we are satisfied that one of skill in the art would have had reason to combine known elements for providing telephone calls, as taught in Brown, into a “module” to provide communications between individuals. *See KSR*, 550 U.S. at 420.

We also are persuaded by Petitioner’s argument, as supported by the testimony of Dr. Kaza, that Brown describes or suggests an “investigative

tools module” that comprises a “word search module” as required in claim 1. *See* Pet. 16–17; Ex. 1003 ¶ 52. Specifically, we are persuaded that components of Brown’s command processing component 340, including data mining component 385, word indexing component 390, bookmarking component 345, and querying component 395, constitute a “word search module,” while Brown’s voice receiver, command filter 215, voice-text converter 245, digital transmitter 285, email/computer system 282, and bookmarking component 345 collectively constitute an “investigative tools module.” *See* Pet. 17; Reply 6–7. We further are persuaded that Brown separately teaches bookmarking data and annotating the data for word searches. *See* Pet. 17 (citing Ex. 1007 ¶ 237). Additionally, we are satisfied that a person of ordinary skill in the art would have understood bookmarking component 345, which is part of command processing component 340, to constitute a “word search module” that would be part of an “investigative tools module.” Ex. 1003 ¶¶ 51–53. Therefore, based on the record before us, we are satisfied that Brown teaches or suggests an “investigative tools module” comprising a “word search module.”

Furthermore, we are satisfied that Brown teaches both bookmarking and annotation of data for word searching, thereby meeting the limitations of (1) an investigative tools module that allows event identifiers, such as bookmarks, to be made identifying events of interests that occur during the communication between individuals, and (2) a word search module that identifies word in the communication between individuals and can place event identifiers at particular words.

Accordingly, we hold that Petitioner has shown by a preponderance of the evidence that claim 1 would have been obvious under 35 U.S.C. § 103 in view of Brown.

b. Independent Claim 21

Petitioner contends Brown teaches or suggests the limitations of claim 21. Pet. 25–28. Specifically, Petitioner contends Brown discloses the ability to monitor and analyze the communications between individuals because Brown states that “[v]oice data . . . can be displayed, in near real-time fashion” such that a user can follow the call by reading the data displayed on the display device. *Id.* at 27 (citing Ex. 1007 ¶ 80).

Patent Owner argues that Brown does not disclose “said monitoring comprises logic of a call processing system analyzing content of said communications between individuals,” as required by independent claim 21. PO Resp. at 31–32. According to Patent Owner, Petitioner fails to identify any specific element that represents the “logic of a call processing system analyzing content of said communications between individuals.” *Id.* Patent Owner further argues that “the mere following of a conference call does not necessitate any ‘analyzing [of] content of said communications with individuals.’” *Id.* at 32. Patent Owner also notes that the Petition never alleges that this limitation would be obvious from the cited disclosure of Brown. *Id.*

Despite Patent Owner’s arguments, we are persuaded by Petitioner’s contention. As discussed above, we find that the broadest reasonable construction of “logic of a call processing system,” for purposes of this decision, to encompass an automated process performed using logic elements. Brown discloses converting voice data to text data using a

converter and then displaying the converted text data. Ex. 1007 ¶ 80. The Declaration of Dr. Kaza supports Petitioner’s position that Brown discloses “logic of a call processing system” as we have construed the term. Dr. Kaza testifies that Brown describes both (i) processing commands received during the call (Ex. 1007, Fig. 6, ¶ 98) and (ii) converting commands to text (*id.*, Fig. 32, ¶ 210), and (iii) searching call data for a particular word or phrase (*id.*, Fig. 32, ¶ 210). Ex. 1003 ¶ 84. Given this information, we are persuaded by Petitioner’s proposition, as supported by Dr. Kaza’s Declaration, that voice data converted to text data and displayed on a display device, as taught by Brown (*see* Pet. 27; Ex. 1007 ¶ 80), meet the limitation of “monitoring said communications between individuals, said monitoring comprises logic of a call processing system analyzing content of said communications between individuals,” as required by claim 21.

Therefore, we are persuaded by Petitioner’s argument that challenged claim 21 would have been obvious over Brown.

c. Dependent Claims 3, 7–10, 14–19, and 31–36

With regard to dependent claims 3, 7–10, 14–19, and 31–36, Petitioner contends Brown teaches or suggests the limitations of each claim. Pet. 18–25, 28–32. Patent Owner specifically contests Petitioner’s positions regarding claims 10, 15–19, and 32–36. PO Resp. 17–31, 33–34. We have considered all of Patent Owner’s arguments, but for reasons set forth below we agree with Petitioner’s positions.

Challenged claim 10 recites “wherein said investigative tools module further allows said user to control one or more aspects of said communications between individuals.” Ex. 1001, 34:52–54. According to Patent Owner, the antecedent basis of “said user” is found in claim 1, but

Petitioner fails to identify a “user” disclosed by Brown that both “monitor[s] said communications between individuals” and “control[s] one or more aspects of said communications between individuals.” PO Resp. 17. Patent Owner argues that a “participant” in Brown is different from and cannot be a “user” under the language in claim 10. *Id.* at 18. Patent Owner further argues that allowing or disallowing a requester to join a call is not controlling an aspect of the communication. *Id.* We do not agree with Patent Owner’s position, because we do not read Brown to exclude the “personal telephony recorder user” from being a “participant.” Thus, we are persuaded by Petitioner that challenged claim 10 would have been obvious in view of Brown.

Similarly, dependent claim 16 requires “information associated with said monitored one of said communications between individuals comprises identification of at least one of said individuals” (Ex. 1001, 35:6–9), while claim 33 recites “information associated with said select one of said communications between individuals comprises identification of at least one of said individuals” (*id.* at 36:26–30). Patent Owner contends that Brown does not disclose the identification of at least one of said individuals presented to the user as part of a data interface; rather Brown discloses email/computer system 282 that can display data, but does not disclose that the identification of at least one of said individuals is displayed thereon. PO Resp. 22–23. Brown, however, discloses that “whereupon the participant from whom the voice data was received is identified (step 445). This identification can be based upon the line from which the data was received or may be made by analyzing the vocal characteristics of the participants

[sic] voice.” See Ex 1007 ¶ 90. Thus, we are persuaded by Petitioner that challenged claims 16 and 33 would have been obvious in view of Brown.

After consideration of the language recited in claims 3, 7–10, 14–19, and 31–36 of the ’222 patent, the Petition, the Patent Owner Response, and Petitioner’s Reply, as well as the relevant evidence discussed in those papers, we find that one of ordinary skill in the art would have considered these dependent claims obvious over Brown. Accordingly, we determine that Petitioner has shown by a preponderance of the evidence that claims 3, 7–10, 14–19, and 31–36 of the ’222 patent are unpatentable under 35 U.S.C. § 103(a) in view of Brown.

E. Asserted Obviousness of Claims 2, 11, 13, and 22–30 in View of Brown and Gainsboro

Petitioner contends claims 2, 11, 13, and 22–30 of the ’222 patent are unpatentable under 35 U.S.C. § 103 in view of Brown and Gainsboro. Pet. 32–41. Patent Owner disputes Petitioner’s position, arguing that a person of ordinary skill in the art would not have had reason to combine the references in the manner proposed by Petitioner (PO Resp. 34–37) and further that the combination of the references fails to teach or suggest all of the claim limitations (*id.* at 37–41).

We have reviewed the Petition, the Patent Owner Response, and Petitioner’s Reply, as well as the relevant evidence discussed in those papers. For reasons that follow, we determine Petitioner has shown by a preponderance of the evidence that claims 2, 11, 13, and 22–30 of the ’222 patent are unpatentable as obvious over the combination of Brown and Gainsboro.

1. Overview of Brown

See Section II.D.1 discussed above.

2. Overview of Gainsboro

Gainsboro discloses a system for Automatic Speech Recognition (ASR) that identifies key words. Ex. 1008, Abstract. The system in Gainsboro is integrated with a telephone control system and recording system, specifically for correctional facilities. *Id.* at 1:6–9.

One embodiment in Gainsboro discloses a system that monitors live conversations and triggers an alert function when specific key words or phrases are used in a conversation. *Id.* at 4:17–26. Following the alert trigger, the system allows for termination of the call or for a correctional officer to be patched into the conversation. *Id.* at 4:26–30.

Another embodiment in Gainsboro discloses a system that monitors recorded conversations and scans the conversation for key words or phrases. *Id.* at 4:19–22. The system identifies the key words or phrases in the recording and logs their location for future playback. *Id.* at 4:31–35.

3. Analysis

a. Reason to Combine Prior Art References

Petitioner contends a person of ordinary skill in the art would have had reason to combine the teachings of Brown and Gainsboro because both are in the same field (telephone communications and recording services) and address the same problem –monitoring, control, and management of those communications. Pet. 34; *see* Ex. 1003 ¶ 100. Petitioner supports its position with the Declaration of Dr. Kaza, who testifies that a person of skill in the art would have combined the functions of Brown and Gainsboro by

known methods, thereby rendering the challenged claims obvious. Ex. 1003 ¶ 102.

Patent Owner disputes Petitioner’s position, arguing that a person of ordinary skill in the art would not have had reason to combine the references in the manner proposed by Petitioner. PO Resp. 34–37. First, Patent Owner argues that Dr. Kaza’s conclusory opinions regarding the combination of Brown and Gainsboro should be given no probative weight because they are based on unsupported statements. *Id.* at 35–36. Second, Patent Owner argues that neither Dr. Kaza nor Petitioner even attempts to explain how the systems in Brown and Gainsboro could be combined, let alone that a person of ordinary skill in the art “would have selected and combined those prior art elements in the normal course of research and development to yield the claimed invention.” *Id.* Patent Owner relies on the Declaration of Dr. Alk to support its position. Dr. Alk testifies as follows

Brown merely discloses a system capable of converting speech to text that can be sent to a user, but no real-time monitoring of a conversation. (Petition at 13) And while Gainsboro discloses live monitoring of a conversation, no attempt is made by Petitioner to reconcile these significant differences in operation of the systems. (Petition at 34).

Ex. 2002 ¶ 101.

We are not persuaded by Patent Owner’s arguments, because they fail (1) to explain the differences between Brown and Gainsboro, (2) to rebut satisfactorily Petitioner’s explanation of why a person of ordinary skill in the art would have combined the teachings of Brown and Gainsboro, and (3) to consider and rebut Petitioner’s arguments regarding the collective teachings of Brown and Gainsboro from the perspective of one of ordinary skill in the

art. *See KSR*, 550 U.S. at 420 (“[F]amiliar items may have obvious uses beyond their primary purpose, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.”). To the contrary, we agree with Dr. Kaza, and find the fact that Brown and Gainsboro are in the same field (telephone communications and recording services) and address the same problem—control and management of those communications (*see* Ex. 1003 ¶ 100), weighs in favor of finding that a person of ordinary skill in the art would “fit the teachings” of Brown and Gainsboro together to render the challenged claims obvious. *See KSR*, 550 U.S. at 420 (“Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.”).

Moreover, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference. *In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012) (“[T]he test for obviousness is what the combined teachings of the references would have suggested to those having ordinary skill in the art.” (citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981))). Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art. *Id.*

b. Analysis of Claims 2, 11, and 13

Claim 2 depends from claim 1 and requires “a call processor providing communication services with respect to a controlled environment facility, and said user comprises an investigator.” Petitioner contends that Gainsboro discloses the “corrections industry” as a “*controlled environment facility*” and “correctional officer” constitutes the recited “*investigator.*”

Pet. 35 (citing Ex. 1008, 4:40–45). Claim 11 depends from claim 1 and requires “wherein said one or more aspects comprises termination of a monitored one of said communications between individuals.” Petitioner contends that Gainsboro discloses an embodiment where phone conversations can be terminated in response to an alert from the system. Pet. 35–36 (citing Ex. 1008, 4:23–29). Claim 13 depends from claim 1 and requires “barging into a monitored one of said communications between individuals.” Petitioner contends that Gainsboro discloses an embodiment that a correctional officer could be patched into the conversation in response to an alert from the system. *Id.*

Patent Owner does not provide contentions regarding additional limitations recited in dependent claims 2, 11, and 13. *See generally* PO Resp.; *see* 37 C.F.R. § 42.23(a).

After consideration of the language recited in claims 2, 11, and 13 of the ’222 patent, the Petition, the Patent Owner Response, and Petitioner’s Reply, as well as the relevant evidence discussed in those papers, we find that one of ordinary skill in the art would have considered these dependent claims obvious over Brown in view of Gainsboro. Accordingly, we determine that Petitioner has shown by a preponderance of the evidence that claims 2, 11, and 13 of the ’222 patent are unpatentable under 35 U.S.C. § 103(a).

c. Analysis of Dependent Claims 22–30

Claims 22–30 depend from claim 21, and Petitioner contends that Brown and Gainsboro discloses embodiments that teach aspects of each dependent claim. Pet. 37–41. Patent Owner contends that Petitioner fails to

explain how Brown or Gainsboro teach the limitations of claims 22, 23, and 26. PO Resp. 37–41.

After consideration of the language recited in claims 22–30 of the '222 patent, the Petition, the Patent Owner Response, and Petitioner's Reply, as well as the relevant evidence discussed in those papers, we find that one of ordinary skill in the art would have considered these dependent claims obvious over Brown in view of Gainsboro. Accordingly, we determine that Petitioner has shown by a preponderance of the evidence that claims 22–30 of the '222 patent are unpatentable under 35 U.S.C. § 103(a).

F. Asserted Obviousness of Claim 4 in View of Brown and Hong Kong

Petitioner contends claim 4 of the '222 patent is unpatentable under 35 U.S.C. § 103 in view of Brown and Hong Kong. Pet. 41–42. Patent Owner disputes Petitioner's position, arguing that a person of ordinary skill in the art would not have had reason to combine the references in the manner proposed by Petitioner (PO Resp. 41–43) and further that the combination of the references fails to teach or suggest all of the claim limitations (*id.* at 44–45).

We have reviewed the Petition, the Patent Owner Response, and Petitioner's Reply, as well as the relevant evidence discussed in those papers. For reasons that follow, we determine Petitioner has shown by a preponderance of the evidence that claim 4 of the '222 patent is unpatentable as obvious over the combination of Brown and Hong Kong.

1. Overview of Brown

See Section II.D.1 discussed above.

2. *Overview of Hong Kong*

Hong Kong discloses information regarding prison conditions in Hong Kong prisons under Chinese rule. Ex. 1009, 2. Hong Kong discloses that “notices are prominently posted warning visitors that monitoring [of communications] occurs.” *Id.* at n115. Hong Kong further states that “in at least one maximum security prison, conversations between certain prisoners and their visitors are recorded.” *Id.*

3. *Analysis*

Petitioner contends that a person of ordinary skill in the art would have been motivated to combine Brown and Hong Kong because Brown describes monitoring telephone conference call services and Hong Kong describes monitoring of visitation calls with inmates. Pet. 42 (citing Ex. 1003 ¶139). According to Petitioner, substitution of one type of conversation (Brown’s telephone call) with another type of conversation (Hong Kong’s inmate visitation call) provides predictable results and, therefore, would have been obvious. *Id.* (citing *KSR Int ’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007)). Therefore, Petitioner concludes that the combination of Brown and Hong Kong discloses “wherein said communications between individuals comprise controlled environment facility visitation calls.”

Patent Owner, however, argues that Hong Kong is a report about prison conditions and is not a technical document that addresses telecommunications or monitoring of prison calls and, therefore, one of skill in the art would not look to Hong Kong for information and would not have combined it with Brown. PO Resp. 44–45. Patent Owner further argues that the combined references fail to teach “wherein said communications

between individuals comprise controlled environment facility visitation calls” as recited in claim 4. *Id.*

Despite Patent Owner’s arguments, we agree with Petitioner that the combination of Brown and Hong Kong would have rendered the claims obvious. Although Hong Kong is not a technical document, it does demonstrate the state of the art and that prisons were monitoring and recording calls between inmates and visitors. Therefore, we are satisfied that a person of skill in the art would have combined the information in Brown and Hong Kong, thereby rendering the limitation “wherein said communications between individuals comprise controlled environment facility visitation calls” obvious.

Accordingly, we determine that Petitioner has shown by a preponderance of the evidence that claim 4 of the ’222 patent is unpatentable under 35 U.S.C. § 103(a).

G. Asserted Obviousness of Claim 5 in View of Brown and Mow

Petitioner contends claim 5 of the ’222 patent is unpatentable under 35 U.S.C. § 103 in view of Brown and Mow. Pet. 42–43. Patent Owner does not provide arguments disputing Petitioner’s position. *See* 37 C.F.R. § 42.23(a).

After consideration of the language recited in claim 5 of the ’222 patent, the Petition, the Patent Owner Response, and Petitioner’s Reply, as well as the relevant evidence discussed in those papers, we find that one of ordinary skill in the art would have considered claim 5 obvious over Brown in view of Mow. Accordingly, we determine that Petitioner has shown by a preponderance of the evidence that claim 5 of the ’222 patent is unpatentable under 35 U.S.C. § 103(a).

H. Asserted Obviousness of Claim 6 in View of Brown and Pettay

Petitioner contends claim 6 of the '222 patent is unpatentable under 35 U.S.C. § 103 in view of Brown and Pettay. Pet. 43–45. Patent Owner disputes Petitioner's position, arguing that the combination of the references fails to teach or suggest all of the claim limitations. PO Resp. 45–46. Specifically, Patent Owner contends that the disclosure of video recording by Pettay does not constitute "video conferencing," because Pettay does not disclose that the video is transmitted or communicated. *Id.*

We do not agree with Patent Owner. Rather, we agree with Petitioner's position. Pet. 43–45. As discussed above, Brown establishes a telephone conference between two or more users (Ex. 1007 ¶¶ 2, 13), such that the extension to video conferencing would have been obvious. Accordingly, we determine Petitioner has shown by a preponderance of the evidence that claim 6 of the '222 patent is unpatentable as obvious over the combination of Brown and Pettay.

I. Asserted Obviousness of Claim 12 in View of Brown, Gainsboro, and Johnson

Petitioner contends claim 12 of the '222 patent is unpatentable under 35 U.S.C. § 103 in view of Brown, Gainsboro, and Johnson. Pet. 45–46. Patent Owner does not provide arguments disputing Petitioner's position. *See* 37 C.F.R. § 42.23(a).

After consideration of the language recited in claim 12 of the '222 patent, the Petition, the Patent Owner Response, and Petitioner's Reply, as well as the relevant evidence discussed in those papers, we find that one of ordinary skill in the art would have considered claim 12 obvious over Brown in view of Gainsboro and Johnson. Accordingly, we determine that

Petitioner has shown by a preponderance of the evidence that claim 12 of the '222 patent is unpatentable under 35 U.S.C. § 103(a).

J. Asserted Obviousness of Claim 20 in View of Brown and Crites

Petitioner contends claim 20 of the '222 patent is unpatentable under 35 U.S.C. § 103 in view of Brown and Crites. Pet. 47. Patent Owner does not provide arguments disputing Petitioner's position. See 37 C.F.R. § 42.23(a).

After consideration of the language recited in claim 20 of the '222 patent, the Petition, the Patent Owner Response, and Petitioner's Reply, as well as the relevant evidence discussed in those papers, we find that one of ordinary skill in the art would have considered claim 20 obvious over Brown in view of Crites. Accordingly, we determine that Petitioner has shown by a preponderance of the evidence that claim 20 of the '222 patent is unpatentable under 35 U.S.C. § 103(a).

K. Asserted Obviousness of Claims 7, 9, and 16 in View of Brown and Hodge

Petitioner contends claims 7, 9, and 16 of the '222 patent are unpatentable under 35 U.S.C. § 103 in view of Brown and Hodge. Pet. 48–51. Patent Owner disputes Petitioner's position with regards to claim 16, arguing that the combination of the references fails to teach or suggest all of the claim limitations. PO Resp. 46–47. According to Patent Owner, claim 16 requires the identification of at least one of said individuals to be part of the information presented to the user by a data interface, yet Petitioner does not explain how the prior art presents information by a data interface. *Id.* The claim, however, does not require that identification be presented to a user by a data interface. Moreover, Hodge specifically addresses a solution

of “an improved telephone call management system using improved identification means including biometric identification . . . [that] incorporates control means, monitoring means, recording means, and a reporting means for an institution based telecommunication network.” *See* Ex. 1014 ¶ 42. Therefore, we agree with Petitioner’s position and find that one of ordinary skill in the art would have considered claims 7, 9, and 16 obvious over Brown in view of Hodge.

Accordingly, we determine that Petitioner has shown by a preponderance of the evidence that claims 7, 9, and 16 of the ’222 patent is unpatentable under 35 U.S.C. § 103(a).

III. MOTION TO AMEND

Patent Owner filed a Motion to Amend in order to correct the dependency of claims 15–20. Paper 21 (“Mot. to Amend”). According to Patent Owner, claims 15–20 depend from claim 1, but “it is clear from the claim language that they were intended to depend from claim 14.” Mot. to Amend 2. In an *inter partes* review, amended claims are not added to a patent as of right, but rather must be proposed as a part of a Motion to Amend. 35 U.S.C. § 316(d). As the moving party, Patent Owner bears the burden of proof in establishing that it is entitled to add proposed substitute claims 15–20. 37 C.F.R. § 42.20(c). As part of this showing, Patent Owner must demonstrate (1) the amendment responds to a ground of unpatentability involved in the trial; (2) the amendment does not seek to enlarge the scope of the claims of the patent or introduce new subject matter; (3) the amendment proposes a reasonable number of substitute claims; and (4) the proposed claims are supported in the original disclosure. 37 C.F.R. § 42.121.

Upon review of the Motion to Amend, we are not persuaded that the requirements of 37 C.F.R. § 42.121 have been met. Specifically, as Patent Owner notes multiple times in its Motion to Amend, the requested corrections “are not made in response to a ground of unpatentability involved in the [*inter partes* review].” Mot. to Amend 2, 10, 12, 15, 17, 19, 22. Rather, the correction is sought merely to correct the dependency of the claims to match the language of the claims as issued. *Id.* Although Patent Owner later argued that its Motion to Amend contains “an unfortunate typo that got carried throughout the Motion to Amend,” (Tr. 34:3–5), the Patent Owner still failed to establish satisfactorily how a correction of claim dependency was in response to a ground of unpatentability involved in the trial (*see, e.g., id.* at 37:19–38:12).

Moreover, even if we were to accept Patent Owner’s argument that the prior statement that “[t]h[e] proposed correction is not made in response to a ground of unpatentability involved in the [*inter partes* review]” was merely a typo or typos, Patent Owner does not establish the proposed claims are supported in the original disclosure. In fact, Patent Owner does not reference the original patent application once in its Motion to Amend, let alone provide citations that would demonstrate written description support for the proposed corrected claims.

Accordingly, we determine that Patent Owner has not met its burden on its Motion to Amend regarding entry of proposed substitute claims 15–20, and thus, we deny the Motion to Amend.

IV. CONCLUSION

We conclude Petitioner has shown by a preponderance of the evidence that claims 1–36 of the '222 patent would have been obvious in view of the following prior art references:

1. Claims 1, 3, 7–10, 14–19, 21, and 31–36 under 35 U.S.C. § 103(a) as unpatentable over Brown;
2. Claims 2, 11, 13, and 22–30 under 35 U.S.C. § 103(a) as unpatentable over Brown and Gainsboro;
3. Claim 4 under 35 U.S.C. § 103(a) as unpatentable over Brown and Hong Kong;
4. Claim 5 under 35 U.S.C. § 103(a) as unpatentable over Brown and Mow;
5. Claim 6 under 35 U.S.C. § 103(a) as unpatentable over Brown and Pettay;
6. Claim 12 under 35 U.S.C. § 103(a) as unpatentable over Brown, Gainsboro, and Johnson;
7. Claim 20 under 35 U.S.C. § 103(a) as unpatentable over Brown and Crites; and
8. Claims 7, 9, and 16 under 35 U.S.C. § 103(a) as unpatentable over Brown and Hodge.

In addition, we conclude Patent Owner has not demonstrated, by a preponderance of the evidence, that the Motion to Amend meets the requirements set forth in 37 C.F.R. § 42.121.

V. ORDER

For the reasons given, it is

ORDERED that, by a preponderance of the evidence, claims 1–36 of the '222 patent are unpatentable;

FURTHER ORDERED that Patent Owner's Motion to Amend is *denied*; and

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FURTHER ORDERED that because this is a Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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