

Global Tel*Link's Inmate Calling Patent Survives AIA Review

By Erin Coe

Law360, San Diego (April 11, 2016, 11:34 PM ET) -- The Patent Trial and Appeal Board has held that Securus Technologies fell short of proving allegations that Global Tel*Link's inmate calling system patent was obvious, upholding the patent and clearing the way for the patent owner to proceed with infringement litigation against Securus in a Texas federal court.

In a final written decision of a case that was the first argued in the PTAB's Detroit satellite office, a three-member panel determined Thursday that Securus Technologies Inc. and its expert didn't go far enough to show how one of ordinary skill in the art would have combined prior art references — in this case, two patents — to render Global Tel*Link Corp.'s patent covering biometric and voice validation of inmate calls invalid as obvious. The patent-at-issue is U.S. Patent Number 7,853,243 B2.

The panel noted that Securus' "perfunctory analysis" was rebutted by Global Tel*Link's expert, who testified that the two prior art references were directed to unrelated concepts and directed to "very different architectures that are not easily combined."

"We credit the testimony of [Global Tel*Link's expert] more strongly than that of [Securus' expert] because [Global Tel*Link's expert] provides explicit reasoning to support his opinion that [the prior art references] are concerned with different implementation settings, rely on different architecture structures, have technical incompatibilities, and are drawn from different fields," the panel found.

Global Tel*Link initially filed suit in a Virginia federal court in October 2013, alleging Securus' Secure Call Platform infringed the '243 patent and other patents covering telecommunication systems and services for correctional facilities. Global Tel*Link has said the '243 patent covers "a fundamental tool for providing and maintaining the security of inmate calling services." The case was later transferred to the U.S. District Court for the Northern District of Texas.

Securus lodged inter partes reviews of the patents at the PTAB. In the current case, it claimed that Global Tel*Link's '243 patent was obvious, and the PTAB instituted a review in May. The Texas federal court then stayed the litigation in August in light of the pending review proceedings before the PTAB.

Securus' petition in the current case asserted that the '243 patent was obvious in light of one patent known as Susen that covers a method for verifying access authorization for voice telephony in a fixed network line or mobile telephone line and another patent known as Gainsboro that discloses a feature of a prison phone system.

The PTAB found on Thursday that Securus failed to show that all steps within the scope of a limitation of Global Tel*Link's patent were disclosed by Susen. It also determined that Securus' reasoning that one of ordinary skill in the art would combine the teachings of Susen and Gainsboro was insufficient and that its expert's testimony merely repeated the statements made in the petition "with only minimal surface changes."

"As patent owner contends, these statements are also made within the context of a broad characterization of the art, namely 'managing institutional calls,'" the panel wrote. "The cursory assertion that the prior-art references are drawn from the same broadly characterized field provides insufficient analysis concerning why and how a person of ordinary skill in the art would have modified or combined the prior art in the manner asserted, and inadequately articulates 'reasoning with some rational underpinning to support the legal conclusion of obviousness.'"

As a result, the PTAB determined that Securus failed to show that any claim of the '243 patent was unpatentable.

"Now that this patent has been entirely validated through the PTAB's rigorous review process, we have a path to trial and the opportunity to show the jury how we believe Securus has infringed these patents, is liable for past damages, and should be prevented from using this technology in their systems in the future," said Brian Oliver, CEO of Global Tel*Link.

Of the other two patents challenged by Securus, the PTAB denied review of one and instituted review of another patent and a decision should be issued later this month, according to Global Tel*Link.

The board's decision highlights that petitioners cannot take short cuts and that detailed technical analysis really matters, according to Michael Specht, a Sterne Kessler Goldstein & Fox PLLC attorney who represents Global Tel*Link.

"The board noted that the petitioner's expert did not respond to questions during his cross-examination to support his positions," he said. "The case also highlights the importance of having highly qualified experts who can support their positions during cross-examination."

The PTAB's Thursday decision comes after the PTAB in February agreed with Global Tel*Link in a separate inter partes review that claims of a Securus patent covering methods for monitoring the activity of prison detainees based on gang affiliation were obvious.

Representatives for Securus were not immediately available for comment Monday.

The patent-at-issue is U.S. Patent Number 7,853,243 B2.

Securus is represented by Justin Kimble of Bragalone Conroy PC.

Global Tel*Link is represented by Michael Specht, Michael Ray and Lauren Schleh of Sterne Kessler Goldstein & Fox PLLC.

The case is Securus Technologies Inc. v. Global Tel*Link Corp., case number IPR2015-00155, in the Patent Trial and Appeal Board.

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