

Filed on behalf of Securus Technologies, Inc.

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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 IPR2016-01220
U.S. Patent No. 9,007,420 B1

PATENT OWNER'S PRELIMINARY RESPONSE

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I. INTRODUCTION

Patent Owner Securus Technologies, Inc. (“Securus” or “Patent Owner”) hereby files this preliminary response (“Preliminary Response”) to the Petition (Paper 2) (the “Petition”) for *Inter Partes* Review of U.S. Patent No. 9,007,420 (Ex. 1001) (the “’420 Patent”) in IPR2016-01220 filed by Global Tel*Link Corporation (“GTL” or “Petitioner”).

The Petitioner’s challenge to the ’420 Patent claims should be rejected because (1) the prior art lacks material claim limitations; (2) Petitioner has failed to consider claims as a whole; and (3) Petitioner’s grounds of unpatentability rely on erroneous claim constructions.

This Response is timely under 35 U.S.C. § 313 and 37 C.F.R. § 42.107(b), as it is filed within three months of the June 22, 2016 mailing date of the Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response. (Paper 3). For purposes of this Preliminary Response, Patent Owner has limited its identification of deficiencies in the Petition and does not intend to waive any arguments not addressed in this Preliminary Response.

A. Grounds in the Petition

The Petition includes two grounds of alleged invalidity; both of the grounds rely on the combination of *Torgersrud* (U.S. Patent App. Pub. No. 2012/0262271 A1) and *Kenoyer* (U.S. Patent No. 8,218,829) for allegedly rendering

obvious independent claims 1 and 11 of the '420 Patent under 35 U.S.C. § 103.

Ground 2 additionally relies upon Zhang (U.S. Patent No. 7,436,988).

Ground	References Combined	Independent Claims	Dependent Claims
1	<i>Torgersrud and Kenoyer</i>	1, 11	2-9, 12-19
2	<i>Torgersrud, Kenoyer, and Zhang</i>	21	10, 20

Pet. at 12.

As discussed in more detail below, none of the references above, either separately or in combination, disclose all limitations in the independent claims, including, for example, the detection of the presence of an “actual face.” Additionally, none of the references cited disclose the capture of a user’s image in response to a request to initiate an electronic visitation session. Thus, the Petition does not demonstrate a reasonable likelihood that any of the proposed grounds of unpatentability will succeed for any claim of the '420 patent.

B. The '420 Patent – The Challenged Patent

The '420 Patent titled “Verifying Presence of Authorized Persons During an Electronic Visitation” was filed on January 10, 2014 and is directed “to methods and systems for verifying presence of authorized persons during an electronic visitation.” '420 Patent at 1:5-10. One important goal of the '420 Patent is to prevent circumvention of the authentication process by users who may use a photograph to fool prior art facial detection and recognition techniques. *Id.* at 1:27-35; 8:66-9:12.

To this end, the '420 Patent provides a system and method that uses a “feature detection process on the captured image,” such as “a 3D feature detection process,” to verify the user’s presence by, among other things, determining if the user’s “actual face” (i.e., a person’s corporeal face) is shown in the captured image, as opposed to a photograph or other facsimile. *Id.*

A controlled-environment facility such as a prison may provide various options for inmates to communicate with visitors and other parties outside the prison. One of these options includes video visitation. These outside parties (e.g., family members) are sometimes located long distances from the inmate, making travel to the prison onerous or impractical. In some cases, outside parties may visit with an inmate remotely using a personal computer with an image capture device such as a web-cam. This is sometimes referred to as “at home visitation,” and occurs via “electronic visitation sessions.” However, inmates are typically restricted to receiving visitation only from approved persons. *Id.* at 1:14-34.

When an individual visits an inmate in person, the individual’s identity may easily be determined by providing identification documents to staff of the controlled-environment facility for verification. *Id.* The identification documents may include a photo-ID such as a driver’s license or the like and the staff members may cross-reference the individual’s name with a list of individuals on the inmate’s approved visitor list.

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