

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 IPR2016-01362
U.S. Patent No. 9,083,850

**PATENT OWNER'S RESPONSE TO PETITIONER'S MOTION TO
SUBMIT SUPPLEMENTAL INFORMATION
UNDER 37 C.F.R. § 42.123(A)**

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Patent Owner Securus Technologies, Inc. (“Securus”) hereby files with the Patent Trial and Appeal Board (“PTAB”) the following response to Petitioner’s Motion to Submit Supplemental Information (Paper 14, referred to as the “Motion”) under 37 C.F.R. § 42.123(a). The Motion was filed on February 17, 2017 by Global Tel*Link Corporation (“Petitioner”) in support of evidence, namely Petitioner’s Exhibit 1008, submitted in the petition for *inter partes* review in this proceeding.

I. Introduction

By this Motion, Petitioner seeks to admit *new evidence*, which it labels “supplemental information,” under 37 C.F.R. § 42.123(a). The Motion seeks the PTAB’s acceptance of new evidence to be filed in these proceedings to “confirm[] the public accessibility of Exhibit 1008 [also referred to as “Gotsopoulos”] prior to the earliest priority date of the ’850 patent.” Motion, 1. This new evidence consists of the following:

1. Declaration of Gerard P. Grenier, Custodian of Records for IEEE, dated January 27, 2017, attesting to the public accessibility of Exhibit 1008 as of at least December 2, 2010, and the public accessibility online as of at least February 13, 2012 (Petitioner’s Exhibit 1011); and
2. The entire European DSP in Education and Research Conference (EDERC2010) proceeding papers downloaded from the IEEE electronic digital library (Petitioner’s Exhibit 1010).

Motion, 1. Because Petitioner did not allege that the supplemental information reasonably could not have been submitted with the Petition, Petitioner's Motion should be denied.

II. Arguments in Support of Response

The "USPTO regulations dictate '[a] party filing a motion has the burden of proof to establish that it is entitled to the requested relief.'" *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 444 (Fed. Cir. 2015) (internal quotations omitted). The Federal Circuit agreed that "[t]his is so, no matter the requested relief." *Id.*

Petitioner seeks the PTAB's acceptance of supplemental information, but does not meet its burden to show that it is entitled to the requested relief. As proof, Petitioner alleges that the Motion "complies with the requirements of rule 42.123(a): a request for the authorization to file a motion to submit supplemental information was timely and the supplemental information is relevant to a claim." Motion, 1. Petitioner further "notes that rule 42.123(a) does not require the movant to demonstrate that the supplemental information proffered could not have been obtained earlier." Motion, 3 (citing IPR2014-01204, Paper 26, pp. 3-4).

To the contrary, the Federal Circuit in *Redline* held that that "nothing in 37 C.F.R. § 42.123 requires that a request to submit supplemental information satisfying these two criteria, i.e., timeliness and relevance, *automatically be granted*

no matter the circumstance.” *Redline*, 811 F.3d at 444 (emphasis added).¹ The Federal Circuit warned that “[t]his provision does not offer a routine avenue for bolstering deficiencies in a petition raised by a patent owner in a Preliminary Response [and that] Petitioner should not expect a wait-and-see opportunity to supplement a petition after initial comments or arguments have been laid out by a patent owner.” *Id.* at 448 (internal quotations omitted). Here, Petitioner has taken that “wait-and-see” attitude to its evidentiary submission, admitting that the only reason it filed the Motion was because “Patent Owner asserted that the evidence of record did not demonstrate that Exhibit 1008 was publicly accessible before the earliest priority date of the ’850 patent.” Motion, 2.²

The Federal Circuit agreed that “whether the Board grants a motion to submit supplemental information also depends upon the Board’s determination that, *in its discretion*, the action sought by the movant is consistent with the Board’s statutory

¹ Patent Owner notes that *Redline* was decided on December 31, 2015, eight months after Paper 26 of IPR2014-01204 was decided on April 10, 2015.

² Previously, on January 24, 2017, Securus filed objections to and sought the denial of the admission and consideration of Exhibit 1008, titled “Remote Controlled DSP Based Image Capturing and Processing System Featuring Two-Axis Motion,” by Gotsopoulos et al. (“Gotsopoulos’).” Paper 13.

mandate.” *Redline*, 811 F.3d at 444 (emphasis added). Importantly, “*the PTAB has discretion to grant or deny motions as it sees fit.*” *Id.* at 447 (emphasis added).

In *Redline*, the Federal Circuit affirmed the PTAB’s use of its discretion to deny a motion to supplement information that otherwise met the timeliness and relevancy requirements of § 42.123(a). The PTAB found that “Redline did not allege any of the arguments or evidence in the newly submitted declaration was information that reasonably could not have been submitted with the Petition.” *Id.* at 443 (Fed. Cir. 2015) (internal quotations omitted).

Here, the PTAB should use its discretion to similarly deny Petitioner’s Motion, because Petitioner fails to allege, argue, or demonstrate any reason why it “the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice.” *See* 37 C.F.R. § 42.123(b), (c). Indeed, Petitioner expressly states it does not need to do so. Motion, 3. Given the date and nature of the information submitted with the Motion, there is every indication that these documents were reasonably available at the time of filing the Petition, and that Petitioner merely neglected to submit them at that time. *See* Exs. 1010, 1011 (documents attesting and purporting to show that Gotsopolous was published in 2010 and copies made available no later than last of conference held from December 1-2, 2010).

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