

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 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. 9,083,850 (Ex. 1001) (the “’850 Patent”) in IPR2016-01362 filed by Global Tel*Link Corporation (“GTL” or “Petitioner”).

The Petitioner’s challenge to the ’850 Patent claims should be rejected because (1) U.S. Patent No. 9,106,789 (Ex. 1004) (“*Shipman*”) and U.S. Patent No. 7,911,513 (Ex. 1005) (“*Garrison*”), the sole basis of Petitioner’s obviousness ground against independent claims 1, 8, and 14 of the ’850 Patent, fail to disclose, both separately and in combination, at least one material limitation of each claim; and (2) Petitioner has failed to show a motivation to combine *Shipman* and *Garrison*, the combination of art that forms the basis of Petitioner’s obviousness claim for all of the independent claims of the ’850 Patent.

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 July 13, 2016 mailing date of the Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response. Paper 4. 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 five grounds of alleged invalidity; all of the grounds rely on the combination of *Shipman* (U.S. Patent No. 9,106,789) and *Garrison* (U.S. Patent No. 7,911,513) for allegedly rendering obvious all independent claims (claims 1, 8, and 14) of the '850 Patent under 35 U.S.C. § 103. Grounds 2-5 address only dependent claims and rely upon additional references as shown below.

| Ground | References Combined | Independent Claims | Dependent Claims |
|---------------|--|---------------------------|-------------------------|
| 1 | <i>Shipman</i> and <i>Garrison</i> | 1, 8, and 14 | 5, 9 |
| 2 | <i>Shipman</i> , <i>Garrison</i> , and <i>Mayhew</i> | | 2-4, 15-18 |
| 3 | <i>Shipman</i> , <i>Garrison</i> , and <i>Gotsopoulos</i> | | 6, 7, 10, 11, and 19 |
| 4 | <i>Shipman</i> , <i>Garrison</i> , <i>Gotsopoulos</i> , and <i>Johnson</i> | | 12 and 20 |
| 5 | <i>Shipman</i> , <i>Garrison</i> , and <i>Johnson</i> | | 13 and 21 |

Pet. at 3-5.

As discussed in detail below, Petitioner fails to show that *Shipman* and *Garrison* disclose, either separately or in combination, disclose all limitations in the independent claims, including, for example, “adjusting a depth of field parameter for the video, such that an image of a first object at a first distance from the video visitation device is in focus and an image of a second object at a second distance from the video visitation device is blurred.” Further, Petitioner fails to demonstrate a motivation to combine these references. Thus, the Petition does not demonstrate a reasonable likelihood that any of the proposed grounds of unpatentability will

succeed for any claim of the '850 patent.

B. The '850 Patent – The Challenged Patent

The '850 Patent was filed on June 29, 2013 and is directed to an apparatus and methods for manipulating video received from a video visitation device in a secure environment that vary the depth of field of the video. '850 Patent, Abstract, 1:52-60, claim 1. One important goal of the '850 Patent is to “safe guard the privacy and promote the safe use of video services provided within inmate housing areas” by preventing viewers of the video services from plainly seeing unintended people and/or details such as showers, bathrooms, interiors of cells, or just other inmates. *Id.*, 1:6-25. The inventor also noticed that “inmates who know they are on camera” may “cause disruptions which can escalate and become safety issues.” *Id.*, 1:6-18.

The prior art sought to solve these problems in a number of different ways: by (1) placing video terminals outside of the general inmate population; (2) designing housing units in such a way that the video terminals face an innocent area; and (3) using facial recognition technology “to ‘lock in’ on the facial features of the inmate and blur everything but those features.” *Id.*, 1:26-48. But all of the prior art solutions had significant problems. Placing video terminals outside of the general inmate population raised “security and administrative issues associated with moving inmates from housing locations to visitation locations.” *Id.*, 1:26-33. Re-designing housing units was “impractical since most correctional institutions were constructed

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