

Securus Tech v. Global Tel*Link Corp: Petition for Inter Partes Review Denied IPR2016-00267

Article By:

Intellectual Property Litigation Drinker Biddle

Takeaway: In order to prevail on obvious grounds at institution, a petitioner must not only show where each limitation is disclosed in the prior art, but also an adequate motivation to combine the references.

In its [Decision](#), the Board denied review of any of the challenged claims (1-55) of the '816 Patent. The '816 Patent describes a system for conducting video visits between two participants, such as prison inmates and outside visitors.

The Board began by determining that claim construction was not necessary for the decision. The Board then reviewed the asserted grounds of obviousness of the challenged claims over Bulriss, Hesse, and Rae. The Board found that Petitioner did not meet its burden of explaining how the combinations of Bulriss, Hesse, and Rae would have rendered the challenged claims unpatentable. Petitioner contended that the problems discussed in the '816 Patent would have served as a rationale to combine Bulriss and Hesse, but the Board found that Petitioner had not shown that those problems were actually known in the relevant timeframe.

The Board agreed with Patent Owner that the communication in Bulriss is attorney-client privileged, and it is not monitored and is private. The Board noted that while it is possible that a "video visit" may encompass more than communications between inmate and attorney, Petitioner had not relied upon more in its Petition. The Board also found that Petitioner did not adequately explain where the monitoring step of claim 1 is disclosed in Bulriss. The Board also agreed with Patent Owner that one of ordinary skill in the art would not have been motivated to provide scheduling of video visits, per claim 1 and 30, in the context of Bulriss, in view of Hesse, for the reasons supplied by Petitioner.

Securus Technologies, Inc. v. Global Tel*Link Corporation, IPR2016-00267

Paper 8: Decision Denying Institution of *Inter Partes* Review

Dated: June 3, 2016

Patent 7,256,816 B2

Before: Kevin F. Turner, Barbara A. Benoit, and Georgianna W. Braden

Written by: Turner

Related Proceeding: *Securus Tech., Inc. v. Global Tel*Link Corp.*, No. 3:14-cv-04233-M (N.D. Tex.)

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