

Fed. Circ. Rejects Rehearing For Nixed Call Patent

By **Kat Greene**

Law360, Los Angeles (July 18, 2017, 6:54 PM EDT) -- The Federal Circuit on Tuesday refused to reconsider a decision to revive a review by the Patent Trial and Appeal Board of certain claims of a call-processing patent, rejecting Securus Technologies Inc.'s contention the decision was just giving its rival a "mulligan."

The appeals court denied Securus' bids for rehearing as a panel or en banc despite its contention that the court's remand of a set of claims for additional proceedings was in error because Congress didn't include the option for a "mulligan" in the America Invents Act, which calls for a one-year deadline on reviews, court records show.

The panel should have either reversed the PTAB's decision on the asserted claims or vacated the decision and remanded the matter with the instruction that the proceedings be nixed without the issuance of a final written decision, Securus had argued.

The appeals court shut down the rehearing bid in a short order Tuesday without comment.

In two inter partes review final decisions, the PTAB in January 2016 held that Securus rival Global Tel Link Corp. had shown that all the claims in the Securus patent at issue were obvious. In April, the Federal Circuit affirmed the board's conclusions with respect to most of those claims.

However, the appeals court said the PTAB had provided nothing more than a "generic sentence" to explain its reasoning for one group of claims. The court remanded that set of claims back to the board for additional proceedings.

The patent at issue is part of a series of patents owned by Securus related to call-processing and call-billing technology used in correctional facilities. Securus and GTL compete in this sector, and each has accused the other of violating protected inventions.

The PTAB used a nearly identical sentence to explain why the asserted claims were obvious: "After consideration of the language recited in [the claims], the petition, the patent owner response and the petitioner's reply, as well as the relevant evidence discussed in those papers, we find that one of ordinary skill in the art would have considered these dependent claims obvious over [the asserted art]."

The Federal Circuit found that wasn't good enough and shipped it back to the board for another look,

but Securus cried foul, saying the PTAB is required by the AIA to conclude its inter partes reviews of patent claims within a year of deciding to institute them. The remand puts that review beyond its one-year deadline, Securus said.

Representatives for the parties didn't immediately respond to requests for comment Tuesday.

The patent at issue is U.S. Patent Number 7,860,222.

Securus is represented by Jeffrey R. Bragalone, Justin B. Kimble, Daniel F. Olejko and Terry A. Saad of Bragalone Conroy PC.

Global Tel Link is represented by Jon Wright, Ross G. Hicks, Michael B. Ray and Michael D. Specht of Sterne Kessler Goldstein & Fox PLLC.

The cases are Securus Technologies Inc. v. Global Tel Link Corp., case numbers 16-1992 and 16-1993, in the U.S. Court of Appeals for the Federal Circuit.

--Additional reporting by Jess Krochtengel, Matthew Bultman and Kevin Penton. Editing by Orlando Lorenzo.