

UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT TRIAL AND APPEAL BOARD

MOTOROLA SOLUTIONS, INC.,
Petitioner,

v.

STA GROUP LLC,
Patent Owner.

Case IPR2023-01292
U.S. Patent No. 7,324,802 B2

PATENT OWNER'S PRELIMINARY RESPONSE

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Exhibit List

Exhibit No.	Exhibit Name
2001	<i>STA Group LLC v. Motorola Solutions, Inc.</i> , Case No. 2:22-cv-00381 (E.D. Tex.), Dkt No. 187
2002	<i>Entity</i> , MERRIAM WEBSTER COLLEGIATE DICTIONARY (11th ed. 2003)
2003	December 2023 DocketNavigator, Time to Trial Statistics in Patent Cases in the United States District Court for the Eastern District of Texas

I. INTRODUCTION

Patent Owner, STA Group LLC (“Patent Owner”), submits this Patent Owner Preliminary Response (“POPR”) pursuant to 37 C.F.R. § 42.107(a) in response to the *Inter Partes* Review (“IPR”) petition (“Petition”) filed by Petitioner Motorola Solutions, Inc. (“Petitioner”) for claims 1-21 (“Challenged Claims”) of U.S. Patent 7,324,802 B2 (“’802 Patent”, Ex. 1001).

The Board should deny the Petition for two reasons.

First, the Board should exercise its discretion to deny institution under § 314(a) because the Petitioner fails to provide a compelling merits argument. The Petition does not present “a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a).

Second, other *Fintiv* factors provide a rationale to deny institution.¹ Petitioner has not requested a stay in the parallel district court litigation (“Parallel Proceeding”), there is no stipulation by Petitioner regarding issues asserted in this Proceeding versus the Parallel Proceeding, there will be substantial costs associated with carrying out both proceedings, and the timing of a Final Written Decision

¹ See *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (designated as precedential May 5, 2020).

(“FWD”) will take place after trial in the Parallel Proceeding. These issues provide independent reasons for the Board to deny institution under § 314(a).

II. THE '802 PATENT

A. The Invention of the '802 Patent

The '802 Patent issued on January 29, 2008. Ex. 1001, Cover. The invention of the '802 Patent relates to systems and methods for the management of messages received simultaneously on different channels in a communication system so that when incoming messages overlap in time, the messages are prioritized and played in order of priority. *Id.*, Abstract. When a message is received on one channel, the method plays the higher priority of the communication while simultaneously saving the lower priority message to be played at another time. *Id.*, 1:62-2:9. The described method is exemplified in Fig. 3:

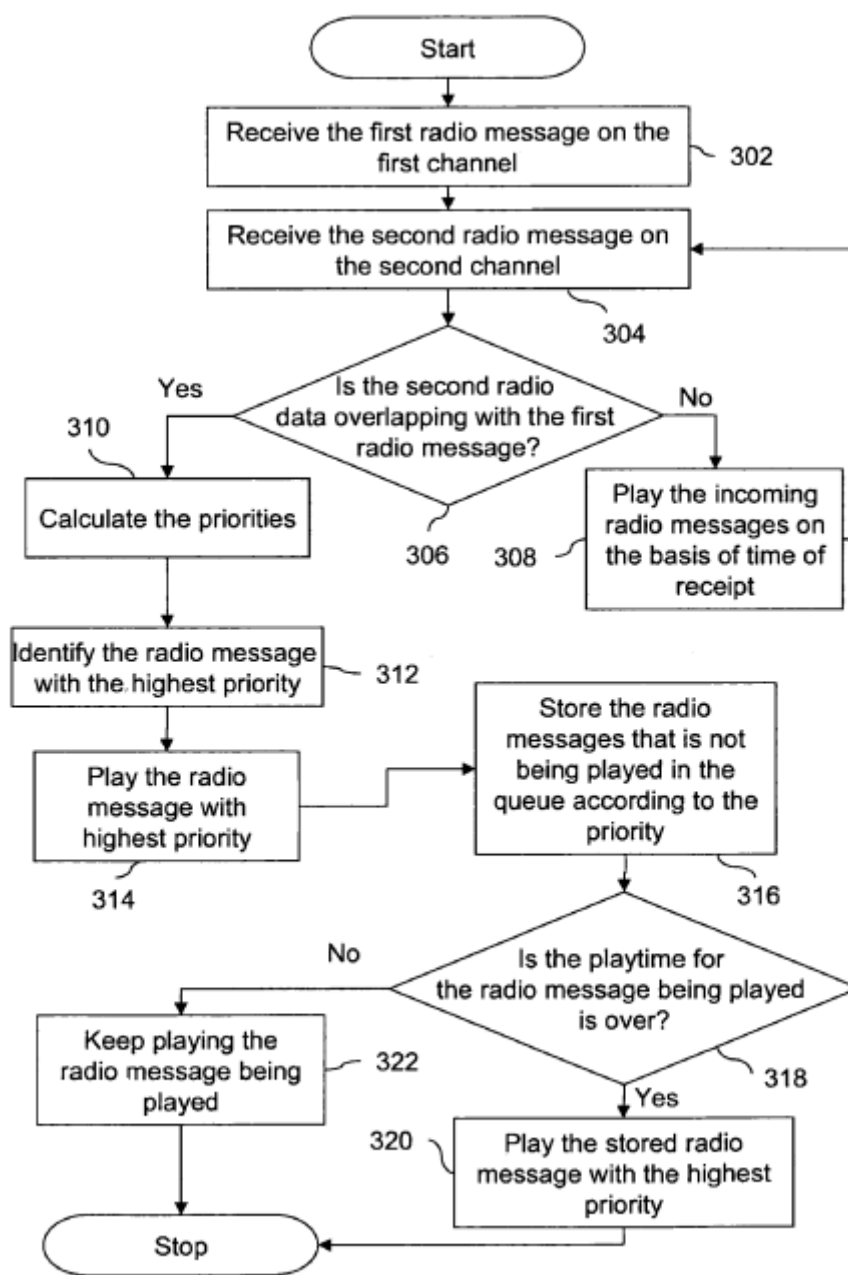


FIG. 3

Id., Fig. 3.

As noted in the '802 Patent, emergency communication systems support a plurality of communication channels, each channel being dedicated to a specific

entity, leading to problems arising when a user in an emergency communication system receives a number of messages on different channels at the same time. Ex. 1001, 1:23-25, 1:46-58, 1:64-2:9. “The receipt of multiple radio messages at one time creates confusion for an operator who needs to reply/act on each incoming radio message.” *Id.*, 1:25-27. The user needs to act on each incoming message, but cannot when overlapping messages interfere with one another, resulting in garbled or missed communications. *Id.*, 1:25-36, 6:53-56. Conventional techniques of managing overlapping messages often lead operators to hear multiple messages at once or to lose high-priority messages mistakenly. *Id.*, 1:29-41.

To solve these shortcomings, the invention claimed in the '802 Patent is directed to systems and methods that “provide for storing and replaying audio or other emergency radio communication information so that information that would be obscured or otherwise unheard can be made intelligible to a listener.” Ex. 1001, 1:46-49. The claimed methods recite: receiving messages on separate channels dedicated to different entities; determining priorities for each message based on pre-defined parameter(s); playing the message with the higher priority; and storing, and then playing, the stored messages in order of their priority. The '802 Patent has twenty-one claims, of which claims 1, 11, 13, 14, 17, 18, and 19 are the only independent claims.

The Petition challenges all twenty-one claims—the Challenged Claims—under three total grounds, Grounds 1-3, as detailed below:

Ground	Basis for Challenge
1	Claims 1-21 are obvious over Ohel
2	Claims 1-7 and 11-21 are obvious over Nigawara
3	Claims 3 and 8-10 are obvious over Nigawara in view of Doolin

B. Claim Construction

The Petition was filed after November 13, 2018, and, as such, the proper claim construction standard to be applied is articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (*en banc*), in accordance with its regulation, 37 C.F.R. § 42.100(b). *Apple Inc. v. Firstface Co.*, No. 2021-1001, 2021 WL 4156323, at *1, n.1 (Fed. Cir. Sept. 13, 2021).

Therefore, these claims should be “given their ordinary and customary meaning [and] that the ordinary and customary meaning of a claim term is the meaning that the term would have to a [POSITA] in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application.” *Phillips*, 415 F.3d at 1312–13. These arguments for claim terms apply for the purposes of this IPR only and without conceding alternative arguments in the counterpart litigations. *See NEC Display Solutions of America, Inc. v. Ultravision Tech.*, IPR2019-01123, Paper 7 at 12–14 (PTAB Dec. 2, 2019).

In the Parallel Proceeding, the parties agreed on certain constructions:

Term	Agreed Construction
Order of Steps (Claim 1)	The “receiving” and “determining” steps must occur before the “storing at least one message...” step, and the “storing at least one message...” step must occur before the “playing the stored message” step.

Ex. 2001, 12.

C. Level of Ordinary Skill in the Art

At this stage of the proceeding, Patent Owner does not dispute the proposal provided by Petitioner as to who would qualify as a POSITA: an individual “would have had at least a bachelor’s degree in computer science, electrical engineering, or a similar field, and would have had approximately two years industry experience in networking or communication systems.” Petition, 3.

III. THE PETITION FAILS TO ESTABLISH A REASONABLE LIKELIHOOD OF SUCCESS ON ANY CHALLENGED CLAIMS

A. Summary of the Alleged Prior Art

1. U.S. Patent Publication No. 2004/0117859 (“Ohel”)

U.S. Patent Publication No. 2004/0117859 (“Ohel”) has a title “Multiple Channel Data Recorder and Method for Recording Data on Multiple Channels.” Ex. 1004, Cover. Ohel was filed Dec. 16, 2002, published June 17, 2004, and was later

abandoned. *Id.* Ohel is directed to “a multiple channel data recorder and method for recording data on multiple channels.” *Id.*, [0002].

As Petitioner points out, Ohel’s disclosure is “designed to ‘prevent loss of communications during overtalk,’—i.e., the communication lost when a police officer’s transmission is interrupted and cut off by a police dispatcher’s transmission.” Petition, 7 (citing Ex. 1004 at [0002], [0005], [0009]). Specifically, as shown below, if a user begins to transmit a message (200, 400) but is already receiving another transmission (300) or is interrupted by a superior transmission (500), one transmission continues and the other transmission is recorded (700, 700a) and made available at another time (1000).

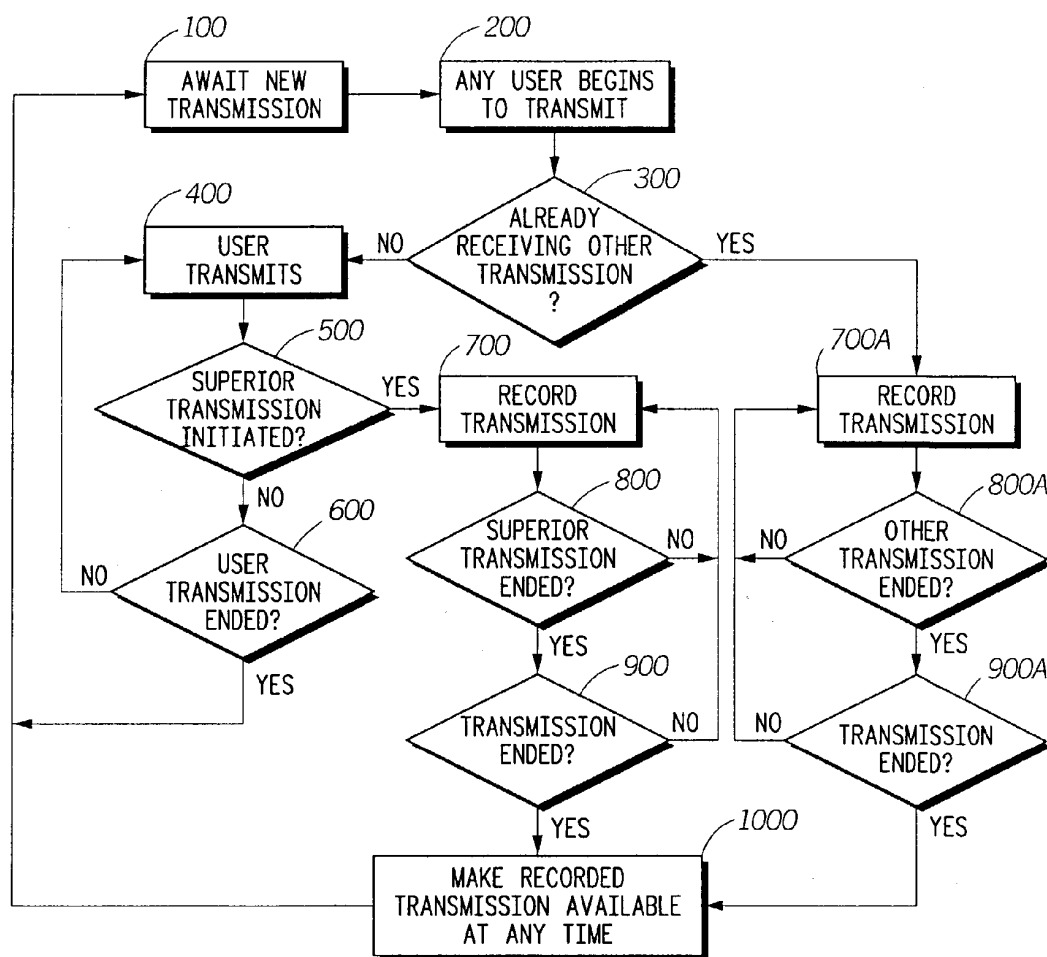


FIG. 1

Ex. 1004, Fig. 1.

2. U.S. Patent No. 4,914,705 (“Nigawara”)

U.S. Patent No. 4,914,705 (“Nigawara”) has a title “Voice Message Announcing Method and System for Plant.” Ex. 1007, Cover. Nigawara was filed September 3, 1987 and issued April 3, 1990. *Id.*

Nigawara is directed to systems and methods for announcing changes in the operating condition of a plant (e.g., a thermal power plant) by way of automatic voice messages. Ex. 1007, 1:40–48. Nigawara describes systems and methods sequentially announcing voice messages pertaining to different operating conditions to avoid the possibility of intermixing the messages with each other. *Id.*, 1:44–1:48. Essentially, a plurality of independent voice message announcing devices generate a plurality of voice messages, which are announced sequentially based on the priority of the voice messages. *Id.*, 1:50–1:55.

In an illustrative example, a plant operating condition identification unit (1) identifies that an announcement of an operating condition related voice message is required. *Id.*, 2:59–2:63; Fig. 1. A voice message signal generating unit (2) then generates the associated voice message signal. *Id.*, 2:66–3:6; Fig. 1. The voice message signal is sent to a message announcing order selection unit (3), where the voice message signals are stored in a voice message signal memory (10). *Id.*, 3:22–25, 3:68–4:2, Fig. 1. The voice message signals are then sent, along with plant operation mode information signals, to a message announcing order determination unit (11). *Id.*, 4:3–5, Fig. 2. The message announcing order determination unit (11) then determines the priority order of the messages. *Id.*, 4:13–15, Fig. 2. A voice message is then selected by a message signal selection unit (101) based on the order of priority determined by the message announcing order determination unit (11) and

sent to the message output unit (102), which announces the message through speakers (4). *Id.*, 4:16–21, Fig. 2. After a message has been announced, the message output unit (102) communicates with the message selection unit (101) to permit the transmission of the next message. *Id.*, 4:20–24, Fig. 2. In response to the permission received from the message output unit (102), the message signal selection unit (101) selects the next highest priority message and sends it to the message output unit (102) and the cycle between the message signal selection unit (101) and the message output unit (102) repeats until the messages are all announced. *Id.*, 4:25–30, Fig. 2. Nigawara further describes that, in instances in which an emergency voice message with a higher priority is received by the message output unit (102) while the message output unit (102) is outputting a message, the lower priority message may be interrupted and the emergency signal may be announced. *Id.*, 4:30–38, Fig. 2.

3. U.S. Patent Publication No. 2006/0176169 (“Doolin”)

U.S. Patent Publication No. 2006/0176169 (“Doolin”) has a title “System for Sensing Environmental Conditions.” Ex. 1008, Cover. Doolin was filed December 16, 2005, published August 10, 2006, and was later abandoned. *Id.*

Doolin is directed to a system and method for obtaining measurements of environmental conditions and locations of same, including a method for creating a network of dispersed sensors. Ex. 1008, [0006]. The sensors can be placed on people, vehicles, or other targets for tracking. *Id.*, [0007]. In an illustrative example, a

wireless sensor network (10) uses environmental sensor nodes (12) which selectively wirelessly communicate with a base station (14) running a sensor-network controller (16). Ex. 1008, [0015]-[0016], Fig. 1.

B. The Legal Framework for Assessing Unpatentability

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). The burden of persuasion in an IPR “never shifts to the patentee.” *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). Moreover, a petitioner should not “place the burden on [the Board] to sift through information presented by Petitioner[], determine where each element [of the challenged claims] is found in [the cited references], and identify any differences between the claimed subject matter and the teachings of [the cited references.]” *Google Inc. v. EveryMD.com LLC*, IPR2014-00347, Paper 9 at 25 (PTAB May 22, 2014).

A claim is unpatentable under § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*,

550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) when in evidence, objective indicia of non-obviousness (i.e., secondary considerations). *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). “To satisfy its burden of proving obviousness, a petitioner cannot employ mere conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

Finally, a petition seeking to establish obviousness based on more than one reference, as is the case here, “must articulate sufficient reasoning with rational underpinnings to combine the teachings.” *Wilson Elec., LLC. v. Cellphone-Mate, Inc.*, IPR2018-01778, Paper 10 at 15 (PTAB Apr. 23, 2019) (citing *KSR Int’l*, 550 U.S. at 418).

C. Ground 1: The Petition Does Not Establish That Claims 1-21 Are Obvious Over Ohel

The Petition fails to show that Ohel discloses all the elements of independent claims 1, 11, 13, 14, 17, 18, and 19. As such, the Petition fails to demonstrate that

the Challenged Claims are unpatentable based on obviousness and institution should be denied under 35 U.S.C. § 314(a).

- 1. Ohel fails to disclose a “first dedicated channel being dedicated to receiving messages from a first entity” and a “second dedicated channel being dedicated to receiving messages from a second entity” as recited in each independent claim**

Claim 1 of the '802 Patent requires:

receiving a first message on a first dedicated channel from amongst the plurality of channels at the communication system, the plurality of channels being dedicated to different entities, *the first dedicated channel being dedicated to receiving messages from a first entity*; receiving a second message on *a second dedicated channel being dedicated to receiving messages from a second entity* from amongst the plurality of channels at the communication system, the second message overlapping with the first message in time.

Ex. 1001, cl. 1 (emphasis added). Each of the remaining independent claims recites the limitations emphasized above.²

Ohel fails to disclose a plurality of channels dedicated to different entities. Petitioner acknowledges Ohel's shortcoming in its petition and attempts to cover the

² Independent claims 13, 14, 17, 18, and 19 recite language nearly identical to that in claim 1; claims 13, 14, 17, and 19 omit the word “being” and claim 18 omits the words “being dedicated.”

missing claim limitations by: (i) making unsupported conclusory statements that also violate the plain and ordinary meaning of the claim terms; and (ii) arguing the '802 Patent itself is the prior art reference that cures Ohel's admitted deficiencies as a prior art reference. *See* Petition, 16–52. Both arguments fail. Accordingly, Petitioner has failed to demonstrate the Challenged Claims are unpatentable and, therefore, institution should be denied under 35 U.S.C. § 314(a).

Each of the claims in the '802 Patent requires both a “first dedicated channel being dedicated to receiving messages from a first entity” and a “second dedicated channel being dedicated to receiving messages from a second entity.” Petitioner argues “[a] POSITA would have understood that Ohel's ‘dispatch channel’ is a channel dedicated to communications with a dispatcher. Ex[1002], ¶127.” Petition, 18. Following this citation to the Williams Declaration shows that Petitioner's support for its position is nothing more than a conclusory statement made without citation to any prior art reference. “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at 418 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cleaned up)). This bare conclusory statement, without citation to a prior art reference or any other meaningful rational underpinning, fails to present a legally

sufficient argument that the '802 Patent is obvious in light of Ohel. Accordingly, for at least this reason, Ground 1 fails.

Further, Petitioner's argument that Ohel teaches a first dedicated channel being dedicated to receiving messages from a first entity and a second dedicated channel being dedicated to receiving messages from a second entity is wrong. Petitioner starts its argument by stating, "[a] POSITA would have understood that Ohel's 'dispatch channel' is a channel dedicated to communications with a dispatcher." Petition, 18. This statement is irrelevant because a dispatcher is not an entity as claimed in the '802 Patent. Petitioner notes that "[t]he '802 Patent provides examples of 'entities' that include 'group/locality/unit' such as the fire department." Petition, 18, n.5. This is correct—the claimed entities are groups, localities, and units. Ex. 1001, 1:15–18.

In further support of Applicant's plain and ordinary usage of the term "entity," Merriam-Webster defines *entity* as "an organization (as a business or governmental unit) that has an identity separate from those of its members." Ex. 2002. Both the '802 Patent and the dictionary definition of entity agree, an entity is an organizational unit with an identity that is distinct from any individual user. Therefore, a dispatcher is not an entity and a channel dedicated to receiving communications from a dispatcher is not the same as a channel dedicated to receiving communications from an entity. This is in contrast to the claimed invention

in the '802 Patent in which each of the channels supports communications from a plurality of members of the entity, whether that be the members of a group, a locality, or a unit.

This failure as a prior art reference is further highlighted in the continuation of Petitioner's argument. Petitioner contends that Ohel teaches a plurality of channels dedicated to different entities by referencing an example in Ohel in which a first simplex unit is set to a dispatch unit and a second simplex unit is set to the channel of another specific user. Petition, 18. Neither a dispatcher, nor another specific user, is an entity as claimed in the '802 Patent. Even in Petitioner's best example, Ohel fails to teach a single channel dedicated to receiving messages from an entity, let alone two channels dedicated to receiving messages from two respective entities.

Further recognizing the weakness of its position, Petitioner continues its argument by contending that, to the extent the Patent Owner argues Ohel's channels are not dedicated to different entities, the '802 Patent itself provides the missing support. Petition, 18. Petitioner essentially admits Ohel's failure to teach two channels dedicated to receiving messages from two respective entities and then fails to provide a single prior art reference to cure Ohel's failure. The fact that Petitioner could not locate any prior art reference to support its obviousness argument perfectly demonstrates its failure.

Accordingly, Ground 1 fails and the Board should deny institution.

D. Ground 2: The Petition Does Not Establish That Claims 1-7 and 11-21 Are Obvious Over Nigawara

Ground 2 alleges that claims 1-7, and 11-21 are obvious over Nigawara.

However, Ground 2 fails for the following reasons.

1. Nigawara Does Not Disclose Storing of Prioritized Messages Based on Prior Determination of Priority

Claim 1 of the '802 Patent requires:

determining which message out of the first message and the second message should be stored and subsequently played based on the second message overlapping with the first message in time and one or more priorities assigned to the first and the second message; ... storing at least one message having a lower priority between the first and the second message based on the determination.

Ex. 1001, cl. 1. Claims 2-7 depend from claim 1.

Nigawara fails to disclose the storing of prioritized messages based on a previous determination of priority. Instead, Nigawara stores all messages regardless of priority, and does not store messages based on any determination of priority as claimed. The Petition plainly admits as much, glossing over Nigawara's deficiency regarding disclosure of the order of claim limitations 1[d] and 1[f]. Petition, 63–67, 69–70. Accordingly, Petitioner has failed to demonstrate claims 1-7 are unpatentable and institution should be denied under 35 U.S.C. § 314(a).

Claim 1 and dependent claims 2-7 require storing at least one message having a lower priority between the first and the second message, where the determination is based on one or more priorities assigned to the first and second message. Claim 1 requires that the **determining** of message priority (limitation 1[d]) occurs before the storing of a message **based on the determination** (limitation 1[f]). However, the Petition ignores the plain and ordinary meaning of claim 1 and argues, in conclusory fashion, that a POSITA would read Nigawara as disclosing these limitations without acknowledging that Nigawara fails to teach storing messages based on the priority determination. *See* Petition, 64–65.

In addition, Petitioner’s expert explicitly acknowledges that Nigawara stores messages before determining priority. “As shown in Figure 2 below, when Nigawara’s system encounters plural demands for voice message announcement, “[v]oice message output signals 6 from...the individual plants are stored in a voice message signal memory 10” and sent to the “message announcing order determination unit 11,” which determines the priorities of each message. Ex[1007], 3:68-4:5.” Ex. 1002, ¶251.

Petitioner clearly admits the announcing order determination in Nigawara occurs after the voice message output signals are stored and provides no other prior art reference or support for its argument. This threadbare assertion is legally insufficient to support institution. *See KSR*, 550 U.S. at 418. For at least this reason,

Ground 2 fails to provide an acceptable argument that claims 1-7 of the '802 Patent would be obvious in light of Nigawara.

2. The Petition Incorporates Deficient Claim 1 Arguments for Claims 11, 14, and 17-19

Independent claims 11, 14, and 17-19 of the '802 Patent describe similar limitations to those disclosed in claim 1:

- Claim 11[f] – storing the message having lower priority in a queue on the basis of the determination and the prioritization.
- Claim 14[e] – a determiner configured to determine which messages out of the received messages should be stored and subsequently played based on the second message overlapping with the first message in time and one or more priorities assigned to the first and the second message.
- Claim 14[g] – storage medium configured to store the messages in a queue based upon the associated priority and the determination.
- Claim 17[f] – a determiner configured to determine which messages out of the received messages should be stored and subsequently played based on the second message overlapping with the first message in time and one or more priorities assigned to the first and the second message.
- Claim 18[e] – one or more instructions for determining which messages out of the received messages should be stored and subsequently played

based on messages overlapping in time and one or more priorities assigned to the first and the second message.

- Claim 19[c] – one or more instructions for determining which messages out of the received messages should be stored and subsequently played based on message overlapping in time and one or more priorities assigned to the first and the second message.

For each of these claims, the Petition incorporates its arguments for claim 1. *See* Petition at 81, 84, 85, 88, 90. However, the Petition cannot cure the deficiencies of its arguments for claim 1, *see supra*, discussing claim limitations 1[d] and 1[f], as each of claims 11, 14, and 17-19 also requires determining of priority prior to storage. Thus, the Petition fails to show why claims 11, 14, and 17-19 would have been obvious over Nigawara, and Ground 2 fails for this additional reason.

Therefore, Ground 2 fails and the Board should deny institution.

E. Ground 3: The Petition Does Not Establish That Claims 3 and 8-10 Are Obvious Over Nigawara In View Of Doolin

Ground 3 alleges that claims 3 and 8-10 are obvious over Nigawara in view of Doolin. However, Ground 3 fails because Doolin cannot cure the deficiency of Nigawara with regard to claim 1, from which claims 3 and 8-10 depend.

Claim 3 discloses:

3. The method of claim 1, wherein the predefined parameter comprises a bandwidth requirement of the received messages.

Ex. 1001, cl. 3. Claims 8-10 disclose:

8. The method of claim 1, wherein a message includes voice over internet protocol communications.
9. The method of claim 1, wherein a message includes mobile phone communications.
10. The method of claim 1, wherein a message includes radio communications.

Id., cl. 8-10.

As discussed above, claim 1 requires storing at least one message having a lower priority between the first and the second message, where the determination is based on one or more priorities assigned to the first and second message. Petitioner makes no argument, because it cannot, that Doolin discloses or renders obvious this limitation. This claim limitation is also present in dependent claims 3 and 8-10. Thus, Ground 3 fails to provide an acceptable argument that claims 3 and 8-10 would be obvious over Nigarawa in view of Doolin, for the same reasons as discussed above with regard to Ground 2.

Therefore, Ground 3 fails and the Board should deny institution.

IV. THE BOARD SHOULD DENY INSTITUTION UNDER 35 U.S.C. § 314

Under the *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* (June 21, 2022) (“Interim Procedure”, Ex. 1023), *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar.

20, 2020) provides the basis for a discretionary denial in this case. This Petition does not “present[] compelling evidence of unpatentability” with the Petition failing to provide a “compelling, meritorious challenge[]” that is “unrebutted [at] trial.” Ex. 1023, 2, 4. A discussion of each factor is outlined below.

A. Factor 1: Potential Stay

Petitioner has not motioned for any stay in the Parallel Proceeding, nor has the judge issued a stay. While the Board should “not attempt to predict how the district court in the related district court litigation will proceed,” this does not preclude the Board from denying institution. *Sand Revolution II, LLC v. Continental Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24 at 7 (PTAB Jun. 16, 2020). Petitioner cites *Sand Revolution* as a rationale for the Board to grant institution under Factor 1. Petition, 100. However, this citation is not a precedential decision and should not be held out as binding on the Board. Additionally, in *Sand Revolution*, the issue of the concurrent stay was not the only factor used in the analysis in the Board reaching their decision to grant institution. The other factors weighed heavily in favor of granting institution. *See Sand Revolution*, Paper 24 at 9–12. As such, considering the availability for Petitioner to file for a stay in light of the upcoming claim construction hearing in March (originally set for December 1, 2023), and deciding not to pursue the stay, this factor weighs in favor of denying institution.

B. Factor 2: Trial Date

The trial in the Parallel Proceeding will commence no later than September 2024, *see* Ex. 1028, 1, which is at most five months before the due date of a Final Written Decision of this Petition. Petitioner waited seven months after receiving the initial infringement contentions to file their Petition. Patent Owner has amended infringement contentions with leave of the Court pursuant to facts learned through discovery exchanges, depositions, and other publicly available material and will submit final contentions in line with the District Court's schedule. The Board's final written decision, if instituted, likely will be due on or around February 2025, which is after the close of fact and expert discovery (closing May 1, 2024 and June 10, 2024, respectively) and after to the deadline for dispositive motions (June 17, 2024). *See BOE Tech. Grp. Co., Ltd., Beijing BOE Display Tech. Co., and Motorola (Wuhan) Mobility Tech. Comm. Co., Ltd., v. Element Capital Commercial Co. PTE. Ltd.*, IPR2023-00808, Paper 9 at 21–22, 34 (PTAB Nov. 15, 2023) (denying institution since the trial date was set to occur 6 months prior to the deadline for a FWD). Petitioner offers nothing in the form of evidence to show any trial date later than the agreed upon September 23, 2024 date. *See BOE*, Paper 9 at 21. The median time to trial for the Eastern District of Texas, Marshall Division for the past five years is nineteen months. Ex. 2003. Even if the Board ignores the agreed upon trial

date of September 23, 2024, the trial date would still occur on or around September 2024 which is before the statutory deadline for the FWD.

Since a stipulated trial date, as agreed by both parties in the district court case, will commence before the deadline to the FWD, then factor two weighs against institution. *See* Ex. 1023, 8–9 (analyzing the proximity of the trial date is not the sole factor, but if other factors weigh in favor of denial then the proximity to trial should be taken into consideration).

C. Factor 3: Investment in the Parallel Proceeding

The parties have invested a considerable amount of time and effort in the Parallel Proceeding. The suit was filed over a year ago in the Eastern District of Texas, Marshall Division on September 30, 2022. *STA Group LLC v. Motorola Solutions, Inc.*, No. 2-22-cv-00381-JRG-RSP (E.D. Tex. Sep. 30, 2022). The defendant moved for partial dismissal of the complaint by alleging that the '802 Patent claims ineligible subject matter and that the complaint fails to plausibly allege infringement. The court denied the motion to dismiss on August 11, 2023 by Judge Gilstrap, with Magistrate Judge Payne recommending denial on July 7, 2023. Further, fact discovery is well underway. While Petitioner alleges that the Petition was filed with diligence, this Petition was filed approximately six weeks before the statutory bar would have prevented filing of the Petition and seven months after service of preliminary infringement contentions. Petition, 101. To that end, both

parties have already expended extensive time and resources in fact discovery preparing for the District Court proceeding. The Claim Construction hearing in the District Court case is set for March 15, 2024. Ex. 1028, 3. Both Petitioner and Patent Owner have submitted extensive briefing related to Claim Construction.

Based on this record, the case is beyond its infancy, and the parties are considerably invested in the district court proceedings as depositions are already underway. Accordingly, this factor weighs against institution.

D. Factor 4: Issue Overlap

Petitioner has neither stipulated to, nor suggested it would stipulate to, any agreement related to issues raised in the Petition not being raised in the Parallel Proceeding. In the Interim Guidance, the director stated that “the PTAB will not discretionarily deny institution in view of parallel district court litigation where a petitioner presents a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have reasonably been raised before the PTAB.” Ex. 1023, 3 (citing *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A)). Absent a stipulation, this factor weighs against institution or is at least neutral.

E. Factor 5: Party Overlap

Petitioner and Patent Owner are both parties in the Parallel Proceeding. This factor weighs against institution. *See Fintiv*, Paper 11 at 13–14.

F. Factor 6: Other Circumstances Favoring Institution

When the sum of *Fintiv* factors 1-5 favor denying institution, which they do here, the PTAB considers whether the Petitioner presents a challenge with compelling merits. *Samsung Elecs. Co., Ltd. v. Cal. Inst. Of Tech.*, IPR2023-00130, Paper 10 at 15 (PTAB May 4, 2023) (citing Ex. 1023, 4–5). That analysis is provided in Section III above and clearly demonstrates that the Petition fails to satisfy the heightened standard that “it is highly likely that the petitioner would prevail with respect to at least one challenged claim.” *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064, Paper 102 at 49 (PTAB Oct. 4, 2022) (precedential) (quoting Ex. 1023, 4); *see also Samsung Elecs.*, Paper 10 at 21 (“The ‘compelling merits’ standard is a standard higher than that required for institution.”) (citing *CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 at 3 (PTAB Feb. 27, 2023)). Accordingly, this factor also weighs against institution.

In view thereof, *Fintiv* Factors 1 (the lack of a stay entered in the district court litigation), 2 (proximity of the court’s trial date to the Board’s projected statutory deadline), 3 (investment in the parallel proceeding by the court and parties), 4 (overlap of issues in Petition vs. parallel proceeding and a lack of a stipulation), 5 (party overlap), and 6 (lack of merits in the petition) weigh in favor of denying institution.

V. CONCLUSION

Petitioner has failed to demonstrate that there is a reasonable likelihood that it would prevail with respect to at least one of the Challenged Claims in the Petition, and institution should be denied.

Dated: December 20, 2023

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Certification of Word Count Under 37 C.F.R. §42.24(d)

The undersigned hereby certifies that the foregoing contains 5,342 words according to the word count of the word-processing software used to prepare the foregoing.

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CERTIFICATE OF SERVICE

I hereby certify that on December 20, 2023, a true and correct copy of the foregoing was caused to be served electronically on the following counsel of record for Petitioner at the following email addresses:

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