

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA SOLUTIONS, INC.,

Petitioner,

v.

STA GROUP LLC,

Patent Owner.

IPR2023-01292

U.S. Patent No. 7,324,802 B2

**PETITIONER'S UPDATED MANDATORY NOTICES
UNDER 37 C.F.R. § 42.8(a)(3)**

Submitted Electronically

PETITIONER’S EXHIBIT LIST

Ex[No.]	Description of Documents
1001	U.S. Patent No. 7,324,802 (“’802 Patent”)
1002	Declaration of David H. Williams dated Aug. 21, 2023
1003	File History of the ’802 Patent
1004	U.S. Patent Publication No. 2004/0117859 A1 to Hagai Ohel, entitled “Multiple Channel Data Recorder and Method for Recording Data on Multiple Channels” (filed Dec. 16, 2002, and published June 17, 2004) (“Ohel”)
1005	Federal Communications Commission, Report and Order and Further Notice of Proposed Rule Making, FCC 94-288 (December 9, 1994) (“FCC”)
1006	U.S. Patent Publication No. 2003/0228863 A1 to Raymond Vander Veen et al., entitled “Voicemail User Interface Methods and Apparatus for Reliable Mobile Communication Devices” (filed June 6, 2003, and issued Dec. 11, 2003) (“Vander Veen”)
1007	U.S. Patent No. 4,914,705 to Seiitsu Nigawara, entitled “Voice Message Announcing Method and System for Plant” (filed Sep. 3, 1987, and issued Apr. 3, 1990) (“Nigawara”)
1008	U.S. Patent Publication No. 2006/0176169 A1 to David M. Doolin, et al., entitled “System for Sensing Environmental Conditions” (filed Dec. 16, 2005, with priority to a provisional application filed Dec. 17, 2004, and published Aug. 10, 2006) (“Doolin”)
1009	U.S. Provisional Patent Appl. No. 60/637,279 to Doolin et al. (“Doolin Provisional”)
1010	File History of U.S. Patent Application Publication No. 2006/0176169 A1 to Doolin et al.
1011	Letter from James Shimota, Partner, K&L Gates to Natalie Gonzales, Partner, Baker Botts L.L.P., RE: Plaintiff’s Infringement Contentions (Mar. 30, 2023)

Ex[No.]	Description of Documents
1012	U.S. Patent Publication No. 2005/0215229 A1 to Steven D. Cheng, entitled “Call Processing System” (filed Mar. 26, 2004, and published Sep. 29, 2005) (“ Cheng ”)
1013	New York Radio Frequencies (June 6, 2002), (https://web.archive.org/web/20020606155134/https://thushara.com/new-york-radio-frequencies.htm)
1014	U.S. Patent Publication No. 2003/0063714 A1 to Peggy M. Stumer et al., entitled “Internet Protocol (IP) Emergency Connections (ITEC) Telephony” (filed Sep. 26, 2001, and published Apr. 3, 2003) (“ Stumer ”)
1015	Ericsson, <i>Maintenance Manual, EDACS ® C3 Maestro™ Console System with Enhanced Audio Enclosure</i> (March 1995) (“ C3 Manual ”)
1016	U.S. Patent No. 3,133,995 to Alfred Zarouni, entitled “Call Awaiting Signal Telephone Circuits” (filed Sep. 18, 1961, and issued May 19, 1964) (“ Zarouni ”)
1017	U.S. Patent No. 5,134,652 to Allan G. Brown et al., entitled “Communication Console Station with Priority Queuing” (filed Aug. 23, 1991, and issued Jul. 28, 1992) (“ Brown ”)
1018	Motorola Inc., <i>CENTRACOM Gold Series Classic CRT User’s Guide</i> (1998) (“ CENTRACOM ”)
1019	U.S. Patent No. 4,959,648 to Robert L. Breeden, et al., entitled “Dual Dynamic Priority Control in a Selective Call System” (filed Feb. 10, 1989, and issued Sep. 25, 1990) (“ Breeden ”)
1020	U.S. Patent Publication No. 2002/0080928 A1 to Cary Lee Bates et al., entitled “Telephone Message System with Flexible Presentation Capability” (filed Dec. 22, 2000, and published Jun. 27, 2002) (“ Bates ”)
1021	U.S. Patent No. 2,800,530 to Harry R. Van Deventer et al., entitled “Telephone Answering and Recording Devices” (filed Dec. 17, 1949, and issued July 23, 1957) (“ Van Deventer ”)

Ex[No.]	Description of Documents
1022	Plaintiff's First Amended Disclosure of Asserted Claims and Infringement Contentions and Document Production Accompanying Disclosure Pursuant to P.R. 3-1 & 3-2, No. 2:22-CV-0381-JRG-RSP (E.D. Tex. June 15, 2023).
1023	Katherine K. Vidal, <i>Memorandum: Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation</i> (June 21, 2022)
1024	Docket Control Order, <i>STA Group LLC v. Motorola Solutions, Inc.</i> , No. 2:22-CV-0381-JRG-RSP, Dkt. 35 (E.D. Tex. Feb. 3, 2023)
1025	Telex Communications, Inc. and Vega Signaling Products, Price List (effective Apr. 1, 2003), (https://web.archive.org/web/20030401105942/http://vega-signaling.com/) (" C-Soft Price List ")
1026	<i>Motorola Annual Report 1975</i> (1975) (" 1975 Report ")
1027	Parties' Local P.R. 4-2 Disclosure of Preliminary Proposed Constructions of Claim Terms and Preliminary Identification of Extrinsic Evidence
1028	Amended Docket Control Order, <i>STA Group LLC v. Motorola Solutions, Inc.</i> , No. 2:22-CV-0381-JRG-RSP, Dkt. 196 (E.D. Tex. Dec. 1, 2023)
1029	Email to Counsel for Patent Owner re: Petitioner's <i>Sotera</i> -Stipulation (December 27, 2023)

I. MANDATORY NOTICES UNDER 37 C.F.R. § 42.8(a)(3)

Pursuant to 37 C.F.R. § 42.8(a)(3), Petitioner provides the following updates to its mandatory notices.

A. Real Party-in-Interest under 37 C.F.R. § 42.8(b)(1) - Unchanged

The real party-in-interest is Motorola Solutions, Inc. No other parties exercised or could have exercised control over this Petition; no other parties funded or directed this Petition.

B. Related Matters under 37 C.F.R. § 42.8(b)(2) - Updated

The '802 Patent is involved in *STA Grp. LLC v. Motorola Solutions, Inc.*, Case No. 2:22-cv-00381 (E.D. Tex. filed Sept. 30, 2022) (“EDTX Litigation”). Petitioner moved to dismiss the complaint on December 12, 2022. That motion was denied in a report and recommendation by the Magistrate Judge on July 7, 2023, and the Court adopted the report and recommendation and denied Motorola Solutions, Inc.’s motion on August 11, 2023.

On December 1, 2023, the Court in the EDTX Litigation entered an Amended Docket Control Order (EX1028) that moved back the trial date and other case deadlines. Jury selection is now set for September 23, 2024 (almost four months later than the original June 3, 2024 date in place at the time the Petition was filed). EX1028, 1. A claim construction hearing is set for March 15, 2024. *Id.* at 3. Fact discovery now closes on May 1, 2024 and the deadline to complete expert discovery is June 10, 2024. *Id.*

On December 27, 2023, Petitioner stipulated as follows: “Motorola Solutions, Inc. stipulates that, if the Patent Trial and Appeal Board institutes an IPR proceeding for U.S. Patent No. 7,324,802 on the grounds presented in the petition in IPR2023-01292, Motorola Solutions, Inc. will not pursue an invalidity defense in the district court action (*STA Group LLC v. Motorola Solutions, Inc.*, Case No. 2:22-cv-00381 (E.D. Tex.)) that the patent claims subject to the instituted IPR are invalid based on grounds that were raised or reasonably could have been raised in the IPR.” See EX1029.

The ’802 Patent was also asserted against Petitioner in an identical Complaint in *STA Group LLC v. Motorola Solutions, Inc.*, Case No. 4-22-cv-00840 (E.D. Tex. filed Sept. 30, 2022), which was filed in error on September 30, 2022 and administratively closed October 6, 2022 without any proceedings.

C. Lead and Back-Up Counsel under 37 C.F.R. § 42.8(b)(3) - Unchanged

Petitioner provides the following designation of counsel:

LEAD COUNSEL	BACK-UP COUNSEL
Eliot D. Williams (Reg. No. 50,822) BAKER BOTTS L.L.P. 700 K Street, N.W Washington, D.C. 20001-5692 Tel: 202-639-1334 eliot.williams@bakerbotts.com	Katharine Burke (<i>pro hac vice</i> application forthcoming) BAKER BOTTS L.L.P. 700 K Street, N.W Washington, D.C. 20001-5692 Tel: 202-639-7720 katharine.burke@bakerbotts.com Michael Knierim (Reg. No. 78,268)

	BAKER BOTTS L.L.P. 30 Rockefeller Plaza New York, NY 10112 Phone: (212) 408-2584 Fax: (212) 259-2584 michael.knierim@bakerbotts.com Clarke W. Stavinoha (Reg. No. 71,152) BAKER BOTTS L.L.P. 2001 Ross Avenue, Suite 900 Dallas, TX 75201-2980 Tel: 214-953-6484 clarke.stavinoha@bakerbotts.com Matthew Thompson (Reg. No. 80,905) BAKER BOTTS L.L.P. 30 Rockefeller Plaza New York, NY 10112 Phone: (212) 408-2580 matthew.thompson@bakerbotts.com
--	---

D. Service Information under 37 C.F.R. § 42.8(b)(4) - Unchanged

Please address all correspondence to lead and back-up counsel. Petitioner consents to service at lead counsel's address provided above. Petitioner consents to electronic service, provided it is made to all of the following e-mail address:

- dlbbstamsiiprs@BakerBotts.com.

Respectfully Submitted,

December 28, 2023

/Eliot D. Williams/
Eliot D. Williams (Reg. No. 50,822)
BAKER BOTTS L.L.P.
700 K Street, N.W
Washington, D.C. 20001-5692
Tel: 202-639-1334

eliot.williams@bakerbotts.com

*Lead Counsel for Petitioner, Motorola
Solutions, Inc.*

CERTIFICATE OF SERVICE

The undersigned certifies that on December 28, 2023, a true and correct copy of the foregoing **PETITIONER'S UPDATED MANDATORY NOTICES UNDER 37 C.F.R. § 42.8(a)(3)** and Exhibit 1029 were served on the following counsel of record for Patent Owner at the email addresses listed below.

Jason A. Engel
Jason.Engel.PTAB@klgates.com

Katherine L. Allor
Katy.Allor@klgates.com

Nolan R. Hubbard
Nolan.Hubbard@klgates.com

Samuel P. Richey
Samuel.Richey@klgates.com

Date: December 28, 2023

/Eliot D. Williams/
Eliot D. Williams (Reg. No. 50,822)
BAKER BOTTS L.L.P.
700 K Street, N.W
Washington, D.C. 20001-5692
Tel: 202-639-1334
eliot.williams@bakerbotts.com

*Lead Counsel for Petitioner, Motorola
Solutions, Inc.*