

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 AUTHORIZED REPLY TO PATENT OWNER'S
PRELIMINARY RESPONSE**

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PETITIONER’S EXHIBIT LIST

EXHIBIT¹	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 ”)

¹ Citations to issued patents (Exhibits 1001, 1007, 1016, 1017, 1019, and 1021) are made by column and line number. Citations to patent application publications (Exhibits 1004, 1006, 1008, 1009, 1012, 1014, and 1020) and Exhibits 1002, and 1005 are made by paragraph number. Citations to Exhibit 1006, 1015, 1018, and 1023-1026 are to the original page numbering in the exhibit. Citations to Exhibits 1003, 1005, 1010-1011, 1013, and 1022 are to the page number added by the exhibit label.

EXHIBIT¹	Description of Documents
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)
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”)

EXHIBIT¹	Description of Documents
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 ”)
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/200304011105942/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)

EXHIBIT ¹	Description of Documents
1029	Email from Katharine.Burke@BakerBotts.com (Dec. 27, 2023)

I. THE BOARD SHOULD NOT EXERCISE ITS DISCRETION TO DENY INSTITUTION UNDER 35 U.S.C. § 314(a) AND *FINTIV*

Petitioner has provided a *Sotera* stipulation in this proceeding. EX1029. The Director's June 21, 2022 memorandum indicates that "the PTAB will not discretionarily deny institution" when such a stipulation is made. EX1023, 3.

II. THE BOARD SHOULD REJECT PO'S IMPLIED CONSTRUCTION OF "*ENTITY*" THAT EXCLUDES A DISPATCHER

Each independent claim recites 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*" (emphasis added). Patent Owner's ("PO") sole basis for distinguishing Ohel from this claim is based on PO's interpretation of "*entity*" to exclude an entity that is a dispatcher. But that implied construction contradicts the '802 patent's specification as well as the leading definition in the dictionary cited by PO itself.²

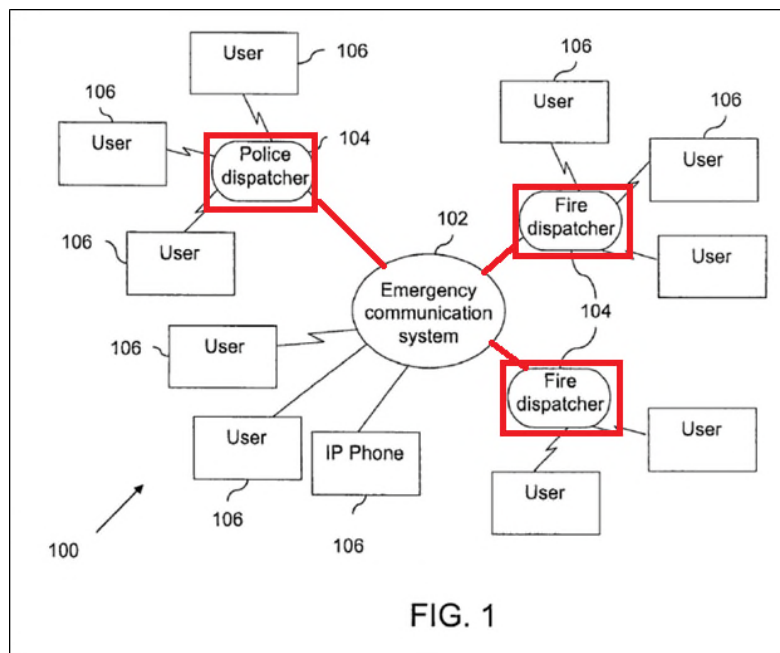
In particular, PO alleges that "a dispatcher is not an entity as claimed in the '802 Patent." Paper 8 ("POPR"), p.15. The portion of the specification cited by PO does not support this narrow construction. *Id.* (citing EX1001, 1:15-18 ("Each emergency communication system supports a plurality of communication channels, wherein each channel may be dedicated to a group/locality/unit.")). Importantly, PO ignores equally relevant portions of the specification that describe a dispatcher using

² PO does not dispute that Ground 2 still satisfies PO's narrower construction.

similar language as the specification portions relied upon by PO, and which confirm that dispatchers are intended to be within the claimed scope:

In accordance with an embodiment of the invention, an emergency communication system 102 is connected to **dispatchers 104 belonging to the emergency teams**. Emergency communication system 102 includes a communication sub-system for sending and receiving messages. **Dispatchers 104 are the operators who handle the communication for the emergency teams** and respond to emergency messages received from a plurality of users 106. Emergency communication system 102 receives messages on a plurality of communication **channels**.

EX1001, 3:59-62 (emphasis added); *see also* Fig. 1 (annotated below, identifying “Police dispatcher” and “Fire dispatcher[s]” communicating with emergency communication system 102 via dedicated channels):



Thus, the '802 Patent confirms that the term “*entity*” encompasses a dispatcher.

PO’s interpretation is also contradicted by PO’s own extrinsic evidence. PO cites to the third definition of “*entity*” listed in Merriam-Webster which defines entity as “an organization (as a business or governmental unit) that has an identity separate from those of its members.” EX2002. Notably, however, PO ignores multiple more relevant definitions in its own exhibit, including the first and second definitions that more broadly include “independent, separate, or self-contained existence” regardless of the entity’s relationship to an organization. *Id.* Nothing in this definition would exclude a dispatcher.

For these reasons, the Board should reject PO’s attempt to distinguish Ohel based on an implied unduly narrow construction of “*entity*” that excludes a dispatcher—an express embodiment of the patent. EX2002; EX1001, 3:59-60.

III. GROUND 2 DISCLOSES “STORING...” EVEN UNDER PO’S IMPLIED CONSTRUCTION

PO argues that Ground 2 does not disclose “storing of prioritized messages based on a previous determination of priority.” POPR, p.17. PO’s argument is premised on an implied construction of the “storing ...” limitation (element 1[f]) that excludes “stor[ing] all messages regardless of priority.” POPR, p.17.

But PO’s argument does not distinguish Nigawara.³ As explained in the

³ PO’s implied constructions described herein were not foreseen as PO has not

Petition, Nigawara discloses that, when multiple messages overlap, priorities are determined for each message and played in priority order. EX1007, 3:68-4:5, 7:23-28; Pet., 64-65, 69-70. Because messages are played in priority order, when higher priority messages are being played, lower priority messages are “stored in a voice message signal memory 10” before being played. EX1007, 4:2. Thus, Nigawara “solve[s] the problem of intermixture of announced messages,” just like the ’802 patent. EX1007, 7:25-28; Pet., 69-71. Every time a lower priority message is in storage at the time a higher priority message is playing, as Nigawara describes, the claim is practiced—even if the higher priority message was first stored. *See Hewlett-Packard Co. v. Mustek Sys., Inc.*, 340 F.3d 1314, 1326 (Fed. Cir. 2003) (prior art “that sometimes, but not always, embodies a claimed method nonetheless teaches that aspect of the invention”).

In this regard, Nigawara operates just like the patent’s preferred embodiment.

proposed or implied such constructions in district court. *E.g.*, Joint Claim Construction Chart, Exhibit B, *STA Group LLC v. Motorola Solutions, Inc.*, No. 2:22-CV-0381-JRG-RSP, Dkt. 187-2 (E.D. Tex. Nov. 27, 2023); Complaint, Exhibit E, *STA Group LLC v. Motorola Solutions, Inc.*, No. 2:22-CV-0381-JRG-RSP, Dkt. 1-6 (E.D. Tex. Sept. 30, 2022) (infringement chart without reference to new interpretations).

In particular, the specification explains overlapping messages can **both** be stored so long as the lower priority message is stored when the higher priority overlapping message is first played. EX1001, FIG.4. The patent identifies a scenario when overlapping messages D and E are received while message C is being played. Both messages are “stored in the queue, based on the priority” until message C has finished playing. *Id.*, 5:44-47. Then, “[a]s soon as radio message C is completed, stored radio message E is played, since it is highest in priority among the stored radio messages.” *Id.*, 5:50-52; *see also id.*, Fig. 4. Thus, both of the received overlapping messages (D and E) are stored before being played in priority order, which contradicts Patent Owner’s new interpretation of the claim and is substantially identical to how Nigawara operates.

Thus, Nigawara does not merely “store[] all messages regardless of priority,” POPR, p.17; it in fact practices the preferred embodiment, and Ground 2 invalidates the claims.

IV. CONCLUSION

Petitioner respectfully requests institution of inter partes review.

Respectfully Submitted,

January 18, 2024

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CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. §42.6(e), the undersigned certifies that on January 18, 2024, a complete and entire copy of the **PETITIONER'S AUTHORIZED REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE** was served on Patent Owner via email at the following correspondence addresses:

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