

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA SOLUTIONS, INC.,

Petitioner,

v.

STA GROUP LLC,

Patent Owner.

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

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

Submitted Electronically

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PETITIONER’S EXHIBIT LIST

EXHIBIT	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)
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”)

EXHIBIT	Description of Documents
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 ”)
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).

EXHIBIT	Description of Documents
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 from Katharine.Burke@BakerBotts.com (Dec. 27, 2023)
1030	Default Protective Order
1031	<i>Locality</i> , Merriam-Webster Dictionary (2024) (https://www.merriam-webster.com/dictionary/locality , last accessed Sep. 16, 2024).
1032	<i>Locality</i> , Random House Webster’s Unabridged Dictionary (2nd ed. 2001).
1033	Transcript of Deposition of Dr. Robert Akl (Sep. 13, 2024)
1034	Supplemental Claim Construction Order, <i>STA Group LLC v. Motorola Solutions, Inc.</i> , No. 2:22-CV-0381-JRG-RSP, Dkt. 367 (E.D. Tex. June 4, 2024).
1035	Expert Report of Dr. Robert Akl, D.SC. Regarding Infringement of U.S. Patent No. 7,324,802, <i>STA Group LLC v. Motorola Solutions, Inc.</i> , No. 2:22-CV-0381-JRG-RSP (E.D. Tex. May 10, 2024).

I. Introduction

Patent Owner's arguments are not commensurate with the scope of the claims or the '802 Patent. When Petitioner's prior art is mapped to the claim language as properly understood, the claims are unpatentable.

II. Ground 1: Claims 1-21 are obvious over Ohel

a. Ohel discloses first and second entities.

PO does not dispute that Ohel discloses receiving a first message on a first channel dedicated to receiving messages from a dispatcher and receiving a second message on a second channel dedicated to receiving messages from another specific user (*e.g.*, a police officer). Paper 1 ("Petition"), 16-22; EX1002, ¶¶125-136. Rather, PO recycles its POPR argument that "a dispatcher is not an 'entity' as claimed." Paper 18 ("POR"), 13. The Board preliminarily determined that "'entity' is broad enough to encompass a user (such as a police officer) and a dispatcher." Paper 11 ("Decision"), 15. Nothing in the POR or in PO's supporting evidence has advanced this argument beyond that which was raised in the POPR; therefore, the Board should reaffirm its preliminary determination.

i. The intrinsic record establishes that a dispatcher is an entity.

The term "entity" appears only in the independent claims. No language in any claim narrows its scope to exclude a dispatcher. The claims merely recite a "first entity" and a "second entity." Entity is a broad term and would have been

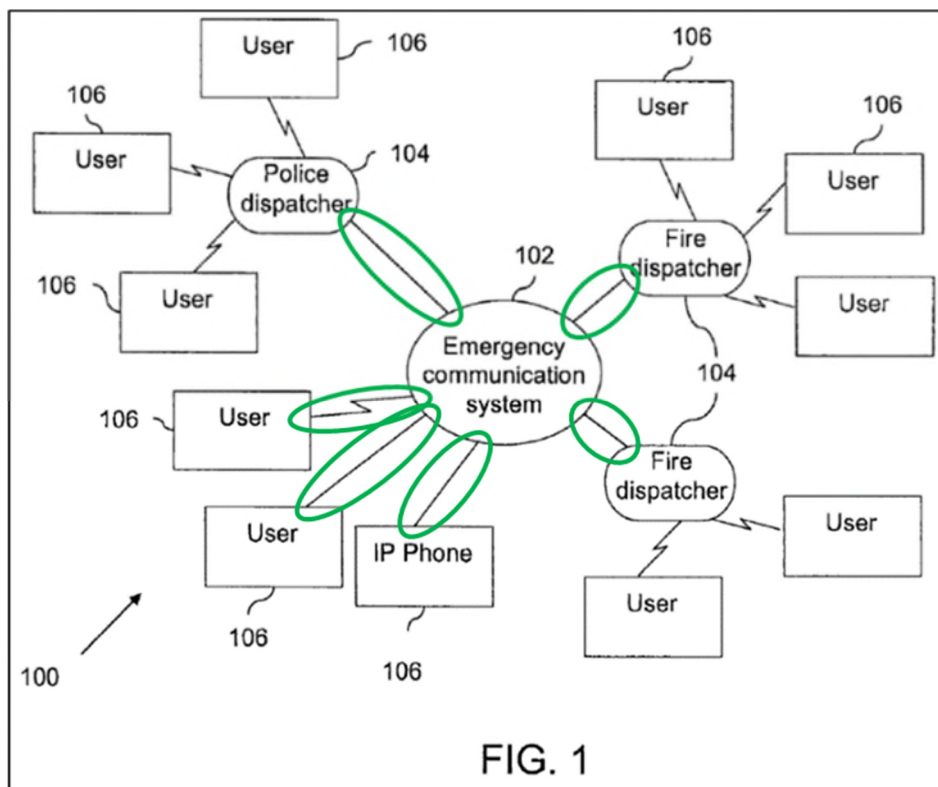
understood as encompassing a dispatcher. *See, e.g.*, EX1002, ¶¶125-136; EX2002 (defining entity as “independent, separate, or self-contained existence”). Nothing in the intrinsic record disclaims a dispatcher (or user) from the scope of “entity.”

At no point during prosecution did the Applicant disclaim a “dispatcher” from the scope of “entity.” EX1003, 44-46 (argument after adding entity limitations). Nor was there any disclaimer limiting an “entity” to “groups, localities, and units.” EX1003, 45 (“For example, a fire department can allocate one channel to a school or other public places, such as shopping malls.”). Rather, Applicant “noted that an entity may include any number of users,” which includes one user. *Id.*

The specification states that “users” can be entities, as can “a group/locality/unit.” EX1001, 7:18-20 (“The invention can operate between any two processes or entities including users....”); 1:13-25; *see also* Decision, 14. The specification also discloses emergency communication system 102 receiving messages from dispatchers and other individual users over dedicated channels. For example:

In accordance with an embodiment of the invention, an **emergency communication system 102 is connected to dispatchers 104 belonging to the emergency teams....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, 3:54-63 (emphases added). Figure 1 shows a “Police dispatcher” and “Fire dispatcher[s]” along with other users and devices communicating with emergency communication system 102 via dedicated channels:



EX1001, Fig. 1 (annotated); EX1033, 27:13-32:5. PO’s interpretation would read out this embodiment. As the Board recognized, “[s]uch an interpretation is rarely, if ever, correct and would require highly persuasive evidentiary support, which is wholly absent in this case.” *Vitronics Corp. v. Conceptronics, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996)); Decision, 14.

ii. The claim language does not support PO’s interpretation.

PO’s argument that the claims differentiate between Ohel’s dispatcher and the claimed entities fails. POR, 14-15. PO alleges that claim 6 “demonstrates that the

users are a part of an entity” by reciting assigning priorities “based on inputs from a user.” POR, 14. Nothing in the claims, however, associates the “user” in claim 6 with either “entity” in claim 1, nor does the claim language require or suggest in any way that the user be “part of an entity,” as opposed to some other user, as PO argues. *Cf.* POR, 14; *see also* EX1033, 62:19-64:14.

Next, PO relies on claim 7, which recites “informing an operator the time of receipt of a message[.]” EX1001, 10:22-24. Again, nothing in the claims associates the “operator” in claim 7 with either “entity” in claim 1. Nevertheless, PO argues that “the entity of claim 1 **must** be distinct from the operator of claim 7” because of claim differentiation. POR, 15. PO misapplies the doctrine, which “means that limitations stated in dependent claims are not to be read into the independent claim from which they depend.” *Karlin Tech., Inc. v. Surgical Dynamics, Inc.*, 177 F.3d 968, 972 (Fed. Cir. 1999).

PO relies on the presumption that different terms have different meanings and scope to argue that “the entity of claim 1 **must** be distinct from the operator of claim 7.” POR, 15. However, the principle that different terms should be accorded different meanings and scope does not mean those different claim terms must be accorded mutually exclusive meanings and scope. *See, e.g., Sound View Innovations, LLC v. Hulu, LLC*, 33 F.4th 1326, 1336 (Fed. Cir. 2022) (finding different terms not “mutually exclusive”); *Lites Out, LLC v. Outdoorlink, Inc.*, 2017

WL 4882613, at *10 (E.D. Tex. Oct. 30, 2017) (using “multiple terms does not require each term to be non-overlapping and mutually exclusive”). Thus, the fact that a dispatcher is an example of an operator in the specification does not mean that a dispatcher cannot also be an “entity.” Nor should the claimed “operator” be limited to a “dispatcher,” which is only an example of an operator in the ’802 patent.

iii. The specification does not support PO’s interpretation.

PO relies on the ’802 patent’s background section, which establishes that it was known for an emergency communication system to “support[] a plurality of communication channels, wherein each channel may be dedicated to a group/locality/unit” and that these groups/localities/units are examples of “entities.” POR, 15-16 (citing EX1001, 1:15-25). But this description that channels *may be* dedicated to a group/locality/unit does not establish that an entity *must be* a group/locality/unit. PO concedes that these are merely “examples” of entities. POR, 15. Moreover, PO and Dr. Akl do not address the specification’s express teaching that “[t]he invention can operate between any two processes or entities including users....” EX1001, 7:18-20.

PO incorrectly alleges that the specification “distinguishes an entity from a dispatcher.” POR, 10. The patent uses the term dispatcher twice (never in the claims). EX1001, 3:54-62. It states that in one embodiment “communication system 102 is connected to dispatchers 104” and “[d]ispatchers 104 are the operators who

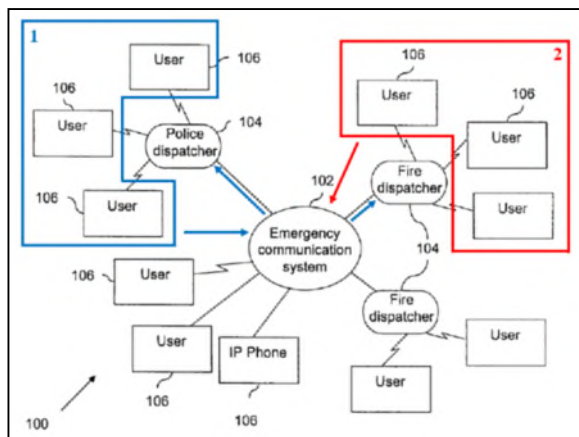
handle the communication for the emergency teams[.]” *Id.* Neither instance “distinguishes” an entity from a dispatcher. POR, 10.

Notably, the specification makes clear that entities can be users and frequently uses the terms “user” and “operator” interchangeably to describe the functionality in claim 7. *See, e.g.*, EX1001, 2:57-59 (“inform a user regarding the time of receipt”), 5:62-64 (“a user is informed about the time of receipt”), 6:31-33 (“inform the operator about the time of receipt”). Thus, the intrinsic record indicates that a dispatcher (an example of an operator) is a user and that users (including a dispatcher) can be entities, which is a broad term that includes individuals.

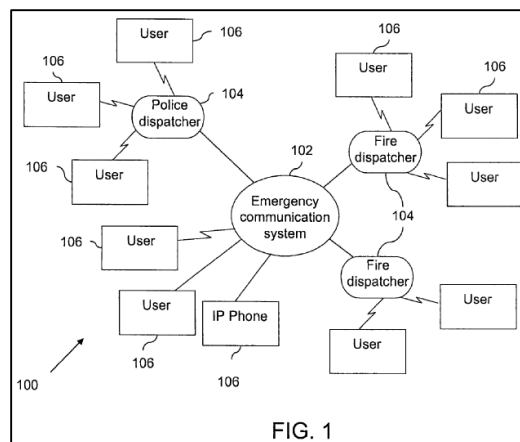
iv. PO’s arguments regarding alleged problems the ’802 patent solves lack merit.

PO’s attempt to distinguish Ohel based on alleged problems the ’802 patent solves is inconsistent with the claims and specification. POR, 16-17. PO alleges the inventions “solve an issue located at the operator sitting between at least two different entities—the operator simultaneously receives messages from different channels dedicated to different entities[.]” POR, 17. The main problem with PO’s argument is that no claim requires an “operator sitting between at least two different entities” or an operator simultaneously receiving messages. EX1033, 53:5-17, 54:5-19.

As shown below, PO’s flawed argument relies on modifying ’802 Figure 1 to include associations and connections that are not disclosed. POR, 17-19.



PO's annotated Figure 1 (POR, 18)

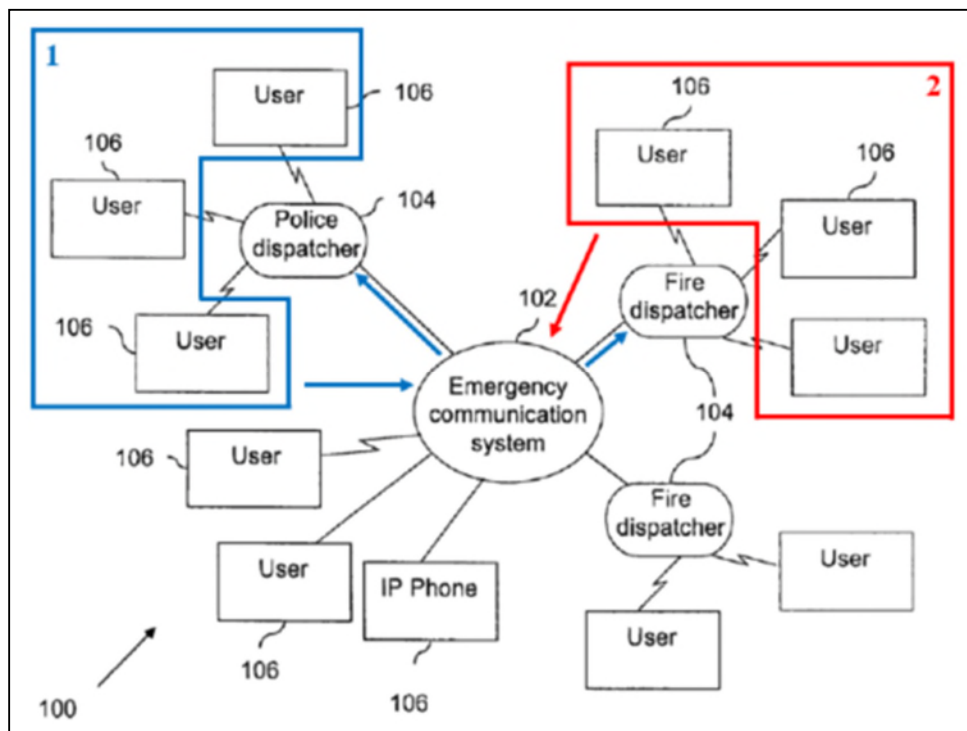


'802 patent Figure 1 (EX1001)

PO's grouping of certain users into groups 1 and 2 representing a "police force entity" and a "fire department entity" is not supported by the cited portions of the specification.¹ POR, 17 (citing EX1001, 3:52-4:5, 4:6-13). PO further modifies Figure 1 to purportedly illustrate that the "communication system may simultaneously receive messages from users of the first and second entity." POR, 17; *see also* POR, 18 ("These messages are represented by the red and blue arrows from each entity to the emergency communication system 102."). PO then fabricates an "illustrative example" in which the system "determines that the message from the

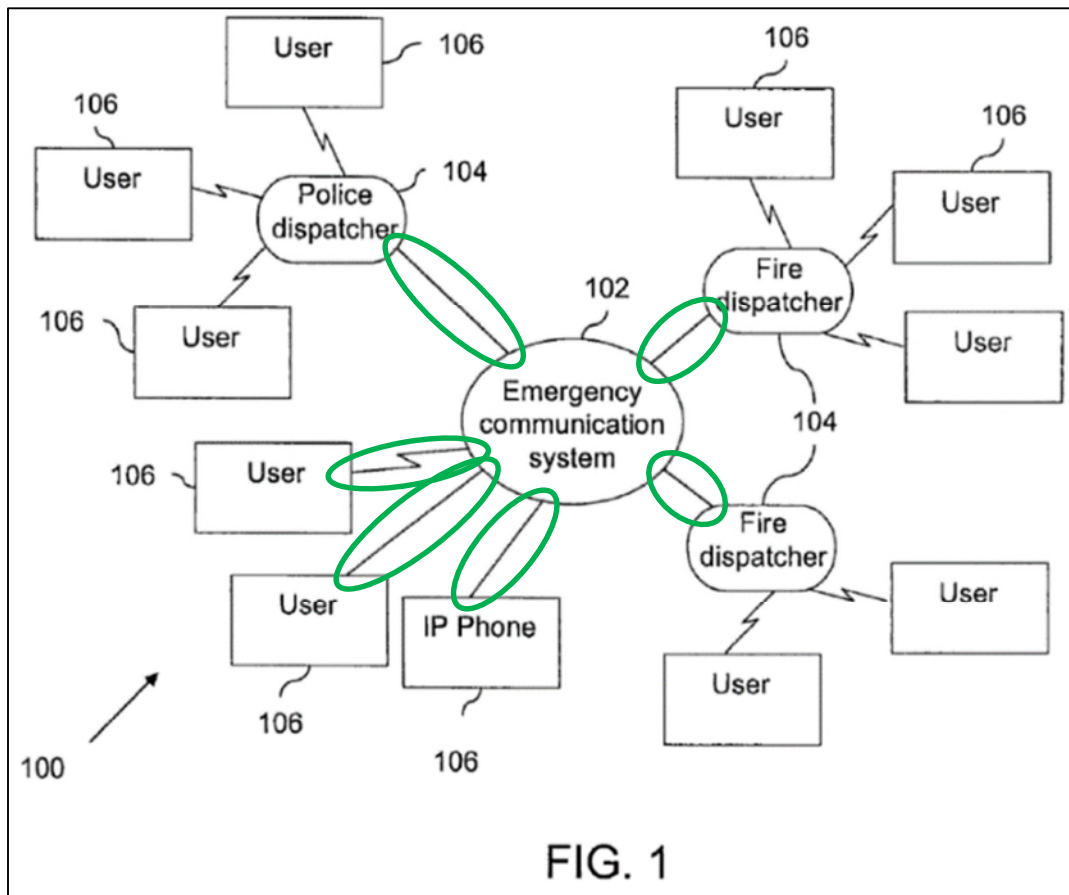
¹ Dr. Akl offered a similar, flawed interpretation of the entities in Figure 1 during his deposition but admitted that the claimed entity is not limited to what is purportedly shown in Figure 1. EX1033, 65:20-68:22. Regardless, the '802 patent makes clear that the claims are not to be limited to described embodiments. EX1001, 6:66-7:1, 7:5-10, 7:41-49, 9:13-16, 9:34-40.

police force is higher in priority than the message from the fire department” and “sends the message from the police force to both dispatchers while storing the red message to be subsequently played.” POR, 18-19.



PO's annotated Figure 1 (POR, 18).

However, no such dedicated channel from a user in the so-called police or fire department entities to system 102 exists in Figure 1. Rather, the users of these hypothetical entities are only shown to be in communication with their respective dispatchers, who are connected via respective dedicated channels to the communication system. EX1001, Fig. 1. Consistent with Petitioner's interpretation, only the dispatchers, two users and one IP phone are shown to be connected to the communication system via channels that could plausibly be called dedicated:

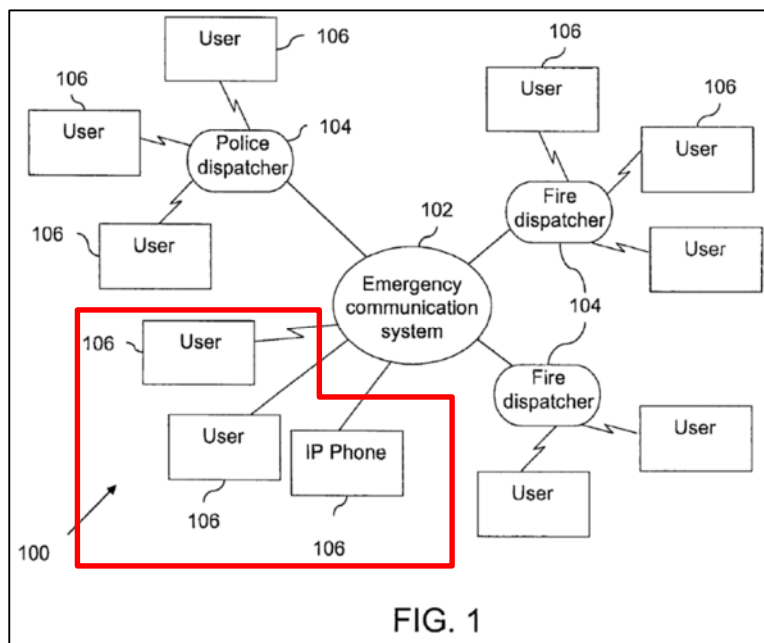


'802 patent, Figure 1 (EX1001)

EX1001, Fig. 1 (annotated). Ultimately, the only conclusion that can be drawn from Figure 1 and the specification is that a dispatcher is an entity from which the claimed communication system may receive a message on a dedicated channel.

PO also relies on alleged distinctions between overtalk and muting, and between the '802 patent's alleged focus on receiving messages on "**multiple** different multi-party communication channels" and Ohel's alleged focus on "an issue that affects individual **officers** on a **single** multi-party communication channel

within a **single entity** (i.e., the police force).” POR, 19-22.² However, no claim recites overtalk, muting, or a multi-party communication channel (let alone more than one). EX1033, 35:22-37:15, 39:16-40:18, 42:20-47:8. Indeed, the specification never mentions a multi-party communication channel. Rather, Figure 1 shows individual users communicating on dedicated channels, contradicting PO’s suggestion that the claims require two multi-party communication channels.



² PO’s characterization of Ohel as limited to communication on a single multi-party channel is inaccurate because Ohel’s communication unit includes transceiver units 2-8 for “communication over separate channels and/or networks.” EX1004, [0060].

v. Ohel teaches the claimed first and second entities.

Ohel discloses receiving overlapping messages from two different entities over respective dedicated channels as required by limitations 1[a] and 1[b]. EX1001, 9:46-55; EX1004, [0042] (“[A] user has the ability to preserve all electronically communicated data ... that previously would have been lost when **a first transmitting entity** was talked over by **a second transmitting entity**.”) (emphases added); Petition, 16-22.

Contrary to PO’s assertion, the Petition and Mr. Williams’ declaration identify multiple examples of overlapping messages in Ohel that satisfy these limitations. POR, 21-22; Petition, 16-22; EX1002, ¶¶121-136. The Petition identifies Ohel’s embodiment in which an “officer is presently talking to another individual...over the CDMA transceiver” as teaching receiving a first message from a first entity. EX1004, [0069]; Petition, 19. And the Petition identifies Ohel’s disclosure that “[d]uring the conversation, the police dispatcher begins to transmit one or more messages to the officer over the APCO transceiver” as teaching receiving a second message from a second entity, the dispatcher. EX1004, [0069]; Petition, 19, 21-22. Furthermore, the Petition explains how Ohel teaches that these examples apply to different scenarios with Ohel’s transceiver units 2-8 (including “first simplex unit 2 ... set to a dispatch channel” and “second simplex unit 3 ... set to a particular channel

of another specific user”). Petition, 18-20, 22. Nothing more is required to satisfy limitations 1[a]-1[b].

PO’s suggestions that Mr. Williams “backtracked” at deposition or otherwise did not support his opinions lack merit. POR, 22-23. Mr. Williams’ testimony reflects the fact that Ohel’s disclosure meets the requirements of the claims for multiple reasons. The notion that a given entity (*e.g.*, dispatcher) could satisfy either the first or second entity is not surprising because the claims broadly recite receiving a first message from a first entity and receiving a second message from a second entity. Moreover, Mr. Williams’ opinion that first and second entities can vary depending on the embodiment is further supported by the order of steps construction. POR, 8-9; EX2004, 15-16 (“steps [1A] and [1B] may be performed in any order”); EX1034, 1.

vi. Ohel renders the claims obvious under PO’s interpretation.

Even if PO’s interpretation of “entity” was correct, PO does not dispute the Petition’s argument that it would have been obvious to use channels dedicated to different entities in Ohel’s system because the ’802 Patent admits that doing so was known. Petition, 18-19 (quoting EX1001, 1:15-18).

b. Ohel renders Claim 5 obvious.

Ohel renders obvious “wherein the type of received messages being one of a group comprising audio, video, text, and image” in claim 5. Petition, 35; EX1002,

¶¶172-174. PO and Dr. Akl assert that claim 5 “limit[s] the way in which prioritizing of incoming messages is performed, to prioritizing based on the type of message received being either an audio, video, text, or image type message.” EX2007, ¶69; *see also* POR, 24. PO argues Ohel does not render obvious “prioritizing **based on** the associated parameter (*i.e.*, the type of message).” POR, 24; *see also* EX2007, ¶71.

PO’s interpretation of claim 5 is inconsistent with the interpretation PO and Dr. Akl applied in the district court and therefore improper. *See Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1351 (Fed. Cir. 2001) (“A patent may not, like a ‘nose of wax,’ be twisted one way to avoid anticipation and another to find infringement.”) (citations omitted); EX1033, 15:18-16:3, 21:12-22:12. In his infringement report (excerpted below), Dr. Akl opined that claim 5 merely “requires that the type of received message be audio, video, text, or image.”

D. Infringement of Claim 5 of the '802 Patent

210. Claim 5 of the '802 patent recites:

The method of claim 4, wherein the type of received messages being one of a group comprising audio, video, text, and image.

211. Claim 5 of the '802 patent depends upon claim 4, and places additional limitations pertaining to the type of received messages. In particular, claim 5 requires that the type of received messages be audio, video, text, or image. For at least the reasons detailed above in relation to claim 4, it is my opinion that the accused MSI products satisfy all elements of claim 4, and thus, said products infringe claim 4. Furthermore, as described below, it is my opinion that the accused MSI products also satisfy the additional limitations included directly within claim 5. As described above, audio messages are received.

EX1035, ¶¶210-211. Dr. Akl did not allege that the accused products prioritize messages based on the message types in claim 5. See EX1035, ¶¶210-215. Rather, Dr. Akl opined that receiving messages of at least one of the types specified satisfies claim 5. See, e.g., EX1035, ¶¶212, 214, 215. Consistent with Dr. Akl’s position in district court, Ohel’s messages can include “voice, code, pictures, and video.” EX1004, [0042]. As explained in the Petition, Ohel’s APCO transceiver messages are audio messages. Petition, 35; EX1002, ¶173. Accordingly, Ohel renders claim 5 obvious. EX1002, ¶¶172-174.

c. Ohel renders claim 7 obvious.

It would have been obvious to a POSITA based on Ohel’s disclosure to inform the officer using Ohel’s communications unit (*i.e.*, the “operator” of Ohel’s communications unit) of the time of receipt of a message while playing the first and second messages via Ohel’s display (*e.g.*, using a time stamp). Petition, 36-38; EX1002, ¶¶179-183; EX2007, ¶72 (“users of communications unit 1 are police officers”).³ PO does not meaningfully dispute this.

Rather, PO argues that “Ohel does not teach claim 7 because **the dispatcher** does not receive a time of receipt as claimed.” POR, 25 (emphasis added). Claim 7

³ Contrary to PO’s argument, the Petition indicated that its argument for claim 7 is an obviousness argument. POR, 25-26; Petition, 38; EX1002, ¶182.

does not recite a dispatcher, however, and PO has not shown that the “operator” in claim 7 is limited to a dispatcher. As discussed, the ’802 patent merely indicates that a dispatcher is an example of an operator. EX1001, 3:54-62. It does not follow that an operator is limited to a dispatcher. EX2005, 96:7-11 (“Q. And so the operator of Claim 7 is the dispatcher of Ohel; is that right? ...A. It can be. It can also be the police officer.”). The ’802 patent uses “operator” and “user” interchangeably, indicating that “operator” includes other types of users (*e.g.*, Ohel’s officer) in addition to a dispatcher. EX1001, 2:57-59, 5:62-64, 6:31-33; *supra*, §II.a.iii.

PO argues that the Petition fails to “articulate **why** it would be obvious to ... inform the **dispatcher**[.]” POR, 26. But that is not required by claim 7. PO also incorrectly suggests that “Mr. Williams does not know the answer to this question.” *Id.* Mr. Williams testified that he had not “done specifically that analysis,” which is not surprising because claim 7 does not recite a “dispatcher” so it was unnecessary to analyze the alternative use case of Ohel proposed by PO. EX2005, 100:11-20. Moreover, PO’s use of ellipses omits Mr. Williams’ explanation that “it would seem to be a reasonable thing to do in terms of particularly a dispatcher having a lot of things going on and wanting to know or be reminded when they did something.” EX2005, 100:15-20; *see also id.*, 99:23-100:1 (“Time stamp being, from a POSITA standpoint, a central piece of information or metadata[.]”). Thus, the claim is obvious even under PO’s theory of the claim scope.

d. Ohel renders Claim 11 obvious.

PO argues that the Petition does not adequately address limitation 11[h] or the “queue” of limitation 11[f]. POR, 27-30. PO is incorrect.

As stated in the Petition, the analysis of claim 1 demonstrates that Ohel teaches “playing the stored message having the highest priority” in limitation 11[h]. Petition, 41-42, 27-28. Claims 1 and 11 recite receiving first and second messages (not the six messages in Figure 4 relied upon by PO). POR, 29-30; EX1033, 48:6-51:1, 55:4-14. Thus, for claim analysis, only two messages are considered.

Accordingly, there is no material difference between limitations 1[g] and 11[h]. EX1002, ¶¶152-154, 193-197. Both require “playing the stored message.” Limitation 11[h] adds “having the highest priority,” but because the claims only recite that one message (the lower priority message) is stored and subsequently played, that stored message has “the highest priority.” EX1033, 62:9-16. Thus, limitation 11[h] is obvious for the same reasons as limitation 1[g].

The Petition also establishes that Ohel renders obvious the “queue” in limitation 11[f]. Petition, 41-42; EX1002, ¶¶193-197, 74-96. PO does not dispute that Ohel discloses prioritizing the first and second messages, determining which message should be stored based on one or more priorities assigned to the first and second message, and storing that message. This teaches “storing the message having lower priority ... on the basis of the determination and the prioritization” as claimed.

The only dispute is whether it would have been obvious to store the message “in a queue.” The Petition, supported by Mr. Williams, proves that it would have been obvious.

The Petition explains that “[a] POSITA would have understood that a queue is one well-known, practical way to store multiple messages in a single memory device such as the dynamic memory device.” Petition, 41-42 (citing EX1002, ¶¶193-195). PO does not dispute this assertion. Rather, Dr. Akl admits that “a queue is indeed one well-known way to store data[.]” EX2007, ¶76. The Technology Background section of Mr. Williams’ declaration highlights that using a queue was well understood and part of the POSITA’s background knowledge. EX1002, ¶¶74-96.

PO argues that a POSITA would not have used a queue with Ohel’s system because Ohel’s user determines which stored information is played while, according to PO, in the ’802 patent “stored messages are automatically played based on their order in a queue at a time of playback.” POR, 28-29. However, claims 11, 13, and 14 (to which PO contends this argument applies) do not require automatically playing stored messages based on their order in a queue at a time of playback. The claims merely require receiving two messages: the higher priority message is played and the lower priority message is stored and subsequently played.

PO fails to identify any reason why a queue is not compatible with user selection. The technique of storing in a queue while allowing user selection from the queue was known at least as early as 1991, as evidenced by the prior art identified in Mr. Williams’ declaration. *See, e.g.*, EX1002, ¶93; EX1017, Fig. 4, 3:60-4:34 (describing new incoming calls “placed in the incoming-call queue 207 according to a predetermined priority” from which a call may be “manually selected by the operator”).⁴

PO argues that “the Petition fails to explain how this modified version of Ohel would function” because “[t]he Petition points to no disclosure in Ohel assigning priorities between the **stored messages.**” POR, 29. This argument is inconsistent with the scope of the claims, which merely require receipt and prioritization of two messages, which Ohel discloses. EX1033, 48:6-22, 55:11-14. The claims do not require assigning priority to multiple stored messages “to determine the priority **between** the stored messages to establish the queue” as PO contends. POR, 29. A POSITA would have understood that there are multiple ways to store messages in a queue. *See, e.g.*, EX1002, ¶93; EX1017, 3:34-68 (describing queue based on

⁴ PO’s argument is inconsistent with Dr. Akl’s opinion in the litigation that this limitation is met by functionality that permits a user to select a message for playing from a list. EX1035, ¶191.

“chronological order”); EX1004, [0045], [0048], [0066] (describing using timestamps with stored messages).

PO further argues that the Petition includes no evidence of how the “stored sequence” of messages would be used. POR, 30. The claims, however, merely require storing one message, and it is used by “playing the stored message,” as discussed for limitation 1[g]. Petition, 27-28; EX1002, ¶¶152-154; EX1033, 57:4-8.

III. Ground 2: Claims 1-7 and 11-21 are obvious over Nigawara

a. Nigawara discloses the claimed entities.

PO’s argument that Nigawara’s plant sites do not disclose the claimed first and second entities fails. POR, 39. The intrinsic record does not support PO’s narrow interpretation of “entity.” *Supra*, §II.a.i-iii. Regardless, Nigawara’s plant sites are entities under PO’s interpretation. PO admits that entities include “groups, localities, and units[.]” POR, 16. At a minimum, Nigawara’s plant sites are localities and/or units. PO acknowledges that Nigawara’s plant sites are “sites within” the plant (*i.e.*, localities). POR, 39.⁵ Furthermore, Nigawara’s plant sites

⁵ See also EX1031, 1 (defining “locality” as “a particular place, situation, or location”); EX1032, 3 (defining “locality” as “a place, spot, or district”).

are “units of the plant.” EX1007, 1:27-29; *see also* EX2007, ¶83 (acknowledging “different units or plant sites, within the plant”).⁶

i. PO’s arguments regarding alleged problems the ’802 patent solves are immaterial.

PO presents argument based on alleged differing goals and solutions between Nigawara and the ’802 patent and other unclaimed features. POR, 39-42. These arguments are premised on: (1) the incorrect assumption that plant sites are not entities; (2) PO’s incorrect interpretation of operator as limited to a dispatcher; and (3) the position that “[t]he ’802 Patent solves the issue of interference between multiple communications arriving to an operator sitting between two different entities.” POR, 39; *see also id.*, 39-42. The claims, however, do not require messages arriving to an operator (or a dispatcher) sitting between different entities. *Supra*, §II.a.iv. Nigawara and the ’802 patent address the problem of overlapping messages becoming “garbled” if played simultaneously. EX1001, 1:22-36; EX1007, 1:29-38. Nigawara’s approach renders the ***claimed*** solution of the ’802 patent obvious.

⁶ PO identifies nothing in the intrinsic record that would exclude an entity that is also part of a larger entity from the claim scope. POR, 39.

b. Nigawara meets the order of steps construction.

PO's argument that Nigawara stores all messages and "does not teach '**determining** which message out of the first message and the second message should be stored and subsequently played **based on** ... one or more **priorities assigned** to the first and the second message'" (limitation 1[d]) under the order of steps construction is incorrect. POR, 47-48; EX2004, 15-16; EX1034, 1. The Board already rejected a similar argument. Decision, 9-12.⁷ Nothing in the POR warrants a different conclusion.

When Nigawara's system encounters overlapping demands for 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. EX1007, 3:68-4:15; Petition, 64-65. After determining priorities, "those voice message signals having priority lower ... are announced with a suitable delay

⁷ PO argues that the Board did not directly address limitation 1[d]. POR, 44. However, the Board indicated that the claim language "does not appear to otherwise specify that the message is not to be stored until its priority is assigned." Decision, 11. The same reasoning supports finding limitation 1[d] satisfied by Nigawara's disclosure.

according to the priority order.” EX1007, 7:23-28; Petition, 65. Determining to announce a lower priority message with a suitable delay (*i.e.*, to continue storing the lower priority message in memory while the higher priority message is announced) teaches “determining which message ... should be stored and subsequently played based on ... one or more priorities assigned to the first and second message” as in limitation 1[d]. EX1002, ¶¶250-253. Consistent with the order of steps construction, this determination occurs **after** determining the priorities and **before** playing the highest priority message and continuing to store the lower priority message. EX2004, 15-16.

The fact that Nigawara temporarily stores all messages until they are played out in priority order is irrelevant, as the claims do not preclude that. Indeed, the ’802 patent teaches the same thing—describing a scenario where both the “higher” and “lower” priority messages are stored while they are played back in priority order. EX1001, 5:34-64 (“...**stored** radio **message E** is played, since it **is highest in priority** among the stored radio messages. [Lower priority] message D is still in the queue ...”) (emphases added). PO relies on Figure 3 (POR, 45) but omits the description that limitation 1[d] can be performed on messages that have been stored. The patent describes that “[t]he radio message with the highest priority is played at step 314 while the remaining radio messages are stored in a queue at step 316.” EX1001, 4:64-66. However, “in case a new radio message is received on any of the plurality

of channels while the radio message with the highest priority is being played, **steps 302 to 316 are performed” again.** EX1001, 5:10-13 (emphasis added), 4:54-67, Fig. 3. Thus, the ’802 patent explicitly confirms that the steps involving determining priority of the messages and determining which message should be stored and subsequently played can be performed on messages stored in memory, including where the “higher” priority message is stored.

The prosecution history does not help PO as it shows no disavowal of the embodiments described above such that the claims preclude temporary storage of messages. POR, 46. PO cites to an argument attempting to overcome a rejection based on Cheng. EX1003, 62, 51. The thrust of Applicant’s argument was not based on Cheng storing all messages, but rather Cheng’s alleged failure to store “based on any determination that the messages or pages overlap in time or the priority of the messages or pages.” EX1003, 62. Nigawara teaches these aspects of the claim.

PO accuses Petitioner of taking an “inconsistent position” with respect to the order of steps. POR, 46-47. As discussed, however, Nigawara’s disclosure meets the order of steps construction. In fact, it is PO and Dr. Akl that have taken inconsistent positions. In his infringement report, Dr. Akl opines that a system in which all received messages are stored and then presented to the user in a sorted list meets limitation 1[d]. EX1035, ¶178. According to Dr. Akl, the user can select which messages to view first “and will thus be prompted to store the lower priority

messages[.]” *Id.* That Dr. Akl and PO now attempt to use storing messages as a basis for distinguishing Nigawara is improper and shows their lack of credibility. *Amazon.com*, 239 F.3d at 1351.

c. The Petition consistently identifies the first and second messages.

PO incorrectly argues that Petitioner does not consistently identify a first and second message. POR, 48. The Petition identifies Nigawara’s “information signals 5” as the received messages. Petition, 56-61. Nigawara’s information signals 5 are “indicative of operating conditions of” the plant sites and it is the “operating conditions of each of these plant sites [that] are announced by voice messages.” EX1007, 2:26-32; *see also* EX2007, ¶45 (acknowledging “announcement of an operating condition”). Petitioner did not “pivot[] to multiple different disclosures in *Nigawara*” as PO contends. POR, 48. The Petition relied on the same terms Nigawara uses to describe its process of announcing operating conditions indicated by information signals 5 to demonstrate that Nigawara renders the claims obvious. Nothing in the ’802 patent’s open-ended, “comprising” claims precludes additional processing of messages between the time the messages are received and the rest of the claimed steps are performed.

d. Nigawara renders Claim 5 obvious.

PO relies on the same interpretation of claim 5 discussed for Ground 1, which conflicts with PO's interpretation in the litigation and fails for the same reasons. *Supra*, §II.b.

Regardless, even under PO's narrow interpretation, PO's assertion that Nigawara's "system prioritizes based on message content without considering the ***type of received messages***" is incorrect. POR, 50. As shown in Table 1 below, Nigawara expressly prioritizes based on the "type of message" received. *See also* Petition, 75-77.

TABLE 1	
Example of determination of priority order according to contents of voice messages (type of message output signals 6)	
Priority order	Contents of Message
1st	Voice message announcing serious trouble in main machinery and equip- ments

TABLE 1-continued	
Example of determination of priority order according to contents of voice messages (type of message output signals 6)	
Priority order	Contents of Message
2nd	Voice message announcing medium trouble in large auxiliary machinery and equipment
3rd	Voice message announcing a change in operat- ing conditions of main machinery and equip- ment
4th	Voice message teaching actuation of automat- ically controlled machinery and equipment
5th	Voice message announcing slight trouble in valves and small auxiliary machinery and equipment
6th	Voice message announcing a change in operating conditions of auxiliary machinery and equip- ment
7th	Voice message announcing guidance for actua- tion of automatically controlled machinery and equipment

EX1007, Table 1 (4:59-5:23) (annotated). As can be seen, Nigawara expressly contemplates prioritizing based on whether the message is a “voice message” (*i.e.*, an audio message) and other criteria. *Id.* This renders obvious prioritizing messages “based on” the type of message being an audio message.

e. Nigawara renders Claim 7 obvious.

PO’s argument for claim 7 is based on PO’s narrow interpretation of “operator” as excluding a user. POR, 52-53. As discussed, the ’802 patent does not define operator to exclusively mean “dispatcher” and instead uses operator and user interchangeably. *Supra*, §II.a.ii-iii. PO admits “Nigawara’s operators would be

users of the '802 Patent[.]” POR, 52. PO does not dispute that it would have been obvious to inform Nigawara’s operators of the time of receipt of a message as claimed.

f. Nigawara renders Claim 11 obvious.

PO raises the same argument regarding limitation 11[h] as raised for Ground 1. POR, 53-54. The Petition’s mapping of Nigawara to claim 1 renders obvious “playing the stored message having the highest priority” for analogous reasons to those discussed for Ohel. *Supra*, §II.d.

i. It would have been obvious to store Nigawara’s messages in a queue.

PO argues that Nigawara “does not store messages ‘in a queue on the basis of the determination and the prioritization’” (POR, 54) but does not dispute the Petition’s argument that Nigawara’s disclosure of storing messages for playback in priority order “at least renders obvious *storing the message having lower priority in a queue.*” Petition, 80 (citing EX1002, ¶¶290-292). Queues were well known in the art. *See, e.g.*, EX1002, ¶93; EX1017, Fig. 4, 3:60-4:34; EX2007, ¶76. PO’s suggestion that Nigawara cannot use a queue because messages are stored before priority is determined fails for analogous reasons to those discussed for claim 1 and the order of steps. *Supra*, §III.b.

PO’s alleged “fundamental differences” purportedly “show[ing] that Nigawara cannot render claim 11 obvious” are unclaimed. POR, 56. The claims do

not require storing messages “in a specific order” or preclude “an incoming signal to identify the highest priority message.” *Id.* Moreover, reassessing priority is not a “fundamental difference” because limitations 11[g]-11[h] (and the ’802 specification) contemplate doing just that. EX1001, 5:1-18, 5:50-62.

ii. Nigawara renders limitation 11[g] obvious.

PO argues that “*Nigawara* does not ‘check[] periodically the status of the message being played’” because Nigawara describes reassessing priority of received messages “[a]t the end of announcement of the first message signal.” POR, 56-57. PO interprets Nigawara’s description of a priority assessment “at the end of announcement” narrowly to mean “after” rather than during the end of the currently-playing announcement. Indeed, as shown in Nigawara’s Figure 4B, during prioritized playback, the messages are continuously played back in order, with no apparent gap between messages. EX1007, Fig. 4. PO’s misreading of Nigawara is confirmed by Nigawara’s explanation that when “a voice message signal ... is being announced” and “an emergency voice message signal having a higher priority is received by the message output unit 102, the announcement of the former signal may be interrupted, and the latter signal or emergency signal may be announced.” EX1007, 4:30-38; EX1002, ¶¶232, 292-293. Thus, as the Petition explained, Nigawara’s ongoing priority determination involves a determination of the status of a message being played.

IV. PO's attempt to undermine Mr. Williams' credibility is unavailing.

PO's arguments based on the Board's findings in an unrelated proceeding do not undermine Mr. Williams' opinions. POR, 59-63. The Board has repeatedly rejected Dr. Akl's testimony. *See, e.g., FanDuel, Inc. v. Interactive Games LLC*, IPR2017-01532, Paper 32, 19 (P.T.A.B. Dec. 10, 2018) (finding "Dr. Akl's speculation" inconsistent with prior art); *FanDuel, Inc. v. CG Tech. Development, LLC*, IPR2017-00902, Paper 45, 38-39 (P.T.A.B. Oct. 4, 2018); *Juniper Networks, Inc. v. Smart Path Connections, LLC*, IPR2022-00240, Paper 41, 77 (P.T.A.B. May 19, 2023) (Dr. Akl's "testimony is conclusory").

PO relies on cherry-picked excerpts from Mr. Williams' deposition involving hypotheticals outside the scope of his direct testimony. POR, 62-63; 37 C.F.R. § 42.53(d)(5)(ii). Mr. Williams acknowledged that he had not considered those scenarios as they were not necessary to his analysis. Mr. Williams provided detailed analysis comparing the claims to the prior art, and his opinions support finding the claims obvious.

V. Conclusion

The Board should cancel the challenged claims.

September 25, 2024

Respectfully Submitted,

/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

*Attorneys for Petitioner, Motorola Solutions,
Inc.*

CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. §§ 42.6(e), the undersigned certifies that on September 25, 2024, a complete and entire copy of the **PETITIONER’S REPLY TO PATENT OWNER’S RESPONSE** and Exhibits 1030-1035 were served on Patent Owner via email at the following correspondence addresses:

Jason.Engel.PTAB@klgates.com

Kyle.Kantarek@klgates.com

Nolan.Hubbard@klgates.com

Jared.Lund@klgates.com

Date: September 25, 2024

/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

*Attorneys for Petitioner, Motorola Solutions,
Inc.*

CERTIFICATION UNDER 37 C.F.R. § 42.24(d)

Pursuant to 37 C.F.R. § 42.24(d), the undersigned hereby certifies that the word count under § 42.24(c) for the foregoing **PETITIONER’S REPLY TO PATENT OWNER’S RESPONSE** totals 5,599 words, within the 5,600 word limit allowed under § 42.24(c)(1).

Date: September 25, 2024

/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

*Attorneys for Petitioner, Motorola Solutions,
Inc.*