

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA SOLUTIONS, INC.,

Petitioner,

v.

STA GROUP LLC,

Patent Owner.

IPR2023-01293

U.S. Patent No. 8,489,134 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. 8,489,134 (“’134 patent”)
1002	Declaration of Dr. Sayfe Kiaei in Support of Petition for <i>Inter Partes</i> Review of the ’134 Patent, with CV attached as Appendix A (“Kiaei Decl.”)
1003	Prosecution File History of the ’134 Patent (“’134 patent file history”)
1004	<i>Satellite Earth Stations and Systems (SES); Broadband Satellite Multimedia; IP Interworking over Satellite; Multicasting</i> , ETSI TR 102 156 v1.1.1 (published April 2003) (“ETSI-156”)
1005	ETSI, Publicly Available Specifications (PAS), https://www.etsi.org/images/files/Brochures/ETSI-Brochure-PAS.pdf (last accessed August 3, 2023)
1006	<i>Resource ReSerVation Protocol (RSVP) – Version 1 Functional Specification</i> by Braden et. al. (published September 1997) (“RFC-2205”)
1007	U.S. Patent Publication 2006/0268824 (published November 30, 2006) (“Dhesikan”)
1008	U.S. Patent Publication 2005/0248652 (published November 10, 2005) (“Firestone”)
1009	U.S. Patent Publication 2007/0036118 (published February 15, 2007) (“Shaffer”)
1010	RFC-Editor, Publication Process, https://www.rfc-editor.org/pubprocess/ (last accessed August 3, 2023)
1011	<i>Satellite Earth Stations and Systems (SES); Broadband Satellite Multimedia; IP Interworking over satellite; Performance, Availability and Quality of Service</i> , ETSI TR 102 157 v1.1.1 (published July 2003) (“ETSI-157”)

Ex[No.]	Description of Documents
1012	<i>Satellite Earth Stations and Systems (SES); Broadband Satellite Multimedia; IP over Satellite</i> , ETSI TR 101 985 v1.1.2 (published November 2002) (“ETSI-985”)
1013	<i>RTP: A Transport Protocol for Real-Time Applications</i> by Schulzrinne et al. (published July 2003) (“RFC 3550”)
1014	<i>The BGAN Extension Programme</i> , The European Space Agency (ESA) Bulletin 124 (Nov. 2005) (“BGAN”)
1015	Web archive for <i>The BGAN Extension Programme</i> , https://web.archive.org/web/20061009113656/https://www.esa.int/esapub/bulletin/bulletin124/bul124j_rivera.pdf (Oct. 9, 2006)
1016	Declaration of Dr. Sylvia Hall-Ellis
1017	ETSI, <i>Technical Committee (TC) Satellite Earth Stations and Systems (SES)</i> , https://www.etsi.org/committee/1412-ses (last accessed Aug. 3, 2023)
1018	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)
1019	Sastri L. Kota, <i>Broadband Satellite Networks: Trends and Challenges</i> , IEEE Wireless Communications and Networking Conference, Vol. 3, pp. 1472-78 (2005) (“Kota”)
1020	Eylem Ekici et al., <i>A Multicast Routing Algorithm for LEO Satellite IP Networks</i> , IEEE/ACM Transactions on Networking, Vol. 10, No. 2, pp. 183-92 (2002) (“Ekici”)
1021	Jiangchuan Liu et al., <i>Adaptive Video Multicast over the Internet</i> , IEEE MultiMedia, Vol. 10, No. 1, pp. 22-33, (2003) (“Liu”)
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, <i>STA Group LLC v. Motorola Solutions, Inc.</i> , No. 2:22-CV-0381-JRG-RSP (E.D. Tex. June 15, 2023).
1023	<i>Host Extensions for IP Multicasting</i> by Deering (published August 1989) (“RFC-1112”)
1024	<i>Internet Group Management Protocol, Version 3</i> by Cain et al. (published October 2002) (“RFC-3376”)

Ex[No.]	Description of Documents
1025	<i>Protocol Independent Multicast – Sparse Mode (PIM-SM): Protocol Specification (Revised)</i> by Fenner et al. (published August 2006) (“RFC-4601”)
1026	U.S. Patent Publication 2005/0047582 (published March 3, 2005) (“Shaffer”)
1027	U.S. Patent Publication 2005/0086302 (published April 21, 2005) (“Aggarwal”)
1028	Celestri Multimedia LEO System, Federal Communications Commission Filing (June 1997) (“Celestri”)
1029	Iridium System Application, Federal Communications Commission Filing (December 3, 1990) (“Iridium”)
1030	U.S. Patent 6,104,925 (issued August, 15, 2000) (“Grube”)
1031	U.S. Patent Publication 2005/0021726 (published January 27, 2005) (“Denoual”)
1032	<i>Comparisons of Conventional and Trunked Systems</i> , Public Safety Wireless Network, May 1999
1033	<i>Satellite Earth Stations and Systems (SES); Broadband Satellite Multimedia; Part 1: Survey on Standardization Objectives</i> , ETSI TR 101 374-1 v1.2.1 (published October 1998) (“ETSI-374”)
1034	U.S. Patent No. 6,477,150 (issued Nov. 5, 2002) (“Maggenti”)
1035	Wayback Machine capture of <i>Resource ReSerVation Protocol (RSVP) – Version 1 Functional Specification</i> by Braden et. al. (published September 1997) (“RFC-2205”) from October 10, 2004
1036	Parties’ Local P.R. 4-2 Disclosure of Preliminary Proposed Constructions of Claim Terms and Preliminary Identification of Extrinsic Evidence
1037	Katherine K. Vidal, <i>Memorandum: Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation</i> (June 21, 2022)
1038	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)
1039	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 '134 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, which was adopted on August 11, 2023.

On December 1, 2023, the Court in the EDTX Litigation entered an Amended Docket Control Order (EX1038) 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). EX1038, 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. 8,489,134 on the grounds presented in the petition in IPR2023-01293, 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 EX1039.

The ’134 Patent was also asserted against Petitioner in an identical Complaint in *STA Grp. 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 forthcoming)</i> BAKER BOTTS L.L.P. 700 K Street, N.W Washington, D.C. 20001-5692 Tel: 202-639-7720 katharine.burke@bakerbotts.com Michael E. Knierim (Reg. No. 78,268) Baker Botts L.L.P. 30 Rockefeller Plaza

	New York, NY 10112 Tel: 212-408-2500 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
--	---

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 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 1039 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.*