

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA SOLUTIONS, INC.

Petitioner,

v.

STA GROUP LLC

Patent Owner

Case IPR2023-01293
U.S. Patent No. 8,489,134 B2

**PATENT OWNER'S SUR-REPLY TO PETITIONER'S
AUTHORIZED REPLY**

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Exhibit List

Exhibit No.	Exhibit Name
2001	Declaration of Michael Craner
2002	December 2023 DocketNavigator, Time to Trial Statistics in Patent Cases in the United States District Court for the Eastern District of Texas

I. INTRODUCTION

Petitioner makes two substantive arguments in its Reply to the Patent Owner's Preliminary Response ("POPR"). First, Petitioner argues the Board should reject the Patent Owner's ("PO") construction of "transcoding." However, as shown below, the Board should instead reject the Petitioner's unduly broad construction, which attempts to improperly expand the meaning of transcoding to include any coding technique "applied to previously encoded data." Second, Petitioner argues that "requesting" is the same as "automatically configured to select." As shown below, they are clearly not the same.

Although Petitioner specifically requested leave to reply to address alleged "conflicts with the apparent constructions applied by STA in their infringement contentions" of both "transcoding" and "select," Petitioner's Reply fails to address the alleged conflict and instead merely rehashes issues previously raised in the Petition and addressed in the POPR, as shown below.

II. PETITIONER'S DEFINITION OF "TRANSCODING" IS UNDULY BROAD

Petitioner's arguments in its Petition rely on construing transcoding to mean "changing codec type" or any other "coding techniques applied to previously encoded data." Petition, 40 ("Modifying bit rate using compression or changing codec type are methods of transcoding because, e.g., they are coding techniques applied to previously encoded data."). The POPR explains why transcoding is not

the same as “changing codec type” or any other “coding techniques applied to previously encoded data.” POPR, 10-11, 14-19. In the Reply, the Petitioner continues to assert this incorrect interpretation, or several variations of this terminology, stating “[a]s described in the Petition, the plain meaning of ‘transcoding’ is straightforward and includes ‘changing codec type[s]’ or other methods of coding previously encoded data,” “adjust[ing] a codec,” “ramp[ing] down a codec,” “adjusting (e.g., substituting) or ramping down (e.g., compressing).” Reply, 1, 3. Petitioner’s argument is simply wrong.

Petitioner’s definition is fundamentally incorrect and unduly broad, even upon comparison to *Twitter*, now relied upon by the Petitioner. Reply, 1 (citing *Twitter, Inc. v. Vidstream LLC*, IPR2017-01133, Paper 68 at 8, n1 (P.T.A.B. Jan. 23, 2019) (construing “transcoding” to mean “converting from one video format to another.”). Properly construed, transcoding is a coding technique that converts data encoded by one codec in a first format (e.g., MPEG-2 video format) into a second format (e.g., H.264 video format) for use by a second codec, through a process of decoding data encoded according to the first codec and re-encoding the data according to the second codec. POPR, 10-11, 18, 19.

The Petitioner’s construction conflates the end result of modifying bit rate to reduce bandwidth consumption with methods that achieve that result. Reply, 1; Petition, 40. The Petitioner *must* conflate these concepts in order to argue ETSI-157

teaches requesting a change or substitution to a codec or the application of additional encoding, e.g., link layer compression encoding, to a signal. POPR, 16-18.

To support its improper construction, Petitioner argues that PO's position departs from the claims and the specification. Reply, 2-3. However, PO's position does not contradict the claims and the specification. "Transcoding" carries a specific meaning separate from both codec substitution and the application of additional encoding that would be understood by a POSITA. POPR, 8-11, 14-18. Accordingly, there is no need to define transcoding in the specification or draw out the steps in the claims; the term transcoding itself carries the appropriate meaning. *Id.*

As already presented in the POPR, even though the ETSI-157 drafters were clearly aware of the term "transcoding" (*see* Ex. 1011, 9, references [6] and [7]), they refrained from using the term, or any derivative thereof. POPR, 14. The Petition, Dr. Kiaei, and the Reply all fail to point out where ETSI-157 discloses transcoding. For example, the Petition and the Reply rely heavily on paragraphs 147-150 of Dr. Kiaei's report. A close read of those paragraphs shows that Dr. Kiaei does not identify any section of ETSI-157 that actually teaches transcoding. Instead, Dr. Kiaei pieces together disparate concepts, sometimes more than 30 pages apart, and none of which actually include the term "transcode" (*see* Ex. 1002, ¶¶ 147-150) to equate codec substitution and additional compression encoding with transcoding.

III. PETITIONER CONFLATES “REQUEST” WITH “AUTOMATICALLY CONFIGURED TO SELECT”

Just as in the Petition, Petitioner’s Reply conflates “request” with “automatically configured to select.” Reply, 4-5. The plain and ordinary meanings of these two phrases are not the same. In addition, as shown in the POPR, a POSITA of telecommunications networks would understand that “request” carries a specific meaning that is not the same as “automatically configured to select.” POPR, 23-24; Ex. 2001, ¶ 52. For example, a request can be denied, but by being “automatically configured to select,” there is no chance of denial. *Id.*

IV. CONCLUSION

For the reasons provided in the POPR and in this Sur-Reply, the Board should deny institution.

Date: January 25, 2024

Respectfully Submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on January 25, 2024, 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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