

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
Patent 8,489,134 B2

Before MICHAEL J. FITZPATRICK, DAVID C. McKONE, and
KEVIN C. TROCK, *Administrative Patent Judges*.

FITZPATRICK, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Petitioner, Motorola Solutions, Inc., filed a Petition to institute an *inter partes* review of claims 1–14 of U.S. Patent No. 8,489,134 B2 (“the ’134 patent”) pursuant to 35 U.S.C. § 311(a). Paper 1 (“Pet.”). Patent Owner, STA Group LLC, filed a Preliminary Response pursuant to 37 C.F.R. § 42.107(b). Paper 7 (“Prelim. Resp.”). With our authorization, Petitioner filed a Preliminary Reply directed solely to the meaning of two claim terms. Paper 9 (“Prelim. Reply”). With our authorization, Patent Owner filed a Preliminary Sur-reply also limited to the meaning of those terms. Paper 10 (“Prelim. Sur-reply”).

Institution of an *inter partes* review requires “a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Determining whether a reasonable likelihood has been met has been delegated to the Board. *See* 37 C.F.R. § 42.4(a) (“The Board institutes the trial on behalf of the Director.”). Upon consideration of the Petition, Preliminary Response, Preliminary Reply, and Preliminary Sur-reply, and for the reasons explained below, we determine that the information presented shows a reasonable likelihood that Petitioner would prevail with respect to at least one claim. Accordingly, we grant the Petition.

A. Related Matters

The parties identify the following district court proceeding involving the ’134 patent, *STA Grp. LLC v. Motorola Solutions, Inc.*, No. 2-22-cv-00381 (E.D. Tex.). Pet. 1; Paper 4, 1.

B. Real Parties In Interest

Petitioner identifies itself, Motorola Solutions, Inc, as the sole real party in interest. Pet. 1.

Patent Owner identifies itself, STA Group LLC, as the sole real party in interest. Paper 4, 1.

C. The '134 Patent

The '134 patent “relates . . . to a system and a method for providing presence[-]based trunking in a network environment.” Ex. 1001, 1:8–9. The context of the '134 patent is IP Multicast (or simply, Multicast). “Multicast utilizes network infrastructure efficiently by requiring the source to send a packet only once, even if it needs to be delivered to a large number of receivers. The nodes in the network take care of replicating the packet to reach multiple receivers.” *Id.* 1:23–27. The '134 patent explains that “the links that carry this data are expensive” and “the ability to optimize communication links in the context of multicasting activities presents a significant challenge to network administrators, component manufacturers, and system designers alike.” *Id.* at 1:33–38.

D. The Challenged Claims

Inter partes review is sought for claims 1–14. Pet. 8. Of these, claims 1, 8, and 12 are independent. Claim 1 is reproduced below.

1. An apparatus, comprising:

a first communication resource manager located in a first domain and operable to interact with a second communication resource manager located in a second domain, wherein the first communication resource manager is configured to:

determine to establish a link for multicasting between users in the first domain and users in the second domain based on presence data of at least one user in the first domain and at least one user in the second domain;

determine an application to be used in a communication session over the link;

allocate a bandwidth level to be used for the link to accommodate the application;

increase the bandwidth level for the link based on a change in the application and based on an identification of additional presence data for additional users that have joined the communication session, *wherein the communication resource managers each includes respective trunking element that is automatically configured to select a transcoding based on available bandwidth;*

adjust the bandwidth level based on a determination which of the additional users and the users in the first and second domains can transmit data simultaneously during the communication session;

detect an absence of active users in the first domain and the second domain; and

tear down the link based on the absence; wherein the link is a satellite communication link.

Ex. 1001, 7:57–8:20 (emphasis added).

E. Asserted Patents and Printed Publications

Name	Reference	Ex. #
ETSI-156	<i>Satellite Earth Stations and Systems (SES); Broadband Satellite Multimedia; IP Interworking over Satellite; Multicasting</i> , ETSI TR 102 156 v1.1.1 (Apr. 2003)	1004
ETSI-157	<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 (July 2003)	1011
ETSI-985	<i>Satellite Earth Stations and Systems (SES); Broadband Satellite Multimedia; IP over Satellite</i> , ETSI TR 101 985 v1.1.2 (Nov. 2002)	1012
RFC-2205	<i>Resource ReSerVation Protocol (RSVP) – Version 1 Functional Specification</i> by Braden et. al. (Sept. 1997)	1006
Dhesikan	US 2006/0268824 A1 (Nov. 30, 2006)	1007
BGAN	<i>The BGAN Extension Programme</i> , The European Space Agency (ESA) Bulletin 124 (Nov. 2005)	1014
Firestone	US 2005/0248652 A1 (Nov. 10, 2005)	1008

In addition to these references, Petitioner relies on a Declaration of Sayfe Kiaei, Ph.D. (Ex. 1002, “Kiaei Decl.”).

F. The Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability:

Claim(s) Challenged	35 U.S.C. §	Basis
1–14	103(a)	ETSI-156, ETSI-157, ETSI-985, RFC-2205
1–14	103(a)	Dhesikan, BGAN, Firestone

Pet. 8.

II. DISCRETIONARY DENIAL

Institution of an *inter partes* review is discretionary. *See* 35 U.S.C. § 314(a) (authorizing institution of an *inter partes* review under particular circumstances, but not requiring institution under any circumstances); *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) (“[Section] 314(a) invests the Director with discretion on the question whether to institute review” (emphasis omitted)); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”).

Patent Owner argues that we should exercise our discretion under 35 U.S.C. § 314(a) and deny the Petition in view of the related lawsuit in the Eastern District of Texas. Prelim. Resp. 26 (citing *Apple Inc. v. Fintiv, Inc.*, No. IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”); *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* (June 21, 2022) (“*Interim Procedure*”)). However, Petitioner has since filed a *Sotera* stipulation, so named based on *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A). *See* Ex. 1039. Thus, pursuant to the *Interim Procedure*, we will not discretionarily deny the Petition based on the related lawsuit. *See Interim Procedure* at 3 (“Consistent with *Sotera Wireless, Inc.*, the PTAB will not discretionarily deny institution in view of parallel district court litigation where a petitioner presents a stipulation not to pursue in a parallel

proceeding the same grounds or any grounds that could have reasonably been raised before the PTAB.”).

III. ANALYSIS

A. Obviousness Generally

A claim is unpatentable “if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.” 35 U.S.C. § 103(a).¹ “Obviousness is a question of law based on underlying facts.” *MobileMedia Ideas LLC v. Apple Inc.*, 780 F.3d 1159, 1167 (Fed. Cir. 2015). The underlying facts include “(i) the scope and content of the prior art, (ii) the differences between the prior art and the claimed invention, (iii) the level of ordinary skill in the field of the invention, and (iv) any relevant objective considerations of nonobviousness.” *Id.* (citing *Graham v. John Deere of Kan. City*, 383 U.S. 1, 17–18 (1966)). An additional underlying fact is whether there was a reason to combine prior art teachings when so asserted. *Id.*; *see also KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418–19 (2007) (“[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, which was enacted September 16, 2011, amended 35 U.S.C. § 103. AIA § 3(c). That amendment became effective eighteen months later on March 16, 2013. *Id.* at § 3(n). Because the application from which the ’134 patent issued was filed before March 16, 2013, any citations herein to 35 U.S.C. § 103 are to the pre-AIA version. *Id.* at § 3(n)(1).

claimed new invention does . . . because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.”).

B. Level of Ordinary Skill in the Art

In determining whether an invention would have been obvious at the time it was made, we consider the level of ordinary skill in the pertinent art at the time of the invention. *Graham*, 383 U.S. at 17. “The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991). The “person having ordinary skill in the art” is a hypothetical construct, from whose vantage point obviousness is assessed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

Petitioner contends a person of ordinary skill in the art of the ’134 patent

would have had at least a bachelor’s degree in computer science, electrical engineering, or a similar field, and would have had approximately three years industry experience in networking or communication systems, in particular addressing interoperability between different types of networks and satellite communications. Ex[1002], ¶52. Additional education in the fields of electrical engineering or computer science may serve as a substitute for experience in the field. *Id.* A person with less or different education but more relevant practical experience, or vice versa, may also meet this standard.

Pet. 10. Patent Owner does not dispute Petitioner’s description of a person of ordinary skill in the art or provide its own description. Indeed, Patent Owner witness Michael Crane explicitly “accept[s]” it. Ex. 2001 ¶28.

Because Petitioner’s formulation of the level of ordinary skill in the art appears consistent with the ’134 patent and the asserted prior art, and because there is no argument to the contrary at this stage of the proceeding, we apply it in our analysis below.

C. Claim Construction

The challenged claims should be read in light of the specification, as it would be interpreted by one of ordinary skill in the art. *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010). Thus, we generally give claim terms their ordinary and customary meaning. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) (“The ordinary and customary meaning is the meaning that the term would have to a person of ordinary skill in the art in question.” (internal quotation marks omitted)); *see also* 37 C.F.R. § 42.100(b) (stating that claims are construed in IPRs according to the same standard as used in federal court).

In a “CLAIM CONSTRUCTION” titled portion of the Petition, Petitioner construes two terms that are not actually recited in the claim. First, Petitioner states that “[m]ulticast” means “the delivery of information to a group of destinations simultaneously using the most efficient strategy.” Pet. 11 (citing Ex. 1001: 1:14–16). None of the challenged claims recite “multicast,” but each of the independent claims recite “multicasting.” This decision does not turn on the meaning of “multicasting,” as Patent Owner does not contest that the cited art teaches such a feature. Accordingly, we need not and do not construe explicitly “multicasting.”

Second, Petitioner states that “presence information” means “a status indicator that conveys an ability and/or willingness of a potential

communication partner to communicate.” Pet. 11 (citing Ex. 1001, 6:41–44). None of the challenged claims recite “presence information,” but each of the independent claims recite “presence data.” This decision does not turn on the meaning of “presence data,” as Patent Owner does not contest that the cited art teaches such a feature. Accordingly, we need not and do not construe explicitly “presence data.”

The section of the Petition titled “CLAIM CONSTRUCTION” does not propose any other express constructions of claim terms. Pet. 11. Likewise, a section of the Preliminary Response titled “Claim Construction” does not propose any express constructions. Nonetheless, a significant dispute about the meaning of the claims exists, as the parties have advanced, at least implicitly, different constructions for “transcoding” and “select.”

After the Preliminary Response was filed, Petitioner sought authorization to file its Preliminary Reply to address implicit constructions for “transcoding” and “select” advanced in the Preliminary Response. We granted authorization for the Preliminary Reply as well as Patent Owner’s Preliminary Sur-reply.

1. “transcoding”

Petitioner argues that “[m]odifying bit rate using compression or changing codec type are methods of *transcoding* because, e.g., they are coding techniques applied to previously encoded data.” Pet. 40 (citing Ex. 1002 ¶150). Patent Owner argues that this is error. Prelim. Resp. 14–19. Patent Owner further argues that “transcoding” would have been understood by a person of ordinary skill in the art to mean “a coding technique to decode from one coding format and re-encode into another

alternative format at the same encoding level.” Prelim. Resp. 10 (citing Ex. 2001 ¶36²); *see also id.* (“To a POSITA at the time of the ’134 Patent, ‘transcoding’ was also commonly used to refer to decoding and re-encoding at the compression level.” (citing Ex. 2001 ¶36)).

In the Preliminary Reply, Petitioner argues that Patent Owner’s construction is unreasonably narrow. Prelim. Reply 2. Petitioner directs us to an unrelated Board decision that interpreted “transcoding” as “converting from one video format to another.” *Id.* at 1 (quoting *Twitter, Inc. v. Vidstream LLC*, No. IPR2017-01133, Paper 68 at 8 (PTAB Jan. 23, 2019)). Petitioner’s reliance on *Twitter* is not persuasive because it involves use of the term in a different, unrelated patent. *Cf. e.Digital Corp. v. Futurewei Techs., Inc.*, 772 F.3d 723, 727 (Fed. Cir. 2014) (holding that “collateral estoppel cannot apply to the construction of a claim in one patent based on a previous claim construction of an unrelated patent”). Moreover, the Board in *Twitter* construed the term in the absence of any dispute as to its meaning. *See Twitter*, Paper 68 at 8 (“Neither party has indicated that our interpretations [in the institution decision] were improper, and we do not perceive any reason or evidence that now compels any deviation from our initial interpretations.”); *Twitter*, Paper 8 at 2 (institution decision noting that the patent owner did not file a preliminary response).

Next, Petitioner draws our attention to the fact that “[t]he challenged claims merely recite ‘select a transcoding’ without requiring any specific method, much less an intermediate decoding step between a first codec and a second codec at the same level of an unrecited coding hierarchy.” Prelim.

² Exhibit 2001 is a Declaration by Michael Craner.

Reply 2. This argument, however, does not rebut Patent Owner’s argument that a person of ordinary skill in the art would have known that “transcoding” means decoding and re-encoding at the same compression or encoding level. That the ’134 patent mentions “transcoding” without going into the details of decoding and re-encoding is consistent with Patent Owner’s position. It is also consistent with Petitioner’s position. In other words, the argument is not probative of either party’s construction.

Petitioner also points out that “transcoding” appears in the ’134 patent only once outside the claims and argues that, in doing so, it “simply refers to adjusting or ramping down a codec.” Prelim. Reply 2 (citing Ex. 1001 4:25–32); *see also id.* at 3 (arguing that the ’134 patent describes “transcoding as covering ‘adjust[ing]’ a codec or ‘ramp[ing] down’ a codec”) (quoting Ex. 1001 4:25–32).

The relevant portion of the ’134 patent states the following:

In yet another embodiment, dynamic trunking elements 50 and 52 (in cooperation with the endpoints) automatically configure the system to select transcoding based on the available bandwidth. As a result, the endpoints are dynamically configured to ramp down the codec on the SatCom link, based on the available bandwidth over the SatCom link. Note that each SatCom link may adjust its codec according to the specific bandwidth it is able to reserve.

Ex. 1001, 4:25–32. This description does not equate transcoding to adjusting or ramping down of a codec; it states, rather, that adjusting or ramping down of a codec is the result of transcoding.

We have two competing constructions for “transcoding,” and a record which is light on intrinsic evidence but which includes declaration testimony from both sides. At this preliminary stage of the proceeding, Patent Owner’s construction appears to be the correct one.

2. “select”

Claims 1, 8, and 12 recite that “the communication resource managers each includes respective trunking element that is automatically configured to *select* a transcoding based on available bandwidth.” (Emphasis added). Petitioner asserts that the prior art teaches the “select” limitation by virtue of a “request.” *See, e.g.*, Ex. 1011, 67 (“The BPM [i.e., broadband satellite multimedia protocol manager] may also *request* from a suite of other available link layer services such as compression, encryption and so on. Joint Network/Link mechanisms can only exist within the BPM and once a DS class has been established the BPM will support it by *requesting* a change to modulation and coding when appropriate.” (emphasis added)).

Patent Owner argues that ““automatically configured to select” conveys a decision without the possibility of a denial.” Prelim. Resp. 24 (citing Ex. 2001 ¶52). The cited Declaration testimony is not persuasive, as Mr. Craner merely repeats the identical statement without offering any evidence in support. Ex. 2001 ¶52. In short, the record presented does not support incorporating “without the possibility of a denial” into the meaning of the word “select.”

D. Ground 1 (TSI-156, ETSI-157, ETSI-985, and RFC-2205)

Petitioner’s Ground 1 contends that claims 1–14 would have been obvious over ETSI-156, ETSI-157, ETSI-985, and RFC-2205. Pet. 8. The Petition breaks claim 1 into 10 portions, labeled 1[a]–1[j], and presents an analysis for each portion. *Id.* at 20–43. The Petition then addresses claims 2–7, which ultimately depend from claim 1, and presents an analysis for the additional limitations recited in those claims. *Id.* at 43–48. Finally, the

Petition addresses each of claims 8–14, exclusively by referring back to the analysis presented for another claim. *Id.* at 48–50.

Patent Owner’s arguments against Ground 1 relate solely to the portion of claim 1 that the Petition labels 1[f], namely, “the communication resource managers each includes respective trunking element that is automatically configured to select a transcoding based on available bandwidth.” Prelim. Resp. 13–24.³ In particular, Patent Owner argues that the prior art fails to teach either “select” or “transcoding.” *Id.* Prelim. Resp. 13–24. We address both arguments below.

1. “select” arguments

Petitioner relies on ETSI-157 as teaching the “select” aspect of the claim. *See* Pet. 39 (“ETSI-157 explains each CRM’s trunking element is configured to automatically select a transcoding based on available bandwidth.” (citing Ex. 1002 ¶147)). Petitioner’s argument is that, in ETSI-157, a codec type automatically changes (i.e., a new codec is automatically selected) based on the available bandwidth. *Id.* at 38–41. In Petitioner’s words:

ETSI-157 discloses that “bandwidth and delay should be used as metrics for QoS routing.” [Ex. 1011], p.43. For example, to address changes in bandwidth, ETSI-157 discloses a “Codec Type” field included in the “QoS metadata.” *Id.*, p.68. A POSITA would have understood that this field would only change if necessary and that the codec with the highest compatible fidelity would generally be selected. *Id.*, p.68; Ex[1002], ¶148.

³ The identical limitation is recited in independent claims 8 and 12. Ex. 1001, 8:56–59 (recitation in claim 8), 9:28–31 (recitation in claim 12). Thus, Patent Owner’s arguments apply to all of the challenged claims.

Pet. 40.

Patent Owner argues that ETSI-157 describes a *request* to change a codec, not a *selection* of a new codec. Prelim. Resp. 19–24. To support that argument, Patent Owner twice draws our attention to page 67 of ETSI-157, which uses the former term, not the latter. Prelim Resp. 19–20, 23; *see* Ex. 1011, 67 (“The BPM may also *request* from a suite of other available link layer services such as compression, encryption and so on. Joint Network/Link mechanisms can only exist within the BPM and once a DS class has been established the BPM will support it by *requesting* a change to modulation and coding when appropriate.” (emphasis added)). Patent Owner argues that ETSI-157’s use of the word “request” “implies that the request can be denied,” whereas the claim’s recitation of “‘automatically configured to select’ conveys a decision without the possibility of a denial.” Prelim. Resp. 23–24. We are not persuaded on either account.

First, as a legal matter and as discussed above in Section III.C.2., Patent Owner fails to persuade us that “select” as used in the claims refers to a selection that cannot be denied or otherwise fail. Second, as a factual matter, Patent Owner does not explain how or why a requested change to coding in ETSI-157 (*see* Ex. 1011, 67) would be denied. Patent Owner has not identified any teaching to that effect. Patent Owner merely speculates that the word itself – “request” – “implies that [it] can be denied.” Prelim. Resp. 24. Petitioner has adequately shown, for institution purposes, that ETSI-157 teaches “automatically configured to select.”

2. “*transcoding*” arguments

Petitioner argues that ETSI-157 teaches two “methods of *transcoding*.” Pet. 40.

First, Petitioner argues that ETSI-157 teaches changing the codec, via a “‘Codec Type’ field included in ‘QoS [or Quality of Service] metadata,’” and that this would be based on “bandwidth and delay.” Pet. 40 (quoting Ex. 1011, 43, 68). Petitioner further argues that a person of ordinary skill in the art would have understood that [the Codec Type] field would only change if necessary and that the codec with the highest compatible fidelity would generally be selected.” *Id.* (citing Ex. 1011, 68; Ex. 1002 ¶148).

Second, Petitioner argues that ETSI-157 teaches that the Communication Resource Manager or “CRM can ‘reduce the rate’ of transmissions to accommodate lower bandwidth circumstances so that ‘service can continue with degraded performance for all services (if the service agreements allow it) or at nominal performance for high QoS classes by shutting down some low priority services.’” Pet. 40 (quoting Ex. 1011, 32).

Petitioner argues that both of these teachings constitute transcoding “because . . . they are coding techniques applied to previously encoded data.” Pet. 40 (citing Ex. 1002 ¶150). Patent Owner argues to the contrary because in neither instance does ETSI-157 describe decoding followed by re-encoding. *See, e.g.*, Prelim. Resp. 19 (“Modifying bit rate using compression . . . may result in a different compression ratio subject to the additional encoding or the substituted codec, but that is not decoding one format at a logical peer level of a signal’s code and re-encoding that peer

level into another codec.”). Patent Owner stresses that “ETSI-157 does not even use the words ‘transcode’ or ‘transcoding.’” Prelim. Resp. 14.

This is a close call on the record presented, where each party’s proposed construction relies heavily on declaration testimony for which neither witness has yet to be cross-examined. But we need not decide whether Petitioner has a reasonable likelihood of prevailing on this ground because, as explained below, we determine there is a reasonable likelihood of Petitioner prevailing on Ground 2. Pursuant to *SAS Institute*, when the Board institutes, we institute on all grounds and claims presented in a petition. 138 S. Ct. at 1356; *see also* 37 C.F.R. § 42.108(a) (“When instituting *inter partes* review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.”). Thus, we institute on Ground 1, despite some weakness on the present record as to whether ETSI-157 teaches “transcoding.”

Petitioner should heed that it bears the burden to prove by a preponderance of the evidence that the Ground 1 prior art teaches the claimed subject matter. *See* 35 U.S.C. § 316(e) (“In an *inter partes* review instituted under this chapter, the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.”); *see also* 37 C.F.R. § 42.104(b)(3)–(4) (stating that a petition for an *inter partes* review must identify, among other things, “(3) How the challenged claim is to be construed [and] (4) How the construed claim is unpatentable under the statutory grounds identified”). More specifically, Petitioner must show how the prior art teaches the claims as properly construed.

E. Ground 2 (Dhesikan, BGAN, and Firestone)

Petitioner's Ground 2 contends that claims 1–14 would have been obvious over Dhesikan, BGAN, and Firestone. Pet. 8. For Ground 2, the Petition again breaks claim 1 into 10 portions, labeled 1a–1j, and presents an analysis for each portion. *Id.* at 59–80. The Petition then addresses claims 2–7, presenting an analysis for the additional limitations recited therein. *Id.* at 80–85. Finally, the Petition addresses each of claims 8–14, exclusively by referring back to the analysis presented for another claim. *Id.* at 85–87.

In Ground 2, Patent Owner again argues that the prior art fails to teach “the communication resource managers each includes respective trunking element that is automatically configured to select a transcoding based on available bandwidth.” Prelim. Resp. 24–25. In doing so, however, Patent Owner argues that a different aspect of this claim language is missing. Here, Patent Owner does not appear to dispute that the prior art teaches selecting a transcoding but only that it fails to teach selecting a transcoding “based on available bandwidth.” *Id.*

In Ground 2, Petitioner relies on Firestone for teaching transcoding. *See, e.g.*, Pet. 58 (“Firestone’s media switches perform ‘transcoding’ operations.” (quoting Ex. 1008 ¶34)). “In the [proposed] combination, when users (end points) have limitations on ‘how much bandwidth reservation’ they can request, Dhesikan’s QoS agent uses functionality from Firestone’s ‘[m]edia switch’ to select ‘transcoding’ and ‘transrating’ to accommodate the ‘[b]andwidth constraints.’” *Id.* at 74 (citing Ex. 1008 ¶¶29, 32, 34, 108, 109; Ex. 1002 ¶237); *see also* Ex. 1008 ¶34 (“Each media switch 26 can register its capabilities at startup, which can include . . . 3) video composition[, which Firestone explains can include] video transrating and

transcoding in order to allow end points using different rates or codecs to natively join the same conference without needing external transraters or transcoders.”).

Petitioner argues that Firestone teaches transcoding “based on available bandwidth” because its media switches “select ‘transcoding’ and ‘transrating’ to accommodate the ‘[b]andwidth constraints.’” Pet. 74 (citing Ex. 1008 ¶¶29, 32, 34, 108, 109; Ex. 1002 ¶237). Petitioner cites numerous paragraphs of Firestone to support the argument but the quotes appear to be from a single sentence of paragraph 29, which states the following: “For end points needing a voice activated service, intelligent media switching may be utilized unless there may be *bandwidth constraints demanding a video transrater* to be inserted in the media path or *a video transcoder due to codec incompatibilities.*” Ex. 1008 ¶29 (emphasis added).

Patent Owner argues that “Firestone teaches the use of ‘a video transcoder *due to codec incompatibilities,*’” not bandwidth constraints. Prelim. Resp. 25 (quoting Ex. 1008 ¶29 (emphasis added)); *see also id.* (“The specification of allowable end point video customization [in Firestone] relates to formatting and codec controls.”). But, according to Petitioner, transrating is a type of transcoding. *See* Pet. 74 n.9 (“As described in Firestone, video transrating is a special case of video transcoding that alters bandwidth of a video signal.” (citing Ex. 1002 ¶237)); *see also* Ex. 1002 ¶237 n.20 (same statement). In its Preliminary Response, Patent Owner does not dispute Petitioner’s assertion that transrating is a type of transcoding. Prelim. Resp. 24–25 (Patent Owner’s Ground 2 arguments). Nor does Patent Owner dispute that Firestone teaches video transrating in relation to bandwidth constraints. *See* Ex. 1008 ¶29 (“there may be

bandwidth constraints demanding a video transrater to be inserted in the media path”). As such, Petitioner has shown, sufficiently for institution purposes, that Firestone teaches the “select[ion] of a transcoding based on available bandwidth,” as recited in the independent claims.

IV. CONCLUSION

For the reasons discussed above, we are persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing in establishing that at least one of the challenged claims is unpatentable.

V. ORDER

In consideration of the foregoing, it is hereby

ORDERED that the Petition is granted and *inter partes* review is hereby instituted as to claims 1–14 of U.S. Patent No. 8,489,134 B2 on the grounds presented; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial on the grounds of unpatentability authorized above; the trial commences on the entry date of this decision.

IPR2023-01293
Patent 8,489,134 B2

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