

UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT TRIAL AND APPEAL BOARD

MOTOROLA SOLUTIONS, INC.,
Petitioner,

v.

STA GROUP LLC,
Patent Owner.

Case IPR2023-01294
U.S. Patent No. 8,831,664

PRELIMINARY PATENT OWNER'S RESPONSE

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. THE '664 PATENT	2
A. The Invention of the '664 Patent.....	2
B. Claim Construction	4
C. Level of Ordinary Skill in the Art	5
III. THE PETITION FAILS TO ESTABLISH A REASONABLE LIKELIHOOD OF SUCCESS ON ANY CHALLENGED CLAIMS.....	5
A. Summary of the Alleged Prior Art	5
1. U.S. Patent No. 5,754,960 (“Downs”)	5
2. Telecommunications Industry Association System Standard (“EDACS”)	6
3. PCT Pub. No. WO2004/034350 (“Kim”)	7
B. The Legal Framework for Assessing Unpatentability	8
C. Ground 1: The Petition Does not Establish That Claims 1-6, 8- 9, and 11-20 are Obvious Over Downs in View of EDACS	9
1. Downs in view of EDACS fail to disclose “monitoring media streams associated with channels in a communication environment.”	10
2. The Petition fails to show that the Downs in view of EDACS combination discloses all elements of claims 2- 6, 8-9, 12-15, and 17-20.....	12
D. Ground 2: Claims 1-6, 8-9, and 11-20 Are Not Obvious Over Downs in View Of EDACS And in Further View Of Childress	13
E. Grounds 3 and 4: The Petition Does Not Establish That Claims 3-5, 13-14, and 18-19 Are Not Obvious Over Grounds 1 and 2 And in Further View Of Hancock	13

F.	Grounds 5 and 6: Claims 7 and 10 Are Not Obvious Over Grounds 1 and 2 in Further View of Reich	13
G.	Ground 7: Claims 1-2, 6-9, 11-12, 15-17, and 20 Are Not Obvious Over Kim	13
H.	Ground 8: Claims 3-5, 13-14, and 18-19 Are Not Obvious Over Ground 7 in View of Ishibashi	16
I.	Ground 9: Claim 10 Is Not Obvious Over Ground 7 in View of Goss.....	16
IV.	THE PETITION SHOULD BE DENIED UNDER 35 U.S.C. § 325(d) BECAUSE ALL REFERENCES IN THE PROPOSED GROUNDS ARE CUMULATIVE	17
A.	Ground 1 References Are Cumulative	17
B.	Ground 2 References Are Cumulative	23
V.	THE BOARD SHOULD DENY INSTITUTION UNDER 35 U.S.C. § 314	25
A.	Factor 1: Potential Stay	25
B.	Factor 2: Trial Date	26
C.	Factor 3: Investment in the Parallel Proceeding	27
D.	Factor 4: Issue Overlap	29
E.	Factor 5: Party Overlap	29
F.	Factor 6: Other Circumstances Favoring Institution.....	29
VI.	CONCLUSION.....	30

TABLE OF AUTHORITIES

Cases	Page(s)
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020)	25, 29
<i>Apple Inc. v. Firstface Co.</i> , No. 2021-1001, 2021 WL 4156323 (Fed. Cir. 2021)	4
<i>BOE tech. Grp. Co., Ltd., Beijing BOE Display Tech. Co., and Motorola (Wuhan) Mobility Tech. Comm. Co., Ltd., v. Element Capital Commercial Co. PTE. Ltd.</i> , IPR2023-00808, Paper 9 (P.T.A.B. Nov. 15, 2023)	26, 27
<i>Darfon Electronics Corp. v. Michael Shipman</i> , IPR2022-01008, Paper 11 (P.T.A.B. Dec. 2, 2022)	17
<i>Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.</i> , 800 F.3d 1375 (Fed. Cir. 2015)	7, 8
<i>Google Inc. v. EveryMD.com LLC</i> , Case No. IPR2014-00347, Paper 9 (P.T.A.B. May 22, 2014)	8
<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966)	8
<i>Harmonic Inc. v. Avid Tech., Inc.</i> , 815 F.3d 1356 (Fed. Cir. 2016)	7
<i>KSR Int’l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007)	8, 9
<i>In re Magnum Oil Tools Int’l, Ltd.</i> , 829 F.3d 1364 (Fed. Cir. 2016)	8
<i>NEC Display Solutions of America, Inc. v. Ultravision Tech.</i> , IPR2019-01123, Paper 7 (P.T.A.B. Dec. 2, 2019)	4
<i>OpenSky Indus., LLC v. VLSI Tech. LLC</i> , IPR2021-01064, Paper 102 (P.T.A.B. Oct. 4, 2022)	29

<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005) (<i>en banc</i>)	4
<i>Samsung Elecs. Co. Ltd. v. California Institute of Tech.</i> , IPR2023-00130, Paper 10 (P.T.A.B. May 4, 2023)	29
<i>Sand Revolution II LLC v. Continental Intermodal Group-Trucking LLC</i> , IPR2019-01393, Paper 24 (P.T.A.B. Jun. 16, 2020)	25
<i>Sotera Wireless, Inc. v. Masimo Corp.</i> , IPR2020-01019, Paper 12 (P.T.A.B. Dec. 1, 2020)	29
<i>STA Group LLC v. Motorola Solutions, Inc.</i> , No. 2:22-cv-00381-JRG-RSP (E.D. Tex Sep. 30, 2022).....	27
<i>Wilson Elec., LLC. v. Cellphone-Mate, Inc.</i> , Case No. IPR2018-01778, Paper 10 (P.T.A.B. Apr. 23, 2019).....	9

Statutes

35 U.S.C. § 103	8
35 U.S.C. § 314.....	1, 2, 9, 13, 15, 16, 25
35 U.S.C. § 325	1, 16, 24

Exhibit List

Exhibit No.	Description
2001	Shaffer et al. (WO2007/021586) (“Shaffer”)
2002	Biltz et al. (US 2008/0037461) (“Biltz”)
2003	December 2023 DocketNavigator Time to Trial Statistics in Patent Cases in the United States District Court for the Eastern District of Texas

I. INTRODUCTION

Patent Owner, STA Group LLC (“Patent Owner”), submits this Preliminary Patent Owner Response (“PPOR”) pursuant to 37 C.F.R. § 42.107(a) in response to the *Inter Partes* Review (“IPR”) petition (“Petition”) filed by Petitioner Motorola Solutions, Inc. (“Motorola” or “Petitioner”) for claims 1-20 (“Challenged Claims”) of U.S. Patent 8,831,664 (“’664 Patent”, Ex. 1001).

The Board should deny Petitioner’s institution request for several reasons.

First, the Board should exercise its discretion to deny institution under § 314(a) because the Petitioner does not provide a compelling merits argument. Specifically, the Board should deny institution because the references relied on for the obviousness grounds fail to disclose all elements of the independent claims.

Second, at least some of the references in the proposed grounds are cumulative to references already cited against the patent in the original prosecution. The cumulative nature of the references provides another reason for the Board to deny institution under 35 U.S.C. § 325(d).

Third, *Fintiv* factors provide a rationale to deny institution. Petitioner has not requested a stay in the parallel district court litigation, there is no stipulation by Petitioner regarding issues asserted in this Proceeding versus the parallel proceeding, there will be substantial costs associated with carrying out both proceedings, and the timing of a Final Written Decision (“FWD”) will take place after trial in the parallel

proceeding. These issues provide independent reasons for the Board to deny institution under § 314(a).

In short, the Petition does not present “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).

II. THE ’664 PATENT

A. The Invention of the ’664 Patent

The ’664 Patent issued on September 9, 2014, and is a continuation of U.S. Patent 8,041,378, which has a priority of December 19, 2008. Ex. 1001, Cover. The invention of the ’664 Patent is directed to a system and method for monitoring media streams associated with channels in a communication environment. *Id.*, Abstract. When an alert is received in a media stream, the system and method elevate a priority of the media stream such that an adjustment is made to how the media stream is provisioned to an endpoint in the communication environment. *Id.*, 2:11-14. Such adjustments can include, *e.g.*, increasing the volume of the media stream, changing the spatial direction for rendering it, or rendering it to a primary channel. *Id.* cl. 2, 3, 6.

As the ’664 Patent explains, typical communication architectures support a plurality of channels, and “[u]niversally, channels are statically configured.” Ex. 1001, 1:36-38. “A problem occurs when a user turns down the volume of a given

channel and, as a result, cannot hear an alert tone or the conversation that follows on that channel.” *Id.* 3:30-33. To solve at least these prior art shortcomings, the invention claimed in the ’664 Patent is generally directed to “monitoring media streams,” receiving alerts in one of the media streams, and “elevating a priority associated with the media stream receiving the alert, such that an adjustment is made to how the media stream is provided to an endpoint in the communication environment.” *See, e.g., id.*, cl. 1. The ’664 Patent has twenty claims, of which claims 1, 11, and 16 are the only independent claims.

The Petition challenges all twenty claims—the Challenged Claims—under nine total grounds, Grounds 1-9, as detailed below:

Ground	Basis for Challenge
1	Claims 1-6, 8-9, and 11-20 are obvious over Downs in view of EDACS
2	Claims 1-6, 8-9, and 11-20 are obvious over Ground 1 in further view of Childress
3	Claims 3-5, 13-14, 18, 19 are obvious over Ground 1 in further view of Hancock
4	Claims 3-5, 13-14, 18, 19 are obvious over Ground 2 in further view of Hancock
5	Claims 7, 10 are obvious over Ground 1 in further view of Reich
6	Claims 7, 10 are obvious over Ground 2 in further view of Reich
7	Claims 1-2, 6-9, 11-12, 15-17, 20 are obvious over Kim

Ground	Basis for Challenge
8	Claims 3-5, 13-14, 18-19 are obvious over Ground 7 in view of Ishibashi
9	Claim 10 is obvious over Ground 7 in view of Goss

B. Claim Construction

The Petition was filed after November 13, 2018, and, as such, the proper claim construction standard to be applied is articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (*en banc*), in accordance with its regulation, 37 C.F.R. § 42.100(b). *Apple Inc. v. Firstface Co.*, No. 2021-1001, 2021 WL 4156323, at *1 (Fed. Cir. 2021).

Therefore, these claims should be “given their ordinary and customary meaning [and] that the ordinary and customary meaning of a claim term is the meaning that the term would have to a [POSA] in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application.” *Phillips*, 415 F.3d at 1312-13; *see also* Ex. 1032. These arguments for claim terms apply for the purposes of this IPR only and without conceding alternative arguments in the counterpart litigations. *See NEC Display Solutions of America, Inc. v. Ultravision Tech.*, IPR2019-01123, Paper 7 at 12-14 (P.T.A.B. Dec. 2, 2019).

C. Level of Ordinary Skill in the Art

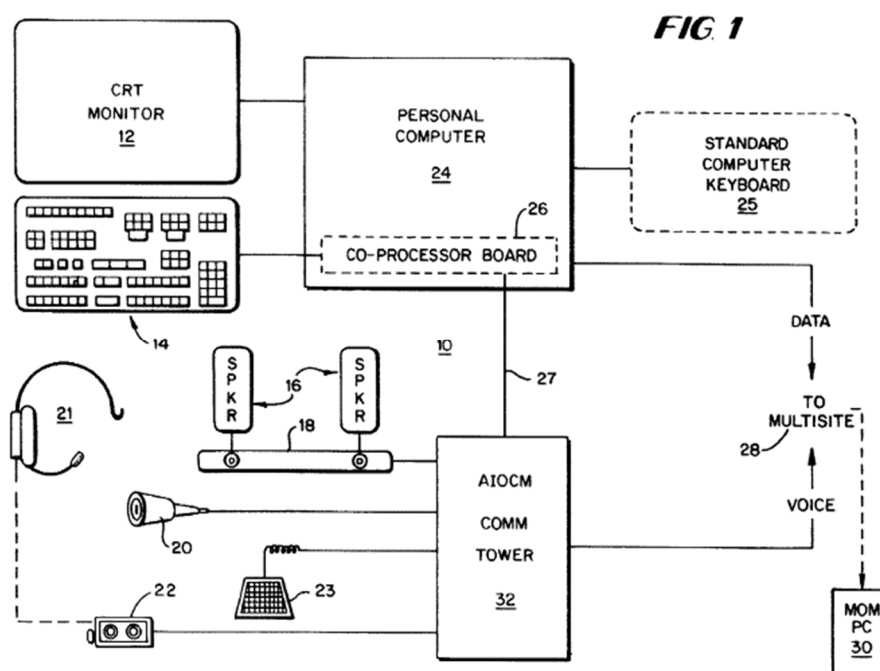
At this stage of the proceeding, Patent Owner does not dispute the proposal provided by Petitioner as to who would qualify as a POSA: an individual “would have had a bachelor’s degree in computer science, electrical engineering, or a similar field, and would have had approximately two years industry experience in networking or communication systems.” Petition, 5.

**III. THE PETITION FAILS TO ESTABLISH A REASONABLE
LIKELIHOOD OF SUCCESS ON ANY CHALLENGED CLAIMS**

A. Summary of the Alleged Prior Art

1. U.S. Patent No. 5,754,960 (“Downs”)

U.S. Patent No. 5,754,960 (“Downs”) is titled “Display Console and User Interface for Multisite RF Trunked System.” Ex. 1004, Cover. Downs was filed Feb. 14, 1992 and issued May 19, 1998. *Id.* Downs is directed to a dispatch console system consisting of a monitor, a personal computer, a keyboard, speakers, etc. *Id.*, Abstract. The described console is depicted in Fig. 1:



Ex. 1004, Fig. 1.

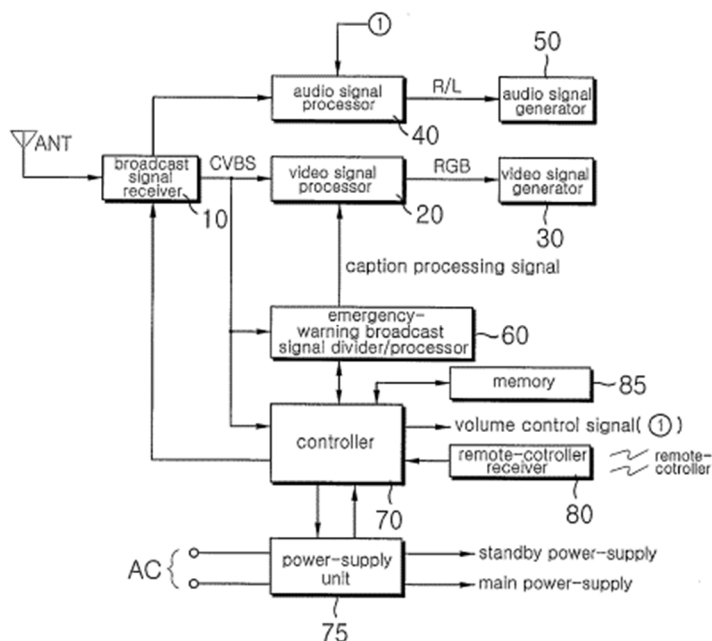
2. Telecommunications Industry Association System Standard (“EDACS”)

The EDACS standard was published by the Telecommunications Industry Association (TIA) and entitled “A system and Standards Definition for a Digital Land Mobile Radio System, TSB69.” Ex. 1005, 1. EDACS is a standard set by the TIA for describing enhanced digital access communication systems and setting outlines for such systems. *Id.* at 3.

EDACS discloses four “call types,” one of which is emergency calls. *Id.* at 23-24. Emergency calls are “initiated by pushing the emergency button on the radio.” *Id.* at 25. Once initiated, the system “receives the emergency call request and assigns the emergency call to a free channel.” *Id.*

3. PCT Pub. No. WO2004/034350 (“Kim”)

PCT Pub. No. WO2004/034350 (“Kim”) is titled “Television Set and Method for Notifying a Disaster Situation.” Ex. 1008, Cover. Kim was filed Oct. 9, 2003 and published April 22, 2004. *Id.* Kim is directed to an emergency broadcast system that provides alerts on television sets. *Id.*, Abstract. Kim discloses how an emergency signal is transmitted to a television set regardless of the power status of the television. *Id.* at 7:9-14, 3:13-18. The described system is exemplified in Fig. 2:



Ex. 1008, Fig. 2.

Kim discloses that broadcasting stations must transmit a predetermined emergency warning signal or predetermined emergency-warning broadcast data previously determined by a broadcasting station in such a way that an emergency-warning broadcast operation can be executed using the TV set. *Id.* at 6:16-7:9.

B. The Legal Framework for Assessing Unpatentability

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity ... the evidence that supports the grounds for the challenge to each claim”)). The burden of persuasion in an IPR “never shifts to the patentee.” *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). Moreover, a petitioner should not “place the burden on [the Board] to sift through information presented by the Petitioner, determine where each element [of the challenged claims] is found in [the cited references], and identify any differences between the claimed subject matter and the teachings of [the cited references.]” *Google Inc. v. EveryMD.com LLC*, Case No. IPR2014-00347, Paper 9 at 25 (P.T.A.B. May 22, 2014).

A claim is unpatentable under § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the

level of skill in the art; and (4) when in evidence, objective indicia of non-obviousness (i.e., secondary considerations). *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). “To satisfy its burden of proving obviousness, a petitioner cannot employ mere conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

Finally, a petition seeking to establish obviousness based on more than one reference, as is the case here, “must articulate sufficient reasoning with rational underpinnings to combine the teachings.” *Wilson Elec., LLC. v. Cellphone-Mate, Inc.*, Case No. IPR2018-01778, Paper 10 at 15 (P.T.A.B. Apr. 23, 2019) (citing *KSR Int’l*, 550 U.S. at 418).

C. Ground 1: The Petition Does not Establish That Claims 1-6, 8-9, and 11-20 are Obvious Over Downs in View of EDACS

The Petition fails to show that Downs in view of EDACS discloses all the elements of independent claims 1, 11, and 16. As such, the Petition fails to demonstrate that the Challenged Claims are unpatentable based on obviousness and the Board should deny institution under 35 U.S.C. § 314(a).

1. Downs in view of EDACS fail to disclose “monitoring media streams associated with channels in a communication environment.”

Claims 1, 11, and 16 of the '664 Patent recite “monitoring media streams associated with channels in a communication environment.” Ex. 1001, cl. 1, 11, and 16. The '664 Patent illustrates this limitation with the example of an alert that is transmitted on a non-priority channel. Because prior art systems are statically configured, the volume on that non-priority channel may be turned down. All messages received on that channel are played at low volume, resulting in missed alert messages. *See, e.g.*, Ex. 1001 3:29-34. In the claimed system, media streams associated with channels are monitored, and an adjustment is made to how a particular media stream is provisioned in response to the receipt of an alert in one of those media streams. Ex. 1001 cl. 1, 11, and 16.

The Petition points to a combination of Downs and EDACS as disclosing the claim requirement of monitoring media streams, but neither reference in fact discloses that limitation.

The Petition first asserts that the Downs dispatcher console is “informed of the status of transmitters and channels.” Petition at 29. However, being informed of the status of a channel is not the same as monitoring the media streams associated with that channel. Similarly, neither having or collecting information on ongoing

communications nor providing call access to entities requires or means monitoring media streams. *See* Petition at 29.

The Petition then asserts that a POSITA would have understood that Downs' dispatch console monitors "audio talk group signals," citing to disclosure that the console "displays call information" (3:4-26) and displays "the available groups, units, consoles, or channels" on the console monitor (6:24-26). Petition at 28. The Petition asserts that these "audio talk group signals" are media streams associated with channels. *Id.* at 29. As Mr. Williams explains, "Downs takes this information about 'the individual transmitters and channels that are being used, and of the status of other transmitters and receivers in the system,'" and uses it to "provide call access to entities via associated data signals (*media streams*)" that are "programmed by the dispatcher to represent a particular group, unit, console, channel, line, etc. that is available to the console." Ex. 1002 at ¶ 151 (emphasis in original).

But even assuming that "associated data signals" are in fact monitored in Downs, as Mr. Williams later attests, "associated data signals" are not "provisioned" in accordance with the claim. Rather, Mr. Williams points to "**audio** from communication modules assigned to the talk group's signals" as the media stream that is provisioned for the purpose of claim limitation 1[c]. Ex. 1002 at ¶ 163 (emphasis added). In the claimed invention, **media streams** must be **both** monitored

and provisioned. In the Petition and the Williams declaration, “associated data signals” are **monitored** and “audio” is **provisioned**.

The Williams Declaration also argues that the “emergency call requests” disclosed in EDACS would be monitored by the console of Downs. *Id.* However, Mr. Williams posits that an emergency call request is an **alert**. Ex. 1002 at ¶ 157 (“...emergency call requests, each of which would correspond to a claimed alert...”). But the claims require monitoring **media streams**.

As the Petition fails to establish that Downs or EDACS teach the monitoring of anything which is also provisioned, it fails to establish that either reference separately or together teaches the monitoring of media streams. For this reason, Ground 1 fails and the Board should deny institution.

2. The Petition fails to show that the Downs in view of EDACS combination discloses all elements of claims 2-6, 8-9, 12-15, and 17-20

Claims 2-6 and 8-9 depend from independent claim 1, claims 12-15 depend from independent claim 11, and claims 17-20 depend from independent claim 16. Since the remaining claims all depend respectively from independent claims 1, 11, and 16, the entirety of Ground 1 should be rejected, as it is axiomatic that, when the prior art does not demonstrate that an independent claim is unpatentable, it cannot be used to demonstrate that any corresponding dependent claim is also unpatentable. *See Hartness*, 819 F.2d at 1108. Therefore, the Board should deny institution.

D. Ground 2: Claims 1-6, 8-9, and 11-20 Are Not Obvious Over Downs in View Of EDACS And in Further View Of Childress

Petitioner points to Childress as teaching “receiving an alert in one of the media streams,” and not for the “monitoring” limitation disclosed above. Accordingly, Childress cannot save the Petition.

Ground 2 of the Petition fails. Therefore, the Board should deny institution.

E. Grounds 3 and 4: The Petition Does Not Establish That Claims 3-5, 13-14, and 18-19 Are Not Obvious Over Grounds 1 and 2 And in Further View Of Hancock

Hancock similarly is not alleged to disclose the “monitoring” step discussed above, and for that reason does not save the Petition. Therefore, the Board should deny institution.

F. Grounds 5 and 6: Claims 7 and 10 Are Not Obvious Over Grounds 1 and 2 in Further View of Reich

Reich is not alleged to teach “monitoring” and cannot remedy the deficiency described above. Therefore, the Board should deny institution.

G. Ground 7: Claims 1-2, 6-9, 11-12, 15-17, and 20 Are Not Obvious Over Kim

The Petition fails to show that Kim discloses all the elements of independent claims 1, 11, and 16. Each of claims 1, 11, and 16 of the '664 Patent, and the claims depending therefrom, recite “elevating a priority associated with the media stream receiving the alert.” Ex. 1001, cl. 1, 11, and 16. Kim fails to disclose “elevating a priority associated with the media stream receiving the alert.” As such, the Petition

fails to demonstrate that the Challenged Claims are unpatentable. Therefore, the Board should deny institution under 35 U.S.C. § 314(a).

With respect to claim 1, Petitioner argues:

Kim discloses “elevating a priority associated with the media stream [e.g., digital broadcast data] receiving the alert [e.g., emergency-warning broadcast], such that an adjustment is made to how the media stream is provisioned [e.g., adjusting volume of the media stream relative to other broadcast data via audio signal processor 40 or controlling power supply unit 75] to an endpoint in the communication environment [e.g., the viewer’s television].”

Petition, 69.

The primary weakness in Petitioner’s argument is that Kim does not teach **elevating a priority associated with the media stream receiving the alert**. Petition, 69-72. Instead, Kim teaches **changing settings of the endpoint** when an emergency-warning broadcast is received.

In a first example, Kim teaches **changing the channel of the television**. Ex. 1008 at 4:12-16 (“the controller selects a channel of a broadcast signal receiver in order to receive a broadcast signal of a predetermined emergency-warning broadcast channel”). *See also, Id.*, 18:14-17.

In a second example, Kim teaches **increasing the volume of the television**. *Id.*, 20:1-6 (“the volume of the TV system can be automatically increased until reaching a predetermined volume level”).

In a third example, Kim teaches **powering on the television**. *Id.*, 3:13-18 (“although the TV system is powered off, it can be automatically powered on when receiving an emergency-warning broadcast signal, such that people who live in a disaster area can view and listen to an emergency-warning broadcast program configured in the form of caption or newflash data via the automatically-driven TV system”). *See also, Id.*, 22:2-19; 28:19-23.

This distinction matters. Changing the channel of a television to play an alert is **not** the same as elevating a priority associated with the media stream receiving the alert—changing the channel does nothing to elevate the priority of the media stream, it merely allows the already prioritized message to be shown. Increasing the volume of the television is **not** the same as elevating a priority associated with the media stream receiving the alert—it merely makes the output from the television of the already prioritized media stream louder. Powering on a television to play an alert is **not** the same as elevating a priority associated with the media stream receiving the alert—it merely allows the already prioritized message to be shown.

For these reasons, Ground 7 fails and the Board should deny institution.

H. Ground 8: Claims 3-5, 13-14, and 18-19 Are Not Obvious Over Ground 7 in View of Ishibashi

For the claims from which dependent claims 3-5, 13-14, and 18-19 depend, Ground 8 relies on the obviousness analysis of Kim set forth in Ground 7 in view of Ishibashi. (Petition, 80 (“A POSITA would have been motivated to combine, and would have reasonably expected success in combining Kim and Ishibashi to arrive at Claims 3-5, 13-14, and 18-19.”)). The Petition only provides an obviousness analysis with respect to additional limitations of dependent claims 3-5, 13-14, and 18-19 and provides no additional analysis of independent claims 1, 11 or 16. (Petition, 83-89). Since the Petition fails to show a reasonable likelihood that claims 1, 11, and 16 are unpatentable, Ground 8 challenging certain dependent claims also fails to show a reasonable likelihood of success. Ground 8 of the Petition therefore fails to warrant institution and the Board should deny institution under 35 U.S.C. § 314(a).

I. Ground 9: Claim 10 Is Not Obvious Over Ground 7 in View of Goss

For the claim from which dependent claim 10 depends, Ground 9 relies on the obviousness analysis of Kim set forth in Ground 7 in further view of Goss. (Petition, 86 (“A POSITA Would Have Combined Ground 7 with Goss.”)). The Petition only provides an obviousness analysis with respect to additional limitations of dependent claim 10 and provides no additional analysis of claim 1. (Petition, 88-89). Since the

Petition fails to show a reasonable likelihood that claim 1 is unpatentable, Ground 9 challenging this dependent claim also fails to show a reasonable likelihood of success. Ground 9 of the Petition therefore fails to warrant institution and the Board should deny institution under 35 U.S.C. § 314(a).

IV. THE PETITION SHOULD BE DENIED UNDER 35 U.S.C. § 325(d) BECAUSE ALL REFERENCES IN THE PROPOSED GROUNDS ARE CUMULATIVE

At least some of references in the proposed grounds are cumulative to references already cited against the patent in the original prosecutions. 35 U.S.C. § 325(d) provides in part:

...In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.

The grounds proposed for institution are based on substantially similar prior art that was cited to the examiner in the original prosecution of the patent. These arguments have successfully been used to deny institution previously. *See Darfon Electronics Corp. v. Michael Shipman*, IPR2022-01008, Paper 11 at 12 (P.T.A.B. Dec. 2, 2022).

A. Ground 1 References Are Cumulative

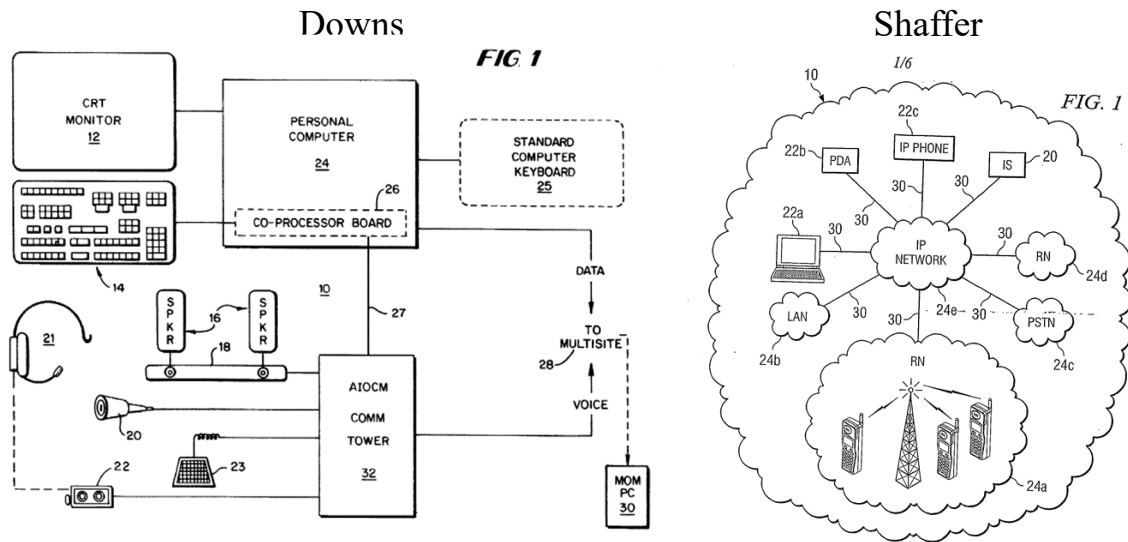
Regarding Ground 1, cited reference Shaffer, International Publication No. WO2007/021586 (Feb. 22, 2007) (Ex. 2001), already discloses a communication

systems in a network, and cited patent publication Biltz, System and Method for Managing Communication Interoperability Switches, 2008/0037461 (Feb. 14, 2008) (Ex. 2002) discloses radio communications and switching between support communications. Shaffer, which is substantially similar in disclosure to Downs and EDACS, configures separate talk groups when a request is received.

A method for automatic configuration of virtual talk groups based on location of media source includes monitoring communications from a plurality of mobile endpoints. Each communication comprises a media message and location information identifying a location of its transmitting endpoint . The method includes selecting a first group of mobile endpoints of the plurality of endpoints according to virtual talk group configuration instructions based on the locations of the mobile endpoints. The method also includes configuring a first virtual talk group comprising the first group of mobile endpoints to facilitate communications among the first group of mobile endpoints. The first group of mobile endpoints comprises mobile endpoints of different communication networks.

Shaffer at Abstract.

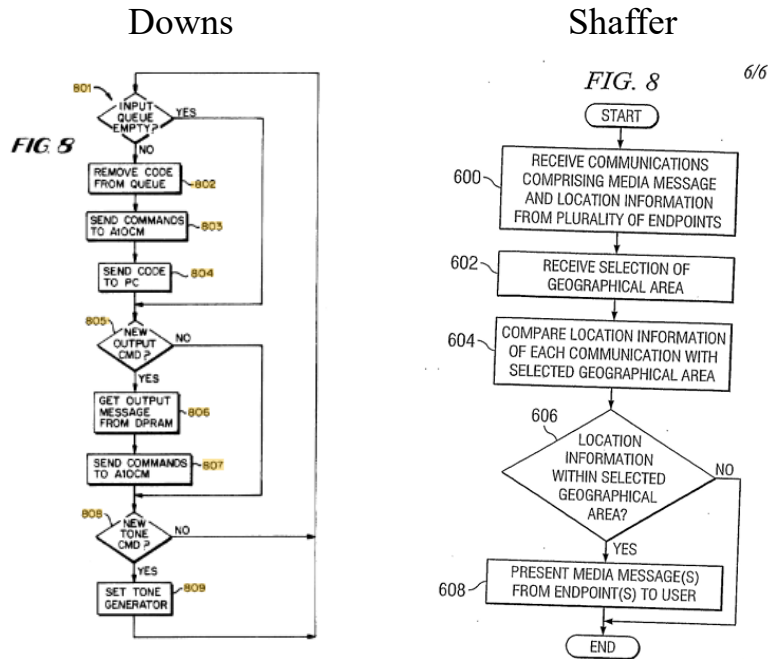
As will be appreciated below, Figure 1 of Shaffer and Figure 1 of Downs disclose substantially similar illustrations of the embodiments.



Downs at Fig. 1; Shaffer at Fig. 1.

Shaffer discloses endpoint surveillance networks working in conjunction with an IP network to facilitate successful cross-communication of users to an individualized end-user (22a). Shaffer at 10:18–11:6. This disclosure is substantially the same as that of Downs for communicating within a network of an end user. Downs at 5:36–45. In Shaffer, an end user (22a) is in communication (30) with a radio network (24d) through a central multisite network (24e). Shaffer at 6:31–7:27. Downs discloses the same connection network with an end user (10) connected to a radio frequency system via a multisite switch (28). Downs at 4:18–29. Both of these systems are intended to communicate with an RF network by an individual end user. See Shaffer 6:31–7:27; Downs at 4:18–35.

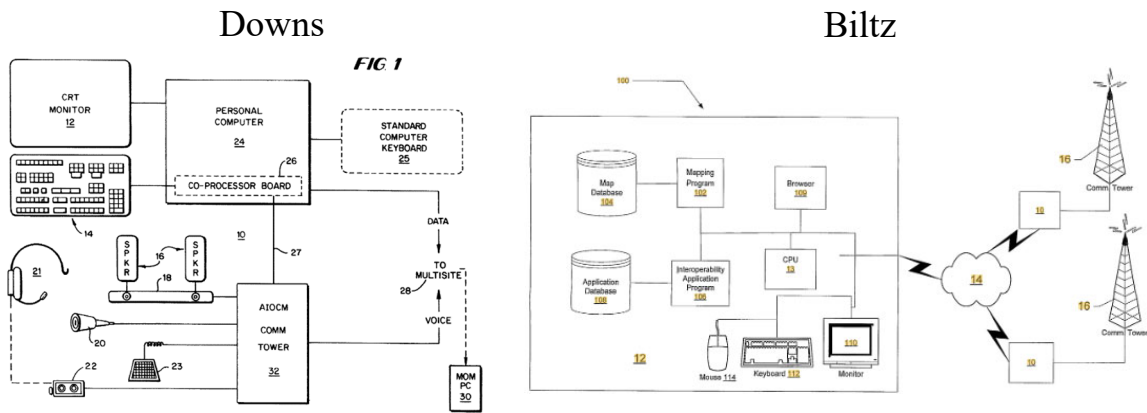
Additionally, the illustrations of the disclosures in Figure 8 of Downs and Figure 8 of Shaffer are substantially similar as can be seen below.



Downs at Fig. 8; Shaffer at Fig. 8.

Both of these method diagrams show substantial similarities by receiving an input from a message or que, sending a command with specific codes, and having an action based on that command. Downs at 9:53–10:7; Shaffer at 44:16–46:12. Specifically, Downs monitors if a code is retrieved (802) and any commands in view of the message are sent to a tower (803), and once acted upon, there is an output command (805). Downs at 9:55–66. This is similar to the method shown in Shaffer. Communication from a plurality of endpoints is received from a location (600), once received, a location tag command is given to the communication (604), and then displayed to user after the location is determined (608). Shaffer at 44:16–46:12. Downs is at least cumulative in light of cited reference Shaffer.

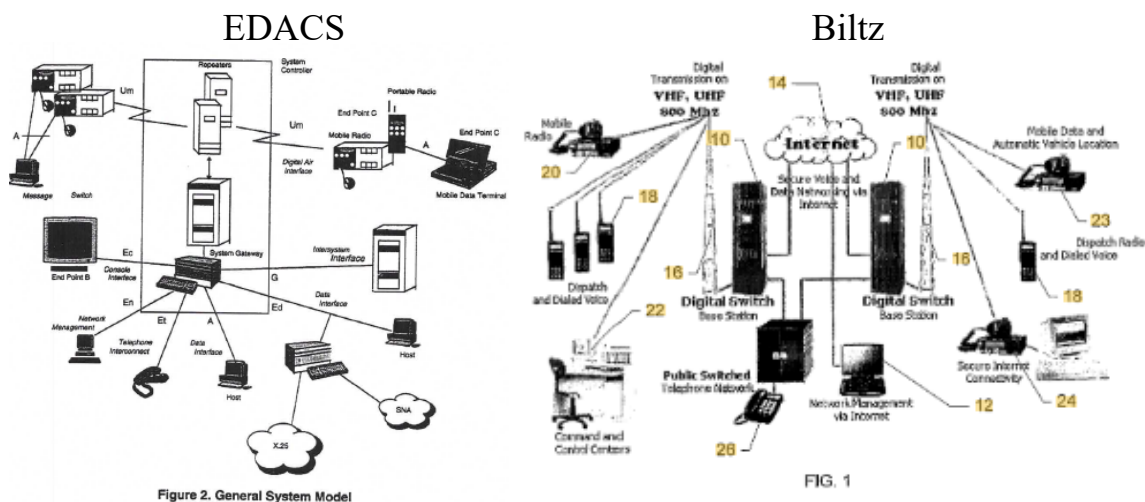
Downs is also cumulative in light of the disclosure in Biltz as shown by Figure 1 of Downs and Figure 2 of Biltz.



Downs at Fig. 1; Biltz at Fig. 2.

Both Downs and Biltz disclose a communication network receiving communications from a multisite network hub and then delivering those communications to an end user. Downs at 4:18–29; Biltz at [0061]–[0062]. Downs discloses a connection network with an end user (10) by a computer (24) connected to a radio frequency system via a multisite switch (28). Downs at 4:18–29. Similarly, Biltz discloses a system (100) that includes a computer (12) connected to a multisite switch (14), which monitors networks. Biltz at [0061]–[0062]. Downs adds nothing more than what has already been presented to the patent office through Shaffer and Biltz.

EDACS is also cumulative. EDACS discloses a communications network similar to the one disclosed in Shaffer and Biltz. As shown below, Biltz's Figure 2 and EDACS Figure 1 disclose substantially similar communication networks.



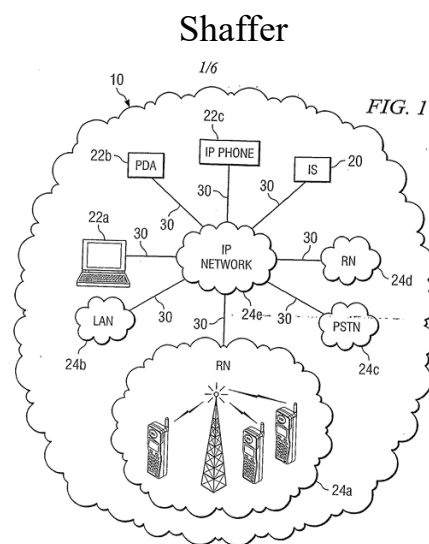
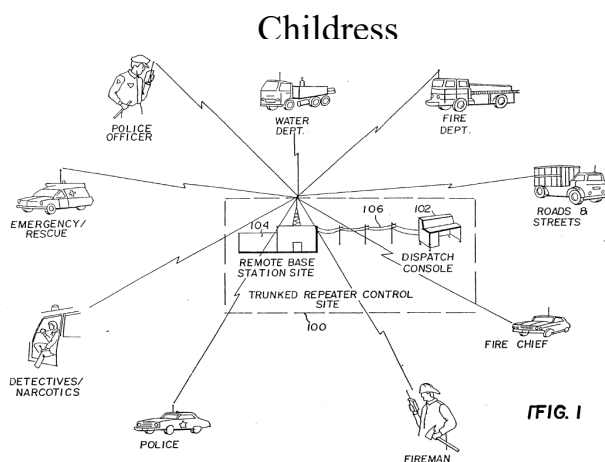
EDACS at Fig. 2; Biltz at Fig. 1.

As can be seen, EDACS discloses a centralized “System Gateway” (G) that communicates with endpoints B and Host users to connect with Mobile Data Terminals and Portable Radios (End Point C). EDACS at Fig. 2, 13–14. Biltz discloses similar aspects to EDACS with a communication system (10) including communication network devices (24a-24e) that are in communication with dispatch radios (18) to connect control centers (22) to these radios via a communication tower (16). Biltz at Fig. 1, [0060].

As such, the IPR references Downs and EDACS, present the same disclosure and are substantially the same art as cited references Shaffer and Biltz.

B. Ground 2 References Are Cumulative

Regarding Ground 2, cited reference Shaffer, International Publication No. WO2007/021586 (Feb. 22, 2007) already discloses a communication systems in a network, and cited patent publication Biltz, System and Method for Managing Communication Interoperability Switches, 2008/0037461 (Feb. 14, 2008) discloses radio communications and switching between support communications. As discussed above, *Supra* § IV.A, EDACS and Downs are substantially similar to cited references Shaffer and Biltz. Childress also fails for similar reasons in light of the cited references and should be considered substantially the same or similar art.

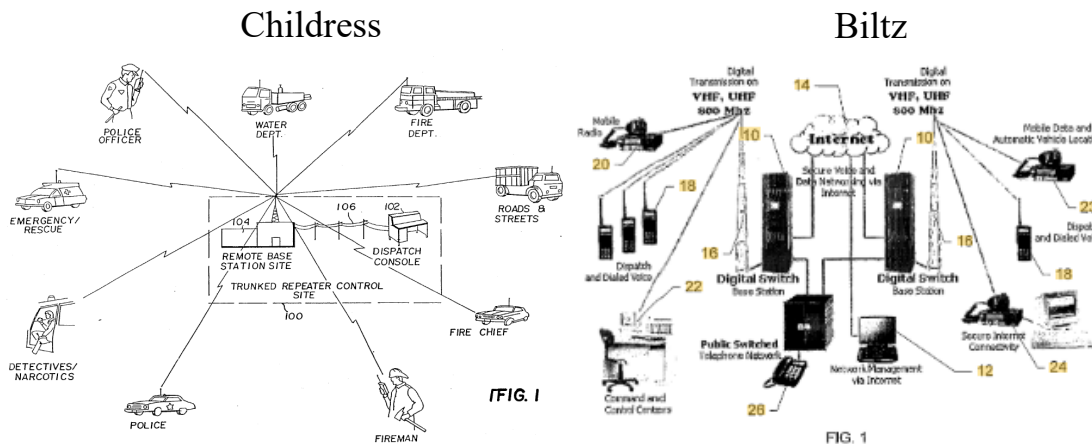


Childress at Fig. 1; Shaffer at Fig. 1.

Childress discloses various groups that communicate (police officer, fireman, fire department, etc.) with each other via a radio channel control site (100) and with a dispatch console (102). Childress at Fig. 1, 11:8–21. This communication setup is

substantially similar to that of Shaffer. Shaffer discloses a control computer (22a) working in tandem as a centralized network (24e) receiving input from other mobile devices (24a). Shaffer at Fig. 1, 10:18–11:6. This disclosure in Childress is substantially similar to that of the cited reference Shaffer.

Additionally, cited reference Biltz offers substantially the same disclosure as Childress by disclosing various communication devices in connection with switches. Biltz at [0060].



Childress at Fig. 1; Biltz at Fig. 1.

As can be seen in Figure 1 of Childress, Childress discloses various groups that communicate (police officer, fireman, fire department, etc.) with each other via a radio channel control site (100) and with a dispatch console (102), which may be located in the station or located in other facilities. Childress at Fig. 1, 11:8–21. This is substantially the same as the network described in Biltz. Biltz discloses a

communication system (10) including communication network devices (24a-24e) that are in communication with dispatch radios (18) to connect control centers (22) to these radios via a communication tower (16). Biltz at Fig. 1, [0060]. As such, the IPR references Downs, EDACS, and Childress, present the same disclosure, and are substantially the same art as cited references Shaffer and Biltz.

For all of the reasons above, the Board should deny institution under 35 U.S.C. § 325(d).

V. THE BOARD SHOULD DENY INSTITUTION UNDER 35 U.S.C. § 314

The *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* (June 21, 2022) (“Interim Procedure”), *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) provides the basis for a discretionary denial in this case. This Petition does not “present[] compelling evidence of unpatentability” with the Petition failing to provide a “compelling, meritorious challenge[]” that is “unrebutted [at] trial.” Interim Procedure at 2, 4. A discussion of each factor is outlined below. *Infra* § V.A-F.

A. Factor 1: Potential Stay

Petitioner has not motioned for any stay in the parallel court proceeding, nor has the judge issued a stay. While the Board should “not attempt to predict how the district court in the related district court litigation will proceed,” this does not

preclude the Board from denying institution. *Sand Revolution II LLC v. Continental Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24 at 7 (P.T.A.B. Jun. 16, 2020). Petitioner cites *Sand Revolution* as a rationale for the Board to grant intuition under Factor 1. However, this citation is not a precedential decision and should not be held out as binding on the Board. Additionally, in *Sand Revolution*, the issue of the concurrent stay was not the only factor used in the analysis in the Board reaching their decision to grant institution. The other factors weighed heavily in favor of granting institution. *See Id.* at 9-12. As such, considering the availability for Petitioner to file for a stay in light of an upcoming claim construction hearing in March (originally set for December 1, 2023), and deciding not to pursue the stay, this factor weighs in favor of denying institution.

B. Factor 2: Trial Date

The trial in the parallel District Court proceedings will commence no later than September 2024, which is at most five months before the due date of a Final Written Decision of this Petition. Ex. 1034, 1. Petitioner waited almost seven months after receiving the initial infringement contentions to file their Petition. Patent Owner has amended infringement contentions with leave of the Court pursuant to facts learned through discovery exchanges, depositions, and other publicly available material and will submit final contentions in line with the District Court's schedule. The Board's final written decision, if instituted, likely will be due on or around

February 2025, which is after the close of fact and expert discovery (closing May 1, 2024 and June 10, 2024, respectively) and after the deadline for dispositive motions (June 17, 2024). *See BOE tech. Grp. Co., Ltd., Beijing BOE Display Tech. Co., and Motorola (Wuhan) Mobility Tech. Comm. Co., Ltd., v. Element Capital Commercial Co. PTE. Ltd.*, IPR2023-00808, Paper 9 at 21–22, 34 (P.T.A.B. Nov. 15, 2023) (denying institution since the trial date was set to occur 6 months prior to the deadline for a FWD). Petitioner offers nothing in the form of evidence to show any trial date later than the agreed upon June 17, 2024 date. *See BOE*, Paper 9 at 21. The median time to trial for the Eastern District of Texas, Marshall Division is 23 months. Ex. 2003. Even if the Board ignores the agreed upon trial date of September 23, 2024, the trial date would still occur on or around August 2024 which is before the statutory deadline for the FWD.

Since a stipulated trial date, as agreed by both parties in the district court case, will commence before the deadline for the FWD, factor two weighs against institution. *See* Ex. 1030, 8–9 (analyzing the proximity of the trial date is not the sole factor, but if other factors weigh in favor of denial then the proximity to trial should be taken into consideration).

C. Factor 3: Investment in the Parallel Proceeding

The parties have invested a considerable amount of time and effort in the parallel district court proceedings. The suit was filed over a year ago in the Eastern

District of Texas, Marshall Division on September 30, 2022. *STA Group LLC v. Motorola Solutions, Inc.*, No. 2:22-cv-00381-JRG-RSP (E.D. Tex. Sep. 30, 2022).

The defendants moved for partial dismissal of the complaint by alleging that the '664 Patent claims ineligible subject matter and that the complaint fails to plausibly allege infringement. The court denied the motion to dismiss on Aug. 11, 2023 by Judge Gilstrap, with Magistrate Judge Payne recommending denial on July 7, 2023. Further, fact discovery is underway with the claim construction hearing set for March 15, 2024. While Petitioner alleges that the Petition was filed with diligence, this Petition was filed approximately six weeks before the statutory bar would have prevented filing of the Petition and five months after service of preliminary infringement contentions. Petition, 91. To that end, both parties have already expended extensive time and effort preparing for the District Court proceeding. The Claim Construction hearing in the District Court case is set for March 15, 2024. Ex. 1034, 3. Both Petitioner and Patent Owner have submitted extensive briefing related to Claim Construction.

Based on this record, the case is beyond its infancy, and the parties are considerably invested in the district court proceedings as depositions are already underway. Accordingly, this factor weighs against institution.

D. Factor 4: Issue Overlap

Petitioner has not stipulated to any agreement related to issues raised in the Petition not being raised in the parallel proceeding. While Petitioner alleges a stipulation in the Petition, no such communication or agreement has been made with Patent Owner at this time. *See* Petition, 92.

In the Interim Guidance, the director stated that “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” Ex. 1030, 3 (citing *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (P.T.A.B. Dec. 1, 2020) (precedential as to § II.A)). Accordingly, this factor weighs against institution.

E. Factor 5: Party Overlap

Petitioner and Patent Owner are both parties in the Parallel Proceeding. This factor weighs against institution. *See Fintiv* Order at 13–14.

F. Factor 6: Other Circumstances Favoring Institution

When the sum of *Fintiv* factors 1-5 favor denying institution, which they do here, the PTAB considers whether the Petitioner presents a challenge with compelling merits. *Samsung Elecs.*, at *6 (citing Interim Procedure, at 4-5). That analysis is provided *supra* Section III above and clearly demonstrates that the

Petition fails to satisfy the heightened burden that it is “highly likely that the petitioner would prevail with respect to at least one challenged claim.” *OpenSky*, at 49 (quoting Ex. 1030, p.4); *see also Samsung Elecs.*, at *6 (“The ‘compelling merits’ standard is a standard higher than that required for institution.”) (citing *CommScope*, at 3). Accordingly, this factor also weighs against institution.

In view thereof, at least *Fintiv* Factors 1 (the lack of a stay entered in the district court litigation), 2 (proximity of the court’s trial date to the Board’s projected statutory deadline), 3 (investment in the parallel proceeding by the court and parties), 4 (overlap of issues in Petition vs. parallel proceeding and a lack of a stipulation), 5 (party overlap) and 6 (lack of merits in the petition) weigh in favor of denying Institution.

VI. CONCLUSION

Petitioner has failed to demonstrate that there is a reasonable likelihood that it would prevail with respect to at least one of the claims challenged in the Petition. The Board should deny institution.

Dated: December 26, 2023

Respectfully submitted,

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Certification of Word Count Under 37 C.F.R. §42.24(d)

The undersigned hereby certifies that the foregoing contains 5,942 words according to the word count of the word-processing software used to prepare the foregoing.

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CERTIFICATE OF SERVICE

I hereby certify that on December 26, 2023, 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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