

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA SOLUTIONS, INC.,

Petitioner,

v.

STA GROUP LLC,

Patent Owner.

IPR2023-01294

U.S. Patent No. 8,831,664 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. 8,831,664 (“’664 Patent”)
1002	Declaration of David H. Williams dated Aug. 21, 2023
1003	File History of the ’664 Patent
1004	U.S. Patent No. 5,754,960 to Stephen R. Downs et al., entitled “Display Console and User Interface for Multisite RF Trunked System” (filed Feb. 14, 1992, and issued May 19, 1998) (“Downs”)
1005	<i>A System and Standards Definition for a Digital Land Mobile Radio System</i> , TSB69, TIA/EIA Telecommunications Systems Bulletin (Nov. 1998) (“EDACS”)
1006	U.S. Patent Publication No. 2006/0147028 A1 to Jerry T. Hancock, entitled “Multi-Mode, Multi-Channel Psychoacoustic Processing for Emergency Communications” (filed Jan. 5, 2005, and published July 6, 2006) (“Hancock”)
1007	U.S. Patent Publication No. 2007/0197248 A1 to Jason A. Reich and Douglas M. Crockett, entitled “System and Method for Multiple Simultaneous Communication Groups in a Wireless System” (filed Feb. 17, 2006, and published Aug. 23, 2007) (“Reich”)
1008	International Patent Publication No. WO 2004/034350 A1 to Chang-Eui Kim, entitled “Television Set and Method for Notifying a Disaster Situation” (filed Oct. 9, 2003, with priority to Oct. 9, 2002, and published Apr. 22, 2004) (“Kim”)
1009	Japanese Patent Publication No. 2006-340164 A to Yoshihiro Ishibashi, entitled “Emergency-Alert Broadcast Receiver and Method for Receiving Emergency-Alert Broadcasts” (filed June 3, 2005, and published Dec. 14, 2006) (Original Japanese Application, Translation, and Translator’s Affidavit) (“Ishibashi”)
1010	U.S. Patent No. 7,330,693 to Stephen Clifford Goss, entitled “Broadcast Channels for Wireless Telephony” (filed Sep. 17, 1999, and issued Feb. 12, 2008) (“Goss”)

Ex[No.]	Description of Documents
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	Opposition to Motion to Dismiss in <i>STA Group LLC v. Motorola Solutions, Inc.</i> , No. 2:22-cv-00381 (E.D. Tex. filed Jan. 17, 2023)
1013	Reply to Motion to Dismiss in <i>STA Group LLC v. Motorola Solutions, Inc.</i> , No. 2:22-cv-00381 (E.D. Tex. filed Feb. 7, 2023)
1014	Declaration of Sylvia D. Hall-Ellis, Ph.D., dated Aug. 20, 2023
1015	Ericsson, <i>Maintenance Manual, EDACS® C3 Maestro™ Console System with Enhanced Audio Enclosure</i> (March 1995) (“ C3 Maestro ”)
1016	Department of Defense, <i>Department of Defense Design Criteria Standard: Human Engineering</i> , MIL-STD-1472F (Aug. 23, 1999) (“ DoD ”)
1017	U.S. Patent No. 5,081,669 to Laura L. Slaninka et al., entitled “Assignable Speakers for Channels at a Trunked Console Operator Position” (filed Aug. 27, 1990, and issued Jan. 14, 1992) (“ Slaninka ”)
1018	Motorola Inc., <i>CENTRACOM Gold Series Classic CRT User's Guide</i> (1998) (“ CENTRACOM ”)
1019	U.S. Patent Publication No. US 2006/0184962 A1 to Scott Allan Kendall et al., entitled “Methods for Controlling Apparatuses Having an Emergency Alert Function” (filed Mar. 30, 2004, and published Aug. 17, 2006) (“ Kendall ”)
1020	U.S. Patent Publication No. US 2007/0107009 A1 to Jin Pil Kim, entitled “Emergency Alert Signaling Method and Digital Television Receiver” (filed Nov. 9, 2006, with priority to Nov. 9, 2005, and published May 10, 2007) (“ Kim ”)
1021	U.S. Patent Publication No. US 2006/0005219 A1 to Garry Owens, entitled “Standby Television Warning System” (filed July 2, 2004, and published Jan. 5, 2006) (“ Owens ”)

Ex[No.]	Description of Documents
1022	Telex-Vega, Signaling Product Company <i>Model C-Soft User Configurable Version USB and Parallel Key Versions Radio Control Console Includes P25 Control Options Version 2.8x, Technical Manual</i> (May 2005) (“ C-Soft ”)
1023	TIA Standard, <i>Project 25 Trunking Control Channel Messages – New Technology Standards Project – Digital Radio Technical Standards</i> , ANSI/TIA-102.AABC-B-2005 (Jan. 12, 2005) (“ P25 Standard ”)
1024	P25 Digital Wireless, <i>Project 25 Statement of Requirements</i> (Mar. 9, 2006) (“ P25 SoR ”)
1025	Telex Communications, Inc. and Vega Signaling Products, <i>Price List</i> (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	U.S. Patent Publication No. US 2004/0070515 A1 to Raymond Burkley et al., entitled “First Responder Communications System” (filed July 2, 2003, and published Apr. 15, 2004) (“ Burkley ”)
1028	European Patent Application No. EP 1,613,105 A1 to Ryan Crawford, entitled “Transmission of Content in a Push-to-Talk System” (filed June 29, 2004, and published Jan. 4, 2006) (“ Crawford ”)
1029	Docket Control Order, <i>STA Group LLC v. Motorola Solutions, Inc.</i> , No. 2:22-CV-0381-JRG-RSP, ECF No.35 (E.D. Tex. Feb. 3, 2023)
1030	Katherine K. Vidal, <i>Memorandum: Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation</i> (June 21, 2022)
1031	U.S. Patent No. 4,905,302 to Jeffrey S. Childress et al., entitled “Trunked Radio Repeater System” (filed June 3, 1987, and issued Feb. 27, 1990) (“ Childress ”)

Ex[No.]	Description of Documents
1032	Parties' Local P.R. 4-2 Disclosure of Preliminary Proposed Constructions of Claim Terms and Preliminary Identification of Extrinsic Evidence
1033	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).
1034	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)
1035	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 '664 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, and the Court adopted the report and recommendation and denied Motorola Solutions, Inc.’s motion on August 11, 2023.

On December 1, 2023, the Court in the EDTX Litigation entered an Amended Docket Control Order (EX1034) 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). EX1034, 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. 8,831,664 on the grounds presented in the petition in IPR2023-01294, 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 EX1035.

The ’664 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
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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:

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Respectfully Submitted,

December 28, 2023

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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 1035 were served on the following counsel of record for Patent Owner at the email addresses listed below.

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