

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 AUTHORIZED REPLY TO PATENT OWNER'S
PRELIMINARY RESPONSE**

TABLE OF CONTENTS

TABLE OF AUTHORITIES	ii
PETITIONER’S EXHIBIT LIST	iii
I. PATENT OWNER’S <i>FINTIV</i> ARGUMENTS ARE MOOT.....	1
II. PO MISCHARACTERIZES THE PETITION AND WILLIAMS DECLARATION (EX1002) REGARDING <i>MEDIA STREAMS</i>	1
III. PO’S SECTION 325(D) ARGUMENTS SHOULD BE REJECTED	2

TABLE OF AUTHORITIES

	Pages(s)
Cases	
<i>Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH</i> , IPR2019-01469, Paper 6 (P.T.A.B. Feb. 13, 2020)	4, 5
<i>Thorne Research, Inc. v. Trustees of Dartmouth Coll.</i> , IPR2021-00491, Paper 18 (PTAB Aug. 12, 2021)	3
<i>Ty Inc. v. Softbelly's, Inc.</i> , No. IPR2020-00689, Paper 10 (P.T.A.B. Sept. 15, 2020)	4
<i>Wolfspeed, Inc. v. Trs. Of Purdue Univ.</i> , IPR2022-00761, Paper 13 (PTAB Mar. 30, 2023)	3

PETITIONER’S EXHIBIT LIST

EXHIBIT¹	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	A System and Standards Definition for a Digital Land Mobile Radio System, 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”)

¹ Citations to issued patents (Exhibits 1001, 1004, 1010, 1017, and 1031) are made by column and line number. Citations to U.S., European, and Japanese patent application publications (Exhibits 1006, 1007, 1009, 1019-1021, and 1027-1028) and Exhibits 1002 and 1014 are made by paragraph number. Citations to International patent application publications (Exhibit 1008) are made by page and line number. Citations to Exhibits 1005, 1012-1013, 1015-1016, 1018, 1022-1026, 1029-1030, and 1033 are to the original page numbering in the exhibits. Citations to Exhibits 1003 and 1011 are to the page number added by the exhibit label.

EXHIBIT ¹	Description of Documents
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 ”)
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, Department of Defense Design Criteria Standard: Human Engineering, 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 ”)

EXHIBIT¹	Description of Documents
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")
1022	Telex-Vega, Signaling Product Company Model C-Soft User Configurable Version USB and Parallel Key Versions Radio Control Console Includes P25 Control Options Version 2.8x, Technical Manual (May 2005) ("C-Soft")
1023	TIA Standard, Project 25 Trunking Control Channel Messages – New Technology Standards Project – Digital Radio Technical Standards, ANSI/TIA-102.AABC-B-2005 (Jan. 12, 2005) ("P25 Standard")
1024	P25 Digital Wireless, Project 25 Statement of Requirements (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")

EXHIBIT¹	Description of Documents
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, Memorandum: Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (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”)
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 from Katharine.Burke@BakerBotts.com (Dec. 27, 2023)

I. PATENT OWNER’S *FINTIV* ARGUMENTS ARE MOOT

Petitioner has provided a *Sotera* stipulation in this proceeding. EX1035. The Director’s June 21, 2022 memorandum indicates that “the PTAB will not discretionarily deny institution” when such a stipulation is made. EX1030, p.3.

II. PO MISCHARACTERIZES THE PETITION AND WILLIAMS DECLARATION (EX1002) REGARDING *MEDIA STREAMS*

Several claims recite “media streams.” *E.g.*, Cl. 1. The Petition explains that the “media streams” each include both voice signals and “associated data signals”—and the resulting streams are both monitored and provisioned, as claimed. Paper 1 (“Pet.”), p.27 (“*media streams* [e.g., continuous voice and associated data signals from talk groups sent to multisite switch 28]”). Patent Owner (“PO”), however, misquotes and mischaracterizes the Petition. Paper 8 (“POPR”), 11-12.

In particular, when addressing Downs, Petitioner’s expert, Mr. Williams, identifies media streams as “voice and data signals.” EX1002, ¶151. In its POPR, PO alters Mr. Williams’ statement and omits “voice and” from the quotation:

POPR, p.11 (emphasis added)	EX1002 at ¶151 (emphasis added)
As Mr. Williams explains, ... [Downs] uses it to “provide call access to entities via associated data signals (media streams) ” ... EX1002 at ¶151	These communication modules thus “provide call access to...entities” such as “an individual trunked radio unit...a radio talk group, or a conventional radio” via voice and associated data signals (<i>media streams</i>)

PO relies on this misquotation to mischaracterize Petitioner’s position, arguing that the Petition *only* focuses on data signals for the claimed monitoring: “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**.” POPR, pp.11-12 (emphasis original). This is incorrect. The Petition (and Mr. Williams) *repeatedly* state that the “media streams” of Ground 1 each include both voice signals and “associated data signals,” and that the media stream receiving the alert is both monitored and provisioned. *See* Pet., pp.27, 29-32, 34, 36, 38, 40, 44, 46; EX1002, ¶¶147, 149-151, 155, 157-158, 161, 163, 165, 169, 174, 181, 182, 192, 197. That is all that is required in the claims.

PO’s mischaracterizations infect other portions of the POPR’s response to Ground 1 as well. For example, PO asserts that Mr. Williams opines that the EDACS prior art monitors an “alert,” but not a “media stream[.]” POPR, p.12. But Mr. Williams actually explains that EDACS discloses media streams that contain alerts—exactly as claimed. EX1001, cl. 1 (“receiving an alert **in** one of the media streams”) (emphasis added); EX1002, ¶¶150, 155, 157-158 (describing the multiple channels in EDACS that support multiple call types to create a media stream); *see also* Pet., pp.28, 31-32; EX1005, Figs. 9, 12. Thus, Downs+EDACS discloses the claims.

III. PO’S SECTION 325(D) ARGUMENTS SHOULD BE REJECTED

PO does not dispute that the references in the Petition’s grounds were *not* considered during prosecution. Instead, PO argues that “[a]t least some of [sic] references in the proposed grounds are cumulative” to those cited during prosecution. POPR, p.17. Importantly, PO does *not* argue that Grounds 3-9

(including Grounds 7-9, which rely on a different primary reference) are cumulative. For this reason alone, exercise of the Board's discretion under §325(d) is unwarranted. Moreover, even for Grounds 1 and 2, PO's arguments fail.

First, PO argues that Downs+EDACS (Ground 1), which the Examiner did not consider, are cumulative to other references (Shaffer (WO2007/021586) and Biltz (US2008/0037461)), which were submitted in IDSs with hundreds of other references over a period of years. EX1003, pp.184 & 152; POPR, pp.17-22. This is insufficient under Part 1. Even assuming Shaffer and Biltz have *some* overlap with Downs and EDACS, there is no evidence that the Examiner considered the portions of Downs and EDACS relied on in the Petition, much less "the same *arguments*" for combinations asserted here. *Wolfspeed, Inc. v. Trs. Of Purdue Univ.*, IPR2022-00761, Paper 13 at 8 (PTAB Mar. 30, 2023) (Director); *see also Thorne Research, Inc. v. Trustees of Dartmouth Coll.*, IPR2021-00491, Paper 18 at 8-9 (PTAB Aug. 12, 2021) (declining to deny petition where only one out of three references in a combination were cited in IDS of challenged patent).

Indeed, Downs+EDACS are not cumulative at least because, unlike Shaffer and Biltz, Downs+EDACS do not disclose the limitation "such that an adjustment is made to how the media stream is provisioned to an endpoint in the communication environment," which was essential to the allowance of claim 1. EX1003, p.19. PO does not dispute this. Instead, PO superficially compares portions of the references

(POPR, pp.18-19) but ignores the parts of Downs+EDACS relied on in the Petition, such as EDACS' Fig. 9 (EX1005), which shows receiving an alert in one of the media streams, and Downs' Fig. 4, which shows an adjustment made to how the media stream is provisioned via "[t]he 'volume settings 86.'" Pet., pp.30-32, 35-36. PO never alleges Shaffer or Biltz has these disclosures, and PO's focus on other irrelevant similarities does not show "substantial similarity." *Ty Inc. v. Softbelly's, Inc.*, No. IPR2020-00689, Paper 10 at 13-14 (P.T.A.B. Sept. 15, 2020) (declining to deny Petition where relevant teachings in Petition are not found in considered art).

Even assuming Part 1 could be satisfied for Downs+EDACS (it cannot), PO's argument fails under Part 2 because the Examiner clearly erred by allowing the claims. "[I]f the record of the Office's previous consideration of the art is not well developed or silent, then a petitioner may show the Office erred by overlooking something persuasive." *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 10 (P.T.A.B. Feb. 13, 2020). Here, there is no record of the Examiner being presented with, much less rejecting, the arguments made in the Petition, let alone in the context of Downs+EDACS. The POPR characterizes the Petition's reliance on Downs+EDACS as merely disclosing "being informed of the status of a channel." POPR, p.10. But Downs+EDACS discloses much more than that including (a) monitoring "information on 'the individual transmitters and channels that are being used,'... 'in an array of

communication module windows,” (Pet., p.29 (citing EX1004, 2:20-23, 3:17-23)); and (b) acting on the information, for example, by detecting a Group Emergency Call alert in one of the media streams, “assign[ing] the highest priority to the talk group,” and broadcasting emergency calls “louder from the dispatcher speakers than other calls,” (Pet., pp.31 (citing EX1005, p.43), 34 (citing EX1004, 6:39-52)). The Examiner never considered such positions.

Second, PO’s argument against Ground 2 and Childress fails for the same reasons. POPR, pp.23-25. PO superficially compares portions of Childress to Shaffer and Biltz but ignores the portions of Childress the Petition actually cites, such as the disclosure of “a ‘Message Trunking’ bit, or a ‘Group Emergency’ ID [that] indicate an *alert* to the receiving unit.” Pet., p.50. Nowhere does PO allege that Shaffer or Biltz have this disclosure. Further, under Part 2, the Examiner clearly erred by allowing the claims. *Advanced Bionics*, Paper 6, at 10. Here again, there is no record of the Examiner being presented with, much less rejecting, the arguments made in the Petition, let alone in the context of Childress’ disclosure of “receiving an alert in one of the media streams.” Pet., p.50 (citing EX1031, 28:42-58). The Examiner never considered such positions.

Respectfully Submitted,

January 18, 2024

/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

*Attorneys for Petitioner, Motorola Solutions,
Inc.*

CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. §42.6(e), the undersigned certifies that on January 18, 2024, a complete and entire copy of the **PETITIONER'S AUTHORIZED REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE** was served on Patent Owner via email at the following correspondence addresses:

Jason.Engel.PTAB@klgates.com

Katy.Allor@klgates.com

Nolan.Hubbard@klgates.com

Samuel.Richey@klgates.com

Date: January 18, 2024

/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

*Attorneys for Petitioner, Motorola Solutions,
Inc.*