

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

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

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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. PATENT OWNER DID NOT MATERIALLY MISCHARACTERIZE
*MEDIA STREAMS***

In the Reply to the Patent Owner's Preliminary Response ("POPR"), Petitioner asserts that Patent Owner ("PO") mischaracterized and misquoted Petitioner's Expert Mr. Williams. Reply to POPR, 1. PO did not materially mischaracterize Mr. William's Declaration and any omission of words or phrases made by PO was inadvertent. No omission was meant to mislead the board. Importantly, PO's argument was always intended to be made in relation to the full and accurate version of Mr. Williams' quote.

PO used Mr. Williams' quote to highlight Petitioner's definition regarding the monitoring of "media streams." The quote from Mr. Williams in the POPR inadvertently omits that media streams include voice in addition to associated data signals. However, the POPR section related to this quote accurately indicates that Downs discloses "'audio talk group signals' are media streams associated with channels." POPR, 11. Despite the inadvertent omission of "voice and" from Mr. Williams' quote, the POPR discusses Downs' inclusion of audio/voice in conjunction with data signals within media streams such that the omission does not materially affect the argument. POPR, 11.

The Petition asserts that "PO relies on this misquotation to mischaracterize Petitioner's position, arguing that the Petition *only* focuses on data signals for the

claimed monitoring...”. Reply to POPR, 1. The inadvertent omission of voice from Mr. Williams’ quote does not change PO’s argument since the POPR acknowledges Downs’ use of voice/audio and data signals. The POPR instead argues that Downs fails to disclose making an adjustment to how a media stream (audio and associated data signals) is provisioned to an endpoint in a communication environment. As argued in the POPR, Downs discloses that the “associated data signals” are only monitored while the “audio” is provisioned through the control of the audio. POPR, 11-12; Downs, 3:4-26 and 6:24-26. If Downs’ media stream comprises audio and associated data signals, as alleged by the Petition and Mr. Williams, an adjustment is not made to how the media stream is provisioned when Downs’ data signals are only monitored. Downs, 5:22-30. The inadvertent omission of voice from Mr. Williams’ statement does not change that Downs’ only monitors, and does not adjust a provisioning of data signals.

PO’s minor mischaracterization was not intended to mislead the board and accordingly does not affect any of the substance of the arguments made by PO in the POPR.

II. PATENT OWNER’S 325(D) ARGUMENT SHOULD NOT BE REJECTED

Petitioner alleges that since PO only discusses EDACS, Downs, and Childress regarding Grounds 1 and 2 in the 325(d) section, then “[f]or this reason alone...the

Board’s discretion under §325(d) is unwarranted.” Reply, 2-3. Petitioner is mistaken as the Board has broad discretion to deny institution under not only 325(d), but the Board may also deny institution on the merits for the Petition failing to establish a reasonable likelihood of success. PO’s omission of the other references for Grounds 3 to 9 in the 325(d) argument does not diminish PO’s 325(d) assertion for Grounds 1 and 2.

Regarding Grounds 1 and 2, Petitioner first alleges that the submission of Shaffer and Blitz with “hundreds of other references over a period of years” negates their validity of being cited in a valid IDS. Reply, 3. Petitioner relies on *Wolfspeed* and *Thorne* as support for their position that there “is no evidence that the Examiner considered” the references asserted. *Id.* This is incorrect. According to *Advanced Bionics*, there is no requirement that the Examiner issue a rejection, only that the “[p]reviously presented art includes art made of record by the Examiner.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 7–8 (P.T.A.B. Feb. 13, 2020)(precedential). As such, Shaffer and Blitz were dutifully cited in IDS and duly considered by the Examiner during prosecution of the ’664 patent and should be considered art of record. *Id.*; *see also Padagis Israel Pharma Ltd. v. Bausch Health Ireland Ltd.*, IPR2023-01114, Paper 18 at 12–13 (P.T.A.B. January 12, 2024); *see further Peloton Interactive, Inc. v. Ifit, Inc.*, IPR2022-00029, Paper 13 at 12–13 (P.T.A.B. April 22, 2022).

Since Shaffer and Blitz are considered art of record, Part 1 of the 325(d) argument assesses whether Downs, EDACS, and Childress are substantially the same as Shaffer and Blitz. Petitioner alleges that Shaffer and Blitz lack some aspects of disclosure, and that this difference is enough to conclude the references are not substantially the same. Reply, 3-4. Direct express disclosure is not the standard for determining substantiality, instead similarity of prior art is sufficient to deny institution. *See Kyak Software Corp. v. International Business Machines Corp.*, CBM2016-00075, Paper 16 at 11–12 (P.T.A.B. December 15, 2016). In a case denying institution under 325(d), the Board stated “[i]n particular, we are unpersuaded by Petitioner’s contention that the references are not cumulative since ‘the primary prior art references used in this Petition disclose an optical transceiver module with integrated optoelectronics, as claimed by the ’795 Patent, rather than an [optical line termination (“OLT”)] device, as disclosed in the primary prior art reference used by the Examiner.’” *Nokia of America Corp. v. Soto*, IPR2023-00680, Paper 10 at 21 (P.T.A.B. Nov. 3, 2023). Petitioner alleges that EDACS and Downs have a volume setting provision which sets it apart from Shaffer and Blitz. Reply, 4. This disclosure can be found in Shaffer noting that some communications are able to be converted to other types of endpoints through different control options. Ex. 2001, 8:19-27. No other argument is made regarding the disclosures and

comparisons of Downs and EDACS to Shaffer and Blitz. Downs and EDACS are accordingly cumulative to Shaffer and Blitz.

Regarding Part 2, Petitioner's position is such that they rely on the Examiner not being presented with the arguments in their Petition. Reply, 4-5. However, this is not the standard for Part 2. "[I]f the alleged error is a disagreement with a specific finding of record by the Office, then ordinarily the petitioner's required showing of material error must overcome persuasively that specific finding of record." *Advanced Bionics*, at 10–11. The Examiner did acknowledge such aspects during the prosecution of the '664 Patent by noting that the art of record "fails to fairly teach or suggest claimed features" including "elevating a priority [in] the media stream" as functionally interconnected. Ex. 1003, 19–20. This material difference over the prior art is squarely what the Examiner considered in allowing the independent claims of the '664 Patent. As such, institution should be denied under § 325(d).

III. 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: January 25, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on January 25, 2024, a true and correct copy of the foregoing was caused to be served electronically on the following counsel of record for Petitioner at the following email addresses:

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