

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
Patent 8,831,664 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 1–20 of U.S. Patent No. 8,831,664 B2 (“the ’664 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 8 (“Prelim. Resp.”). With our authorization, Petitioner filed a Preliminary Reply directed solely to the meaning of two claim terms. Paper 10 (“Prelim. Reply”). With our authorization, Patent Owner filed a Preliminary Sur-reply also limited to the meaning of those terms. Paper 11 (“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 ’664 patent, *STA Grp. LLC v. Motorola Solutions, Inc.*, No. 2-22-cv-00381 (E.D. Tex.) Paper 9, 5; Paper 5, 1.

B. Real Parties In Interest

Petitioner identifies itself, Motorola Solutions, Inc., as the real party in interest. Paper 9, 5.

Patent Owner identifies itself, STA Group LLC, as the real party in interest. Paper 5, 1.

C. The '664 Patent

The '664 patent “relates . . . to a system and a method for providing channel configurations in a communications environment.” Ex. 1001, 1:18–21. The '664 patent explains that in the prior art:

Typically, a management center supports a plurality of channels, where less important channels are rendered to one ear, and channels that are more important are rendered to the other ear. Universally, channels are statically configured, where the volume of each channel can be manually adjusted by an end user. When important information needs to be broadcast, channels should be configured optimally. If the channels are not fully utilized, then messages are not received by their intended recipients.

Ex. 1001, 1:33–42. Thus, according to the '664 patent, it was a challenge “to offer a system or a protocol that offers an effective coordination for channels in a communications environment.” *Id.* at 1:42–46.

The '664 patent discloses a method of “monitoring a plurality of channels provisioned for an endpoint” and “reacting to an alert message by adjusting one of the channels for the endpoint.” Ex. 1001, 2:11–14. Included among possible adjustments are the following: “increasing a volume associated with the channel receiving the alert message,” “changing a spatial direction from which the alert message and an associated media stream are conveyed to the endpoint,” “provision[ing] the alert message

from a left ear to a right ear of an end user of the endpoint,” “determining which is a primary channel of the channels and provisioning the alert message to the primary channel of the endpoint,” “turning a volume down on every other channel besides a channel being used for the alert message,” “using out-of-band signaling,” and “sending the alert message until feedback has been received, which indicates that the alert message has been acknowledged by the endpoint.” *Id.* at 1:15–32.

Alert messages are “meant to connote any type of message or signal that was intended for one or more end users” and “may inform the end users . . . of some situation, or alternatively simply convey some information from a sender.” Ex. 1001, 7:41–46. Alert message could even include “simple conversational exchanges and/or simple correspondence.” *Id.* at 7:46–48.

Figure 5 is reproduced below.

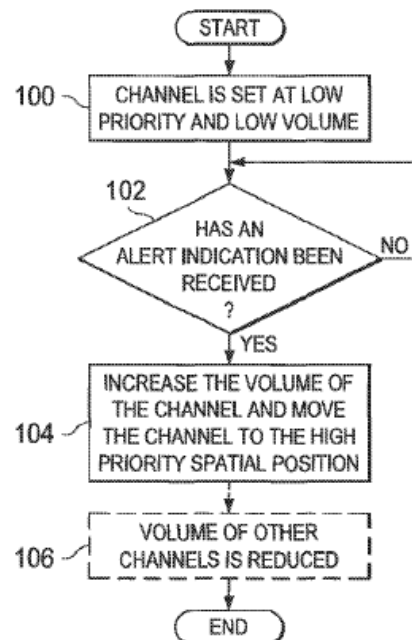


FIG. 5

Figure 5, reproduce above, shows “a simplified flowchart illustrating an example scenario involving communication system 10” and shows

adjustments made at steps 104 and 106 in response to receiving an alert at step 102.

D. The Challenged Claims

Inter partes review is sought for claims 1–20, which are all of the claims of the '664 patent. Pet. 2. Of these, claims 1, 11, and 16 are independent. Claim 1 is reproduced below.

1. A method, comprising:
 - [a] monitoring media streams associated with channels in a communication environment;
 - [b] receiving an alert in one of the media streams; and
 - [c] elevating a priority associated with the media stream receiving the alert, [c'] such that an adjustment is made to how the media stream is provisioned to an endpoint in the communication environment.

Ex. 1001, 8:32–39.¹ Independent claim 11 is directed to “[n]on-transitory readable media that includes code for execution and when executed by a processor operable to perform operations comprising:” [a], [b], and [c]. *Id.* at 8:65–9:5. Independent claim 16 is directed to “[a]n apparatus, comprising: a memory element; a processor; and a management element stored in the memory element and configured to interface with the processor such that the apparatus is configured for:” [a], [b], and [c]. *Id.* at 9:21–10:8. Independent claims 11 and 16 are of somewhat similar scope to claim 1, but do *not* recite limitation [c'], i.e., “such that an adjustment is made to how the

¹ The Petition and Preliminary Response refer to what we have labeled limitations [c] and [c'] as simply limitation [c]. *See, e.g.*, Pet. 32–33; Prelim. Resp. 11. As discussed below, limitation [c'] appears in claim 1 but not in the other independent claims being challenged, i.e., claims 11 and 16. Hence, we label limitation [c'] separately.

media stream is provisioned to an endpoint in the communication environment.”

E. Asserted Patents and Printed Publications

Name	Reference	Ex. #
Downs	US 5,754,960, issued May 19, 1998	1004
EDACS	<i>A System and Standards Definition for a Digital Land Mobile Radio System</i> , TIA/EIA TELECOMMUNICATIONS SYSTEMS BULLETIN (Nov. 1998)	1005
Hancock	US 2006/0147028 A1, published July 6, 2006	1006
Reich	US 2007/0197248 A1, published Aug. 23, 2007	1007
Kim	WO 2004/034350 A1, published Apr. 22, 2004	1008
Ishibashi	JP 2006/340164 A, published Dec. 14, 2006	1009
Goss	US 7,330,693 B1, issued Feb. 12, 2008	1010

In addition to these references, Petitioner relies on a Declaration of David Hilliard Williams. Ex. 1002 (“Williams Decl.”).

F. The Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability:

Ground No.	Claim(s) Challenged	35 U.S.C. §	Basis
1	1–6, 8, 9, 11–20	103(a) ²	Downs, EDACS
2	1–6, 8, 9, 11–20	103(a)	Downs, EDACS, Childress
3	3–5, 13, 14, 18, 19	103(a)	Downs, EDACS, Hancock
4	3–5, 13, 14, 18, 19	103(a)	Downs, EDACS, Childress, Hancock
5	7, 10	103(a)	Downs, EDACS, Reich
6	7, 10	103(a)	Downs, EDACS, Childress, Reich
7	1, 2, 6–9, 11, 12, 15–17, 20	103(a)	Kim
8	3–5, 13–14, 18, 19	103(a)	Kim, Ishibashi
9	10	103(a)	Kim, Goss

Pet. 2.

G. Summary of Key Prior Art References

1. Downs (Ex. 1004)

Downs “relates to a public service radio dispatcher console having a cathode ray tube (CRT) display, customized keyboard, and other user interface devices.” Ex. 1004, 1:39–44. Downs explains that “[r]adio

² 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). The amendment became effective eighteen months later on March 16, 2013. *Id.* at § 3(n). Because the application from which the ’664 patent issued was filed before March 16, 2013, any citations herein to 35 U.S.C. § 103 are to its pre-AIA version. *Id.* at § 3(n)(1).

dispatchers work with radio communication systems that are becoming increasingly complex” and “[t]he number of radio frequency (RF) channels in these systems and the area that a single system covers have increased substantially.” *Id.* at 1:47–51. “Instead of only communicating with a small number of users, radio dispatchers can now communicate with hundreds, if not thousands, of system users.” *Id.* at 1:58–60. Despite this complexity, Downs explains that “dispatchers must be free to concentrate on the substance of the calls, any one of which may be an emergency call.” *Id.* at 2:44–46.

To facilitate such concentration by dispatchers, Downs discloses a CRT display that presents “information on individual communications . . . shown in an array of communication modules,” each of which “provides information on a specific call or group such as the caller, volume, and emergency.” *Id.* at 3:17–24. Downs discloses that “emergency calls are broadcast louder from the dispatcher speakers than other calls” based on the predetermined emergency volume level set by the dispatcher. *Id.* at 6:47–52, Fig. 4.

2. EDACS (Ex. 1005)

EDACS is titled “A System and Standards Definition for a Digital Land Mobile Radio System.” Ex. 1005, 1. The acronym “EDACS” refers to “Enhanced Digital Access Communications System.” *Id.* at 3. EDACS “describes the functional elements of the EDACS System, as well as defining the basic system architecture.” *Id.* EDACS supports emergency calls. *Id.* at 25.

An emergency call is initiated by pressing the emergency button on the radio. Once initiated, the radio immediately

transmits the emergency call request on the inbound control channel. The system receives the request and assigns the emergency call to a free channel. If all channels are busy, the request is placed at the ‘top of the queue,’ where it will be assigned the first available channel. Even on heavily loaded systems, emergency calls are handled quickly and efficiently.

Id.

3. *Kim (Ex. 1008)*

Kim relates to “an emergency-warning broadcast television system for propagating emergency-warning broadcast signals.” Ex. 1008, 1:20–21. Kim discloses using two signal receivers simultaneously, whereby one signal receiver monitors a dedicated emergency-warning broadcast station. *Id.* at 23:2–18, Fig. 5. When an emergency-warning broadcast signal is received, it is processed by the “emergency-warning broadcast signal divider/processor,” and “[t]he TV system’s controller 70” can carry out certain functions in regards to the emergency warning broadcast, including turning the TV on if off, turning to the prescribed channel, increasing the volume, and processing captions for display. *Id.* at 3:22–23, 14:7, Fig. 3.

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*, 815 F.3d

at 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”).

A. Discretion Under 35 U.S.C. § 314

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. 25 (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. 1035. 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.”).

B. Discretion Under 35 U.S.C. § 325

Patent Owner argues that we should exercise our discretion under 35 U.S.C. § 325(d) and deny the Petition in view of “[a]t least some of references in the proposed grounds are cumulative to references already cited against the patent in the original prosecutions.” Prelim. Resp. 17.

In assessing whether to exercise the Board’s authority to deny institution under § 325(d), the Board considers a two-part analysis. *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, No. IPR2019-01469, Paper 6 at 8–9 (Feb. 13, 2020) (precedential). First, in Part One, the Board considers whether “the same or substantially the same” art or arguments were previously presented to the Office. *Id.* at 8. If so, in Part Two, the Board then considers whether the petition demonstrates that the Office “erred in a manner material to the patentability of the challenged claims.” *Id.* In applying the two-part framework, the Board considers several nonexclusive factors set forth in *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, No. IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph).

Patent Owner presents arguments solely for Ground 1 and 2. Prelim. Resp. 17–25. For Ground 1, which is based on Downs and EDACS, Patent Owner argues that each of Downs and EDACS is cumulative of two references that were previously presented to the Office, namely WO2007/021586, published Feb. 22, 2007 (“Shaffer,” Ex. 2001) and US 2008/0037461 A1, published Feb. 14, 2008 (“Biltz,” Ex. 2002). *Id.* at 17–22. For Ground 2, which is additionally based on Childress, Patent Owner argues that Childress also is cumulative Shaffer and Biltz. *Id.* at 23–25.

Petitioner argues that we should not exercise discretion for multiple reasons. First, Petitioner argues that Patent Owner “does *not* argue that Grounds 3–9 (including Grounds 7–9, which rely on a different primary reference) are cumulative” of art or arguments previously presented to the Office. Prelim. Reply. 2–3. This is true and it strongly cuts against Patent Owner’s request that we discretionarily deny the Petition.

Second, Petitioner argues that Patent Owner does not show that the specific teachings of Downs, EDACS, and Childress that are relied upon in the Petition (as opposed to more general aspects) are cumulative of Shaffer or Biltz and that “there is no record of the Examiner being presented with, much less rejecting, the arguments made in the Petition.” Prelim. Reply. 3–5; *see also Advanced Bionics*, Paper 6 at 10 (“[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”). Further, Petitioner points out that Shaffer and Biltz “were submitted in IDSs with hundreds of other references over a period of years.” *Id.* at 3 (citing Ex. 1003, 184, 152); *see also* Ex. 1001, [56] (listing numerous References Cited).

The record before us indicates that (1) none of the asserted references was before the Office during prosecution of the ’644 patent, (2) well over a hundred references were made of record during the prosecution of the ’644 patent, (3) Patent Owner alleges two such references are cumulative of only a minority of the references asserted in the Petition and relate to only a minority of the grounds asserted in the Petition, and (4) Patent Owner has not shown that the Examiner considered any of the purportedly cumulative teachings by Shaffer or Biltz. In view of this record, we are not persuaded to discretionarily deny the Petition.

III. REASONABLE LIKELIHOOD OF PREVAILING

A. Obviousness Generally

A claim is unpatentable “if the differences between the subject matter sought to be patented 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.” 35 U.S.C. § 103(a). “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 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 '664 patent “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.” Pet. 5; *see also id.* (“A person with less or different education but more relevant practical experience, or vice versa, may also meet this standard.”).

“At this stage of the proceeding, Patent Owner does not dispute” Petitioner’s contention regarding a person of ordinary skill in the art. Prelim. Resp. 5. Because Petitioner’s contention appears consistent with the '664 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).

Neither party proposes any express constructions. Pet. 5–6; Prelim. Resp. 4. However, there is a clear dispute between the parties as to the meaning of the claims, as will become evident from our discussion below.

D. Ground 1 (Downs and EDACS)

Petitioner’s Ground 1 contends that claims 1–6, 8, 9, and 11–20 would have been obvious over Downs and EDACS. Pet. 2. The Petition summarizes Downs (Pet. 7–8), summarizes EDACS (*id.* at 8–11), presents reasons for why a person of ordinary skill in the art would have combined Downs and EDACS (*id.* at 22–27), and maps the so-combined prior art to the challenged claims (*id.* at 27–48).

Patent Owner’s arguments against Ground 1 purportedly relate solely to limitation [a], although, as will be discussed below, they additionally relate to limitation [c]. *See* Prelim. Resp. 10 (“**Downs in view of EDACS fail to disclose [a] ‘monitoring media streams associated with channels in a communication environment.’**”); *see also id.* (“Claims 1, 11, and 16 of the ’664 Patent recite ‘monitoring media streams associated with channels in a communication environment.’”).

Patent Owner’s first such argument is that “being informed of the status of a channel,” “having or collecting information on ongoing communications,” and “providing call access to entities” does not constitute “monitoring media streams,” as recited in claims 1, 11, and 16. *See* Prelim. Resp. 10–11 (citing Pet. 29). Patent Owner does not, however, propose a construction for “monitoring media streams,” let alone one that might elucidate the distinction Patent Owner is advancing. Nor is such a distinction apparent based on the claim language. For example, the plain

and ordinary meaning of “monitoring media streams” appears to encompass, among other things, Down’s disclosure that “[t]he dispatcher console is informed of the individual transmitters and channels that are being used and of the status of other transmitters and receivers in the system.” Ex. 1004, 2:20–22; *see also id.* at 3:17–26 (explaining that the display provides caller, volume, and, if applicable, emergency status of each individual communication). The plain and ordinary meaning of “monitoring media streams” appears to also encompass EDACS’s disclosure that its “system receives [an emergency] request and assigns the emergency call to a free channel.” Ex. 1005, 25.

Second, and despite Patent Owner framing its Ground 1 arguments solely in relation to limitation [a], they additionally relate to limitation [c], i.e., “such that an adjustment is made to how the media stream is provisioned to an endpoint in the communication environment.” In that regard, Patent Owner argues:

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**. . . .

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.

Prelim. Resp. 11–12 (*italics added*). One problem with this argument is that limitation [c] does not appear in either of independent claims 11 and 16. Thus, in view of the foregoing, and the Petition’s arguments and evidence, there is a reasonable likelihood of Petitioner prevailing on Ground 1 with respect to at least claims 11 and 16.

Although a reasonable likelihood of Petitioner prevailing on a single claim is sufficient to warrant institution, we additionally address the parties' dispute as to claim 1, which does recite limitation [c'].

Patent Owner argues that, in the combination of Downs and EDACS, as argued by Petitioner and its declarant, “‘associated data signals’ are **monitored** and ‘audio’ is **provisioned**, . . . [b]ut the claims require monitoring of **media streams**.” Prelim. Resp. 12. Patent Owner does not appear to contest that a “media stream” may encompass audio (voice) and an associated data signal, as argued by Petitioner. *See, e.g.*, Pet 27 (“*media streams* [e.g., continuous voice and associated data signals from talk groups sent to multisite switch 28]”); Ex. 1002 ¶151 (“voice and associated data signals (*media streams*)”). Rather, Patent Owner appears to be arguing that claim 1 requires monitoring every aspect of a media stream. Thus, according to Patent Owner, the monitoring of a data signal associated with an audio transmission does not constitute “monitoring media stream[,]” within the meaning of the claims. Such an implicit and narrow construction is not supported by the present record.

There is a reasonable likelihood of Petitioner prevailing on Ground 1 as to claims 1, 11, and 16.

E. Ground 7 (Kim)

Petitioner's Ground 7 contends that claims 1, 2, 6–9, 11, 12, 15–17, 20 would have been obvious over Kim. Pet. 2. The Petition summarizes Kim (Pet. 16–19) and explains how it teaches or renders obvious the subject matter of the challenged claims (*id.* at 66–80).

Patent Owner’s arguments against Ground 7 relate solely to limitation [c], i.e., “elevating a priority associated with the media stream receiving the alert.” Patent Owner acknowledges that Kim teaches, when an emergency broadcast is received, changing the channel of the TV to the channel broadcasting the emergency, increasing the volume of the TV, and even turning the TV on to play the emergency broadcast if the TV is off. Prelim. Resp. 14–15. Patent Owner argues, however, that such actions do not constitute “elevating a priority associated with the media stream receiving the alert,” as recited in the claims. *Id.* at 14. According to Patent Owner, “[i]nstead” of teaching limitation [c], “Kim teaches **changing settings of the endpoint** when an emergency-warning broadcast is received.” *Id.* Patent Owner does not propose a construction of limitation [c] to support its argument. Nor does Patent Owner provide a satisfactory explanation for the distinction it attempts to create. Patent Owner merely provides conclusory statements, as follows:

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.

Id. at 15.

We are not persuaded by Patent Owner’s arguments. That an emergency broadcast arguably has already been prioritized in Kim by the

time the TV is turned on, its channel is changed, or its volume is increased, does not negate that such actions elevate a priority associated with the broadcast emergency. Indeed, some of the actions described in Kim — namely, increasing the volume and changing the channel—are identical to those that Patent Owner concedes meet the claim language. *See* Prelim. Resp. 2 (describing the claimed invention and stating that limitation [c], as well as limitation [c'], are met by “increasing the volume of the media stream . . . or rendering it to a primary channel”).

There is a reasonable likelihood of Petitioner prevailing on Ground 7 as to claims 1, 11, and 16.

F. Remaining Grounds and Claims

In *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018), the Supreme Court held the following:

Section 314(a) [of Title 35] does not require the Director to evaluate every claim individually. Instead, it simply requires him to decide whether the petitioner is likely to succeed on “at least 1” claim. Once that single claim threshold is satisfied, it doesn’t matter whether the petitioner is likely to prevail on any additional claims; the Director need not even consider any other claim before instituting review. Rather than contemplate claim-by-claim institution, then, the language anticipates a regime where a reasonable prospect of success on a single claim justifies review of all.

SAS, 138 S. Ct. at 1356. Thus, because we have decided to grant review of Grounds 1 and 7 as to claims 1, 11, and 16, we do the same for all grounds and all claims challenged under each ground. *Id.*; *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.”).

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. 35 U.S.C. § 314(a).

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 1–20 of U.S. Patent No. 8,831,664 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.

IPR2023-01294
Patent 8,831,664 B2

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