

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE 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 B2

**PETITIONER'S IDENTIFICATION OF NEW SUR-REPLY
ARGUMENTS**

Submitted Electronically

PETITIONER’S EXHIBIT LIST

EXHIBIT	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”)
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”)

EXHIBIT	Description of Documents
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> (Mar. 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 ”)
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 ”)

EXHIBIT	Description of Documents
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 ”)
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 ”)

EXHIBIT	Description of Documents
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, ECF No. 196 (E.D. Tex. Dec. 1, 2023)
1035	Email from Katharine.Burke@BakerBotts.com (Dec. 27, 2023)
1036	Supplemental Claim Construction Order, <i>STA Group LLC v. Motorola Solutions, Inc.</i> , No. 2:22-cv-00381-JRG-RSP, ECF No. 367 (E.D. Tex. June 4, 2024).
1037	Excerpts from Deposition Transcript of Shmuel Shaffer, Ph.D. dated Mar. 7, 2024.
1038	Default Protective Order
1039	<i>Out-band/Out-of-Band Signaling</i> , The Telecommunications Illustrated Dictionary (2nd ed. 2002).

EXHIBIT	Description of Documents
1040	PC Magazine, <i>Definition of: Signaling In/Out-of-Band</i> , PCMag.com (Jan. 19 2008), https://web.archive.org/web/20080119112709/http://www.pcmag.com/encyclopedia_term/0,2542,t=signaling+inout-of-band&i=51333,00.asp (last accessed Aug. 16 2024).
1041	Excerpts from Expert Report of Dr. Matthew A. Pooley Regarding Infringement of U.S. Patent Nos. 8,831,664, and 8,994,830, <i>STA Group LLC v. Motorola Solutions, Inc.</i> , No. 2:22-cv-00381-JRG-RSP (E.D. Tex. May 10, 2024).
1042	Deposition Transcript of Shmuel Shaffer, Ph.D. dated Oct. 1, 2024.

Per the Board’s November 19, 2024, Order (Paper 32), Petitioner submits this identification of new arguments in Patent Owner’s Sur-Reply (Paper 30).

I. Ground 1: Downs-EDACS

In its Sur-Reply, Patent Owner argues for the first time that EDACS (as opposed to the Downs-EDACS combination relied upon in the Petition’s Ground 1) does not disclose monitoring media streams associated with channels in a communication environment. See Paper 30 at 7-10; see also *id.* at 3 (“EDACS does not monitor these media streams”), 7 (“EDACS fails to disclose monitoring media streams (i.e., audio and/or video) associated with channels in a communication environment”), 8 (“EDACS does not monitor media streams”), 10 (“EDACS simply does not monitor media streams”). This argument was not raised in Patent Owner’s Response (Paper 30) for Ground 1. Compare Paper 30 at 7-10 with Paper 19 at 25-37 (arguing, separately, that: (1) “*EDACS* Does Not Disclose or Render Obvious ‘receiving an alert in one of the media streams’” (Paper 19 at 25-31); (2) “*EDACS* Does Not Disclose or Render Obvious ‘elevating a priority associated with the media stream receiving the alert’” (Paper 19 at 31-33); (3) “*Downs* Also Does Not Disclose or Render Obvious ‘elevating a priority associated with the media stream receiving the alert’”) (Paper 19 at 34-36); and (4) “*Downs* Does Not Disclose or Render Obvious ‘an adjustment is made to how the media stream is provisioned to an endpoint’”) (Paper 19 at 36-38)).

II. Ground 7: Kim

In its Sur-Reply, Patent Owner argues that Kim does not render Claim 1 obvious based on claim differentiation between Claim 1 and Claims 11 and 16. *See* Paper 30 at 15-20; *see also id.* at 15 (“Claim differentiation between independent Claim 1 and Claims 11 and 16 support the endpoint of Claim 1 being a separate device”), 16 (“The difference in claim language of Claim 1 and Claims 11 and 16 corresponds to separate embodiments disclosed in the specification of the ’664 patent.”), 19 (“In view of the claim differentiation between Claims 1 and Claims 11 and 16, Claim 1 additionally requires the system to adjust the media stream before the media stream is received by the endpoint.”). This claim differentiation argument was not raised in Patent Owner’s Response (Paper 30) for Ground 7. *Compare* Paper 30 at 15-20 *with* Paper 19 at 48-49 (contending that Patent Owner’s arguments that *Kim* does not teach “an **adjustment** is made to how the media stream is **provisioned to an endpoint** in the communication environment” are “also applicable to the elevating limitations found in claims 1, 11, and 16.”).

November 25, 2024

Respectfully Submitted,
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CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. §§ 42.6(e), the undersigned certifies that on November 25, 2024, a complete and entire copy of the **PETITIONER'S IDENTIFICATION OF NEW SUR-REPLY ARGUMENTS** was served on Patent Owner via email at the following correspondence addresses:

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