UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA SOLUTIONS, INC.,

Petitioner,

v.

STA GROUP LLC,

Patent Owner.

IPR2023-01295
U.S. Patent No. 8,994,830 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. 8,994,830 ("'830 Patent")
1002	Declaration of Nathaniel Polish, Ph. D. in Support of Petition for *Inter Partes* Review of the '830 Patent, with CV attached as Appendix A ("Polish Decl.")
1003	Prosecution File History of the '830 Patent ("'830 Patent File History")
1004	U.S. Patent App. No. 2006/0281471 (published Dec. 14, 2006) ("Shaffer")
1005	U.S. Patent App. No. 2007/0036100 (published Feb. 15, 2007) ("Shaffer '100")
1006	U.S. Patent App. No. 2007/0173273 (published Jul. 26, 2007) ("Gogic")
1007	U.S. Patent No. 8,090,388 (priority date Mar. 20, 2007, issued Jan. 3, 2012) ("Opitz")
1008	*First Line of Defense Glassbreak Detectors by IntelliSense*, Honeywell (2006)
1009	Docket Control Order, *STA Group LLC v. Motorola Solutions, Inc.*, No. 2:22-CV-0381-JRG-RSP, Dkt. 35 (E.D. Tex. Feb. 3, 2023)
1010	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)
1011	U.S. Patent No. 7,113,090 (issued Sept. 26, 2006) ("Saylor")
1012	U.S. Patent No. 5,152,011 (issued Sept. 29, 1992) ("Schwob")
1013	U.S. Patent App. No. 2007/0270172 (published Nov. 22, 2007) ("Kalley")
1014	U.S. Patent App. No. 2008/0108339 (published May 8, 2008) ("Shaffer '339")

Ex[No.]	Description of Documents
1015	*Voice over IP in LMR Environments, Technical Note 2006-5*, Office of Grants and Training Interoperable Communications Technical Assistance Program (ICTAP) (Nov. 2, 2005).
1016	U.S. Patent No. 7,864,716 (priority date Feb. 15, 2007, issued Jan. 4, 2011) ("Manroa")
1017	*Understanding Wireless Communications in Public Safety, A Guidebook to Technology, Issues, Planning, and Management* by Imel et. Al (published Jan. 2003)
1018	*How Wireless IP Communications Supports Fast Emergency Response*, Cisco (published 2007)
1019	*Washington Statewide Communications Interoperability Plan*, Washington State Interoperability Executive Committee (SIEC) (published Apr. 4, 2008)
1020	U.S. Patent App. No. 2007/0076094 (published Apr. 5, 2007) ("Dickerson")
1021	U.S. Patent App. No. 2007/0060144 (published Mar. 15, 2007) ("Mills")
1022	*Spectrum Management Regulations and Procedures Manual*, Federal Aviation Administration (published Nov. 17, 2005)
1023	*In re FCC 04-168, REPORT AND ORDER, FIFTH REPORT AND ORDER, FOURTH MEMORANDUM OPINION AND ORDER, AND ORDER*, Federal Communications Commission (adopted July 8, 2004)
1024	U.S. Patent App. No. 2004/0192313 (published Sept. 30, 2004) ("Otting")
1025	U.S. Patent No. 7,783,316 (priority date Sept. 9, 2004, issued Aug. 24, 2010) ("Mitchell")
1026	U.S. Patent No. 7,260,394 (issued Aug. 21, 2007) ("Welnick")
1027	U.K. Patent App. No. GB2384393 (published July 23, 2007) ("Valentine")
1028	U.S. Patent App. No. 2008/0115174 (published May 15, 2008) ("Nicholl")
1029	U.S. Patent App. No. 2005/0190263 (published Sept. 1, 2005) ("Monroe")
1030	U.S. Patent App. No. 2004/0023635 (published Feb. 5, 2004) ("Impson")

Ex[No.]	Description of Documents
1031	Plaintiff's and Defendant's Local P.R. 4-2 Disclosure of Preliminary Proposed Constructions of Claim Terms and Preliminary Identification of Extrinsic Evidence
1032	Katherine K. Vidal, *Memorandum: Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* (June 21, 2022)
1033	Amended Docket Control Order, *STA Group LLC v. Motorola Solutions, Inc.*, No. 2:22-CV-0381-JRG-RSP, Dkt. 196 (E.D. Tex. Dec. 1, 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 '830 Patent is involved in *STA Group 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 (EX1033) 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). EX1033, 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.*

The ’830 Patent was also asserted against Petitioner in an identical Complaint in *STA Group 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:

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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 5, 2023

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CERTIFICATE OF SERVICE

The undersigned certifies that on December 5, 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 1033 were served on the following counsel of record for Patent Owner at the email addresses listed below.

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