

UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT TRIAL AND APPEAL BOARD

MOTOROLA SOLUTIONS, INC.,
Petitioner,

v.

STA GROUP LLC,
Patent Owner.

Case IPR2023-01295
U.S. Patent No. 8,994,830

PRELIMINARY PATENT OWNER'S RESPONSE

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. THE '830 PATENT	2
A. The Invention of the '830 Patent.....	2
B. Claim Construction	5
C. Level of Ordinary Skill in the Art.....	6
III. THE PETITION FAILS TO ESTABLISH A REASONABLE LIKELIHOOD OF SUCCESS ON ANY CHALLENGED CLAIMS.....	7
A. Summary of the Alleged Prior Art	7
1. U.S. Patent Application Publication No. 2006/0281471 ("Shaffer").....	7
2. U.S. Patent No. 7,113,090 ("Saylor").....	8
3. U.S. Patent Application Publication No. 2007/0173273 ("Gogic").....	9
4. U.S. Patent No. 8,090,388 ("Opitz")	10
B. The Legal Framework for Assessing Unpatentability	11
C. Ground 1: The Petition Does not Establish That Claims 1-5, 7- 19, and 21-24 are Obvious Over Shaffer in View of Saylor.....	13
1. Shaffer in view of Saylor fails to disclose "wherein the at least one video feed is associated with the selected communication channel based on a user policy that identifies one or more video feeds that are relevant to the user when the user accesses the selected communication channel"	13
2. Shaffer in view of Saylor fails to address the relationship between the communication channels and radio frequencies	16

3.	Shaffer in view of Saylor fails to disclose “providing a plurality of radio frequencies on a display of the mobile communication device, each radio frequency being associated with a geographical zone from which a plurality of video feeds associated with the geographic zone are sourced”	19
D.	Ground 2: The Petition Does not Establish That Claims 1-5, 8-19, and 22-24 are Obvious Over Gogic in view of Opitz	27
1.	Gogic in view of Opitz fails to disclose “identifying at least one video feed by selecting the at least one video feed from the plurality of video feeds associated with the geographic zone, wherein the at least one video feed is associated with the selected communication channel based on a user policy that identifies one or more video feeds that are relevant to the user when the user accesses the selected communication channel”	27
2.	Gogic in view of Opitz fails to disclose “providing a plurality of radio frequencies on a display of the mobile communication device, each radio frequency being associated with a geographical zone from which a plurality of video feeds associated with the geographic zone are sourced”	29
IV.	THE PETITION SHOULD BE DENIED UNDER 35 U.S.C. § 325(d) BECAUSE ALL REFERENCES IN THE PROPOSED GROUNDS ARE CUMULATIVE	32
A.	Petitioner’s “virtual talk group” arguments relying on Shaffer and Gogic are substantially the same as those made during examination with respect to Shaffer ‘339 and Kalley.....	32
B.	Petitioner’s “monitoring a selection” arguments relying on Shaffer, Gogic, and Opitz are substantially the same as those made during examination with respect to Kalley.....	34
C.	Petitioner’s “identifying at least one video feed” arguments relying on Saylor and Gogic are substantially the same as those made during examination with respect to Shaffer ‘339.....	35

D.	Petitioner’s “providing access to the identified at least one video feed” arguments relying on Gogic are substantially the same as those made during examination with respect to Shaffer ‘339	37
V.	THE BOARD SHOULD DENY INSTITUTION UNDER 35 U.S.C. § 314	37
A.	Factor 1: Potential Stay	38
B.	Factor 2: Trial Date	38
C.	Factor 3: Investment in the Parallel Proceeding	40
D.	Factor 4: Issue Overlap	41
E.	Factor 5: Party Overlap	41
F.	Factor 6: Other Circumstances Favoring Institution.....	41
VI.	CONCLUSION.....	43

TABLE OF AUTHORITIES

Cases	Page(s)
<i>Abiomed, Inc. v. Maquet Cardiovascular, LLC</i> , IPR2017-01204, -01205.....	19
<i>ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.</i> , 694 F.3d 1312 (Fed. Cir. 2012)	30
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020).....	37, 41
<i>Apple Inc. v. Firstface Co.</i> , No. 2021-1001, 2021 WL 4156323 (Fed. Cir. 2021).....	5
<i>Becton, Dickinson & Co. v. Tyco Healthcare Grp.</i> , 616 F.3d 1249 (Fed. Cir. 2010)	31
<i>Belden Inv. v. Berk-Tek LLC</i> , 805 F.3d 1064 (Fed. Cir. 2015)	30
<i>BOE tech. Grp. Co., Ltd., Beijing BOE Display Tech. Co., and Motorola (Wuhan) Mobility Tech. Comm. Co., Ltd., v. Element Capital Commercial Co. PTE. Ltd.</i> , IPR2023-00808, Paper 9 (P.T.A.B. Nov. 15, 2023).....	38, 39
<i>Cisco Sys., Inc. v. Constellation Techs. LLC</i> , Case No. IPR2014-01179, Paper 7 (P.T.A.B. Feb. 4, 2015).....	24
<i>Curtiss-Wright Flow Control Corp. v. Velan, Inc.</i> , 438 F.3d 1374 (Fed. Cir. 2006)	22
<i>Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.</i> , 800 F.3d 1375 (Fed. Cir. 2015)	11
<i>In re Fritch</i> , 972 F.2d 1260 (Fed. Cir. 1992)	25, 30
<i>Google Inc. v. EveryMD.com LLC</i> , Case No. IPR2014-00347, Paper 9 (P.T.A.B. May 22, 2014).....	12

<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966).....	12
<i>Grit Energy Sols. v. Oren Techs.</i> , 957 F.3d 1309 (Fed. Cir. 2020) (Newman, J., dissenting)	25
<i>Halliburton Energy Services, Inc. v. Schlumberger Technology Corp.</i> , IPR2017–02072, Paper 11 (P.T.A.B. Apr. 12, 2018).....	24
<i>Harmonic Inc. v. Avid Tech., Inc.</i> , 815 F.3d 1356 (Fed. Cir. 2016)	11
<i>Initiative for Medicines, Access & Knowledge (I-MAK), Inc. v. Gilead Pharmasset LLC</i> , IPR2018-00120, Paper 7 (P.T.A.B. May 4, 2018)	24
<i>KSR Int’l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007).....	12, 13
<i>In re Magnum Oil Tools Int’l, Ltd.</i> , 829 F.3d 1364 (Fed. Cir. 2016)	12
<i>NEC Display Solutions of America, Inc. v. Ultravision Tech.</i> , IPR2019-01123, Paper 7 (P.T.A.B. Dec. 2, 2019)	5
<i>OpenSky Indus., LLC v. VLSI Tech. LLC</i> , IPR2021-01064, Paper 102 (P.T.A.B. Oct. 4, 2022).....	42
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005) (<i>en banc</i>)	5
<i>Samsung Elecs. Co. Ltd. v. California Institute of Tech.</i> , IPR2023-00130, Paper 10 (P.T.A.B. May 4, 2023)	42
<i>Sand Revolution II LLC v. Continental Intermodal Group-Trucking LLC</i> , IPR2019-01393, Paper 24 (P.T.A.B. Jun. 16, 2020)	38
<i>STA Group LLC v. Motorola Solutions, Inc.</i> , No. 2:22-cv-00381-JRG-RSP (E.D. Tex Sep. 30, 2022).....	40

<i>In re Stepan Co.</i> , 868 F.3d 1342 (Fed. Cir. 2017)	19
<i>TQ Delta, LLC v. Cisco Systems, Inc.</i> , 942 F.3d 1352 (Fed. Cir. 2019)	24
<i>Wilson Elec., LLC. v. Cellphone-Mate, Inc.</i> , Case No. IPR2018-01778, Paper 10 (P.T.A.B. Apr. 23, 2019).....	12, 13
Statutes	
35 U.S.C. § 103	12, 31
35 U.S.C. § 112	6
35 U.S.C. § 314	2, 13, 26, 37
35 U.S.C. § 325	1, 31, 32, 33, 34, 36, 37

Exhibit List

Exhibit No.	Description
2001	<i>STA Group LLC v. Motorola Solutions, Inc.</i> , Case No. 2:22-cv-00381 (E.D. Tex.), Dkt. No. 187
2002	Kalley et al. (US 2007/0270172) (“Kalley”)
2003	Shaffer et al. (US 2008/0108339) (“Shaffer ’339”)
2004	December 2023 DocketNavigator Time to Trial Statistics in Patent Cases in the United States District Court for the Eastern District of Texas

I. INTRODUCTION

Patent Owner, STA Group LLC (“Patent Owner”), submits this Preliminary Patent Owner Response (“PPOR”) pursuant to 37 C.F.R. § 42.107(a) in response to the *Inter Partes* Review (“IPR”) petition (“Petition”) filed by Petitioner Motorola Solutions, Inc. (“Motorola” or “Petitioner”) for claims 1-5, 7-19, and 21-24 (“Challenged Claims”) of U.S. Patent 8,994,830 (“’830 Patent”, Ex. 1001).

The Board should deny Petitioner’s institution request for several reasons.

First, the Challenged Claims require “the at least one video feed is associated with the selected communication channel based on a user policy that identifies one or more video feeds that are relevant to the user when the user accesses the selected communication channel.” *None* of the references relied upon by Petitioner includes associating a video feed with a communications channel *based on a user policy* that identifies one or more video feeds that are *relevant to the user when the user accesses the selected communication channel*. For this reason, and the additional reasons discussed herein, institution should be denied.

Second, at least some of the references in the proposed grounds are cumulative to references already cited against the patent in the original prosecution. The cumulative nature of the references provides another reason for the Board to deny institution under 35 U.S.C. § 325(d).

Third, other *Fintiv* factors provide a rationale to deny institution. Petitioner has not requested a stay in the parallel district court litigation (“Parallel Proceeding”), there is no stipulation by Petitioner regarding issues asserted in this Proceeding versus the Parallel Proceeding, there will be substantial costs associated with carrying out both proceedings, and the timing of a Final Written Decision (“FWD”) will take place after trial in the Parallel Proceeding. These issues provide independent reasons for the Board to deny institution under § 314(a).

In short, the Petition does not present “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).

II. THE ’830 PATENT

A. The Invention of the ’830 Patent

The ’830 Patent issued on March 31, 2015 from an application filed August 8, 2008. Ex. 1001, Cover. The invention of the ’830 Patent is directed to a method and system for providing access to video streams associated with communication channels in a communication network. *Id.*, Abstract. Independent claims 1 and 15 recite providing available radio frequencies for selection by a user. Each radio frequency is associated with a geographical zone. *Id.* cl. 1, 15. Claims 1 and 15 recite that a plurality of video feeds are associated with each geographic zone. *Id.* cl. 1, 15.

A user selects a radio frequency of the available radio frequencies. The radio frequency is associated with a geographic zone. *Id.* cl. 1, 15. Instead of providing all the video feeds that are associated with the geographic zone, claims 1 and 15 recite that only one or some of the video feeds are identified for providing to the user. *Id.* cl. 1, 15. The identification of the video feeds is made based on a *user policy* that identifies one or more video feeds that are relevant to the user when the user accesses the selected communication channel. *Id.* cl. 1, 15.

The multi-selection feature is described at least in relation to Figure 9, which depicts a GUI that allows a user to select a communication channel, and once that channel is selected, to select a communication frequency. *Id.*, 9:60–10:12. Once the user selects a channel, the frequencies associated with that channel and associated with the user's location may then be selected from a drop-down menu. *Id.*, 10:13–41. Figures 8 and 9 show an exemplary GUI that allows a user to select a communication channel and associated frequency, where policy rules 806 are used for identifying which video feeds can be shown to a user based, for example, on an access policy or a user's role. *Id.*, 9:45–59.

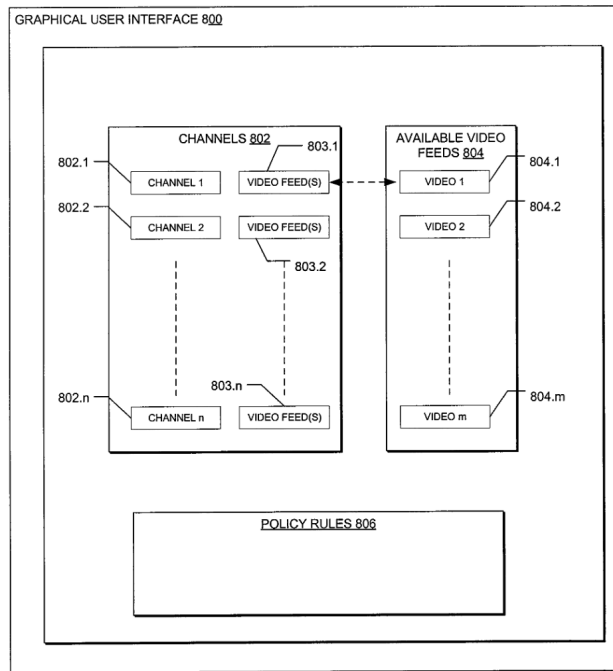


Fig. 8

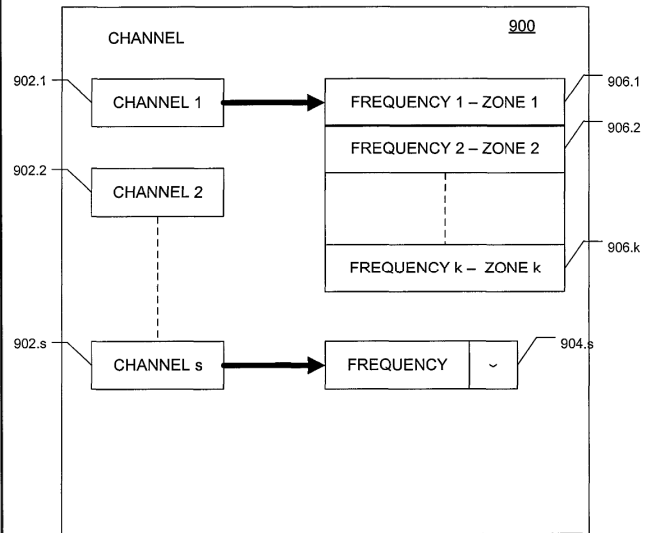


Fig. 9

Ex. 1001, Figs. 8, 9.

The '830 Patent issued with thirty claims, of which claims 1, 15, and 25 are independent. The Petition challenges Claims 1-5, 7-19, and 21-24—the Challenged Claims—under two grounds as detailed below:

Ground	Basis for Challenge
1	Claims 1-5, 7-19, and 21-24 are obvious over Shaffer in view of Saylor
2	Claims 1-5, 8-19, and 22-24 are obvious over Gogic in further view of Opitz

B. Claim Construction

The Petition was filed after November 13, 2018, and, as such, the proper claim construction standard to be applied is articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (*en banc*), in accordance with its regulation, 37 C.F.R. § 42.100(b), *see also Apple Inc. v. Firstface Co.*, No. 2021-1001, 2021 WL 4156323, at *1 (Fed. Cir. 2021).

Therefore, these claims should be “given their ordinary and customary meaning [and] that the ordinary and customary meaning of a claim term is the meaning that the term would have to a [POSA] in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application.” *Phillips*, 415 F.3d at 1312-13 (internal citations omitted); *see also* Ex. 1032. These arguments for claim terms apply for the purposes of this IPR only and without conceding alternative arguments in the counterpart litigations. *See NEC Display Solutions of America, Inc. v. Ultravision Tech.*, IPR2019-01123, Paper 7 at 12-14 (P.T.A.B. Dec. 2, 2019).

In the Parallel Proceeding, the parties agreed on certain constructions:

Term	Agreed Construction
Order of Steps (Claim 1)	The “monitoring a selection of a communication channel” step must be performed before the “identifying at least one video feed by selecting the at least one video feed from the plurality of video feeds” step.
“Push-to-Talk (PTT) channel in a PTT communication network” (Claim 5)	“A channel for transmitting half-duplex communications in a Push-to-Talk communication network”

Ex. 2001, 12, 13-14. In the Petition, Petitioner also proposes a construction of “video stream association module” that invokes pre-AIA 35 U.S.C. § 112, ¶ 6. Patent Owner maintains that the plain and ordinary meaning of the term “video stream association module” applies, and does not concede to the term being governed by pre-AIA 35 U.S.C. § 112, ¶ 6. Regardless, institution should be denied irrespective of the construction applied.

C. Level of Ordinary Skill in the Art

At this stage of the proceeding, Patent Owner does not dispute the proposal provided by Petitioner as to who would qualify as a POSA: an individual “would

have had at least (a) a bachelor’s degree in computer science, electrical engineering, or a similar field, and (b) approximately 2 years industry experience in networking or communication systems, including interoperating different types of networks that include video feeds.” Petition, 13.

III. THE PETITION FAILS TO ESTABLISH A REASONABLE LIKELIHOOD OF SUCCESS ON ANY CHALLENGED CLAIMS

A. Summary of the Alleged Prior Art

1. U.S. Patent Application Publication No. 2006/0281471 (“Shaffer”)

Shaffer was filed June 8, 2005, and published on December 14, 2006. Ex. 1004, Cover. Shaffer describes “a method for communicating using position information.” *Id.*, Abstract, ¶ [0005]. As a user moves from a first location to a second location, the method identifies the updated position of the user and automatically adjusts communication parameters to join and communicate on a communication network at the second location. *Id.*

Shaffer only describes the migration to a second communication network as occurring automatically when the user moves into a new location. *Id.*, ¶¶ [0006]-[0007]. Shaffer also describes an “endpoint 200” that “includes a transmitter/receiver 202, a user interface 204, a processor 206 and a memory module 208.” *Id.*, ¶ [0044]. The “[t]ransmitter/receiver 202 obtains signals from GPS satellites or ground stations of a communication network in order to determine a

position of endpoint 200” so that the endpoint can join the communication network for the geographic location it is presently in. *Id.* “User interface 204 provides a mechanism through which a user of mobile endpoint 200 may operate the endpoint and communicate with other network devices.” *Id.*

“[M]emory module 208 includes network communication parameter listings 210 which contain mappings of communication settings, such as radio frequencies and encryption keys, of communication networks by location.” *Id.*, ¶ [0046]. As the user moves from a first location to a second location, the endpoint 200 finds the relevant radio frequency and encryption key for the new location and automatically selects those parameters to allow the endpoint to communicate on the communication network of the second location. *Id.*, ¶¶ [0049]-[0050], 52 (“As indicated above, technical advantages of particular embodiments of the present invention include utilizing GPS information to adjust parameters of a mobile endpoint and automatically tune its parameters to match local network requirements.”).

2. U.S. Patent No. 7,113,090 (“Saylor”)

Saylor issued on September 26, 2006, from an application filed July 27, 2005. Ex. 1011, Cover. Saylor “provides a personal security network where an individual’s system or systems of security devices maybe connected to a central security network.” *Id.* at Abstract. Saylor allows users to set up “personalized alarms and

alert services” that specify who is to be contacted, the order and method of contact, and the type of situation to be alerted of. *Id.*, 2:26-31. The system further monitors images, and if “a change in images (indicating motion) is detected, an alarm may be signaled” along with the images or video clips of the motion. *Id.*, 2:45-55.

Saylor includes a set of databases that “may store relevant information for personalized alarm services.” *Id.*, 6:9-14. The user’s profile can be created to specify how the user is to be notified in the event of a security alert. *Id.*, 6:19-32. Saylor further states that a notification may be sent to “police, fire department, and/or rescue squads” but that notification to these emergency services occurs after the user is notified and has confirmed the existence of the alert in order to prevent triggering false alarms. *Id.*, 6:31-32, 8:16-28, 12:30-41. The user preferences of Saylor generally relate to determining when, how, and who is contacted in the event of an emergency or security event. *Id.*, 11:4-28.

3. U.S. Patent Application Publication No. 2007/0173273 (“Gogic”)

Gogic published July 26, 2007 from an application filed April 4, 2006. Ex. 1006, Cover. Gogic describes providing group communication services according to proximity to other users of communication devices in a communication system. *Id.*, ¶¶ [0010], [0024]. According to Gogic, an invitation to join a communication group is first disseminated to the other devices “that meet the group membership location

criteria.” *Id.*, ¶¶ [0010], [0014]. Devices that meet the location criteria are configured and/or permitted to accept the invitation. *Id.*, ¶¶ [0011]-[0012]. In another embodiment, an invitation is transmitted and the “group membership location criteria is evaluated at each of the plurality of wireless communication devices receiving the invitation and the communication group is formed by ones of the plurality of wireless communication devices that meet the group membership location criteria.” *Id.*, ¶ [0014].

4. U.S. Patent No. 8,090,388 (“Opitz”)

Opitz issued on January 3, 2012 from an application filed March 20, 2007. Ex. 1007, Cover. Opitz is directed to a communication system that uses a wireless signal to determine a location of the communication system or a component of the communication system. *Id.*, Title, Abstract, 1:8-10. Opitz is an alternative to GPS systems, the functionality of which was not present in many communication systems at that time. *Id.*, 1:44-52. As a vehicle travels from one location to another, Opitz recognizes that regional messages transmitted to a vehicle lose signal strength and relevance as the vehicle moves away from the related location. *Id.*, 2:45-59. Conversely, as the vehicle approaches a new location, the transmission signal strength and relevance of messages related to the new location increase. *Id.*

Opitz teaches being able to determine a current location of a vehicle/communication system based on identification information included in a

wireless communication received by the communication system. *Id.*, 3:16-29. In response to the changing relevance, the vehicle's onboard communication system (e.g., scanning radio) may be configured to scan communication channels known to be associated with the new location. *See id.*, 3:30-4:56 (detailing a vehicle's path through a region, including updating the communication system "according to the availability of communications from communications towers 120 and 162 as vehicle 134 crosses into communication regions 158 and 160."). As the vehicle moves and the relevant and local communication region changes, Opitz teaches a display 248 that "displays identification data corresponding to the channel being monitored by the scanner 136" and that "can be used to select channels which are to be excluded from the scanning list." *Id.*, 5:3-18.

B. The Legal Framework for Assessing Unpatentability

"In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable." *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing § 312(a)(3) (requiring *inter partes* review petitions to identify "with particularity ... the evidence that supports the grounds for the challenge to each claim"))). The burden of persuasion in an IPR "never shifts to the patentee." *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). Moreover, a petitioner should not "place the burden on [the Board] to sift through information presented by

the Petitioners, determine where each element [of the challenged claims] is found in [the cited references], and identify any differences between the claimed subject matter and the teachings of [the cited references.]” *Google Inc. v. EveryMD.com LLC*, Case No. IPR2014-00347, Paper 9 at 25 (P.T.A.B. May 22, 2014).

A claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter 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. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) when in evidence, objective indicia of non-obviousness (i.e., secondary considerations). *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). “To satisfy its burden of proving obviousness, a petitioner cannot employ mere conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

Finally, a petition seeking to establish obviousness based on more than one reference, as is the case here, “must articulate sufficient reasoning with rational

underpinnings to combine the teachings.” *Wilson Elec., LLC. v. Cellphone-Mate, Inc.*, Case No. IPR2018-01778, Paper 10 at 15 (P.T.A.B. Apr. 23, 2019) (citing *KSR Int’l*, 550 U.S. at 418).

C. Ground 1: The Petition Does not Establish That Claims 1-5, 7-19, and 21-24 are Obvious Over Shaffer in View of Saylor

The Petition fails to show that Shaffer in view of Saylor discloses all the elements of independent claims 1 and 15. As such, the Petition fails to demonstrate that the Challenged Claims are unpatentable based on obviousness and institution should therefore be denied under 35 U.S.C. § 314(a).

1. Shaffer in view of Saylor fails to disclose “wherein the at least one video feed is associated with the selected communication channel based on a user policy that identifies one or more video feeds that are relevant to the user when the user accesses the selected communication channel”

Petitioner points to the preferences stored in Saylor’s databases that identify: (i) when to notify users (such as security personnel); and (ii) what to send them as the claimed “user policy.” Petition at 40-41. However, Petitioner fails to point to any mechanism by which Saylor’s stored preferences are used to identify one or more video feeds that are relevant to the user *when the user accesses the selected communication channel*. *Id.* In fact, neither Shaffer, nor Saylor teaches a user policy that identifies one or more video feeds that are relevant to the user when the user accesses the selected communication channel. Because Petitioner fails to address

this claim limitation, and because the cited references fail to teach this claim limitation, Petitioner's argument fails and the Board should deny institution.

The '830 Patent describes that when a user joins a VTG (or selects a communication channel), the video feeds associated with that channel, or only those video feeds relevant to that VTG, are presented to the user. Ex. 1001, 5:38-59. The policy functions to "automatically associate video feeds with a particular group of video feeds, [and] automatically associate groups of feed with channels, VTGs, or the like" *Id.*, 5:60-64. These claim elements are important to achieve the objectives of the '830 Patent in the context of the highly complex communication networks to which it relates.

Petitioner argues that Saylor teaches "a set of preferences stored in Saylor's databases identifying when to notify users (such as security personnel) and what to send them" based on some determination of "which alarms are relevant to the users." Petition, 40-41 (citing Ex. 1011, 8:34-60, 12:34-41). However, Saylor's "user preferences" are not used to identify one or more video feeds that are relevant to a user *when a user accesses the selected communication channel*, as recited in claims 1 and 15.

Petitioner's best argument on this point is with reference to the following disclosure in Saylor:

A subscriber may register for certain video clip notifications which are triggered when an event of interest occurs. For example, a subscriber may request notification when a front door opens, and request that the notification include a video clip of the front door at the time it was opened. The subscriber may also request a video link or other image data when an unrecognized person enters. According to another example, if an internal motion is triggered but no door has opened and video analysis suggests that a human is inside, the subscriber may request an alert notification with a single frame clip.

Ex. 1011, 33:66-34:9.

In this example, Saylor’s “user policy” includes a user request to receive a video clip as a notification when the front door is opened. It would be entirely fair for Petitioner to argue this description is an example of a user policy that identifies one or more video feeds that are relevant to the user. However, Petitioner cannot, and notably does not, argue that this is an example of “a user policy that identifies one or more video feeds that are relevant to the user *when the user accesses the selected communication channel.*” Petition at 40-41.

An observant reading of Petitioner’s arguments on this point shows the care Petitioner took to avoid addressing the “when the user accesses the selected communication channel” portion of the claim limitation. *Id.* For example, page 41 of the Petition provides Petitioner’s only description of what happens in the purported Shaffer-Saylor combination *when* the user accesses the selected

communication channel. *Id.* 41. Here Petitioner describes “when the security personnel selects a communication channel associated with the multicast IP address, as described in limitation 1[a], the officer can access the transmitted communications, as described in Shaffer. Ex. 1002, ¶ [0107]; Ex. 1004, ¶¶ [0040]-[0042].” *Id.* Note that there is no reference to Saylor, there is no reference to the operation of a user policy, there is no reference to the identification of the one or more video feeds relevant to the user. *Id.* The Petitioner does not make these arguments because the combination of Shaffer and Saylor simply do not teach “a user policy that identifies one or more video feeds that are relevant to the user when the user accesses the selected communication channel.”

Petitioner completely fails to argue that a combination of Shaffer and Saylor teach “a user policy that identifies one or more video feeds that are relevant to the user *when the user accesses the selected communication channel.*” This is because no combination of Shaffer and Saylor teach this claim limitation. Accordingly, the Board should deny institution.

2. Shaffer in view of Saylor fails to address the relationship between the communication channels and radio frequencies

The proposed Shaffer-Saylor combination further fails to address the multiple communication channels and multiple radio frequencies claimed in the '830 Patent. More specifically, claims 1 and 15 of the '830 Patent each recite “monitoring a

selection of a communication channel” and “monitoring a selection of a radio frequency,” implicitly requiring that multiple communication channels and radio frequencies exist or else no selection would be necessary.

The '830 Patent clearly draws a distinction between “communication channels” and associated “communication frequencies.” *See* Ex. 1001, 9:60–65. In the '830 Patent, as a user selects a communication channel, a drop down of a plurality of available radio frequencies becomes available, with each frequency corresponding to a difference geographic zone. *Id.*, 9:60–10:41. In one specific example, “a user may select a specific VTG by selecting one of the channels 902.1-902.s. Thereafter, a frequency associated with a region in which the user is located may be selected using the drop down menus. Thereafter, in an automated manner without human intervention, groups of video feeds (e.g., surveillance cameras) may then be accessible to the user.” *Id.*, 10:14–24. Pictorially, this could look like the example GUI depicted in Fig. 9, reproduced below:

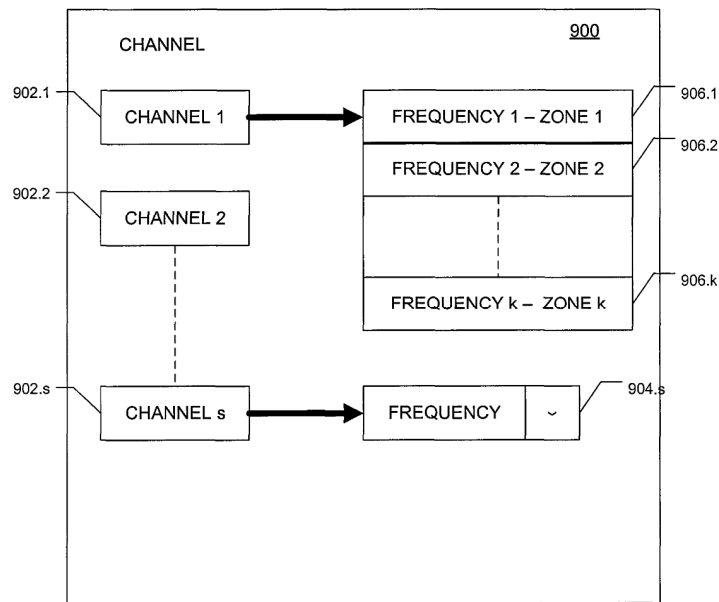


Fig. 9

Ex. 1001, Fig. 9. Once a channel, e.g., channel 1, is selected, the associated frequencies, e.g., frequency 1-frequency k, become available for selection. Independent claims 1 and 15 recite both “monitoring a selection of a communication channel,” e.g., channel 1-channel s, and “monitoring a selection of a radio frequency,” e.g., frequency 1-frequency k.

Shaffer operates entirely different than the recitations of claims 1 and 15 of the '830 Patent. Even if the Board accepts Petitioner's conclusory assertions that Shaffer teaches both communication channels and radio frequencies, the Petition is still deficient because it fails to include both in any embodiment or provide any reason to combine the “communication channels” and “radio frequencies” supposedly taught be Shaffer in a single embodiment. Put differently, the “multicast

IP address” embodiment depicted in Shaffer Fig. 3 (*see* Petition, 30-31) is a distinct embodiment from the “radio frequency” embodiment depicted in Shaffer Figs. 4 and 2 (*see* Petition, 32-34), and the Petition does nothing to explain how or why a POSA would combine these distinct embodiments. *Abiomed, Inc. v. Maquet Cardiovascular, LLC*, IPR2017-01204, -01205, Paper 9 at 9 (P.T.A.B. Oct. 23, 2017) (denying institution for failure to explain why a POSITA would combine embodiments in a single reference); *see also In re Stepan Co.*, 868 F.3d 1342, 1346 at n.1 (Fed. Cir. 2017).

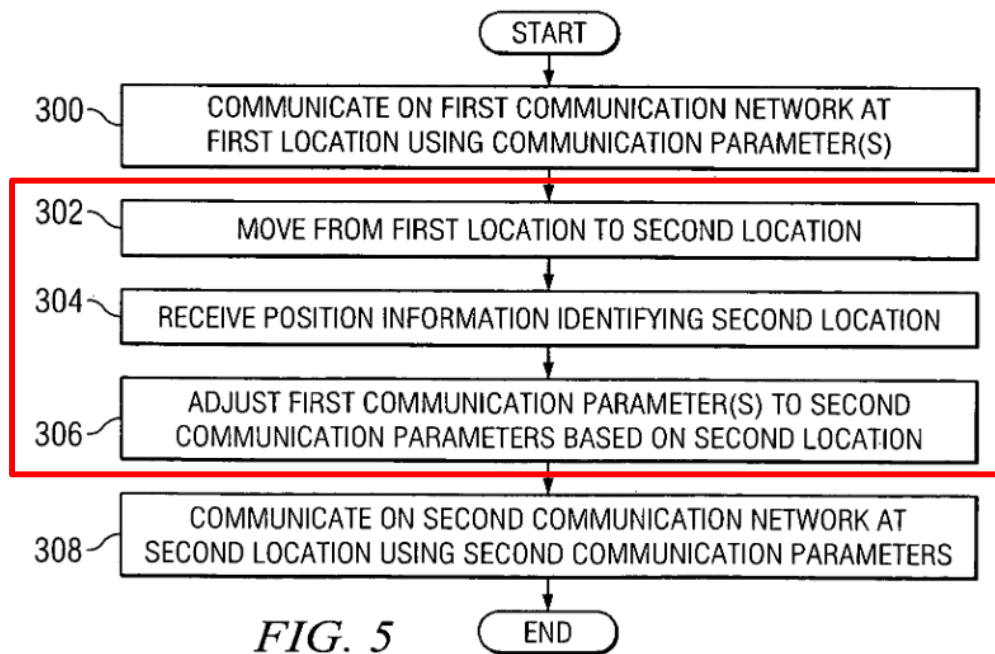
3. Shaffer in view of Saylor fails to disclose “providing a plurality of radio frequencies on a display of the mobile communication device, each radio frequency being associated with a geographical zone from which a plurality of video feeds associated with the geographic zone are sourced”

Claims 1 and 15 of the ’830 Patent each recite “providing a plurality of radio frequencies on a display of the mobile communication device, each radio frequency being associated with a geographical zone from which a plurality of video feeds associated with the geographic zone are sourced.” Ex. 1001, cl. 1, 15.

The Petition relies exclusively on Shaffer to argue this limitation is obvious. Petition, 32–35, 54. In particular, the Petition points to Figure 4 of Shaffer, which shows an endpoint 200 with a memory 208 that includes a communication parameter listing 210. *Id.* 33; *see also* Ex. 1004, ¶ [0046]. Petitioner notes that “Shaffer

describes that a user's device can *store* a plurality of radio frequencies associated with geographical zones." Petition, 32, 33. Petitioner strains the reference in an attempt to argue that the stored plurality of radio frequencies are ever presented to a user on a display of the endpoint 200. *Id.*, 34. Shaffer includes no such teaching.

Instead, Shaffer teaches that the radio frequencies associated with a geographical zone are stored in memory, and are *automatically* selected when a user enters a geometric zone as determined by the device's GPS radio. Ex. 1004, ¶¶ [0047] ("as an endpoint moves into a new location, it may recognize the new location through GPS technology and automatically adjust its communication settings (e.g., radio frequency and/or encryption key) to allow its user to communicate on a communication network of the location."), [0035], [0050]. Indeed, this is clearly depicted in steps 302, 304, and 306 in Figure 5 of Shaffer, reproduced below.



Id., Fig. 5, ¶ [0050].

In other words, Shaffer teaches *storing* radio frequencies associated with a geometric area and selecting stored radio frequencies *based on GPS location*. *Id.*, ¶¶ [0046]-[0047]. This automatic parameter selection is distinguishable from, and does not render obvious, the claimed “providing a plurality of radio frequencies on a display of the mobile communication device, each radio frequency being associated with a geographical zone from which a plurality of video feeds associated with the geographic zone are sourced.”

In support of its bare assertion that “Shaffer further discloses that the radio frequencies are provided by the memory of the mobile communication device to a display on the user interface of the mobile communication device,” Petitioner relies

on (1) user interface 204 of Shaffer, and (2) unsupported and conclusory assertions of its purported expert. Petition, 34-35. Petitioner claims interface 204 of Shaffer “presents frequencies to the user so that ‘through interface 204 a user may input instructions regarding adjustment of the end point’s communication settings (e.g., radio frequency, modulation method and encryption key) upon entering a new communication network.’” Petition, 34-35 (quoting Ex. 1004, ¶ [0044]). However, Shaffer does not actually teach this.

In addition, the added steps of identifying a geographical location of the user’s mobile communication device and automatically rendering access to the video feed associated with the user’s geographic location, as recited in dependent claims 11 and 24, confirms that this restriction cannot also be a limitation on independent claims 1 and 15. *Curtiss-Wright Flow Control Corp. v. Velan, Inc.*, 438 F.3d 1374, 1380 (Fed. Cir. 2006) (under the doctrine of claim differentiation, there is a “presumption that an independent claim should not be construed as requiring a limitation added by a dependent claim.”). As detailed above, Shaffer deals squarely with automatic selection of a communication network based on the device’s GPS location. Ex. 1004, ¶¶ [0047] (“as an endpoint moves into a new location, it may recognize the new location through GPS technology and automatically adjust its communication settings (e.g., radio frequency and/or encryption key) to allow its user to communicate on a communication network of the location.”), [0035], [0050], Fig.

5. Petitioner’s reliance on Shaffer is, therefore, inapposite, because the disclosure fails to address the limitations of independent claims 1 and 15.

Regarding the claimed “providing a plurality of radio frequencies on a display of the mobile communication device,” Petitioner points to interface 204 of Shaffer. Shaffer, however, merely describes how interface 204 “may comprise a...display” and that interface 204 allows a user “to input instructions regarding adjustment of the endpoint’s communication settings.” Ex. 1004, ¶ [0044]. Shaffer does not teach providing a plurality of radio frequencies on interface 204, as required by claims 1 and 15. Even if the ability to adjust radio frequencies through interface 204 were the claimed “providing a plurality of radio frequencies on a display,” which it is not, there is indisputably no teaching in Shaffer that the displayed radio frequencies are associated with a geographical zone, which is also recited in claims 1 and 15.

Shaffer’s “adjustment of the end point’s communication settings” is distinguishable from the claimed invention’s “providing a plurality of radio frequencies on a display.” Indeed, the only support mustered in the Petition for the notion that Shaffer teaches “that the radio frequencies are provided by the memory of the mobile communication device to *display* on the user interface of the mobile communication device” is Petitioner’s declarant. Petition, 34 (citing Ex. 1002, ¶ [0099]) (emphasis in original). Petitioner’s declarant, Dr. Polish, does nothing in his declaration to show how or why the “adjustment of the end point’s communication

settings” disclosure of Shaffer renders obvious the claimed “providing a plurality of radio frequencies on a display.” Ex. 1002, ¶¶ [0096]-[0100].

Indeed, Dr. Polish’s declaration, at least with respect to this limitation, simply parrots the Petition without providing any objective proof for the bare assertion therein. *Compare* Petition, 34-35 with Ex. 1002, ¶ [0099]; *see also Initiative for Medicines, Access & Knowledge (I-MAK), Inc. v. Gilead Pharmasset LLC*, IPR2018-00120, Paper 7 at 21 (P.T.A.B. May 4, 2018); *Halliburton Energy Services, Inc. v. Schlumberger Technology Corp.*, IPR2017-02072, Paper 11 at *18 (P.T.A.B. Apr. 12, 2018). This lackluster declaration cannot remedy the deficiencies of the Petition as a matter of law. *TQ Delta, LLC v. Cisco Systems, Inc.*, 942 F.3d 1352, 1359 (Fed. Cir. 2019) (“conclusory expert testimony is inadequate to support an obviousness determination”); *Cisco Sys., Inc. v. Constellation Techs. LLC*, Case No. IPR2014-01179, Paper 7 at 13-16 (P.T.A.B. Feb. 4, 2015). As such, Dr. Polish’s conclusory assertions should be given little to no weight, and fail to remedy the flaws of the Petition.

Even if the Board accepts the conclusory, unsupported assertion regarding Shaffer’s user interface, it is even more farfetched to stretch the teaching of Shaffer to cover the display providing radio frequencies where “each radio frequency [is] associated with a geographical zone.” Ex. 1001, cls. 1, 15. The only disclosure in Shaffer regarding the user interface is in paragraph 44, which states:

User interface 204 provides a mechanism through which a user of mobile endpoint 200 may operate the endpoint and communicate with other network devices. For example, through interface 204 a user may input instructions regarding adjustment of the endpoint's communication settings (e.g., radio frequency, modulation method and encryption key) upon entering a new communication network. Interface 204 may comprise a keypad, display, touch screen, audio input or any other suitable interface. Instructions may be submitted through speech recognition, collection of keystrokes, soft key or otherwise.

Ex. 1004, ¶ [0044]. This lone teaching in Shaffer does not even hint at the display providing a plurality of frequencies each associated with a geographical zone. Instead, it merely suggests a user can adjust communication settings when a user enters a new communication network. *Id.* Expanding the disclosure of Shaffer to cover the claimed invention is clearly only achieved through the use of impermissible hindsight. *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.”); *see also Grit Energy Sols. v. Oren Techs.*, 957 F.3d 1309, 1326–27 (Fed. Cir. 2020) (Newman, J., dissenting) (“It is inappropriate to edit a reference to remove its explicit limitations, and then to apply the judicially-enlarged disclosure as prior art.”). Thus, Shaffer does not render claims 1 or 15 obvious.

Finally, the claimed plurality of radio frequencies provided on a display are not limited to a single geographic region, and instead allows users to select cameras of any location.

FIG. 9 shows a GUI 900 in accordance with an example embodiment, to allow a user to select a communication frequency associated with a communication channel. The GUI 900 is shown to include a plurality of channel identifiers 902.1-902.s, each of which has an associated frequency drop-down menu (see drop-down menu 904.s). For example, when a user selects a drop-down menu associated with the first channel 902.1, it is expanded to provide a plurality of available frequencies to which channel 1 may be tuned (see expanded drop-down menu 906). The expanded drop-down menu 906 is shown to include a first frequency 906.1 *associated with a first zone*, a second frequency 906.2 *associated with a second zone* and so on.

Ex. 1001, 9:60-10:5.

The opposite is true of Shaffer's display, the only display relied upon in the Petition in support of this limitation. Petition, 34-35. Shaffer discloses, "[i]n some cases one or more interface actions, such as the pressing of a key stroke, and/or predefined instructions may be used to adjust endpoint communication settings transmitted by CCP 80 *based on location information* to allow communication between mobile endpoint 74 and devices of a communication network *as the endpoint moves into the network's area*." Ex. 1004, ¶ [0035]. Shaffer is limited to

providing information from the user's current geometric location and providing access to video feeds in that geographic location. The Challenged Claims are not so limited. For these reasons, Ground 1 fails and the Board should deny institution.

D. Ground 2: The Petition Does not Establish That Claims 1-5, 8-19, and 22-24 are Obvious Over Gogic in view of Opitz

The Petition fails to show that the combination of Gogic and Opitz discloses all the elements of independent claims 1 and 15. As such, the Petition fails to demonstrate that the Challenged Claims are unpatentable based on obviousness and institution should be denied under 35 U.S.C. § 314(a).

- 1. Gogic in view of Opitz fails to disclose “identifying at least one video feed by selecting the at least one video feed from the plurality of video feeds associated with the geographic zone, wherein the at least one video feed is associated with the selected communication channel based on a user policy that identifies one or more video feeds that are relevant to the user when the user accesses the selected communication channel”**

Regarding claim limitation 1[c] (and 15[e]), Petitioner relies on Gogic to disclose the claimed “user policy.” As recited in claims 1 and 15, a communication channel is associated with video feeds. The user policy is used to identify one or more video feeds that are relevant to a user when the user accesses a communication channel. As such, the user policy limits the video feeds to those available in the communication channel that are relevant for the user.

The Petitioner attempts to equate Gogic’s “group membership location criteria” with the “user policy” of claims 1 and 15. Petition, 65 (citing Ex. 1006, ¶ [0062]). However, Gogic only applies its location-based criteria to “allow users to join an ad-hoc group only if they are within a certain area.” Petition, 65-66. This is not a “user policy” that identifies one or more video feeds associated with a communication channel that are relevant to a user, as recited in claims 1 and 15.

Gogic does not mention the terms “user policy” or “policy” at all, let alone as a mechanism for identifying one or more video feeds that are relevant to the user when the user joins the communication channel. Instead, Gogic’s only concern is with creating communication groups for communication devices (“CDs”) based on locations of users. *See* Ex. 1006, ¶ [0062]. Indeed, according to Petitioner, the only purported relationship between the “group membership location criteria”—which Petitioner calls the user policy—and the video feeds is the conclusory assertion that the location criteria “identif[ies] one or more video feeds that are relevant to the user when the user accesses the communication channel.” Petition, 67 (citing only Ex. 1002, ¶ [0172]). Petitioner ignores the fact that Gogic fails to describe any selection process for identifying a selection of video feeds as being relevant to a user. The truth is Gogic’s sole selection process is to identify which users can connect to the communication group based on their geographic location.

Said plainly, Gogic uses location information (which Petitioner argues is a user policy) to form an ad-hoc communication group. This so called “user policy” determines which users can join the group. According to Gogic, if a user is in the group, all video feeds in the group are relevant to that user. As a result, Gogic makes no attempt to teach any mechanism for determining which video feeds in a communication channel are relevant to specific users.

For the reasons above, Gogic fails to disclose a user policy that identifies one or more video feeds that are relevant to a user when the user accesses a communication channel. Gogic in view of Opitz, therefore, fails to render the Challenged Claims obvious and the Board should deny institution.

2. Gogic in view of Opitz fails to disclose “providing a plurality of radio frequencies on a display of the mobile communication device, each radio frequency being associated with a geographical zone from which a plurality of video feeds associated with the geographic zone are sourced”

Petitioner argues that the scanner display of Opitz discloses the claim limitation “providing a plurality of radio frequencies on a display of the mobile communication device.” Petition, 59-60. Notably, Petitioner contends “Gogic discloses each and every limitation [of the Challenged Claims] except the limitation requiring radio frequencies displayed on a mobile device and selected by a user.” Petition, 55. Expressly recognizing Gogic’s failure to provide this limitation, and

using the Challenged Claims as a roadmap, Petitioner then improperly embarks on a targeted search for this lone limitation and argues Opitz fills the gap. *In re Fritch*, 972 F.2d at 1266 (citing *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991)) (“It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.”).

Petitioner further suggests that “presenting and allowing selection of frequencies on a display was one of a finite number of known, predictable solutions for connecting a radio to a base station.” Petition, 55. That a POSA *could* have incorporated some sort of display is a legally insufficient basis for combining these references. *Belden Inv. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015) (“obviousness concerns whether a skilled artisan not only *could have made* but *would have been motivated to make* the combinations or modifications of prior art to arrive at the claimed invention.”) (emphasis in original); *see also ActiveVideo Networks, Inc. v. Verizon Commc’ns, Inc.*, 694 F.3d 1312, 1327 (Fed. Cir. 2012). Thus, even if a POSA *could have* incorporated a display with frequency selection functionality from a separate reference, the Petition’s failure to address why a POSA *would have been motivated to make* such a modification renders the combination of Gogic and Opitz unacceptable.

Even if it were obvious to combine Gogic and Opitz, the combination itself fails to render the Challenged Claims obvious. As used in Opitz, the term “communication channel” is used to refer to numerous communication channel types. Ex. 1007, 3:1-9 (“Municipal police, fire and rescue communications channels are mentioned herein only by way of example. A communication system according to the present disclosure can be employed to update a wide variety of communication channel types. These communications can include *AM and FM broadcast channels*, cellular communications channels, television channels, and citizens’ band channels, as examples.”) (emphasis added). In other words, in an embodiment in which the communication channel is an FM radio frequency, both the communication channel and the radio frequency are the same element in Opitz.

In marked contrast to Opitz, the ’830 Patent clearly requires the communication channel and the radio frequency to be distinct elements. *See* Ex. 1001, cl. 1 (including both “monitoring a selection of a communication channel” and “monitoring a selection of a radio frequency” as distinct elements); 15 (same). That Opitz treats the terms “communication channel” and “radio frequency” as equivalent distinguishes its teaching from the ’830 Patent. *Becton, Dickinson & Co. v. Tyco Healthcare Grp.*, 616 F.3d 1249, 1257 (Fed. Cir. 2010) (“Claims must be interpreted with an eye toward giving effect to all terms in the claim.”) With this critical distinction between the scope and subject matter of Opitz in relation to the ’830

Patent, there is no motivation to combine Opitz's display of a plurality of radio frequencies and monitoring of a selection of a radio frequency with Gogic's monitoring a selection of a communication channel—Opitz's radio frequency *is* its communication channel.

For each of these reasons, the combination of Gogic and Opitz fail to render the Challenged Claims obvious. Therefore, the Board should deny institution.

IV. THE PETITION SHOULD BE DENIED UNDER 35 U.S.C. § 325(d) BECAUSE ALL REFERENCES IN THE PROPOSED GROUNDS ARE CUMULATIVE

During prosecution of the Challenged Claims, the Examiner rejected the then-pending claims “under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al. (US 2008/0108339) in view of Kalley et al. (US 2007/0270172).” Ex. 1003, 183-185. The prior art and arguments relied upon in the Petition are substantially the same prior art and arguments that were previously presented in prosecution. Therefore, the Petition should be denied under 35 U.S.C. § 325(d).

A. Petitioner's “virtual talk group” arguments relying on Shaffer and Gogic are substantially the same as those made during examination with respect to Shaffer ‘339 and Kalley

During examination of the '830 Patent, the examiner relied on US 2008/0108339 (“Shaffer '339”) as disclosing “a talk group which is a communication channel that may be accessed by the devices mobile devices 110” with “controllers 108 and 112 [that] direct relevant video feeds to the users of the

communication channel or talk group.” *Id.*, 184. The examiner further argued Shaffer ’339 taught “the video feed is provided to the devices 110 based on user policy.” *Id.* The examiner then pointed to US 2007/0270172 (“Kalley”) as teaching “that the user may select the virtual talk group or communication channel.” *Id.*

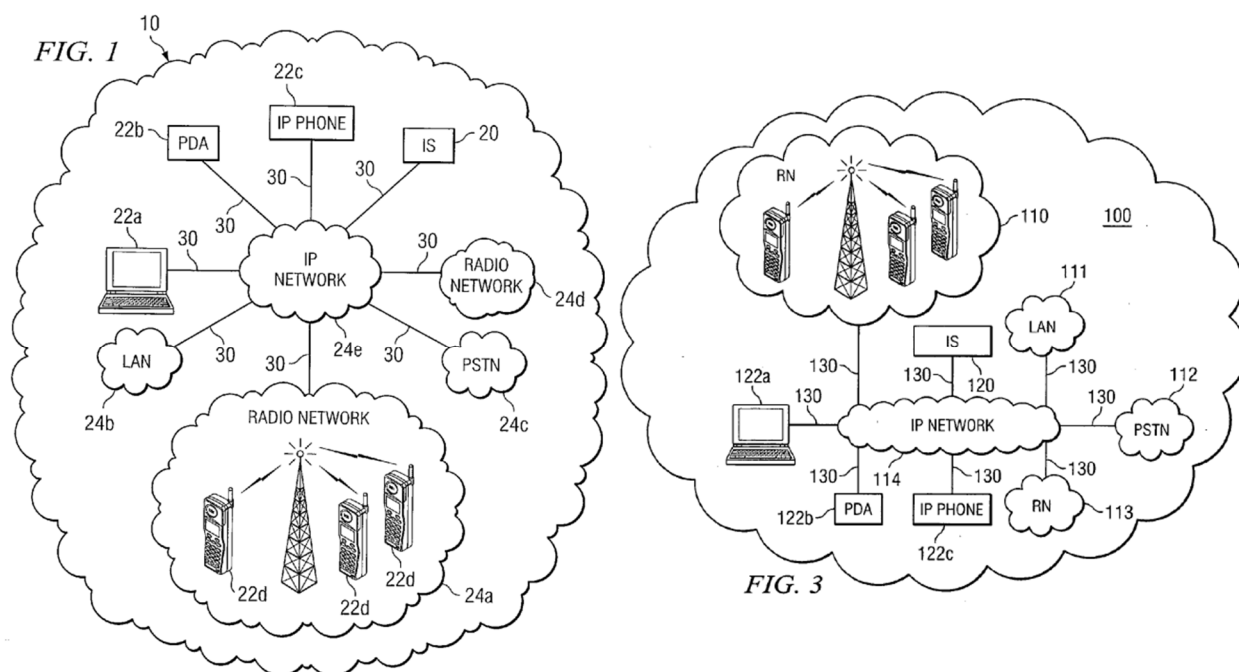
Highlighting the similarity of Petitioner’s art to the art that was before the PTO during prosecution, Shaffer, Shaffer ’339, and Kalley all share a common set of inventors, including Shmuel Shaffer himself.

The Petition mirrors the examiner’s rejection, with the arguments related to Shaffer and Gogic being substantially the same as those made by the examiner with respect to Shaffer ’339. In particular, according to Petitioner, Shaffer, like Shaffer ’339, discloses “a ‘particular IP address’ *for hosting a ‘virtual talk group,’*” Petition, 29–30, and Gogic teaches grouping communication devices into an “ad-hoc ‘group’ or ‘net’ that ‘denotes a collection of communication device users authorized to communicate with each other,’” much like a virtual talk group. Petition, 56 (quoting Ex. 1006, ¶¶ [0034]-[0035]).

Accordingly, the Board should deny institution under 35 U.S.C. § 325(d) because “the same or substantially the same prior art or arguments previously were presented to the Office,” and the prior art and related arguments were overcome.

B. Petitioner’s “monitoring a selection” arguments relying on Shaffer, Gogic, and Opitz are substantially the same as those made during examination with respect to Kalley

The Petition relies on Shaffer’s “PC with a touch screen” as teaching the claimed “monitoring a selection of a communication channel by a user of a mobile device.” This argument is substantially the same as made during examination with respect to Kalley. Ex. 1003, 184. Indeed, a side-by-side comparison of Kalley, Figure 1 and Shaffer, Figure 3 (which is also reproduced on page 30 of the Petition) confirms the two include the same disclosure.



Ex. 2002, Fig. 1; Ex. 1004, Fig. 3.

Petitioner’s arguments related to Gogic’s “activation of a push-to-talk (PTT) key or switch” and Opitz’s “display [that] allows a user to ‘expressly select from the

available channels those channels he or she wishes to scan” are used for the same purpose and are also substantially the same as the arguments already overcome during examination.

Accordingly, the Board should deny institution under 35 U.S.C. § 325(d) because “the same or substantially the same prior art or arguments previously were presented to the Office,” and the prior art and related arguments were overcome.

C. Petitioner’s “identifying at least one video feed” arguments relying on Saylor and Gogic are substantially the same as those made during examination with respect to Shaffer ‘339

During examination, the examiner argued that the claim limitation:

identifying at least one video feed by selecting the at least one video feed from the plurality of video feeds associated with the geographic zone, wherein the at least one video feed is associated with the selected communication channel based on a user policy that identifies one or more video feeds that are relevant to the user when the user accesses the selected communication channel, the one or more video feeds being independent of the selected communication channel;

was obvious over paragraph 13 of Shaffer ‘339. Ex. 1003, 184. Specifically, the examiner argued that Shaffer ‘339 “teaches the controllers 108 and 112 direct relevant video feeds to the users of the communication channel or talk group.” *Id.*

Petitioner’s arguments regarding Saylor are substantially the same. Specifically, the Petitioner argues Saylor discloses “[i]n steps 1022 and 1024, a

‘video clip[]’ from that feed is processed [by a controller, like controllers 108 and 112 of Shaffer ’339] to determine whether certain ‘conditions are met for alarm triggers’ or ‘[n]otifications.’” Petition, 37 (quoting Ex. 1011, 17:1-5). Then, according to Petitioner, “in steps 1026 and 1028 [of Saylor], an ‘image may be automatically transmitted’ to recipients.” *Id.* (citing Ex. 1011, 17:8-9, 34:1-9).

The Petitioner also makes substantially similar arguments with respect to Gogic, specifically with respect to Gogic as teaching “when the user accesses the communication channel associated with an ad-hoc group relating to a car accident at a particular location, he or she will receive video feeds from police officers or other emergency personnel responding to the same incident.” Petition, 68 (citing Ex. 1006, ¶ [0009]). Petitioner’s argument that some controller in Gogic “direct[s] relevant video feeds to the users of the communication channel or talk group” is substantially the same as the Shaffer ’339 argument previously overcome during examination. Ex. 1003, 184.

Accordingly, the Board should deny institution under 35 U.S.C. § 325(d) because “the same or substantially the same prior art or arguments previously were presented to the Office,” and the prior art and related arguments were overcome.

D. Petitioner’s “providing access to the identified at least one video feed” arguments relying on Gogic are substantially the same as those made during examination with respect to Shaffer ‘339

During examination, the examiner relied on paragraph 28 of Shaffer ’339 as teaching the limitation “providing access to the identified at least one video feed to the mobile communication device based on the user policy.” Ex. 1003, 184. The user policy described in Shaffer ’339, paragraph 28 includes a “proximity radius” to allow “any agent in that zone [to] be included in the virtual talk group.” Ex. 2003, ¶ [0028]. This argument is identical to Petitioner’s argument regarding Gogic: “providing access to at least one video feed in the ad-hoc group based on the group membership *location criteria* (user policy).” Petition, 69.

Accordingly, the Board should deny institution under 35 U.S.C. § 325(d) because “the same or substantially the same prior art or arguments previously were presented to the Office,” and the prior art and related arguments were overcome.

V. THE BOARD SHOULD DENY INSTITUTION UNDER 35 U.S.C. § 314

The *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* (June 21, 2022) (“Interim Procedure”), *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020) provides the basis for a discretionary denial in this case. This Petition does not “present[] compelling evidence of unpatentability” with the Petition failing to

provide a “compelling, meritorious challenge[]” that is “unrebutted [at] trial.” Ex. 1032, 2, 4. A discussion of each factor is outlined below.

A. Factor 1: Potential Stay

Petitioner has not motioned for any stay in the parallel court proceeding, nor has the judge issued a stay. While the Board should “not attempt to predict how the district court in the related district court litigation will proceed,” this does not preclude the Board from denying institution. *Sand Revolution II LLC v. Continental Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24 at 7 (P.T.A.B. Jun. 16, 2020). Petitioner cites *Sand Revolution* as a rationale for the Board to grant institution under Factor 1. However, this citation is not a precedential decision and should not be held out as binding on the Board. Additionally, in *Sand Revolution*, the issue of the concurrent stay was not the only factor used in the analysis in the Board reaching their decision to grant institution. The other factors weighed heavily in favor of granting institution. *See id.* at 9-12. As such, considering the availability for Petitioner to file for a stay in light of the upcoming claim construction hearing in March (originally set for December 1, 2023), and deciding not to pursue the stay, this factor weighs in favor of denying institution. Ex. 1033 at 3.

B. Factor 2: Trial Date

The trial in the parallel District Court proceedings will commence no later than September 2024, which is five months before the due date of a Final Written

Decision of this Petition. Ex. 1033, 1. Petitioner waited almost seven months after receiving the initial infringement contentions to file their Petition. Patent Owner has amended infringement contentions with leave of the Court pursuant to facts learned through discovery exchanges, depositions, and other publicly available material and will submit final contentions in line with the District Court's schedule. The Board's final written decision, if instituted, likely will be due on or around February 2025, which is after the close of fact and expert discovery (closing May 1, 2024 and June 10, 2024, respectively) and after the deadline for dispositive motions (June 17, 2024). *See BOE tech. Grp. Co., Ltd., Beijing BOE Display Tech. Co., and Motorola (Wuhan) Mobility Tech. Comm. Co., Ltd., v. Element Capital Commercial Co. PTE. Ltd*, IPR2023-00808, Paper 9 at 21–22, 34 (P.T.A.B. Nov. 15, 2023) (denying institution since the trial date was set to occur 6 months prior to the deadline for a FWD). Petitioner offers nothing in the form of evidence to show any trial date later than the agreed upon September 23, 2024 date. *See BOE*, Paper 9 at 21. The median time to trial for the Eastern District of Texas, Marshall Division for the past five years is 19 months. Ex. 2004. Even if the Board ignores the agreed upon trial date of September 23, 2024, the trial date would still occur on or around September 2024 which is before the statutory deadline for the FWD.

Since a stipulated trial date, as agreed by both parties in the district court case, will commence before the deadline for the FWD, factor two weighs against

institution. *See* Ex. 1032, 8–9 (analyzing the proximity of the trial date is not the sole factor, but if other factors weigh in favor of denial then the proximity to trial should be taken into consideration).

C. Factor 3: Investment in the Parallel Proceeding

The parties have invested a considerable amount of time and effort in the parallel district court proceedings. The suit was filed over a year ago in the Eastern District of Texas, Marshall Division on September 30, 2022. *STA Group LLC v. Motorola Solutions, Inc.*, No. 2:22-cv-00381-JRG-RSP (E.D. Tex. Sep. 30, 2022). The defendants moved for partial dismissal of the complaint by alleging that the '830 Patent claims ineligible subject matter and that the complaint fails to plausibly allege infringement. The court denied the motion to dismiss on Aug. 11, 2023 by Judge Gilstrap, with Magistrate Judge Payne recommending denial on July 7, 2023. Further, fact discovery is well underway. While Petitioner alleges that the Petition was filed with diligence, this Petition was filed approximately six weeks before the statutory bar would have prevented filing of the Petition and five months after service of preliminary infringement contentions. Petition, 91. To that end, both parties have already expended extensive time and effort preparing for the District Court proceeding. The Claim Construction hearing in the District Court case is set for March 15, 2024. Ex. 1034, 3. Both Petitioner and Patent Owner have submitted extensive briefing related to Claim Construction.

Based on this record, the case is beyond its infancy, and the parties are considerably invested in the district court proceedings as seven depositions have already been completed, and eleven more will be complete before an institution decision is due. Accordingly, this factor weighs against institution.

D. Factor 4: Issue Overlap

Petitioner has neither stipulated to, nor suggested it would stipulate to any agreement related to issues raised in the Petition not being raised in the parallel proceeding. In the Interim Guidance, the director stated that “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” Ex. 1030, 3 (citing *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A)). Absent a stipulation, this factor weighs against institution or is at least neutral.

E. Factor 5: Party Overlap

Petitioner and Patent Owner are both parties in the Parallel Proceeding. This factor weighs against institution. *See Fintiv* Order at 13-14.

F. Factor 6: Other Circumstances Favoring Institution

When the sum of *Fintiv* factors 1-5 favor denying institution, which they do here, the PTAB considers whether the Petitioner presents a challenge with

compelling merits. *Samsung Elecs. Co. Ltd. v. California Institute of Tech.*, IPR2023-00130, Paper 10 at 20 (P.T.A.B. May 4, 2023) (citing Ex. 1032, at 4-5). That analysis is provided in Section III above and clearly demonstrates that the Petition fails to satisfy the heightened burden that it is “highly likely that the petitioner would prevail with respect to at least one challenged claim.” *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064, Paper 102 at 49 (P.T.A.B. Oct. 4, 2022) (precedential) (quoting Ex. 1032, p.4); *see also Samsung Elecs.*, IPR2023-00130 at 21 (“The ‘compelling merits’ standard is a standard higher than that required for institution.”) (citing *Commscope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 at 3 (P.T.A.B. Feb. 27, 2023) (precedential)). Accordingly, this factor also weighs against institution.

In view thereof, *Fintiv* Factors 1 (the lack of a stay entered in the district court litigation), 2 (proximity of the court’s trial date to the Board’s projected statutory deadline), 3 (investment in the parallel proceeding by the court and parties), 4 (overlap of issues in Petition vs. parallel proceeding and a lack of a stipulation), 5 (party overlap), and 6 (lack of merits in the Petition) weigh in favor of denying Institution.

VI. 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, and the Board should deny institution.

Dated: December 26, 2023

Respectfully submitted,

By: /Jason A. Engel/
Jason A. Engel
Reg. No. 51,654
K&L GATES LLP

Counsel for Patent Owner

Certification of Word Count Under 37 C.F.R. §42.24(d)

The undersigned hereby certifies that the foregoing contains 9,148 words according to the word count of the word-processing software used to prepare the foregoing.

By: /Jason A. Engel/
Jason A. Engel
Reg. No. 51,654
K&L GATES LLP
70 W. Madison Street, Suite 3100
Chicago, IL 60602
Jason.Engel.PTAB@klgates.com
T: (312) 807-4236
F: (312) 827-8145

CERTIFICATE OF SERVICE

I hereby certify that on December 26, 2023, 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:

Eliot D. Williams
Katharine Burke
Joseph B. Cahill
BAKER BOTTS L.L.P.
700 K Street, N.W
Washington, D.C. 20001
Email: eliot.williams@bakerbotts.com
Email: dlbbstamsiiprs@bakerbotts.com
Email: katharine.burke@bakerbotts.com
Email: joe.cahill@bakerbotts.com

Michael Knierim
BAKER BOTTS L.L.P.
30 Rockefeller Plaza
New York, NY 10112
Email: michael.knierim@bakerbotts.com

Clarke W. Stavinoha
BAKER BOTTS L.L.P.
2001 Ross Avenue, Suite 900
Dallas, TX 75201
Email: clarke.stavinoha@bakerbotts.com

By: /Jason A. Engel/
Jason A. Engel
Reg. No. 51,654
K&L GATES LLP