

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA SOLUTIONS, INC.,
Petitioner,

v.

STA GROUP LLC,
Patent Owner.

Case IPR2023-01295
U.S. Patent No. 8,994,830 B2

**PETITIONER’S UNOPPOSED MOTION FOR *PRO HAC VICE*
ADMISSION UNDER 37 C.F.R. § 42.10 OF STEPHEN O’DONOHUE**

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 <i>Inter Partes</i> 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	<i>First Line of Defense Glassbreak Detectors by IntelliSense</i> , Honeywell (2006)
1009	Docket Control Order, <i>STA Group LLC v. Motorola Solutions, Inc.</i> , 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”)

Ex[No.]	Description of Documents
1014	U.S. Patent App. No. 2008/0108339 (published May 8, 2008) (“Shaffer ’339”)
1015	<i>Voice over IP in LMR Environments, Technical Note 2006-5</i> , 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	<i>Understanding Wireless Communications in Public Safety, A Guidebook to Technology, Issues, Planning, and Management</i> by Imel et. Al (published Jan. 2003)
1018	<i>How Wireless IP Communications Supports Fast Emergency Response</i> , Cisco (published 2007)
1019	<i>Washington Statewide Communications Interoperability Plan</i> , 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	<i>Spectrum Management Regulations and Procedures Manual</i> , Federal Aviation Administration (published Nov. 17, 2005)
1023	<i>In re FCC 04-168, REPORT AND ORDER, FIFTH REPORT AND ORDER, FOURTH MEMORANDUM OPINION AND ORDER, AND ORDER</i> , 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”)

Ex[No.]	Description of Documents
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”)
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, <i>Memorandum: Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation</i> (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)
1034	Email from Katharine.Burke@BakerBotts.com (Dec. 27, 2023)
1035	Declaration of Mr. Stephen O’Donohue In Support of Motion for <i>Pro Hac Vice</i> Admission

Pursuant to 37 C.F.R. § 42.10(c) and as authorized by the Notice of Filing Date Accorded (Paper No. 5 at 2), Petitioner Motorola Solutions, Inc. (“Petitioner”) respectfully requests that the Board recognize Mr. Stephen O’Donohue as counsel *pro hac vice* during this proceeding, IPR2023-01295. Petitioner has met and conferred with Patent Owner, and Patent Owner does not oppose this motion.

1 Time For Filing

This Motion for *Pro Hac Vice* Admission is being filed no sooner than twenty one (21) days after service of the petition as required by the Notice of Filing Date Accorded to Petition entered on September 25, 2023.

2 Statement of Facts Showing Good Cause for the Board to Recognize Counsel Pro Hac Vice During The Proceeding

As required by the Order Authorizing Motion for *Pro Hac Vice* Admission (IPR2013-00639) and in accordance with 37 C.F.R § 42.10(c), the following statement of facts shows that there is good cause for the Board to recognize Mr. O’Donohue *pro hac vice*.

Mr. O’Donohue is an experienced litigation attorney, and has been involved in litigations involving patent infringement in District Courts across the country. He has experience in jury and bench trials, *Markman* hearings, and oral arguments in patent infringement litigation matters.

U.S. Patent No. 8,994,830 (the “’830 Patent”) at issue in this proceeding was asserted by Patent Owner STA Group LLC in a co-pending litigation, *STA Group LLC v. Motorola Solutions, Inc.*, Eastern District of Texas, Case No. 2:22-cv-0381 (“the co-pending litigation”). Mr. O’Donohue is counsel for Motorola Solutions, Inc. in the co-pending litigation and, as such, has an established familiarity with the ’830 Patent and the subject matter at issue in this proceeding. Petitioner has expended significant financial resources in the co-pending litigation with Mr. O’Donohue as counsel, and Petitioner wishes to continue using Mr. O’Donohue as counsel in this proceeding.

Further, Petitioner will file a Power of Attorney evidencing Mr. O’Donohue’s representation of Petitioner upon granting of this Motion.

Therefore, Petitioner respectfully submits that there is good cause for the Board to recognize Mr. O’Donohue as counsel *pro hac vice* during this proceeding.

3 Affidavit or Declaration of Individual Seeking to Appear

This Motion for *Pro Hac Vice* Admission is accompanied by the Declaration of Mr. Stephen O’Donohue, submitted as Exhibit 1035, as required by the “Order -
- Authorizing Motion for Pro Hac Vice Admission” in Case IPR2013-00639, Paper 7 (PTAB Oct. 15, 2013).

August 30, 2024

Respectfully Submitted,

/Eliot D. Williams/

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of PETITIONER'S UNOPPOSED MOTION FOR PRO HAC VICE ADMISSION UNDER 37 C.F.R. § 42.10 OF STEPHEN O'DONOHUE and Exhibit 1035 has been filed with the P-TACTS filing system and served on all counsel of record via the P-TACTS filing system, as well as email on:

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Dated: August 30, 2024

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