UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA SOLUTIONS, INC.
Petitioner

v.

STA GROUP LLC
Patent Owner

Inter Partes Review No.: IPR2024-00479
U.S. Patent No. 9,319,852 B2

PETITIONERS' NOTICE RANKING PETITIONS AND EXPLAINING MATERIAL DIFFERENCES BETWEEN PETITIONS

I. INTRODUCTION

Petitioner is filing two concurrent petitions challenging the patentability of claims of U.S. Patent No. 9,319,852 B2 (the "'852 Patent"):

- Petition 1 (IPR2024-00479) challenges independent claim 8 and dependent claims 9-11.
- Petition 2 (IPR2024-00511) challenges independent claims 1, 8, and 12 and several dependent claims that depend from those claims (i.e., dependent claims 2-5, 7, 9-11, and 13-16).

Petitioner was unable to include all of these challenges in a single petition due to the limit on word count for a single petition.

Petitioner submits this paper, pursuant to the Board's November 2019 Consolidated Trial Practice Guide ("TPG"), in order to "identify: (1) a ranking of the petitions in the order in which it wishes the Board to consider the merits…, and (2) a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions if it identifies one petition that satisfies petitioner's burden under 35 U.S.C. § 314(a)." TPG, 60.

II. RANKING OF PETITIONS

Petitioner believes that both petitions are meritorious and justified. Nonetheless, as required by the TPG, Petitioner provides the following ranking:

Rank	Petition/PTAB Case No.	Challenged Claims
1	Petition 2/IPR2024-00511	1–5 and 7–16
2	Petition 1/IPR2024-00479	8-11

III. MATERIAL DIFFERENCES REQUIRING MULTIPLE PETITIONS

The key difference between the two petitions is that the challenges in Petition 2 rely on references for which it may be possible for patent owner to demonstrate do not constitute prior art. The first ground of Petition 2 (denoted therein as Ground 2) relies on Shaffer, which is the publication of the parent application for the ’852 patent, pursuant to the assertion that the claims challenged under that ground are not entitled to priority to the parent application for lack of written description. While Petitioner believes this assertion is correct, Patent Owner may be able to successfully challenge that assertion. The second and third grounds of Petition 2 (denoted therein as grounds 3 and 4) rely on a primary reference, Chowdhury, which is a 35 U.S.C. § 102(e) reference which Patent Owner may succeed in antedating. Patent Owner has not provided any indication in the parallel litigation between the parties that would foreclose either possibility. In view of these possibilities, Petitioner has also filed Petition 1 which is based on a reference, Choksi, which is indisputably prior art under 35 U.S.C. § 102(b) and cannot be antedated.

Petitioners made every reasonable effort to shorten Petition 2 to include the challenge based on Choksi in Petition 1. However, due to the length of the first petition, which was over 13,000 words, it was not possible to do so.

Petitioner respectfully submits that under these circumstances, the Board should not discretionarily deny Petition 1. As the Consolidated Trial Practice Guide recognizes, more than one petition may be necessary under circumstances such as "when there is a dispute about priority date requiring arguments under multiple prior art references" and that "[i]n such cases two petitions by a petitioner may be needed." Consolidated Trial Practice Guide, P.T.A.B. November 2019, at 59. The situation here is analogous in that one of the challenges in the first-ranked petition is based on a reference that is subject to potential antedating, and the second challenge in the first-ranked petition is based on a reference that is subject to a potential showing by Patent Owner of written description support to an earlier application which would result in the reference not constituting prior art. Accordingly, Petitioner respectfully requests institution of both Petition 2 and Petition 1.

Date: January 30, 2024	Respectfully submitted, */s/ James M. Heintz* James M. Heintz Reg. No. 41,828 **DLA Piper LLP** One Fountain Square 11911 Freedom Drive, Suite 300 Reston, VA 20190-5602 Phone: + 1 703 773 4000 Fax: + 1 703 773 5000 jim.heintz@us.dlapiper.com *Attorney for Petitioner, Motorola Solutions, Inc.*

CERTIFICATE OF SERVICE

I hereby certify that on January 30, 2024, the foregoing document entitled Petitioners' Notice Ranking Petitions and Explaining Material Differences Between Petitions was served on Patent Owner's counsel via email, as agreed to by Patent Owner, at the following address:

KLG-STA-Motorola@klgates.com

A courtesy copy was sent to the below counsel via electronic mail:

Brenna.Legaard@klgates.com

Respectfully submitted,

/s/ James M. Heintz