

UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT TRIAL AND APPEAL BOARD

MOTOROLA SOLUTIONS, INC.
Petitioner

v.

STA GROUP LLC
Patent Owner

CASE: IPR2024-00479
U.S. PATENT NO. 9,319,852

PATENT OWNER'S PRELIMINARY RESPONSE

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I. INTRODUCTION

Patent Owner, STA Group LLC (“Patent Owner”), submits this Patent Owner Preliminary Response 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 and 8-11 (“Challenged Claims”) of U.S. Patent 9,319,852 (“’852 Patent”, Ex. 1001).¹

The Board should deny Petitioners’ institution request for several reasons.

First, Choksi fails to disclose receiving a determination that an endpoint is not in adherence with capabilities of a predefined floor control mechanism, where the capabilities include quality of service, rules of transmission, and a trusted endpoint identity. Choksi instead uses a location of a transmitting subscriber unit to determine if transcoding is needed to reach a recipient subscriber unit on a different push-to-talk network. This does not render obvious receiving a determination that

¹ The Introduction section of the Petition states Petitioner “requests *inter partes* review of claims 1-5 and 7-16” of the ’852 Patent. Petition, 1. The same claims are listed in the Index of Claims. Petition, vi-viii. This appears to be a copy-paste error from Petitioner’s parallel-filed petition. *Motorola Solutions, Inc. v. STA Group LLC*, IPR2024-00511, Paper 3 at 1 (P.T.A.B. Jan. 30, 2024).

an endpoint is not in adherence with the capabilities of the predefined floor control mechanism, as required by each independent claim.

Second, Choksi fails to disclose receiving a first determination that a proxy is to be dynamically inserted to connect an endpoint to a virtual talk group. Choksi instead discloses the use of a proxy to analyze incoming session requests from a subscriber unit to determine if translation between push-to-talk networks is needed.

Third, Petitioner chose to file two petitions directed to the same claims of the same patent. The P.T.A.B.'s Consolidated Trial Practice Guide clarifies that it will only allow parallel petitions in rare instances. This is not one of those rare instances. Petitioner does not allege there are differing issues or claims between the two proceedings. Instead, Petitioner alleges there is a dispute regarding the priority date of the '852 Patent. However, there is no real dispute about the priority date. Instead, Petitioner avers the '852 Patent's claims are not supported by the specification. This is not a statutorily allowed basis for instituting IPR. Thus, institution should be denied.

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 '852 PATENT

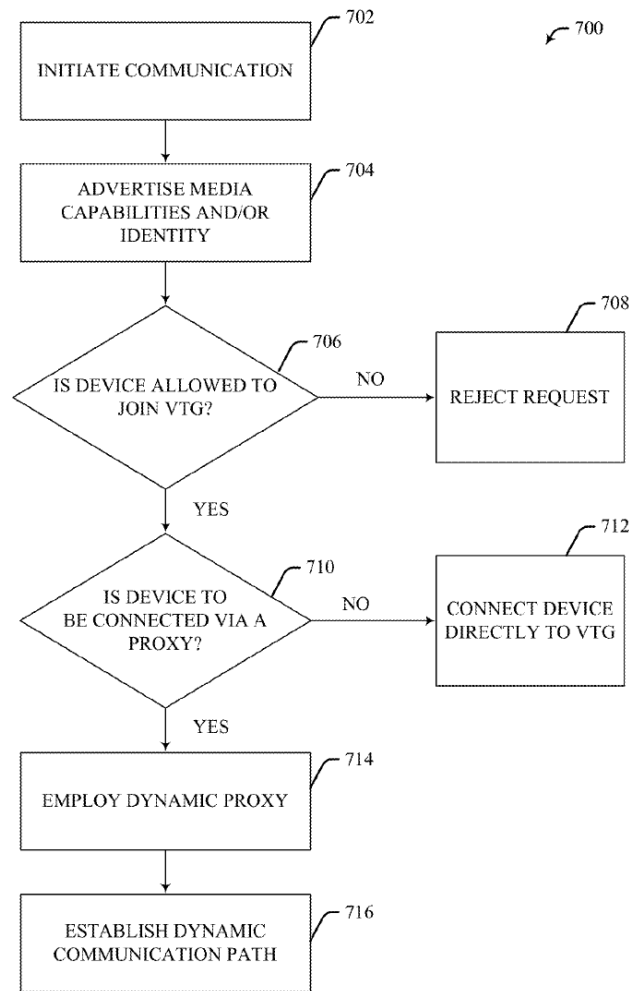
A. The Invention of the '852 Patent

The '852 Patent issued on October 24, 2014, as a divisional of an application filed May 27, 2008. Ex. 1001, Cover. The invention of the '852 Patent is directed to a system and methodology to facilitate communication between non-compatible communication devices using a dynamic media proxy. *Id.*, Abstract. Independent claims 1, 8, 12, and 17 recite identifying information related to an endpoint, negotiating a communication session with an interoperability server (IS), receiving a determination that the endpoint is not in adherence with the capabilities of a predefined floor control mechanism, and receiving a determination that a proxy is to be dynamically inserted to connect the endpoint to a virtual talk group. *Id.* cl. 1, 8, 12, 17.

The '852 Patent describes ISs and endpoints that include capability and information determination components and can “determine media capabilities of the endpoint and/or the identity of the endpoint.” *Id.*, 2:43-46, 2:52-57. A negotiation component is configured to advertise the determined capability and identity information “and negotiate a session with an interoperability server (IS) over a private channel.” *Id.*, 2:46-51. “[B]ased on the capability negotiation,” the IS “can dynamically insert a media proxy.” *Id.*, Abstract, 4:27-30, 6:27-32. In this way, the system “can dynamically facilitate communication between two or more non-

compatible communication devices.” *Id.*, 2:33-42. The insertion of a proxy can be based, in part, on the system’s floor control policy. *Id.*, 6:27-32. The dynamic proxy also has the benefit of allowing for rogue endpoints to be screened from the virtual talk group. *Id.*, 3:10-20, 7:48-57.

Figure 7 shows an example procedure that dynamically facilitates communication between non-compatible communication devices. At Step 704, the IS determines media capabilities or an identity of an endpoint device to determine communication compatibility. *Id.*, 11:43-48. Step 710 specifies that the IS makes a determination as to whether an endpoint device is to be connected to a virtual talk group via a proxy based on communication compatibility. *Id.*, 11:48-52. When there is no communication compatibility between the endpoint device and the virtual talk group, as shown in Step 714, the IS dynamically inserts a proxy to allow the endpoint device to be connected to the virtual talk group. *Id.*, 11:63-12:3.



Id., Fig. 7, 2:1-4.

The '852 Patent issued with twenty claims, of which claims 1, 8, 12, and 17 are independent. The Petition challenges Claims 1-5 and 8-11—the Challenged Claims—under one ground as detailed below:

Ground	Basis for Challenge
1	Claims 1-5 and 8-11 are <u>obvious</u> over Choksi

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). *Apple Inc. v. Firstface Co.*, No. 2021-1001, 2021 WL 4156323, at *1 (Fed. Cir. Sept. 13, 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; *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, Institution Decision, Paper 7, pp. 12-14 (P.T.A.B. Dec. 2, 2019).

Petitioner proposes a construction for limitation [1c] that, at this stage of the proceeding, need not be addressed. Petition, 6-7. The Petition fails to establish a likelihood of success in rendering any challenged claim unpatentable, and therefore institution should be denied under any construction.

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 bachelor’s degree in electrical engineering, computer science, or a similar field, plus approximately three years of industry in networking or communication systems, in particular address interoperability between different types of networks and satellite communications.” Petition, 4-5.

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. Pat. Pub. No. 2006/0058007 (“Choksi”)

Choksi was filed on September 9, 2005, and published on March 16, 2006. Ex. 1005, cover. Choksi “relates generally to push-to-talk (PTT) wireless communications systems and more particularly to systems and methods for facilitating the monetization of group calls spanning disparate, inter-worked PTT networks.” Ex. 1005, ¶ 2.

To accomplish the monetization of group calls, “an inter-working architecture facilitates dispatch communications between a group of dispatch devices spanning a plurality of dispatch networks, with each dispatch network having a separate administrative domain and operating on at least one of a plurality of technologies.” *Id.*, ¶ 7. Choksi discloses that “a user may initiate a dispatch call with any other

users connected to the WWD network 10. For example, user 22 may initiate a dispatch call with users 32 and 34. The dispatch network 20 will recognize that users 32 and 34 are not subscribers of the dispatch network 20 and will forward an initial dispatch request to the WWD network 10.” *Id.*, ¶ 34.

Choksi’s “WWD architecture 98 includes a signaling controller 100 that manages communications across PTT carriers and technologies.” *Id.*, ¶ 43. “After the PTT networks are identified, a determination is made as to whether transcoding is required between the calling PTT network and target PTT network through a transcoder 118.” *Id.* More specifically, a “proxy 106 analyzes incoming session requests to determine whether the originating and terminating PTT networks use the same PTT technology. If the same PTT technology is used then the proxy 106 facilitates communications between the originating and terminating PTT networks without translation.” *Id.*, ¶ 46. On the other hand, “[i]f different technologies are used, then the session is routed to the signaling bridge 104 for translation.” *Id.*, ¶¶ 45-46.

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).

C. Ground 1: The Petition Does Not Establish That Claims 1-5 and 8-11 are Obvious Over Choksi

The Petition fails to show that Choksi discloses all the elements of independent claims 1 and 8. 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. Choksi fails to teach a processor configured to “receive a first determination from the IS that the endpoint is not in adherence with capabilities of the predefined floor control mechanism and that a proxy is to be dynamically inserted to connect the endpoint to a virtual talk group, wherein the capabilities comprise quality of service, rules of transmission and trusted endpoint identity”**

Claims 1 and 8 recite receiving a first determination that the endpoint is not in adherence with capabilities of the predefined floor control mechanism and dynamically inserting a proxy to connect the endpoint to a virtual talk group. Claims 1 and 8 recite what is meant by capabilities of the predefined floor control mechanism. Specifically, the capabilities include quality of service, rules of transmission, and a trusted endpoint identity.

- a. *Choksi does not teach receive a determination whether an endpoint is in adherence with capabilities of a predefined floor control mechanism*

As an initial matter, Choksi does not receive a determination whether an endpoint is in adherence with capabilities of a predefined floor control mechanism. Instead, Choksi is simply concerned with floor control itself. To this point, Choksi discloses a master controller 924 that arbitrates floor control among different users. Ex. 1005, ¶¶ 107, 110, 114. In particular, Choksi specifies that the “master controller 924 in the originating carrier 920 is responsible for arbitrating the floor across active members of the group.” *Id.*, ¶ 108.

While Choksi discloses arbitrating floor control, Choksi fails to disclose determining whether any of the subscriber units of active group members are in *adherence* with capabilities of a predefined floor control mechanism. For example, rather than receiving a first determination from the IS that the endpoint is not in adherence with capabilities of the predefined floor control mechanism, Choksi’s signaling controller instead merely identifies locations of the calling PTT network and the target PTT network to determine whether transcoding is required. Specifically, Choksi discloses:

A WWD architecture 98 includes a signaling controller 100 that manages communications across PTT carriers and technologies. ***The signaling controller 100 is adapted to locate target users from the addresses received from the calling network.*** The PTT network on

which the target user is located is determined via lookup by querying the address translator 112 and the location function 102. In one embodiment, the domain portion of the target user address is used to identify the target PTT network 120. ***After the PTT networks are identified, a determination is made as to whether transcoding is required between the calling PTT network and target PTT network through a transcoder 118.*** The signaling controller 100 may also host and manage sessions for roaming subscribers and locate users in a WWD roaming database. It is further contemplated that the signaling controller 100 may perform admission control to prevent unwanted access to the WWC architecture 98 and, with respect to authorized PTT access, enforce restrictions based on resource availability and contractual terms and conditions.

Id., ¶ 43 (emphasis added).

As highlighted above, Choksi determines if transcoding is needed between a calling PTT network and a target PTT network. Choksi is silent about assessing capabilities of the subscriber units themselves, let alone assessing whether the subscriber units (i.e., endpoints) are in adherence with capabilities of a predefined floor control mechanism. The Petition fails to point to any portion of Choksi that discloses receiving a first determination from the IS that the endpoint is not in adherence with capabilities of the predefined floor control mechanism. Petition, 25-27.

The Petition instead broadly asserts that Choksi’s signaling controller 100 performs the recited claim language. Petition, 26. The Petition then generally cites to ¶ 118 from Dr. Kiaei’s declaration. Petition, 26. However, Dr. Kiaei’s declaration also fails to cite evidence from Choksi regarding determining whether any subscriber units are in *adherence* with capabilities of a predefined floor control mechanism. Petitioner’s reliance on the unsupported declaration fails to establish it has met its burden. *I-MAK*, IPR2018-00120, Paper 7 at 21; *TQ Delta*, 942 F.3d at 1359; *see also Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1363 (Fed. Cir. 2016) (“while ‘common sense’ can be invoked, even potentially to supply a limitation missing from the prior art, it must still be supported by evidence and a reasoned explanation”). For at least this reason, institution should be denied.

- b. *Choksi does not teach dynamically inserting a proxy when an endpoint fails to meet a capabilities of a predefined floor control mechanism*

Claims 1 and 8 recite that capabilities of a predefined floor control mechanism include quality of service, rules of transmission, and a trusted endpoint identity. Regarding the quality of service capability, the Petition points to the media gateway 110 and the “MEGACO (media gateway control) protocol.” Petition, 27 (citing Ex. 1005, ¶ 51). More specifically, the Petition states “[o]ne aspect of the MEGACO protocol is that the media gateway controller (which a POSITA would have understood to be signaling controller 100) sets quality of service standards for the

connection between an initiating endpoint and the media gateway (*i.e.*, media gateway 110).” *Id.*

Choksi does not disclose an IS that communicates, to a processor, a determination that an endpoint is not in adherence with capabilities of a predefined floor control mechanism. Choksi further fails to teach dynamically inserting a proxy to connect an endpoint when it fails the capabilities of a predefined floor control mechanism.

Instead, Choksi discloses a border gateway that meters, marks, classifies, and polices traffic crossing the gateway, including for quality of service:

In one embodiment, the border gateway 108 performs metering, marking, classifying and policing of the traffic traversing the border gateway 108 in both directions in accordance with aggregate carrier service level agreements, ***which may include multiple levels of quality of service*** including requirements specifying network availability, latency and packet loss rate and service availability and denial and billing accuracy.

Ex. 1005, ¶ 54 (emphasis added).

Choksi fails to specify that, when receiving a determination from an IS that an endpoint is not in adherence with quality of service capabilities, a proxy is to be dynamically inserted to connect the endpoint to a virtual talk group. Instead, Choksi

merely teaches metering, marking, classifying, and policing of the traffic traversing the border.

Accordingly, the Petition fails to establish that Choki discloses “receiv[ing] a first determination from the IS that the endpoint is not in adherence with capabilities of the predefined floor control mechanism and that a proxy is to be dynamically inserted to connect the endpoint to a virtual talk group, wherein the capabilities comprise quality of service, rules of transmission and trusted endpoint identity.” Institution should, therefore, be denied.

2. Choksi fails to disclose a processor configured to “receive a first determination from the IS...that a proxy is to be dynamically inserted”

a. No proxy is “dynamically inserted”

The specification of the '852 Patent discloses the relationship between the capabilities of the floor control mechanism and the dynamically inserted proxy, stating when “an active VTG [] already has multiple talkers streaming media into it,” the endpoint “can be dynamically connected to the VTG via a proxy to prevent transmitting media into [the] active VTG.” Ex. 1001, 6:34-45. Put differently, when an endpoint is “non-conforming with the floor control policy of the system, the IS 102 (FIG. 1) can dynamically insert a proxy between the endpoint 104 and the VTG” to prevent “rendering the VTG useless.” *Id.*

In contrast to claims 1 and 8, Choksi discloses a signaling bridge 104 and a proxy 106 as permanent fixtures of the WWD network 98. Fig. 3 from Choksi is reproduced below and shows the signaling bridge 104 and the proxy 106 connected between a signaling controller 100 and a border gateway 108.

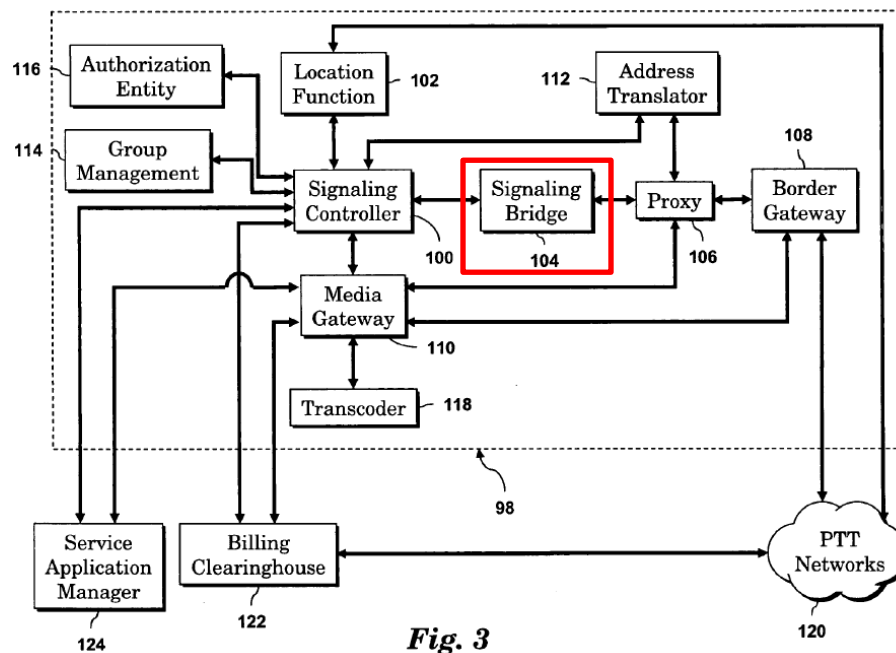


Fig. 3

Ex. 1005, Fig. 3. As permanent fixtures, the signaling bridge 104 and the proxy 106 are never “dynamically inserted”, as recited by claims 1 and 8. Instead, as the Petition acknowledges, “proxy 106 may make routing decisions based on PTT protocol type information embedded in the session header.” Petition, 31 (quoting Ex. 1005, ¶ 46). “If different [PTT] technologies are used, then the session is routed [by the proxy 106] to the signaling bridge 104 for translation.” *Id.* (brackets in original) (quoting Ex. 1005, ¶ 46). The signaling bridge 104 is not dynamically

“inserted” by Choksi since it has to be present to accommodate routing decisions made by the proxy 106 for incoming sessions. The signaling bridge 104 instead provides translation between different PTT networks when requested by the proxy 106. Ex. 1005, ¶ 46.

Similarly, Choksi’s proxy is not dynamically inserted. Choksi discloses that the proxy 106 “analyzes incoming session requests.” Ex. 1005, ¶ 46. Choksi’s proxy 106 is needed to be present at all times to analyze the incoming session requests. Without the proxy 106 in place, Choksi could not analyze incoming session requests.

For at least the above-reasons, Choksi does not teach a processor configured to “receive a first determination...that a proxy is to be dynamically inserted.” Choksi therefore fails to render Claim 1 obvious.

- b. *Choksi fails to disclose the proxy is “dynamically inserted to connect to the endpoint to a virtual talk group”*

In introducing this part of limitation [1c], the Petition ignores that the proxy is “dynamically inserted *to connect to the endpoint to a virtual talk group.*” Petition, 31. The Petition instead asserts that “the signaling bridge is not always used, as shown in Figure 12.” *Id.*, 32. Ironically, this Figure and related Figure 10 show that the signaling bridge 104 has nothing to do with connecting the endpoint to a VTG. See Ex. 1005, ¶¶ 88, 90.

Choksi discloses that the embodiment shown in Figure 10, the operation of which is described in Figure 12, “includes a proxy 602 *to control whether WWD sessions between carriers will be translated.*” Ex. 1005, ¶ 88. This is the extent of the purpose of the proxy 602. *Id.*, ¶¶ 88, 90. “[I]f the PTT session requires translation then the proxy 602 routes the session to the signaling bridge 604 where it is converted to a common WWD protocol in step 626.” *Id.*, ¶ 90. Controlling whether WWD sessions will be translated and routing sessions through a signaling bridge 604 does not result in an endpoint being connected to a virtual talk group by dynamically inserting a proxy, as recited in independent claims 1 and 8. Thus, Choksi fails to render this limitation obvious.

Choksi, therefore, fails to render obvious the claimed “processor [] configured to:...receive a first determination from the IS...that a proxy is to be dynamically inserted to connect the endpoint to a virtual talk group.” For at least this additional reason, Choksi fails to disclose claims 1 and 8, and institution should be denied.

3. Dependent Claims 2-5 and 9-11

Because the Petition fails to show a reasonable likelihood of invalidating independent claims 1 or 8, the challenges to the dependent claims also fail to show a reasonable likelihood of success. *See, e.g., Hartness Int’l Inc. v. Simplimatic Eng’g Co.*, 819 F.2d 1100, 1108 (Fed. Cir. 1987) (“[T]he district court was correct in holding that independent claim 1 was nonobvious. *A fortiori*, dependent claim 3 was

nonobvious (and novel) because it contained all the limitations of claim 1 plus a further limitation.”).

IV. THE PETITION SHOULD BE DENIED UNDER 35 U.S.C. § 314(a)

Petitioner has filed two IPRs on the ’852 Patent, the instant proceeding and IPR2024-00511 (the “511 Petition”). Petitioner has identified that it requests the Board to prioritize the 511 Petition over this proceeding. Paper 3, 1-2. While both proceedings should be denied institution based on the merits, there is a further independent basis to deny institution of this proceeding under 35 U.S.C. § 314(a).

Because the instant Petition and the 511 Petition were filed on the same day, the appropriate inquiry is explained in the Consolidated Trial Practice Guide (“Trial Practice Guide”).² *Apple Inc. v. Speir Technologies Ltd.*, IPR2023-00543, Paper 8 at 8-9 (P.T.A.B. August 8, 2023). The relevant portion of the Trial Practice Guide reads as follows:

Parallel Petitions Challenging the Same Patent. Based on the Board’s experience, one petition should be sufficient to challenge the claims of a patent in most situations. Two or more petitions filed against the same patent at or about the same time (e.g., before the first preliminary response by the patent owner) may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness,

² Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

timing, and efficiency concerns. *See* 35 U.S.C. § 316(b). In addition, multiple petitions by a petitioner are not necessary in the vast majority of cases. To date, a substantial majority of patents have been challenged with a single petition.

Nonetheless, the Board recognizes that there may be circumstances in which more than one petition may be necessary, including, for example, when the patent owner has asserted a large number of claims in litigation or when there is a dispute about priority date requiring arguments under multiple prior art references. In such cases two petitions by a petitioner may be needed, although this should be rare. Further, based on prior experience, the Board finds it unlikely that circumstances will arise where three or more petitions by a petitioner with respect to a particular patent will be appropriate.

Trial Practice Guide, 59.

The issues presented in these concurrent proceedings are similar. Each and every claim challenged in this Petition is also challenged in the 511 Petition. *Compare* Petition, 1 (stating claims 1-5 and 8-11 are challenged) *with* *Motorola*, IPR2024-00511, Paper 3 at 1 (stating claims 1-5 and 7-16 are challenged). Petitioner does not assert that a large number of claims were asserted in litigation or that the differences between the grounds warrant institution of more than one review. Paper 3, 2-3. Thus, the challenges themselves provides no basis for institution to be granted. *Intel Corp. v. Tela Innovations, Inc.*, IPR2019-01220, Paper 19 at 7-9

(P.T.A.B. Jan. 30, 2020) (“that the grounds rely on different references” does not “establish sufficient differences between the grounds of the two petitions”).

Instead, Petitioner hitches to the language in the Trial Practice Guide allowing for “more than one petition...when there is a dispute about priority date requiring arguments under multiple prior art references.” Trial Practice Guide, 59. However, the Trial Practice Guide “does not convey that whenever a priority issue is involved, Petitioner is entitled to file two petitions against the same claims of the same patent.” *Square, Inc. v. 4361423 Canada Inc.*, IPR2019-01630, Paper 13 at 9 (P.T.A.B. Apr. 2, 2020). “Rather, the operative phrase [in the Trial Practice Guide] is ‘may be needed, although this should be rare.’” *Id.* (quoting Trial Practice Guide 59). This is not one of those rare cases, indeed this is not even a case about the priority date.

Petitioner’s chief complaint about the priority date in the 511 Petition revolves around Petitioner’s allegation that “[t]he Challenged Claims are not entitled to priority to the ’397 Application [U.S. Patent Application No. 12/127,397, the application of the ’852 Patent’s parent] because that application lacks written description support for the [receiving] claim limitation.” *Motorola*, IPR2024-00511, Paper 3 at 7, 8 n.2, 14. The specification of the ’852 Patent is the exact same as the ’397 Application. To be clear, the ’852 Patent rightfully claims priority to the ’397 Application. Thus, this isn’t a challenge to whether the ’852 Patent can claim priority to its parent patent, but whether the ’852 Patent’s claims are supported by

the specification at all. Lack of written description support is not within the statutorily allowed scope of *inter partes* review. 35 U.S.C. § 311(b).

Recognizing perhaps that the 511 Petition may not be instituted, Petitioner has hedged its bets by filing the instant petition, but this parallel filing “place[s] a substantial and unnecessary burden on the Board and the [p]atent [o]wner [that] raise[s] fairness, timing, and efficiency concerns.” Trial Practice Guide, 59. Because the Petitioner fails to identify any *acceptable* reason for a second-filed petition, the instant petition should be denied.

V. 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.

Respectfully submitted by

K&L GATES LLP,

By: /Jason A. Engel/
Jason A. Engel
Reg. No. 51,654

CLAIM APPENDIX OF THE CHALLENGED CLAIMS

- [1pre] An apparatus comprising a processor, wherein the processor is configured to:
 - [1a] identify information related to an endpoint to obtain identified information; and
 - [1b] negotiate a communication session with an interoperability server (IS) based in part on at least one of the identified information or a predefined floor control mechanism associated with the IS; and
 - [1c] receive a first determination from the IS that the endpoint is not in adherence with capabilities of the predefined floor control mechanism and that a proxy is to be dynamically inserted to connect the endpoint to a virtual talk group, wherein the capabilities comprise quality of service, rules of transmission and trusted endpoint identity.
- [2] The apparatus of claim 1, wherein the processor is further configured to identify media capabilities associated with the endpoint, the media capabilities employed by the IS to dynamically determine if the endpoint should be connected to the virtual talk group via the proxy.
- [3] The apparatus of claim 2, further comprising a transmitter, wherein the transmitter transmits data to the virtual talk group if it is determined that the proxy is not employed to connect the endpoint to the virtual talk group.

- [4] The apparatus of claim 2, further comprising a transmitter, wherein the transmitter transmits data to the proxy over a private channel if it is determined that the proxy is employed to connect the endpoint to the virtual talk group.
- [5] The apparatus of claim 1, wherein the processor is further configured to determine an identity associated with the endpoint, the identity employed by the IS to dynamically determine if the endpoint should be connected to the virtual talk group via the proxy.
- [8pre] A method comprising:
 - [8a] initiating communication with a non-compatible communication device;
 - [8b] identifying information associated with an initiating device; and
 - [8c] negotiating a communication session with an interoperability server (IS) based in part on at least one of the identified information or a predefined floor control mechanism associated with the IS; and
 - [8d] receiving a first determination from the IS that the initiating device is not in adherence with capabilities of the predefined floor control mechanism and that a proxy is to be dynamically inserted to connect the initiating device to a virtual talk group, wherein the capabilities comprise quality of service, rules of transmission and trusted endpoint identity.

- [9] The method of claim 8, wherein the information associated with the initiating device includes at least one of media capability information associated with the initiating device or an identity of the initiating device.
- [10] The method of claim 8, further comprising transmitting media to the proxy over a private network through custom messages if it is evaluated that the proxy is employed.
- [11] The method of claim 8, further comprising, attaching the initiating device directly to the virtual talk group and transmitting media directly to the virtual talk group if the proxy is not employed to attach the initiating device to the virtual talk group.

Certification of Service Under 37 C.F.R. §42.6(e)(4)

I hereby certify that on May 13, 2024, 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:

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

The undersigned hereby certifies that the foregoing Patent Owner's Preliminary Response contains **4,541** words, not including a table of contents, table of authorities, mandatory notices under §42.8, certificate of service, certificate of word count, appendix of exhibits or appendix of claim listing as specified by 37 C.F.R. §42.24, according to the word count feature of the word-processing software used to prepare the Patent Owner's Preliminary Response.

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