

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA SOLUTIONS, INC.,
Petitioner,

v.

STA GROUP LLC,
Patent Owner.

IPR2024-00479
Patent 9,319,852 B2

Before SHARON FENICK, SCOTT RAEVSKY, and BRIAN P. MURPHY,
Administrative Patent Judges.

RAEVSKY, *Administrative Patent Judge.*

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Motorola Solutions, Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–5 and 8–11¹ in U.S. Patent No. 9,319,852 B2 (Ex. 1001, “the ’852 patent”). Paper 2 (“Pet.”). STA Group, LLC (“Patent Owner”) filed a Preliminary Response. Paper 9 (“Prelim. Resp.”).

Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless it is determined that there is a reasonable likelihood that the petitioner would prevail with respect to at least one of the claims challenged in the petition. After considering the parties’ arguments and evidence, and for the reasons set forth below, Petitioner has not demonstrated a reasonable likelihood of prevailing with respect to any of the challenged claims of the ’852 patent. Accordingly, we decline to institute an *inter partes* review.

II. BACKGROUND

A. Related Matters

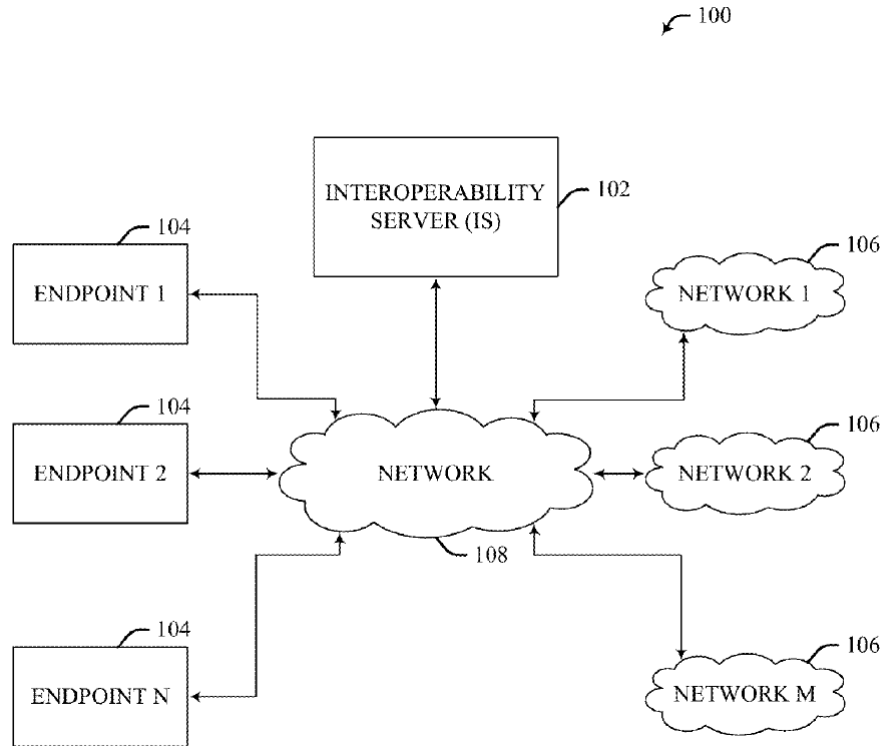
The parties identify the following related matters: *STA Group LLC v. Motorola Solutions, Inc.*, No. 2:23-cv-00030 (E.D. Tex, Jan. 26, 2023); and IPR2024-00511, filed concurrently on the ’852 patent. Pet. 46; Paper 5, 1.

B. The ’852 patent

The ’852 patent relates to facilitating communication between non-compatible communication devices by using a dynamic media proxy. Ex. 1001, code (57). Figure 1 illustrates a system 100 that can dynamically

¹ The first page of the Petition states that it challenges claims 1–5 and 7–16 but only provides a single ground directed to claims 1–5 and 8–11. Pet. 1. As Petitioner only submits arguments for claims 1–5 and 8–11, we assume the reference to claims 1–5 and 7–16 is in error. *See id.* at 12–45.

join various non-compatible communication systems into one cohesive infrastructure:



Ex. 1001, 4:46–49. In Figure 1, system 100 includes interoperability server (IS) 102, endpoints 104, networks 106 that employ different technologies, and network 108. *Id.* at 4:49–55, 5:14–15. System 100 can allow users of two-way radios, often called push-to-talk (PTT) radios, and other voice devices, such as cell phones and regular telephones, to directly communicate. *Id.* at 4:49–52.

IS 102 can facilitate communication between different non-compatible communication devices, such as endpoints 104. *Id.* at 4:56–58. IS 102 can connect two-way radios to other networks, for example, by employing IP (internet protocol) technology standards. *Id.* at 5:3–5. Thus, IS 102 can allow an entity using a different (non-compatible) communication device to communicate with a PPT radio. *Id.* at 5:5–10.

C. Challenged Claims

Claim 1 is illustrative of the challenged claims:²

1. [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.

Ex. 1001, 16:47–60.

² We use the same numbers and letters that Petitioner uses to identify the claim language. *See* Pet. vi (Claims Listing). These annotations do not impact our analysis.

D. Asserted Challenges to Patentability

Petitioner asserts the following challenges to patentability (Pet. 1):

Claim(s) Challenged	35 U.S.C. § ³	Reference(s)/Basis
1–5, 8–11	103	Choksi ⁴

To support these challenges, Petitioner relies on the declaration of Thomas W. Kenny, Ph.D. (Ex. 1003). Patent Owner has not submitted testimonial evidence.

IV. ANALYSIS

A. Legal Principles: Obviousness

“In an IPR, 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 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)).

A patent may not be obtained “if the differences between the subject matter sought to be patented and the prior art are such that the subject matter

³ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011), revised 35 U.S.C. §§ 102, 103 effective March 16, 2013. The challenged patent claims priority to an application filed before March 16, 2013, so the pre-AIA version of § 103 presumptively applies. Ex. 1001, code (22). Petitioner challenges this priority claim in a related *inter partes* review, IPR2024-00511, filed on the same day as this Petition. Because no such challenge exists in this proceeding, we apply the pre-AIA version of § 103, but our analysis would not change under the AIA version of § 103.

⁴ US Pub. No. 2006/0058007 A1, published Mar. 16, 2006 (Ex. 1005).

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.” 35 U.S.C. § 103(a) (2006). An obviousness analysis involves underlying factual inquiries including (1) the scope and content of the prior art; (2) differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) where in evidence, objective indicia of nonobviousness, such as commercial success, long-felt but unsolved needs, and failure of others. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18, 35–36 (1966). We analyze the obviousness issues according to these principles.

B. Level of Ordinary Skill in the Art

Petitioner asserts that a person of ordinary skill in the art (“POSITA”) “would have had at least a bachelors’ 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,” and that “[a]dditional education in the fields of electrical engineering or computer science, such as a masters or doctorate degree, could substitute for professional experience in the field.” Pet. 4 (citing Ex. 1002 ¶ 72). Petitioner adds that “[a] person with less or different education but more relevant practical experience, or vice versa, may also meet this standard.” *Id.* at 4–5.

Patent Owner does not dispute Petitioner’s proposal. Prelim. Resp. 7.

Based on the current record, we accept Petitioner’s description of an ordinarily skilled artisan as consistent with the ’852 patent and the asserted prior art.

C. Claim Construction

In *inter partes* review, we construe a claim using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. 37 C.F.R. § 42.100(b).

Petitioner proposes a construction for limitation [1c]. Pet. 6–7. Patent Owner asserts that no construction is necessary because the Petition fails to establish a likelihood of success regardless of what construction is accorded to this limitation. Prelim. Resp. 6. We agree with Patent Owner, for reasons explained below, and our reasoning is unrelated to the proposed construction for this limitation. We therefore determine that neither limitation [1c] nor any other terms require construction. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

D. Alleged Obviousness over Choksi

Petitioner contends that claims 1–5 and 8–11 are unpatentable over Choksi in view of the knowledge of a POSITA. *See* Pet. 12–45.

We determine below that Petitioner has not met its burden to show a reasonable likelihood that Choksi would have rendered the challenged claims obvious.

1. *Overview of Choksi*

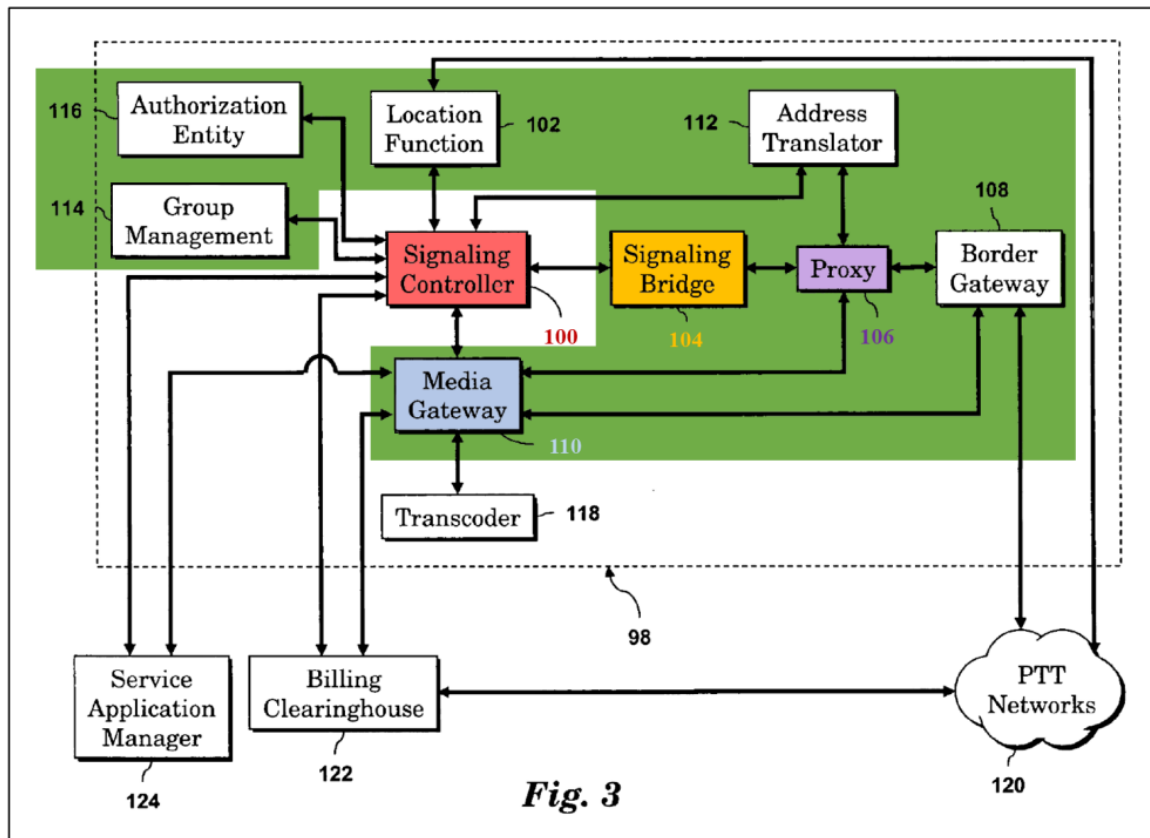
Choksi discloses an inter-working network that facilitates group communications among subscribers spanning a plurality of disparate dispatch networks, a signaling controller, a media gateway, a system for facilitating the monetization of inter-carrier dispatch communications and a group management server. Ex. 1005, code (57). The signaling controller and media gateway generate dispatch call records for dispatch sessions facilitated through the inter-working network. *Id.*

2. *Independent Claim 1*

Patent Owner disputes that Choksi discloses limitation [1c]. Prelim. Resp. 10–18. We agree that Petitioner fails to establish a reasonable likelihood that Choksi discloses limitation [1c]. As this issue is dispositive, we address only limitation [1c].

- a. *[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*

Petitioner contends that Choksi “discloses and/or renders obvious” limitation [1c]. *See* Pet. 25; *see also id.* at 24–34. By way of background, Petitioner relies on the following annotated version of Choksi’s Figure 3:



Id. at 29. Figure 3 depicts a worldwide dispatch (WWD) architecture. Ex. 1005 ¶¶ 30, 42. Petitioner asserts that everything it has highlighted in green in Figure 3 is part of an interoperability server (IS) (Pet. 23–25), that signaling controller 100 (in red) is the claimed processor (Pet. 19–21, 26), and that signaling bridge 104 (in orange) is the claimed proxy (Pet. 31).

We focus our analysis on Petitioner’s argument with respect to the following recitation of limitation [1c] because it is dispositive: “receive a first determination from the IS . . . that a proxy is to be dynamically inserted *to connect the endpoint to a virtual talk group.*” See Pet. 31–34. For this recitation, Petitioner asserts that Choksi’s “signaling controller 100 also receives a first determination that the signaling bridge 104 (the claimed proxy) is to be dynamically inserted to connect the initiating endpoint to a virtual talk group.” *Id.* at 31. When discussing this recitation, however,

Petitioner says nothing more about how Choksi discloses the claimed “virtual talk group.”⁵

We summarize the remainder of Petitioner’s argument for this recitation, which does not address the virtual talk group, as follows. Choksi’s “signaling bridge 104 converts session and signaling messages from one PTT technology to another.” *Id.* (citing Ex. 1005 ¶ 45). Choksi’s proxy 106 (part of the IS) analyzes “incoming session requests to determine whether the originating and terminating PTT networks use the same PTT technology.” *Id.* “If different [PTT] technologies are used, then the session is routed [by the proxy 106] to the signaling bridge 104 for translation;” otherwise the signal goes directly to the signaling controller 100. *Id.* (citing Ex. 1005 ¶ 46). “A POSITA would have considered the signaling bridge 104 (the claimed ‘proxy’) ‘dynamically’ inserted because the signaling bridge 104 performs a translation in response to a determination by proxy 106 that translation is required.” *Id.* at 31–32 (citing Ex. 1002 ¶ 126; Ex. 1005, Fig. 12). “A POSITA would also have understood the signaling controller 100 receives the determination that the signaling bridge 104 (the claimed proxy) is to be inserted for the rest of the session.” *Id.* at 33 (citing Ex. 1002 ¶ 127).

Patent Owner contends, and we agree, that “the Petition ignores that the proxy is ‘dynamically inserted *to connect . . . the endpoint to a virtual talk group.*” Prelim. Resp. 17. Petitioner’s argument fails because the

⁵ Elsewhere, Petitioner mentions “virtual talk group” in the context of the recited “rules of transmission” (Pet. 27) and trusted endpoint identity (Pet. 30), but neither of these passages provides an explanation of how Choksi discloses “receive a first determination from the IS . . . that a proxy is to be dynamically inserted to connect the endpoint to a virtual talk group.”

Petition provides no explanation as to what constitutes claim 1's "virtual talk group" in Choksi, let alone that Choksi teaches "that a proxy is to be dynamically inserted to connect the endpoint to a virtual talk group" as claimed. Even if we were to agree with Petitioner that Choksi's signaling bridge is a dynamically inserted proxy, Petitioner does not explain how the signaling bridge "connect[s] the endpoint to a virtual talk group."

Petitioner also does not propose a construction for "virtual talk group" that might explain how Petitioner proposes that Choksi teaches such a group. For example, Petitioner does not explain whether the phrase "connect the endpoint to a virtual talk group" entails connecting an endpoint to multiple other endpoints.⁶ Along those lines, Petitioner does not explain whether Choksi's initiating endpoint is connected to multiple endpoint devices via the insertion of a proxy, or provide any argument regarding the claimed "determination" regarding such a connection to a "virtual talk group." Moreover, if Petitioner had a different understanding of the meaning of "virtual talk group," Petitioner did not convey this understanding either. We are left with no clear mapping of a teaching in Choksi to this portion of limitation 1[c]. We decline to supply the missing analysis in the first instance ourselves regarding the presence of this claim element in the teachings of Choksi. *Cf. SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1320 (Fed. Cir. 2006) ("Judges are not like pigs, hunting for

⁶ We note that Petitioner describes a "target endpoint" for communications with the claimed "endpoint." Pet. 21. To the extent that we look to the balance of the Petition for our understanding with respect to claim 1, we additionally note that Petitioner describes, with reference to claim 2, connection to an "ending endpoint" rather than a group of endpoint devices, which also is not described in any mapping of limitation 1c. *Id.* 35–36.

truffles buried in briefs.” (quoting *United States v. Dunkel*, 927 F.2d 955, 956 (7th Cir. 1991)); *DeSilva v. DiLeonardi*, 181 F.3d 865, 867 (7th Cir. 1999) (“[a] brief must make all arguments accessible to the judges, rather than ask them to play archaeologist with the record.”).

We find no further support for Petitioner’s argument in its expert declaration, which is substantially similar to the Petition. *See* Ex. 1002 ¶¶ 125–128.

Thus, the Petition fails to establish that Choksi discloses the claimed “receive a first determination from the IS . . . that a proxy is to be dynamically inserted to connect the endpoint to a virtual talk group” of claim 1.

b. Summary as to Claim 1

For the above reasons, Petitioner has failed to meet its burden to show a reasonable likelihood that claim 1 would have been obvious over Choksi.

3. Independent Claim 8

Petitioner raises similar arguments for claim 8 as for claim 1 and therefore also fails to meet its burden for claim 8. *See* Pet. 42.

4. Dependent Claims 2–5 and 9–11

As Petitioner has failed to meet its burden on claims 1 and 8, it also fails to meet its burden for dependent claims 2–5 and 9–11.

V. CONCLUSION

We determine that Petitioner has not demonstrated a reasonable likelihood of prevailing on its challenges as to at least one challenged claim. Accordingly, we do not institute *inter partes* review.

VI. ORDER

Accordingly, it is

ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review is *denied*.

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