

From: [Trials](#)
To: [Nightingale, Joshua R.](#); [Trials](#)
Cc: [Galvan, Hilda C.](#); [Marlott, John A.](#); [Mishaga, Stephanie M.](#); [Jason Engel PTAB](#); [Majewski, Dennis A.](#); [Halverson, Erik J.](#)
Subject: RE: IPR2024-00207, -00511 (Motorola v. STA, '249 and '852 patents)
Date: Friday, May 31, 2024 12:52:45 PM

Counsel:

For IPR2024-00207, Petitioner's unopposed request to file a reply to the preliminary response is granted. The reply should be limited to 5 pages and is due one week from this email. Patent Owner may file a sur-reply limited to 5 pages, due one week from the filing of the reply.

For IPR2024-00511, the Board determines that no further briefing or conference call is required to address the issues raised in the preliminary response.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Nightingale, Joshua R. <jrnightingale@jonesday.com>
Sent: Thursday, May 30, 2024 1:00 PM
To: Trials <Trials@USPTO.GOV>
Cc: Galvan, Hilda C. <hcgalan@JonesDay.com>; Marlott, John A. <jamarlott@JonesDay.com>; Mishaga, Stephanie M. <smishaga@jonesday.com>; Jason Engel PTAB <Jason.Engel.PTAB@klgates.com>; Majewski, Dennis A. <Dennis.Majewski@klgates.com>; Halverson, Erik J. <Erik.Halverson@klgates.com>
Subject: IPR2024-00207, -00511 (Motorola v. STA, '249 and '852 patents)

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Dear Board,

Petitioner Motorola Solutions, Inc. ("Motorola" or "Petitioner") respectfully seeks leave to file a reply to the POPR in IPR2024-00207 for U.S. Patent No. 8,145,249 (the "'249 patent"). Petitioner further seeks to clarify an issue in IPR2024-00511 for U.S. Patent No. 9,319,852 (the "'852 patent"), with the hope of avoiding the need for a preliminary reply in that case.

Petitioner details its request and clarifying point as follows:

IPR2024-00207: Petitioner seeks leave to file a preliminary reply limited to seven (7) pages, addressing the § 325(d) issue raised in the POPR. In the interest of fairness and ensuring the

Board is fully briefed before reaching a decision, Petitioner will not oppose a sur-reply by Patent Owner of the same length.

There is good cause for granting Petitioner's request. Specifically, good cause exists because Petitioner could not reasonably address, predict, or rebut Patent Owner's argument that the "prior art and arguments relied upon in the Petition are substantially the same prior art and arguments that were previously presented in prosecution" (POPR at 28) when Petitioner relied upon new references that had not previously been cited during prosecution, and the new references' disclosure is not cumulative of that considered during prosecution. *See PLR Worldwide Sales LTD. v. Flip Phone Games, Inc.*, IPR2024-00209, Paper 9 at 14 (PTAB May 10, 2024) (authorizing "Petitioner to respond to Patent Owner's arguments that the prior art relied on in the Petition was substantially the same as prior art that was considered" because "it is not reasonable to require Petitioner to anticipate 'substantially the same prior art' arguments and address them in the Petition.").

IPR2024-00511: Petitioner filed two IPR petitions against the '852 patent, one in IPR2024-00479 and the other in IPR2024-00511. The -00479 petition includes a single ground (denoted "Ground 1"), obviousness over U.S. Pat. Pub. No. 2006/0058007 ("Choksi"). (-00479 Petition at 1.) The -00511 petition includes three additional grounds (Grounds 2-4), none of which is based on Choksi. (-00511 Petition at 1.) The -00511 petition refers to Ground 1, noting it as "Reserved" and "the subject of IPR2024-00479," but does not specify the ground's statutory basis nor the prior art on which it relies. (*Id.* at 1, 33.) Patent Owner argues that "Petitioner's treatment of Ground 1 [in IPR2024-00511] is an improper incorporation by reference ... and runs afoul of the Board's framework following *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018)." (-00511 POPR at 11.)

With this email, Petitioner certifies that Ground 1 is not part of the -00511 petition. Petitioner numbered the grounds (*i.e.*, Ground 1 in -00479, and Grounds 2-4 in -00511) to avoid the confusion of having two "Ground 1's" across the two IPRs directed to the '852 patent. The -00511 petition never incorporates Ground 1 by reference. Petitioner hopes that this email clarifies the issue, such that further briefing on it is not necessary. But at the Board's request, Petitioner can be prepared to file a preliminary reply further addressing Patent Owner's incorporation-by-reference argument. Petitioner can also be available for a conference call at the Board's convenience, if so desired.

Counsel for Petitioner has conferred with counsel for Patent Owner. For IPR2024-00207, Patent Owner does not oppose Petitioner's request to file a preliminary reply limited to seven (7) pages, provided Patent Owner is given a sur-reply of the same length. Patent Owner provides the following as its position for IPR2024-00511:

IPR2024-00511: Patent Owner believes that an email is not the proper way to address this argument. The Petition as filed defines the contours of the proceeding. Patent Owner responded to the Petition as filed, which includes Ground 1 in the relief requested. Patent Owner opposes any additional briefing on this issue and respectfully requests a call with the Board to address this argument.

Petitioner is available for a call with the Board at the Board's convenience.

Joshua R. Nightingale

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