

UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT TRIAL AND APPEAL BOARD

MOTOROLA SOLUTIONS, INC.,
Petitioner,

v.

STA GROUP LLC,
Patent Owner.

Case No. IPR2023-01293
U.S. Patent No. 8,489,134

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317(a) AND 37 C.F.R. §§ 42.72, 42.74**

Exhibit List

Exhibit No.	Exhibit Name
2001	Declaration of Michael Craner
2002	December 2023 DocketNavigator, Time to Trial Statistics in Patent Cases in the United States District Court for the Eastern District of Texas
2003	Claim Construction Order, STA Group LLC v. Motorola Solutions, Inc., Case No. 2:22-CV-00381-JRG (E.D. Tex.)
2004	Confidential Settlement Agreement

I. INTRODUCTION

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72, 42.74, and the Board’s authorization via email on June 27, 2024, Patent Owner STA Group LLC (“Patent Owner”) and Petitioner Motorola Solutions, Inc. (“Petitioner”) jointly request termination of the *inter partes* review of U.S. Patent No. 8,489,134 (the “’134 Patent”) due to settlement.

Petitioner and Patent Owner submit with this motion a confidential version of a true and correct copy of the agreement (“Agreement”), Exhibit 2004, between Petitioner and Patent Owner made in connection with, or in contemplation of, the termination of this proceeding under 35 U.S.C. § 317(b) and 37 CFR § 42.74(b). The Parties certify that there are no other agreements, oral or written, between the Parties made in connection with, or in contemplation of, the termination of this proceeding.

The Parties are concurrently filing a joint request that the confidential Agreement be treated as business confidential information, be kept separate from the file of the involved patent, and be made available only to Federal Government agencies on written request, or to any person on a showing of good cause pursuant to 37 C.F.R. § 72.74(c). In view of that request, Exhibit 2004 has been filed as available to “Parties and Board Only.”

II. STATUS OF RELATED PROCEEDINGS

On June 5, 2024, the litigation between Petitioner and Patent Owner involving U.S. Patent No. 8,489,134 in the Eastern District of Texas was stayed. *See STA Group LLC v. Motorola Solutions, Inc.*, Case No. 2:22-CV-00381-JRG (E.D. Tex.), Dkt. No. 368. Patent Owner has moved to dismiss its claims related to the '134 Patent in the litigation.

U.S. Patent Nos. 8,994,830, 8,831,664, and 7,324,802 are still at issue in the district court case and are the subject of IPR2023-01295, IPR2023-01294, and IPR2023-01292, respectively, which are pending before the Board and not affected by the Parties' resolution of this proceeding.

III. RELIEF REQUESTED

Petitioner and Patent Owner jointly request that the Board dismiss and terminate this proceeding in its entirety. Termination is appropriate at this stage and in view of a settlement between Petitioner and Patent Owner. Exhibit 2004. Patent Owner has not filed its patent owner response in this proceeding, and the Parties have reached an agreement that resolves their dispute with respect to U.S. Patent No. 8,489,134 at issue in this case.

Under 35 U.S.C. § 317(a), “[a]n *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of

the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.”

Moreover, both Congress and the federal courts have expressed a strong interest in encouraging settlement in litigation. *See, e.g., Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) (“The purpose of [Federal Rule of Civil Procedure] 68 is to encourage the settlement of litigation.”); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) (“The law favors settlement of cases.”), cert. denied, 479 U.S. 950 (1986). The U.S. Court of Appeals for the Federal Circuit also places a particularly strong emphasis on settlement. *See Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility between parties). Therefore, “[t]he Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” Consolidated Trial Practice Guide at 86 (November 2019) (citing 35 U.S.C. § 317(a)).

Here, the Agreement settles all disputes between the Parties relating to the ’134 Patent and the Parties have filed a confidential version of a true and correct copy of the Agreement as Exhibit 2004. The Parties certify that there are no other agreements or understandings, oral or written, between the Parties made in connection with, or in contemplation of, the termination of the above-referenced

proceeding. The Board has not decided the merits of this proceeding. As such, the Parties respectfully submit that granting the Parties' Joint Motion to Terminate at this juncture would serve to preserve the Board's and Parties' resources and promote a speedy and inexpensive resolution. 37 C.F.R. § 42.1(b).

IV. CONCLUSION

In view of the above, the Parties respectfully request that the above-captioned *inter partes* review, IPR2023-01293, be terminated.

Date: June 27, 2024

Respectfully submitted,

/Jason A. Engel/

Jason A. Engel

Reg. No. 51,654

K&L GATES LLP

70 W. Madison Street, Suite 3100

Chicago, IL 60602

Jason.Engel.PTAB@klgates.com

T: (312) 807-4236

F: (312) 827-8145

Lead Counsel for Patent Owner

/Eliot D. Williams/

Eliot D. Williams

Reg. No. 50,822

BAKER BOTTS L.L.P.

700 K Street, N.W

Washington, D.C. 20001-5692

eliot.williams@bakerbotts.com

Tel: 202-639-1334

Lead Counsel for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on June 27, 2024, I caused a true and correct copy of the foregoing to be served on the following counsel of record for Petitioner by electronic mail to the following addresses:

Eliot D. Williams
Katharine M. Burke
BAKER BOTTS L.L.P.
700 K Street NW
Washington, DC 20001
Email: eliot.williams@bakerbotts.com
Email: katharine.burke@bakerbotts.com

Michael E. Knierim
BAKER BOTTS L.L.P.
30 Rockefeller Plaza
New York, NY 10112
Email: michael.knierim@bakerbotts.com

Clarke Stavinoha
BAKER BOTTS L.L.P.
2001 Ross Avenue, Suite 900
Dallas, TX 75201
Email: clarke.stavinoha@bakerbotts.com

By: /Jason A. Engel/
Jason A. Engel
Reg. No. 51,654
K&L GATES LLP
70 W. Madison Street, Suite 3100
Chicago, IL 60602
Jason.Engel.PTAB@klgates.com
T: (312) 807-4236
F: (312) 827-8145