

UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT TRIAL AND APPEAL BOARD

MOTOROLA SOLUTIONS, INC.,
Petitioner,

v.

STA GROUP LLC,
Patent Owner.

Case No. IPR2024-00207
U.S. Patent No. 8,145,249

JOINT MOTION TO TERMINATE

LIST OF EXHIBITS

Exhibit No.	Description
1001	U.S. Patent No. 8,145,249
1002	Declaration of Dr. Sayfe Kiaei
1003	File History of U.S. Pat. No. 8,145,249
1004	U.S. Patent No. 8,121,057 (“Botha”)
1005	U.S. Pat. Pub. No. 2003/0182001 (“Radenkovic”)
1006	U.S. Pat. No. 7,580,706 (“Koren”)
1007	U.S. Pat. Pub. No. 2002/0097746 (“McDonald”)
1008	U.S. Pat. No. 6,647,020
1009	T. G. Ekstrom, "Site hand off operation in a SmartZone system," Proceedings of IEEE Vehicular Technology Conference (VTC), Stockholm, Sweden, 1994, pp. 106-110 vol.1, doi: 10.1109/VETEC.1994.345134
1010	U.S. Pat. No. 5,081,669 (“Slaninka”)
1011	U.S. Pat. Pub. No. 2005/0239486 (“D’Avello”)
1012	U.S. Pat. No. 6,882,856 (“Alterman”)
1013	U.S. Pat. No. 6,404,861
1014	U.S. Pat. Pub. No. 2005/0125553
1015	De Smet & Stichele, “Subband Based MPEG Audio Mixing for Internet Streaming Applications, 2001 IEEE Int’l Conf. on Acoustics, Speech and Signal Processing Proceedings, pages 1393-1396

Exhibit No.	Description
1016	Zhihong Qian, “Audio Mixers for Centralized VoIP Conferencing, thesis submitted to Ottawa Carleton Institute for Electrical and Computer Engineering, Carleton University, May 2003
1017	Confidential Binding Term Sheet
1018	Confidential Settlement and License Agreement

Petitioner Motorola Solutions, Inc. and Patent Owner STA Group LLC have entered into agreements (the “Agreements”) that resolve all underlying disputes between the parties involving U.S. Patent 8,145,249 (“the ’249 Patent”). The parties have jointly moved to dismiss the pending related litigation. The Agreements are the only agreements or understandings between the parties made in connection with, or in contemplation of, the termination of this inter partes review.

The parties jointly move that the Board terminate the above-captioned inter partes review. Pursuant to 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.” Here, termination is appropriate because the Board has not yet decided the merits of this inter partes review with a Final Written Decision.

No other party’s rights would be prejudiced by the termination of this inter partes review. The parties are not aware of any other pending proceeding involving the subject patent that would be affected by the requested termination of this proceeding.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the parties certify that they are filing concurrently herewith as Ex. 1017, a true copy of the Binding Term Sheet and Ex. 1018, a true copy of the Settlement and License Agreement

between the parties related to the subject patent, and a joint request to treat the Agreements as business confidential information and to keep the Agreements separate from the file of the involved patent, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R § 42.74(c).

In view of the above, the parties respectfully request that the Board grant the parties' joint motion to terminate this inter partes review. The parties further request that the Board grant their joint request to treat the Agreements as business confidential information and keep it separate from the file of the involved patent.

Date: April 2, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that I caused to be served on the counsel for Patent Owner a true and correct copy of **JOINT MOTION TO TERMINATE** by electronic means at the following addresses of record:

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