

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA SOLUTIONS, INC.,
Petitioner,

v.

STA GROUP LLC,
Patent Owner.

IPR2024-00207
Patent 8,145,249 B2

Before KEVIN C. TROCK, SCOTT RAEVSKY, and
BRIAN P. MURPHY, *Administrative Patent Judges*.

TROCK, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

I. INTRODUCTION

With the Board’s authorization, Petitioner and Patent Owner (collectively, “the Parties”) filed a Joint Motion to Terminate the above-identified proceeding due to settlement. Paper 23 (“Joint Motion”). In support of the Joint Motion, the Parties filed a Binding Term Sheet (Ex. 1017) and a Settlement and License Agreement (Ex. 1018) (collectively, “the Agreements”), as well as a Joint Request that the Agreements be treated as business confidential information and be kept separate, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 24 (“Joint Request”)).

II. DISCUSSION

In the Joint Motion, the Parties represent that they “have entered into agreements . . . that resolve all underlying disputes between the parties involving U.S. Patent 8,145,249,” and that they “have jointly moved to dismiss the pending related litigation.” Joint Motion 1. The Parties also indicate that “[t]he 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,” and that Exhibits 1017 and 1018 are true copies of the Agreements. *Id.* at 1–2. According to the Parties, “[n]o other party’s rights would be prejudiced by the termination of this inter partes review.” *Id.* at 1.

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.” Section 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

We instituted a trial in this proceeding on August 14, 2024. Paper 11. We have not yet decided the merits of the proceeding, and a final written decision has not been entered. Notwithstanding, that the proceeding has moved beyond the preliminary stage, the Parties have adequately shown that the termination of the proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceeding with respect to the Parties.

In the Joint Request, the Parties assert that the Agreements “contain highly sensitive business confidential information that would substantially harm their business interest if publicly disclosed.” Joint Request 1. Accordingly, the Parties request that the Agreements be kept separate from the file of Patent 8,145,249. *Id.* After reviewing the Agreements, we find that they contain confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Agreements as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

The Parties additionally request that if “a person or entity makes a written request, as stated in 37 C.F.R. § 42.74(c)(1)-(2), for access to the Agreements, that any such written request be served upon the parties on the day the written request is provided to the Board and that the parties be provide[d] an opportunity to respond to the request.” *Id.* We have no such procedure for serving parties and receiving responses to requests to access business confidential information, and, further, our regulations do not require us to do so. Therefore, we decline to issue an order regarding service and response upon receiving access requests for the Agreements.

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

III. ORDER

For the reasons discussed above, it is

ORDERED that the Joint Motion is *granted*, and IPR2024-00207 is *terminated* with respect to Petitioner and Patent Owner pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Request is *granted*, and the Agreements (Exs. 1017, 1018) shall be kept separate from the file of Patent 8,145,249, and be made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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