

UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT TRIAL AND APPEAL BOARD

MOTOROLA SOLUTIONS, INC.,
Petitioner,

v.

STA GROUP LLC,
Patent Owner.

Case No. IPR2024-00511
U.S. Patent No. 9,319,852

JOINT MOTION TO TERMINATE

LIST OF EXHIBITS

Exhibit No.	Description
1001	U.S. Patent No. 9,319,852
1002	Declaration of Dr. Kiaei
1003	File History of U.S. Patent No. 9,319,852
1004	U.S. Patent Application No. 14/523,299
1005	U.S. Patent Application Publication No. 2006/0058007
1006	U.S. Patent Application No. 11/047,897
1007	U.S. Patent No. 7,359,726
1008	U.S. Patent Application No. 11/047,892
1009	U.S. Patent No. 7,359,731
1010	U.S. Provisional Patent Application No. 60/608,110
1011	U.S. Provisional Patent Application No. 60/608,113
1012	U.S. Provisional Patent Application No. 60/608,117
1013	U.S. Provisional Patent Application No. 60/608,126
1014	U.S. Provisional Patent Application No. 60/608,131
1015	U.S. Patent No. 8,892,149
1016	U.S. Patent Application Publication No. 2009/0298525
1017	U.S. Patent Application No. 12/127,397
1018	HARRY NEWTON, NEWTON'S TELCOM DICTIONARY (22ND ED. 2006)
1019	H.248.1 (2005.09)

Exhibit No.	Description
1020	B. Campbell <i>et al.</i> , <i>Session Initiation Protocol (SIP) Extension for Instant Messaging</i> , RFC3428 (Dec. 2002)
1021	RFC 3428 Approved as Proposed Standard (2002)
1022	DANIEL COLLINS, CARRIER GRADE VOICE OVER IP (2nd ed. 2003)
1023	N. Greene, et al., <i>Media Gateway Control Protocol Architecture and Requirements</i> , RFC 2805 (Apr. 2000)
1024	U.S. Patent Application Publication No. 2004/0133683
1025	U.S. Patent Application Publication No.2010/0004014
1026	U.S. Patent Application Publication No.2010/0004014
1027	U.S. Patent App. Pub. No. 2003/0231639
1028	File History of U.S. Patent No. 8,892,149
1029	<i>OMA Push to Talk over Cellular (PoC) – Architecture V2.0</i> (OMA-AD-PoCV2_0) (Feb. 26, 2008)
1030	<i>OMA Push to Talk over Cellular 2 Requirements V2.0</i> (OMA-RD-PoCV2_0) (April 21, 2008)
1031	<i>OMA PoC System Description V2.0</i> (OMA-TS-PoC_System_DescriptionV2_0) (Feb. 26, 2008)
1032	<i>OMA PoC Interworking Service V2.0</i> (OMA-TS-PoC_Interworking_ServiceV2_0) (Feb. 26, 2008)
1033	<i>3GPP enablers for Open Mobile Alliance (OMA) Push-to-talk over Cellular (PoC) services</i> (3GPP TR23.979)V7.0.0 (June 2007)
1034	<i>3GPP General Packet Radio Service (GPRS) Description</i> (3GPP TS23.060) V8.0.0 (March 2008)
1035	U.S. Patent No 7,774,012

Exhibit No.	Description
1036	U.S. Patent Application Publication No. 2006/0003781
1037	Push to Talk over Cellular (PoC) - Architecture V2.0 (OMA-AD-PoCV2_0) (February 26, 2008)
1038	OMA Push to Talk over Cellular 2 Requirements V2.0 (OMA-RD-PoCV2_0) (April 21, 2008)
1039	OMA PoC System Description V2.0 (OMA-TS-PoC_System_DescriptionV2_0) (February 26, 2008)
1040	OMA PoC Interworking Service V2.0 (OMA-TS-PoC_Interworking_ServiceV2_0) (February 26, 2008)
1041	2008.09.05 - Push to talk over Cellular V2.0
1042	OMA FTP PoC Public Documents (July 11, 2007), available at https:// web.archive.org/web/20070711185720/ http://member.openmobilealliance.org/ftp/public_documents/POC/ Permanent_documents/
1043	OMA Release Program and Specifications (October 26, 2007), available at https://web.archive.org/web/20071026121236/http://www. openmobilealliance.org/ release_program/index.html
1044	OMA Push to talk over Cellular Working Group (February 20, 2008), available at https://web.archive.org/web/20080220172844/http://www. openmobilealliance.org/Technical/poc. aspx
1045	OMA Technical Section - Publicly Available Documents (February 23, 2008), available at https://web.archive. org/web/20080223000148/http://www.openmobilealliance.org/tec h/ publicmaterial.html

Exhibit No.	Description
1046	OMA Publicly Available Documents (March 8, 2008), available at https:// web.archive.org/web/20080308082514/ http://www.openmobilealliance.org/ Technical/PublicMaterial.aspx
1047	3GPP Specifications Home Page (July 2, 2007), available at https://web. archive.org/web/20070702234758/ http://www.3gpp.org/specs/specs.htm
1048	3GPP specification Release version matrix (July 4, 2007), available at https://web.archive.org/web/ 20070704004228/http://www.3gpp.org/ ftp/Specs/html-info/ SpecReleaseMatrix.htm
1049	3GPP Specification 23.979 (August 3, 2007), available at https://web.archive. org/web/20070803213451/http://www. 3gpp.org/ftp/Specs/html-info/23979. htm
1050	3GPP specification status report (September 17, 2007), available at https://web.archive.org/web/ 20070917060533/http://www.3gpp.org/ ftp/Specs/html- info/status-report.htm
1051	3GPP Specifications Releases (and phases and stages) (October 20, 2007), available at https://web.archive.org/ web/20071020044252/http://www. 3gpp.org/specs/releases.htm
1052	3GPP Specifications Releases (and phases and stages) (March 31, 2008), available at https://web.archive.org/ web/20080331005358/http://www. 3gpp.org/specs/releases.htm
1053	3GPP Specification 23.060 (April 21, 2008), available at https://web.archive. org/web/20080421203604/http://www. 3gpp.org/FTP/Specs/html-info/23060. htm

Exhibit No.	Description
1054	3GPP specification Release version matrix (April 25, 2008), available at https://web.archive.org/web/20080425220025/http://www.3gpp.org/ftp/Specs/html-info/SpecReleaseMatrix.htm
1055	3GPP specification status report (April 30, 2008), available at https://web.archive.org/web/20080430174910/http://www.3gpp.org:80/ftp/Specs/html-info/status-report.htm
1056	3GPP Home Page (March 31, 2008), available at https://web.archive.org/web/20080331113619/http://www.3gpp.org/
1057	2006.01.11 - Motorola Push-To-Talk Over Cellular
1058	2006.02.22 - PoC Consortium Phase 2 Specifications and Documentation
1059	2007.12.13 - Motorola Push-To-Talk Over Cellular
1060	Motorla PoC Solution Brochure (2004)
1061	Declaration of Madhu Pai
1062	Confidential Binding Term Sheet
1063	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 9,319,852 (“the ’852 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. 1062, a true copy of the Binding Term Sheet and Ex. 1063, 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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