

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA SOLUTIONS, INC.,

Petitioner,

v.

APPLIED CAPITAL, INC.,

Patent Owner

IPR2023-00418

Patent 8,378,817

**JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW OF U.S.
PATENT NO. 8,378,817 UNDER 35 U.S.C. § 317 AND 37 C.F.R. § 42.72**

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.72, Petitioner Motorola Solutions, Inc. (“MSI”) and Patent Owner Applied Capital, Inc. (“ACI”) (collectively, the “Parties”) jointly move to terminate the above-captioned *inter partes* review proceeding pursuant to the parties’ settlement of their dispute related to the challenged patent, U.S. Patent No. 8,378,817 (the “’817 Patent”). This joint motion was authorized by the Board in its email dated November 14, 2023. Along with this joint motion to terminate this proceeding, the Parties concurrently submit a true copy of the Parties’ agreement as Exhibit 1035 along with a motion to keep the agreement confidential and separate from the file of the ’817 Patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74. There are no other agreements, written or oral, between the Parties made in connection with, or in contemplation of, the termination of this proceeding.

Termination is appropriate because the Parties’ agreement resolves all disputes related to the ’817 Patent between the Parties. Indeed, the underlying district court litigation between the parties, captioned *Applied Capital, Inc. v. Motorola Solutions, Inc.*, Case No. 6:22-cv-00304-JDK (E.D. Tex.), has been dismissed with prejudice pursuant to the Parties’ agreement. In addition, MSI is the only Petitioner in this proceeding, meaning that this proceeding can be terminated in its entirety pursuant to this motion. And, finally, this proceeding is in its very early stages. No discovery has occurred, and Patent Owner’s response is not due

until November 22, 2023. See Paper 19 (Second Joint Notice of Stipulation to Adjust Schedule). Accordingly, the Board has not rendered any decision on the merits or entered a final written decision in this proceeding. Neither party will be prejudiced by terminating this proceeding.

Dated: November 14, 2023

/s/ Luis M. Ortiz

Luis M. Ortiz
Reg. No. 36,230
Ortiz & Lopez, PLLC
6605 Uptown Blvd NE, Suite 240
Albuquerque, NM 87110
Telephone: (505) 314-1310

*Attorneys for Patent Owner,
Applied Capital, Inc.*

/s/ Eliot D. Williams

Eliot D. Williams Reg. No. 50,822
eliot.williams@bakerbotts.com
Katharine M. Burke (PHV
forthcoming)
BAKER BOTTS L.L.P.
700 K Street Northwest Suite 900,
Washington, DC 20001-5692
202.639.7700

Robert Maier, Reg. No. 54,291
Baker Botts L.L.P.
30 Rockefeller Plaza
New York, NY 10112
Phone: (212) 408-2538
Fax: (212) 259-2538
Robert.maier@bakerbotts.com
Michael Knierim, Reg. No. 78,268
Baker Botts L.L.P.
30 Rockefeller Plaza
New York, NY 10112
Phone: (212) 408-2584
Fax: (212) 259-2584

*Counsel for Petitioner
Motorola Solutions, Inc.*

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 14th day of November, 2023, the **Joint Motion to Terminate *Inter Partes* Review of U.S. Patent No. 8,378,817 Under 35 U.S.C. § 317 and 37 C.F.R. § 42.72** was served by email on the following counsel for Patent Owner:

Luis M. Ortiz, Lead Counsel
USPTO Reg. No. 36,230
Ortiz & Lopez, PLLC
6605 Uptown Blvd NE, Suite 240
Albuquerque, NM 87110
Telephone: (505) 314-1310
Facsimile: (505) 314-1311
Email: lortiz@olpatentlaw.com

Kermit D. Lopez, Back-Up Counsel
USPTO Reg. No. 41,953
Ortiz & Lopez, PLLC
6605 Uptown Blvd NE, Suite 240
Albuquerque, NM 87110
Telephone: (505) 314-1310
Facsimile: (505) 314-1312
Email: klopez@olpatentlaw.com

Dated: November 14, 2023

/s/ Eliot D. Williams
Eliot D. Williams, Reg. #50,822
BAKER BOTTS L.L.P.
1001 Page Mill Road
Building One, Suite 200
Palo Alto, CA 94304
T: (650) 739-7511
F: (650) 739-7611

*Counsel for Petitioner Motorola
Solutions, Inc.*