

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 B2

Before LARRY J. HUME, GEORGIANNA W. BRADEN, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

AMUNDSON, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
Granting Joint Motion to Treat Settlement
Agreement as Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. § 42.74

I. INTRODUCTION

Motorola Solutions, Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–16 in U.S. Patent No. 8,378,817 B2 (Exhibit 1001, “the ’817 patent”) under 35 U.S.C. §§ 311–319. Paper 2. Applied Capital, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 8.

On August 8, 2023, the Board instituted an *inter partes* review of claims 1–16 in the ’817 patent. Paper 7.

On November 14, 2023, after receiving Board authorization, Petitioner and Patent Owner filed a Joint Motion to Terminate this proceeding under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74. Paper 20. As Exhibit 1035, the parties filed a copy of an agreement titled “Settlement and License Agreement.” Ex. 1035, 1. For Exhibit 1035, the parties filed a Joint Motion to Keep Confidential and Separate under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 21.

II. DISCUSSION

The parties represent that their settlement agreement (Exhibit 1035) “resolves all disputes” related to the ’817 patent between the parties and that “the underlying district court litigation between the parties . . . has been dismissed with prejudice pursuant to” their settlement agreement. Paper 20, 2. The parties represent that a “true copy” of their settlement agreement has been filed as Exhibit 1035. *Id.* The parties also represent that “[t]here are no other agreements, written or oral, between the Parties made in connection with, or in contemplation of, the termination of this proceeding.” *Id.*

Further, the parties assert that (1) “this proceeding is in its very early stages,” (2) “[n]o discovery has occurred,” (3) “Patent Owner’s response is not due until November 22, 2023,” and (4) “[n]either party will be prejudiced by terminating this proceeding.” Paper 20, 2–3.

This proceeding has not progressed very far. Patent Owner has not yet filed its Response. Terminating this proceeding will save the Board administrative and judicial resources, e.g., in conducting an oral hearing and issuing a final written decision to decide the patentability issues raised in the Petition. Further, “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding,” and “[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.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012); *see* Consolidated Trial Practice Guide, 86 (Nov. 2019).¹

After reviewing the parties’ settlement agreement, we find that the settlement agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the settlement agreement as business confidential information and to keep it separate from the file of the patent in this proceeding under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Under these circumstances, we also determine that it is appropriate to terminate this proceeding.

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

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

III. ORDER

Accordingly, it is

ORDERED that the parties' Joint Motion to Terminate (Paper 20) is granted;

FURTHER ORDERED that this proceeding is terminated as to all parties; and

FURTHER ORDERED that the parties' Joint Motion to Keep Confidential and Separate (Paper 21) is granted, and the parties' settlement agreement (Exhibit 1035) shall be treated as business confidential information and be kept separate from the file of U.S. Patent No. 8,378,817 B2 and made available only under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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Patent 8,378,817 B2

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