UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA SOLUTIONS, INC.,

Petitioner,

v.

APPLIED CAPITAL, INC.,
Patent Owner

IPR2023-00419
Patent 9,728,082

JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW OF U.S. PATENT NO. 9,728,082 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. 9,728,082 (the "'082 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 '082 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 '082 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 17 (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

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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. 9,728,082 Under 35 U.S.C. § 317 and 37 C.F.R. § 42.72** was served by email on the following counsel for Patent Owner:

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