

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLIED CONCEPTS INC.,
Petitioner

v.

KUSTOM SIGNALS INC.,
Patent Owner

Case: IPR2024-00829
U.S. Patent No. 11,194,039

JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW

Petitioner Applied Concepts Inc. and Patent Owner Kustom Signals Inc. (collectively, the “Parties”) have reached an agreement that resolves all disputes between them regarding U.S. Patent No. 11,194,039, including those relating to this proceeding IPR2024-00829 and the related district court action *Kustom Signals Inc. v. Applied Concepts Inc.*, Case No. 3:23-cv-01937-N (N.D. Tex.) (filed August 30, 2023). There are no other litigation or IPR proceedings regarding the ’039 Patent.

In view of the foregoing and pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72 and 42.74, the Parties jointly request termination of IPR2024-00829. The Parties were authorized to file this Motion by the Board (via e-mail) on April 14, 2025.

Pursuant to 37 C.F.R. §§ 42.72, “[t]he Board may terminate a trial without rendering a final written decision, where appropriate, including . . . pursuant to a joint request under 35 U.S.C. §§ 317(a) or 327(a).” “There are strong public policy reasons to favor settlement between the parties to a proceeding. . . . The 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.” PTAB Consolidated Trial Practice Guide (“CTPG”) at 86 (Nov. 2019) (citing 35 U.S.C. §§ 317(a), 327).

The Board has not yet “decided the merits of the proceeding” (*see* 35 U.S.C. § 317(a)) as Patent Owner filed its response to the petition on February 13, 2025 and Petitioner has not yet filed a reply to the Patent Owner’s Response. Accordingly, this proceeding should be terminated. CTPG at 86 (“The 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.”).

A true copy of the written agreement resolving the disputes between the Parties, which includes all agreements between the Parties related to this proceeding, is additionally being filed concurrently herewith as Confidential Exhibit 1014. The Parties certify that there are no other collateral agreements or understandings, oral or written, between the Parties made in connection with, or in contemplation of, the termination of this proceeding.

Accordingly, the Parties respectfully request that that the Board grant the Parties’ Joint Motion to Terminate.

Date: April 16, 2025

Respectfully submitted,

By: /Christopher J. Rourk/
Christopher J. Rourk
USPTO Reg. No. 39,348
Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing JOINT MOTION TO TERMINATE was served by filing the documents through the Patent Trial and Appeal Case Tracking System (P-TACTS) on April 16, 2025, and a courtesy copy was also served via electronic mail on the following:

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Date: April 16, 2025

By: /Christopher J. Rourk/
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