

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Home Depot U.S.A., Inc.,
Petitioner

v.

H2 Intellect LLC,
Patent Owner

Post-Grant Review No.: PGR2025-00047

**JOINT MOTION TO TERMINATE POST GRANT REVIEW OF U.S.
PATENT NO. 12,056,736 UNDER 37 C.F.R. § 42.72**

INDEX OF EXHIBITS

Exhibit No.	Description
1001	U.S. Patent No. 12,056,736.
1002	Declaration of David H. Williams.
1003	File History of U.S. Pat. No. 12,056,736.
1004	<i>Samsung Electronics America, Inc., v. Hardin</i> , IPR2022-01331, Paper 4 (PTAB Aug. 2, 2022).
1005	<i>Samsung Electronics America, Inc., v. Hardin</i> , IPR2022-01331, Paper 14 (PTAB Feb. 8, 2023).
1006	<i>Hardin v. Samsung Electronics Co.</i> , Case No. 2:21-cv-290-JRG, Document 218 (EDTX Jan. 28, 2023) (“ Pretrial Conference ”).
1007	<i>H2 Intellect LLC v. The Home Depot, Inc.</i> , Case No. 2:24-cv-00694-JRG-RSP, Dkt. No. 26 (EDTX Jan. 09, 2025) (“ First Complaint ”).
1008	U.S. Patent No. 8,433,296 (“ 296 patent ”).
1009	U.S. Patent No. 8,977,247 (“ 247 patent ”).
1010	U.S. Patent No. 9,286,625 (“ 625 patent ”).
1011	U.S. Patent No. 9,779,418 (“ 418 patent ”).
1012	U.S. Patent No. 10,049,387 (“ 387 patent ”).
1013	U.S. Patent No. 10,984,447 (“ 447 patent ”).
1014	U.S. Patent No. 11,948,171 (“ 171 patent ”).
1015	U.S. Patent Publication No. 2014/0279018 (“ 018 publication ”).
1016	File History of Application No. 14/292,204.
1017	File History of U.S. Patent No. 9,286,625.
1018	File History of U.S. Patent No. 9,779,418.
1019	File History of U.S. Patent No. 8,433,296.
1020	File History of U.S. Patent No. 8,977,247.
1021	File History of U.S. Patent No. 10,049,387.
1022	File History of U.S. Patent No. 10,984,447.
1023	<i>H2 Intellect LLC v. The Home Depot, Inc., et al.</i> , Infringement Contentions, November 1, 2024.
1024	<i>Samsung Electronics Co., Ltd. v. Ryan Hardin</i> , IPR2022-01327, Paper 13 (PTAB Feb. 2, 2023).
1025	<i>Samsung Electronics Co., Ltd. v. Ryan Hardin</i> , IPR2022-01333, Paper 13 (PTAB Feb. 2, 2023).
1026	File History of U.S. Patent No. 11,948,171.
1027	U.S. Patent No. 6,807,427 (“ Sakamoto ”).

Exhibit No.	Description
1028	U.S. Patent Publication No. 2006/0149630 (“ Elliott ”).
1029	U.S. Patent Publication No. 2002/0161633 (“ Jacob ”).
1030	Geofencing, Techopedia, https://www.techopedia.com/definition/14937/geofencing (last visited February 10, 2025).
1031	Jonathan P. Munson & Vineet K. Gupta, Location-Based Notification as a General-Purpose Service, Proceedings of the 2nd International Workshop on Mobile Commerce 40 (2002).
1032	What We Do, Locating What’s Important To You, Cell-Loc, http://web.archive.org/web/20030411221815/http://cellloc.com/what_locating.html (last visited February 10, 2025).
1033	Alan Cohen, “Location, Location, Location,” PC Mag., available at https://books.google.com/books?id=eIvagv988JgC&pg=PA82#v=onepage&q&f=false (last visited February 10, 2025).
1034	U.S. Patent No. 7,133,685.
1035	U.S. Patent No. 7,164,986.
1036	U.S. Patent No. 8,536,999.
1037	U.S. Patent Publication No. US 2008/0094256.
1038	U.S. Patent No. 8,010,134.
1039	U.S. Patent Publication No. US 2006/0116817.
1040	<i>H2 Intellect LLC v. The Home Depot, Inc.</i> , Case No. 2:25-cv-00123-JRG-RSP, Dkt. No. 1 (EDTX Feb. 03, 2025) (“ Second Complaint ”).
1041	Papers of H. Bentley Hahn: The Man Who Invented the 5-Digit ZIP Code. https://jfk.blogs.archives.gov/2021/07/01/papers-of-h-bentley-hahn-the-man-who-invented-the-5-digit-zip-code/ (July 1, 2021).
1042	Settlement Agreement.

I. INTRODUCTION

Pursuant to 37 C.F.R. §42.71(a), Petitioner, Home Depot U.S.A., Inc., and Patent Owner, H2 Intellect LLC, jointly request termination of the Post Grant Review of U.S. Patent No. 12,056,736 (the “’736 Patent”) in PGR2025-00047. On July 18, 2025, the Parties informed the Board of a settlement agreement between Petitioner and Patent Owner via email and requested authorization to file a Joint Motion to Terminate the proceedings with respect to both the Patent Owner and the Petitioner. As set forth in an email dated July 29, 2025, the Board authorized the filing of the requested Joint Motion to Terminate. Accordingly, Petitioner and Patent Owner jointly request termination of the present proceeding.

II. ARGUMENT

A joint motion to terminate generally must “(1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office; and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26 at 2 (PTAB Jul. 28, 2014).

A. Brief Explanation as to Why Termination is Appropriate

Petitioner and Patent Owner have entered into a written confidential

agreement that fully resolves this matter. The Parties are concurrently filing a copy of the agreement as Exhibit 1042 along with a request to treat it as business confidential information pursuant to 35 U.S.C. § 327(b). Pursuant to 37 C.F.R. § 42.74(b), the Parties acknowledge, as of the filing of this Motion and the concurrent Motion to Keep Confidential, that Exhibit 1042 represents the entire agreement or understanding between the Parties made in connection with, or in contemplation of, the termination of this proceeding, and further, that Exhibit 1042 is a true and accurate copy of the agreement between the Parties that resolves the present proceeding. The Parties agree that neither Patent Owner nor Petitioner will be prejudiced by termination of this proceeding.

The Parties “may terminate the proceeding...unless the Board has already decided the merits of the proceeding.” Consolidated Office Patent Trial Practice Guide, at 4 (November 2019). This proceeding is still in its early stages following filing of the Petition. Patent Owner’s Discretionary Denial Briefing is scheduled for August 12, 2025. The Parties have now resolved their dispute and have reached agreement to terminate the Petition. Termination is appropriate because public policy favors terminating the present petition for post grant review. Congress and federal courts have expressed a strong interest in encouraging settlement in litigation. *Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) (“The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation.”); *Bergh v. Dept.*

of Transp., 794 F.2d 1575, 1577 (Fed. Cir. 1986) (“The law favors settlement of cases.”), cert. denied, 479 U.S. 950 (1986). The Federal Circuit places a particularly strong emphasis on settlement. *Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility between parties). The Board’s Trial Practice Guide stresses that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding.” Consolidated Office Patent Trial Practice Guide, at 86 (Nov. 2019).

B. Identification of Parties and Status of Litigation

The ’736 Patent is not subject to any actions.

C. Identification and Status of Related Proceedings Before the USPTO

Petitioner has not filed any further Petition for Post Grant Review related to the ’736 Patent. Patent Owner’s Discretionary Denial Briefing is the next deadline in PGR2025-00047 due August 12, 2025.

Date: July 30, 2025

By: /s/ Jennifer Librach Nall

Jennifer Librach Nall

Reg. No. 57,053

Counsel for Petitioner

By: /Brian E. Ferguson/

Brian E. Ferguson

Reg. No. 36,801

Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned certifies pursuant to 37 C.F.R. §§42.6(e) and 42.205 that on July 30, 2025, a true and correct copy of the Joint Motion to Terminate Post Grant Review of U.S. Patent No. 12,056,736 in connection with PGR2025-00047 was served by emailing a copy of the same (by agreement) to the following attorneys for the Patent Owner:

Brian E. Ferguson – BEFerguson@winston.com

Matthew Hopkins - MHopkins@winston.com

Scott Border - SBorder@winston.com

A courtesy copy was sent to the below counsel via electronic mail:
IPR-H2@winston.com.

Respectfully submitted,

Date: July 30, 2025

By: /s/ Jennifer Librach Nall
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