

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

SOLiD, Inc.  
Petitioner

v.

COMMScope TECHNOLOGIES LLC  
Patent Owner

---

Cases IPR2021-1390; -01391; -01392; -01393; -01394  
U.S. Patent Nos. 7,639,982; 8,326,218; 8,577,286; 9,332,402

---

**JOINT MOTION TO DISMISS THE PETITIONS**

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74, Petitioner SOLiD, Inc. (“Petitioner”) and Patent Owner CommScope Technologies LLC (“Patent Owner”) (collectively “the Parties”), jointly request dismissal of the petitions for *inter partes* review (“IPR”) in the following pending cases between the Parties.

IPR2021-1390 (Patent No. 7,639,982)
IPR2021-1391 (Patent No. 7,639,982)
IPR2021-1392 (Patent No. 8,326,218)
IPR2021-1393 (Patent No. 8,577,286)
IPR2021-1394 (Patent No. 9,332,402)

An identical Joint Motion is being filed in each of the IPR proceedings between the Parties.

### **Certification**

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the Parties’ agreements are in writing, and the Parties submit true copies of the Parties’ agreements made in connection with, or in contemplation of, the termination of the proceedings. See Settlement Agreement with attached Exhibits A1-A5. The Parties ask that the Settlement Agreement and Exhibits A1-A5 (filed collectively herewith as Exhibit 1050) be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). A request for treatment of Exhibit 1050 as confidential business information is submitted herewith.

## **Status of Related Proceedings**

On May 18, 2020, Patent Owner filed a complaint against Petitioner in the Northern District of Texas. See Ex A1. The complaint alleged the infringement of four patents: (1) United States Patent No. 7,639,982 (“the ‘982 patent”); (2) United States Patent No. 8,326,218 (“the ‘218 patent”); (3) United States Patent No. 8,577,286 (“the ‘286 patent”); and (4) United States Patent No. 9,332,402 (“the ‘402 patent”). These patents correspond to the same patents at issue in IPRs identified in the above table (“Patents-at-Issue”). The Parties conducted settlement discussions under a Confidentiality and Standstill Agreement (the “Confidentiality and Standstill Agreement”). Ex. A2. On January 6, 2021, after exchanging certain disclosures, CommScope dismissed the litigation without Prejudice. See Ex. A3 (Notice of Dismissal without Prejudice). The Patents-at-Issue have since expired, and CommScope has no plans to refile its suit against SOLiD on any of the Patents-at-Issue. See also paragraph 4 of the Settlement Agreement.

The Parties have resolved their dispute concerning the four patents at issue in the five IPR proceedings identified above, and pursuant to the Settlement Agreement that resolves their dispute, now move to dismiss the petitions for IPR. In accordance with 37 C.F.R. 42.20(b), the Parties jointly sought authorization to file this motion, and received such authorization from the Board on November 8, 2021.

## Relief Requested

The Parties jointly request that the Board dismiss the petitions for these proceeding in their entirety. Dismissal is appropriate at this stage and in view of a settlement between the Parties. “An *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner....” 35 U.S.C. § 317(a). Good cause exists to terminate this proceeding. The Parties have resolved their dispute regarding the Patents-At-Issue and now jointly request dismissal of the petitions. 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012) (“There are strong public policy reasons to favor settlement between the parties to a proceeding”). This proceeding is still at an early stage as the Office has not yet made an institution decision, let alone a decision on the merits. 77 Fed. Reg. at 48768 (“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.”). Dismissal now would serve the interests of judicial economy as well as the mutual interests of the Parties.

Date: November 10, 2021

Respectfully submitted,

By: Matthew W. Johnson

Matthew W. Johnson

Reg. No. 59,108

JONES DAY

500 Grant Street, Suite 4500

Pittsburgh, PA 15219

Telephone: (412) 394-9524

Facsimile: (412) 394-7959

mwjohnson@jonesday.com

Counsel for Petitioner

Date: November 10, 2021

By: Iain A. McIntyre

Iain A. McIntyre

Registration No. 40,337

CARLSON CASPERS

225 South Sixth Street, Suite 4200

Minneapolis, MN 55402

Telephone: (612) 436-9600

Facsimile: (612) 436-9605

imcintyre@carlsoncaspers.com

Counsel for Patent Owner

## **CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(a), I certify that, on November 10, 2021, I caused true and correct copies of the foregoing **JOINT MOTION TO DISMISS THE PETITIONS** to be served by electronic mail on the following attorneys:

Philip P. Caspers ([pcaspers@carlsoncaspers.com](mailto:pcaspers@carlsoncaspers.com))

Iain A. McIntyre ([imcintyre@carlsoncaspers.com](mailto:imcintyre@carlsoncaspers.com))

Aaron Pederson ([apederson@carlsoncaspers.com](mailto:apederson@carlsoncaspers.com))

Date: November 10, 2021

Respectfully submitted,

By: /Matthew W. Johnson/

Matthew W. Johnson