

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ACUITY BRANDS LIGHTING, INC.,

Petitioner,

v.

LYNK LABS, INC.,

Patent Owner.

Case IPR2016-01133

Patent 8,841,855 B2

Before BRYAN F. MOORE, JENNIFER MEYER CHAGNON, and
JAMES J. MAYBERRY, *Administrative Patent Judges*.

MAYBERRY, *Administrative Patent Judge*.

DECISION

Granting Joint Motion to Terminate
35 U.S.C. § 317(a); 37 C.F.R. § 42.72

Granting Request to Treat Settlement Documents
as Confidential Business Information
35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c)

Pursuant to our authorization, on March 1, 2017, the parties filed a Joint Motion to Terminate (Paper 14) and a Joint Request to Treat Settlement Documents as Business Confidential Information (Paper 15). Pursuant to 37 C.F.R. § 42.74(b), the parties also filed a true copy of their written settlement agreement (Ex. 1032), as well as another settlement agreement between Lynk Labs, Inc. and Schneider Electric USA referenced therein (Ex. 1033). *See* Paper 14, 2.

In the Joint Motion to Terminate, the parties indicate that they have reached an agreement regarding all of their disputes involving U.S. Patent No. 8,841,855 B2 (“the ’855 patent”). *Id.* at 1. The parties also indicate that their settlement includes dismissing the related district court proceeding¹ involving the ’855 patent (*see* Ex. 1031 (providing a “Joint Motion to Dismiss with Prejudice” the related district court proceeding)), as well as terminating one other co-pending *inter partes* review, IPR2016-01116, involving U.S. Patent No. 8,531,118 B2. Paper 14, 1. The parties represent that there are no other district court cases or *inter partes* review proceedings involving the ’855 patent. *Id.* at 2.

Under 35 U.S.C. § 317(a), “[a]n *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” The parties indicate that, although a Decision to Institute was entered on

¹ *Lynk Labs, Inc. v. Acuity Brands, Inc.*, No. 15-cv-04833 (N.D. Ill. 2015). Further, the other district court litigation proceeding identified by the parties as involving the ’855 patent, styled *Lynk Labs, Inc. v. Schneider Electric USA, Inc.*, No. 16-cv-04636 (N.D. Ill. 2016), also has been dismissed.

December 2, 2016 (Paper 10), no post-institution briefing, depositions, or oral arguments have taken place, and we have not rendered a Final Written Decision on the merits. Paper 14, 3.

The parties contend that termination would save significant further expenditure and resources of both the Board and the parties. *Id.* The parties further contend that maintaining this proceeding would discourage future settlements. *Id.* at 3–4. In view of the circumstances presented in this case, we agree. Indeed, there are strong public policy reasons to favor settlement between the parties to a proceeding. *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). When, as here, we have not rendered a Final Written Decision on the merits, we generally expect that the proceeding will terminate after the filing of a settlement agreement. *See id.*

Based on the preceding, we determine that it is appropriate to terminate this proceeding without rendering a Final Written Decision as to the patentability of claims 1–5 of the '855 patent.

Accordingly, it is:

ORDERED that the parties' request that the settlement agreements (Ex. 1032; Ex. 1033) be treated as business confidential information and kept separate from the files of U.S. Patent No. 8,841,855 B2, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is *granted*; and

ORDERED that the Joint Motion to Terminate this proceeding is *granted*, and this proceeding is hereby terminated.

IPR2016-01133
Patent 8,841,855 B2

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