

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

CORDELIA LIGHTING, INC.  
Petitioner,  
v.

COOPER LIGHTING, LLC  
Patent Owner

---

Case IPR2017-01859  
Patent 9,010,956 B1

---

Before LYNNE E. PETTIGREW, GREGG I. ANDERSON, and  
ROBERT J. WEINSCHENK, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

DECISION  
Termination of the Proceeding after Institution  
35 U.S.C. § 317(a) and 37 C.F.R. § 42.72

On November 20, 2018, pursuant to Board authorization, Petitioner, Cordelia Lighting, Inc., and Patent Owner, Cooper Lighting, LLC, filed a joint motion to terminate this proceeding along with a copy of their written settlement agreement. Paper 25; Ex. 2006. In their joint motion, the parties indicate that there are no collateral agreements referred to in the settlement agreement, there are no other collateral agreements or understandings made in connection with, or in contemplation of, terminating this *inter partes* review, and the settlement agreement reflects the parties' desires that the Board terminate the review in its entirety. Paper 25, 3. The parties further state that as a result of the settlement agreement, the pending district court action<sup>1</sup> between the parties in which U.S. Patent No. 9,010,956 B1 ("the '956 patent") is being litigated was dismissed with prejudice on November 14, 2018. *Id.* The parties also assert that there are no other pending actions or proceedings involving the '956 patent. *Id.*

With their joint motion, the parties also filed a joint request that the settlement agreement be treated as business confidential information and kept separate from the files of the '956 patent. Paper 26.

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." We instituted a trial in this proceeding on January 16, 2018. Paper 7. Patent Owner's Response, Petitioner's Reply have both been filed and an oral

---

<sup>1</sup> *Cooper Lighting, LLC v. Cordelia Lighting, Inc.*, No. 1:16-cv-02669-WMR (N.D. Ga.).

hearing was held on September 20, 2018. We have not yet decided the merits of the proceeding.

The parties note that a final written decision is not due until January 16, 2019. Paper 25, 1. The parties agree that “[t]ermination of this proceeding is appropriate as the Parties have settled their dispute, including reaching an agreement to terminate this review.” *Id.* at 1–2 (citing 77 Fed. Reg. 48756, 48678 (August 14, 2012) (“There are strong public policy reasons to favor settlement between the parties to a proceeding.”)).

A companion case involving the same parties was terminated on November 19, 2018. *See* IPR2017-01857, Paper 35. While this proceeding is at a more advanced stage that the parties have settled their other pending dispute is a factor favoring settlement. To proceed here to a final decision is not an efficient use of judicial resources and potentially frustrates the parties’ reasons and motivations for settlement. Under the circumstances presented in this case, we determine it is appropriate to terminate this proceeding without rendering a final written decision. *See* 37 C.F.R. §§ 42.72, 42.74.

As requested by the parties, the settlement agreement (Ex. 2006) will be treated as business confidential information and kept separate from the file for U.S. Patent No. 9,010,956 B1. *See* 37 C.F.R. § 42.74(c).

Accordingly, it is

ORDERED that the parties’ joint motion to terminate the proceeding (Paper 25) is *granted*;

FURTHER ORDERED that the parties’ joint request that the settlement agreement (Ex. 2006) be treated as business confidential information (Paper 26) is *granted*; and

IPR2017-01859  
Patent 9,010,956 B1

FURTHER ORDERED that this proceeding is hereby *terminated*.

PETITIONER:

Lester Savit  
Paul Feng  
John Lord  
ONE LLP  
lsavit@onellp.com  
pfeng@onellp.com  
jlord@onellp.com

PATENT OWNER:

Geoffrey K. Gavin  
Calvin P. Griffith  
Joshua R. Nightingale  
JONES DAY  
ggavin@jonesday.com  
cpgriffith@jonesday.com  
jrnightingale@jonesday.com