

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SIGNIFY HOLDING B.V. and ACUITY BRANDS LIGHTING, INC.,
Petitioner,

v.

LIGHTING SCIENCE GROUP CORP.,
Patent Owner.

IPR2020-00643 (Patent 8,506,118 B2)
IPR2020-00753 (Patent 8,506,118 B2)¹

Before STACEY G. WHITE, JOHN A. HUDALLA, and
SHARON FENICK, *Administrative Patent Judges*.

HUDALLA, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

¹ This Order addresses issues that are the same in the identified cases. We exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this filing style in subsequent papers.

I. INTRODUCTION

On December 21, 2020, Petitioner and Patent Owner (collectively, “the Parties”) filed a Joint Motion to Terminate in each of the above-captioned proceedings due to settlement (“Joint Motions”). Paper 25.² In support of the Joint Motions, Patent Owner filed copies of two Settlement and Release Agreements, Exs. 2003, 2004 (“Settlement Agreements”),³ and corresponding Requests to Keep the Settlement Agreements Confidential and Separate pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), Paper 24 (“§ 317(b) Requests”). The Parties never sought authorization for their filings.

II. DISCUSSION

Before turning to the merits of the Parties’ Joint Motions, we address the Parties’ failure to obtain authorization for the Joint Motions and § 317(b) Requests. Generally, a motion will not be entered without prior Board authorization. 37 C.F.R. § 42.20(b); *Consolidated Trial Practice Guide*, 37 (Nov. 2019) (“Consolidated TPG”).⁴ We may, however, waive or suspend any requirement of part 42. 37 C.F.R. § 42.5(b). The Parties’ failure to obtain authorization has already resulted in the long-term pendency of the Joint Motions. Given the particular circumstances of these

² For purposes of expediency, we cite to papers filed in IPR2020-00643, unless otherwise noted. The Parties filed similar papers in each of the above-identified proceedings.

³ For purposes of expediency, we cite to the copies of the Settlement Agreements filed in IPR2020-00643. The Parties filed the same Settlement Agreements in each of the above-identified proceedings.

⁴ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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cases, we exercise our authority and waive the requirement for prior Board authorization to file the instant Joint Motions and § 317(b) Requests.

Nevertheless, we remind counsel to request authorization from the Board before filing any motion other than as authorized by rule or in a scheduling order.

In the Joint Motions, the Parties contend that termination is appropriate based on the settlement of all disputes between the Parties related to the challenged patent. Joint Motions 2. The Parties also represent that Patent Owner has filed true and correct copies of the Settlement Agreements and that there are no other agreements or understandings between the Parties. *Id.* at 4. The Parties further represent that they have filed stipulations of dismissal in the related district court cases (*Lighting Sci. Grp. Corp. v. Acuity Brands, Inc.*, No. 1:19-cv-00805 (D. Del. filed May 1, 2019) and *Lighting Sci. Grp. Corp. v. Signify N.V.*, No. 1:19-cv-00807 (D. Del. filed May 1, 2019)). *Id.* at 3–4. Accordingly, the Parties jointly request termination of these proceedings. *Id.* at 4.

The Board generally expects that a case “will terminate after the filing of a settlement agreement, unless the Board has already decided the merits.” Consolidated TPG, 86; *see* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72. Although we have instituted *inter partes* review of the challenged patent in these proceedings, we have not yet decided the merits of these proceedings. Therefore, we determine that it is appropriate to terminate these proceedings without rendering any further decisions.

In the § 317(b) Requests, Patent Owner requests to have the Settlement Agreements treated as business confidential information and to keep them separate from the files of the patent involved in these *inter partes*

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proceedings. § 317(b) Requests 2. After reviewing the Settlement Agreements, we find that they contain confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreements as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

III. ORDER

Accordingly, for the reasons discussed above, it is

ORDERED that the Joint Motions to Terminate are *granted*, and the above-identified proceedings are *terminated*; and

FURTHER ORDERED that the Patent Owner's Requests to Keep the Settlement Agreements Confidential and Separate are *granted*, and the Settlement Agreements shall be kept separate from the files of U.S. Patent No. 8,506,118 B2, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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