

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CURRENT LIGHTING SOLUTIONS, LLC, and HLI SOLUTIONS, INC.,
Petitioner,

v.

ALSI HOLDINGS, LLC,
Patent Owner.

IPR2023-00198
Patent 8,721,114 B2

Before HUBERT C. LORIN, GRACE KARAFFA OBERMANN, and
DONNA M. PRAISS, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial and
Granting Joint Request to Treat Settlement Agreement as
Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. § 42.74

I. INTRODUCTION

Petitioner and Patent Owner (collectively “the Parties”) have requested that the above-identified *inter partes* review proceeding be terminated pursuant to a settlement. On February 28, 2024, the Parties filed “Joint Motion to Terminate *Inter Partes* Review Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74” (“Joint Motion,” Paper 31) in the above identified proceeding. The Parties previously sought authorization to file the Joint Motion and received that authorization by Order mailed February 29, 2024. Paper 34. The Parties also filed a copy of a settlement agreement (“Settlement Agreement,” Ex. 2020) accompanied by “Joint Request To File Document As Business Confidential Information” (“Joint Request,” Paper 32).

II. DISCUSSION

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 the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” It is also provided in 35 U.S.C. § 317(a) that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

In the Joint Motion, the Parties represent that they have reached an agreement that resolves this proceeding and related district court litigation *ALSI Holdings, LLC. v. Current Lighting Solutions, LLC et al.*, Case No. 6:21-cv-01187-ADA (W.D. TX), and that the filed copy of the Settlement Agreement is a true and correct copy. Joint Motion 2–3.

We instituted trial in the above-identified proceeding on May 23, 2023. Paper 12. We have not yet heard final oral arguments or decided the

merits of the proceeding, and a final written decision has not been entered. Notwithstanding that the proceeding has moved beyond the preliminary stage, therefore, the Parties have shown adequately that termination of the proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceeding with respect to the Parties.

The Parties also requested that the Settlement Agreement be treated as business confidential information and be kept separate from the file of U.S. Patent 8,721,114 B2. Joint Request 1. After reviewing the Settlement Agreement, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement 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 Motion is *granted*, and IPR2023-00198 is *terminated* with respect to Petitioner and Patent Owner, pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Request is *granted*, and the Settlement Agreement shall be kept separate from the file of U.S. Patent 8,721,114 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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