

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SIGNIFY NORTH AMERICA CORP.,
Petitioner,

v.

CAO LIGHTING, INC.,
Patent Owner.

IPR2023-00214
Patent 6,465,961 C2

Before GRACE KARAFFA OBERMANN, CHRISTOPHER M. KAISER,
and BRIAN D. RANGE, *Administrative Patent Judges*.

RANGE, *Administrative Patent Judge*.

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

On September 7, 2023, Petitioner and Patent Owner (collectively, “the parties”) filed a Joint Contingent Motion to Terminate Proceeding due to settlement of their dispute concerning the challenged patent, U.S. Patent No. 6,465,961 C2 (“the ’961 patent). Paper 17. The parties also filed a copy of a settlement agreement (Ex. 1031) and a Joint Request to Treat Settlement Agreement as Business Confidential Information and to Keep Separate. Paper 18.

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.” Accordingly, 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. See Patent Trial and Appeal Board Consolidated Trial Practice Guide¹ (November 2019) 86.

According to the Motion, the parties have reached a settlement that resolves all disputes between them with respect to this proceeding and the parties’ related district court litigation. Mot. 3–4, 5–6.² The parties state that the lawsuit would proceed if neither IPR proceeding is terminated. *Id.* The parties also certify that “[t]here are no collateral agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the proceeding.” *Id.* at 2.

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

² The Motion’s page numbering is incorrect. We refer to page numbers based on the page starting with “I. INTRODUCTION” being page one.

This IPR proceeding is in its early stages: Patent Owner has not yet filed its Response, Petitioner has not yet filed its Reply, no expert depositions have taken place) and the Parties have no other pending requests for relief. The hearing, if requested, is currently scheduled for April 2, 2024. Because this IPR proceeding is in its early stages and because we have not yet decided the merits of this proceeding, we determine that it is appropriate to terminate this proceeding. See 37 C.F.R. §§ 42.5(a), 42.72.

The parties also requested that the Settlement Agreement be treated as business confidential information and be kept separate from the public files of the '961 patent. Paper 18, 1. We determine that good cause exists to treat the Settlement Agreement as business confidential pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Accordingly, it is

ORDERED that the joint motion to terminate the case is granted;

FURTHER ORDERED that IPR2023-0214 is hereby terminated;

FURTHER ORDERED that the hearing for this proceeding scheduled for April 2, 2024, is canceled; and

FURTHER ORDERED that the Joint Request is granted and the settlement agreement shall be kept separate from the files of the '961 patent 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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