

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CURRENT LIGHTING SOLUTIONS, LLC
D/B/A GE CURRENT,
Petitioner

v.

JIAXING SUPER LIGHTING ELECTRIC APPLIANCE CO., LTD.,
Patent Owner

IPR2023-00270
Patent 9,723,662 B2

JOINT MOTION TO TERMINATE PROCEEDING

PETITIONER'S EXHIBIT LIST

Exhibit	Shorthand	Description
1001	'662 Patent	U.S. Patent No. 9,723,662
1002	Baker	Expert Declaration of Dr. R. Jacob Baker
1003		CV of Dr. R. Jacob Baker
1004	Zhang	U.S. Patent No. 10,045,406
1005	Tao	U.S. Patent App. Pub. No. 2016/0174307
1006	Langovsky	U.S. Patent No. 8,330,381
1007		<i>MaxLite, Inc. v. Jiaxing Super Lighting Electric Appliance Co., Ltd.</i> , IPR2020-00181, Paper 1 (PTAB Nov. 25, 2019)
1008		<i>MaxLite, Inc. v. Jiaxing Super Lighting Electric Appliance Co., Ltd.</i> , IPR2020-00181, Paper 7 (PTAB May 26, 2020)
1009		Excerpts of the '662 Patent prosecution history
1010	Litigation Scheduling Order	Scheduling Order, <i>Jiaxing Super Lighting Electric Appliance Co., Ltd. v. Current Lighting Solutions LLC</i> , No. 6:22-cv-00534, Dkt. 31 (W.D. Tex. Dec. 12, 2022)
1011		U.S. Patent No. 9,338,853
1012		U.S. Patent No. 5,616,990
1013	D'Andrade Report	Excerpts of the Infringement Report of Dr. D'Andrade, <i>Jiaxing Super Lighting Electric Appliance Co., Ltd. v. MaxLite, Inc.</i> , Case No. 2:19-cv-04047 (C.D. Cal.)
1014		Draft Litigation Stipulation
1015		U.S. Patent No. 8,888,976
1016		Infringement Contentions, Cover Pleading and Claim Chart C
1017		U.S. Patent No. 8,441,824
1018		U.S. Patent No. 7,256,505
1019		U.S. Patent No. 7,557,521
1020		U.S. Patent No. 9,148,922
1021		U.S. Patent No. 6,703,795
1022		OMITTED
1023		U.S. Patent No. 8,841,897
1024		U.S. Patent No. 8,792,253
1025		U.S. Patent No. 8,134,297

Exhibit	Shorthand	Description
1026		U.S. Patent No. 3,731,148
1027		U.S. Patent App. Pub. No. 2016/0345394
1028		U.S. Patent No. 7,966,075
1029		U.S. Patent App. Pub. No. 2012/0256551
1030		U.S. Patent App. Pub. No. 2012/0038289
1031		OMITTED
1032		U.S. Patent App. Pub. No. 2013/0076255
1033		U.S. Patent No. 9,237,610
1034		U.S. Patent App. Pub. No. 2013/0234620
1035		U.S. Patent App. Pub. No. 2012/0206433
1036		U.S. Patent App. Pub. No. 2014/0009076
1037		U.S. Patent App. Pub. No. 2014/0084701
1038		U.S. Patent App. Pub. No. 2012/0300501
1039		U.S. Patent App. Pub. No. 2012/0147564
1040		U.S. Patent No. 9,066,403
1041		U.S. Patent App. Pub. No. 2010/0265732
1042		PCT App. No. WO 2014/115010
1043		U.S. Patent No. 8,247,999
1044		Complaint, <i>Jiaxing Super Lighting Electric Appliance Co., Ltd. v. MaxLite, Inc.</i> , Case No. 2:19-cv-04047, Dkt. 1 (C.D. Cal. May 8, 2019)
1045		Exhibit 14 to Complaint, <i>Jiaxing Super Lighting Electric Appliance Co., Ltd. v. MaxLite, Inc.</i> , Case No. 2:19-cv-04047, Dkt. 1-14 (C.D. Cal. May 8, 2019)
1046		Exhibit 15 to Complaint, <i>Jiaxing Super Lighting Electric Appliance Co., Ltd. v. MaxLite, Inc.</i> , Case No. 2:19-cv-04047, Dkt. 1-15 (C.D. Cal. May 8, 2019)
1047		Revised Draft Litigation Stipulation
1048		First Amended Complaint, <i>Jiaxing Super Lighting Electric Appliance Co., Ltd. v. Current Lighting Solutions, LLC</i> , No. 6:22-cv-00534, Dkt. 12 (W.D. Tex. Sept. 16, 2022)
1049		Confidential Settlement and Patent License Agreement

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. §§ 42.72 and 42.74, and the Board's authorization on October 11, 2023, Petitioner Current Lighting Solutions, LLC d/b/a/ GE Current ("Current") and Patent Owner Jiaxing Super Lighting Electric Appliance Co., Ltd. ("Super") jointly move to:

- (1) terminate this instituted proceeding per 35 U.S.C. §317(a) as a result of a settlement between Current and Super; and
- (2) treat as business confidential and keep separate the settlement agreement per 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Motion to Terminate. Current and Super have resolved their underlying dispute and reached agreement regarding the '662 Patent. A true and correct copy of that agreement is submitted as Exhibit 1049 in accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). There are no other agreements or understandings, oral or written, between Current and Super made in connection with, or in contemplation of, termination of this IPR.

On October 3, 2023, pursuant to Federal Rule of Civil Procedure 41(a)(1)(A)(ii), Current and Super jointly filed a motion for dismissal of all claims and counterclaims in *Jiaxing Super Lighting Electric Appliance Co., Ltd. et al. v. Current Lighting Solutions, LLC d/b/a GE Current*, Case No. 6:22-cv-00534-ADA-DTG (W.D. Tex.) (the "Court Action") (Dkt. 96), in which the '662 Patent was asserted. On October 11, 2023, the Court granted the motion and the Court Action

is terminated. Dkt. 97. Other than the Court Action, there are no litigation matters or proceedings between Current and Super involving the '662 Patent.

Termination of this proceeding is proper under 35 U.S.C. § 317(a) because the proceeding has not yet proceeded to oral argument and the Board has not decided the merits of the proceeding. Accordingly, the parties respectfully request termination of this proceeding.

Request to Keep Separate. Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), the parties jointly request that Exhibit 1049 be treated as business confidential information and be kept separate from the file of the involved patent. Exhibit 1049 contains confidential and competitively sensitive business information that could cause competitive harm to the parties if publicly released.

Dated: October 13p, 2023

Respectfully submitted,

/Eagle H. Robinson/
Eagle H. Robinson (Reg. No. 61,361)
Lead Counsel for Petitioner Current
Lighting Solutions, LLC d/b/a GE
Current

Dated: October 12, 2023

Respectfully submitted,

/Patrick J. McKeever/
Patrick J. McKeever (Reg. No. 66,019)
Lead Counsel for Patent Owner Jiaying
Super Lighting Electric Appliance Co.,
Ltd.

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on October 13, 2023, copies of this Joint Motion to Terminate Proceedings and EX1049 were served on Patent Owner via email (by consent) to:

IPRSuperLighting-GECurrent@perkinscoie.com

/Eagle H. Robinson/
Eagle H. Robinson (Reg. No. 61,361)