

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMMSCOPE TECHNOLOGIES LLC,
Petitioner,

v.

DALI WIRELESS, INC.,
Patent Owner.

IPR2023-00466
Patent 9,197,358

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R §§ 42.72, 42.74**

I. Statement of Relief Requested

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74, Petitioner CommScope Technologies LLC (“CommScope” or “Lead Petitioner”) and Patent Owner Dali Wireless, Inc. (“Dali” or “Patent Owner”) jointly move to terminate the present inter partes review proceeding, in light of the parties’ resolution of their dispute relating to U.S. Patent No. 9,197,358 (the ‘358 patent) and the executed written agreement regarding the parties’ resolution. Because CommScope is the only petitioner in this inter partes review, no petitioner will remain, and the Office may terminate the review in its entirety under Section 317.

II. Termination is appropriate

Termination is appropriate because Patent Owner and CommScope have settled their entire dispute concerning the challenged patent. Filed, concurrently herewith, is a true copy of the executed written agreement between CommScope and Dali as Exhibit 1038. CommScope and Dali certify that, other than Exhibit 1038, they made no collateral agreements or understandings in connection with, or in contemplation of, the termination of the inter partes review. CommScope and Dali further request, pursuant to 37 C.F.R. § 42.74(c), that the agreement be treated as confidential business information and kept separate from the files of the involved patent. Filed, concurrently herewith, is a request to treat the settlement

agreement as confidential business information pursuant to 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c).

The applicable statute provides that an inter partes review proceeding “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.” 35 U.S.C. § 317(a). Moreover, strong public policy considerations favor settlement between parties to an inter partes review proceeding. Indeed, the Office Patent Trial Practice Guide provides:

N. Settlement. There are strong public policy reasons to favor settlement between the parties to a proceeding. The Board will be available to facilitate settlement discussions, and where appropriate, may require a settlement discussion as part of the proceeding. 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.

The Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14 2012). As applied here, no oral argument or final written decision has occurred. Thus, the Board has not decided the merits of this proceeding. Because the Board has not yet decided the merits of the present inter partes review proceeding, Section 317 provides that the proceeding should be terminated with respect to Petitioner. Because CommScope is the only petitioner in this inter partes review, no petitioner will remain, and the Office may terminate the review in its entirety

under Section 317. Patent Owner and CommScope agree neither will be prejudiced by the termination.

III. Conclusion

For the foregoing reasons, Patent Owner and Petitioner CommScope jointly and respectfully request that the instant proceeding be terminated. Under 35 U.S.C. § 317(a), because Lead Petitioner and Patent Owner request this termination, no estoppel under 35 U.S.C. § 315(e) shall attach as to Petitioner CommScope.

Dated: October 27, 2023

Respectfully submitted,

By: /Samuel A. Hamer /

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4) and 42.205(b), the undersigned certifies that on October 27, 2023, a complete and entire copy of the foregoing was provided via electronic service to the Patent Owner by serving the correspondence address of record as follows:

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