

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

IPR2023-00676
Patent 9,939,140

JOINT MOTION TO TERMINATE PROCEEDING

PETITIONER'S EXHIBIT LIST

Exhibit	Shorthand	Description
EX1001	'140 Patent	U.S. Patent No. 9,939,140
EX1002	Lebby	Declaration of Michael Lebby, Ph.D.
EX1003	'140 FH	Excerpts from File History of the '140 Patent
EX1004	'645 Application	U.S. Patent App. Pub. No. 2016/0219672
EX1005	'387 Application	U.S. Patent App. Pub. No. 2016/0091147
EX1006	'138 Application	U.S. Patent App. Pub. No. 2016/0102813
EX1007	Ivey813	U.S. Patent No. 8,596,813
EX1008	Ivey345	U.S. Patent App. Pub. No. 2014/0015345
EX1009	Sadwick	U.S. Patent App. Pub. No. 2017/0311396
EX1010	Powell	U.S. Patent No. 9,438,165
EX1011	Digi-Key	Wayback Machine capture of <i>Product Index > Discrete Semiconductor Products > FETs – Arrays</i> , Digi-Key (Apr. 10, 2014, 11:03 AM), http://www.digikey.com/product-search/en/discrete-semiconductor-products/fets-arrays/1377094 [https://web.archive.org/web/20140410110347/http://www.digikey.com/product-search/en/discrete-semiconductor-products/fets-arrays/1377094]
EX1012	Fairchild	Wayback Machine capture of <i>FDG6303N Dual N-Channel, Digital FET</i> , Fairchild Semiconductor (Mar. 8, 2014, 4:25 AM), http://www.fairchildsemi.com/ds/FD/FDG6303N.pdf [https://web.archive.org/web/20140308042522/http://www.fairchildsemi.com/ds/FD/FDG6303N.pdf]

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EX1013	Premier	Wayback Machine capture of <i>Should You Replace Your T8 Fluorescent Lamps with T8 LED Tubes? (updated)</i> , Premier Lighting (June 27, 2014, 9:59 PM), http://www.premierltg.com/should-you-replace-your-t8-fluorescent-lamps-with-t8-led-tubes-2/ [https://web.archive.org/web/20140627215905/http://www.premierltg.com/should-you-replace-your-t8-fluorescent-lamps-with-t8-led-tubes-2/]
EX1014	Pyeon	U.S. Patent No. 9,240,227
EX1015	Parks	Wayback Machine capture of Michael Parks, <i>Don't Burn Out! Calculating LED Current Limiting Resistor</i> , Mouser Electronics (Oct. 10, 2014, 6:43 AM), http://www.mouser.com/blog/dont-burn-out-calculating-led-current-limiting-resistor [https://web.archive.org/web/20141010064339/http://www.mouser.com/blog/dont-burn-out-calculating-led-current-limiting-resistor]
EX1016	Etkina	Eugenia Etkina & Gorazd Planinšič, <i>Light-Emitting Diodes: Exploration of Underlying Physics</i> , 52 The Physics Teacher 212 (2014)
EX1017	Briggs	U.S. Patent No. 8,564,214
EX1018	Mandal	M.K. Mandal & B.C. Sarkar, <i>Ring oscillators: Characteristics and applications</i> , 48 Indian J. of Pure & Applied Physics 136 (2010)
EX1019	Recom	Wayback Machine capture of <i>High Power LED and DC/DC-Driver Applications</i> , RECOM Power (Jan. 6, 2015, 4:09 AM) http://www.recom-power.com/fileadmin/RECOM-Downloads/Whitepaper/WP_RCD_Applications_1107_EN.pdf [https://web.archive.org/web/20150106040908/http://www.recom-power.com/fileadmin/RECOM-Downloads/Whitepaper/WP_RCD_Applications_1107_EN.pdf]
EX1020	Guang	U.S. Patent App. Pub. No. 2017/0303353
EX1021	Esaki	U.S. Patent No. 8,872,437

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EX1022	Physics-Classroom	Wayback Machine capture of <i>Two Types of Connections</i> , The Physics Classroom (Dec. 01, 2011, 12:54 AM), https://www.physicsclassroom.com/Class/circuits/u9l4b.cfm [https://web.archive.org/web/20111201005447/https://www.physicsclassroom.com/Class/circuits/u9l4b.cfm]
EX1023	Nave-1	Wayback Machine capture of Rod Nave, <i>OR Gate</i> , HyperPhysics (Mar. 3, 2004, 3:58 PM), http://hyperphysics.phy-astr.gsu.edu/hbase/Electronic/or.html [https://web.archive.org/web/20040303155843/http://hyperphysics.phy-astr.gsu.edu/hbase/Electronic/or.html]
EX1024	Nave-2	Wayback Machine capture of Rod Nave, <i>Relaxation Oscillator Concept</i> , HyperPhysics (May 1, 2001, 4:38 AM), http://hyperphysics.phy-astr.gsu.edu/hbase/electronic/relaxo.html [https://web.archive.org/web/20010501043853/http://hyperphysics.phy-astr.gsu.edu/hbase/electronic/relaxo.html]
EX1025	Actel	Wayback Machine capture of <i>Using Schmitt Triggers for Low Slew-Rate Input</i> , Actel (Sept. 19, 2014, 1:18AM), http://www.microsemi.com/document-portal/doc_download/130021-ac161-using-schmitt-triggers-for-low-slew-rate-input-app-note [https://web.archive.org/web/20140919011857/http://www.microsemi.com/document-portal/doc_download/130021-ac161-using-schmitt-triggers-for-low-slew-rate-input-app-note]
EX1026		Claim Construction Order, <i>Jiaxing Super Lighting Elec. Appliance Co., Ltd. v. CH Lighting Tech. Co. Ltd.</i> , No. 6:20-CV-00018, Dkt. No. 57 (W.D. Tex. Oct. 24, 2020)
EX1027		Final Jury Instructions, <i>Jiaxing Super Lighting Elec. Appliance Co., Ltd. v. CH Lighting Tech. Co. Ltd.</i> , No. 6:20-CV-00018, Dkt. No. 226 (W.D. Tex. Nov. 4, 2021)

Exhibit	Shorthand	Description
EX1028		Jury Trial Transcript, <i>Jiaxing Super Lighting Elec. Appliance Co., Ltd. v. CH Lighting Tech. Co. Ltd.</i> , No. 6:20-CV-00018, Dkt. No. 238 (W.D. Tex. Dec. 2, 2021)
EX1029		Jury Trial Transcript, <i>Jiaxing Super Lighting Elec. Appliance Co., Ltd. v. CH Lighting Tech. Co. Ltd.</i> , No. 6:20-CV-00018, Dkt. No. 239 (W.D. Tex. Dec. 2, 2021)
EX1030		Defendants' Opposed Motion for Judgment as a Matter of Law Under Federal Rule of Civil Procedure 50(b), <i>Jiaxing Super Lighting Elec. Appliance Co., Ltd. v. CH Lighting Tech. Co. Ltd.</i> , No. 6:20-CV-00018, Dkt. No. 294 (W.D. Tex. Aug. 31, 2022)
EX1031		Plaintiffs' Opposition to Defendants' Motion for Judgment as a Matter of Law Under Federal Rule of Civil Procedure 50(b), <i>Jiaxing Super Lighting Elec. Appliance Co., Ltd. v. CH Lighting Tech. Co. Ltd.</i> , No. 6:20-CV-00018, Dkt. No. 299 (W.D. Tex. Sept. 9, 2022)
EX1032		Defendants' Reply in Support of Motion for Judgment as a Matter of Law Under Federal Rule of Civil Procedure 50(b), <i>Jiaxing Super Lighting Elec. Appliance Co., Ltd. v. CH Lighting Tech. Co. Ltd.</i> , No. 6:20-CV-00018, Dkt. No. 308 (W.D. Tex. Sept. 20, 2022)
EX1033		Amended Memorandum Opinion & Order, <i>Jiaxing Super Lighting Elec. Appliance Co., Ltd. v. CH Lighting Tech. Co. Ltd.</i> , No. 6:20-CV-00018, Dkt. No. 323 (W.D. Tex. Mar. 8, 2023)
EX1034		Plaintiffs Jiaxing Super Lighting Electric Appliance Co., Ltd., and Obert, Inc.'s Preliminary Infringement Contentions, Claim Chart A1, <i>Jiaxing Super Lighting Elec. Appliance Co., Ltd. v. Current Lighting Solutions, LLC d/b/a GE Current</i> , No. 6:22-CV-00534-ADA (W.D. Tex. Oct. 19, 2022)

Exhibit	Shorthand	Description
EX1035		Plaintiffs Jiaxing Super Lighting Electric Appliance Co., Ltd., and Obert, Inc.'s Preliminary Infringement Contentions, Claim Chart A2, <i>Jiaxing Super Lighting Elec. Appliance Co., Ltd. v. Current Lighting Solutions, LLC d/b/a GE Current</i> , No. 6:22-CV-00534-ADA (W.D. Tex. Oct. 19, 2022)
EX1036		Scheduling Order, <i>Jiaxing Super Lighting Elec. Appliance Co., Ltd. v. Current Lighting Solutions, LLC d/b/a GE Current</i> , No. 6:22-CV-00534-ADA, Dkt. No. 31 (W.D. Tex. 2022)
EX1037		Draft of Defendant's Stipulation of Invalidity Contentions to be filed in <i>Jiaxing Super Lighting Elec. Appliance Co., Ltd. v. Current Lighting Solutions, LLC d/b/a GE Current</i> , No. 6:22-CV-00534-ADA (W.D. Tex. 2022)
EX1038		Declaration of Sylvia D. Hall-Ellis, Ph.D.
EX1039		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 pre-institution 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 '140 Patent. A true and correct copy of that agreement is submitted as Exhibit 1039 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 '140 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 '140 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 1039 be treated as business confidential information and be kept separate from the file of the involved patent. Exhibit 1039 contains confidential and competitively sensitive business information that could cause competitive harm to the parties if publicly released.

Dated: October 13, 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 EX1039 were served on Patent Owner via email (by consent) to:

IPRSuperLighting-GECurrent@perkinscoie.com

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