

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NINTENDO CO., LTD., and
NINTENDO OF AMERICA INC.,
Petitioner

v.

POLARIS POWERLED TECHNOLOGIES, LLC,
Patent Owner

Case IPR2023-00778
U.S. Patent No. 8,223,117 B2

JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW

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Patent Trial and Appeal Board
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313

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PATENT OWNER’S UPDATED EXHIBIT LIST

Exhibit No.	Description
2001	Claim Construction Order entered on January 7, 2019, in <i>Polaris PowerLED Techs., LLC v. Samsung Elecs. Am., Inc.</i> , No. 2:17- cv-00715 (E.D. Tex. Jan 7, 2019), ECF No. 138
2002	Claim Construction Order entered on November 26, 2019, in <i>Polaris PowerLED Techs., LLC v. VIZIO, Inc.</i> , No. 8:18-cv-01571 (C.D. Cal. Nov. 26, 2019), ECF No. 212
2003	Claim Construction Order re Supplemental Claim Construction entered on December 23, 2019, in <i>Polaris PowerLED Tech., LLC v. VIZIO, Inc.</i> , No. 8:18-cv-01571 (C.D. Cal. Dec. 23, 2019), ECF No. 264
2004	“Basic Televisions and Video Systems”, Bernard Grob, (1984, 5 th ed.) (“Grob”) [Excerpts]
2005	Patent Owner Supplemental Excerpts from Donald G. Fink, Television Engineering Handbook, First Edition, McGraw-Hill Book Company (1957) (“Fink II”) [Excerpt]
2006	RCA Television User’s Guide, Model CR20310 (2001) [Excerpt]
2007	RCA Television User’s Guide (2004) [Excerpt]
2008	IEEE 100, The Authoritative Dictionary of IEEE Standards Terms, 7 th ed. (2000) (“IEEE Dictionary”) [Excerpts]
2009	Microsoft Computer Dictionary, 5 th ed. (2002) (“MS Computer Dictionary”) [Excerpt]
2010	Office Action dated September 6, 2007, excerpt of the file history of U.S. Patent No. 7,468,722 (“’722 patent”)
2011	Petition for <i>Inter Partes</i> Review, <i>Samsung Electronics Co., Ltd. v. Polaris PowerLED Technologies, LLC</i> , Case No. IPR2018-01262 (P.T.A.B. June 15, 2018), Paper 4

Exhibit No.	Description
2012	Patent Owner's Preliminary Response, <i>Samsung Electronics Co., Ltd. v. Polaris PowerLED Technologies, LLC</i> , Case No. IPR2018-01262 (P.T.A.B. Oct. 26, 2018), Paper 13
2013	Institution Decision, <i>Samsung Electronics Co., Ltd. v. Polaris PowerLED Technologies, LLC</i> , Case No. IPR2018-01262 (P.T.A.B. Jan. 17, 2019), Paper 14
2014	Petition for <i>Inter Partes</i> Review, <i>VIZIO, Inc. v. Polaris PowerLED Technologies, LLC</i> , Case No. IPR2020-00043 (P.T.A.B. Oct. 15, 2019), Paper 2
2015	Public version, Patent Owner's Preliminary Response, <i>VIZIO, Inc. v. Polaris PowerLED Technologies, LLC</i> , Case No. IPR2020-00043 (P.T.A.B. Feb. 6, 2020), Paper 10
2016	Institution Decision, <i>VIZIO, Inc. v. Polaris PowerLED Technologies, LLC</i> , Case No. IPR2020-00043 (P.T.A.B. May 4, 2020), Paper 30
2017	Request for Rehearing Decision, <i>VIZIO, Inc. v. Polaris PowerLED Technologies, LLC</i> , Case No. IPR2020-00043 (P.T.A.B. Sept. 15, 2020), Paper 32
2018	Petition for <i>Inter Partes</i> Review, <i>LG Electronics, Inc. v. Polaris PowerLED Technologies, LLC</i> , Case No. IPR2020-01283 (P.T.A.B. July 16, 2020), Paper 3
2019	Patent Owner's Preliminary Response, <i>LG Electronics, Inc. v. Polaris PowerLED Technologies, LLC</i> , Case No. IPR2020-01283 (P.T.A.B. Dec. 17, 2020), Paper 8
2020	Institution Decision, <i>LG Electronics, Inc. v. Polaris PowerLED Technologies, LLC</i> , Case No. IPR2020-01283 (P.T.A.B. Mar. 9, 2021), Paper 9
2021	Petition for <i>Inter Partes</i> Review, <i>Hisense Co., Ltd. v. Polaris PowerLED Technologies, LLC</i> , Case No. IPR2020-01337 (P.T.A.B. July 21, 2020), Paper 1

Exhibit No.	Description
2022	Patent Owner’s Preliminary Response, <i>Hisense Co., Ltd. v. Polaris PowerLED Technologies, LLC</i> , Case No. IPR2020-01337 (P.T.A.B. Dec. 17, 2020), Paper 9
2023	Institution Decision, <i>Hisense Co., Ltd. v. Polaris PowerLED Technologies, LLC</i> , Case No. IPR2020-01337 (P.T.A.B. Mar. 9, 2021), Paper 11
2024	Reexamination Control No. 90/019,119 Office Action, filed June 2, 2023
2025	Reexamination Control No. 90/019,119 Information Disclosure Statement, filed July 19, 2023
2026	Declaration of Aidan Brewster In Support of <i>Pro Hac Vice</i> Admission, dated January 17, 2024
2027	Reexamination Control No. 90/019,119 Response to Non-Final Office Action, dated Aug. 2, 2023
2028	Reexamination Control No. 90/019,119 Notice of Intent to Issue Reexamination Certificate, dated Nov. 17, 2023
2029	Reexamination Control No. 90/019,119 <i>Ex Parte</i> Reexamination Certificate for U.S. Patent No. 8,223,117, dated Dec. 21, 2023
2030	Declaration of Dr. Robert L. Stevenson (“Stevenson”)
2031	Polaris’ Opening Claim Construction Brief, <i>Polaris PowerLED Techs., LLC v. VIZIO, Inc.</i> , No. 8:18-cv-01571 (C.D. Cal. Sept. 13, 2019), ECF No. 106
2032	(Corrected) Deposition Transcript of R. Jacob Baker, Ph.D., P.E., dated January 26, 2024
2033	Tamara A. Papalias and Mike Wong, <i>Making Sense of Light Sensors</i> , EE Times, July 19, 2006, https://www.eetimes.com/making-senses-of-light-sensors/

Exhibit No.	Description
2034	Renesas Electronics Corporation Application Note, AN1422, Rev.0.00, dated Aug. 28, 2008
2035	U.S. Patent No. 7,270,461 (Chou)
2036	U.S. Patent No. 7,791,694 (Molsen)
2037	Digi-Key Catalog #T032, May-August 2003
2038	Microsemi LX1970 Production Data Sheet, Rev. 1.0, dated April 30, 2003
2039	Microsemi LX1971 Production Data Sheet, Rev. 1.0, dated Nov. 25, 2003
2040	Defendants' Preliminary Claim Constructions and Extrinsic Evidence, <i>Polaris PowerLED Techs., LLC v. Nintendo Co., Ltd., et al.</i> , No. 2:22-cv-00386-JLR (E.D. Tex. Jan. 12, 2023)
2041	Agreement (CONFIDENTIAL)

I. STATEMENT OF RELIEF REQUESTED

Nintendo Co., Ltd., and Nintendo of America Inc. (collectively, “Petitioner”) and Polaris PowerLED Technologies, LLC (“Patent Owner”) (collectively, “the parties”) have entered into a confidential agreement that resolves all underlying disputes between Petitioner and Patent Owner with respect to U.S. Patent No. 8,223,117 (“the ’117 patent”). A copy of the parties’ agreement is being filed with this motion as Exhibit 2041 (the “Agreement”). Patent Owner concurrently files a separate unopposed request that the Agreement be treated as business confidential information and be kept separate from the files of the involved patent, pursuant to 37 C.F.R. § 42.74(c).

Accordingly, pursuant to 37 C.F.R § 42.74 and the authorization provided by the Board on April 24, 2024, the parties jointly request termination of this *inter partes* review proceeding in its entirety.

II. STATEMENT OF FACTS

On April 18, 2024, the parties entered into a confidential Agreement. *See* EX2041 (Confidential). Under the terms of the Agreement, the parties agreed to jointly seek termination of this proceeding.

III. ARGUMENT

A. Termination is appropriate.

IPR proceedings “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); *see also id.* (“If no petitioner remains in the inter partes review, the Office may terminate the review...”). Petitioner and Patent Owner have resolved their dispute regarding the ’117 patent, including both this proceeding and Patent Owner’s assertion of the ’117 patent in the related district court litigation, *Polaris PowerLED Technologies, LLC v. Nintendo Co., Ltd. et al*, Civil Action No. 2:22-cv-00386 (W.D. Wash.). The parties do not anticipate further litigation between them concerning the ’117 patent. The parties are therefore jointly requesting termination of this proceeding. And the Office has not decided the merits of this IPR. Termination of this IPR is therefore appropriate. *See* 35 U.S.C. §317(a).

Good cause exists to terminate this proceeding because the parties have resolved their dispute regarding the ’117 patent. The Board’s Trial Practice Guide stresses that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding.” PTAB November 2019 Consolidated Trial Practice Guide, 86. Further, the proceeding is at an early stage. Petitioner has not yet filed its Reply, and the Office has not decided the merits of the proceeding. Terminating

the proceeding now would serve the interests of judicial economy as well as the mutual interest of the parties.

B. Written Agreement

The parties represent that their entire agreement in connection with the termination of this proceeding is embodied in the Agreement, which has been made in writing. There are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this *inter partes* review.

Pursuant to 35 U.S.C. §317(b), a true and correct copy of the Agreement is filed herewith as Exhibit 2041. The Agreement has been filed for access by the “Parties and Board Only” due to the highly sensitive business confidential information it contains. The parties agree that the Agreement should be maintained as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), and a separate unopposed request to treat the agreement as business confidential information is being filed concurrently.

IV. CONCLUSION

Petitioner and Patent Owner respectfully request that the Board grant the parties' Joint Motion to Terminate this proceeding in its entirety.

Respectfully submitted,

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))

The undersigned certifies that true and correct copies of the foregoing
JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW and
EXHIBIT 2041 (CONFIDENTIAL) were served in their entireties on April 25,
2024, upon the following parties via electronic mail:

Matthew J. Brigham (Lead Counsel)
Andrew C. Mace (Back-Up Counsel)
Patrick W. Lauppe (Back-Up Counsel)
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