

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.

IPR2023-00778
Patent 8,223,117 B2

Before KALYAN K. DESHPANDE, *Vice Chief Administrative Patent Judge*, PHILLIP J. KAUFFMAN, and KARA L. SZPONDOWSKI, *Administrative Patent Judges*.

SZPONDOWSKI, *Administrative Patent Judge*.

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

I. INTRODUCTION

On April 25, 2024, with authorization of the Board, Petitioner Nintendo Co., Ltd. and Nintendo of America, Inc. and Patent Owner Polaris PowerLED Technologies, LLC, (collectively “the Parties”) filed a Joint Motion to Terminate the *inter partes* review in this proceeding pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72 and 42.74. Paper 34 (“Joint Motion”). The Parties also filed a copy of an Agreement (“Agreement”) governing their settlement. Ex. 2041. Patent Owner filed an Unopposed Request to Keep the Agreement Business Confidential and Separate, and stated that “Petitioner does not oppose.” Paper 35 (“Request”).

II. DISCUSSION

In the Joint Motion, the Parties represent that they have “resolved their dispute regarding [U.S. Patent No. 8,223,117 (‘the ’117 patent’)],” “do not anticipate further litigation between them concerning the ’117 patent,” and are “therefore jointly requesting termination of this proceeding.” Joint Motion 2. The Parties further state that the Agreement embodies “their entire agreement in connection with the termination of this proceeding” and that there are “no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this *inter partes* review.” *Id.* at 3. The Parties represent that the filed copy of the Agreement represents a “true and correct copy” of the agreement between them. *Id.*

We instituted a trial in this proceeding on October 18, 2023. Paper 9. This proceeding has not yet advanced to the stage where an oral hearing has been held nor has the Board decided the merits of the proceeding. Under these circumstances, we determine that it is appropriate to terminate this proceeding. We also determine that it is appropriate to treat the Agreement

as business confidential information to be kept separate from the patent file and the files of this proceeding and therefore grant the Request to keep the Agreement separate from the file of the subject patent. *See* 37 C.F.R. § 42.74(c).

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

III. ORDER

Accordingly, it is:

ORDERED that the Joint Motion to Terminate IPR2023-00778 (Paper 34) is *granted*, and this proceeding is *terminated*;

FURTHER ORDERED that Patent Owner's Request to Keep the Agreement as Business Confidential and Separate (Paper 35) is *granted*; and

FURTHER ORDERED that the Agreement shall be kept separate from the file of Patent 8,223,117 B2 and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 37 C.F.R. § 42.74(c).

IPR2023-00778
Patent 8,223,117 B2

PETITIONER:

Matthew Brigham
Andrew Mace
Stephen Smith
Mark Weinstein
Patrick Lauppe
Dena Chen
COOLEY LLP
mbrigham@cooley.com
amace@cooley.com
stephen.smith@cooley.com
mweinstein@cooley.com
plauppe@cooley.com
dchen@cooley.com

PATENT OWNER:

Russell Tonkovich
David Alberti
Sal Lim
KRAMER ALBERTI LIM & TONKOVICH LLP
rtonkovich@feinday.com
dalberti@feinday.com
slim@feinday.com

Jason Fitzsimmons
Michael Specht
Richard Bemben
STERNE, KESSLER, GOLDSTEIN & FOX PLLC
jfitzsimmons-ptab@sternekessler.com
mspecht-ptab@sternekessler.com
rbemben-ptab@sternekessler.com