

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BEAR DOWN BRANDS, LLC DBA VERILUX, INC.,
Petitioner,

v.

THE LITEBOOK COMPANY LTD.,
Patent Owner.

IPR2023-00940 (Patent 7,678,140 B2)
IPR2023-00974 (Patent 6,875,225 B1)

Before JAMES P. CALVE, BARRY L. GROSSMAN, and
GEORGE R. HOSKINS, *Administrative Patent Judges*.

CALVE, *Administrative Patent Judge*.

TERMINATION
Due to Settlement Before Institution of Trial
35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74

I. INTRODUCTION

On August 30, 2023, Petitioner and Patent Owner (collectively, “the Parties”) filed a Joint Motion to Terminate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74 (“Joint Motion”) in each of the above-identified *inter partes* reviews due to settlement. Paper 7 in each proceeding. The Parties previously sought authorization to file a Joint Motion in each proceeding, and we provided that authorization via email on August 24, 2023. *Id.* at 1. The Parties filed a Confidential Settlement and Patent License Agreement (“Settlement Agreement”) in support of each Joint Motion. IPR2023-00940, Ex. 1035; IPR2023-00974, Ex. 1033. The parties filed a Joint Request to Treat Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b) (“Joint Request”). Paper 8 in each proceeding.

II. DISCUSSION

Under 35 U.S.C. § 317(a), “[a]n inter partes review instituted under this chapter 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.” Section 317(a) also provides that the Office may terminate the review if no petitioner remains in the *inter partes* review.

In the Joint Motions, the Parties represent that they have settled their dispute regarding U.S. Patent No. 7,678,140 (“the ’140 patent”) and U.S. Patent No. 6,875,225 (“the ’225 patent”) and the filed copy of the Settlement Agreement is a true and correct copy that represents their entire agreement. Joint Motion 1 (“The parties certify that, other than Exhibit 1035 [1033], the parties have no collateral agreements or understandings in connection with, or in contemplation of, the termination of the *inter partes* review.”).

IPR2023-00940 (Patent 7,678,140 B2)

IPR2023-00974 (Patent 6,875,225 B1)

The Parties represent that the Settlement Agreement resolves their dispute regarding the '140 patent and the '225 patent in each proceeding and in related district court litigation. Joint Motion 1. The parties represent that no further litigation is anticipated between them concerning the '140 patent or the '225 patent, and no related proceedings between them are currently before the Board. *Id.*

The parties assert that good cause exists to terminate each proceeding because the parties have settled their dispute regarding the '140 patent and the '225 patent, and each proceeding is at an early stage. Joint Motion 2.

We have not instituted trial in either proceeding. No briefing has been submitted by either party except a petition that was filed in each proceeding. Paper 2 in each proceeding. Therefore, we are still in the preliminary stages. In these circumstances, we determine that good cause exists to terminate both proceedings.

The parties filed a Joint Request to treat the Settlement Agreement as business confidential information and keep it separate from the files of the '140 patent and the '225 patent in each proceeding. Joint Request 1. After reviewing the Settlement Agreement, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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

IPR2023-00940 (Patent 7,678,140 B2)

IPR2023-00974 (Patent 6,875,225 B1)

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motions are *granted*, and IPR2023-00940 and IPR2023-00974 are *terminated* with respect to Petitioner and Patent Owner, pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Requests are *granted*, and the Settlement Agreement shall be treated as business confidential information and shall be kept separate from the files of the above-referenced patents, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

IPR2023-00940 (Patent 7,678,140 B2)

IPR2023-00974 (Patent 6,875,225 B1)

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