

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIDENDUM PRODUCTION SOLUTIONS, INC.,
Petitioner,

v.

ROTOLIGHT LIMITED,
Patent Owner.

IPR2023-01218
Patent 10,845,044 B2

Before JEFFREY W. ABRAHAM, KIMBERLY McGRAW, and
AVELYN M. ROSS, *Administrative Patent Judges*.

ROSS, *Administrative Patent Judge*.

JUDGMENT

Terminating the Proceeding and
Granting Request to Treat Settlement Agreement as
Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74

On December 11, 2024, with our prior authorization, Videndum Production Solutions Inc. (“Petitioner”) and Rotolight Ltd. (“Patent Owner”) (collectively, “the parties”) filed a Joint Motion to Terminate. Paper 17 (“Motion”). Together with the Motion, the parties filed a copy of their written Settlement Agreement (Ex. 1013, “Agreement”) and a Joint Request to File Settlement Materials as Business Confidential Information and to Maintain Said Materials Separate from the Public File Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 38 (“Joint Request”).

The Board generally expects that a case “will terminate after the filing of a settlement agreement, unless the Board has already decided the merits.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012); *see* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72. We instituted an *inter partes* review in this case on October 16, 2024. Paper 15. Patent Owner has not yet filed a Patent Owner Response. The parties indicate that “the settlement completely resolves the controversy between Patent Owner and Petitioner relating to U.S. Patent No. 10,845,044 B2.” Motion, 2. The parties also “confirm that all other litigation between the parties to this [*inter partes* review] involving the ’ 044 Patent has been resolved, including *Rotolight Limited v. Videndum PLC, et al.* pending in the United States District Court for the District of Delaware, Civil Action No. 1-22-cv-00928.” *Id.* at 3. The parties further represent that the Agreement constitutes the entire agreement between the parties. *See generally* Agreement. Under these circumstances, we determine that it is appropriate to enter judgment and terminate this proceeding without

rendering a final written decision. *See* 35 U.S.C. § 317(a); 37 C.F.R. §§ 42.5(a), 42.72.

Further, after reviewing the Joint Request and the Agreement, we find that the Settlement contains confidential business information regarding the terms of the settlement and that good cause exists to treat the Agreement as business confidential information to be kept separate from the patent file. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c). This Paper does not constitute a Final Written Decision under 35 U.S.C. § 318(a).

ORDER

In view of the foregoing, it is

ORDERED that the Joint Request to File the Settlement Materials as Business Confidential Information and to Maintain Said Materials Separate from the Public File (Paper 18) is granted;

FURTHER ORDERED that the Settlement Agreement (Ex. 1013) shall be treated as business confidential information and shall be kept separate from the patent file; and

FURTHER ORDERED that the Joint Motion to Terminate (Paper 17) is granted and this proceeding is hereby terminated.

IPR2023-01218
Patent 10,845,044 B2

For PETITIONER:

David Magee
Trenton Ward
GREENBERG TRAURIG, LLP
david.magee@gtlaw.com
trenton.ward@gtlaw.com

For PATENT OWNER:

Bradley Liddle
Michael Pomeroy
Scott Breedlove
Lithaw Lim
CARTER ARNETT PLLC
bliddle@carterarnett.com
sbreedlove@carterarnett.com
mpomeroy@carterarnett.com
hlim@carterarnett.com