

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NICHIA CORP.,

Petitioner,

v.

BX LED LLC,

Patent Owner.

Case No.: IPR2024-00542

U.S. Patent No. 8,567,988

JOINT MOTION TO TERMINATE PROCEEDINGS

I. PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a), Petitioner Nichia Corporation and Patent Owner BX LED LLC jointly request that this *inter partes* review proceeding involving U.S. Patent No. 8,567,988 ("the '988 patent") be terminated based on a settlement between Petitioner and Patent Owner ("the Parties") with respect to the '988 patent and other patents owned by Patent Owner.

II. REASONS FOR GRANTING THE MOTION

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). The Board authorized filing of the instant motion on July 10, 2024. Guidance as to the content of a motion to terminate is provided in IPR2013-00428, Paper No. 56. There, the Board indicated that a joint motion, such as this one, should (a) include a brief explanation as to why termination is appropriate; (b) identify all parties in any related litigation involving the patent at issue; (c) identify any related proceedings currently before the Office; and (d) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding. *Id.* at 2. This motion satisfies each of the above requirements and is accompanied by the Parties' settlement agreement, as

required by 35 U.S.C. § 317(b) and 35 C.F.R. § 42.74 (b).

a. Brief Explanation of Why Termination is Appropriate

Termination is appropriate because the Board has not decided whether to institute this *inter partes* review proceeding, no patent owner response or further papers have been filed, oral argument has not been held, the Board has not decided the merits of the proceeding, and a final written decision has not been issued. Under 35 U.S.C. § 317(a), this proceeding "shall be terminated with respect to [] [P]etitioner" because the parties are jointly requesting termination and the Office has not yet "decided the merits of the proceeding before the request for termination is filed." Further, termination with respect to all parties is appropriate because the Parties have resolved their disputes with respect to the '988 patent, no litigation is pending between the Parties, and Patent Owner has provided Petitioner, its Affiliates, and their respective vendors, suppliers, manufacturers, developers, distributors, contractors, partners, hosts, customers and end-users a license and covenant not to sue under the '988 patent.

b. All Parties in Any Pending Related Litigation Involving the Patent at Issue

The following litigations are/were related to the '988 patent:

Caption, Case Number, and Court	Status
<i>Everlight Electronics Co., Ltd. v. Bridgelux, Inc.</i> , 4-	Terminated 12/14/2018

17-cv-03363 (CAND)	
<i>BX LED LLC v. Wayfair LLC</i> 6-22-cv-00446 (WDTX)	Terminated 2/27/2023
<i>BX LED LLC v. Walmart Inc. f/k/a Walmart Stores, Inc.</i> 6-22-cv-00445 (WDTX)	Terminated 8/31/2023
<i>BX LED LLC v. Home Depot USA, Inc. d/b/a The Home Depot</i> 6-22-cv-00444 (WDTX)	Terminated 12/22/2022
<i>BX LED LLC v. Lowe's Companies, Inc. et al</i> 6-23-cv-00451 (WDTX)	Pending – Stayed pending settlement 5/29/2024
<i>BX LED LLC v. RAB Lighting Inc.</i> 3-23-cv-01323 (NDTX)	Terminated 9/1/2023
<i>BX LED LLC v. Keystone Technologies LLC</i> 3-23-cv-02862 (NDTX)	Pending – Motion to Dismiss filed 4/3/2024
<i>BX LED LLC v. Current Lighting Solutions, LLC</i> 6-24-cv-00095 (WDTX)	Pending

c. Related Proceedings Currently Before the Office

The same Parties are before the Board in connection with IPR2024-00544 concerning US Patent 7,973,465. A similar Motion to Terminate that proceeding is being filed concurrently herewith.

U.S. Patent No. 8,567,988 was previously at issue in *EVERLIGHT ELECTRONICS CO., LTD. v. BRIDGELUX, INC.*, IPR 2018-01483 (PTAB) (terminated 12/10/2018).

d. Current Status of Each Such Related Litigation or Proceeding

With Respect to Each Party in the Litigation or Proceeding

Sections II.b and II.c above indicate the status of each related litigation or proceeding with respect to each party to the litigation or proceeding.

III. SETTLEMENT AGREEMENT

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the Parties' settlement agreement is in writing, and a true and correct copy is being filed concurrently herewith as BX LED Exhibit 2001.¹ There are no other agreements, oral or written, between the Parties made in connection with, or in contemplation of, the termination of these proceedings. The Parties are also filing concurrently herewith a joint request under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) to treat the settlement agreement, Ex. 2001, as business confidential information and keep them separate from the files of the '988 patent.

IV. CONCLUSION

¹ The settlement agreement is being filed via the P-TACTS system with access to the "Parties and Board Only."

For all these reasons, the Parties respectfully request termination of this proceeding.

Respectfully submitted,

Dated: July 10, 2024

/Patrick Colsher/

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EXHIBIT LIST

Exhibit No.	Description
2001	Confidential Settlement Agreement between BX LED LLC and Nichia Corporation, dated July 3, 2024 (Parties & Board Only)

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing
JOINT MOTION TO TERMINATE PROCEEDINGS

and its associated exhibits was served on July 10, 2024, by filing this document through the PTAB P-TACTS System as well as by delivering a copy via email directed to the attorneys of record for the Petitioner at the following address:

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Respectfully submitted,

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