

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NICHIA CORP.,
Petitioner,

v.

BX LED LLC,
Patent Owner.

IPR2024-00542 (Patent 8,567,988 B2)
IPR2024-00544 (Patent 7,973,465 B2)¹

Before DONNA M. PRAISS, JEFFREY W. ABRAHAM,
ELIZABETH M. ROESEL, and SHELDON M. MCGEE,
*Administrative Patent Judges.*²

PRAISS, *Administrative Patent Judge.*

DECISION

*Granting Joint Motions to Terminate Proceedings Due to
Settlement before Institution and
Granting Joint Requests to Treat Settlement Agreement as
Business Confidential Information
37 C.F.R. § 42.74*

¹ This Order applies to each of the listed cases. We exercise our discretion to issue one Order to be docketed in each case. The parties, however, are not authorized to use this caption for any subsequent papers.

² This listing of Administrative Patent Judges does not reflect an expanded panel. This order addresses multiple proceedings that collectively involve more than three Administrative Patent Judges.

Petitioner and Patent Owner (collectively, “the Parties”) filed a Joint Motion to Terminate Proceedings in each of the above-identified proceedings. Paper 7 (“Joint Motion”).³ The Parties previously sought authorization to file the Joint Motions and received that authorization on July 10, 2024. Joint Motion 2. The Parties also filed copies of a settlement agreement (Ex. 2001, “Settlement Agreement”) and filed a Joint Motion to File Settlement Agreement as Business Confidential Information (Paper 8, “Joint Request”) in each of the above-identified proceedings.

In the Joint Motions, the Parties represent that their disputes with respect to U.S. Patent No. 8,567,988 B2 and U.S. Patent No. 7,973,465 B2 have been resolved, that the Settlement Agreement is “a true and correct copy,” and “[t]here are no other agreements, oral or written, between the Parties made in connection with, or in contemplation of, the termination of these proceedings.” Joint Motion 3, 5.

We have not yet instituted a trial in the above-identified proceedings. Nor have we decided the merits of the proceedings, and final written decisions have not been entered in the proceedings. The Parties have shown adequately that termination of the proceedings is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceedings with respect to the Parties.

The Parties also requested that the Settlement Agreement be treated as business confidential information and be kept separate from the files of U.S. Patent No. 8,567,988 B2 and U.S. Patent No. 7,973,465 B2. Joint Request

³ For expediency, we cite to the Motions and Exhibit filed in IPR2024-00542, unless otherwise indicated. Similar papers were filed in IPR2024-00544.

IPR2024-00542 (Patent 8,567,988 B2)

IPR2024-00544 (Patent 7,973,465 B2)

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 between the Parties as business confidential information pursuant to 37 C.F.R. § 42.74(c).

In addition:

The parties further jointly request that the Board order that in the event a person or entity makes a written request, as stated in 37 C.F.R. § 42.74(c)(1)–(2), for access to the Agreement, that any such written request be served upon the parties on the day the written request is provided to the Board.

Id. However, 37 C.F.R. § 42.74 does not state that the Office will serve such notice on the parties if a written request is made. Therefore, we deny this request.

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

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motions are *granted*, and IPR2024-00542 and IPR2024-00544 are *terminated* with respect to Petitioner and Patent Owner; and

FURTHER ORDERED that the Joint Requests are *granted*, and the Settlement Agreement shall be kept separate from the files of U.S. Patent No. 8,567,988 B2 and U.S. Patent No. 7,973,465 B2 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).

IPR2024-00542 (Patent 8,567,988 B2)

IPR2024-00544 (Patent 7,973,465 B2)

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