UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NICHIA CORP.,

Petitioner,

v.

BX LED LLC,

Patent Owner.

Case No.: IPR2024-00544

U.S. Patent No. 7,973,465

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. 7,973,465 ("the '465 patent") be terminated based on a settlement between Petitioner and Patent Owner ("the Parties") with respect to the '465 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 '465 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 '465 patent.

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

The following litigations are/were related to the '465 patent:

Caption, Case Number, and Court	Status
BX LED LLC v. Wayfair LLC	Terminated 2/27/2023

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

c. Related Proceedings Currently Before the Office

The same Parties are before the Board in connection with IPR2024-00542 concerning US Patent 8,567,988. A similar Motion to Terminate that proceeding is being filed concurrently herewith.

d. Current Status of Each Such Related Litigation of 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. § 31 7(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 ’465 patent.

IV. CONCLUSION

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

Respectfully submitted,

Dated: July 10, 2024

/Patrick Colsher/
Patrick Colsher (Reg. No. 74,955)
REICHMAN, JORGENSEN,

/Tarek N. Fahmi/
Tarek N. Fahmi (Reg. No. 41,402)
Ascenda Law Group, PC

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

LEHMAN & FELDBERG LLP
100 Marine Parkway, Suite 300
Redwood Shores, CA 94065
pcolsher@reichmanjorgensen.com

Attorneys for Petitioner
Nichia Corporation

2150 N First St., Suite 420
San Jose, CA 95131

tarek.fahmi@ascendalaw.com

Attorneys for Patent Owner
BX LED LLC

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 though 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:

Patrick Colsher
Matthew G. Berkowitz
Khue Hoang
Connor S. Houghton
Reichman Jorgensen Lehman & Feldberg LLP
100 Marine Parkway, Suite 300
Redwood Shores, CA 94065

Email:
pcolsher@reichmanjorgensen.com
mberkowitz@reichmanjorgensen.com
khoang@reichmanjorgensen.com
choughton@reichmanjorgensen.com
rj_nichiabxled@reichmanjorgensen.com

Respectfully submitted,

Dated: July 10, 2024

/Tarek N. Fahmi/
Tarek N. Fahmi
Reg. No. 41,402

Ascenda Law Group, PC
2150 N. First St., Suite 420
San Jose, CA 95131
Tel: 866-877-4883
Email: patents@ascendalaw.com