UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE

THE PATENT TRIAL AND APPEAL BOARD

IKEA Supply AG

Petitioner

v.

Everlight Electronics Co., Ltd.,

Patent Owner

Patent No. 9,640,733 to Hsieh *et al.* IPR Case No.: IPR2024-00972

JOINT MOTION TO TERMINATE THE PROCEEDING

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. §§ 42.72 and 42.74, and the Board's prior authorization of January 7, 2025, Petitioner IKEA Supply AG ("Petitioner" or "IKEA") and Patent Owner Everlight Electronics Co., Ltd., ("Patent Owner" or "Everlight") (collectively, the "Parties") jointly move to terminate this *inter partes* review (IPR) proceeding in light of the settlement of their dispute regarding U.S. Patent No. 9,640,733 (the "'733 patent").

I. Procedural Background

IKEA's Petition in this proceeding was filed on May 31, 2024. Everlight filed its mandatory notices pursuant to 37 C.F.R. § 42.8 on June 21, 2024. Everlight did not file a preliminary response to IKEA's petition. The Board instituted the IPR on December 12, 2024.

On December 19, 2024, the Parties entered into a settlement agreement that resolves the Parties' dispute regarding the '733 patent (Confidential Exhibit 1025). The Parties contacted the Board by email to request authorization to file this Joint Motion to Terminate and the concurrently filed Joint Request to Treat Settlement Agreement as Business Confidential Information on January 6, 2025. The Board authorized both filings in a responsive email on January 7, 2025.

II. The Parties' Joint Motion to Terminate Should be Granted

The Board states that "[t]here are strong public policy reasons to favor settlement between the parties to a proceeding." Consolidated Trial Practice Guide

(November 2019), § II.N. The Board further explains that it "expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding." Consolidated Trial Practice Guide (November 2019), § II.N (citing 35 U.S.C. § 317(a)).

Termination of this proceeding is appropriate because the Parties have settled their dispute regarding the '733 patent and have executed a settlement agreement to terminate this proceeding, as well as the Parties' related district court litigation concerning the '733 patent – *Everlight Electronics Co., Ltd. v. IKEA US Retail LLC, et al.*, No 6:23-cv-00481-AM-DTG (W.D. Tx. filed Jul. 5, 2023). The Parties' related district court litigation concerning the '733 patent – *Everlight Electronics Co., Ltd. v. IKEA US Retail LLC, et al.*, No 6:23-cv-00481-AM-DTG (W.D. Tx. filed Jul. 5, 2023) – was terminated on January 6, 2025. The Board has yet to make a final determination on the merits in this proceeding. There is no other litigation between the Parties involving the '733 patent beyond the present proceeding.

35 U.S.C. § 317(b) further requires that any settlement agreement "shall be filed in the Office before the termination of the *inter partes* review as between the parties." Pursuant to 35 U.S.C. § 317(b), a true and correct copy of the Parties' settlement agreement is being filed along with this paper as Confidential Exhibit 1025. The Parties further certify that there are no other agreements or understandings

between the parties, including any collateral agreements, made in connection with, or in contemplation of, the termination of this proceeding. The Parties are also concurrently filing a joint request under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) to treat the settlement agreement as business confidential information and to be kept separate from the files of the patent-at-issue.

III. Conclusion

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

Respectfully submitted,

FLASTER GREENBERG P.C.

Date: January 16, 2025

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Certificate Of Service

I hereby certify that on January 16, 2025, a copy of the foregoing Joint Motion to Terminate Proceeding was served by electronic means, as agreed by the parties, to Patent Owner's counsel of record via the following email addresses:

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Harrison, Bryan Bryan.Harrison@troutman.com

Respectfully submitted,
FLASTER GREENBERG P.C.

Date: January 16, 2025

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