

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MINKA LIGHTING, LLC,
Petitioner,

v.

WANGS ALLIANCE CORPORATION,
Patent Owner.

IPR2024-01027
Patent 11,028,854 B2

Before ELIZABETH M. ROESEL, JOHN A. HUDALLA, and
DONALD E. DAYBELL, *Administrative Patent Judges*.

DAYBELL, *Administrative Patent Judge*.

ORDER
Denying Without Prejudice Motion to Terminate
37 C.F.R. § 42.74

I. INTRODUCTION

With our authorization (*see* Ex. 1038), the parties filed a “Joint Motion to Terminate.” Paper 7 (“Mot.”). Along with the Joint Motion, the parties filed a copy of “Complainant’s Unopposed Motion to Suspend the Procedural Schedule and to Terminate the Investigation in Its Entirety” (“Agreement,” Ex. 1039).

The parties are required to file a true and complete copy of their settlement papers in accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). Specifically, this includes “[a]ny agreement or understanding between the parties made in connection with, or in contemplation of, the termination.” 37 C.F.R. § 42.74(b).

Referring to the Agreement, the Motion states it “is the entire agreement between the parties.” Mot. 2; *see also* Agreement, 2–3 (“*subject to footnote 1* here, there are no other agreements, written or oral, express or implied, between Complainant and Respondents concerning the subject matter of this Investigation”) (emphasis added). The Agreement states that “[o]n July 3, 2024, Minka Lighting will file a request with the Board to seek its permission to move to terminate its petition for *inter partes* review in IPR2024-01027 and will file the motion to terminate within one business day of receiving the Board’s authorization.” Agreement at 3, n.1.

The parties also filed a “Joint Request to File Agreement as Business Confidential Information.” Paper 8.

II. DISCUSSION

In the Joint Motion, the parties represent that they have reached an agreement to jointly seek termination of the above-identified *inter partes* review proceeding, and that the filed copy of the Settlement Agreement is a

“true copy” and “the entire agreement between the parties.” Mot. 1, 2. The parties further represent that their Settlement Agreement resolves all currently pending ITC, Patent Office, and District Court proceedings between the parties involving the above-identified patent at issue. *Id.*

However, even though the Motion states the Agreement is the “entire agreement between the parties,” the Agreement states that, at least as to

[REDACTED]:

1. Certain parties have “confidentially reached an oral resolution in principle”; Ex. 1039, 3 n.1.
2. The “consideration” for the [REDACTED] includes “terms that continue to be discussed”; *Id.*
3. “No written agreement has yet been drafted or executed . . . as to this resolution in principle.” *Id.*

The applicable statute and rules require that any agreement or understanding between a patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of an AIA proceeding shall be in writing and a true copy (i.e., an accurate, unaltered/unredacted copy of the *complete* original agreement) of such agreement or understanding shall be filed in the Office before the termination of proceeding as between the parties. *See* 35 U.S.C. § 317(b), 37 C.F.R. § 42.74(b); *see also* *DTN, LLC v. Farms Technology, LLC*, IPR2018-01412 (2020) (precedential), Paper 21, 10 (“the two Collateral Agreements fall under the ambit of 35 U.S.C. § 317(b) as agreements that must be filed in the Office before these two proceedings may be terminated.”).

In this case, there appear to be both oral and as-yet-unresolved terms

that are, or will become, part of the Agreement (or a collateral agreement referred to in the Agreement), and that have not been filed in writing in this proceeding. As such, termination of the proceeding appears to be premature at this time. We therefore *deny* the Motion to Terminate, without prejudice.

In view of the circumstances, the parties are authorized to file a Renewed Joint Motion to Terminate that complies with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b) and specifically addresses points 1, 2, and 3 noted above

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motion to Terminate (Paper 7) and Joint Request to File the Agreement as Business Confidential Information (Paper 8) are *denied* without prejudice;

FURTHER ORDERED that the parties may refile a motion to terminate, and, if needed, a request to treat as business confidential any agreement filed therewith, after the completion of settlement negotiations; and

FURTHER ORDERED that the parties shall jointly file a proposed redacted version of this Order, or, in the alternative, a Notice stating that the Order does not contain any confidential information, by August 28, 2024.

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