

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MINKA LIGHTING, LLC
Petitioner,

v.

WANGS ALLIANCE CORPORATION
Patent Owner.

Case No. IPR2024-01027
U.S. Patent No. 11,028,854

RENEWED JOINT MOTION TO TERMINATE

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EXHIBIT LIST

No.	Short Name	Reference
1001	'854 Patent	Certified copy of U.S. Patent No. 11,028,854 to Stefankiewicz et al.
1002	'854 File Hist.	Certified File Prosecution History of the '854 Patent
1003	Min Decl.	Expert Declaration of Paul Min, Ph.D.
1004	Min CV	Curriculum Vitae of Paul Min
1005	Markman Order	Inv. No. ITC-337-TA-1374 – Order Construing Terms of the Asserted Claims
1006	<u>Qirong</u>	Certified translation of Chinese Utility Model Patent No. 206738206
1007	<u>Yun</u>	Certified translation of Chinese Utility Model Patent No. 204783774
1008	<u>McPherson</u>	U.S. Patent Publication No. 2015/0325112
1009	Hunter Fan	Hunter Fan Co., M3602-01 Installation Guide (2016)
1010	Suro	U.S. Patent Publication No. 2013/0073431
1011	Fanimation	Fanimation, 2017 Showroom Collection
1012	Ahmed	Ahmed et al., Design and Construction of a Remote Controlled Fan Regulator, Leonardo Electronic Journal of Practices and Technologies Issue 9 pp. 55-62 (July 2006)
1013	Lach	Lach et al., Smart Home System Operating Remotely Via 802.11b/g Wireless Technology (January, 2007)
1014	Mehta	U.S. Patent No. 5,689,261 to Mehta et al.
1015	Hart	U.S. Patent No. 5,041,825 to Hart et al.
1016	McDonough	U.S. Patent No. 6,120,262 to McDonough et al.
1017	Mangla	Mangla et al., A Comprehensive Review: Internet of Things (IOT), IOSR Journal of Computer Engineering, Vol. 19, Issue 4, pp 62-72 (July, 2017)

1018	Sailaja	Sailaja et al., Literature Survey on Real World Applications using Internet of Things, 2018 IADS International Conference on Computing, Communications & Data Engineering (April, 2018)
1019	Matsuoka	U.S. Patent Publication No. 2014/0101082
1020	Li	Li et al., Research and application on the smart home based on component technologies and Internet of Things, pp 2087-92 (2011)
1021	Haiku Guide	Big Ass Fans, Haiku 60 Installation Guide (2014)
1022	Haiku Case Study	Big Ass Fans, Kinetis MCUs – The Brain Behind a Remarkably Smart Fan (2016)
1023	Bauer	U.S. Patent Publication No. 2015/0137941
1024	Festus	Festus et al., Development of a Rechargeable Fan, pp 43-46 (September, 2017)
1025	Weidong	Certified translation of Chinese Utility Model Patent No. 204716567
1026	Stay Order	<i>Minka Lighting, LLC v. Wangs Alliance Corp.</i> , Case No. 5-23-cv-02493-AB-SHK, (C.D. Cal.) – Order Granting Plaintiff’s Unopposed Motion to Stay Pending Resolution of Related ITC Proceeding
1027	Computer Dictionary	Microsoft Computer Dictionary, Fifth Edition, Microsoft Press (2002)
1028	Oxford Computer Dictionary	Oxford Dictionary of Computer Science, Seventh Edition, Oxford University Press (2016)
1029	Oxford English Dictionary	Oxford English Dictionary, <i>synchronize</i> (2016), https://www.oed.com/dictionary/synchronize_v?tl=true
1030	Haiku Technical Specifications	Big Ass Fans, Haiku 60 Technical Specifications (2015)

1031	'152 Provisional Application	U.S. Provisional Patent Application No. 62/617152
1032	'274 Provisional Application	U.S. Provisional Patent Application No. 62/617274
1033	ARM Spec.	Specification for ARM Cortex-M4 processor
1034	Mason	U.S. Patent 78,674
1035	Fan Histroy	LA Times, "Whirlwind History of Ceiling Fans" (1997).
1036	WAC Claim Construction	Inv. No. ITC-337-TA-1374 – WAC Opening Claim Construction Brief
1037	Minka Claim Construction	Inv. No. ITC-337-TA-1374 – Minka Opening Claim Construction Brief
1038	Auth. Email	Email authorizing the parties to file a joint motion to terminate the proceeding and a joint request to treat the settlement agreement as business confidential
1039	Motion to Terminate	[CONFIDENTIAL] Complainant's Unopposed Motion to Suspend the Procedural Schedule and to Terminate the Investigation in its Entirety

2001 (NEW)	Lahav Declaration	Declaration of Etia Lahav in Support of Complainant Wangs Alliance Corporation D/B/A WAC Lighting's Unopposed Motion to Suspend the Procedural Schedule and to Terminate
2002 (NEW)	ITC Order 23	Order 23, Initial Determination Terminating the Investigation

I. INTRODUCTION

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72, 42.74, Petitioner Minka Lighting, LLC (“Petitioner”) and Patent Owner Wangs Alliance Corp. (“Patent Owner”) jointly move to terminate this *inter partes* review proceeding (IPR2024-01027) pursuant to a confidential agreement related to U.S. Patent No. 11,028,854 (the “’854 Patent”), the patent subject to the instant proceeding.

The Board authorized the parties to file a joint motion on July 24, 2024, EX1038, which was originally filed on August 6, 2024. *See* Paper 7. The Board denied the motion without prejudice on August 21, 2024, and authorized the parties to file a Renewed Motion to Terminate that addresses certain points raised by the Board. *See* Paper 10. The parties are submitting this renewed joint motion to terminate, as well as a true copy of the agreement reached between the parties, (EX1039), and additional filings that make clear that EX1039 is the only agreement between the parties relating to the ’854 Patent. Because Minka Lighting, LLC is the only Petitioner in this *inter partes* review proceeding, the agreement resolves all disputes related to the ’854 Patent, and this proceeding should be terminated as to both Petitioner and Patent Owner.

II. THE REQUESTED RELIEF IS WARRANTED

On Sep. 20, 2023, Patent Owner WAC filed a complaint in the International Trade Commission (“ITC Investigation”). *See Smart Ceiling Fans, Components Thereof, and Associated Systems and Software*; Inv. No. 337-TA-1374 (ITC).

On June 13, 2024, Petitioner filed a petition for *inter partes* review in this proceeding. Paper 1. On July 2, 2024, Patent Owner and Petitioner came to an agreement that resolved the underlying dispute in this *inter partes* review proceeding, the ITC Investigation, and several other pending cases. EX1039.

On July 3, 2024, Patent Owner WAC moved to terminate the ITC investigation. EX1039. The parties’ agreement is memorialized within WAC’s motion to terminate the ITC investigation, including its agreement with respect to this IPR. EX1039, 3 n.1; *see also* EX2001, EX2002. On August 2, 2024, WAC submitted a declaration confirming that the entirety of the parties’ agreement was captured in Footnote 1 of Complainant’s Unopposed Motion to Suspend the Procedural Schedule and to Terminate the Investigation in Its Entirety, and that “no further agreements between the or among the parties, written or oral, are forthcoming.” EX2001.

On August 14, 2024, the ALJ issued an Initial Determination granting Complainant’s Unopposed Motion to Suspend the Procedural Schedule and to Terminate the Investigation in Its Entirety. EX2002.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true copy of the parties' agreement resolving the dispute in this proceeding was submitted as EX1039 by the parties, along with a request that the agreement is treated as business confidential information to be kept separate from the files of this proceeding under 37 C.F.R. § 42.74(c). Paper 14. The agreement memorialized in EX1039 is the complete agreement between the parties. No other agreements, written or oral exist outside of EX1039, or are forthcoming. *See* EX2001. EX1039, EX2001, and the statements herein fully address points 1, 2, and 3 in Paper 10.

Therefore, the parties certify that there are no other collateral agreements or understandings made in connection with, or in contemplation of, the termination of this proceeding under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), which are not reflected in WAC's motion to terminate. *See* EX2001.

Termination of this proceeding is appropriate here because all disputes between Petitioner and Patent Owner regarding the '854 Patent have been resolved. Joint motions to terminate because of settlement are routinely granted. Moreover, termination is proper because these proceedings are still at an early stage—the petition was filed recently, Patent Owner has not filed a preliminary response, and the Board has not issued a decision on institution. *See Samsung Elecs. Co. v. Fundamental Innovation Sys. Int'l, Ltd.*, IPR2018-00605 (PTAB July 16, 2018) (Paper No. 10).

III. CONCLUSION

Accordingly, the parties respectfully request termination of this proceeding.

Dated: September 3, 2024

Respectfully Submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on this 3rd day of September, 2024, I caused to be served a true and correct copy of the foregoing and any accompanying exhibits by email on the following counsel:

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