

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MINKA LIGHTING, LLC,  
Petitioner,

v.

WANGS ALLIANCE CORPORATION,  
Patent Owner.

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IPR2024-01027  
Patent 11,028,854 B2

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

DAYBELL, *Administrative Patent Judge*.

DECISION  
Settlement Prior to Institution of Trial  
37 C.F.R. § 42.74

## I. INTRODUCTION

On September 3, 2024, with Board authorization (*see* Papers 12, 13), the parties filed a “Renewed Joint Motion to Terminate.” Paper 14 (“Mot.”). Along with the parties’ original Joint Motion to Terminate (Paper 7), the parties filed a copy of Patent Owner’s “Unopposed Motion to Suspend the Procedural Schedule and to Terminate the Investigation in Its Entirety” (“Agreement,” Ex. 1039), a document Patent Owner originally filed in an International Trade Commission (“ITC”) investigation involving the parties and the challenged patent.

The parties also filed a “Renewed Joint Request to File Agreement as Business Confidential Information.” Paper 15.

## II. DISCUSSION

On June 13, 2024, Petitioner filed a Petition requesting *inter partes* review of claims 1–4 and 8–10 of U.S. Patent No. 11,028,854 B2. Paper 2.

In the Renewed Joint Motion, the parties represent that “all disputes between Petitioner and Patent Owner regarding the ’854 Patent have been resolved.” *Id.* at 3.

The parties further represent that 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.” Mot. 3; *see also id.* (“[T]he 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 [Patent Owner’s] motion to terminate [the ITC investigation].”).

Referring to the Agreement, the Renewed Motion states the parties also provided “additional filings that make clear that EX1039 is the only agreement between the parties relating to the ’854 Patent.” Mot. 1. In addition, the Motion indicates that, as to the related ITC investigation, “[o]n 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.” Mot. 2 (citing Ex. 2002).

The parties represent that Exhibit 2001, cited throughout the Motion, is “a declaration confirming that the entirety of the parties’ agreement was captured in Footnote 1 of [Patent Owner’s] Unopposed Motion to Suspend the Procedural Schedule and to Terminate the [ITC] Investigation in Its Entirety, and that ‘no further agreements between the or among the parties, written or oral, are forthcoming.’” Mot. 2 (citing Ex. 2001). We accept the parties’ representations that the agreement reflected in Exhibit 1039 is the only agreement resolving the dispute between the parties, and that there are and will be no other agreements, oral or written, between the parties relating to the ’854 Patent.

This proceeding is at an early stage, and we have not yet decided whether to institute a trial in the proceeding. In view of the early stage of the proceeding and the settlement between the parties, we determine that good cause exists to dismiss the petition, and terminate the proceeding with respect to the parties.

The parties also filed a Renewed Joint Request that the Agreement be treated as business confidential information and be kept separate from the file of the patent involved in this *inter partes* proceeding. Paper 15. After reviewing the Agreement between Petitioner and Patent Owner, we find that

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the Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Agreement between Petitioner and Patent Owner as business confidential information pursuant to 37 C.F.R. § 42.74(c).

### III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Renewed Joint Motion to Terminate (Paper 14) is *granted*, the Petition is dismissed, and the above proceeding is *terminated*;

ORDERED that the parties' Renewed Joint Motion to treat the Agreement as business confidential (Paper 15) is *granted*, and the Agreement (Ex. 1039) shall remain designated as "Parties and Board Only" in Board's filing system, shall made available only to Federal Government agencies on written request, or to any person on a showing of good cause, and shall be kept separate from the files of the involved patents and associated preliminary proceedings, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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