

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENERATION BRANDS LLC,
Petitioner,

v.

LIGHTING SCIENCE GROUP CORP.,
Patent Owner.

Case IPR2016-01478 (Patent 8,201,968 B2)
Case IPR2016-01546 (Patent 8,967,844 B2)¹

Before KEVIN F. TURNER, PATRICK M. BOUCHER, and
JOHN A. HUDALLA, *Administrative Patent Judges*.

HUDALLA, *Administrative Patent Judge*.

ORDER
Denying Without Prejudice Motions to Terminate the Proceedings
37 C.F.R. § 42.72

¹ This Order pertains to both of these cases. Therefore, we exercise our discretion to issue a single Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

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On March 13, 2017, the parties attempted to file, in both of the instant cases, a joint motion to terminate the trial on the basis of a settlement reached by the parties. *See* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72. The parties also filed a copy of their written settlement agreement, a collateral settlement agreement, and a separate request to treat the settlement papers as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). *See* Case IPR2016-01478, Papers 10–13; Case IPR2016-01546, Papers 13–16. We authorized the joint motions to terminate in an email dated March 13, 2017. Because the joint motions are deficient in a number of ways, we deny the motions to terminate without prejudice.

At the outset, we note that the document in Case IPR2016-01546 listed as the joint motion to terminate is actually a second copy of the parties’ request to treat the settlement papers as confidential information. *See* Case IPR2016-01546, Paper 13. As such, no motion to terminate has been filed in that case.

In both cases, the parties have filed a collateral agreement in addition to the main settlement agreement. *See* Case IPR2016-01478, Papers 13; Case IPR2016-01546, Papers 16. This collateral agreement contains a redaction. Therefore, contrary to the parties’ representations, the parties have not complied with the requirement that they provide a “true copy” of its settlement papers in accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). We additionally observe that the collateral agreement is not mentioned or explained in either the motion to terminate or the motion to treat the settlement papers as confidential information.

Finally, we remind the parties that settlement agreements are considered evidence that is typically filed in the form of an exhibit. *See*

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37 C.F.R. § 42.63(a). Any further filings in these cases shall treat settlement agreements accordingly.

In order to facilitate the re-filing of the motions to terminate, we expunge the papers the parties sought to keep confidential (i.e., the settlement agreement and the collateral settlement agreement). *See* 37 C.F.R. § 42.7(a).

In consideration of the foregoing, it is hereby:

ORDERED that Papers 11 and 13 in Case IPR2016-01478 and Papers 14 and 16 in Case IPR2016-01546 Papers 16 are *expunged*;

FURTHER ORDERED that the motions for termination of these proceedings, as well as the requests to file the settlement papers as business confidential information, are *denied without prejudice*;

FURTHER ORDERED that the parties are authorized to re-file corrected joint motions to terminate these proceedings;

FURTHER ORDERED that the corrected joint motions shall indicate and explain the presence of any collateral settlement agreements;

FURTHER ORDERED that the corrected joint motions must be accompanied by a true copies of the parties' settlement agreements as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b); and

FURTHER ORDERED that the copies of the parties' settlement agreements shall be filed as exhibits and shall be free of redactions.

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