

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)

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

HUDALLA, *Administrative Patent Judge*.

DECISION
Termination of the Trials
37 C.F.R. § 42.72

IPR2016-01478 (Patent 8,201,968 B2)

IPR2016-01546 (Patent 8,967,844 B2)

On March 15, 2017, the parties filed, in each of the instant cases, an amended 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 copy of a collateral settlement agreement, and an amended request to treat the settlement agreements as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).¹ The main settlement agreement refers to the collateral agreement, which relates to Petitioner’s exclusive engagement of an expert witness. Paper 15, 2.

The parties’ joint motions to terminate were filed prior to the oral hearings in these cases, and the Board has not made a final decision on the merits in any of these cases. *See* 35 U.S.C. § 317(a). Although the parties’ underlying district court litigation had been consolidated with several other cases that remain pending, the parties represent that their case has been settled and dismissed with prejudice. Paper 15, 2–3. The parties also represent that they have settled their dispute. *Id.* at 2. Given these facts, we determine that it is appropriate to terminate the trials, without rendering a final written decision, under 37 C.F.R. § 42.72. The oral hearings in both of the instant cases are canceled.

“At the request of a party to the proceeding, the [settlement] agreement or understanding shall be treated as business confidential

¹ *See* Case IPR2016-01478, Papers 15, 16, Exs. 1018, 1019; Case IPR2016-01546, Papers 18, 19, Exs. 1019, 1020. Because the papers are nearly identical in each case, we will refer to those filed in Case IPR2016-01478 for convenience. Our Order of March 14, 2017, authorized the amended joint motions to terminate so the parties could address certain deficiencies in earlier filings. *See* Paper 14.

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information, shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.” 35 U.S.C. § 317(b). After reviewing the parties’ settlement agreement and collateral settlement agreement, we find that these papers contain confidential business information regarding the terms of settlement. We determine that good cause exists to treat these papers as business confidential information pursuant to 35 U.S.C. § 317(b).

In consideration of the foregoing, it is hereby:

ORDERED that the parties’ joint request to treat their settlement agreement and collateral settlement agreement (Case IPR2016-01478, Exs. 1018, 1019; and Case IPR2016-01546, Exs. 1019, 1020) as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) and to continue their designation as “Parties and Board Only” in the Patent Trial and Appeal Board End to End (PTAB E2E) system is *granted*;

FURTHER ORDERED that the parties’ settlement agreement be kept separate from the files of U.S. Patent No. 8,201,968 B2 and U.S. Patent No. 8,967,844 B2, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause; and

FURTHER ORDERED that the joint motions to terminate the instant trials are *granted* and the trials are hereby *terminated*.

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