

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PRIME WIRE & CABLE, INC.,
Petitioner

v.

CANTIGNY LIGHTING CONTROL, LLC,
Patent Owner

Case IPR2018-01592
Patent No. 9,320,122 B2

**JOINT MOTION TO TERMINATE PURSUANT TO
35 U.S.C. § 317 AND 37 C.F.R. §§ 42.72 AND 42.74**

Pursuant to 35 U.S.C. § 317, 37 C.F.R. §§ 42.72 and 42.74, and the Board's authorization of December 4, 2018, Petitioner Prime Wire & Cable, Inc. ("Petitioner") and Patent Owner Cantigny Lighting Control, LLC ("Patent Owner") jointly move to terminate the present *inter partes* review proceeding in light of Petitioner, Patent Owner, and licensee Jasco Products Company's ("Jasco") resolution of their dispute regarding U.S. Patent No. 9,320,122 ("the '122 patent").

Petitioner and Patent Owner are concurrently filing a true and complete copy of their written Settlement Agreement (Confidential Exhibit 2001) in connection with this matter as required by the statute. Petitioner and Patent Owner certify that there are no other agreements or understandings, oral or written, between the parties, including any collateral agreements, made in connection with, or in contemplation of, the termination of the present proceeding. A joint request to treat the Settlement Agreement as business confidential information kept separate from the file of the involved patent pursuant to 35 U.S.C. § 317(b) is being filed concurrently.

LEGAL STANDARD

An *inter partes* review proceeding “shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” 35 U.S.C. § 317(a). A joint motion to terminate generally “must (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office, and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper No. 26, at *2 (P.T.A.B. July 28, 2014).

ARGUMENT

Termination of the present *inter partes* review proceeding is appropriate because (1) Petitioner, Patent Owner, and licensee Jasco have resolved their dispute regarding the '122 patent and have agreed to terminate this proceeding, (2) the Office has not yet decided the merits of the proceeding, and (3) public policy favors the termination.

This proceeding is in its early stages. To date, Patent Owner has neither filed nor waived a preliminary response to the petition pursuant to the December 11, 2018 deadline provided in the Board’s Notice of September 11, 2018 (Paper 5).

Public policy also favors the termination. As recognized by the rules of practice before the Board:

There are strong public policy reasons to favor settlement between the parties to a proceeding. The Board will be available to facilitate settlement discussions, and where appropriate, may require a settlement discussion as part of the proceeding. The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.

Patent Office Trial Practice Guide, Fed. Register, Vol. 77, No. 157 at 48768 (Aug. 14, 2012). Moreover, no public interest or other factors militate against termination of this proceeding.

As to the remaining *Heartland Tanning* requirements, the sole district court litigation that involves the '122 patent or any related patents is *Jasco Products Company, LLC and Cantigny Lighting Control, LLC v. Prime Wire & Cable, Inc. and YFC-BonEagle Electric Co., Ltd.*, Case No. 5:18-cv-00044-RJC-DSC (W.D.N.C., filed March 14, 2018). This litigation was dismissed on November 27, 2018 (Dkt. No. 38) pursuant to the Settlement Agreement (Exhibit 2001). Apart from the instant proceeding, no petitions for *Inter Partes* Review have been filed against the '122 patent or any related patent.

CONCLUSION

For the foregoing reasons, Petitioner and Patent Owner jointly and respectfully request that the instant proceeding be terminated.

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY LLP

Dated: December 5, 2018

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