

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

SANTA'S BEST AND POLYGROUP LIMITED (MCO),  
Petitioner

v.

VARIABLE LIGHTING LLC,  
Patent Owner

---

Case IPR2016-01066  
Patent 6,285,140

---

**JOINT MOTION TO TERMINATE THE PROCEEDING WITH RESPECT  
TO POLYGROUP LIMITED (MCO) PURSUANT TO 35 U.S.C. § 317 AND  
37 C.F.R. § 42.74**

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74, Patent Owner Variable Lighting, LLC (“Patent Owner”) and Petitioner Polygroup Limited (MCO) (“Polygroup”) and Santa’s Best jointly move to terminate the present *inter partes* review proceeding only with respect to Polygroup, in light of Polygroup’s and Patent Owner’s (herein after Polygroup and Patent Owner are references as “the parties”) resolution of their dispute relating to U.S. Patent No. 6,285,140. Santa’s Best does not oppose termination of the instant proceeding with respect to Polygroup. This Joint Motion was authorized by the Board by email on July 29, 2016.

Termination with respect to Polygroup is appropriate in the instant proceeding because the dispute between the parties has been resolved, and further, the parties have agreed to terminate Polygroup as a party to this *inter partes* review. As required by 35 U.S.C. § 317(b), the parties are filing, concurrently herewith a true copy of their Settlement and Patent License Agreement (executed on June 28, 2016) as Exhibit 1012.<sup>1</sup> Pursuant to Paragraph 4.5 of the Settlement and Patent License Agreement, Patent Owner and Polygroup jointly agreed to

---

<sup>1</sup> The Settlement and Patent License Agreement has been filed electronically via E2E for “Board Only” to preserve confidentiality. Filing under the designation “Board Only” was authorized in the Board’s July 29, 2016 email.

terminate this proceeding with respect to Polygroup.<sup>2</sup> Accordingly, Polygroup and Patent Owner jointly request that this proceeding be terminated with respect to Polygroup under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74. *See Fandango, LLC et al. v. Ameranth, Inc.*, CBM2014-00013, Paper 22, pp. 5-6 (PTAB March 24, 2014).

Under 35 U.S.C. § 317(a), “[a]n inter partes review instituted under this chapter 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.” This proceeding is still in its early stages. In fact, Patent Owner has not yet filed a preliminary response (and thus, no institution decision has issued). Termination with respect to Polygroup will not adversely affect any of the other parties or impair the Board in proceeding to a decision on the merits. Moreover, strong public policy considerations favor settlement between the parties to an inter partes review proceeding. *See Office Trial Practice Guide*, Fed. Reg., Vol. 77, No. 157 at 48768 (Aug. 14, 2012). No

---

<sup>2</sup> Additionally, pursuant to the Settlement and Patent License Agreement, the parties jointly moved to dismiss the pending district court litigation between them (*Variable Lighting LLC v. Polygroup Services N.A. Inc.*, C.A. 16-00183-RGA) with prejudice, and an Order doing so was entered on July 11, 2016. *See* 16-cv-00183, D.I. 18.

public interest or other factors weigh against termination of this proceeding with respect to Polygroup.

The parties further request, pursuant to 37 C.F.R. § 42.74(c), that the agreement (Ex. 1012) be treated as confidential business information and kept separate from the files of the involved patent. The parties are filing, concurrently herewith, a motion to seal pursuant to 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c).

For the foregoing reasons, the parties jointly and respectfully request that the instant proceeding be terminated with respect to Polygroup.

Respectfully submitted,

/Jason D. Eisenberg/

Jason D. Eisenberg (Reg. No. 43,447)  
Lead Counsel for Petitioner

/Padmaja Chinta/

Padmaja Chinta (Reg. No. 54,792)  
Lead Counsel for Patent Owner

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing **JOINT MOTION TO TERMINATE THE PROCEEDING WITH RESPECT TO POLYGROUP LIMITED (MCO) PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.74** has been served on attorneys for Patent Owner, served via electronic mail on August 17, 2016, to the following addresses provided by Patent Owner:

Padmaja Chinta  
pchinta@cittonechinta.com

Henry Cittone  
hcittone@cittonechinta.com

Andrew Berks  
aberks@cittonechinta.com

Peter Fratangelo  
pfratangelo@cittonechinta.com

Respectfully submitted,

Dated: August 17, 2016

/Jason D. Eisenberg/  
Jason D. Eisenberg (Reg. No. 43,447)  
Lead Counsel for Petitioner