

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMMSCOPE TECHNOLOGIES LLC, and
CORNING OPTICAL COMMUNICATIONS LLC,
Petitioner,

v.

DALI WIRELESS, INC.,
Patent Owner.

IPR2022-01293 (Patent 10,334,499 B2)
IPR2022-01242 (Patent 11,026,232 B2)¹

Before KARL D. EASTHOM, BARBARA A. BENOIT,
SHARON FENICK, and JOHN R. KENNY, *Administrative Patent Judges*.²

FENICK, *Administrative Patent Judge*.

TERMINATION

Granting Joint Motion to Terminate Corning Optical Communications LLC
as Petitioner Due to Settlement Before Institution of Trial and
Granting Joint Request to Treat Settlement Agreement as
Business Confidential Information
37 C.F.R. § 42.74

¹ This Order applies to each of the listed cases. Given the similarities of issues, we issue one Order to be docketed in each case. The parties, however, are not authorized to use this filing style in subsequent papers.

² This listing of Administrative Patent Judges does not reflect an expanded panel under SOP 1 § III.M. This order addresses multiple proceedings that collectively involve more than three Administrative Patent Judges.

I. INTRODUCTION

With Board authorization, Corning Optical Communications LLC (“Corning”) and Dali Wireless, Inc. (“Patent Owner”) filed a Joint Motion to Terminate Proceeding as to Petitioner Corning Optical Communications LLC in each of the above-identified proceedings (“Joint Motion”). Paper 10.^{3,4} Corning and Patent Owner previously sought authorization to file the Joint Motion and received that authorization via email on January 18, 2023. Joint Motion 1. Corning and Patent Owner also filed a Settlement Agreement (Exhibit 1045, “Settlement Agreement”) and a Joint Request to File Settlement Agreement as Business Confidential Information in each of the above-identified proceedings (Paper 9, “Joint Request”).⁵

II. DISCUSSION

In the Joint Motions, Corning and Patent Owner represent that they have reached an agreement to jointly seek termination of Corning as Petitioner in each of the above-identified proceedings, the filed copy of the Settlement Agreement is “a true and correct copy,” and “there are no other agreements or understandings, oral or written, between them, including any collateral agreements, made in connection with, or in contemplation of, the termination of Corning from this proceeding as set forth in 35 U.S.C. § 317(b).” Joint Motion 1, 4.

We have not yet instituted a trial in the above-identified proceedings. Nor have we decided the merits of the proceedings, and final written

³ We cite to the Papers and the Exhibit filed in IPR2022-01293, unless otherwise indicated.

⁴ In IPR 2022-01242, Paper 16 is the Joint Motion.

⁵ In IPR2022-01242, Exhibit 1058 is the Settlement Agreement, and Paper 15 is the Joint Request.

IPR2022-01293 (Patent 10,334,499 B2)

IPR2022-01242 (Patent 11,026,232 B2)

decisions have not been entered in the proceedings. Corning and Patent Owner have shown adequately that termination of each of the above-identified proceedings is appropriate for Corning. Under these circumstances, we determine that good cause exists to terminate each of the above-identified proceedings with respect to Corning. CommScope Technologies LLC will remain as Petitioner in each of the above-identified proceedings.

Corning and Patent Owner also requested that the Settlement Agreement be treated as business confidential information and be kept separate from the files of Patent 10,334,499 and Patent 11,026,232. Joint Request 1–2. After reviewing the Settlement Agreement between Corning and Patent Owner, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

III. ORDER

Accordingly, for the reasons discussed above, it is

ORDERED that the Joint Motions are *granted*, and each of IPR2022-01293 and IPR2022-01242 is *terminated* with respect to Corning, pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72;

FURTHER ORDERED that CommScope Technologies LLC will remain as Petitioner in each of the above-identified proceedings, which will continue; and

IPR2022-01293 (Patent 10,334,499 B2)

IPR2022-01242 (Patent 11,026,232 B2)

FURTHER ORDERED that the Joint Requests are *granted*, and the Settlement Agreement shall be kept separate from the files of Patent 10,334,499 and Patent 11,026,232, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

IPR2022-01293 (Patent 10,334,499 B2)

IPR2022-01242 (Patent 11,026,232 B2)

For PETITIONER:

Philip P. Caspers

Samuel A. Hamer

CARLSON, CASPERS, VANDENBURGH & LINDQUIST PA

pcaspers@carlsoncaspers.com

shamer@carlsoncaspers.com

Christopher TL Douglas

Caleb J. Bean

ALSTON & BIRD LLP

christopher.douglas@alston.com

caleb.bean@alston.com

For PATENT OWNER:

David D. Schumann

Palani P. Rathinasamy

Moses Xie

Timothy Dewberry

FOLIO LAW GROUP PLLC

david.schumann@foliolaw.com

palani@foliolaw.com

moses.xie@foliolaw.com

timothy.dewberry@foliolaw.com