

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BOMBARDIER INC,
Petitioner

v.

THE LITEBOOK COMPANY LTD.,
Patent Owner

IPR2023-00192
U.S. Patent No. 7,678,140

**JOINT MOTION BY PETITIONER AND PATENT OWNER TO
TERMINATE
PROCEEDING PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.74**

Pursuant to 37 C.F.R. § 42.71(a) and 42.74, Petitioner Bombardier Inc. (“Bombardier”) and Patent Owner The Litebook Company Ltd. (“Litebook”) jointly request termination of this proceeding IPR2023-00192, directed to Patent No. 7,678,140 (“the ’140 patent”), with prejudice. The Board authorized the parties to file this Joint Motion on July 6, 2023, via email.

Petitioner and Patent Owner have settled their dispute regarding the ’140 patent, expressly including both this IPR and Patent Owner’s assertion of the ’140 patent in the related district court litigation, *The Litebook Company Ltd. v. Bombardier Aerospace Corporation and NETJETS Aviation, Inc.*, Case No. 4:22-cv-00615 (N.D. Tex.). The parties do not anticipate further litigation between them concerning the ’140 patent. There are no related proceedings between the parties currently before the Board.

Although the Board has issued a decision on institution, the proceeding is still in its early stages, as the Patent Owner has not yet filed its response to the Petition. The Board strongly favors settlement between the parties and “expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” PTAB Consolidated Trial Practice Guide, II(N) (Nov. 2019); *see also* 35 U.S.C. §§ 317(a), 327; *Commc’ns Test Design, Inc. v. Contec, LLC*, IPR2019-01669, Paper 14, at 3-4 (P.T.A.B. May 13, 2020) (granting joint motion to terminate after Board granted

institution of review but before the proceeding had reached the first due date of the scheduling order because it was in the “early stage of the proceedings”). Accordingly, good cause exists to terminate the proceedings based on settlement as the Board has not yet conducted an oral hearing or otherwise resolved the merits of the Petition.

The settlement agreement has been made in writing, and a true and correct copy shall be filed as Exhibit 1035. The parties certify that, other than Exhibit 1035, the parties have no collateral agreements or understandings in connection with, or in contemplation of, the termination of the *inter partes* review. The parties further request, pursuant to 37 C.F.R. § 42.74(c), that the Exhibit 1035 be treated as business confidential information and kept separate from the files of the involved patent. The parties are filing, concurrently herewith, a request to treat the settlement agreement as business confidential information pursuant to 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c).

Good cause exists to terminate this proceeding because the parties have settled their dispute regarding the '140 patent and the proceeding is still at an early stage. Terminating the proceeding now would thus serve the interests of judicial economy as well as the mutual interest of the parties. Therefore, Petitioner and Patent Owner respectfully request termination of the *Inter Partes* Review in Case No. IPR2023-00192.

Respectfully submitted,

Date: July 10, 2023

/Monica Grewal/

Monica Grewal

Lead Counsel for Petitioner

Registration No. 40,056

/Cabrach J. Connor/

Cabrach J. Connor

Lead Counsel for Patent Owner

Registration No. 53,837

Updated Table of Exhibits

Exhibit	Description
1001	U.S. Patent No. 7,678,140
1002	File History of U.S. Patent No. 7,678,140
1003	Encyclopædia Britannica, The visible spectrum (online). Available at https://www.britannica.com/science/color/The-visible-spectrum . Visited November 21, 2022.
1004	German Patent No. 29618670U1 (“Weth”) (certified translation attached “Energy-saving lamp for medical therapies”)
1005	Declaration of Dr. Horace Craig Heller
1006	Grossweiner et al., <i>The Science of Phototherapy: An Introduction</i> . Springer, First Edition (2005)
1007	Choukroun and Geoffroy, <i>Light Therapy in Mood Disorders: A Brief History with Physiological Insights</i> , <i>Chronobiol Med.</i> , 1(1):3-8 (2019)
1008	Czeisler et al., <i>Entrainment of Human Circadian Rhythms by Light-Dark Cycles: A Reassessment</i> , <i>Photochemistry and Photobiology</i> , 34, 239 (1981) (“Lewy”)
1009	Britannica, “The electromagnetic spectrum.” Available at https://www.britannica.com/science/electromagnetic-spectrum#/media/1/183297/106806 . Visited November 21, 2022.
1010	Lewy et al., <i>Light suppresses melatonin secretion in humans</i> , <i>Science</i> , 12;210 (4475):1267-69 (1980)
1011	Czeisler et al., <i>Bright Light Resets the Human Circadian Pacemaker Independent of the Timing of the Sleep-Wake Cycle</i> , <i>Science</i> , 233(4764):667-671 (1986)
1012	Canada Patent No. 2209694
1013	Wirz-Justice et al., <i>Light treatment of seasonal affective disorder in Switzerland</i> , <i>Acta Psychiatrica Scandinavica</i> , 74:193-204 (1986) (“Wirz-Justice”)
1014	Ennever, <i>Blue Light, Green Light, White Light, More Light: Treatment of Neonatal Jaundice</i> , <i>Clinics in Perinatology</i> , 17(2): 467-481 (1990).
1015	Lee et al., <i>Spectral properties of phototherapy for seasonal affective disorder: a meta-analysis</i> , <i>Acta Psychiatrica</i>

Exhibit	Description
	Scandinavica, 96: 117-121 (1997)
1016	Shanahan et al., <i>Resetting the Melatonin Rhythm with light in Humans</i> , Journal of Biological Rhythms, 12(6): 556-567 (1997)
1017	Britannica, “retina.” Available at https://www.britannica.com/science/retina . Visited November 21, 2022.
1018	U.S. Patent No. 5,047,006
1019	U.S. Patent No. 5,849,027
1020	Provisional Application No. 60/228,493
1021	Provisional Application No. 60/203,308
1022	U.S. Patent No. 6,531,230 (“Weber”)
1023	Morita et al., <i>Inhibitory Effect of Light of Different Wavelengths on the Fall of Core Temperature during the Nighttime</i> , Japanese Journal of Physiology, 45: 667-671 (1995)
1024	Declaration of Dr. Sylvia Hall-Ellis
1025	Director Vidal, Memorandum: Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (June 21, 2022)
1026	Aschoff et al., <i>Circadian rhythms in men under as influenced by light-dark cycles of various periods</i> , Pflugers Arch. 306:58-70 (1969)
1027	Campbell et al., <i>Light treatment for sleep disorders: consensus report. I. Chronology of seminal studies in humans</i> , Review J. Biol. Rhythms., 10(2):105-9 (1995)
1028	Provencio et al., <i>A Novel Human Opsin in the Inner Retina</i> , The Journal of Neuroscience 20(2): 600-605 (2000)
1029	RESERVED
1030	World Health Organization, “Lasers and Optical Radiation” (1982)
1031	International Commission on Non-Ionizing Radiation Protection, <i>Guidelines on Limits to Exposure to Broad-Band Incoherent Optical Radiation (0.38 to 3 μM)</i> , Health Physics: 73(3):539-554 (1997)
1032	Levine, “Chapter 1: An Introduction to Neuroendocrine Systems,” Handbook of Neuroendocrinology, Fink et al. Eds. Academic Press, 3-19 (2012)

Exhibit	Description
1033	Cleveland Clinic, “Dopamine.” Available at https://my.clevelandclinic.org/health/articles/22581-dopamine . Visited November 28, 2022.
1034	Watson et al., <i>Neuropharmacology of Sleep and Wakefulness</i> , Sleep Med. Clin., 5:513-528 (2010)
1035	Confidential Settlement and Patent Licensing Agreement

CERTIFICATE OF SERVICE

The undersigned certifies, in accordance with 37 C.F.R. § 42.6(e), that service was made on Patent Owner as detailed below.

Date of service July 10, 2023

Manner of service Electronic Email: cab@CLandS.com; john@CLandS.com

Documents served **JOINT MOTION BY PETITIONER AND PATENT
OWNER TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. §
42.74**

EXHIBIT 1035

UPDATED TABLE OF EXHIBITS

Persons served Cabrach J. Connor
John M. Shumaker
CONNOR LEE & SHUMAKER PLLC
609 Castle Ridge Road, Suite 450
Austin, Texas 78746

Respectfully submitted,

/Monica Grewal/

Monica Grewal
Registration No. 40,056
Lead Counsel for Petitioner