

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APUTURE IMAGING INDUSTRIES CO., LTD.,
Petitioner,

v.

ROTOLIGHT LIMITED,
Patent Owner.

IPR2024-01422 (Patent No. 10,845,044 B2)
IPR2024-01423 (Patent No. 10,203,101 B2)
IPR2024-01424 (Patent No. 10,197,257 B2)
IPR2021-01425 (Patent No. 10,197,258 B2)

Before GRACE KARAFFA OBERMANN, RAE LYNN P. GUEST,
KIMBERLY MCGRAW, and AVELYN M. ROSS,¹
Administrative Patent Judges.

ROSS, *Administrative Patent Judge.*

JUDGMENT
Terminating the Proceeding and
Granting Request to Treat Settlement Agreement as
Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74

¹ This is not an expanded panel. A three-judge panel is assigned to each proceeding, but in light of the related subject matter and convenience to the Board and parties, a consolidated order is issued for IPR2024-01422, IPR2024-01423, IPR2024-01424, and IPR2024-01425. The parties are not authorized to use this caption.

IPR2024-01422 (Patent No. 10,845,044 B2)
IPR2024-01423 (Patent No. 10,203,101 B2)
IPR2024-01424 (Patent No. 10,197,257 B2)
IPR2021-01425 (Patent No. 10,197,258 B2)

On January 9, 2025, with our prior authorization, Aputure Imaging Industries, Co., Ltd. (“Petitioner”) and Rotolight Limited (“Patent Owner”) (collectively, “the parties”) filed Joint Motions to Terminate IPR2024-01422, IPR2024-01423, IPR2024-01424, and IPR2024-01425. Paper 4 (“Motion”).² Together with the Motion, the parties filed a copy of their written Settlement Agreement (Ex. 1013, “Agreement”) and Joint Requests to File Settlement Materials as Business Confidential Information and to Maintain Said Materials Separate from the Public File Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 5 (“Joint Request”).

The Board generally expects that a case “will terminate after the filing of a settlement agreement, unless the Board has already decided the merits.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012); *see* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72. The Patent Owner has not filed a Patent Owner Response and the Board has not issued a decision on institution. The parties indicate that “the settlement completely resolves the controversy between Patent Owner and Petitioner relating to” U.S. Patent Nos. 10,845,044, 10,203,101, 10,197,257, and 10,197,258 and “the Office has not decided the merits of the proceeding.” Motion, 2; Ex. 1013. The parties also “confirm that all other litigation between the parties” involving U.S. Patent Nos. 10,845,044, 10,203,101, 10,197,257, and 10,197,258 has been resolved, including *Rotolight Limited v. Aputure Imaging Industries*

² Paper and exhibit numbers cited herein are to IPR2024-01422. Similar papers and exhibits have been filed in IPR2024-01423 (Papers 4, 5; Ex. 1013), IPR2024-01424 (Papers 5, 6; Ex. 1012), and IPR2024-01425 (Papers 4, 5; Ex. 1013).

IPR2024-01422 (Patent No. 10,845,044 B2)
IPR2024-01423 (Patent No. 10,203,101 B2)
IPR2024-01424 (Patent No. 10,197,257 B2)
IPR2021-01425 (Patent No. 10,197,258 B2)

Co., Ltd. pending in the United States District Court for the Eastern District of Texas, Civil Action No. 4-23-cv-00508. *Id.* at 3. The parties further represent that the Agreement constitutes the entire agreement between the parties. *See generally* Ex. 1013; 37 C.F.R. § 317(b). Under these circumstances, we determine that it is appropriate to enter judgment and terminate this proceeding without rendering a final written decision. *See* 35 U.S.C. § 317(a); 37 C.F.R. §§ 42.5(a), 42.72.

Further, after reviewing the Joint Request and the Agreement, we find that the Settlement contains confidential business information regarding the terms of the settlement and that good cause exists to treat the Agreement as business confidential information to be kept separate from the patent file. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c). This Paper does not constitute a Final Written Decision under 35 U.S.C. § 318(a).

ORDER

In view of the foregoing, it is

ORDERED that, in each proceeding, the Joint Request to File the Settlement Materials as Business Confidential Information and to Maintain Said Materials Separate from the Public File is granted;

FURTHER ORDERED that, in each proceeding, the Settlement Agreement shall be treated as business confidential information and shall be kept separate from the patent file; and

FURTHER ORDERED that, in each proceeding, the Joint Motion to Terminate is granted and IPR2024-01422, IPR2024-01423, IPR2024-01424, and IPR2024-01425 are hereby terminated.

IPR2024-01422 (Patent No. 10,845,044 B2)
IPR2024-01423 (Patent No. 10,203,101 B2)
IPR2024-01424 (Patent No. 10,197,257 B2)
IPR2021-01425 (Patent No. 10,197,258 B2)

FOR PETITIONER:

Donald R. McPhail
Daniel J. Pereira, Ph.D.
MERCHANT & GOULD P.C.
dmcpail@merchantgould.com
dpereira@merchantgould.com

FOR PATENT OWNER:

Michael Pomeroy
Scott Breedlove
Harold. L. Lim
CARTER ARNETT PLLC
bliddle@carterarnett.com
sbreedlove@carterarnett.com
hlim@carterarnett.com