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Paper 23
Entered: January 21, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NRG ENERGY, INC. and
TALEN ENERGY CORPORATION
Petitioner,

v.

MIDWEST ENERGY EMISSIONS CORP.,
Patent Owner.

IPR2020-00832
IPR2020-00834
Patent 10,343,114 B2[1]

Before KRISTINA M. KALAN, CHRISTOPHER M. KAISER, and AVELYN M. ROSS, *Administrative Patent Judges*.

KALAN, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial and
Granting Joint Request to Treat Settlement Agreement as
Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. § 42.74

[1] This Order applies to both proceedings. We exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

I. INTRODUCTION

Petitioner and Patent Owner (collectively "the Parties") have requested that the above-identified *inter partes* review proceeding be terminated pursuant to a settlement. On January 14, 2021, the Parties filed a Joint Motion to Terminate in each of the above-identified proceedings ("Joint Motion"). Paper 20.[2] We had authorized the Parties to file a joint motion to terminate the above-identified proceedings in a January 4, 2021 email. *See* Joint Motion 2.

The Parties also filed a Fleetwide License and Supply Agreement (Exhibit 1071, "License and Supply Agreement"), a Term Sheet (Exhibit 1072, "Term Sheet"), and a Joint Request That Agreements Be Treated As Business Confidential Information (Paper 19, "Joint Request") in each of the above-identified proceedings.

II. DISCUSSION

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." It is also provided in 35 U.S.C. § 317(a) that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

In the Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of these *inter partes* review proceedings, that the filed copies of the License and Supply Agreement and

[2] For expediency, we cite to the Papers and Exhibits filed in IPR2020-00832, unless otherwise indicated. Similar Papers and Exhibits were filed in IPR2020-00834.

Term Sheet are true and correct copies, and there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of these proceedings. Joint Motion 2–3. The Joint Motion indicates that the settlement resolves all currently pending Patent Office and District Court proceedings between the Parties involving Patent 10,343,114. *Id.* at 2.

We instituted a trial on the above-identified proceedings on October 26, 2020. Paper 17. We have not yet decided the merits of the proceeding, and a final written decision has not been entered. Notwithstanding that the proceeding has moved beyond the preliminary stage, the Parties have shown adequately that the termination of the proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceeding with respect to the Parties.

The Parties also requested that the License and Supply Agreement and Term Sheet be treated as business confidential information and be kept separate from the file of Patent 10,343,114. Joint Request 2. After reviewing the License and Supply Agreement and Term Sheet, we find that these documents contain confidential business information regarding the terms of settlement. We determine that good cause exists to treat the License and Supply Agreement and Term Sheet 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 IPR2020-00832 and IPR2020-00834 are each *terminated* with respect to Petitioner and Patent Owner, pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Requests are *granted*, and the License and Supply Agreement and Term Sheet shall be kept separate from the file of Patent 10,343,114, 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).

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