

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.

IPR2020-00926 (8,168,147 B2)
IPR2020-00928 (8,168,147 B2)¹

Before ZHENYU YANG, CHRISTOPHER M. KAISER, and
AVELYN M. ROSS, *Administrative Patent Judges*.

ROSS, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial
Granting Request to Treat Settlement Agreement as
Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. §§ 42.72

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.

IPR2020-00926 (8,168,147 B2)

IPR2020-00928 (8,168,147 B2)

On January 14, 2021, with Board authorization, NRG Energy, Inc. and Talen Energy Corporation (collectively “Petitioner”) and Midwest Energy Emissions Corp. (“Patent Owner”) filed a Joint Motion to Terminate *inter partes* review. *See* IPR2020-00926, Paper 22; IPR2020-00928, Paper 20 (collectively, “Motions to Withdraw”). Together with the Motions to Withdraw, the parties filed a copy of their written Agreement (Ex. 1093, “Agreement”), and Joint Requests that the Agreement be Treated as Business Confidential Information Pursuant to 35 U.S.C. § 317(b). IPR2020-00926, Paper 21; IPR2020-00928, Paper 19 (“Joint Requests”). The Motions to Withdraw and Joint Requests filed in each *inter partes* review are substantively identical. *See id.*

The Board generally expects that a case “will terminate after the filing of a settlement agreement, unless the Board has already decided the merits.” *Consolidated Trial Practice Guide*, 86 (Nov. 2019) (“Consolidated TPG”)²; *see* 35 U.S.C. §317(a) and 37 C.F.R. § 42.72. Petitioner filed two petitions requesting an *inter partes* review of certain claims of U.S. Patent No. 8,168,147 on July 15, 2020 (“the ’147 patent”). *See* IPR2020-00926, Paper 2; IPR2020-00928, Paper 3).³ We instituted *inter partes* review on July 26, 2020. IPR2020-00926, Paper 19; IPR2020-00928, Paper 17. The oral hearing is scheduled for September 2, 2021. IPR2020-00926, Paper 20; IPR2020-00928, Paper 18.

² Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

³ Vistra Corporation joined in the requests for *inter partes* review but was terminated on August 9, 2020. *See* IPR2020-00926, Paper 11; IPR2020-00928, Paper 2

In the Motions to Withdraw, the parties represented that they have “settled their dispute, and have reached agreement to terminate NRG’s and Talen’s participation in this *inter partes* review” and that “Patent Owner has dismissed with prejudice its claims against Petitioners” in the copending district court litigation. Motions 2. The parties explain that the ’147 patent is not involved in any other pending litigation. *Id.* Accordingly, the parties “respectfully jointly request termination of this *inter partes* review.” *Id.* at 3. Under these circumstances, we determine that it is appropriate to terminate these proceedings without rendering a final written decision. *See* 35 U.S.C. § 317(a); 37 C.F.R. §§ 42.5(a), 42.72. After reviewing the Agreement, we further find that it 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 Order does not constitute a Final Written Decision under 35 U.S.C. § 318(a).

Accordingly, it is,

ORDERED that the Joint Requests to File Settlement as Business Confidential Information (IPR2020-00926, Paper 21; IPR2020-00928, Paper 19) are *granted*; and

FURTHER ORDERED that the Agreement (Ex. 1093) shall be treated as business confidential information and shall be kept separate from the patent file; and

FURTHER ORDERED that the parties’ Joint Motions to Terminate the *inter partes* reviews (IPR2020-00926, Paper 22; IPR2020-00928, Paper 19) are *granted* and these proceedings are hereby terminated.

IPR2020-00926 (8,168,147 B2)

IPR2020-00928 (8,168,147 B2)

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