

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NORTHERN STATES METALS COMPANY,
Petitioner,

v.

NEXTRACKER, INC.,
Patent Owner.

IPR2021-00025
Patent 9,806,669

Before LINDA E. HORNER, JAMES A. TARTAL, and
PAUL J. KORNICZKY, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION
Settlement Prior to Institution of Trial
37 C.F.R. § 42.74

Northern States Metals Company (“Petitioner”) filed a Petition (Paper 1, “Pet.”) seeking *inter partes* review of claims 1–13 of U.S. Patent No. 9,806,669 B2 (Ex. 1001, “the ’669 patent”). Petitioner subsequently informed the Board that it had reached an agreement with Patent Owner NEXTracker, Inc. to settle this proceeding and sought authorization to file a joint motion to terminate this proceeding. With our authorization, the parties

filed a Joint Motion to Terminate the Proceeding Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.72 and Joint Request to Keep Papers Separate as Business Confidential Information. Paper 7. A copy of the Settlement Agreement executed by the parties also was filed as Exhibit 1019.

The Parties represent that they have settled their dispute with respect to the challenged patent and memorialized their settlement in the written Settlement Agreement. Paper 7, 2. The parties further state that they have settled and dismissed the related district court litigation. *Id.*

This proceeding is at an early stage. Patent Owner has not yet filed a preliminary response in the proceeding, and we have not yet entered a decision on whether to institute *inter partes* review of the '669 patent. In view of the early stage of this proceeding, the parties' representations, and the concurrent settlement of the district court lawsuit, we determine that it is appropriate to dismiss the Petition and terminate the proceeding. *See* 37 C.F.R. § 42.71(a). Therefore, the Joint Motion to Terminate the Proceeding is granted. We also grant the request of the parties to treat the Settlement Agreement as business confidential information. Paper 7, 3.

Therefore, the Joint Motion and the Joint Request are *granted*.

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

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Request to Treat Settlement Agreement as Business Confidential Information pursuant to 35 U.S.C. § 317(b) is *granted*;

FURTHER ORDERED that the Settlement Agreement (Ex. 1019) shall be treated as business confidential information and shall be kept separate from the patent file; and

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FURTHER ORDERED that the Joint Motion to Terminate the Proceeding is *granted* and the proceeding is *terminated* with respect to both Petitioner and Patent Owner.

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