

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALTENERGY POWER SYSTEMS INC.,
Petitioner,

v.

TIGO ENERGY INC.,
Patent Owner.

IPR2021-00540 (Patent 10,256,770 B2)
IPR2021-00541 (Patent 8,933,321 B2)

Before CHRISTOPHER L. CRUMBLEY, JO-ANNE M. KOKOSKI, and
AVELYN M. ROSS, *Administrative Patent Judges*.

ROSS, *Administrative Patent Judge*.

DECISION
Dismissal Prior to Institution of Trial
35 U.S.C. § 314

IPR2020-01296 (Patent 8,168,147 B2)

IPR2020-01297 (Patent 8,168,147 B2)

On February 16, 2021 Altenergy Power Systems Inc. filed two petitions requesting *inter partes* review of certain claims of U.S. Patent Nos. 10,256,770 and 8,933,321 (collectively “challenged patents”) owned by Tigo Energy Inc. See IPR2021-00540, Paper 1; IPR2021-00541, Paper 1. On April 26, 2021, with Board authorization, the parties filed Joint Motions to Terminate Proceedings in each *inter partes* review. IPR2021-00540, Paper 6; IPR2021-00541, Paper 6 (collectively “Motion to Terminate”). The Motions filed in each *inter partes* review are substantively identical. *Id.* The parties also filed Joint Motions to File the Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317. IPR2021-00540, Paper 7; IPR2021-00541, Paper 7.

The parties explain that “[t]ermination is appropriate because no patent owner response or further papers have been filed, oral argument has not been held, the Board has not decided the merits of the proceeding, and a final written decision has not been issued.” Motion to Terminate 2. The parties further assert that they have “resolved their disputes and executed an agreement which contemplates requesting termination of this proceeding and dismissing the Parties’ related proceeding regarding the [challenged patents] in *Tigo Energy Inc. v. Altenergy Power Sys. Inc. et al.*, 5:20-cv-03622 (N.D. Cal.).” *Id.*; Ex. 1025. According to the parties, “[a] joint stipulation of dismissal was submitted in [the district court] action” and “[t]here are no other pending district court actions in which the [challenged patents are] asserted.” Motion to Terminate 2. The parties represent that they have fully resolved the issues between them (Ex. 1025, “Settlement Agreement”) and “[t]here are no other agreements, oral or written, between the parties”

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(Motion to Terminate 3). Accordingly, the parties jointly request that we terminate this proceeding. *Id.* at 4.

Our “regulations expressly provide the Board with broad authority to dismiss a petition where appropriate.” *Facebook, Inc. v. EveryMD.com*, IPR2018-00050, Paper 19 at 4 (PTAB Oct. 9, 2018); *see* 37 C.F.R.

§ 42.71(a) (“The Board . . . may grant, deny, or dismiss any petition or motion.”). Under these circumstances, we determine that it is appropriate to dismiss the Petition and terminate the proceeding. After reviewing the Settlement Agreement, we further find that it contains confidential business information regarding the terms of the settlement and that good cause exists to grant the Motion to File and treat the Settlement Agreement as business confidential information to be kept separate from the patent files. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c).

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

ORDER

In view of the foregoing, it is,

ORDERED that the Parties’ Joint Motion to Terminate Proceedings (Paper 6) in each case is *granted*;

FURTHER ORDERED that the Petition in each case is dismissed, and IPR2021-00540 and IPR2021-00541 are terminated;

FURTHER ORDERED that the Joint Motion to File the Agreement as Business Confidential (Paper 7) in each case is *granted*;

FURTHER ORDERED that the Settlement Agreement (Ex. 1025) shall be kept separate from the files of U.S. Patent Nos. 10,256,770 and 8,933,321.

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For PETITIONER:

Philip Marsh

Michael Nguyen

Arnold & Porter Kaye Scholer LLP

Philip.marsh@arnoldporter.com

Michael.nguyen@arnoldporter.com

For PATENT OWNER:

Heath J. Briggs (Reg. No. 54,919)

John P. Ward (Reg. No. 40,216)

Leif Olson (Reg. No. 79,428)

Greenberg Traurig, LLP

BriggsH@gtlaw.com

wardj@gtlaw.com

olsonl@gtlaw.com