

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SUNSPEC ALLIANCE,
Petitioner,

v.

TIGO ENERGY INC.,
Patent Owner.

IPR2021-01286
Patent 8,933,321 B2

Before JO-ANNE M. KOKOSKI, KRISTINA M. KALAN, and
AVELYN M. ROSS, *Administrative Patent Judges*.

KALAN, *Administrative Patent Judge*.

TERMINATION
Due to Settlement on Remand
35 U.S.C. § 317; 37 C.F.R. § 42.74

I. INTRODUCTION

With the Board’s authorization, Sunspec Alliance (“Petitioner”) and Tigo Energy Inc. (“Patent Owner”)(collectively referred to as “the Parties”) filed a Joint Motion to Terminate the above-identified proceeding due to settlement. Paper 32 (“Joint Motion”). In support of the Joint Motion, the Parties filed a Confidential Settlement Agreement (Ex. 1055 (“Settlement Agreement”)), as well as a Joint Request to Treat Settlement Agreement as Business Confidential Information (Paper 33 (“Joint Request”)) pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74.

II. DISCUSSION

Petitioner challenged claims 1, 5, 6, 7, 12, and 13 of U.S. Patent No. 8,933,321 B2 (Ex. 1001, “the ’321 patent”) in the present *inter partes* review. On January 26, 2023, we issued a Final Written Decision. Paper 27 (“Final Dec.” or “FWD”). In the Final Written Decision, we determined that Petitioner did not show by a preponderance of the evidence that claims 1, 5, 6, 7, 12, and 13 of the ’321 patent are unpatentable. Final Dec. 28.

Petitioner appealed to the U.S. Court of Appeals for the Federal Circuit. Paper 28. On appeal, the Federal Circuit affirmed the Board’s Final Written Decision for the ’321 patent as to Ground 1 (finding claims 1, 6, 7, 12, and 13 not unpatentable) and Ground 3 (finding claims 1 and 5 not unpatentable). Paper 30, 9. The Federal Circuit vacated the Board’s Final Written Decision for the ’321 patent as to Ground 2 (finding claims 1, 6, 7, 12, and 13 not unpatentable), and remanded “for the Board to address whether Kronberg, in combination with Moine, teaches a ‘predetermined number’ of skips.” *Id.*

In the Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of this *inter partes* review proceeding, and that the filed copy of the Settlement Agreement is a true and complete copy. Joint Motion 7. The Parties further represent that their settlement agreement resolves all disputes between the Parties regarding the '321 patent. *Id.* at 6.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board already has decided the merits of the proceeding. PTAB Consolidated Trial Practice Guide, 86 (Nov. 2019).¹ Here, although the Board already issued a Final Written Decision, the Federal Circuit reversed the part of that decision addressing Ground 2 and remanded to the Board for further proceedings regarding particular issues associated with Ground 2. Paper 30, 9. The Board has not issued a decision on remand and, thus, has not decided the merits of the issues that were remanded to the Board. Under these circumstances, we determine it is appropriate to grant the Joint Motion and terminate the proceedings.

The Parties also jointly request that the Settlement Agreement be treated as business confidential information and be kept separate from the files of the '321 patent and these proceedings. Joint Request 2. We have reviewed the Settlement Agreement, which contains confidential business information regarding the settlement terms, and we determine that good cause exists to treat the Settlement Agreement as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) and

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

keep it separate from the files of the '321 patent and these proceedings. Accordingly, we grant this aspect of the Parties' Joint Request.

The Parties also "each request that they be notified if and when the Board receives and/or considers a request for access to the settlement agreement, and be offered an opportunity to respond to any such request." Joint Request 2. However, neither the statute nor the regulation provides for any such notification, and the Parties have not provided any reason or special circumstance that would justify issuing an order that purports to impose an additional requirement. Accordingly, we deny this portion of the Parties' Joint Request.

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 Motion is *granted*, and IPR2021-01286 is *terminated* with respect to Petitioner and Patent Owner pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72;

FURTHER ORDERED that the Joint Request is *granted-in-part*;

FURTHER ORDERED that that Settlement Agreement shall remain designated as "Parties and Board Only" in the Board's electronic filing system, be treated as business confidential information, be kept separate from the file of Patent 8,933,321 B2, and be 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); and

FURTHER ORDERED that IPR2021-01286 is terminated.

IPR2021-01286
Patent 8,933,321 B2

For PETITIONER:

Philip Marsh
Jeffrey Miller
ARNOLD & PORTER KAYE SCHOLER LLP
philip.marsh@arnoldporter.com
jmillerptab@apks.com

For PATENT OWNER:

Heath J. Briggs
Leif Olson
GREENBERG TRAURIG LLP
briggsh@gtlaw.com
olsonl@gtlaw.com