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Paper 15
Date: April 12, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SIEMENS GAMESA RENEWABLE ENERGY INC.,
Petitioner,

v.

GENERAL ELECTRIC COMPANY,
Patent Owner.

IPR2022-01479
Patent 6,921,985 B2

Before BARBARA A. PARVIS, JEFFREY W. ABRAHAM, and SCOTT B. HOWARD, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

Petitioner (Siemens Gamesa Renewable Energy Inc.) and Patent Owner (General Electric Company) have indicated that they have reached an agreement to settle the above-identified *inter partes* review proceeding. The Board authorized the parties to file a joint motion to terminate the proceeding on April 3, 2023.

On April 4, 2023, pursuant to 37 C.F.R. § 42.74 and 35 U.S.C. § 317(a), the parties filed a Joint Motion to Terminate the above-identified proceeding (Paper 13 ("Joint Motion")) and a Joint Request to Treat a Settlement Agreement as business confidential information and to keep said Settlement Agreement separate from the public file (Paper 14 ("Joint Request")), along with a copy of the confidential Settlement Agreement (Ex. 2003 ("Agreement")). The parties represent that they have submitted "true and correct copies" of the parties' settlement agreement and any collateral agreements made in contemplation of termination of all proceedings involving US 6,921,985 B2. Paper 13, 1–2. In particular, the parties submit they "have resolved the disputes in this proceeding, and Patent Owner will file a notice of voluntary dismissal with prejudice of its amended complaint in the district court litigation related to the '985 Patent." *Id.* at 2. The parties further represent that "[n]o other such agreements, written or oral, exist between the parties." *Id.* at 1.

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

at an intermediate stage. The parties have not filed substantive briefing after institution. We have not yet decided the merits of this proceeding, and a final written decision has not been entered in this proceeding. Terminating this proceeding will save the Board administrative and judicial resources, e.g., in conducting an oral argument and issuing a final written decision to decide the patentability issues raised in the Petition. Furthermore, there are strong public policy reasons to favor settlement between the parties to a proceeding. *Consolidated Trial Practice Guide*, 84 Fed. Reg. 64,280 (Nov. 21, 2019). Under these circumstances, and in view of the parties' settlement and representations, we determine that good cause exists to terminate this proceeding. Accordingly, we *grant* the Joint Motion.

The parties also request that "the written settlement agreement filed as Ex. 2003 be treated as business confidential information and be kept separate from the files of U.S. Patent No. 6,921,985." Paper 14, 1; *see also* Paper 13, 1. The parties additionally "request that the settlement agreement be made available only to (i) Federal Government agencies on written request or (ii) to any person only on showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c)." Paper 14, 1. We have reviewed the Agreement, which contains confidential business information regarding the terms of settlement, and we determine that good cause exists to treat the Agreement as business confidential information and to keep it separate from the file of the patent in the above-identified proceeding pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Accordingly, we *grant* this aspect of the parties' Joint Request.

The parties also request that

> In the event that a third party submits a written request to the Board for a copy of the settlement agreement along with a purported showing of good cause, due to the highly sensitive nature of the agreement, the Parties would like to be notified of such request and be given the opportunity to respond thereto.

Paper 14, 1. But the statute does not provide for any such notification or opportunity to respond. *See* 35 U.S.C. § 317(b). Nor does the regulation. *See* 37 C.F.R. § 42.74(c). Also, we see no persuasive reason or special circumstance here that would justify issuing an order that imposes these additional requirements. Thus, we *deny* this part of the parties' Joint Request.

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

It is:

ORDERED that the Joint Motion to Terminate (Paper 13) is *granted*, and IPR2022-01479 is *terminated*;

FURTHER ORDERED that the Joint Request (Paper 14) is *granted-in-part*, and the Agreement (Ex. 2003) shall be treated as business confidential information, kept separate from the file of the involved U.S. Patent No. 6,921,985 B2, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause on written request, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that the filed Agreement (Exhibit 2003) shall remain designated as "Parties and Board Only" in the Board's filing system.

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