

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SMA SOLAR TECHNOLOGY AMERICA LLC,

Petitioner

v.

TIGO ENERGY INC.,

Patent Owner.

Case IPR2023-01184

U.S. Patent No. 8,823,218

**JOINT REQUEST TO TREAT SETTLEMENT AGREEMENT
DOCUMENTS AS BUSINESS CONFIDENTIAL INFORMATION**

PETITIONERS' UPDATED EXHIBIT LIST

Exhibit No.	DESCRIPTION
1001	U.S. Patent No. 8,823,218
1002	Declaration of Randy R. Dunton
1003	Curriculum Vitae of Randy R. Dunton
1004	Prosecution History of U.S. Patent No. 8,823,218
1005	U.S. Patent No. 8,531,055 to Adest et al. (“ <i>Adest</i> ”)
1006	U.S. Patent No. 5,054,023 to Kronberg (“ <i>Kronberg</i> ”)
1007	U.S. Patent No. 6,650,031 to Goldack (“ <i>Goldack</i> ”)
1008	French Patent Application Publication No. FR2894401A1 (“ <i>Moine</i> ”), English Translation, and Translator’s Declarations
1009	Excerpts from IEEE 100 THE AUTHORITATIVE DICTIONARY OF IEEE STANDARDS TERMS (7th Ed. 2000)
1010	IPR2021-01287, Paper No. 27 (Final Written Decision)
1011	Statistic (Time to Trial - Delaware)
1012	Statistic (Time to Trial - Judge Gregory B. Williams)
1013	Joint Agreed-Upon Amended Scheduling Order [D.I. 57] from <i>Tigo Energy Inc. v. SMA Solar Technology America LLC et al.</i> , 1-22-cv-00915 (D. Del. June 14, 2023).
1014	File History of U.S. Patent Application No. 12/254,780
1015	File History of U.S. Patent Application No. 12/411,317
1016	File History of U.S. Patent Application No. 12/628,977
1017	File History of U.S. Provisional Patent Application No. 61/343,155
1018	File History of U.S. Provisional Patent Application No. 61/200,601
1019	File History of U.S. Provisional Patent Application No. 61/001,587
1020	File History of U.S. Provisional Patent Application No. 61/275,977
1021	File History of U.S. Provisional Patent Application No. 61/276,753
1022	U.S. Certified Copy of <i>Moine</i> (French Patent Application Publication No. FR2894401A1—see Ex-1008)
1023	French Certified Copy of <i>Moine</i> (French Patent Application Publication No. FR2894401A1—see Ex-1008)
1024	Markman Opinion [D.I. 97] from <i>Tigo Energy Inc. v. SMA Solar Technology America LLC et al.</i> , 1-22-cv-00915 (D. Del. Dec. 4, 2023).
1025	Markman Order [D.I. 98] from <i>Tigo Energy Inc. v. SMA Solar Technology America LLC et al.</i> , 1-22-cv-00915 (D. Del. Dec. 4, 2023).

Exhibit No.	DESCRIPTION
1026	Confidential Documents Showing Settlement between Petitioner and Patent Owner [FILED UNDER SEAL]

Pursuant to 35 U.S.C. § 317(b), 37 C.F.R. § 42.74(c), and the Board’s email of August 5, 2024, Petitioner SMA Solar Technology America LLC (“Petitioner”), and Patent Owner Tigo Energy Inc. (“Patent Owner”) (collectively, the “Settling Parties”) file this Joint Request to Treat Settlement Agreement Document as Business Confidential Information. The parties have reached a settlement and are concurrently jointly filing a Motion to Terminate the above-captioned proceeding. As permitted by statute, Petitioner and Patent Owner request that the Board treat as business confidential information the true and complete copy of the documents evidencing settlement between between the parties (Ex. 1026), as referenced in the parties’ Joint Motion to Terminate, filed concurrently herewith.

35 U.S.C. § 317(b) provides that:

At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.

Likewise, 37 C.F.R. § 42.74(c) provides that:

A party to a settlement may request that the settlement be treated as business confidential information and be kept separate from the files of

an involved patent or application. The request must be filed with the settlement. If a timely request is filed, the settlement shall only be available:

- (1) To a Government agency on written request to the Board; or
- (2) To any other person upon written request to the Board to make the settlement agreement available, along with the fee specified in § 42.15(d) and on a showing of good cause.

The present request, which is being filed contemporaneously with the settlement agreements, is timely and in accordance with the foregoing authority. Therefore, the parties request that the documents evidencing the parties settlement (Confidential Exhibit 1026) (i) be treated as business confidential information, (ii) be maintained separate from the publicly available file of the involved patent, and (iii) shall be made available only to Federal Government agencies on written request, or to persons showing good cause on written request, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Further, Petitioner and Patent Owner each request that they be notified if and when the Board receives and/or considers a request for access to the documents evidencing the parties settlement, and be offered an opportunity to respond to any

such request. *See Arista Networks, Inc. v. Catlemorton Wireless, LLC*, IPR2020-00986 Pap. 7, 4 (PTAB Oct. 28, 2020).

Respectfully submitted,

Date: August 20, 2024

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Respectfully submitted,

Date: August 20, 2024

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Lead Counsel for Patent Owner

CERTIFICATE OF SERVICE

I certify that on August 20, 2024, I caused a true and correct copy of the foregoing Joint Request to Treat Settlement Agreement as Business Confidential Information to be served on the Patent Owner via electronic mail to Patent Owner's counsel of record below:

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A courtesy copy was also sent via electronic mail to Patent Owner's lead litigation counsel listed below:

Nicholas A. Brown
brownn@gtlaw.com

/Philip W. Marsh/
Philip W. Marsh, Reg. No. 46,061

Counsel for Petitioner