

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 MOTION TO TERMINATE PROCEEDING

Pursuant to 37 C.F.R § 42.74 and the authorization provided by the Board on August 5, 2024, Petitioner SMA Solar Technology America LLC (“Petitioner”), and Patent Owner Tigo Energy Inc. (“Patent Owner”) jointly request termination of this proceeding, IPR2023-01184, directed to U.S. Patent No. 8,823,218 (“the ’218 patent”).

Petitioner and Patent Owner have settled their dispute regarding the ’218 patent, including both this proceeding and Patent Owner’s assertion of the ’218 patent in the related district court litigation against Petitioner, *Tigo Energy Inc. v. SMA Solar Technology America LLC and SMA Solar Technology AG*, Civil Action No. 1:22-cv-00915-GBW. The parties do not anticipate further litigation between them concerning the ’218 patent. The following related proceeding, which involves a different patent, is currently before the Board:

- SMA Solar Technology America, LLC, Petitioner, v. Tigo Energy, INC., Patent Owner, IPR2023-00879, U.S. Patent No. 9,584,021 B2.

Good cause exists to terminate this proceeding. The parties have settled their dispute regarding the ’218 patent and the proceeding is still at an early stage. Trial was instituted and Patent Owner has filed its response. Petitioner has not submitted a Reply. Terminating the proceeding now would thus serve the interests of judicial economy as well as the mutual interest of the parties.

A true and correct copy of the documents constituting the parties' agreement to settle this proceeding will be filed as Exhibit 1026, along with a joint motion to treat those documents as business confidential information. Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. §42.74(b), the parties hereby certify that there are no other written or oral agreements concerning the settlement beyond the documents submitted as Exhibit 1026.

This paper is being filed by, and the signature for Patent Owner's counsel is being applied by, counsel for Petitioner with permission of counsel for Patent Owner.

Date: August 20, 2024

Respectfully submitted,

/Philip W. Marsh/

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CERTIFICATE OF SERVICE

I certify that on August 20, 2024, I caused a true and correct copy of the foregoing Joint Motion to Terminate Proceeding to be served via electronic mail to Patent Owner's counsel of record listed below:

Heath J. Briggs
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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
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/Philip W. Marsh/
Philip W. Marsh, Lead Counsel
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