

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.

IPR2023-01184
Patent 8,823,218 B2

Before JO-ANNE M. KOKOSKI, ELIZABETH M. ROESEL, and JULIA
HEANEY, *Administrative Patent Judges*.

HEANEY, *Administrative Patent Judge*.

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

With the Board's authorization, Petitioner and Patent Owner (collectively referred to as "the Parties") filed a Joint Motion to Terminate the above-identified proceeding. Paper 18 ("Joint Motion"). In support of the Motion, the Parties filed a copy of a Settlement Agreement (Ex. 1026), as well as a Joint Request to Treat the Settlement Agreement Documents as Business Confidential Information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 17 ("Joint Request").

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.

In the Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of the above-identified proceeding, that the filed copy of the Settlement Agreement is a true and complete copy, and that there are no other agreements concerning the settlement. Joint Motion, 1–2. The Parties further represent that their settlement agreement resolves all currently pending Patent Office and District Court proceedings between the Parties involving the above-identified patent. *Id.* at 1.

We have not yet decided the merits of the above-identified proceeding, and a final written decision has not been entered. Notwithstanding that the proceedings have moved beyond the preliminary stage, the Parties have shown adequately that termination of the proceedings is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceeding with respect to the Parties.

The Parties also filed a Joint Request that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the patent involved in this proceeding. Joint Request, 2. After reviewing the Settlement Agreement between Petitioner and Patent Owner, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement between Petitioner and Patent Owner as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

The Parties further request that “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.” Joint Request, 2–3. We have no such procedure to serve upon the Parties a request for access to the Settlement Agreement, and, further, our regulations do not require us to do so. 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).

ORDER

Accordingly, it is:

ORDERED that the Joint Motion to Terminate Proceeding is *granted*;

FUTHER ORDERED that IPR2023-01184 is *terminated*; and

FURTHER ORDERED that the Joint Request is *granted-in-part*, and the Settlement Agreement (Ex. 1026) shall be treated as business confidential information, shall be kept separate from the files of the challenged patents and made available only under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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