

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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BERKSHIRE HATHAWAY ENERGY COMPANY and  
PACIFICORP,  
Petitioner,

v.

BIRCHTECH CORP.,  
Patent Owner.

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IPR2025-00280  
Patent 10,596,517 B2

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Before CHRISTOPHER M. KAISER, KRISTNA M. KALAN, and  
DAVID COTTA, *Administrative Patent Judges*.

COTTA, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial  
Granting Joint Request to Treat Settlement Agreement as  
Business Confidential Information  
*35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74*

The parties filed a joint motion to terminate the instant proceeding on the basis of a settlement reached by the parties. *See* Paper 93 (“Mot.”); 35 U.S.C. § 317(a); 37 C.F.R. §§ 42.72, 42.74. The parties also filed a copy of their written settlement agreement (Exhibit 1167), along with a joint request (Paper 94 “Request”)) to treat the agreement as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

In the joint motion to terminate, the parties represent that they “reached a settlement as to all disputes in this proceeding and as to the ’517 patent.” Mot. 4. The parties further state that they filed a “true copy” of their settlement agreement and that “[n]o other agreements, written or oral, exist between or among the Settling Parties relating to this proceeding.” *Id.* at 4–5.

We have not yet reached a final written determination as to the patentability of any challenged claim in this case. In view of the stage of this proceeding and the settlement between Petitioner and Patent Owner, we determine that it is appropriate to terminate the instant proceeding without rendering any further decisions.

The parties request that “the Board treat as business confidential information the executed settlement agreement (Exhibit 1167).” Request 1. The parties also request that “the Board inform the Settling Parties if anyone seeks production of the final settlement agreement and afford the Settling Parties an opportunity to address whether good cause supports such request.” *Id.* at 3.

After reviewing the Agreement between Petitioner and Patent Owner, we find that the Agreement contains confidential business information regarding the terms of settlement. We determine that it is appropriate to

treat the Agreement as business confidential information and keep it separate from the file of U.S. Patent No. 10,596,517 B2. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c). As to the parties' request that we inform them if anyone seeks production of the settlement agreement, neither the statute nor the rule provides for noticing the parties of a request for access to a settlement agreement. Accordingly, the Board will not provide the requested notice.

This Order does not constitute a final written decision under 35 U.S.C. § 318(a).

In consideration of the foregoing, it is hereby:

ORDERED that the parties' request that the settlement agreement (Exhibit 1167) be treated as business confidential information, kept separate from the file of U.S. Patent No. 10,596,517 B2, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is *granted*;

FURTHER ORDERED that the parties' request that the Board inform the parties in the event a person or entity makes a written request for access to the release agreement is *denied*; and

FURTHER ORDERED that the joint motion to terminate is *granted* and the proceeding is hereby *terminated*.

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