

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PACIFICORP,
Petitioner,

v.

BIRCHTECH CORP.,
Patent Owner.

IPR2025-00717
Patent 10,926,218 B2

Before KRISTINA M. KALAN, ZHENYU YANG, and
DAVID COTTA, *Administrative Patent Judges*.

YANG, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. §§42.72, 42.74

PacifiCorp, Interstate Power & Light Company (“IPL”), MidAmerican Energy Company (“MidAmerican”), WEC Energy Group, Inc. (“WEC”), and Wisconsin Power & Light Company (“WPL”) filed a Petition, seeking *inter partes* review of claims 1–4 and 6–26 of U.S. Patent No. 10, 926,218 B2. Paper 1. After filing the Petition, IPL, MidAmerican, WEC, and WPL subsequently settled their dispute with Patent Owner, and have been terminated from this proceeding. Papers 26, 31, 34.

With our authorization, PacifiCorp, the only remaining Petitioner, and Patent Owner filed a Joint Motion to Terminate Proceeding. Paper 48 (“Mot.”). In support of the Joint Motion, the parties filed a copy of their Settlement Agreement. Ex. 1167. The parties also filed a Joint Request to treat the Settlement Agreement as business confidential information. Paper 49.

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.” In this proceeding, the Board has not issued a final written decision determining the patentability of the challenged claims.

The parties represent that (1) they “have reached a settlement as to all disputes in this proceeding and as to the ’218 patent;” (2) a true copy of the Settlement Agreement has been filed; and (3) no other agreements exist between the parties. Mot. 4.

The Board has not issued a final written decision determining the patentability of the challenged claims. Under these circumstances, we determine that it is appropriate to terminate this proceeding without

rendering a final written decision. *See* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72.

Further, after reviewing the Joint Request and the Settlement Agreement, we find that the Settlement Agreement contains confidential business information regarding the terms of the settlement. As such, good cause exists to treat the Settlement Agreement as business confidential information to be kept separate from the patent file. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c).

In the Joint Request, 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.” Paper 49, 3. Notifying the parties of any future request for production puts undue burden on the Board’s limited resources. In addition, our Rules do not provide the parties an opportunity to be involved in a decision regarding any future request for production. *See, e.g.,* 37 C.F.R. § 42.74(c). We, therefore, deny the parties’ additional request.

This Order does not constitute a Final Written Decision under 35 U.S.C. § 318(a).

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motion to Terminate is granted;

FURTHER ORDERED that the Joint Request to Treat Final Settlement Agreement as Business Confidential Information is granted, and the Settlement Agreement shall be kept separate from the files of

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Patent 10,926,218 B2 and made available only under the provisions
of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that this proceeding is terminated.

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