

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SIEMENS GAMESA RENEWABLE ENERGY INC.,  
Petitioner,

v.

GENERAL ELECTRIC COMPANY,  
Patent Owner.

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IPR2022-01279  
Patent 7,629,705 B2

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Before BARBARA A. PARVIS, JEFFREY W. ABRAHAM, and  
SCOTT B. HOWARD, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*.

DECISION  
Settlement Prior to Institution of Trial  
*37 C.F.R. § 42.74*

Petitioner (Siemens Gamesa Renewable Energy Inc.) and Patent Owner (General Electric Company) have indicated that they have reached an agreement to settle the above-identified *inter partes* review proceeding. The Board authorized the parties to file a joint motion to terminate the proceeding on March 14, 2023.

On April 4, 2023, pursuant to 37 C.F.R. § 42.74 and 35 U.S.C. § 317(a), the parties filed a Joint Motion to Terminate the above-identified proceeding (Paper 17 (“Joint Motion”)) and a Joint Request to Treat a Settlement Agreement as business confidential information and to keep said Settlement Agreement separate from the public file (Paper 18 (“Joint Request”)), along with a copy of the confidential Settlement Agreement (Ex. 2010 (“Agreement”)). The parties represent that they have submitted “true and correct copies” of the parties’ settlement agreement and any collateral agreements made in contemplation of termination of all proceedings involving US 7,629,705 B2. Paper 17, 1–2. In particular, the parties submit they “have resolved the disputes in this proceeding, and Patent Owner will file a notice of voluntary dismissal with prejudice of its amended complaint in the district court litigation related to the ’705 Patent.” *Id.* at 2. The parties further represent that “[n]o other such agreements, written or oral, exist between the parties.” *Id.* at 1.

The above-identified proceeding is at an early stage, and we have not yet decided whether to institute a trial in this proceeding. There are strong public policy reasons to favor settlement between the parties to a proceeding. *Consolidated Trial Practice Guide*, 84 Fed. Reg. 64,280 (Nov. 21, 2019). In view of the early stage of the proceeding and the parties’ settlement and representations, we determine that good cause exists to

terminate this proceeding and dismiss its petition without rendering a decision on institution. Accordingly, we *grant* the Joint Motion.

The parties also request that “the written settlement agreement filed as Ex. 2010 be treated as business confidential information and be kept separate from the files of U.S. Patent No. 7,629,705.” Paper 18, 1; *see also* Paper 17, 1. The parties additionally “request that the settlement agreement be made available only to (i) Federal Government agencies on written request or (ii) to any person only on showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).” Paper 18, 1. We have reviewed the Agreement, which contains confidential business information regarding the terms of settlement, and we determine that good cause exists to treat the Agreement as business confidential information and to keep it separate from the file of the patent in the above-identified proceeding pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Accordingly, we *grant* this aspect of the parties’ Joint Request.

The parties also request that

In the event that a third party submits a written request to the Board for a copy of the settlement agreement along with a purported showing of good cause, due to the highly sensitive nature of the agreement, the Parties would like to be notified of such request and be given the opportunity to respond thereto.

Paper 18, 1. However, neither the statute nor the regulation provides for any such notification or opportunity to respond, and the parties have not provided any special circumstance that would justify issuing an order that purports to impose additional requirements. Accordingly, we *deny* this portion of the parties’ Joint Request.

This is not a final written decision pursuant to 35 U.S.C. § 318(a).

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It is:

ORDERED that the Joint Motion to Terminate (Paper 17) is *granted*, the Petition is *dismissed*, and IPR2022-01279 is *terminated*;

FURTHER ORDERED that the Joint Request (Paper 18) is *granted-in-part*, and the Agreement (Ex. 2010) shall be treated as business confidential information, kept separate from the file of the involved U.S. Patent 7,629,705 B2, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause on written request, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that the filed Agreement (Exhibit 2010) shall remain designated as “Parties and Board Only” in the Board’s filing system.

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