

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GARMIN INTERNATIONAL, INC.,
Petitioner,

v.

BLACKBIRD TECH, LLC d/b/a BLACKBIRD TECHNOLOGIES,
Patent Owner.

Case IPR2017-01058
Patent 6,434,212

Before DEBRA K. STEPHENS, THOMAS L. GIANNETTI, and
CHRISTA P. ZADO, *Administrative Patent Judges*.

STEPHENS, *Administrative Patent Judge*.

ORDER
Granting Joint Motion to Terminate
37 C.F.R. §§ 42.5, 42.72, 42.74(c)

On November 10, 2017, with Board authorization, the parties filed a joint motion to terminate the proceeding (Paper 9), along with what they indicate is their written settlement agreement (Ex. 1032). According to counsel, the parties have settled their disputes, and have reached agreement to terminate this *inter partes* review (“IPR”), which challenged the patentability of U.S. Patent No. 6,434,212 (“the ’212 patent”) (*see* Paper 1, 1).

The parties further request confidential treatment of the settlement agreement, pursuant to 37 C.F.R. § 42.74(c) (Paper 9).¹ The joint request to treat the settlement agreement as business confidential information includes a request that the settlement agreement be kept separate from file of the ’212 patent (Paper 10; *see also* 37 C.F.R. § 42.74(c) (“A party to a settlement may request that the settlement be treated as business confidential information and be kept separate from the files of an involved patent or application.”)).

The parties jointly request the proceeding be terminated because Patent Owner and Petitioner have reached an agreement “fully resolving the dispute involving the patent at issue” in the *Inter Partes* Review and in the litigation between Patent Owner and Petitioner (Paper 9, 2). The parties further state Patent Owner has not yet filed its Patent Owner Response and the Board has not issued a final written decision on the merits (*id.* at 3).

Based on the facts of this case, we agree it is appropriate to terminate the proceeding because doing so will preserve the Board’s and the parties’

¹ The parties state the ’212 patent has been asserted in many different pending district court litigations and in several *Inter Partes* Review petitions which have not yet reached an institution decision (Paper 9, 3).

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resources while also furthering the Patent Office's policy of "secur[ing] the just, speedy, and inexpensive resolution." 37 CFR § 42.1(b).

Accordingly, the joint motion to terminate the above-identified proceeding and the joint request to treat the settlement agreement as business confidential information are granted. As requested by the parties, the settlement agreement will be treated as business confidential information and kept separate from the patent file. 37 C.F.R. § 42.74(c). This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

Therefore, it is

ORDERED that the joint motion to terminate IPR2017-01058 is granted;

FURTHER ORDERED that the proceeding in IPR2017-01058 is terminated pursuant to 37 C.F.R. §§ 42.5, 42.72, 42.74(c); and

FURTHER ORDERED that the parties' joint request that the settlement agreement (Ex. 1032) be treated as business confidential information, be kept separate from the file of the involved patent, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, under 37 C.F.R. § 42.74(c), is granted.

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