

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

IPR2017-01058
Patent 6,434,212

JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72, Patent Owner and Petitioner jointly request termination of *Inter Partes* Review No. IPR2017-01058. The Board authorized the parties on November 9, 2017 to file this motion and a request that the settlement agreement be treated as business confidential information and be kept separate from the file of the involved patent.

Patent Owner and Petitioner respectfully submit that termination is appropriate because they have entered into a confidential written agreement fully resolving the dispute involving the patent at issue in the above-captioned *Inter Partes* Review and the litigation between Patent Owner and Petitioner.

As required under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the parties are filing herewith a true copy of the confidential written agreement along with a request to treat it as business confidential information and keep it separate from the file of the involved patent. *See* Confidential Exhibit EX1032. The parties represent that there are no collateral agreements, understandings, or other agreements between the parties made in connection with, or in contemplation of, the termination of the present proceeding and that EX1032 represents a true and accurate copy of the agreement between the parties that resolves this proceeding.

The parties have filed a joint motion to dismiss with prejudice the case styled, *Blackbird Tech LLC d/b/a Blackbird Technologies v. Garmin International, Inc. and Garmin USA, Inc.*, Case No. 16-CV-689 (D. Del.), in which the patent-at-

issue had been asserted. The parties represent that the patent-at-issue also is asserted in the following district court litigations that remain pending: *Blackbird Tech LLC d/b/a Blackbird Technologies v. Fitbit, Inc.*, Case No. 16-CV-683 (D. Del.), *Blackbird Tech LLC d/b/a Blackbird Technologies v. Timex Group USA, Inc.*, Case No. 16-CV-686 (D. Del.), *Blackbird Tech LLC d/b/a Blackbird Technologies v. TomTom, Inc.*, Case No. 16-CV-687 (D. Del.), *Blackbird Tech LLC d/b/a Blackbird Technologies v. Wahoo Fitness, Inc.*, Case No. 16-CV-688 (D. Del.). The patent-at-issue also is presently the subject of *Inter Partes* Review Petitions, which have not yet reached an institution decision, in the following matters: IPR2017-2012, IPR2017-2023, and IPR2017-2025.

This request is proper because of the early stage of this proceeding. The *Inter Partes* Review in this matter was recently instituted by the Board on September 29, 2017, Patent Owner has not yet filed its Patent Owner Response, and no final written decision on the merits has been entered. Further, this request is proper because of the public policy favoring settlement of litigation and settlement of proceedings before the Board. For at least these reasons, Patent Owner and Petitioner submit that termination is appropriate.

Dated: November 10, 2017

Respectfully submitted,

BY: /s/ Jason R. Mudd

Jason R. Mudd, Reg. No. 57,700
Adam P. Seitz, Reg. No. 52,206
ERISE IP, P.A.
6201 College Blvd., Suite 300
Overland Park, KS 66211
P: (913) 777-5600
F: (913) 777-5601
jason.mudd@eriseip.com
adam.seitz@eriseip.com

Paul R. Hart, Reg. No. 59,646
ERISE IP, P.A.
5600 Greenwood Plaza Blvd.
Suite 200
Greenwood Village, CO 80111
paul.hart@eriseip.com

Attorneys For Petitioner

BY: /s/ Walter D. Davis -w/ permission

Walter D. Davis, Jr., Reg. No. 45,137
Wayne M. Helge, Reg. No. 56,905
Aldo Noto, Reg. No. 35,628
Davidson, Berquist Jackson &
Gowdey LLP
8300 Greensboro Drive, Suite 500
McLean, VA 22012
(571) 765-7700
wdavis@dbjg.com
whelge@dbjg.com
anoto@dbjg.com

Attorneys For Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing document was served on November 10, 2017 via electronic mail directed to the counsel of record for Patent Owner as follows:

Walter D. Davis, Jr., Reg. No. 45,137
Wayne M. Helge, Reg. No. 56,905
Aldo Noto, Reg. No. 35,628
Davidson, Berquist Jackson & Gowdey LLP
8300 Greensboro Drive, Suite 500
McLean, VA 22012
(571) 765-7700
wdavis@dbjg.com
whelge@dbjg.com
anoto@dbjg.com

Attorneys For Patent Owner

BY: /s/ Jason R. Mudd
Jason R. Mudd, Reg. No. 57,700
Lead Counsel for Petitioner