

Filed on behalf of:  
Petitioner

Paper No. \_\_\_\_  
Date: January 18, 2023

By: Bryan C. Smith (Lead Counsel)  
George R. McGuire (Back-up Counsel)

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SIGNIFY NORTH AMERICA CORPORATION,

Petitioner,

v.

BLACKBIRD TECH LLC,

Patent Owner.

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Case IPR2023-00054

Patent 7,086,747

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**PETITIONER'S UNOPPOSED MOTION TO DISMISS PETITION FOR  
*INTER PARTES* REVIEW**

Pursuant to 37 C.F.R. § 42.74 and the authorization provided by the Board email of January 18, 2023, Petitioner SIGNIFY NORTH AMERICA CORPORATION ("Petitioner") requests termination of the proceeding and dismissal of the Petition filed in this proceeding, IPR2023-00054, directed to U.S. Patent No. 7,086,747 (the "'747 Patent"). The parties have met and conferred and Patent Owner does not oppose this motion.

## I. CERTIFICATION

Petitioner submits a true copy of any agreement or understanding (**Exhibit 1034**) between Petitioner and Patent Owner made in connection with, or in contemplation of, the dismissal of the Petition for the proceeding under 37 CFR § 42.74(b) with this motion. Petitioner certifies that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this *inter partes* review proceeding.

## II. STATUS OF RELATED PROCEEDINGS

Petitioner and Patent Owner have resolved their disputes regarding the '747 Patent, including both in this proceeding and assertion of the '747 Patent in related district court litigation, *Blackbird Tech, LLC d/b/a Blackbird v. Signify North America Corporation*, 3:21-CV-18463 (D.N.J.). The parties do not anticipate further litigation between them concerning the '747 Patent.

### III. RELIEF REQUESTED

As authorized by the Board, Petitioner is contemporaneously filing: (i) this motion to dismiss the Petition; (ii) a true copy of any agreement or understanding (**Exhibit 1034**) between Petitioner and Patent Owner made in connection with, or in contemplation of, the requested dismissal of the Petition; and (iii) a joint request to treat the agreement as business confidential information and keep the agreement (**Exhibit 1034**) separate from the file of the involved patent, pursuant to 37 C.F.R. § 42.74(c).

Petitioner requests that the Board terminate this proceeding in its entirety. Termination is appropriate at this stage and in view of a settlement between Petitioner and Patent Owner. *See* 37 C.F.R. § 42.71(a) (“The Board ... may grant, deny, or dismiss any petition”). *See also RSPCT Basketball Tech., Ltd. v. Pillar Vision, Inc.*, IPR2021-00006, Paper 8 (PTAB Jan. 5, 2021); *Palo Alto Networks, Inc. v. Proven Networks, LLC*, IPR2021-00596, Paper 8 (PTAB Aug. 10, 2021) (terminating the proceeding and dismissing the petition in view of settlement prior to issuance of institution decision). Good cause exists to terminate this proceeding because (1) Petitioner and Patent Owner have resolved their disputes regarding the '747 Patent; (2) this proceeding is still at an early stage because the Office has not yet decided whether to institute trial; and (3) terminating the proceeding now would

IPR2023-00054 (Patent 7,086,747)

Petitioner's Unopposed Motion to Dismiss Petition for *Inter Partes* Review

thus serve the interests of preservation of Board resources as well as the mutual interest of the parties.

Respectfully submitted,

Date: January 18, 2023

/Bryan C. Smith/

Bryan C. Smith (Lead Counsel)

Registration No. 59,767

**CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME  
LIMITATION, TYPEFACE REQUIREMENTS, AND TYPE STYLE  
REQUIREMENTS**

1. This paper complies with the page limitation of 15 pages excluding the parts exempted by 37 C.F.R. § 42.24.

2. This paper complies with the general format requirements of 37 C.F.R. § 42.6 and has been prepared using Microsoft® Word 2016 in 14 point Times New Roman.

Respectfully submitted,

Date: January 18, 2023

/Bryan C. Smith/

Bryan C. Smith (Lead Counsel)

Registration No. 59,767

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