

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SIGNIFY NORTH AMERICA CORPORATION,
Petitioner,

v.

BLACKBIRD TECH LLC,
Patent Owner.

IPR2023-00054
Patent 7,086,747 B2

Before DEBRA K. STEPHENS, JO-ANNE M. KOKOSKI, and KERRY
BEGLEY, *Administrative Patent Judges*.

STEPHENS, *Administrative Patent Judge*.

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

I. INTRODUCTION

On January 18, 2023, pursuant to the Board's authorization, Signify North America Corporation ("Petitioner") filed a Petitioner's Unopposed Motion to Dismiss Petition for *Inter Partes* Review (Paper 7 ("Unopposed Motion")). Petitioner and Blackbird Tech LLC ("Patent Owner") (collectively, "the Parties") filed a Joint Request That the Settlement

Agreement be Treated as Business Confidential Information and be Kept Separate Under 35 U.S.C. § 317(b) (Paper 8 (“Joint Request”)). In support of the Joint Request, the Parties filed a copy of a Confidential Settlement Agreement (Ex. 1034 (“Settlement Agreement”)).

II. DISCUSSION

In the Unopposed Motion, Petitioner states that the Parties have resolved their disputes regarding [U.S. Patent No. 7,086,747 (“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

(Unopposed Motion 2). Petitioner further states “a true copy of any agreement or understanding ([Settlement Agreement]) between Petitioner and Patent Owner made in connection with, or in contemplation of, the dismissal of the Petition for the proceeding” under 37 C.F.R. § 42.74(b) is submitted (Unopposed Motion 2). Petitioner additionally “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” (*id.*).

Petitioner asserts “termination is appropriate” 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 thus serve the interests of preservation of Board resources as well as the mutual interest of the parties

(Unopposed Motion 3–4).

“There are strong public policy reasons to favor settlement between the parties to a proceeding” (Patent Trial and Appeal Board Consolidated Trial Practice Guide 86 (Nov. 2019)).¹ Here, the proceeding is in its preliminary phase, and we have not yet decided whether to institute a trial in the proceeding. In view of the early stage of the proceeding and the settlement between the Parties, we determine it is appropriate to dismiss the Petition and terminate the proceeding as to the Parties, without rendering a decision on institution or a final written decision.

Additionally, in the Joint Request, the Parties

jointly request that a true copy of their settlement agreement, filed concurrently herewith as **Exhibit 1034**, be treated as business confidential information and be kept separate from the file of this *inter partes* review (IPR) proceeding

(Joint Request 2).

The Parties assert the Settlement Agreement “contain[s] highly sensitive business confidential information that would substantially harm their business interests if publicly disclosed” and request the Settlement Agreement “be made available only under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c)” (Joint Request 2). The Parties “further jointly request that the Board order that in the event a person or entity makes a written request, as stated in 37 C.F.R. § 42.74(c)(1)–(2), for access to the [S]ettlement [A]greement, that any such written request be served upon the parties on the day the written request is provided to the Board” (*id.*).

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>

After reviewing the Settlement Agreement between the Parties, we find the Settlement Agreement contains confidential business information regarding the terms of settlement. We also determine the Parties have complied with the requirements of 37 C.F.R. § 42.74(c) to have the Settlement Agreement be treated as business confidential information and be kept separate from the files of the '747 Patent in this proceeding.

Accordingly, we *grant* the Parties' request to treat the Settlement Agreement (Ex. 1034) between the Parties as business confidential information under 37 C.F.R. § 42.74(c) and keep the Settlement Agreement separate from the files of the involved patent and associated proceeding.

We *deny*, however, the Parties' request that the Board order that in the event a person or entity makes a written request, as stated in 37 C.F.R. § 42.74(c)(1)–(2), for access to the Settlement Agreement, any such written request be served upon the parties on the day the written request is provided to the Board, as this requirement is not contemplated by our Rules. In particular, 37 C.F.R. § 42.74(c) requires the Settlement Agreement be made available to a government agency “on written request to the Board,” or to any other person “upon written request to the Board” and on showing of good cause; we decline to impose an additional burden on the requester to serve such written request upon the Parties.

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

III. ORDER

Accordingly, it is

ORDERED that the Petitioner's Unopposed Motion to Dismiss Petition for *Inter Partes* Review is *granted*;

FURTHER ORDERED that the Joint Request to Treat Settlement Agreement as Business Confidential Information is *granted*, and the Settlement Agreement shall remain designated as “Parties and Board Only” in the Board’s filing system, shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause, and shall be kept separate from the files of the involved patent and associated proceeding, pursuant to 37 C.F.R. § 42.74(c);

FURTHER ORDERED that the Parties’ request that the Board order that any person or entity making a written request, per 37 C.F.R. § 42.74(c)(1)–(2), for access to the Settlement Agreement, serve such written request upon the Parties on the day the written request is provided to the Board, is *denied*; and

FURTHER ORDERED that the above-captioned proceeding is *terminated* and the Petition is *dismissed*.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.