UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EIKO GLOBAL, LLC and
HALCO LIGHTING TECHNOLOGIES, LLC

Petitioners,

v.

BLACKBIRD TECH LLC,

Patent Owner.

Trial No.: IPR2017-00980
U.S. Patent No. 7,086,747 B2

JOINT MOTION TO TERMINATE
UNDER 35 U.S.C. § 317

STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. § 42.72, and the Board's email dated May 17, 2017, authorizing this motion, Petitioner Halco Lighting Technologies, LLC ("Halco") and Patent Owner Blackbird Tech LLC d/b/a Blackbird Technologies ("Blackbird"; collectively, "the Parties") jointly request termination of *Inter Partes* Review Case IPR2017-00980 of U.S. Patent No. 7,086,747 (the "'747 patent") with respect to Halco.

STATEMENT OF FACTS

Halco filed its petition for *inter partes* review on February 27, 2017. (Paper No. 1). The USPTO issued a Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response on March 15, 2017. (Paper No. 4). Since receiving that Notice, the Parties have settled their dispute and reached a Settlement Agreement. (Ex. 1014). The Settlement Agreement obligates the Parties to jointly move to terminate this review as to Halco. (Ex. 1014 at Section 4.1). All claims between the Parties relating to the '747 patent in the district court have previously been dismissed without prejudice. (*See* Order Granting Stipulation of Dismissal, *Blackbird Tech LLC v. Halco Lighting Techs., LLC*, Case No. 1:16-cv-00971 (D. Del.), D.I. 19 (the "Dismissal Order")). Because there is a remaining petitioner party, the current proceeding will continue without Halco. As

a result, terminating the proceeding as to Halco will not change the Board's ability to review the subject patent.

ARGUMENT

I. Termination of This IPR Is Appropriate

Generally, a proceeding will terminate after the filing of a settlement agreement. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). In IPR2013-00428, Paper No. 56, the Board provided guidance as to the content of a motion to terminate. The Board indicated that a joint motion, such as this one, should (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue and the status of each; and (3) identify any related proceedings currently before the Office. IPR2013-00428, Paper No. 56 at 2. This Motion satisfies each of the above requirements.

1. Brief Explanation as to Why Termination Is Appropriate

The Board should terminate this review because Blackbird and Halco jointly request the termination as to Halco, and because the proceeding is still in its very early stages. The Office has not "decided the merits of the proceeding before the request for termination is filed." 35 U.S.C. § 317(a). Patent Owner's Preliminary Response is not due until June 15, 2017. No decision as to whether to institute trial

in this proceeding has been entered, and no final written decision on the merits of this *inter partes* review proceeding has been made. Halco and Blackbird have settled their related dispute, and the Settlement Agreement obligates the Parties to jointly move for termination of this *inter partes* review as to Halco.

Inasmuch as no trial has been instituted, concluding this review as to Halco promotes the congressional goal to establish a more efficient and streamlined patent system that, *inter alia*, limits unnecessary and counterproductive litigation costs. *See* "Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents," Final Rule, 77 Fed. Reg., No. 157, p. 48680 (Tuesday, August 14, 2012).

2. Identification of All Parties in Any Related Litigation Involving the Patents at Issue and the Status of Each

Blackbird's claims relating to the '747 patent in the district court against both Petitioners, Halco and EiKO Global, LLC, have been dismissed without prejudice. (*See* Dismissal Order). The '747 patent is at issue in the litigation described below:

Blackbird's appeal is currently pending before the United States Court of Appeals for the Federal Circuit in *Blackbird Tech LLC v. ELB Elecs., Inc.*, Case No. 17-1703 (Fed. Cir.), from a stipulated Judgment of Non-infringement of U.S. Patent No. 7,086,747 in favor of defendants ELB Electronics, Inc., Feit Electric

Company, Inc. and ETi Solid State Lighting Inc. in *Blackbird Tech LLC v. ELB Elecs., Inc., et. al.*, Case No. 1:15-cv-00056-RGA (D. Del.).

In the following cases involving claims of infringement of the ’747 patent, Default Judgment has been entered against defendants, and the cases are closed pending damages discovery:

- *Blackbird Tech LLC v. Axlen Inc.*, Case No. 1:15-cv-00055-RGA (D. Del.);
- *Blackbird Tech LLC v. 3NLED Lighting USA Inc.*, Case No. 1:15-cv-00063-RGA (D. Del.).

The following cases involving claims of infringement of the ’747 patent have been stayed, and the cases are closed pending the appeal in *Blackbird Tech LLC v. ELB Elecs., Inc.*, 17-1703 (Fed. Cir.):

- *Blackbird Tech LLC v. DAMAR Worldwide 4 LLC*, Case No. 1:16-cv-00969-RGA (D. Del.);
- *Blackbird Tech LLC v. TADD, LLC*, Case No. 1:16-cv-00970-RGA (D. Del.);
- *Blackbird Tech LLC v. Espen Tech. Inc.*, Case No. 1:16-cv-00973-RGA (D. Del.).

3. Related Proceedings Currently Before the Office.

There are no other proceedings pending before the Office involving the '747 patent. The Parties are also unaware of any other matter before the Office that would be affected by the settlement of this review between the Parties.

II. Future Participation by the Parties

Halco will not further participate in *Inter Partes* Review Case IPR2017-00980 if this proceeding is not terminated as to Halco pursuant to this joint motion. Blackbird will continue to participate, as the status of EiKO Global, LLC as a petitioner will not be affected by this joint motion. Because a "petitioner remains in the inter partes review," full termination of this review would not be appropriate if the joint motion is granted. 35 U.S.C. § 317(a).

III. Settlement Agreement

The Parties' Settlement Agreement has been made in writing, and as required under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true copy of the written Settlement Agreement resolving the Parties' dispute underlying this review is filed herewith as Exhibit 1014.[1] The Parties desire that this Settlement Agreement be treated as business confidential information and kept separate from the file of the involved patent, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. §

[1] The Settlement Agreement is being filed electronically via the PTAB E2E System as "Parties and Board Only."

42.74(c), and a separate joint request to that effect is being filed on even date herewith.

CONCLUSION

For the foregoing reasons, Halco and Blackbird respectfully request termination of *Inter Partes* Review Case IPR2017-00980 of U.S. Patent No. 7,086,747 with respect to Halco. Further, because Blackbird and Halco jointly request this termination as to Halco's involvement in this *inter partes* review, no estoppel under 35 U.S.C. § 315(e) shall attach to Halco. 35 U.S.C. § 317(a).

Respectfully submitted,

For Patent Owner:
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Dated: May 25, 2017

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the above-captioned **JOINT MOTION TO TERMINATE UNDER 35 U.S.C. § 317** was served electronically via e-mail on May 25, 2017 in its entirety on the following counsel for Patent Owner:

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