

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NIANTIC, INC.,
Petitioner,

v.

BLACKBIRD TECH LLC,
Patent Owner.

Cases IPR2019-00489 and IPR2019-00492 (Patent 9,802,127 B2)¹

Before BARRY L. GROSSMAN, MITCHELL G. WEATHERLY, and
TIMOTHY J. GOODSON, *Administrative Patent Judges*.

GOODSON, *Administrative Patent Judge*.

ORDER

Termination Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

¹ This Order applies to both of the listed proceedings. These proceedings have not been consolidated. The parties may use this style caption only if a paper contains a footnote indicating that the identical paper has been filed in each proceeding.

I. INTRODUCTION

After receiving our authorization to do so, Petitioner and Patent Owner (collectively “the Parties”) filed a Joint Motion to Terminate Proceeding in each of the above-captioned proceedings. Paper 12 (“Joint Motion”).² The Parties also filed, in each of the above-captioned proceedings, a copy of a Settlement, License, and Covenant Not To Sue Agreement (Ex. 1025 (“Agreement”)), and a Joint Motion to Treat Settlement as Business Confidential Information and Keep Separate (Paper 13 (“Joint Request”)).

II. DISCUSSION

The Parties represent that they “have settled their dispute regarding the ’127 Patent, including this proceeding, the pending inter partes review proceeding in IPR2019-00492 and Patent Owner’s assertion of the ’127 Patent in the related district court litigation.” Joint Motion 2. According to the Agreement, the Parties “desire to settle the Lawsuit and the Invalidation Proceedings and enter into this Agreement providing for a full, final, complete and global settlement of the subject matter of the Lawsuit and Invalidation Proceedings and for certain releases, licenses and covenants not to sue Niantic and its Affiliates.” Agreement 1.

Under 35 U.S.C. § 317(a), “[a]n inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” We have not entered Final Written Decisions in these proceedings, nor have we

² The papers and exhibits filed in these proceedings are substantively the same. We cite to the record in IPR2019-00489, unless otherwise noted.

reached a decision on the merits. Under these circumstances, we determine that it is appropriate to terminate the above-captioned proceedings without entering Final Written Decisions. *See* 37 C.F.R. § 42.72.

The Parties also filed a Joint Motion to Treat Settlement as Business Confidential Information and Keep Separate in each of the above-captioned proceedings. Joint Request 1. The Parties request that the Agreement be treated as business confidential information, and that the Agreement be kept separate from the file of the patents involved in the above-captioned proceedings. *Id.* at 2. “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.” 37 C.F.R. § 42.74(c). After reviewing the Agreement, we determine that it is appropriate to treat the Agreement between the Parties as business confidential information pursuant to 37 C.F.R. § 42.74(c).

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motion to Terminate Proceeding in each of the above-captioned proceedings is *granted*, and IPR2019-00489 and IPR2019-00492 are *terminated* with respect to Petitioner and Patent Owner; and

FURTHER ORDERED that the Joint Motion to Treat Settlement as Business Confidential Information and Keep Separate in each of the above-captioned proceedings is *granted*, and the Agreement shall be kept separate from the files of Patent 9,802,127 B2, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 37 C.F.R. § 42.74(c).

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