

**IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF PENNSYLVANIA**

Boxton Corporation,	:	
	:	
Plaintiff,	:	2019-cv-1234
	:	
v.	:	Honorable Richard A. Lloret
	:	
Blakbäks AS,	:	Hearing: April 17, 2019
	:	
Defendant.	:	

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**BOXTRON’S MOTION TO ENJOIN BLAKBÄKS FROM FILING AND  
PROSECUTING PETITIONS FOR *INTER PARTES* REVIEW IN THE USPTO**

# Introductions

For the Court: Honorable Richard A. Lloret, United States District Court for the Eastern District of Pennsylvania

Counsel for Plaintiff/Movant, Boxtron Corporation: Nicole D. Galli, Esq., Law Offices of N.D. Galli LLC

Counsel for Defendant/Non-Movant, Blakbäks AS: Steven J. Rocci, Baker & Hostetler LLP

## **Facts:**

- Boxtron and Blakbäks are competitors in the market for specialized black boxes (SBB's)
- 2014: Boxtron sues Blakbäks for infringement of the 789 patent
- Settlement: Royalty bearing patent license agreement; royalties payable on “Covered SBB's”
- “Covered SBB”: a Blackbäks SBB covered by any valid and enforceable claim of the 789 patent
- Agreement contains a no challenge clause

## Facts (continued):

- Blakbäks redesigns several of its SBB's and stops paying royalties on them
- 2018: Boxtron sues for breach of contract alleging that Blakbäks' redesigned SBB's are Covered SBB's and therefore are royalty bearing
- Complaint includes a detailed claim chart showing how the 789 patent claims allegedly cover the redesigned SBB's
- Blakbäks files a petition for *inter partes* review (IPR) of the 789 patent
- Boxtron moves to enjoin Blakbäks from filing and prosecuting IPR petitions

**Provision 1 (No Challenge):**

- (a) Blakbäks withdraws any allegations that the 789 patent is invalid or unenforceable.
- (b) Blakbäks agrees that it will not, during the term of the agreement, challenge the validity or enforceability of the 789 patent whether before a court, before the U.S. Patent and Trademark Office (“USPTO”), or in any other manner.
- (c) Blakbäks shall not be bound by Provision 1 in the event that Boxtron hereafter asserts the 789 patent against Blakbäks.

**Provision 2 (Forum Selection):**

- (a) All disputes arising out of or in connection with this agreement shall be brought in the United States District Court for the Eastern District of Pennsylvania (“EDPA”).
- (b) The parties consent to jurisdiction in the EDPA and waive all objections as to venue.

## **Spoiler alert:**

*Dodocase VR, Inc. v. MerchSource, LLC*, No. 3:17- cv-7088, 2018 WL 1475289 (N.D. Cal. Mar. 26, 2018) – Exhibit 1 to the case materials.

Appealed to the Federal Circuit (pending). Oral argument heard on April 3, 2019.

# Questions ?