UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC.,

Petitioner,

v.

JAWBONE INNOVATIONS LLC,

Patent Owner.

Case IPR2023-00561

U.S. Patent No. 8,503,691

JOINT MOTION TO TERMINATE PROCEEDINGS

LIST OF EXHIBITS

Exhibit No.	Description of Document
2001	Confidential Settlement Agreement
2002	Confidential Release

I. PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a), Petitioner Amazon.com, Inc. ("Petitioner") and Patent Owner Jawbone Innovations, LLC ("Patent Owner") jointly request that this *inter partes* review proceeding involving U.S. Patent No. 8,503,691 ("the '691 patent") be terminated based on an agreement between Petitioner and Patent Owner ("the Parties").

Patent Owner and Petitioner are parties to an agreement that resolves the disputes in the above-captioned *inter partes* review relating to the '691 patent. Petitioner and Patent Owner have thus settled their dispute regarding the '691 patent, including both this proceeding and Patent Owner's assertion of the '691 Patent in the related district court litigation, *Jawbone Innovations, LLC v. Amazon.com, Inc.*, Case No. 3:22-cv-06727-TLT (N.D. Cal.). The Parties filed a joint motion to dismiss with prejudice the related district court action on July 24, 2023, and the district court entered an order dismissing the case on July 26, 2023.

The agreements resolving the Parties' dispute include a confidential settlement agreement between Patent Owner and a third party, as well as a confidential release agreement between the Parties. Patent Owner submits a true copy of the confidential agreements in their entirety, filed herewith as Exhibits 2001 and 2002, respectively. The Parties do not anticipate any further litigation between them concerning the '091 patent. There are no other agreements, oral or written,

between the Parties made in connection with, or in contemplation of, the termination of this proceeding.

II. REASONS FOR GRANTING THE MOTION

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding. *See, e.g.*, Consolidated Trial Practice Guide, 86 (Nov. 2019). The Board's policy is in accord with the governing statute, which states that "An 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." 35 U.S.C. § 317(a). The Board has not decided the merits of this proceeding.

The Board authorized filing of the instant motion on July 26, 2023. Guidance as to the content of a motion to terminate is provided in *Apotex Cop. v. Alcon Research, Ltd.*, IPR2013-00428, Paper No. 56. There, the Board indicated that a joint motion, such as this one, should (a) include a brief explanation as to why termination is appropriate; (b) identify all parties in any related litigation involving the patent at issue; (c) identify any related proceedings currently before the Office; and (d) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding. *Id.* at 2. This motion satisfies each of the above requirements.

A. Brief Explanation of Why Termination is Appropriate

Good cause exists to terminate this proceeding because the Parties have settled their dispute regarding the ’691 patent and the Board has not determined the merits of the proceeding. Terminating this proceeding thus serves the interests of judicial economy as well as the mutual interests of the Parties.

Termination is appropriate because no post-institution briefs have been filed, oral argument has not been held, and the Board has not decided the merits of the proceeding, i.e., a final written decision has not been issued. Under 35 U.S.C. § 317(a), this proceeding “shall be terminated” because the Parties are jointly requesting termination and the Office has not yet “decided the merits of the proceeding before the request for termination is filed.” The Parties have resolved their disputes and executed an agreement which contemplates requesting termination of this proceeding and dismissing the Parties’ related proceeding regarding the ’691 patent in *Jawbone Innovations, LLC v. Amazon.com, Inc.*, Case No. 3:22-cv-06727-TLT (N.D. Cal.).

B. All Parties in Any Pending Related Litigation Involving the Patent at Issue

The following litigation is related to the ’691 patent and the Parties:

- *Jawbone Innovations, LLC v. Amazon.com, Inc.*, Case No. 3:22-cv-06727-TLT (N.D. Cal.)

A joint motion to dismiss with prejudice was submitted in the above action on July 24, 2023, and the Court granted that motion on July 26, 2023.

The ’691 patent is also the subject of concurrent litigation between Patent Owner and Google LLC (“Google”) in the Northern District of California: *Jawbone Innovations, LLC v. Google LLC*, Case No. 3:23-cv-00466-TLT (N.D. Cal.) (“the Google Litigation”). Petitioner is not a party to the Google Litigation. Patent Owner and Google have also settled their dispute and have filed a stipulation of dismissal with prejudice in the Google Litigation.

The ’691 patent is also the subject of litigation between Patent Owner and other defendants in the following cases. Petitioner is not a party to any of the below litigations.

- *Jawbone Innovations, LLC v. Guangdong OPPO Mobile Telecommunications Corp., Ltd., d/b/a OPPO*, Case No. 3:23-cv-00079 (E.D. Tex.);
- *Jawbone Innovations, LLC v. HTC Corporation*, Case No. 3:23-cv-00077 (E.D. Tex.);
- *Jawbone Innovations, LLC v. LG Electronics, Inc.*, Case No. 2:23-cv-00078 (E.D. Tex.);
- *Jawbone Innovations, LLC v. Meta Platforms, Inc.*, Case No. 6:23-cv-00158 (W.D. Tex.);

- *Jawbone Innovations, LLC v. Panasonic Holdings Corporation*, Case No. 2:23-cv-00081 (E.D. Tex.);
- *Jawbone Innovations, LLC v. Sony Electronics Inc.*, Case No. 2:23-cv-01161-MEF-LDW (D.N.J.); and
- *Jawbone Innovations, LLC v. ZTE Corporation*, Case No. 3:23-cv-00082 (E.D. Tex.).

C. Related Proceedings Currently Before the Office

The ’691 patent is the subject of IPR2023-00559, filed by Amazon. Pursuant to the Board’s authorization, the Parties are filing a joint motion to terminate IPR2023-00559.

The ’691 patent is the subject of IPR2022-01060 and IPR2022-01061 filed by Google (the “Google IPRs”). Pursuant to the Board’s Order, Petitioner in this proceeding was joined to IPR2022-01061. As noted above, Patent Owner and Google have settled their dispute and have filed a motion to terminate the Google IPRs. Petitioner and Patent Owner are further filing a motion to terminate Petitioner from IPR2022-01061.

The ’691 patent is further the subject of IPR2023-01228 and IPR2023-01229, which have not been instituted. The party in IPR2023-01229 has filed a motion for joinder to this IPR. That motion is currently pending before the Board.

The Parties submit that none of the above proceedings are cause for the Board to deny the present Motion as they do not involve both of the present parties and/or are inapplicable to consideration of a motion to terminate this proceeding.

D. Current Status of Each Such Related Litigation or Proceeding with Respect to Each Party in the Litigation or Proceeding

Sections II.B and II.C above indicate the status of each related litigation or proceeding with respect to each party to the litigation or proceeding.

III. AGREEMENT

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the agreements made in connection with, or in contemplation of, the termination of the proceeding is in writing, and Patent Owner is filing true and correct copies of those agreements concurrently herewith as Exhibits 2001 and 2002. The agreements are being filed via the Patent Trial and Appeal Board Case Tracking System (PTACTS) system with access to the "Board only." The Parties are also filing concurrently herewith a joint request under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) to treat the agreements as business confidential information and keep them separate from the files of the '091 patent. The Parties certify that there are no other agreements, oral or written, between the Parties made in connection with, or in contemplation of, the termination of this proceeding.

IV. CONCLUSION

For all these reasons, the Pfarties respectfully request termination of this proceeding.

Date: July 29, 2023

Respectfully submitted,

/Colin B. Heideman/

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