UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC

Petitioner,

v.

JAWBONE INNOVATIONS LLC,

Patent Owner.

Case IPR2023-01074

U.S. Patent No. 8,321,213

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 Google LLC ("Petitioner") and Patent Owner Jawbone Innovations, LLC ("Patent Owner") jointly request that this *inter partes* review proceeding involving U.S. Patent No. 8,321,213 ("the '213 patent") be terminated based on an agreement between Petitioner and Patent Owner ("the Parties").

Patent Owner and Petitioner have entered into an agreement which resolves the disputes in the above-captioned *inter partes* review relating to U.S. Patent No. 8,321,213. Petitioner and Patent Owner have settled their dispute regarding the '213 patent, including both this proceeding and Patent Owner's assertion of the '213 Patent in the related district court litigation, *Jawbone Innovations, LLC v. Google LLC*, Case No. 3:23-cv-00466-TLT (N.D. Cal.). Patent Owner filed a stipulation of dismissal, with prejudice, in the related district court action on July 25, 2023. Petitioner and Patent Owner submit a true copy of that confidential agreement in its entirety, filed herewith as Exhibit 2001. Petitioner and Patent Owner further submit a true copy of a confidential release signed by the Parties, filed herewith as Exhibit 2002. The Parties do not anticipate any further litigation between them concerning the '213 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 24, 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 ’213 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 trial has not been instituted in this proceeding, 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 ’213 patent in *Jawbone Innovations, LLC v. Google LLC*, Case No. 3:23-cv-00466-TLT (N.D. Cal.).

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

The following litigation is related to the ’213 patent and the Parties:

- *Jawbone Innovations, LLC v. Google LLC*, Case No. 3:23-cv-00466-TLT (N.D. Cal.)

A stipulation of dismissal with prejudice was submitted in the above action on July 25, 2023.

The ’213 patent is also the subject of concurrent litigation between Patent Owner and Amazon.com, Inc. (“Amazon”) in the Northern District of California: *Jawbone Innovations, LLC v. Amazon.com, Inc.*, Case No. 3:22-cv-06727-TLT (N.D. Cal.) (“the Amazon Litigation”). Petitioner is not a party to the Amazon Litigation. Patent Owner and Amazon have also settled their dispute and have filed a joint motion to dismiss the Amazon Litigation.

The ’213 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 ’213 patent is the subject of IPR2022-00797, filed by Google. Pursuant to the Board’s authorization, the parties are filing a motion to terminate that proceeding.

The ’213 patent is the subject of IPR2023-00276 and IPR2023-00279 filed by Amazon (the “Amazon IPRs”). As noted above, Patent Owner and Amazon have settled their dispute and are preparing a motion to terminate the Amazon IPRs.

The ’213 patent is further the subject of IPR2023-01083, IPR2023-01084, IPR2023-01111, IPR2023-01112, IPR2023-01117, and IPR2023-01118, which have not been instituted.

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 Parties' agreement made in connection with, or in contemplation of, the termination of the proceeding is in writing, and a true and correct copy is being filed concurrently herewith as Exhibit 2001.[1] A true and correct copy of a confidential release is being filed concurrently herewith as Exhibit 2002.[2] 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 this agreement as business confidential information and keep it separate from the files of the '213 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 Parties respectfully request termination of this proceeding.

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[1] The agreement is being filed via the Patent Trial and Appeal Board Case Tracking System (PTACTS) system with access to the "Board only."

[2] The agreement is being filed via the Patent Trial and Appeal Board Case Tracking System (PTACTS) system with access to "Parties and Board."

Date: July 27, 2023

Respectfully submitted,

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