
From: Trials <Trials@USPTO.GOV>
Sent: Tuesday, April 16, 2024 8:32 AM
To: Gewirtz, Gregory S.; Trials
Cc: 'Peter Lambrianakos'; 'vrubino@fabricantllp.com'; 'ffabricant@fabricantllp.com'; 'Jacob Ostling'; 'eiturralde@fabricantllp.com'; 'Richard Cowell'; 'PTAB'; 'gracewang@paulhastings.com'; 'lisanguyen@paulhastings.com'; 'davidtenant@paulhastings.com'; 'alanbillharz@paulhastings.com'; 'ericlancaster@paulhastings.com'; 'PH-Meta-Jawbone-IPR@paulhastings.com'; 'ggewirtz.IPR'; Cockings, Orville R.; Faegenburg, Russell W.; Caro-Esposito, Daniela; Litigation; Apicella, Laura; Dowell, Jonathan
Subject: RE: Petitioner Sony's Request to Terminate Participation in IPR 2023-01084, -01127 and -01128 (Meta Lead)

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Counsel,

The Board authorizes the parties' request to file a joint motion to terminate Sony as a party in each of the below-listed proceedings. Any settlement agreements need not be filed in the consolidated proceedings but may instead be filed in the related proceedings where Sony is sole petitioner, in view of confidentiality considerations. In addition, the parties are authorized to file a joint request to treat the agreement(s) as business confidential information in each case under 37 C.F.R. § 42.74(c). This request may be part of the joint motion to terminate or may be filed as a separate paper, and if there is such a joint request, the exhibit containing the agreement(s) must be filed "For Board only" or "For Board and Parties Only."

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Gewirtz, Gregory S. <ggewirtz@lernerdavid.com>
Sent: Friday, April 12, 2024 3:47 PM
To: Trials <Trials@USPTO.GOV>
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Subject: Petitioner Sony's Request to Terminate Participation in IPR 2023-01084, -01127 and -01128 (Meta Lead)

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Dear Board:

Pursuant to 37 C.F.R. §§ 42.20(b) and 42.74 and the PTAB Consolidated Practice Guide (Nov. 2019), Petitioner Sony Electronics Inc. (“Sony”) respectfully requests authorization to file a motion to terminate its participation in the following five IPR proceedings:

- (1) IPR2023-01084 (U.S. Patent No. 8,321,213 (claims 14-42));
- (2) IPR2023-01127 (U.S. Patent No. 8,019,091); and
- (3) IPR2023-01128 (U.S. Patent No. 8,326,611 (claims 1-28)).

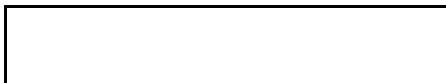
Petitioner and Patent Owner, Jawbone Innovations, LLC, have reached an agreement to simplify a related patent infringement lawsuit (Civil Action No. 2:23-cv-01161-MEF-LDW filed by Patent Owner against Petitioner in the United States District Court for the District of New Jersey) by dismissing the above subject patents along with certain other patents from that lawsuit. The Parties have entered into a confidential agreement regarding dismissal of the above-identified patents and certain other patents from the lawsuit. The agreement resolves all disputes between Petitioner and Patent Owner relating to the IPR proceedings above. That agreement will be submitted for filing with the Board as business confidential pursuant to 37 C.F.R. §§ 42.74(b) and (c).

Please note that Sony is in a back-up role in the above IPR proceedings and that Meta Platforms, Inc. (“Meta”) is the lead Petitioner in these proceedings. Sony’s present request and expected motion only seeks to terminate Sony’s own petition and involvement in these proceedings – it does not impact Meta’s role as the lead Petitioner.

Respectfully submitted,

Gregory S. Gewirtz
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Counsel for Petitioner Sony Electronics Inc.

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