Filed: March 18, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS INC.
Petitioner,

v.

JAWBONE INNOVATIONS, LLC,
Patent Owner.

IPR2023-01112
U.S. Patent No. 8,321,213

PETITIONER LG ELECTRONICS INC. AND PATENT OWNER JAWBONE INNOVATIONS, LLC'S JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, LG Electronics Inc. ("Petitioner" or "LGE") and Patent Owner Jawbone Innovations, LLC ("Patent Owner") (collectively, the "parties") jointly request termination of this inter partes review (IPR) of U.S. Patent No. 8,321,213 ("'213 Patent" or "challenged patent"), Case No. IPR2023-01112.

The parties have settled their dispute with respect to the challenged patent and have reached agreement to terminate this IPR; the parties do not anticipate any further litigation concerning the challenged patent. In accordance with 37 C.F.R. § 42.20(b), the parties received authorization from the Board to file this motion on March 14, 2024.

Termination of this proceeding is proper for at least the following reasons:

- The parties are jointly requesting termination. 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012) ("There are strong public policy reasons to favor settlement between the parties to a proceeding.") (emphasis added). Both Congress and the federal courts have expressed a strong interest in encouraging settlement in litigation. *See, e.g., Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) ("The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation."); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) ("The law favors settlement of cases."), *cert. denied*, 479 U.S. 950 (1986). The Federal Circuit places a particularly strong emphasis on

settlement. *See Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility between parties). Here, no public interest or other factors weigh against termination of this proceeding.

- The Board has not yet "decided the merits of the proceeding before the request for termination is filed." 35 U.S.C. § 317(a) (emphasis added); 77 Fed. Reg. 48768 ("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.") Petitioner filed its petition for inter partes review on June 23, 2023. This Board instituted a trial on January 9, 2024 but has not issued a final written decision. No motions are outstanding in this proceeding. No other party's rights will be prejudiced by the termination of this inter partes review. This supports the propriety of terminating this proceeding under 35 U.S.C. § 317. 77 Fed. Reg. 48680, 48686 (Aug. 14, 2012) (And 35 U.S.C. 317(a) provides "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.")

- The parties in the related district court action, *Jawbone Innovations, LLC v. LG Electronics, Inc.*, Case No. 2:23-cv-00078-JRG-RSP pending in the Eastern District of Texas moved to dismiss all claims in that case, including those that relate to the ’213 Patent. The court granted the motion to dismiss on March 14, 2024.

The settlement agreement between the parties has been made in writing, and a true and correct copy will be filed in this proceeding as Exhibit 4001 to the contemporaneously filed Joint Motion to Keep Separate. The parties certify that there are no other collateral agreements in connection with the settlement per 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b).

/Indranil Mukerji/
Indranil Mukerji
Reg. No. 46,944
WILLKIE FARR & GALLAGHER LLP
1875 K Street, N.W.
Washington, DC 20006-1238
Telephone: (202) 303-1000
Facsimile: (202) 303-2000
Counsel for Petitioner
LG ELECTRONICS INC.

/Peter Lambrianakos/
Peter Lambrianakos
Reg. No. 58,279
FABRICANT LLP
411 Theodore Fremd Avenue, Suite 206 South Rye, New York 10580
Telephone: (212) 257-5797
Facsimile: (212) 257-5796
Counsel for Patent Owner
JAWBONE INNOVATIONS, LLC

CERTIFICATE OF SERVICE

I certify that on March 18, 2024, I caused a true and correct copy of the foregoing Joint Motion To Terminate to be served via electronic mail to Patent Owner's counsel of record below:

Alfred R. Fabricant (ffabricant@fabricantllp.com)
Peter Lambrianakos (plambrianakos@fabricantllp.com)
Vincent J. Rubino, III (vrubino@fabricantllp.com)
Enrique W. Iturralde (eiturralde@fabricantllp.com)
Richard Cowell (rcowell@fabricantllp.com)
Jacob Ostling (jostling@fabricantllp.com)
ptab@fabricantllp.com

Justin Kurt Truelove (kurt@truelovelawfirm.com)

WILLKIE FARR & GALLAGHER LLP

/Indranil Mukerji/
Counsel for Petitioner,
LG ELECTRONICS INC.