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.

IPR2023-01127
U.S. Patent No. 8,019,091

PETITIONER LG ELECTRONICS INC. AND PATENT OWNER JAWBONE INNOVATIONS, LLC'S JOINT MOTION TO TERMINATE LG ELECTRONICS INC. AS A PARTY IN THE CONSOLIDATED PROCEEDING 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 LGE as a party in consolidated inter partes review (IPR) of U.S. Patent No. 8,019,091 ("'091 Patent" or "challenged patent"), Case No. IPR2023-01127.

The parties have settled their dispute with respect to the challenged patent and have reached agreement to terminate LGE as a party in 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. 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).

Termination of LGE as a party in the consolidated proceeding is proper for at least the following reasons:

- The parties are jointly requesting termination of LGE as a party. 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 LGE as a party to 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 individual IPR petition, IPR2023-01154, on July 5, 2023. The Board ordered LGE to file its individual IPR petition in the consolidated proceeding, IPR2023-01127, on February 5, 2024. Petitioner filed its individual IPR petition in IPR2023-01127 on Februry 15, 2024. This Board instituted trials for IPR2023-01127 and IPR2023-01154 on December 21, 2023 but has not issued final written decisions in either IPR. No motions are outstanding in this proceeding. No

other party's rights will be prejudiced by the termination of LGE as a party in IPR2023-01127. This supports the propriety of terminating of LGE as a party to 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 '091 Patent. The court granted the motion to dismiss on March 14, 2024.

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that on March 18, 2024 a copy of the foregoing document was served by email upon the following:

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