

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY ELECTRONICS INC.,
Petitioners,

v.

JAWBONE INNOVATIONS, LLC,
Patent Owner.

IPR2023-01117 (U.S. Patent No. 8,321,213)
IPR2023-01166 (U.S. Patent No. 8,019,091)
IPR2023-01177 (U.S. Patent No. 8,326,611)

**JOINT MOTION TO TERMINATE PETITIONER
SONY ELECTRONICS INC. AS A PARTY**

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Petitioner Sony Electronics Inc. (“Sony”) and Patent Owner Jawbone Innovations, LLC (“Jawbone”) (collectively “the Parties”) jointly request termination of Sony as a party in *Inter Partes* Review Nos. IPR2023-01117 (U.S. Patent No. 8,321,213 cls.14-42); IPR2023-01166 (U.S. Patent No. 8,019,091; and IPR2023-01177 (U.S. Patent No. 8,326,611 cls.1-28) (collectively “the IPRs” for “the challenged patents”).

An Order to consolidate these IPRs with Meta Platforms, Inc.’s (“Meta”) corresponding IPRs (i.e., IPR2023-01084 for the ’213 Patent; IPR2023-01127 for the ’091 Patent; and IPR2023-01128 for the ’611 Patent) was entered on February 6, 2024, with Meta being the lead party. This motion only seeks to terminate Sony’s proceeding and does not relate to Meta’s above-identified proceedings, which are ongoing.

The present Joint Motion To Terminate has been filed because Parties have now settled their dispute involving the challenged patents.

Jawbone filed a patent infringement lawsuit on February 28, 2023, against Sony in the United States District Court for the District of New Jersey alleging infringement of the challenged patents and other patents. That lawsuit is still pending as *Jawbone Innovations, LLC v. Sony Electronics Inc.*, 2:23-cv-01161-MEF-LDW. On April 15, 2024, the Parties filed a Joint Stipulation of Partial Dismissal to dismiss with prejudice all claims and counterclaims of the challenged patents and certain

other patents. On April 16, 2024, the Court entered an Order of Partial Dismissal dismissing with prejudice all claims and counterclaims of the challenged patents and other patents, and a true and correct copy of such document is being filed herewith as follows:

IPR No.	Exhibit No.
IPR2023-01117	1017
IPR2023-01166	1020
IPR2023-01177	1017

The Board issued decisions instituting the present IPR proceedings on the following dates:

January 9, 2024 – IPR2023-01117 ('213 Patent)

December 21, 2023 – IPR2023-01166 ('091 Patent)

January 9, 2024 – IPR2023-01177 ('611 Patent)

Pursuant to 35 U.S.C. § 317(b), the Parties entered an Agreement that resolves all disputes between the Parties relating to the challenged patents. That agreement was made in contemplation of termination of these proceedings. Such Agreement is in writing, and a true and correct copy of such document is being filed herewith as follows:

IPR No.	Exhibit No.
IPR2023-01117	1018
IPR2023-01166	1021
IPR2023-01177	1018

The Parties request that the Agreement be maintained as business confidential under 37 C.F.R. § 42.74(c), and a separate joint request to that effect is being filed concurrently herewith. No other such agreements, written or oral, exist between or among the Parties in connection with or in contemplation of the dismissal of these proceedings.

On April 15, 2024, the Board sent an email authorizing the Parties to file the present Joint Motion to Terminate, and a true and correct copy of such document is being filed herewith as follows:

IPR No.	Exhibit No.
IPR2023-01117	1019
IPR2023-01166	1022
IPR2023-01177	1019

Under 35 U.S.C. § 317(a), “[a]n *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 have settled their dispute and do not anticipate any further litigations concerning the challenged patents. Moreover, the Board has not decided the merits of the proceedings. As such, granting the Parties’ Joint Motion To Terminate the IPRs at this juncture would serve to preserve the Board’s and Parties’ resources and promote a speedy and inexpensive resolution. 37 C.F.R. § 42.1(b)

In view of the above, the Parties request that the subject IPRs be terminated.

Respectfully submitted,

LERNER DAVID LLP

Dated: April 26, 2024

/Gregory S. Gewirtz/
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FABRICANT LLP

Dated: April 26, 2024

/Peter Lambrianakos/
Peter Lambrianakos
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Counsel for Patent Owner
Jawbone Innovations, LLC

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **JOINT MOTION TO TERMINATE PETITIONER SONY ELECTRONICS INC. AS A PARTY** is being served by filing this document and by email this 26th day of April, 2024, on the following counsel of record:

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