Filed on behalf of: Meta Platforms, Inc.

Filed: December 3, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.,
Petitioner,

v.

JAWBONE INNOVATIONS, LLC,
Patent Owner.

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

JOINT MOTION TO TERMINATE PROCEEDING PURSUANT TO 35 U.S.C. § 317(a) AND 37 C.F.R § 42.74

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. §§ 42.72 and 42.74, Petitioner Meta Platforms, Inc. ("Petitioner") and Patent Owner Jawbone Innovations, LLC ("Patent Owner") (collectively, the "Parties") jointly request termination of the *inter partes review* ("IPR") proceeding of U.S. Patent No. 8,019,091 ("'091 Patent"), Case No. IPR2023-01127. The filing of this Joint Motion was authorized by the Board in email correspondence dated December 2, 2024.

II. STATEMENT OF REASONS FOR THE RELIEF REQUESTED

On December 2, 2024, Petitioner and Patent Owner executed a confidential agreement to resolve all disputes regarding the '091 Patent. Accordingly, termination is appropriate because all disputes between the Parties regarding the '058 Patent have been resolved.

Pursuant to 37 C.F.R. §§ 42.5 and 42.72, the Board may terminate a trial without rendering a final written decision where appropriate, including pursuant to a joint request under 35 U.S.C. §§ 317(a) or 327(a). *See Winplus N. Am., Inc. v. Pilot, Inc.*, No. IPR2018-00488, Paper 12 (P.T.A.B. Oct. 24, 2018); *see also* Consolidated Trial Practice Guide at 86 (Nov. 2019) ("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."). Further, a dismissal of this IPR would promote efficiency and minimize unnecessary costs.

The Parties are jointly requesting termination because the parties have settled their larger dispute concerning the '091 Patent, including the related district court action, *Jawbone Innovations, LLC v. Meta Platforms, Inc.*, No. 6:23-cv-00158-ADA (W.D. Tex.). 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012) ("There are strong public policy reasons to favor settlement between the parties to a proceeding."). Both Congress and the federal courts have expressed a strong interest in encouraging settlement in litigation, and terminating this IPR furthers that purpose. *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.").

The Parties' confidential agreement is submitted concurrently herewith. In accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the Parties also submit concurrently herewith a joint request that the confidential agreement be treated as confidential business information, be kept separate from the file of the involved patent, and be made available only to the Federal Government agencies on written request, or to any person on showing of good cause under 35 U.S.C. § 317 and 37 C.F.R. § 42.74(c). A true and correct copy of the confidential agreement is submitted with that Request as Confidential Exhibit 1023.

Petitioner and Patent Owner certify that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the

termination of the proceeding. Both Petitioner and Patent Owner support termination of the proceeding.

III. STATUS OF RELATED CASES

The status of related cases to this IPR proceeding are as follows:

- IPR2023-01084, U.S. Patent No. 8,321,213: Oral argument occurred on October 9, 2024. The final written decision has not issued.
- IPR2023-01128, U.S. Patent No. 8,326,611: Oral argument occurred on October 9, 2024. The final written decision has not issued.
- IPR2023-01291, U.S. Patent No. 8,467,543: Oral argument was previously scheduled to commence on December 4, 2024, but has been canceled pursuant to email correspondence from the Board dated December 2, 2024.
- IPR2023-01352, U.S. Patent No. 8,467,543: Oral argument was previously scheduled to commence on December 11, 2024, but has been canceled pursuant to email correspondence from the Board dated December 2, 2024.
- *Jawbone Innovations, LLC v. Meta Platforms, Inc.*, No. 6:23-cv-00158-ADA (W.D. Tex.): The Parties have filed a Joint Motion to Dismiss with Prejudice pursuant to their settlement.

IV. CONCLUSION

For the foregoing reasons, Petitioner and Patent Owner jointly request that the Board dismiss this proceeding in its entirety.

Dated: December 3, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of **JOINT MOTION TO TERMINATE PROCEEDING PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R § 42.74** was served via electronic email on Patent Owner's counsel of record listed below, pursuant to its Mandatory Notices, on December 3, 2024:

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