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Paper 23
Date: April 30, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY ELECTRONICS INC.,
Petitioner,

v.

JAWBONE INNOVATIONS, LLC,
Patent Owner.

IPR2023-01065 (U.S. Patent No. 10,779,080)
IPR2023-01119 (U.S. Patent No. 7,246,058)
IPR2023-01222 (U.S. Patent No. 8,467,543)
IPR2023-01228 (U.S. Patent No. 8,503,691)
IPR2023-01229 (U.S. Patent No. 8,503,691)[1]

Before GEORGIANNA W. BRADEN, NORMAN H. BEAMER, SHEILA F. McSHANE, and JASON M. REPKO, *Administrative Patent Judges*.[2]

PER CURIAM.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

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[1]The Board is entering the same Order in all captioned cases. The parties are not authorized to use this combined case caption.

[2] This is not an expanded panel. Three of the listed judges are on each case.

I. INTRODUCTION

With the Board's authorization, Petitioner Sony Electronics Inc. and Patent Owner Jawbone Innovations, LLC (collectively, "the parties") filed Joint Motions to Terminate in the above-identified proceedings. IPR2023-01065, Paper 17; IPR2023-01119, Paper 24; IPR2023-01222, Paper 21; IPR2023-01228, Paper 16; IPR2023-01229, Paper 15 (collectively "Joint Motion"). In support of the Motions, the parties filed a copy of a Settlement Agreement (IPR2023-01065, Ex. 1035; IPR2023-01119, Ex. 1023; IPR2023-01222, Ex. 1030; IPR2023-01228, Ex. 1021; IPR2023-01229, Ex. 1021) and Joint Request To File Agreement As Business Confidential Information Under 37 C.F.R. § 42.74(c). IPR2023-01065, Paper 18; IPR2023-01119, Paper 25; IPR2023-01222, Paper 22; IPR2023-01228, Paper 17; IPR2023-01229, Paper 16 (collectively "Joint Request").

II. DISCUSSION

In the Joint Motions, the parties requested the Board terminate the above-identified *inter partes* review proceedings as a result of a settlement agreement reached between Petitioner and Patent Owner. Joint Motion, 1.[3] The parties represent that the filed copy of the Settlement Agreement is a true copy. *Id.* at 2. The parties also represent that "[n]o other such

[3] For convenience, we cite solely to the papers in IPR2023-01065, but similar citations apply to each of the above-identified cases.

agreements, written or oral, exist between or among the Parties in connection with or in contemplation of the dismissal of these proceedings." *Id.* at 3. The Settlement Agreement indicates that the parties have resolved their disputes and the litigation between them involving the above-identified patents at issue. IPR2023-01065, Ex. 1035; IPR2023-01119, Ex. 1023; IPR2023-01222, Ex. 1030; IPR2023-01228, Ex. 1021; IPR2023-01229, Ex. 1021.

According to 35 U.S.C. § 317(a), an *inter partes* review proceeding shall be terminated post-institution 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. As the Board has not yet decided the merits of the proceedings addressed in this order, we determine that good cause exists to terminate the proceedings before rendering a final written decision in accordance with 37 C.F.R. § 42.72.

Moreover, in the Joint Request, the parties request that the Settlement Agreement be treated as business confidential information and be kept separate from the files of the above-identified patent at issue. *See, e.g.*, IPR2023-01065, Paper 18, 2. After reviewing the Settlement Agreement between the parties, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement between the parties as business confidential information pursuant to 37 C.F.R. § 42.74(c).

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motions to Terminate are *granted*;

FURTHER ORDERED that IPR2023-01065, IPR2023-01119, IPR2023-01222, IPR2023-01228, and IPR2023-01229 are *terminated* pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Request To File Agreement As Business Confidential Information Under 37 C.F.R. § 42.74(c) are *granted*, and the confidential Settlement Agreement (IPR2023-01065, Ex. 1035; IPR2023-01119, Ex. 1023; IPR2023-01222, Ex. 1030; IPR2023-01228, Ex. 1021; IPR2023-01229, Ex. 1021) shall be treated as business confidential information pursuant to 37 C.F.R. § 42.74(c) and be kept separate from the files of the challenged patents and made available only under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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