From: Trials <Trials@USPTO.GOV>
Sent: Monday, April 15, 2024 10:22 AM
To: Gewirtz, Gregory S.; Trials
Cc: Peter Lambrianakos; vrubino@fabricantllp.com; 'ffabricant@fabricantllp.com'; Jacob Ostling; eiturralde@fabricantllp.com; Richard Cowell; PTAB; ggewirtz.IPR; Cockings, Orville R.; Faegenburg, Russell W.; Caro-Esposito, Daniela; Litigation; Apicella, Laura; Dowell, Jonathan
Subject: RE: Petitioner's Request to Terminate IPR 2023-01065, -0119, -01222, -01228, and -01229

EXTERNAL EMAIL: Use caution when opening attachments or links.

Counsel,

The Board authorizes the parties to file a Joint Motion to Terminate, signed by counsel of record for both parties, in the following five IPR proceedings:

(1) IPR2023-01065 (U.S. Patent No. 10,779,080);
(2) IPR2023-01119 (U.S. Patent No. 7,246,058);
(3) IPR2023-01222 (U.S. Patent No. 8,467,543);
(4) IPR2023-01228 (U.S. Patent No. 8,503,691 (claims 1-22, 29-40)); and
(5) IPR2023-01229 (U.S. Patent No. 8,503,691 (claims 23-28, 41-46)).

The parties are reminded of their obligations under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74, which require the filing of a complete (unredacted) copy of the settlement agreement and any collateral agreements (including any license agreements) with the Board as an exhibit. For their joint motion, the parties should state whether there are other agreements, oral or written, between the parties made in connection with, or in contemplation of, the dismissal of the proceeding.

Furthermore, the parties are authorized to file a joint request to treat their agreement(s) as business confidential information in each case under 37 C.F.R. § 42.74(c). This request may be part of the Joint Motion to Terminate or may be filed as a separate paper, and if there is such a joint request, the exhibit containing the agreement(s) must be filed "For Board only" or "For Board and Parties Only."

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Gewirtz, Gregory S. <ggewirtz@lernerdavid.com>
Sent: Friday, April 12, 2024 3:40 PM
To: Trials <Trials@USPTO.GOV>
Cc: Peter Lambrianakos <plambrianakos@fabricantllp.com>; vrubino@fabricantllp.com; 'ffabricant@fabricantllp.com' <ffabricant@fabricantllp.com>; Jacob Ostling <jostling@fabricantllp.com>; eiturralde@fabricantllp.com; Richard Cowell <rcowell@fabricantllp.com>; PTAB <PTAB@fabricantllp.com>; ggewirtz.IPR <ggewirtz.IPR@ldlkm.com>; Cockings, Orville R. <ocockings@lernerdavid.com>; Faegenburg, Russell W. <rfaegenburg@lernerdavid.com>; Caro-Esposito, Daniela <dcaro-esposito@lernerdavid.com>; Litigation <litigation@lernerdavid.com>; Apicella, Laura <lapicella@lernerdavid.com>; Dowell, Jonathan <jdowell@lernerdavid.com>
Subject: Petitioner's Request to Terminate IPR 2023-01065, -0119, -01222, -01228, and -01229

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Dear Board:

Pursuant to 37 C.F.R. §§ 42.20(b) and 42.74 and the PTAB Consolidated Practice Guide (Nov. 2019), Petitioner Sony Electronics Inc. respectfully requests authorization to file a motion to terminate the following five IPR proceedings:

(1) IPR2023-01065 (U.S. Patent No. 10,779,080);
(2) IPR2023-01119 (U.S. Patent No. 7,246,058);
(3) IPR2023-01222 (U.S. Patent No. 8,467,543);
(4) IPR2023-01228 (U.S. Patent No. 8,503,691 (claims 1-22, 29-40)); and
(5) IPR2023-01229 (U.S. Patent No. 8,503,691 (claims 23-28, 41-46)).

Petitioner and Patent Owner, Jawbone Innovations, LLC, have reached an agreement to simplify a related patent infringement lawsuit (Civil Action No. 2:23-cv-01161-MEF-LDW filed by Patent Owner against Petitioner in the United States District Court for the District of New Jersey) by dismissing the above subject patents along with certain other patents from that lawsuit. The Parties have entered into a confidential agreement regarding dismissal of the above-identified patents and certain other patents from the lawsuit. The agreement resolves all disputes between Petitioner and Patent Owner relating to the IPR proceedings above. That agreement will be submitted for filing with the Board as business confidential pursuant to 37 C.F.R. §§ 42.74(b) and (c).

Respectfully submitted,

Gregory S. Gewirtz
Lerner David LLP
Counsel for Petitioner Sony Electronics Inc.

Gregory S. Gewirtz
ggewirtz@lernerdavid.com
908-518-6343 Direct Office
908-447-7796 Mobile

Lerner David LLP
20 Commerce Drive | Suite 400 | Cranford, NJ 07016