Trials@uspto.gov
571-272-7822

Paper 16
Entered: March 28, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS INC.,
Petitioner,

v.

JAWBONE INNOVATIONS, LLC,
Patent Owner.

IPR2023-01110 (Patent No. 7,246,058 B2)
IPR2023-01112 (Patent No. 8,321,213 B2)
IPR2023-01154 (Patent No. 8,019,091 B2)
IPR2023-01155 (Patent No. 8,326,611 B2)
IPR2023-01248 (Patent No. 8,467,543 B2)[1]

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

RAEVSKY, *Administrative Patent Judge*.

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 LG Electronics Inc. and Patent Owner Jawbone Innovations, LLC (collectively, "the parties") filed Joint Motions to Terminate in the above-identified proceedings. IPR2023-01110, Paper 15; IPR2023-01112, Paper 15; IPR2023-01154, Paper 16; IPR2023-01155, Paper 15; IPR2023-01248, Paper 14 (collectively "Joint Motion"). In support of the Motions, the parties filed a copy of a Settlement Agreement (IPR2023-01110, Ex. 1021; IPR2023-01112, Ex. 1017; IPR2023-01154, Ex. 1020; IPR2023-01155, Ex. 1017; IPR2023-01248, Ex. 1029) and Joint Request to Keep Separate Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74. IPR2023-01110, Paper 16; IPR2023-01112, Paper 16; IPR2023-01154, Paper 17; IPR2023-01155, Paper 16; IPR2023-01248, Paper 15 (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 3. The parties also represent that "there are no other collateral agreements in connection with the settlement." *Id.* The Settlement Agreement indicates that the parties have resolved their disputes

[3] For convenience, we cite solely to the papers in IPR2023-01110, but similar citations apply to each of the above-identified cases.

and the litigation between them involving the above-identified patents at issue. IPR2023-01110, Ex. 1021; IPR2023-01112, Ex. 1017; IPR2023-01154, Ex. 1020; IPR2023-01155, Ex. 1017; IPR2023-01248, Ex. 1029.

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.*, IPR2023-01110, Paper 16, 1. 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 IPR2023-01110, IPR2023-01112, IPR2023-01154, IPR2023-01155, and IPR2023-01248 are *terminated* with respect to Petitioner and Patent Owner pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Requests to Treat the Settlement Agreement as Business Confidential Information are *granted*, and the confidential Settlement Agreement (IPR2023-01110, Ex. 1021; IPR2023-01112, Ex. 1017; IPR2023-01154, Ex. 1020; IPR2023-01155, Ex. 1017; IPR2023-01248, Ex. 1029) 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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FOR PETITIONER:

Indranil Mukerji
Rajarshi Chakraborty
WILLKIE FARR & GALLAGHER LLP
imukerji@willkie.com

FOR PATENT OWNER:

FOR PATENT OWNER:
Peter Lambrianakos
Vincent Rubino
Enrique Iturralde
Richard Cowell
Jacob Ostling
FABRICANT LLP
plambrianakos@fabricantllp.com
vrubino@fabricantllp.com
eiturralde@fabricantllp.com
rcowell@fabricantllp.com
jostling@fabricantllp.com