

Paper No. ____

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

SMARTWATCH MOBILE CONCEPTS, LLC,
Patent Owner.

Case No. IPR2024-00852
Patent No. 10,362,480

JOINT MOTION TO TERMINATE PROCEEDING

LISTING OF EXHIBITS

Exhibit	Description
1001	U.S. Patent No. 10,362,480 (“the ’480 patent”)
1002	Prosecution History of U.S. Patent No. 10,362,480
1003	Declaration of David Williams (“Williams”)
1004	CV of David Williams
1005	Plaintiff’s Preliminary Infringement Contentions, <i>SmartWatch Mobileconcepts, LLC v. Google LLC</i> , Ex. 26-1, Case No. 6:23-cv-00398 (W.D. Tex.) (now Case No. 3:24-cv-00937-TSH (N.D. Cal.) due to transfer) (as filed 11/9/2023)
1006	Exhibit to Plaintiff’s Preliminary Infringement Contentions, <i>SmartWatch Mobileconcepts, LLC v. Google LLC</i> , 6:23-cv-00398 (W.D. Tex.) (now Case No. 3:24-cv-00937-RFL (N.D. Cal.) due to transfer) (as filed 11/9/2023)
1007	U.S Patent No. 9,684,778 (“Tharappel”)
1008	U.S. Patent Application Publication No. 2003/0046228 (“Berney”)
1009	U.S. Patent Application Publication No. 2014/0196131 (“Lee”)
1010	U.S. Patent No. 9,836,900 (“Jun”)
1011	U.S. Patent Application Publication No. 2015/0028996 (“Agrafioti”)
1012	U.S. Patent Application Publication No. 2016/0155281 (“O’Toole”)
1013	U.S. Patent No. 8,943,580 (“Fadell”)
1014	U.S. Patent Application Publication No. 2010/0178866 (“Jalkanen”)
1015	Plaintiff’s Response to Defendant’s Motion To Dismiss, <i>Smartwatch Mobileconcepts, LLC v. T-Mobile USA, Inc.</i> , No. 6:23-400, Doc. 16 (W.D. Tex.)
1016	Plaintiff’s Response to Defendant’s Motion To Dismiss, <i>SmartWatch Mobileconcepts, LLC v. Google LLC</i> , No. 6:23-00398, Doc. 21 (W.D. Tex.) (now Case No. 3:24-cv-00937-RFL (N.D. Cal.) due to transfer)
1017	Docket Sheet, No. 3:24-cv-00937-RFL (N.D. Cal.)
1018	U.S. Patent No. 8,208,867
1019	U.S. Patent Application Publication No. 2002/0188210
1020	U.S. Patent No. 8,781,569
1021	U.S. Patent No. 6,178,343
1022	U.S. Patent No. 6,192,253
1023	Defendant Google LLC’s Opening Claim Construction Brief, <i>SmartWatch Mobileconcepts, LLC v. Google LLC</i> , No. 6:23-00398,

Exhibit	Description
	Doc. 34 (W.D. Tex.) (now Case No. 3:24-cv-00937-RFL (N.D. Cal.) due to transfer)
1024	U.S. Patent No. 8,825,011
1025	U.S. Patent No. 8,781,475
1026	U.S. Patent No. 9,743,279
1027	U.S. Patent No. 6,185,157
1028	U.S. Patent No. 7,391,677
1029	U.S. Patent No. 7,889,085
1030	Toshiyo Tamura, et al., “Wearable Photoplethysmographic Sensors—Past and Present,” <i>Electronics</i> , 3:282-302 (2014)
1031	Yuka Maeda, “The Advantages of Wearable Green Reflected Photophethysmography,” <i>J. Medical Sys.</i> 35:829-834 (2010)
1032	U.S. Patent No. 8,851,372
1033	U.S. Patent No. 5,708,422
1034	Lieber, “A Two-Step Plan to Stop Hackers,” <i>The New York Times</i> (2014)
1035	U.S. Patent No. 8,111,589
1036	U.S. Patent No. 8,467,272
1037	U.S. Patent Application Publication No. 2015/0304322
1038	U.S. District Courts—Combined Civil and Criminal Federal Court Management Statistics (December 31, 2023), https://www.uscourts.gov/statistics-reports/analysis-reports/federal-court-management-statistics
1039	Certified Translation of Korean Patent Application 10-2015-0068739 (“Jun-739”)
1040	Redline Comparison of Jun and Jun-739
1041	Merriam-Webster’s Collegiate Dictionary (2006)
1042	“The 25th Edition of the International Symposium on Wearable Computers,” <i>IEEE Pervasive Computing</i> (April-June 2022), available at https://ieeexplore.ieee.org/document/9817040 .
1043	Pascoe, “On the Use of Mobile Tools in Everyday Life,” <i>OZCHI '07: Proceedings of the 19th Australasian conference on Computer-Human Interaction: Entertaining User Interfaces</i> , 39-47 (November 2007).
1044	IT History Society, “Benefon ESC!,” available at https://www.ithistory.org/db/hardware/benefon/benefon-esc
1045	“(Sc)Rolling Down the Highway: Vintage 1927 Analog GPS,” available at https://gajitz.com/scrolling-down-the-highway-vintage-1927-analog-gps/

Exhibit	Description
1046	“Garmin Forerunner,” available at https://trigearlab.com/garmin-forerunner/
1047	“World Geodetic System,” available at https://en.wikipedia.org/wiki/World_Geodetic_System#WGS84
1048	Weiss, “When a Password Is Not a Password,” IEEE Proceedings IEEE International Carnahan Conference on Security Technology, Crime Countermeasures (1990)
1049	Zhang, “Location-based Authentication and Authorization Using Smart Phones,” IEEE Proceedings 11th International Conference on Trust, Security and Privacy in Computing and Communications (2012).
1050	Yuksel, “Biometric Identification Through Hand Vein Patterns,” IEEE Proceedings 2010 International Workshop on Emerging Techniques and Challenges for Hand-Based Biometrics (2010)
1051	Settlement Agreement [CONFIDENTIAL]

Pursuant to 37 C.F.R § 42.74 and the authorization provided by the Board on September 3, 2024, Petitioner Google LLC (“Petitioner”) and Patent Owner SmartWatch Mobileconcepts, LLC (“Patent Owner”) jointly request termination of this proceeding, IPR2024-00852, directed to U.S. Patent No. 10,362,480.

Petitioner and Patent Owner have settled their dispute regarding U.S. Patent No. 10,362,480, including both this proceeding and Patent Owner’s assertion of U.S. Patent No. 10,362,480 in the related district court litigation, *SmartWatch MobileConcepts, LLC v. Google, LLC*, Case No. 3:24-cv-00937 (N.D. Cal.). The parties do not anticipate further litigation between them concerning U.S. Patent No. 10,362,480. There are no related proceedings currently before the Board.

Good cause exists to terminate this proceeding because the parties have settled their dispute regarding the U.S. Patent No. 10,362,480 and the proceeding is still at an early stage. The Petitioner has not yet provided its preliminary response. Terminating the proceeding now would thus serve the interests of judicial economy as well as the mutual interest of the parties.

A true and correct copy of the parties’ settlement agreement will be filed as Exhibit 1051, along with a joint motion to treat the settlement agreement as business confidential information. The parties 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.

Respectfully submitted,

/Jacob Henry/

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September 5, 2024

CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (E)(4)

I certify that on September 5, 2024, I will cause a copy of the foregoing document, including any exhibits filed therewith, to be served via electronic mail, as previously consented to by Patent Owner, upon the following:

Jacob B. Henry
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Date: September 5, 2024

/Dara Del Rosario/
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