

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
SAMSUNG ELECTRONICS AMERICA, INC., AND APPLE INC.,
Petitioners,

v.

JAWBONE INNOVATIONS, LLC,
Patent Owner.

IPR2022-01321
Patent 11,122,357 B2

Before LYNNE E. PETTIGREW, GEORGIANNA W. BRADEN,
and NORMAN H. BEAMER, *Administrative Patent Judges*.

BEAMER, *Administrative Patent Judge*.

TERMINATION
Settlement Prior to Institution of Trial
37 C.F.R. § 42.74

On January 9, 2023, with our authorization, Apple Inc. (“Apple”), Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (“Samsung”), and Jawbone Innovations, LLC (“Jawbone”) (collectively, “the Parties”) filed a Joint Motion to Terminate the Proceeding. Paper 15 (“Mot.”). In the Motion, the Parties represent that they have settled all disputes relating to U.S. Patent 11,122,357 B2, and they jointly request termination of this proceeding. *Id.* at 2. The Parties specifically state that Samsung and Jawbone reached agreement to resolve their disputes (*see* Ex. 1031) and that Apple and Jawbone reached agreement to resolve their disputes (*see* Ex. 1032; Ex. 1033). Mot. 1. The Parties represent that, pursuant to 37 C.F.R. § 42.74(b), these agreements are in writing and that true and correct copies are filed as Exhibits 1031, 1032, and 1033 (“the Agreements”). Mot. 1; *see id.* at 2–3.

This proceeding is in a preliminary stage, and we have not yet issued a decision on institution. In view of the Parties’ settlements and representations, we determine that good cause exists to terminate the proceeding. Accordingly, we grant the Motion.

In addition, the Parties filed joint requests to treat the Agreements as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 16 (“Apple-Jawbone Req.”); Paper 17 (“Samsung-Jawbone Req.”). We have reviewed the Agreements, which contain confidential business information regarding the settlement terms, and we determine that good cause exists to treat the Agreements as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Accordingly, we grant this aspect of the parties’ joint requests.

The parties also “request that they be notified if and when the Board receives and/or considers a request for access to the Agreements, and be offered an opportunity to respond to any such request.” Apple-Jawbone Req. 2; Samsung-Jawbone Req. 2. However, neither the statute nor the regulation provides for any such notification or opportunity to respond, and the parties have not provided any reason or special circumstance that would justify issuing an order that purports to impose additional requirements. Accordingly, we deny that portion of the parties’ joint requests.

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

It is:

ORDERED that the Joint Motion to Terminate (Paper 15) is granted;

FURTHER ORDERED that the Joint Requests (Papers 16 and 17) are granted-in-part, and the Agreements (Exhibits 1031, 1032, and 1033) shall be treated as business confidential information, kept separate from the file of U.S. Patent 11,122,357 B2, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause on written request, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that this proceeding is terminated.

IPR2022-01321
Patent 11,122,357 B2

For PETITIONER:

Ali R. Sharifahmadian
Jin-Suk Park
J. Christopher Moulder
ARNOLD & PORTER KAYE SCHOLER LLP
ali.sharifahmadian@arnoldporter.com
jin.park@arnoldporter.com
chris.moulder@arnoldporter.com

W. Karl Renner
David Holt
Parvin Ghane
FISH & RICHARDSON
axf-ptab@fr.com
holt2@fr.com
ghane@fr.com

For PATENT OWNER:

Peter Lambrianakos
Vincent J. Rubino, III
Alfred R. Fabricant
FABRICANT LLP
plambrianakos@fabricantllp.com
vrubino@fabricantllp.com
ffabricant@fabricantllp.com
Enrique W. Iturralde
eiturralde@fabricantllp.com