

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC.,

Petitioner,

v.

JAWBONE INNOVATIONS LLC,

Patent Owner.

Case IPR2023-00251

U.S. Patent No. 11,122,357

JOINT MOTION TO TERMINATE PROCEEDINGS

LIST OF EXHIBITS

Exhibit No.	Description of Document
2001	Confidential Settlement Agreement
2002	Confidential Release

I. PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a), Petitioner Amazon.com, Inc. (“Petitioner”) and Patent Owner Jawbone Innovations, LLC (“Patent Owner”) jointly request that this *inter partes* review proceeding involving U.S. Patent No. 11,122,357 (“the ’357 patent”) be terminated based on an agreement between Petitioner and Patent Owner (“the Parties”).

Patent Owner and Petitioner are parties to an agreement that resolves the disputes in the above-captioned *inter partes* review relating to the ’357 patent. Petitioner and Patent Owner have thus settled their dispute regarding the ’357 patent, including both this proceeding and Patent Owner’s assertion of the ’357 patent in the related district court litigation, *Jawbone Innovations, LLC v. Amazon.com, Inc.*, Case No. 3:22-cv-06727-TLT (N.D. Cal.). The Parties filed a joint motion to dismiss with prejudice the related district court action on July 24, 2023, and the district court entered an order dismissing the case on July 26, 2023.

The agreements resolving the Parties’ dispute include a confidential settlement agreement between Patent Owner and a third party, as well as a confidential release agreement between the Parties. Patent Owner submits a true copy of the confidential agreements in their entirety, filed herewith as Exhibits 2001 and 2002, respectively. The Parties do not anticipate any further litigation between them concerning the ’357 patent. There are no other agreements, oral or written,

between the Parties made in connection with, or in contemplation of, the termination of this proceeding.

II. REASONS FOR GRANTING THE MOTION

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding. *See, e.g.*, Consolidated Trial Practice Guide, 86 (Nov. 2019). The Board's policy is in accord with the governing statute, which states that "An inter partes review instituted under this chapter *shall be terminated* with respect to any petitioner 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." 35 U.S.C. § 317(a). The Board has not decided the merits of this proceeding.

The Board authorized filing of the instant motion on July 26, 2023. Guidance as to the content of a motion to terminate is provided in *Apotex Cop. v. Alcon Research, Ltd.*, IPR2013-00428, Paper No. 56. There, the Board indicated that a joint motion, such as this one, should (a) include a brief explanation as to why termination is appropriate; (b) identify all parties in any related litigation involving the patent at issue; (c) identify any related proceedings currently before the Office; and (d) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding. *Id.* at 2. This motion satisfies each of the above requirements.

A. Brief Explanation of Why Termination is Appropriate

Good cause exists to terminate this proceeding because the Parties have settled their dispute regarding the '357 patent and the Board has not determined the merits of the proceeding. Terminating this proceeding thus serves the interests of judicial economy as well as the mutual interests of the Parties.

Termination is appropriate because no post-institution briefs have been filed, oral argument has not been held, and the Board has not decided the merits of the proceeding, i.e., a final written decision has not been issued. Under 35 U.S.C. § 317(a), this proceeding “shall be terminated” because the Parties are jointly requesting termination and the Office has not yet “decided the merits of the proceeding before the request for termination is filed.” The Parties have resolved their disputes and executed an agreement which contemplates requesting termination of this proceeding and dismissing the Parties’ related proceeding regarding the '357 patent in *Jawbone Innovations, LLC v. Amazon.com, Inc.*, Case No. 3:22-cv-06727-TLT (N.D. Cal.).

B. All Parties in Any Pending Related Litigation Involving the Patent at Issue

The following litigation is related to the '357 patent and the Parties:

- *Jawbone Innovations, LLC v. Amazon.com, Inc.*, Case No. 3:22-cv-06727-TLT (N.D. Cal.)

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