

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC.,
Petitioner,

v.

JAWBONE INNOVATIONS, LLC,
Patent Owner.

IPR2023-00251 (Patent 11,122,357 B2)
IPR2023-00275 (Patent 8,467,543 B2)

Before GEORGIANNA W. BRADEN, NORMAN H. BEAMER,
and JASON M. REPKO, *Administrative Patent Judges*.

BEAMER, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

IPR2023-00251 (Patent 11,122,357 B2)
IPR2023-00275 (Patent 8,467,543 B2)

With the Board's authorization, Petitioner and Patent Owner filed, in each of the captioned proceedings, a Joint Motion to Terminate. Paper 14.¹ The parties also filed their confidential agreements (IPR2023-00251, Exs. 2001, 2002; IPR2023-00275, Exs. 2001, 2002) and a Joint Motion to File the Agreement as Business Confidential Information (Paper 13).

The parties represent that they have settled their dispute in these proceedings and in the related district-court litigation and they filed true copies of their agreement in its entirety. Paper 14, 1. The parties also represent that there are no other agreements between them made in connection with or in contemplation of the termination of these proceedings. *Id.* at 6. According to the parties, the agreements that they filed contain confidential information under the Board's rules. Paper 13, 1 (citing 37 C.F.R. § 42.54).

The parties assert that these proceedings should be terminated because (1) the Board has not decided the merits, (2) the parties have settled their dispute, and (3) the parties jointly request termination. Paper 14, 3. We agree that termination is appropriate for all those reasons. *See Consolidated Trial Practice Guide*, 86 (Nov. 2019) ("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.")²

¹ Similar motions were filed in both proceedings. *See* IPR2023-00251 Paper 13 (Joint Motion to File Agreement as Business Confidential), Paper 14 (Joint Motion to Terminate); IPR2023-00275, Paper 13 (Joint Motion to File Agreement as Business Confidential Information), Paper 14 (Joint Motion to Terminate). For brevity, citations in this order are to the papers in IPR2023-00251.

² Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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Although there are multiple pending motions to join this proceeding, we see no reason here to postpone ruling on the Joint Motion to Terminate until ruling on the joinder motions. “[F]iling a petition accompanied by a request for joinder does not guarantee that the petition will be instituted, or that joinder will be granted,” and “there is no guarantee that such filings will be considered prior to a termination of the proceeding sought to be joined.” *Mylan Techs., Inc. v. MonoSol Rx, LLC*, IPR2017-00200, Paper 22 at 2–3 (PTAB Oct. 5, 2017).

We also agree that the agreements filed in each proceeding contain confidential information under the Board’s rules. *See* IPR2023-00251, Exs. 2001, 2002; IPR2023-00275, Exs. 2001, 2002. So they should be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

This Order does not constitute a final written decision under 35 U.S.C. § 318(a).

IPR2023-00251 (Patent 11,122,357 B2)

IPR2023-00275 (Patent 8,467,543 B2)

ORDER

It is

ORDERED that the parties' Joint Motions to Terminate the Proceedings (IPR2023-00251, Paper 14; IPR2023-00275, Paper 14) are *granted*;

FURTHER ORDERED that the parties' Joint Motions to File the Agreement as Business Confidential Information (IPR2023-00251, Paper 13; IPR2023-00275, Paper 13) are *granted* and the parties' confidential agreements (IPR2023-00251, Exs. 2001, 2002; IPR2023-00275, Exs. 2001, 2002) shall be treated as business confidential information and be kept separate from the files of the respective challenged patents, U.S. Patent No. 11,122,357 B2 and U.S. Patent No. 8,467,543 B2, and made available only under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that these proceedings are terminated.

IPR2023-00251 (Patent 11,122,357 B2)

IPR2023-00275 (Patent 8,467,543 B2)

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