

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

JAWBONE INNOVATIONS, LLC,

Plaintiff,

v.

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

Defendants.

CASE NO. 2:21-cv-00186-JRG

JURY TRIAL DEMANDED

**DEFENDANTS SAMSUNG ELECTRONICS CO., LTD.'S
AND SAMSUNG ELECTRONICS AMERICA, INC.'S
MOTION TO STAY PROCEEDINGS PENDING *INTER PARTES* REVIEW**

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I. INTRODUCTION

Defendants Samsung Electronics Co., Ltd. (“SEC”) and Samsung Electronics America, Inc. (“SEA”) (together, “Samsung” or “Defendants”), filed petitions for IPR challenging all the asserted claims of all the Asserted Patents and respectfully move to stay the above-captioned litigation until the Patent Trial and Appeal Board (“PTAB”) has concluded *inter partes* review (“IPR”) of U.S. Patent Nos. 7,246,058 (“the ’058 patent”), 8,019,091 (“the ’091 patent”), 8,467,543 (“the ’543 patent”), 8,503,691 (“the ’691 patent”), 10,779,080 (“the ’080 patent”), and 11,122,357 (“the ’357 patent”) (together, “the Asserted Patents”)¹.

Plaintiff Jawbone Innovations, LLC (“Jawbone” or “Plaintiff”) filed a Complaint against Samsung on May 27, 2021, asserting only the ’091 patent and ’072 patent. ECF No. 1. Five months later, on October 26, 2021, Jawbone filed a First Amended Complaint asserting five additional patents (the ’058, ’543, ’691, ’080, and ’357 patents). ECF No. 21. Between November 19, 2021 and July 27, 2022, Defendants filed eight IPR petitions challenging all seven of the originally asserted patents, including every claim currently asserted among the six remaining patents. *See* Exs. 3, 5, 7, 9, and 11-14.

All of the factors considered by this Court favor a stay. First, a stay will not unduly prejudice Plaintiff, because Plaintiff, a non-practicing entity, does not compete with Defendants and can be adequately compensated through monetary damages. *See, VirtualAgility Inc. v. Salesforce.com*, 759 F.3d 1307, 1318 (Fed. Cir. 2014). Second, the case is in its early stages, and staying the case now would conserve the Court’s and the parties’ resources. Finally, the IPRs are

¹The PTAB also instituted trial on Samsung’s IPR challenging U.S. Patent No. 8,280,072 (“the ’072 patent”), which Jawbone dropped from this litigation the day before IPR was instituted.

likely to simplify the issues in this matter. The IPR petitions cover all of the asserted claims of the Asserted Patents and rely on primary prior art references and prior art combinations that were not considered by the patent examiners. Moreover, Plaintiff's statements in IPR proceedings will be relevant to the issues in this case, including claim construction.

Given the substantive effect the IPR petitions will have on the Asserted Patents, the interests of efficiency favor staying this case now. Defendants respectfully request that the Court stay this matter pending final resolution of the IPRs.

On August 4, 2022, the parties discussed the relief sought by this motion. Counsel for Plaintiff indicated that Plaintiff opposes a stay and would oppose this motion.

II. BACKGROUND

This case is still in its early stages. A claim construction order has not been issued and burden expert reports will not be served until September 12, 2022. ECF No. 58 at 3. On November 19, 2021, Samsung filed IPR2022-00213 ("the '072 IPR") challenging all claims of the '072 patent. Ex. 3. The PTAB instituted trial on the '072 IPR on June 8, 2022. Ex. 4. On April 26, 2022, Samsung filed IPR2022-00865 ("the '543 IPR") challenging all claims of the '543 patent. Ex. 5. The PTAB's institution decision for the '543 IPR is due by December 8, 2022. *See* Ex. 6. On May 16, 2022, Samsung filed IPR2022-01021 ("the '058 IPR") challenging all claims of the '058 patent. Ex. 7. The PTAB's institution decision on the '058 IPR is due by January 9, 2023. *See* Ex. 8. On June 16, 2022, Samsung filed IPR2022-01147 ("the '091 IPR") challenging all claims of the '091 patent. Ex. 9. The PTAB's institution decision on the '091 IPR is due by January 9, 2023. *See* Ex. 10. On July 27, 2022, Samsung filed IPR2022-01320 ("the '080 IPR") challenging all claims of the '080 patent, IPR2022-01321 ("the '357 IPR") challenging all claims of the '357 patent, and IPR2022-01322 and IPR2022-01323 (together, "the '691 IPRs") challenging all claims of the '691 patent between the two petitions (all four IPRs together "the Copycat IPRs"). Exs. 11-

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