

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY ELECTRONICS INC.,
Petitioner,

v.

JAWBONE INNOVATIONS, LLC,
Patent Owner.

IPR2023-01119 (U.S. Patent No. 7,246,058)

IPR2023-01222 (U.S. Patent No. 8,467,543)

IPR2023-01065 (U.S. Patent No. 10,779,080)

IPR2023-01228 (U.S. Patent No. 8,503,691; cls.1-22, 29-40)

IPR2023-01229 (U.S. Patent No. 8,503,691; cls.23-28, 41-46)

JOINT MOTION TO TERMINATE

Pursuant to 35 U.S.C. § 317(a), Petitioner Sony Electronics Inc. (“Sony”) and Patent Owner Jawbone Innovations, LLC (“Jawbone”) (collectively “the Parties”) jointly request termination of *Inter Partes* Review Nos. IPR2023-01119 (U.S. Patent No. 7,246,058); IPR2023-01222 (U.S. Patent No. 8,467,543); IPR2023-01065 (U.S. Patent No. 10,779,080); IPR2023-01228 (U.S. Patent No. 8,503,691 cls.1-22, 29-40); and IPR2023-01229 (U.S. Patent No. 8,503,691 cls.23-28, 41-46) (collectively “the IPRs” for the “challenged patents”).

The present Joint Motion To Terminate has been filed because Parties have now settled their dispute involving the challenged patents.

Jawbone filed a patent infringement lawsuit on February 28, 2023, against Sony in the United States District Court for the District of New Jersey alleging infringement of the challenged patents and other patents. That lawsuit is still pending as *Jawbone Innovations, LLC v. Sony Electronics Inc.*, 2:23-cv-01161-MEF-LDW. On April 15, 2024, the Parties filed a Joint Stipulation of Partial Dismissal to dismiss with prejudice all claims and counterclaims of the challenged patents and certain other patents. On April 16, 2024, the Court entered an Order of Partial Dismissal dismissing with prejudice all claims and counterclaims of the challenged patents and other patents, and a true and correct copy of such document is being filed herewith as follows:

IPR No.	Exhibit No.
IPR2023-01119	1022
IPR2023-01222	1029
IPR2023-01065	1034
IPR2023-01228	1020
IPR2023-01229	1020

The Board issued decisions instituting the present IPR proceedings on the following dates:

January 10, 2024 – IPR2023-01119 ('058 Patent)

January 19, 2024 – IPR2023-01222 ('543 Patent)

December 12, 2023 – IPR2023-01065 ('080 Patent)

January 19, 2024 – IPR2023-01228 ('691 Patent cls.1-22, 29-40)

January 19, 2024 – IPR2023-01229 ('691 Patent cls.23-28, 41-46).

Pursuant to 35 U.S.C. § 317(b), the Parties entered an Agreement that resolves all disputes between the Parties relating to the challenged patents. That agreement was made in contemplation of termination of these proceedings. Such Agreement is in writing, and a true and correct copy of such document is being filed herewith as follows:

IPR No.	Exhibit No.
IPR2023-01119	1023
IPR2023-01222	1030
IPR2023-01065	1035
IPR2023-01228	1021
IPR2023-01229	1021

The Parties request that the Agreement be maintained as business confidential under 37 C.F.R. § 42.74(c), and a separate joint request to that effect is being filed concurrently herewith. No other such agreements, written or oral, exist between or among the Parties in connection with or in contemplation of the dismissal of these proceedings.

On April 15, 2024, the Board sent an email authorizing the Parties to file the present Joint Motion to Terminate, and a true and correct copy of such document is being filed herewith as follows:

IPR No.	Exhibit No.
IPR2023-01119	1024
IPR2023-01222	1031
IPR2023-01065	1036
IPR2023-01228	1022
IPR2023-01229	1022

Under 35 U.S.C. § 317(a), “[a]n *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.” The Parties have settled their dispute and do not anticipate any further litigations concerning the challenged patents. Moreover, the Board has not decided the merits of the proceedings. As such, granting the Parties’ Joint Motion To Terminate the IPRs at this juncture would serve

to preserve the Board's and Parties' resources and promote a speedy and inexpensive resolution. 37 C.F.R. § 42.1(b)

In view of the above, the Parties request that the subject IPRs be terminated.

Respectfully submitted,

LERNER DAVID LLP

Dated: April 26, 2024

/Gregory S. Gewirtz/
Gregory S. Gewirtz
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Sony Electronics Inc.

FABRICANT LLP

Dated: April 26, 2024

/Peter Lambrianakos/
Peter Lambrianakos
(Reg. No. 58,279)
Counsel for Patent Owner
Jawbone Innovations, LLC

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **JOINT MOTION TO TERMINATE** is being served by filing this document and by email this 26th day of April, 2024, on the following counsel of record:

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Vincent J Rubino. III
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Dated: April 26, 2024

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