

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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Fitbit, Inc.,  
Petitioner

v.

Immersion Corporation,  
Patent Owner

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Case: IPR2018-00592  
U.S. Patent No. 8,638,301

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**JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317(a)**

***Mail Stop “PATENT BOARD”***  
Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Pursuant to 35 U.S.C. § 317(a), Petitioner Fitbit Inc. and Patent Owners Immersion Corp. jointly request termination of this proceeding, IPR2018-00592, which is directed to U.S. Patent No. 8,638,301.

## **I. STATEMENT OF PRECISE RELIEF REQUESTED**

Petitioner and Patent Owners jointly request termination of this proceeding pursuant to a settlement between the parties.

## **II. STATEMENT OF FACTS**

Petitioner and Patent Owner have reached a settlement that resolves the dispute between Petitioner and Patent Owners with respect to this proceeding. A “Joint Request That Settlement Agreement Be Treated as Business Confidential Information and Kept Separate Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74” is being filed concurrently with this Joint Motion to Terminate in reference to sealing of the settlement agreement. *See* 35 U.S.C. § 317(b) (requiring parties to file agreements in writing with the Office).

A joint motion to terminate generally must “(1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office, and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.”

*Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26 at 2 (PTAB Jul. 28, 2014).

**(1) Brief Explanation.** Termination of this proceeding is appropriate because Petitioner and Patent Owner have reached a settlement that resolves all disputes between Petitioner and Patent Owner.

**(2) Related Litigation.** Patent Owner has asserted the '301 Patent against Petitioner in a lawsuit styled *Immersion Corp. v. Fitbit, Inc.*, No. 5:17-cv-03886-LHK, pending in the United States District Court for the Northern District of California. The settlement between Petitioner and Patent Owner encompasses this related litigation.

**(3) and (4) Related Proceedings before the Patent Office and Their Statuses.** Petitioner filed two Requests for *Inter Partes* Review of the U.S. Patent No. 8,059,105 (other related litigation patent-in-suit) on February 7, 2018 and is currently pending before the Board as IPR2018-00588 and IPR2018-00590, *Fitbit, Inc. v. Immersion Corp.* In addition, Petitioner also filed a Request for *Inter Partes* Review of U.S. Patent No. 8,351,299 (other related litigation patent-in-suit) on February 7, 2018 and is currently pending before the Board as IPR2018-00591, *Fitbit, Inc. v. Immersion Corp.* Further, Petitioner filed an additional Request for *Inter Partes* Review of the '301 Patent on February 7, 2018 and is currently pending before the Board as IPR2018-00593, *Fitbit, Inc. v. Immersion Corp.*

The settlement between Petitioner and Patent Owner encompasses these related proceedings.

### **III. ARGUMENT**

The Board should terminate this *inter partes* review with respect to Petitioner and Patent Owner jointly request, for the following reasons.

First, this case is in its preliminary stage; an institution decision has not yet issued.

Second, Petitioner and Patent Owner have met the statutory requirement that they file a “joint request” to terminate before the Office “has decided the merits of the proceeding.” 35 U.S.C. § 317(a). Under section 317(a), an *inter partes* review shall be terminated with respect to a party upon such joint request “unless the Office has decided the merits of the proceeding before the request for termination is filed.” There are no other preconditions of 35 U.S.C. § 317(a).

Third, Petitioner and Patent Owner have reached a settlement that resolves all disputes between Petitioner and Patent Owner in this proceeding and as to the ’301 Patent. Patent Owner does not contemplate any litigation or proceeding involving the subject patent in the foreseeable future. A true copy of the settlement agreement is filed concurrently herewith. Petitioner and Patent Owner request that the settlement agreement be treated as business confidential information, and be

kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c).

The parties in the present proceeding jointly certify that there are no other written or oral agreements or understandings, including any collateral agreements, between them, including but not limited to licenses, covenants not to sue, confidentiality agreements, payment agreements, or other agreements of any kind, that are made in connection with or in contemplation of, the termination of the instant proceeding.

#### **IV. CONCLUSION**

For the foregoing reasons, Petitioner and Patent Owners respectfully request termination of this proceeding related to the '301 Patent.

Dated: July 26, 2018

By: /s/ Scott W. Hejny  
Scott W. Hejny, Reg. No. 45,882  
shejny@mckoolsmith.com  
McKOOL SMITH, P.C.  
300 Crescent Court, Suite 1500  
Dallas, TX 75201  
Tel.: 214.978.4241  
Fax: 214.978.4044

Respectfully submitted,

By: /s/ Eugene Goryunov  
Eugene Goryunov (Reg. No. 61,579)  
eugene.goryunov@kirkland.com  
KIRKLAND & ELLIS LLP  
300 North LaSalle  
Chicago, IL 60654  
Telephone: (312) 862-2000  
Fax: (312) 862-2200

**CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))**

The undersigned hereby certifies that the foregoing **JOINT MOTION TO TERMINATE** was served electronically via e-mail on July 26, 2018, on the following counsel of record for Petitioners:

Eugene Goryunov  
KIRKLAND & ELLIS LLP  
300 North LaSalle  
Chicago, IL 60654  
Telephone: (312) 862-2000  
Fax: (312) 862-2200  
eugene.goryunov@kirkland.com

Michael Reza Dokhanchy  
KIRKLAND & ELLIS LLP  
555 California Street  
San Francisco, CA 94104  
Telephone: (415) 439-1400  
Fax: (415) 439-1500  
reza.dokhanchy@kirkland.com

Fitbit-IPR@kirkland.com

By: /s/ Scott W. Hejny  
Scott W. Hejny, Reg. No. 45,882  
shejny@mckoolsmith.com  
McKOOL SMITH, P.C.  
300 Crescent Court, Suite 1500  
Dallas, TX 75201  
Tel.: 214.978.4241  
Fax: 214.978.4044