

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHARKNINJA, INC., SHARKNINJA OPERATING LLC,
SHARKNINJA MANAGEMENT LLC, AND
SHARKNINJA SALES COMPANY,
Petitioner,

v.

DYSON TECHNOLOGY LIMITED,
Patent Owner.

IPR2023-01322
Patent 10,433,687 B2

Before JAMES A. TARTAL, FRANCES L. IPPOLITO, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

TARTAL, *Administrative Patent Judge*.

ORDER

Denying Joint Motion to Terminate
Due to Settlement After Institution of Trial and
Granting Request to Treat Settlement Agreement as
Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. § 42.74

I. INTRODUCTION

SharkNinja, Inc., SharkNinja Operating LLC, SharkNinja Management LLC, and SharkNinja Sales Company (“Petitioner”) and Dyson Technology Limited (“Patent Owner”)(collectively “the Parties”) filed a Joint Motion to Terminate Proceeding seeking to terminate this case based on an agreement the Parties reached concerning settlement. Paper 47 (“Mot.” or “Motion”). The Motion was filed with our prior authorization, provided to the Parties in an email communication from the Board. *See* Ex. 3001, 1 (email correspondence between the Parties and the Board on various dates). Along with the Motion, the Parties also filed a copy of an agreement (Ex. 2029, “Settlement Agreement”) and a Joint Request to File Settlement Agreement as Business Confidential Information (Paper 48, “Request”). As further explained below, because the Settlement Agreement filed by the Parties may not be the entire agreement between the Parties, the Motion is denied. Additionally, the Request is granted because the Parties show sufficiently that the Settlement Agreement is business confidential information.

II. DISCUSSION

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.”

Further, 35 U.S.C. § 317(b) states as follows:

Any agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of an inter partes review

under this section *shall be in writing and a true copy of such agreement or understanding shall be filed in the Office before the termination of the inter partes review as between the parties.*

35 U.S.C. § 317(b) (emphases added); *see also* 37 C.F.R. § 42.74(b) (similar). Similarly, in our authorization email, we stated that “[t]he motion to terminate should include a statement that there are no other agreements, oral or written, between the Parties made in connection with, or in contemplation of, the termination of the proceeding other than the agreement(s) filed with the motion to terminate.” Ex. 3001.

Rather than comply with the requirements of 35 U.S.C. § 317(b) or 37 C.F.R. § 42.74(b), and in apparent disregard of our express instructions in our authorization, the Parties instead state in their Motion that “[t]here are *currently* no other agreements, written or oral, between or among the parties made in connection with, or in contemplation of, the dismissal of the proceeding.” Motion 2 (emphasis added). The statute does not permit the Parties to circumvent filing copies of any “agreement or understanding . . . made in connection with, or in contemplation of, the termination of an inter partes review” by merely asserting in their Motion that any such additional agreement does not “currently” exist. More remarkable, although the Settlement Agreement, itself, reflects that the Parties’ statement that “there are currently no other agreements” may be factually accurate as of the date it was made, it nonetheless suggests that additional agreements are under contemplation between the Parties. Settlement Agreement 1. The Parties, however, fail to address either this provision or the actual status of the settlement reflected in the Settlement Agreement in their Motion.

Accordingly, we deny the Motion to Terminate without prejudice, with leave to file another joint motion to terminate at such time as the Parties

are in a position to comply with 35 U.S.C. § 317(b) or 37 C.F.R. § 42.74(b). Any renewed motion to terminate must include a representation by the Parties, without modification, as follows:

The Parties represent that any agreement or understanding between them, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of this inter partes review proceeding are in writing and a true copy of every such agreement or understanding has been filed as an exhibit in this proceeding.

See 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). We note that a renewed motion to terminate does not appear to be warranted until the expiration of any period of time during which the Parties may contemplate additional agreements.

Additionally, after reviewing the Settlement Agreement between the Parties, we find that the Parties have sufficiently shown that it contains confidential business information regarding the terms of settlement. We, therefore, determine that it is appropriate to treat the Agreement as business confidential information and keep it separate from the file of U.S. Patent No. 10,433,687 B2. *See* 37 C.F.R. § 42.74(c). Accordingly, we grant the Joint Motion to Keep Confidential and Separate.

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Motion is *denied without prejudice*, with leave to refile; and

FURTHER ORDERED that the Request is *granted*, and the Settlement Agreement (Exhibit 2029) shall be kept separate from the file of U.S. Patent No. 10,433,687 B2 and made available only to Federal

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Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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