UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DYSON TECHNOLOGY LIMITED AND DYSON, INC.,
Petitioners,

v.

OMACHRON INTELLECTUAL PROPERTY INC.,
Patent Owner.

Case No. IPR2024-00670

U.S. PATENT NO. 8,607,407

JOINT MOTION TO TERMINATE PROCEEDING

PETITIONER'S UPDATED EXHIBIT LIST

Exhibit No.	Description
Ex1001	U.S. Patent No. 8,607,407 ("'407 Patent")
Ex1002	Declaration of Robert Giachetti
Ex1003	*Curriculum Vitae* of Robert Giachetti
Ex1004	File History of U.S. 8,607,407 (App. No. 12/720,484)
Ex1005	U.S. Patent Publication No. 2007/0209335 to Conrad ("Conrad335")
Ex1006	U.K. Patent Publication No. GB283,179 to Inventia Patent-Verwertungs-Gesellschaft ("IPVG")
Ex1007	French Patent No. 497,856 to Aktiebolaget Lux ("Lux")
Ex1008	U.S. Patent No. 2,149,135 to Eriksson-Jons ("Eriksson-Jons")
Ex1009	French Patent No. 1,094,603 to Martelliere ("Martelliere")
Ex1010	Certified English translation of French Patent No. 1,094,603 to Martelliere ("Martelliere")
Ex1011	Canadian Patent No. 161,428 to Robinson ("Robinson")
Ex1012	Chinese Patent Publication No. 101,061,932 to Jianan ("Jianan")
Ex1013	Certified English translation of Chinese Patent Publication No. 101,061,932 to Jianan ("Jianan")
Ex1014	U.S. Patent Publication No. 2006/0156508 to Khalil ("Khalil")
Ex1015	U.S. Publication No. 2008/0040883 ("Beskow")
Ex1016	International Publication No. WO 02/067753 to Vuijk ("Vuijk")
Ex1017	Ex. C-1 to Plaintiffs' Infringement Contentions in *SharkNinja Operating LLC v. Dyson, Inc.*, No. 1:23-cv-12372 (D. Mass.)
Ex1018	Swiss Patent No. CH203,675 to Peter ("Peter")

Ex1019	Certified English translation of Swiss Patent No. CH203,675 to Peter ("Peter")
Ex1020	PCT Publication No. 2007/084543 to Butler et al. ("Butler")
Ex1021	Plaintiffs' Infringement Contentions in *SharkNinja Operating LLC v. Dyson, Inc.*, No. 1:23-cv-12372 (D. Mass.)
Ex1022	The Parties' Revised Proposed Schedule in *SharkNinja Operating LLC v. Dyson, Inc.*, No. 1:23-cv-12372 (D. Mass.)
Ex1023	https://www.uscourts.gov/sites/default/files/data_tables/fcms_na_distprofile1231.2023.pdf
Ex1024	Petitioners' Stipulation
Ex1025	U.S. Patent No. 11,529,034 to Conrad ("'034 Patent")
Ex1026	U.S. Patent No. 11,992,849 to Conrad ("'849 Patent")
Ex1027	U.S. Patent No. 10,159,391 to Brown et al. ("'391 Patent")
Ex1028	Transcript of Deposition of Dr. Glenn Akhavein (June 12, 2024)
Ex1029	Screw Threads (https://www.aliexpress.com/i/3256805159501218.html?gatewayAdapt=4itemAdapt)
Ex1030	Bayonet Mount (https://en.wikipedia.org/wiki/Bayonet_mount)
Ex1031	Crawlspace Door (https://cathmer.com/products/cathmer-crawlspace-door-overlay-install-16x33)
Ex1032	Settlement Agreement (CONFIDENTIAL)

Petitioners Dyson Technology Limited and Dyson, Inc. ("Petitioners"), and Patent Owner Omachron Intellectual Property Inc. ("Patent Owner") have reached a settlement. Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Petitioners and Patent Owner move to terminate the present *inter partes* review proceeding.

I. STATEMENT OF FACTS

Petitioners and Patent Owner have reached agreement (the "Settlement Agreement") to resolve their disputes.

Pursuant to 37 C.F.R. § 42.74(b), the Settlement Agreement is in writing, and a true and correct copy is being filed as Confidential Exhibit 1032. The Settlement Agreement is being filed electronically with access to "Board Only." A "Joint Request to Treat Settlement Agreement as Business Confidential Information" is being filed concurrently with this Joint Motion to Terminate Proceeding, to treat the Settlement Agreement as business confidential information and to keep it separate from the files of the involved patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

II. RELIEF REQUESTED

Termination of this *inter partes* review is requested, and all the parties respectfully submit that such termination is justified. "There are strong public policy reasons to favor settlement between the parties to a proceeding." 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." *Id*. (citing 35 U.S.C. §§ 317(a)).

The Board should terminate this proceeding as the Settling Parties jointly request, for the following reasons.

First, the parties 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 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 recited in 35 U.S.C. § 317(a).

Second, the parties have reached a settlement as to all the disputes in this proceeding and as to the '407 patent. A true copy of the Settlement Agreement is filed concurrently herewith. *See* Confidential Ex1032. The parties 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).

In IPR2023-01322, the parties filed a Joint Motion to Terminate based on the same Settlement Agreement submitted here, which the Board denied without prejudice, stating that "because the Settlement Agreement filed by the Parties may not be the entire agreement between the Parties, the Motion is denied" and 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." IPR2023-01322, Paper 47, Paper 50 at 2, 4. That time period has since expired, and the parties have not entered into any other agreements. The Settlement Agreement is the only agreement, and there are no other agreements, written or oral, between or among the parties made in connection with, or in contemplation of, the dismissal of the proceeding. **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.**

Third, termination would save significant further expenditure of resources by the parties. Termination upon settlement, as requested, would also further the purpose of *inter partes* review proceedings, which seek to provide an efficient and less costly alternative forum for patent disputes. Further, maintaining the proceeding would discourage further settlements, as patent owners in similar situations would have a strong disincentive to settle if they perceived that an *inter partes* review would continue regardless of a settlement.

III. CONCLUSION

For the foregoing reasons, Petitioners and Patent Owner respectfully request termination of this *inter partes* review.

Date: February 3, 2025

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a complete copy of the foregoing document was served on February 3, 2025 on counsel of record via email to the following addresses:

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