

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DYSON TECHNOLOGY LIMITED and DYSON, INC.,
Petitioner,

v.

OMACHRON INTELLECTUAL PROPERTY INC.,
Patent Owner.

IPR2024-00938 (Patent 11,389,038 B2)
IPR2024-00950 (Patent 10,080,472 B2)
IPR2024-01151 (Patent 11,910,984 B2)
IPR2024-01162 (Patent 11,903,546 B2)¹

Before ERIC C. JESCHKE, MATTHEW S. MEYERS, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

JESCHKE, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

¹ Because this Order addresses issues common to all four proceedings, we issue one Order to be entered in each proceeding. The parties are not authorized to use this caption.

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BACKGROUND

The Board granted institution in each of these proceedings. With the Board’s prior authorization (IPR2024-00938, Ex. 3001; IPR2024-00950, Ex. 3001, IPR2024-01151, Ex. 3001; IPR2024-01162, Ex. 3001), the parties filed three documents in each proceeding: (1) a joint motion to terminate proceeding (IPR2024-00938, Paper 12; IPR2024-00950, Paper 12; IPR2024-01151, Paper 10; IPR2024-01162, Paper 11 (collectively, the “motions” or “Mot.”)); (2) a joint request to treat settlement agreement as business confidential information (IPR2024-00938, Paper 13; IPR2024-00950, Paper 13; IPR2024-01151, Paper 11; IPR2024-01162, Paper 12 (“the requests” or “Req.”))²; and (3) a true copy of a settlement agreement made in connection with the termination of these proceedings (IPR2024-00938, Ex. 1031; IPR2024-00950, Ex. 1021; IPR2024-01151, Ex. 1034; IPR2024-01162, Ex. 1029 (the “Agreement”)). Upon consideration of the arguments presented and for the reasons below, we *grant* the motions, *grant in part* the requests, and *terminate* these four proceedings.

DISCUSSION

A. Joint Motions to Terminate

Under 35 U.S.C. § 317(a), an instituted *inter partes* review “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.” We have

² Because each of the motions and requests in these proceedings are substantively the same, we cite to them collectively, as “Mot.” and “Req.”

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instituted *inter partes* review in these proceedings, but the final written decisions are not due for several months. Thus, we must terminate with respect to both Dyson Technology Limited and Dyson, Inc. (collectively, “Petitioner”). *See* 35 U.S.C. § 317(a). No other petitioners remain.

Section 317(a) also provides, “[i]f no petitioner remains in the *inter partes* review, the Office may terminate the review or proceed to a final written decision under section 318(a).” The Board, therefore, has discretion to terminate this proceeding with respect to Patent Owner, Omachron Intellectual Property Inc.

In the motions, the parties state that they have settled their disputes and have reached a written agreement that resolves the disputes in this proceeding as well as the disputes in all other matters between the parties relating to the patents involved in these proceedings. Mot. 1–3; *see* 35 U.S.C. § 317(b) (requiring that “[a]ny agreement or understanding between the patent owner and a petitioner . . . made in connection with, or in contemplation of, the termination of an *inter partes* review . . . shall be in writing”). The parties further represent that the Agreement is a true copy and 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[se] proceeding[s].” Mot. 3.

Upon consideration of the motions and the circumstances here, and even though the proceedings have moved beyond the preliminary stages, we determine that it is appropriate to terminate these proceedings without rendering final written decisions. *See* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72 (“The Board may terminate a trial without rendering a final written decision,

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where appropriate, including where the trial is consolidated with another proceeding or pursuant to a joint request under 35 U.S.C. 317(a)”); *see also* Consolidated Trial Practice Guide 86 (Nov. 2019)³ (“There are strong public policy reasons to favor settlement between the parties to a proceeding. . . . 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.”).

*B. Joint Requests to Treat Settlement Agreement
as Business Confidential Information*

The parties request that the Agreement (1) “be treated as business confidential information” and (2) “be maintained separate from the publicly available file of the involved patent[s].” Req. 2; *see* Mot. 2 (similar). After reviewing the Agreement between Petitioner and Patent Owner, we find that the Agreement contains confidential business information regarding the terms of settlement. We thus treat the Agreement as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), to be kept separate from the files of the involved patents.

In the Request, the parties also

request that they be notified if and when the Board receives and/or considers a request for access to the settlement agreement and be offered an opportunity to respond to any such request. *See Arista Networks, Inc. v. Castlemorton Wireless, LLC*, IPR2020-00986[, Paper 7 at] 4 (PTAB Oct. 28, 2020).

Req. 2.

³ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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If a third party were to request to make the Agreement available, the proper course of action—including whether to allow argument by the parties to these proceedings—will be determined at that future time. Further, the relevant regulations do not require the Board to provide any written requests for the Agreement to the parties to these proceedings. We thus decline to mandate such action in this Order. This aspect of the parties' Request is *denied*.

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

ORDER

Accordingly, it is hereby:

ORDERED that the joint motions are *granted*, and these four proceedings are *terminated* with respect to all parties;

FURTHER ORDERED that the joint requests to treat the settlement agreement as business confidential information are *granted in part* as detailed above; and

FURTHER ORDERED that the Settlement Agreement (e.g., IPR2024-00938, Ex. 1031) (1) shall be treated as business confidential information; (2) shall be kept separate from the files of U.S. Patent No. 11,389,038 B2; U.S. Patent No. 10,080,472 B2; U.S. Patent No. 11,910,984 B2; and U.S. Patent No. 11,903,546 B2; and (3) shall be made available only to Federal Government agencies on written request to the Board, or to any person on a showing of good cause.

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