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. IPR2024-01233

U.S. PATENT NO. 9,301,666

JOINT MOTION TO TERMINATE PROCEEDING

PETITIONER'S UPDATED EXHIBIT LIST

Exhibit No.	Description
Ex1001	U.S. Patent No. 9,301,666 ("'666Patent")
Ex1002	Declaration of Robert Giachetti
Ex1003	*Curriculum Vitae* of Robert Giachetti
Ex1004	File History of U.S. 9,301,666 (App. No. US14/489,646)
Ex1005	U. K. Patent Application GB2399780A to Liddell ("Liddell")
Ex1006	U.S. Patent No. 7,770,256 to Fester ("Fester256")
Ex1007	Certified English Translation of German Patent 357279C to Schmidt ("Schmidt")
Ex1008	U.S. Patent Publication No. US2005/0198770 to Jung ("Jung")
Ex1009	U.S. Patent No. 7,547,336 to Fester ("Fester336")
Ex1010	U.S. Provisional Patent Application No. 60/593,125 ("Fester336 Provisional")
Ex1011	U. K. Patent Application GB194963A to Lehmann ("Lehmann")
Ex1012	U.S. Provisional Patent Application No. 60/521,466 ("Fester256 Provisional")
Ex1013	U.S. Patent No. 5,504,412 to Chan ("Chan")
Ex1014	Certified English Translation of Spanish Patent No. ES43816 to Dayer ("Dayer")
Ex1015	Spanish Patent No. ES43816 to Dayer ("DayerES")
Ex1016	U.K. Patent Application No. GB2035787 to Merritt ("Merritt")
Ex1017	U.K. Patent Application No. GB2372434A ("Organ")

Ex1018	Certified English Translation of French Patent No. 1,094,603 to Martelliere ("Martelliere")
Ex1019	Exhibit H-1 to PO's Infringement Contentions
Ex1020	PO's Opening *Markman* Brief in *SharkNinja Operating LLC v. Dyson, Inc.*, No. 1:23-cv-12372 (D. Mass.) (Dkt. 122)
Ex1021	German Patent 357279C to Schmidt ("DESchmidt")
Ex1022	French Patent No. 1,094,603 to Martelliere ("MartelliereFR")
Ex1023	National Judicial Caseload Profile https://www.uscourts.gov/sites/default/files/data_tables/fcms_na_distprofile1231.2023.pdf
Ex1024	The Parties' Revised Proposed Schedule in *SharkNinja Operating LLC v. Dyson, Inc.*, No. 1:23-cv-12372 (D. Mass.)
Ex1025	Plaintiffs' Infringement Contentions in SharkNinja Operating LLC v. Dyson, Inc., No. 1:23-cv-12372 (D. Mass.)
Ex1026	Petitioners' Stipulation
Ex1027	Certified English Translation of Japanese Patent Publication No. JPS48107459U to Tsukuji ("Tsukuji")
Ex1028	Japanese Patent Publication No. JPS48107459U to Tsukuji ("TsukujiJP")
Ex1029	U.S. Patent No. 1,861,261 to Carson ("Carson")
Ex1030	U.S. Patent No. 3,425,192 to Davis ("Davis")
Ex1031	Certified English translation of Swiss Patent No. CH203,675 to Peter ("Peter")
Ex1032	Swiss Patent No. CH203,675 to Peter ("PeterCH")
Ex1033	Defendants' P.R. 3-3 Invalidity Contentions, *Dyson, Inc. v. SharkNinja, Inc.*, No. 2:24-cv-386 (E.D. Tex.)
Ex1034	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 1034. 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 '666 patent. A true copy of the Settlement Agreement is filed concurrently herewith. *See* Confidential Ex1034. 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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