

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.

IPR2024-01233 (Patent 9,301,666 B2)
IPR2024-01288 (Patent 10,219,661 B2)¹

Before ERIC C. JESCHKE, RYAN H. FLAX, and BRENT M. DOUGAL,
Administrative Patent Judges.

JESCHKE, *Administrative Patent Judge.*

DECISION
Settlement Prior to Institution of Trial
37 C.F.R. § 42.74

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

BACKGROUND

During the summer of 2024, Dyson Technology Limited and Dyson, Inc. (collectively, “Petitioner”) filed a petition in both of these proceedings. IPR2024-01233, Paper 2; IPR2024-01288, Paper 2. Patent Owner, Omachron Intellectual Property Inc., timely filed a preliminary response in each proceeding. IPR2024-01233, Paper 7; IPR2024-01288, Paper 7. The Board has not issued decisions on institution in either proceeding.

With the Board’s prior authorization (IPR2024-01233, Ex. 3002; IPR2024-01288, Ex. 3001), the parties filed three documents in each proceeding: (1) a joint motion to terminate proceeding (IPR2024-01233, Paper 9; IPR2024-01288, Paper 8 (collectively, the “motions” or “Mot.”)); (2) a joint request to treat settlement agreement as business confidential information (IPR2024-01233, Paper 10; IPR2024-01288, Paper 9 (collectively, the “requests” or “Req.”))²; and (3) a true copy of the settlement agreement made in connection with the termination of these proceedings (IPR2024-01233, Ex. 1034; IPR2024-01288, Ex. 1030 (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 two proceedings.

DISCUSSION

A. Joint Motions to Terminate

Under the applicable regulations, the parties may agree to settle any issue in a proceeding. 37 C.F.R. § 42.74(a) (2024). In addition, “[a]ny

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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agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and a true copy shall be filed with the Board before the termination of the trial.”

37 C.F.R. § 42.74(b).

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.

Because the parties have satisfied the requirements to terminate the proceedings based on settlement, we *grant* the motions and *terminate* these proceedings.

*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

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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.

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 two 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., IPR2024-01233, Ex. 1034) (1) shall be treated as business confidential

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information; (2) shall be kept separate from the files of U.S. Patent No. 9,301,666 B2 and U.S. Patent No. 10,219,661 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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