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. IPR2024-01288

U.S. PATENT NO. 10,219,661

JOINT MOTION TO TERMINATE PROCEEDING

PETITIONER'S UPDATED EXHIBIT LIST

Exhibit No.	Description
Ex1001	U.S. Patent No. 10,219,661 ("'661Patent")
Ex1002	Declaration of Robert Giachetti
Ex1003	*Curriculum Vitae* of Robert Giachetti
Ex1004	Excerpted File History of U.S. Patent No. 10,219,661 (App. No. 15/085,830)
Ex1005	PCT Publication No. 2007/084543 to Butler et al. ("Butler")
Ex1006	Japanese Patent Publication No. JPS48107459U to Tsukuji ("TsukujiJP")
Ex1007	Certified English translation of Japanese Patent Publication No. JPS48107459U to Tsukuji ("Tsukuji")
Ex1008	French Patent No. 1,094,603 to Martelliere ("MartelliereFR")
Ex1009	Certified English translation of French Patent No. 1,094,603 to Martelliere ("Martelliere")
Ex1010	Complainants' Exhibit 26, Infringement Claim Chart regarding the '661Patent, *In the Matter of Certain Surface Cleaning Devices and Components Thereof; Inv. No. 337-TA-1404*
Ex1011	Spanish Patent No. ES43816 to Dayer SA ("DayerES")
Ex1012	Certified English Translation of Spanish Patent No. ES43816 to Dayer SA ("Dayer")
Ex1013	German Patent No. DE1691786 to Boehmler ("BoehmlerDE")
Ex1014	Certified English Translation of German Patent No. DE1691786 to Boehmler ("Boehmler")
Ex1015	German Patent Publication No. DE1680208 to Rebel ("RebelDE")

Ex1016	Certified English Translation of German Patent Publication No. DE1680208 to Rebel ("Rebel")
Ex1017	Korean Patent Publication No. KR19980020751 to Moon ("MoonKR")
Ex1018	Certified English Translation of Korean Patent Publication No. KR19980020751 to Moon ("Moon")
Ex1019	PCT Publication No. 2013/117901 to Sunderland et al. ("Sunderland")
Ex1020	International Publication No. WO 02/067753 to Vuijk ("Vuijk")
Ex1021	U.S. Patent No. 7,175,682 to Nakai et al. ("Nakai")
Ex1022	Chinese Patent Publication No. CN103784081A to Wenjie ("WenjieCN")
Ex1023	Certified English Translation of Chinese Patent Publication No. CN103784081A to Wenjie ("Wenjie")
Ex1024	German Patent Publication No. DE1213967B to Berg ("BergDE")
Ex1025	Certified English Translation of German Patent Publication No. DE1213967B to Berg ("Berg")
Ex1026	German Patent No. DE6942662U to Knipping ("KnippingDE")
Ex1027	Certified English Translation of German Patent No. DE6942662U to Knipping ("Knipping")
Ex1028	Japanese Patent No. JP2854263 to Ikki ("IkkiJP")
Ex1029	Certified English Translation of Japanese Patent No. JP2854263 to Ikki ("Ikki")
Ex1030	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 1030. 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 '661 patent. A true copy of the Settlement Agreement is filed concurrently herewith. *See* Confidential Ex1030. 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

/s/ Christian Huehns

Christian Huehns (Reg. No. 77,717)
KIRKLAND & ELLIS LLP
333 West Wolf Point Plaza
Chicago, IL 60654
Telephone: (312) 862-2000
Facsimile: (312) 862-2200
christian.huehns@kirkland.com
DysonIPR@kirkkland.com

Matthew Benjamin Hershkowitz
(Reg. No. 77,881)
KIRKLAND & ELLIS LLP
601 Lexington Ave
New York, NY 10022
Telephone: (212) 446-4800
Facsimile: (212) 446-4900
matt.hershkowitz@kirkland.com
Attorneys for Petitioners

Date: February 3, 2025

/s/ Brian M. Buroker

Brian M. Buroker (Reg. No. 39,125)
Shuo Josh Zhang (Reg. No. 71,774)
GIBSON, DUNN & CRUTCHER LLP
1700 M Street N.W.
Washington, DC 20036
Phone: (202) 955-8500
Fax: (202) 467-0539
bburoker@gibsondunn.com
szhang@gibsondunn.com

Brian A. Rosenthal (*pro hac vice*)
Vivian Lu (Reg. No 74,443)
Ahmed ElDessouki (*pro hac vice*)
GIBSON, DUNN & CRUTCHER LLP
200 Park Avenue
New York, NY 10166
brosenthal@gibsondunn.com
vlu@gibsondunn.com
aeldessouki@gibsondunn.com

Nathan R. Curtis (Reg. No. 70,471)
GIBSON, DUNN & CRUTCHER LLP
2001 Ross Avenue
Dallas, TX 75201
ncurtis@gibsondunn.com

Attorneys for Patent Owner

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:

GDC-SharkNinjaIPRD@gibsondunn.com

DysonIPR@kirkland.com

/s/ Christian Huehns
Christian Huehns (Reg. No. 77,717)