

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.

IPR2024-01351
Patent 7,776,120 B2

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

FLAX, *Administrative Patent Judge.*

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

Omachron Intellectual Property Inc. (“Patent Owner”) is the owner of U.S. Patent 7,776,120 B2 (Ex. 1001, “the ’120 patent”). Paper 3, 1. On August 22, 2024, Dyson Technology Limited and Dyson, Inc. (“Petitioner”) filed a Petition for *inter partes* review challenging the patentability of claims 1–20 of the ’120 patent (all claims). Paper 2, 3. On December 12, 2024, Patent Owner filed a Preliminary Response to the Petition. Paper 6. We have not yet entered a decision whether to institute trial in this proceeding.

On February 3, 2005, the parties jointly, with our authorization, filed a Joint Motion to Terminate this proceeding on the basis of a settlement reached by the parties. Paper 7 (“Motion” or “Mot.”); *see* 35 U.S.C. § 317(a); 37 C.F.R. § 42.74; *see also* Ex. 3001 (authorization).

35 U.S.C. § 317(b) states:

Any agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of an *inter partes* review under this section shall be in writing and a true copy of such agreement or understanding shall be filed in the Office before the termination of the *inter partes* review as between the parties.

Id. Pursuant to that statute, and in connection with the Joint Motion to Terminate, the parties filed a copy of their written settlement agreement resolving, *inter alia*, this *inter partes* review, which they certify “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.” Mot. 3; Ex. 1027 (“Settlement Agreement”). Based on the language and execution date of the Settlement Agreement, this certification is sufficient.

Generally, 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. *See* 35 U.S.C. § 317(a) (“An inter partes review instituted under this chapter 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.”); 37 C.F.R. § 42.72 (“The Board may terminate a trial without rendering a final written decision, where appropriate, including . . . pursuant to a joint request under 35 U.S.C. 317(a)”). As noted above, the Board has not yet rendered a final decision. Thus, we *grant* the Joint Motion to Terminate the proceeding.

The parties also jointly request that the Settlement Agreement (Ex. 1027) be treated as confidential information and kept separate from the ’120 patent’s record. Paper 8. Based on our review of the Settlement Agreement, we find good cause exists and this request is *granted*. *See* 37 C.F.R. § 42.74(c).

Relatedly, the parties also jointly 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 Pap. 7, 4 (PTAB Oct. 28, 2020).

Paper 8, 2.

In the event that a request is made to make the Settlement Agreement available, the course of action, including whether to allow argument by the parties can be determined at that time. Further, our regulations do not require that the Board serve any written requests for the Settlement

Agreement on the parties. We therefore decline to issue an order mandating such action. Thus, to this extent, the parties' request is *denied*.

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

Accordingly, it is:

ORDERED that the Joint Motion to Terminate this proceeding is *granted*, the Petition is *dismissed*, and this proceeding is hereby *terminated* under 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72, 42.74;

FURTHER ORDERED that the related Joint Request to Treat the Settlement Agreement (Ex. 1027) as Confidential Information is *granted* to the extent that this agreement shall be kept separate from the public files of the '120 patent, and made available only to Government agencies on written request, or to any person on written request and a showing of good cause, under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that no other relief is granted.

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