Paper No. 8
Filed: October 26, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Taiwan Semiconductor Manufacturing Company Ltd.,

Petitioner,

v.

Daedalus Prime LLC,

Patent Owner.

Patent No. 10,700,178 B2
Filing Date: May 20, 2019
Issue Date: June 30, 2020

Title: CONTACT RESISTANCE REDUCTION EMPLOYING GERMANIUM OVERLAYER PRE-CONTACT METALIZATION

Inter Partes Review No. IPR2023-01120

JOINT MOTION TO FILE SETTLEMENT AGREEMENT AS BUSINESS CONFIDENTIAL INFORMATION PURSUANT TO 35 U.S.C. § 317(b)

INTRODUCTION

Petitioner and Patent Owner are filing a Joint Motion to Terminate Proceeding along with a settlement agreement that resolves all underlying disputes between the parties, including this proceeding. In an email dated October 25, 2023, the Board authorized the parties to file a true copy of the agreement between Petitioner and Patent Owner made in connection with or in contemplation of termination of this proceeding. As authorized by the Board, the parties are submitting a true copy of the settlement agreement as Exhibit 1064. The parties have agreed to waive service.

RELIEF REQUESTED

The rules permit the parties to have any filed agreement treated as business confidential information and kept separate from the files of the involved patent. 37 C.F.R. § 42.74(c). The statute requires:

> At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.

35 U.S.C. § 317(b).

Pursuant to 37 C.F.R. § 42.74(c) and 35 U.S.C. § 317(b), Petitioner and Patent Owner jointly request that the Office treat the settlement agreement (Exhibit 1064)

as business confidential information, that the settlement agreement be kept separate from the file of the involved patent, and that the settlement agreement be made available only to Federal Government agencies on written request, or to other persons only on a showing of good cause.

Respectfully submitted,

Date: October 26, 2023

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Date: October 26, 2023

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that the foregoing **JOINT MOTION TO FILE SETTLEMENT AGREEMENT AS BUSINESS CONFIDENTIAL INFORMATION PURSUANT TO 35 U.S.C. § 317(b)** was served via e-mail on counsel of record for the Patent Owner on October 26, 2023, at the following addresses:

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Patent Owner has agreed to electronic service.

Dated: October 26, 2023

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