Paper No. 7
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. 11,251,281 B2
Filing Date: May 22, 2020
Issue Date: February 15, 2022

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

Inter Partes Review No. IPR2023-01121

JOINT MOTION TO TERMINATE PROCEEDING

INTRODUCTION

Petitioner Taiwan Semiconductor Manufacturing Company Ltd. and Patent Owner Daedalus Prime LLC have made an 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 joint motion to terminate this proceeding and a joint motion to file their settlement agreement as business confidential information.

As required by the Board, the parties are submitting a true copy of the settlement agreement as Exhibit 1063, along with this Joint Motion to Terminate Proceeding and a Joint Motion to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b). The parties have agreed to waive service of the agreement.

The parties jointly certify that, aside from the settlement agreement, there are no collateral agreements or understandings in connection with or in contemplation of terminating this proceeding. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(b). The settlement agreement filed as Exhibit 1063 supersedes any other agreements or term sheets between the parties that may relate to the termination of this proceeding.

STATUS OF PROCEEDINGS

The following are the only proceedings either between the parties in the United States or that involve the subject patent:

Case	Number	Venue	Status
Semiconductor Devices, Mobile Devices Containing the Same, and Components Thereof	Inv. No. 337-TA-1336	ITC	Joint motion to terminate filed.
Daedalus Prime LLC v. Samsung Electronics Co., Ltd.	2:22-cv-00352	EDTX	Dismissed under Fed. R. Civ. P. 41(a).
Taiwan Semiconductor Mfg. Co. Ltd. v. Daedalus Prime LLC et al.	1:22-cv-01647	DDE	Joint motion to terminate filed.
Samsung Electronics Co., Ltd. v. Daedalus Prime LLC	IPR2023-00653	PTAB	Terminated.

RELIEF REQUESTED

Petitioner and Patent Owner jointly request that the Board terminate this proceeding in its entirety in view of the agreement the parties are filing. That agreement ends all patent disputes between the parties, including this proceeding.

Both Congress and the federal courts have expressed a strong interest in encouraging settlement in litigation. *See, e.g.*, *Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) ("The purpose of [Federal Rule of Civil Procedure] 68 is to encourage the settlement of litigation."); *Bergh v. Dept. of Transp*., 794 F.2d 1575, 1577 (Fed. Cir. 1986) ("The law favors settlement of cases."), *cert. denied*, 479 U.S.

950 (1986). The U.S. Court of Appeals for the Federal Circuit also places a particularly strong emphasis on settlement. *See Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility between parties). Moreover, the Board generally expects that a proceeding will terminate after the filing of a settlement. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 46,768 (Aug. 14, 2012).

Maintaining this proceeding after settlement between Patent Owner and Petitioner would discourage future settlements by removing a primary motivation for settlement, which is eliminating litigation risk by resolving the parties' disputes and ending the pending proceedings between them. For patent owners, litigation risks include the potential for an invalidity ruling against their patents. If a patent owner knows that an *inter partes* review will likely continue regardless of settlement, it creates a strong disincentive for the patent owner to settle.

CONCLUSION

For the foregoing reasons, Petitioner and Patent Owner jointly request that the Board terminate this proceeding in its entirety.

Respectfully submitted,

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 TERMINATE PROCEEDING** 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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