

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 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 1063. 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 1063)

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

By: / J. Preston Long /
J. Preston Long, Reg. No. 65,125
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP
901 New York Avenue, NW
Washington, DC 20001-4413
Telephone: (202) 408-4000

Lead Counsel for Petitioner

Date: October 26, 2023

By: / William A. Meunier /
William A. Meunier (Reg. No. 41,193)
Mintz, Levin, Cohn, Ferris, Glovsky and
Popeo, P.C.
One Financial Center
Boston, Massachusetts 02111
Phone: 617-348-1845
Fax: 617-542-2241
Email: WAMeunier@mintz.com

Lead Counsel for Patent Owner

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:

William A. Meunier (Reg. No. 41,193)
Mintz, Levin, Cohn, Ferris, Glovsky and
Popeo, P.C.
One Financial Center
Boston, Massachusetts 02111
Phone: 617-348-1845
Fax: 617-542-2241
Email: WAMeunier@mintz.com

Suparna Datta (Reg. No. 63,616)
Mintz, Levin, Cohn, Ferris, Glovsky and
Popeo, P.C.
One Financial Center
Boston, Massachusetts 02111
Phone: 617-348-4405
Fax: 617-542-2241
Email: SDatta@mintz.com

Michael T. Renaud (Reg. No. 44,299)
Mintz, Levin, Cohn, Ferris, Glovsky and
Popeo, P.C.
One Financial Center
Boston, Massachusetts 02111
Phone: 617-348-1870
Fax: 617-542-2241
Email: MTRenaud@mintz.com

Adam Rizk (Reg No. 66,867)
Mintz, Levin, Cohn, Ferris, Glovsky and Popeo,
P.C.
One Financial Center
Boston, Massachusetts 02111
Phone: 617-348-4709
Fax: 617-542-2241
Email: ARizk@mintz.com

Patent Owner has agreed to electronic service.

Dated: October 26, 2023

By: / William J. Esper /
William J. Esper
Case Manager and PTAB Coordinator
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.