

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORMFACTOR, INC.,
Petitioner,

v.

TECHNOPROBE S.P.A.,
Patent Owner.

Case IPR2024-00933

Patent No. 11,035,885 B2

JOINT MOTION TO TERMINATE DUE TO SETTLEMENT¹

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

¹ This Joint Motion was authorized by the Board in an e-mail dated June 3, 2025.

UPDATED LISTING OF EXHIBITS

Exhibit	Description
Ex. 1001	U.S. Pat. No. 11,035,885 (the “’885 patent”)
Ex. 1002	The ’885 Patent Prosecution History
Ex. 1003	Declaration of Frederick L. Taber
Ex. 1004	Korea Patent No. 10-1384714 (“Kim KR”)
Ex. 1005	Certified English Translation of Kim KR
Ex. 1006	U.S. Pub. No. 2015/0198632 A1 (“Kim”)
Ex. 1007	Japanese Patent Pub. No. H11-352182 (“Tezuka”)
Ex. 1008	Certified English Translation of Tezuka
Ex. 1009	U.S. Pat. No. 6,417,684 (“Schmid”)
Ex. 1010	U.S. Pat. No. 5,225,777 (“Bross”)
Ex. 1011	U.S. Pat. No. 9,470,715 (“Fan”)
Ex. 1012	U.S. Pub. No. 2014/0197860 (“Hsu”)
Ex. 1013	Introduction to Probe Cards, by Rod Schwartz (1998 SWTest Conference)
Ex. 1014	U.S. Pat. No. 4,622,514 (“Lewis”)
Ex. 1015	U.S. Pat. No. 10,281,491 (“McQuade”)
Ex. 1016	EP3555638A1 Prosecution History
Ex. 1017	Excerpt of JP2019-531897 Prosecution History
Ex. 1018	Certified English Translation of Excerpt of JP2019-531897 Prosecution History
Ex. 1019	Nakamoto Decl ISO Motion for Admission <i>Pro Hac Vice</i>
Ex. 1020	Scheduling Order in <i>Technoprobe S.p.A. v. FormFactor, Inc.</i> , Case No. 1:23-cv-00842-JCG (D. Del.)
Ex. 1021	Patent Owner’s Amended Complaint in <i>Technoprobe S.p.A. v. FormFactor, Inc.</i> , Case No. 1:23-cv-00842-JCG (D. Del.)
Ex. 1022	United States District Courts — National Judicial Caseload Profile, <i>available at</i> https://www.uscourts.gov/sites/default/files/fcms_na_distprofile1231.2023_0.pdf (last accessed May 9, 2024)
Ex. 1023	Curriculum Vitae of Frederick L. Taber
Ex. 1024	[Reserved]
Ex. 1025	[Reserved]
Ex. 1026	USPTO Memorandum, Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (June 21, 2022)

IPR2024-00933

U.S. Patent No. 11,035,885

Ex. 1027	Cover Pleading of Patent Owner's Infringement Contentions
Ex. 1028	SWTest Willtechnology Presentation
Ex. 1029	SWTest Willtechnology Presentation – WayBack June 3, 2016
Ex. 1030	SWTest Willtechnology Presentation – WayBack December 6, 2016
Ex. 1031	SWTest Willtechnology Presentation – June 7, 2016 Podium Proceedings
Ex. 1032	Confidential Settlement Agreement Between FormFactor, Inc. and Patent Owner Technoprobe S.P.A.

I. INTRODUCTION

Petitioner FormFactor, Inc. and Patent Owner Technoprobe S.p.A. (collectively, “the Parties”) have settled their disputes. Pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72 and 42.74, the Parties jointly request termination as to the petitioner and termination of this IPR in its entirety.

The Parties concurrently file another joint motion requesting that the Board treat Confidential Ex. 1032 as business confidential information and keep Confidential Ex. 1032 separate from the patent files.

II. THE PARTIES HAVE SETTLED THEIR DISPUTES

The Parties have resolved all disputes between them with regard to the challenged patent. In compliance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true and correct copy of the settlement agreement (Confidential Ex. 1032) that resolves the disputes between the Parties is concurrently filed with this Joint Motion.² The Parties jointly certify that there are no other agreements, oral or written, between the Parties made in connection with, or in contemplation of, the termination sought.

Moreover, the Parties contemplate no new district court or administrative

² Due to the confidentiality terms of these agreements, Petitioner is filing Confidential Ex. 1032 as “Parties and Board Only.”

proceeding between them with respect to the challenged patent in the foreseeable future.

Furthermore, the pending district court proceeding involving the challenged patent, *Technoprobe S.p.A. v. FormFactor, Inc.*, Case No. 1:23-cv-00842-JCG (D. Del.), has been settled and have been dismissed with prejudice.

III. THE PARTIES JOINTLY REQUEST TERMINATION AS TO THE PETITIONERS

Under 35 U.S.C. § 317(a), “[a]n 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.” The Parties jointly request termination as to the Parties. The Board has not decided the merits of the proceeding. The Parties have not yet fully briefed their arguments following institution, oral argument has not yet occurred, and no final written decision has been entered.

IV. THE PARTIES JOINTLY REQUEST TERMINATION OF THIS IPR IN ITS ENTIRETY

“There are strong public policy reasons to favor settlement between the parties to a proceeding. ... 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.” Consolidated Trial Practice Guide at 86

(November 2019). The Parties jointly request termination of this IPR in its entirety in support of the public policy considerations. Termination is appropriate at least because there are no other petitioners in this proceeding, there has been no decision on the merits, and termination will conserve the limited resources of the Board.

IV. CONCLUSION

For at least the foregoing reasons, the Parties respectfully request termination as to the petitioner and termination of this IPR in its entirety.

Dated: June 10, 2025

Respectfully submitted,

By: /Houtan K. Esfahani/

Houtan K. Esfahani

Reg. No. 41,893

COUNSEL FOR PATENT OWNER

/T. Vann Pearce, Jr./

T. Vann Pearce, Jr.

Reg. No. 58,945

COUNSEL FOR PETITIONER

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that the foregoing, JOINT MOTION TO TERMINATE PROCEEDING PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.74 was served on June 10, 2025, via e-mail directed to counsel of record for the Patent Owner at the following:

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