

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SMIC, AMERICAS,

Petitioner,

v.

INNOVATIVE FOUNDRY TECHNOLOGIES LLC,

Patent Owner

Case No. IPR2020-01003

U.S. Patent No. 6,580,122

**JOINT REQUEST TO FILE SETTLEMENT AGREEMENT AS BUSINESS
CONFIDENTIAL INFORMATION PURSUANT TO
35 U.S.C. § 317(b) AND 37 C.F.R. § 42.74(c)**

Petitioner SMIC, Americas (“SMIC”) and Patent Owner Innovative Foundry Technologies LLC (“IFT”) (collectively, the “Parties”) are contemporaneously filing a Joint Motion to Terminate along with a Settlement Agreement (Confidential Exhibit 1028) that resolves all underlying disputes between the Parties, including this proceeding. Pursuant to 35 U.S.C. § 317(b), 37 C.F.R. §§42.74(c), and the Board’s authorization on April 27, 2021, Petitioner and Patent Owner jointly request to treat the filed Settlement Agreement between the Parties as business confidential information and keep it separate from the file of this proceeding and the involved patents.¹

If requested, the rules permit the parties to have any filed settlement agreement treated as business confidential information and kept separate from the files of the involved patent. 37 C.F.R. § 42.74(c). Indeed, the statutes require it.

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.

¹ The Settlement Agreement has been filed electronically via E2E for “Parties and Board Only” to preserve confidentiality.

35 U.S.C. § 317(b). Likewise, 37 C.F.R. § 42.74(c) provides that:

A party to a settlement may request that the settlement be treated as business confidential information and be kept separate from the files of an involved patent or application. The request must be filed with the settlement. If a timely request is filed, the settlement shall only be available:

- (1) To a Government agency on written request to the Board; or
- (2) To any other person upon written request to the Board to make the settlement agreement available, along with the fee specified in § 42.15(d) and on a showing of good cause.

37 C.F.R. § 42.74(c).

Therefore, the parties hereby jointly request that the Settlement Agreement filed herewith (i) be treated as business confidential information, (ii) be maintained separate from the publicly available file of the above-captioned proceeding, and (iii) shall be made available only to Federal Government agencies on written request, or to any persons showing good cause on written request, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Respectfully submitted by:

Date: April 27, 2021

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of the foregoing was served by electronic mail on counsel of record for the Patent Owner as follows:

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