

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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QUALCOMM INCORPORATED

PETITIONER

v.

DAEDALUS PRIME LLC

PATENT OWNER

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IPR2023-00550  
PATENT 8,775,833

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**JOINT MOTION TO TERMINATE  
PURSUANT TO 35 U.S.C. § 317 and 37 C.F.R. § 42.74  
&  
REQUEST TO TREAT SETTLEMENT AGREEMENT AS BUSINESS  
CONFIDENTIAL INFORMATION AND KEEP SEPARATE**

**PETITIONER’S UPDATED EXHIBIT LIST**

<b>Exhibit No.</b>	<b>DESCRIPTION</b>
1001	U.S. Patent No. 8,775,833
1002	Declaration of Dr. Trevor Mudge
1003	Curriculum Vitae of Dr. Trevor Mudge
1004	File History of U.S. Patent No. 8,775,833
1005	U.S. Published Patent Application No. 2010/0115304 (“Finkelstein”)
1006	U.S. Published Patent Application No. 2007/0049133 (“Conroy”)
1007	U.S. Published Patent Application No. 2011/0022356 (“Nussbaum”)
1008	U.S. Published Patent Application No. 2009/0089602 (“Bose”)
1009 – 1019	INTENTIONALLY LEFT BLANK
1020	Claim Mapping Table
1021- 1022	INTENTIONALLY LEFT BLANK
1023	U.S. Patent No. 7,263,457 (“White”)
1024	U.S. Patent No. 8,438,416 (“Kocev”)
1025	U.S. Patent No. 8,984,523 (“Vajda”)
1026	U.S. Patent No. 7,779,276 (“Bolan”)
1027	Selected pages of Stefanos Kaxiras et al., Computer Architecture Techniques for Power-Efficiency (2008)
1028	U.S. Published Patent Application No. 2010/0162006 (“Therien”)
1029- 1038	INTENTIONALLY LEFT BLANK
1039	Daedalus Prime LLC & Qualcomm Incorporated Settlement Agreement ( <b>BUSINESS CONFIDENTIAL</b> )

Patent Owner (“Daedalus Prime LLC”) and Petitioner (“Qualcomm Incorporated”) (collectively, “the Parties”) have reached a settlement. Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, the Parties jointly request termination of this proceeding, IPR2023-00550, directed to U.S. Patent No. 8,775,833 (the “’833 Patent”). The Parties were authorized to file this Joint Motion by the Board (via e-mail) on January 8, 2024.

## **I. CERTIFICATION**

As required by 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, the Parties jointly submit a true copy of the settlement agreement (the “Agreement”) between Patent Owner and Petitioner made in connection with, or in contemplation of, the termination of the proceeding under 37 CFR § 42.74(b) with this joint motion. The Agreement is filed herewith as a confidential exhibit (EX1039).

The Parties certify that there are no other agreements or understandings between Patent Owner and Petitioner, or any collateral agreements referred to in the Agreement, made in connection with, or in contemplation of, the termination of this proceeding. 35 U.S.C. § 317(a); see also 37 CFR § 42.74(b).

## **II. STATUS OF RELATED PROCEEDINGS**

The Parties have resolved their disputes regarding the ’833 Patent, including both in this proceeding and in the related district court litigation, *Daedalus Prime LLC v. Mazda Motor Corporation et al.*, No. 1:22-cv-1109 (D. Del. 2022) and the

related International Trade Commission Investigation, *In re Certain Integrated Circuits, Mobile Devices Containing the Same, and Components Thereof*; Inv. No. 337-TA-1335. The Parties do not anticipate further litigation between them concerning the '833 Patent.

### **III. STATEMENT OF PRECISE RELIEF REQUESTED**

As authorized by the Board's e-mail message on January 8, 2024, the Parties are jointly and contemporaneously filing: (i) this joint motion to terminate the proceeding; (ii) a true copy of the entire Agreement between Patent Owner and Petitioner; and (iii) a joint request to treat the Agreement as business confidential information and keep the Agreement separate from the file of the involved patent, pursuant to 37 C.F.R. § 42.74(c).

The Parties jointly request the Board terminate this proceeding in its entirety. Termination of this proceeding is appropriate because a settlement has been reached. "An *inter partes* review 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 proceedings before the request for termination is filed." 35 U.S.C § 317(a).

Good cause exists to terminate this proceeding because: (1) Patent Owner and Petitioner resolved their disputes regarding the '833 Patent; (2) "[t]here are strong public policy reasons to favor settlement between the parties to a proceeding"

(Consolidated Trial Practice Guide (“TPG”) at 86 (November 2019)); (3) “[t]he 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” (*id.* citing 35 U.S.C. §§ 317(a), 327); (4) the Board has granted late-stage termination in other proceedings, even after oral arguments (*see, e.g., Nissan North America, Inc. & Nissan Motor Co., Ltd., v. Blitzsafe Tex., LLC*, IPR2016-00418, Paper 50; *SZ DJI Tech. Co., Ltd. & Parrot Inc. v. Drone-Control, LLC*, IPR2018-00204, IPR2018-00205, IPR2018-00206, IPR2018-00207, IPR2018-00208, Paper 42); and (5) termination would serve the interests of judicial economy and both Parties.

#### **IV. REQUEST TO TREAT AS BUSINESS CONFIDENTIAL**

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, the Parties jointly request to treat the Agreement (EX1039) between Patent Owner and Petitioner, as business confidential information that shall be kept separate from the file of the involved patent and be made available only to Federal Government agencies on written request or to persons showing good cause. See 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c).

#### **V. CONCLUSION**

The Parties have settled all disputes relating to the ’833 Patent. The Board has not entered a final written decision on the merits. Accordingly, the Parties jointly and respectfully request that the Board terminate the instant proceeding in its entirety

and treat Exhibit 1039 as Business Confidential Information and keep it separate from the patent file.

Dated: January 11, 2024

Respectfully submitted,

/Eagle H. Robinson/  
Eagle H. Robinson

*Lead Counsel for Petitioner*

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*Counsel for Patent Owner,  
Daedalus Prime LLC*

**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on January 11, 2024, a complete copy of the foregoing was served on Patent Owner via email (by consent) at:

PFSnell@mintz.com  
ARizk@mintz.com  
MTRenaud@mintz.com  
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/Eagle H. Robinson/  
Eagle H. Robinson (Reg. No. 61,361)