

Paper No. \_\_\_  
Filed: January 26, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

TIANMA MICROELECTRONICS CO. LTD.,  
Petitioner,

v.

JAPAN DISPLAY INC.,  
Patent Owner.

---

Case No. IPR2021-01058  
U.S. Patent No. 7,636,142

---

**JOINT REQUEST TO TREAT SETTLEMENT AGREEMENT  
AS BUSINESS CONFIDENTIAL INFORMATION  
PURSUANT TO 35 U.S.C. § 317(b)**

Petitioner Tianma Microelectronics Co. Ltd., and Patent Owner Japan Display Inc. have entered into a settlement agreement that resolves all underlying disputes between the parties, including the related district court litigation and *inter partes* review proceeding IPR2021-01058, against U.S. Patent No. 7,636,142, currently before the Board.

In an email dated January 25, 2022, the Board authorized the parties to file a joint motion to terminate and a joint request to treat the settlement agreement (including the license agreement) as business confidential information. In accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true copy of the settlement agreement (including the license agreement) between the parties is being submitted concurrently herewith in this proceeding as Ex. 1024.

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 statute requires 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.

35 U.S.C. § 317(b).

Accordingly, 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 (including the license agreement) filed concurrently herewith as Ex. 1024 as business confidential information, that the agreement be kept separate from the file of the involved patent, and that the 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,

Dated: January 26, 2022

By: /Joshua L. Goldberg/  
Joshua L. Goldberg, Reg. No. 59,369  
Counsel for Petitioner

By: /Eric J. Klein/  
Eric J. Klein, Reg. No. 51,888  
Counsel for Patent Owner

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing **Joint Request to Treat Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b)** was served on January 26, 2022, via email directed to counsel of record for Patent Owner at the following:

Eric J. Klein (Reg. No. 51,888) eklein@velaw.com VINSON & ELKINS L.L.P. 2001 Ross Avenue, Suite 3900 Dallas, TX 75201 Tel: (214) 220-7700 Fax: (214) 220-7716	Abigail Lubow (Reg. No. 75,839) alubow@velaw.com VINSON & ELKINS L.L.P. 555 Mission Street, Suite 2000 San Francisco, CA 94105 Tel: (415) 979-6963 Fax: (415) 358-5770  Jeffrey R. Swigart (Reg. No. 77,008) jswigart@velaw.com VINSON & ELKINS L.L.P. 2001 Ross Avenue, Suite 3900 Dallas, TX 75201-2975 Tel: (214) 220-7700 Fax: (214) 220-7716
---	---

Dated: January 26, 2022

By: Valencia Daniel/  
Valencia Daniel  
Litigation Legal Assistant  
FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, LLP