

Form PTO-1595 (Rev. 07/05)  
OMB No. 0651-0027 (exp. 6/30/2008)

U.S. DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office

## RECORDATION FORM COVER SHEET PATENTS ONLY

To the Director of the U.S. Patent and Trademark Office: Please record the attached documents or the new address(es) below.

### 1. Name of conveying party(ies)

FlipChip International LLC

Additional name(s) of conveying party(ies) attached? ☐ Yes ☒ No

### 3. Nature of conveyance/Execution Date(s):

Execution Date(s) March 10, 2008; March 11, 2008

- ☐ Assignment ☐ Merger  
☐ Security Agreement ☐ Change of Name  
☐ Joint Research Agreement  
☐ Government Interest Assignment  
☐ Executive Order 9424, Confirmatory License  
☒ Other Amended and Restated License Agreement

### 2. Name and address of receiving party(ies)

Name: Advanced Semiconductor Engineering, Inc.

Internal Address: \_\_\_\_\_

Street Address: 26, Chin 3rd Road 811,

Nantze Export Processing Zone

City: Kaohsiung

State: \_\_\_\_\_

Country: Taiwan Zip: \_\_\_\_\_

Additional name(s) & address(es) attached? ☐ Yes ☒ No

### 4. Application or patent number(s):

A. Patent Application No.(s)

☐ This document is being filed together with a new application.

B. Patent No.(s)

7,057,292 B1; 6,287,893 B2; 6,441,487 B2; 6,750,135 B2;  
7,126,164 B2; 7,118,833 B2; 6,578,755 B1; 5,547,740; 5,803,340;  
5,607,099; 5,632,667

Additional numbers attached? ☐ Yes ☒ No

### 5. Name and address to whom correspondence concerning document should be mailed:

Name: Thelen Reid Brown Raysman & Steiner LLP

Internal Address: \_\_\_\_\_

Street Address: P.O. Box 1510

City: New York

State: N.Y. Zip: 10150-1510

Phone Number: 212-603-2000

Fax Number: 212-208-4552

Email Address: Patents-NY@thelen.com

### 6. Total number of applications and patents involved: 11

### 7. Total fee (37 CFR 1.21(h) & 3.41) \$ 440.00

- ☐ Authorized to be charged by credit card  
☒ Authorized to be charged to deposit account  
☐ Enclosed  
☐ None required (government interest not affecting title)

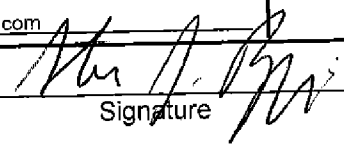
### 8. Payment Information

a. Credit Card Last 4 Numbers \_\_\_\_\_  
Expiration Date \_\_\_\_\_

b. Deposit Account Number 50-1698

Authorized User Name Karen Bellinger

### 9. Signature:

  
Signature

May 8, 2008  
Date

Steven J. Rizzi  
Name of Person Signing

Total number of pages including cover sheet, attachments, and documents: 16

Documents to be recorded (including cover sheet) should be faxed to (571) 273-0140, or mailed to:  
Mail Stop Assignment Recordation Services, Director of the USPTO, P.O.Box 1450, Alexandria, V.A. 22313-1450

CH \$440.00 501698 7057292

## AMENDED AND RESTATED LICENSE AGREEMENT

THIS AMENDED AND RESTATED LICENSE AGREEMENT (the "Agreement") is entered into on this 7th day of March, 2008 (the "Effective Date") by and between FlipChip International, LLC (hereinafter "FCI"), having a place of business at 3701 E. University Avenue, Phoenix, Arizona 85034, USA and Advanced Semiconductor Engineering, Inc. (hereinafter "ASE"), a Taiwanese corporation, having a principal place of business at 26, Chin 3rd Road 811, Nantze Export Processing Zone, Kaohsiung, Taiwan. Either FCI or ASE may hereinafter be individually referred to as a "Party" or collectively as the "Parties"; and

WHEREAS, ASE and FCI's predecessor, Flip Chip Technologies, LLC, entered into two license agreements on or about March 1, 1999, and December 28, 2000, respectively, both of which were amended on or about March 10, 2005 (collectively, the "License Agreements");

WHEREAS, the License Agreements granted ASE rights under certain FCI intellectual property, including but not limited to certain patents and know-how pertaining to semiconductor packaging processes designated by FCI in the License Agreements as "Flex-On-Cap," "RDL Technologies," and "Ultra CSP<sup>TM</sup>" (collectively, the "Licensed Subject Matter");

WHEREAS, a dispute has arisen between the Parties concerning (1) an audit of ASE's records requested by FCI; and (2) royalty payments due FCI under the License Agreements (collectively, the "Dispute");

WHEREAS, no Party admits or acknowledges any wrongdoing in connection with the Dispute;

WHEREAS, the Parties now agree to terminate the License Agreements, and all rights and obligations arising therefrom, forever release any claims for breach of the License Agreements arising from or relating to the Dispute, and replace the License Agreements with this Agreement.

NOW THEREFORE, for good and valuable consideration and the mutual promises, releases, covenants and agreements contained herein FCI and ASE agree as follows:

### *1. Definitions*

1.1 "Affiliate" means a Party's predecessors, successors, subsidiaries, divisions, departments, or other operating units, and any legal entity that is controlled by, in common control of or under common control with the relevant Party.

1.2 "Confidential Information" means unpublished research and development information, know-how, Trade Secrets, and technical data provided to ASE under the License Agreements; provided, however, that the following do not constitute Confidential Information as defined herein:

- (a) any information that appears in published patents and applications, or has otherwise been published;

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- (b) any information which is in the public domain for reasons other than a breach of this Agreement;
- (c) any information that ASE can show was already known to it prior to the disclosure;
- (d) any information that was received by ASE from a source who obtained the information lawfully through channels independent of FCI; and
- (e) any information that ASE can show was independently developed by it after the time of disclosure by personnel who did not have access to FCI's Confidential Information

1.3 "Know-How" means Confidential Information and any other proprietary rights owned by FCI, or which FCI otherwise has the right to license, in any country in the world.

1.4 "Licensed IP" means (i) the Patents; and (ii) any Know-How, trademarks, and copyrights pertaining to the Licensed Subject Matter.

1.5 "Patents" means all patents, patent applications, continuations, continuations-in-part, divisionals, reissues, extensions, utility models, invention registrations and similar rights throughout the world that are owned by FCI, or which FCI otherwise has the right to sublicense to ASE, without obligation to pay additional royalties for such grant of sublicense to ASE, covering any aspect of the Know-How or manufacturing processes disclosed under the License Agreements, including but not limited to, the patents and patent applications identified in Schedules A and B hereto.

1.6 "Trade Secrets" means information of a technical nature, such as formula, manufacturing processes or machines, materials, inventions, and research projects; business data such as costs, profits, markets, sales, customer lists, plans for future development, and other information of a similar nature not generally available to the public.

## ***2. Termination of License Agreements***

2.1 Notwithstanding anything to the contrary in the License Agreements, all rights and obligations arising and/or accrued under the License Agreements are hereby terminated and revoked, and the terms of the License Agreements shall have no further force and effect.

## ***3. Representations and Warranties***

3.1 ASE represents and warrants that, as of the Effective Date, ASE has not, to its knowledge, granted to any third party any explicit rights, licenses, or sublicenses with respect to any of the rights granted to ASE under the License Agreements, except in accordance with the terms of the License Agreements.

3.2 FCI represents and warrants that, to the best of its knowledge based on a reasonable investigation, i) the patents and patent applications identified in Schedule A include all patents and patent applications owned or controlled by FCI and any Affiliates, and necessary to practice the Licensed Subject Matter; and ii) the patents and patent applications identified in Schedule B include all patents and patent applications necessary to practice the Licensed Subject Matter that

FCI and/or any Affiliates have the right to sublicense to ASE, without an obligation to pay additional royalties for the grant of such sublicense rights.

3.3 FCI represents and warrants that, PTO records notwithstanding, the patents listed in Schedule C are not owned or controlled by FCI or any Affiliate, and neither FCI nor any Affiliate has the right to grant license or sublicense rights under any such patents.

3.4 OTHER THAN AS STATED IN THIS SUBSECTION 3.3, NEITHER PARTY MAKES ANY REPRESENTATIONS OR WARRANTIES AS TO ANY MATTER WHATSOEVER, AND EACH PARTY HEREBY DISCLAIMS ALL OTHER WARRANTIES, INCLUDING WITHOUT LIMITATION THE IMPLIED WARRANTIES OF MERCHANTABILITY, FITNESS FOR A PARTICULAR PURPOSE, TITLE AND NON-INFRINGEMENT OF THIRD PARTY RIGHTS.

#### *4. Mutual Waiver and Release of Claims; Covenant not to Sue*

4.1 Each Party, on behalf of itself and its Affiliates, specifically releases, waives, and forever discharges the other Party, its past, present and future successors in interest, assigns, officers, directors, employees, agents, stockholders, subsidiaries, Affiliates, insurers and underwriters, from any and all claims, demands, actions, liabilities and causes of actions, of every kind and character, whether asserted or unasserted, whether known or unknown, suspected or unsuspected, in law or in equity, arising from or relating to the Dispute, including, without limitation, any claims by FCI for breach of contract, patent infringement, or infringement, violation or misappropriation of any other intellectual property rights (the "Released Claims").

4.2 *Unknown Claims.* The Parties hereto expressly acknowledge and agree that this Agreement fully and finally releases and forever resolves the Released Claims, including those that are unknown, unanticipated or unsuspected or that may hereafter arise as a result of the discovery of new and/or additional facts, and each of the parties expressly, knowingly, and intentionally waives all rights, if any, under Section 1542 of the Civil Code of California, which the Parties each acknowledge they have read and understood and which provides as follows:

A GENERAL RELEASE DOES NOT EXTEND TO CLAIMS WHICH THE CREDITOR DOES NOT KNOW OR SUSPECT TO EXIST IN HIS FAVOR AT THE TIME OF EXECUTING THE RELEASE, WHICH IF KNOWN BY HIM MUST HAVE MATERIALLY AFFECTED HIS SETTLEMENT WITH THE DEBTOR.

Each Party also expressly, knowingly, and intentionally waive and relinquish any and all rights that they have under Section 1542, as well as under any other statutes, legal decisions or common law principles of similar effect.

Notwithstanding the foregoing waiver of any rights under Section 1542 of the Civil Code of California, and notwithstanding anything to the contrary in this Agreement, the parties understand and agree that this Agreement shall not be subject to any of the laws of the state of California, and that further the release effected by this Section 4 is not, and is not intended to be, a general release, and is instead confined to the terms expressly stated above.

#### 4.3 Covenant Not to Sue

(a) Each Party, on behalf of itself and its Affiliates, unconditionally and irrevocably covenants not to sue or initiate any action or proceeding against the other Party or its Affiliates, arising from or relating to any Released Claims; and

(b) FCI, on behalf of itself and its Affiliates, unconditionally and irrevocably covenants not to sue or initiate any action or proceeding against ASE or its Affiliates, arising from or relating to i) the future making, using, selling, importation, offer for sale, or other disposition by ASE or its Affiliates of any semiconductor packages that were made, used, sold, offered for sale, imported, or otherwise disposed of prior to the Effective Date, and future packages substantially similar thereto; or (ii) the future use by ASE or its Affiliates of any processes to make such packages that were used prior to the Effective Date, and future processes substantially similar thereto.

#### 4.4 Spheron Patent Application

Notwithstanding anything to the contrary in this Agreement, in the event that FCI determines that any future improvements to ASE's semiconductor packages, and/or future improvements to ASE's processes for making such packages (collectively, "ASE's Future Improvements") may be infringing some or any claims of any valid and enforceable patent issued from, or related to, International Application Number PCT/US2005/039008, and/or US application number 60/623,200 (both titled "Semiconductor Device Package With Bump Overlying A Polymer Layer") (collectively, the "Spheron Patent Application"), then in such case FCI shall give notice thereof to ASE, and the parties shall negotiate in good faith as to the terms of an appropriate written license agreement with respect thereto. FCI agrees that it shall offer to ASE license terms, individually and collectively, that are no less favorable than the terms of all other licenses then already granted by FCI with respect to any such patent (other than licenses in which the consideration provided to FCI consists substantially of equity or other ownership of a third party entity); provided, however, that nothing in this Agreement shall obligate ASE to accept a license under any such patents. For purposes of clarity, "ASE Future Improvements," as used in this Section 4.4 shall mean a significant change to the design, structure, materials, or manufacturing processes currently or previously used by ASE to make semiconductor packages, and shall not include insignificant changes such as changes in external package dimensions, pitch, number and location of solder bumps, bond pads, or solder balls, and the like.

## 5. License

5.1 FCI hereby grants to ASE and its Affiliates, effective as of March 1, 1999, a non-exclusive, perpetual (other than as to the Patents, the license to which shall be for the life thereof), non-transferable, worldwide, royalty-free, unrestricted, fully paid-up license, without the right to sub-license under the Licensed IP, to make, have made, use, sell, offer to sell, import, lease, export or otherwise dispose of products, and use and/or practice the Licensed IP.

5.2 Upon receipt by FCI of the final payment set forth in Section 6.1(d), the license granted pursuant to Section 5.1 above shall become permanent, non-terminable, and irrevocable.

5.3 Except as set forth in Section 5.1 above, no licenses or other rights are granted under any intellectual property rights of either Party.

### 5.4 U.S. Patent No. 6,825,568

In the event FCI determines in good faith that it has a reasonable business need for rights under U.S. Patent No. 6,825,568 (titled "Flip Chip Package Structure and Flip Chip Device With Area Bump"), owned by ASE, upon request by FCI, ASE agrees to then offer FCI a non-exclusive license, for no additional consideration, to make, have made, use, sell, offer to sell, import or otherwise dispose of products covered by such patent. Such license shall be personal to FCI, non-assignable, non-transferable, fully paid-up, and without the right to sublicense. In response to such request, the parties shall negotiate in good faith to finalize the terms of a license agreement consistent with the foregoing terms.

## 7. Duty to Hold Confidential Information in Confidence

7.1 ASE agrees not to disclose Confidential Information to any third party not authorized to receive such information, and to take such precautions to prevent disclosure of Confidential Information to such third parties to at least the same extent as are taken by ASE to safeguard its own proprietary information.

7.2 ASE agrees to limit disclosure of Confidential Information to those of ASE's employees, consultants, and contractors having a reasonable need to know such Confidential Information in order for ASE to practice the rights granted in accordance with this Agreement.

7.3 ASE's obligations pursuant to this Section 7 shall terminate after five (5) years from the Effective Date.

### **8. Non-Solicitation**

8.1 For a three (3) year period commencing on the Effective Date, neither Party will solicit for employment or consultation any current employee of the other Party, without the written consent of the other Party.

### **9. Indemnification**

9.1 FCI agrees to indemnify ASE and its Affiliates, and hold ASE and its Affiliates harmless, against any damages or claims by any third party for infringement of any patent, intellectual property, and/or other proprietary rights in the United States based on ASE's or its Affiliates' use of the Licensed Subject Matter, provided such claims arise from ASE's or its Affiliates' use of the Licensed IP or ASE's or its Affiliates' practice of the Licensed Subject Matter in accordance with the instructions provided by FCI, and provided further, however, that (a) FCI's obligation to indemnify ASE hereunder shall not exceed the amount of five hundred thousand U.S. dollars (U.S. \$ 500,000.00); and (b) ASE shall promptly notify FCI of such claim. Notwithstanding the foregoing, FCI shall provide all available records and documentation requested by ASE to support the defense of such claims or litigation, and that can be provided to ASE without waiver of any attorney-client or other applicable privilege. ASE has the right to utilize such records and documentation in the defense or settlement of such claims. ASE shall not settle any claim subject to indemnification by FCI without the consent of FCI.

9.2 ASE agrees to notify FCI in writing of any infringement claim or threatened infringement claim made known to ASE and/or asserted against ASE or its customers subject to indemnification by FCI pursuant to Section 9.1. ASE shall provide written notice within thirty (30) days of the date ASE receives notice of the existence or threat of such claim. ASE's failure to provide the thirty (30) day notice to FCI will cancel and nullify FCI's obligation to indemnify ASE, unless such failure does not prejudice FCI.

9.3 ASE agrees to indemnify and hold FCI harmless against product liability claims asserted by customers of ASE against FCI provided that such claim is attributed to ASE's fault.

9.4 Each Party shall indemnify the other Party and its Affiliates for any claims, liabilities, and damages arising from a breach of any representation or warranty by such Party, provided, however, that each Party's liability hereunder shall not exceed the amount of five hundred thousand U.S. dollars (U.S. \$ 500,000.00).

### **10. Confidentiality of License Terms**

10.1 The Parties agree that the terms of this Agreement shall not be disclosed to third parties; provided that either Party may issue a press release and/or advise third parties that FCI has granted ASE a non-exclusive, perpetual, worldwide license to practice the Flex-On-Cap, RDL Technologies, and Ultra CSP Process, and provided further that either party may disclose the terms of this Agreement within documents filed in a court in conjunction with a court proceeding brought to interpret and/or enforce the terms of this Agreement, or as may be compelled by a

court of competent jurisdiction, subject to notice to the other Party. Any press release shall be subject to review and approval by the other party and approval shall not be unreasonably withheld.

10.2 ASE may record this Agreement in the United States Patent and Trademark Office, provided Section 6 is redacted.

### ***11. Force Majeure***

11.1 Neither Party will be liable for nonperformance due to: a labor dispute, strike, war or act of war (whether an actual declaration is made or not), insurrection, riot, or civil commotion, act of public enemy, accident, fire, flood, acts of God, governmental action, supply of raw material, utility shortage, or a similar cause beyond each Party's reasonable control and through no fault or negligence of the Party prevented from meeting obligations. The Party prevented from meeting obligations will use reasonable effort to remedy the situation and neither Party will be liable for loss, damages, or costs caused by an inability to remedy the situation. The Party prevented from meeting obligations under this Agreement will promptly give written notice of the basis for invoking Force Majeure, the obligations which are suspended due to Force Majeure, identify remedial measures being taken and provide an estimate of the duration of the Force Majeure conditions.

### ***12. Termination***

12.1 This Agreement may not be terminated by either Party except due to a material breach by the other Party, which breach is not cured within sixty (60) days following written notice by the non-breaching Party.

12.2 This Agreement may not be terminated by FCI following receipt by FCI of the final payment pursuant to Section 6.1(d).

12.3 In the event this Agreement is terminated prior to receipt by FCI of the final payment pursuant to Section 6.1(d), such termination shall have the following effects:

(a) The terms and conditions of the License Agreements shall be reinstated, effective as of the Effective Date; and

(b) Any payments made under this Agreement shall be credited toward royalties owed under the License Agreements, reinstated as set forth above, if any.

(c) The difference between any amounts paid under this Agreement, and royalties owed under the License Agreements, shall be held on account by FCI and applied toward future royalties owed under the License Agreements. Any amount held on account by FCI after payment of all royalties owed under the License Agreements shall be reimbursed to ASE within thirty (30) days of termination of the last-to-terminate License Agreement.



### *13. Future License Rights*

13.1 In the event FCI believes that ASE or any Affiliate is infringing or violating any FCI intellectual property rights not covered by this Agreement, and that FCI is willing to license, it shall offer such intellectual property rights to ASE on commercially reasonable terms.

13.2 The Parties shall negotiate in good faith for a period of at least sixty (60) days to reach agreement with respect to a license under any such FCI intellectual property rights subject to Section 13.1.

13.3 No action, claim or proceeding may be brought by either Party relating to alleged violation or misappropriation of any FCI intellectual property rights subject to Section 13.1 prior to or during the period specified in Section 13.2 above, and any such action, claim or proceeding shall be deemed litigation arising out of or relating to this Agreement for purposes of Section 14.4 below.

### *14. Miscellaneous*

14.1 This Agreement may not be assigned or transferred by either Party, and all rights and licenses granted under this Agreement may not be transferred, assigned or alienated in whole or in part, without the prior written consent of the other Party.

14.2 All rights and licenses granted under this Agreement are binding on and enforceable against the successors, assigns and transferees of either Party. By way of example, and without limitation, the licenses granted under the Patents shall run with the Patents and be binding on any assignees, successors, or transferees of such Patents.

14.3 All terms and provisions of this Agreement shall be binding upon and inure to the benefit of the Parties hereto and their respective successors, assigns and transferees.

14.4 This Agreement shall be construed and the legal relations between the Parties determined in accordance with the laws of the State of Arizona. Any litigation arising out of or relating to this Agreement, the License Agreements, and/or the Licensed IP shall be brought solely in the state or federal courts of the State of Arizona. The Parties shall submit to the jurisdiction and venue of the courts of the State of Arizona regarding such litigation.

14.5 This Agreement supersedes all prior understandings, NDA's and/or licenses between the Parties and contains the entire agreement between the Parties concerning this subject matter.

14.6 Any notice required will be delivered by registered or certified mail, return receipt requested, postage prepaid, or by Federal Express, and will be addressed to each Party at the address first set forth above, or at any other address that either Party may subsequently specify in writing.

14.7 No modification or waiver of any portion of this Agreement shall be effective unless in writing and signed by both Parties.

14.8 In the event any provision of this Agreement is held invalid, illegal or unenforceable by a court of competent jurisdiction, that provision shall be severed from this Agreement and the remaining provisions shall continue in force.

14.9 The terms of this Agreement are the product of negotiation between the Parties and are not to be construed as being drafted solely by one Party, and no presumption is to arise therefrom in favor of either Party.

To indicate agreement to the terms and conditions of this Agreement, the Parties have had their designated representatives sign effective as of the date first set forth above.

**FLIPCHIP INTERNATIONAL, LLC (FCI)**

MARCH 11, 2008  
Date

By: 

Bob Forcier  
CEO

**ADVANCED SEMICONDUCTOR  
ENGINEERING, INC. (ASE)**

MARCH 10, 2008  
Date

By: 

Tien Wu  
COO

Schedule A

Patent/Publication Number	Title	Family Members
US 7,057,292 B1	Solder Bar For High Power Flip Chips	EP1305829 A4, WO0191183 A1
US 6,287,893 B2, US 6,441,487 B2, US 6,750,135 B2	Method For Forming Chip Scale Package	EP1036414 A4, JP2001521288T, US20010011764 A1, US20010031548 A1, WO9921226 A1, GB 9822505, GB 2331651, DE 19847528

Patent Publication Number	Title	US Number
US 7,126,164 B2	Wafer-Level Moat Structures	US 20050070083 A1 CN1906746 A, EP1665363 A4, KR20060963725, WO2005031807 A3
US 7,118,833 B2	Forming Partial-Depth Features in Polymer Film	US 20050069782 A1 CN1871555A, EP1664936A2, KR1020060103888 A, WO2005031458 A3
US 6,578,755 B1	Polymer Collar For Solder Bumps	EP1324851 A4 TW520561 WO2002024391 A1

Schedule B

Patent Publication Number	Title	Family Members
US 5,547,740	Solderable Contacts For Flip Chip Integrated Circuit Devices	
US 5,803,340	Composite Solder Paste For Flip Chip Bumping	
US 5,607,099	Solder Bump Transfer Device For Flip Chip Integrated Circuit Devices	
US 5,632,667	No Coat Backside Wafer Grinding Process	

### **Privacy Act Statement for Patent Assignment Recordation Form Cover Sheet**

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with the above request for information. This collection of information is authorized by 35 U.S.C. 1, 2, 261 and E.O. 9424. This information will primarily be used by the USPTO for the recordation of assignments related to patents and patent applications. Submission of this information is voluntary but is required in order for the USPTO to record the requested assignment. If you do not provide the information required on the cover sheet, the assignment will not be recorded, and all documents will be returned to you.

After the information is recorded, the records and associated documents can be inspected by the public and are not confidential, except for documents that are sealed under secrecy orders or related to unpublished patent applications. Assignment records relating to unpublished patent applications are maintained in confidence in accordance with 35 U.S.C. 122. Records open to the public are searched by users for the purpose of determining ownership for other property rights with respect to patents and trademarks.

Routine uses of the information you provide may also include disclosure to appropriate Federal, state, local, or foreign agencies in support of their enforcement duties and statutory or regulatory missions, including investigating potential violations of law or contract and awarding contracts or other benefits; to a court, magistrate, or administrative tribunal in the course of presenting evidence; to members of Congress responding to requests for assistance from their constituents; to the Office of Management and Budget in connection with the review of private relief legislation; to the Department of Justice in connection with a Freedom of Information Act request; to a contractor in the performance of their duties; to the Office of Personnel Management for personnel studies; and to the General Services Administration (GSA) as part of their records management responsibilities under the authority of 44 U.S.C. 2904 and 2906. Such disclosure to GSA shall not be used to make determinations about individuals.