

Filed: December 3, 2018

On behalf of:

**ASM IP Holding B.V.**

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UNITED STATES PATENT AND TRADEMARK OFFICE

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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**ASM IP HOLDING B.V.**

Petitioner,

v.

**KOKUSAI ELECTRIC CORPORATION**

Patent Owner

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IPR2019-00369

U.S. Patent 7,808,396

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**PETITIONER'S SUPPLEMENTAL MANDATORY NOTICE:  
RELATED MATTERS**

Pursuant to 37 C.F.R. § 42.8(a), Petitioner ASM IP Holding B.V. (“ASM”) updates its mandatory notice information regarding related matters to this petition for *inter partes* review of U.S. 7,808,396 (“the ’396 patent”). Specifically, ASM updates the Related Matters under 37 C.F.R. § 42.8(b)(2).

**I. RELATED MATTERS: PROCEEDINGS INVOLVING THE ’869, ’007, ’076 AND ’627 PATENTS**

On July 31, 2018, ASM filed a petition for IPR of U.S. 6,514,869 (“the ’869 patent”) in IPR2018-01479, which was purportedly owned by Hitachi Kokusai Electric Inc. (“Hitachi”). On November 21, 2018, Hitachi filed its preliminary response.

On August 7, 2018, ASM filed a petition for IPR of U.S. 7,622,007 (“the ’007 patent”) in IPR2018-01523, which was purportedly owned by Hitachi. On August 21, 2018, ASM filed a petition for IPR of U.S. 8,673,076 (“the ’076 patent”) in IPR2018-01561, which was also purportedly owned by Hitachi. The claims of the ’007 and ’076 patents are highly similar. On November 21, 2018, Hitachi filed its preliminary response in the ’007 case. Hitachi’s preliminary response in the ’076 case is due on December 10, 2018.

On August 22, 2018, ASM filed two Petitions for IPR of U.S. Patent No. 6,783,627 (the ’627 patent) in IPR2018-01582 and IPR2018-01584. The Petition in IPR2018-01582 challenges Claims 1-19 and 26-30 of the ’627 patent. The Petition in IPR2018-01584 challenges Claims 20-25 and 31-42 of the ’627 patent. These

two Petitions together challenge all claims of the '627 patent. The '627 patent is purportedly owned by Kokusai Semiconductor Equipment Corp.

The '869, '007, '076 and '627 patents were asserted against ASM International, N.V. in *Hitachi Kokusai Electric Inc. v. ASM International, N.V.*, C.A. No. 18-cv-00323 (D. Or.).

## **II. RELATED MATTERS: PROCEEDINGS INVOLVING THE '937, '063, '316, '988, '396, '023 AND '018 PATENTS**

On November 29, 2018, ASM filed a petition for IPR of U.S. 7,033,937 (“the '937 patent”) in IPR2019-00364, which is purportedly owned by Kokusai Electric Corp. (“Kokusai”). On November 30, 2018, ASM filed a petition for IPR of U.S. 6,576,063 (“the '063 patent”) in IPR2019-00375, which is also purportedly owned by Kokusai. The claims of the '937 and '063 patents are similar.

On November 30, 2018, ASM filed a petition for IPR of U.S. 9,318,316 (“the '316 patent”) in IPR2019-00371, which is purportedly owned by Kokusai. Also on November 30, 2018, ASM filed a petition for IPR of U.S. 8,409,988 (“the '988 patent”) in IPR2019-00378, which is also purportedly owned by Kokusai. The claims of the '316 and '988 patents are similar.

On November 30, 2018, ASM filed a petition for IPR of U.S. 7,808,396 (“the '396 patent”) in IPR2019-00369, which is purportedly owned by Kokusai.

On December 3, 2018, ASM filed a petition for IPR of U.S. RE43,023 (“the '023 patent”) in IPR2019-00393, which is purportedly owned by Kokusai.

On December 3, 2018, ASM filed a petition for IPR of U.S. 6,744,018 (“the ’018 patent”) in IPR2019-00392, which is purportedly owned by Kokusai.

The ’937, ’063, ’316, ’988, ’396, ’023 and ’018 patents were asserted against ASM International, N.V. in *Hitachi Kokusai Electric Inc. v. ASM International, N.V.*, C.A. No. 17-cv-06880 (N.D. Cal.).

### **III. RELATED MATTERS: PROCEEDINGS INVOLVING THE ’662, ’552 AND ’478 PATENTS**

On May 24, 2018, Hitachi filed a petition for IPR in IPR2018-01151 challenging several claims from U.S. 7,537,662 (“the ’662 patent”) owned by ASM. On September 5, 2018, ASM filed its preliminary response.

On July 13, 2018, Kokusai filed a petition for IPR in IPR2018-01357 challenging several claims from U.S. 7,833,352 (“the ’352 patent”) owned by ASM. On October 23, 2018, ASM filed its preliminary response.

On October 22, 2018, Kokusai filed a petition for IPR in IPR2019-00099 challenging several claims from U.S. 7,018,478 (“the ’478 patent”) owned by ASM. ASM’s preliminary response for the ’478 patent is due on February 8, 2019.

The ’662, ’352 and ’478 patents were asserted by ASM against Hitachi in *ASM IP Holding B.V. v. Hitachi Kokusai Elec., Inc.*, C.A. No. 17-cv-06879 (N.D. Cal.).

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: December 3, 2018

By: /Kerry Taylor/

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**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing  
**PETITIONER'S SUPPLEMENTAL MANDATORY NOTICE: RELATED  
MATTERS** is being served on December 3, 2018, via Priority Mail Express on  
counsel of record for U.S. Patent No. 7,808,396 as addressed below:

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Alexandria, VA 22320-4850

Dated: December 3, 2018

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