

**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 CORP.,  
Patent Owner.

Case No. IPR2019-00369

Patent No. 7,808,396

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**PATENT OWNER'S MANDATORY NOTICES  
PURSUANT TO 37 C.F.R. § 42.8(a)(2)**

Pursuant to 37 C.F.R. § 42.8(a)(2), Patent Owner submits the following mandatory notice information identified in 37 C.F.R. § 42.8(b).

**I. Real Parties-in-Interest (37 C.F.R. § 42.8(b)(1))**

Kokusai Electric Corp. is the Patent Owner in this matter.

The real parties-in-interest are Kokusai Electric Corp. (“Patent Owner”) (which is the English translation of the Japanese company Kabushiki-Kaisha Kokusai Electric), Kokusai Semiconductor Equipment Corp., and KKR HKE Investment LP.

**II. Related Matters (37 C.F.R. § 42.8(b)(2))**

The challenged patent was asserted against ASM International, N.V., the parent of the Petitioner (ASM IP Holding B.V.), in *Hitachi Kokusai Electric Inc. v. ASM International, N.V.*, No. 5-17-cv-06880 (N.D. Cal. Dec. 1, 2017). Patent Owner has asserted several U.S. Patents against Petitioner in that proceeding, and Petitioner has filed IPRs challenging the validity of those asserted patents. The following lists the asserted U.S. Patent Nos. (including the challenged patent) in that action and the respective IPR proceedings filed by ASM: 7,033,937 (IPR2019-00364), 6,576,063 (IPR2019-00375), 6,744,018 (IPR2019-00392), 7,808,396 (IPR2019-00369), 8,409,988 (IPR2019-00378), 9,318,316 (IPR2019-00371), and RE43023 (IPR2019-00393). On December 5, 2018, Petitioner added counterclaims asserting U.S. Patent Nos. 7,964,513, 7,771,533, and 7,998,883.

Patent Owner has asserted four patents against Petitioner in *Hitachi Kokusai Electric Inc. v. ASM International, N.V.*, No. 3:18-cv-00323 (D. Or. Feb. 20, 2018). Petitioner has filed IPRs on those asserted patents. The following lists the asserted U.S. Patent Nos. and the respective IPR numbers: 7,622,007 (IPR2018-01523), 8,673,076 (IPR2018-01561), 6,783,627 (IPR2018-01584 and IPR2018-01582), and 6,514,869 (IPR2018-01479).

Petitioner has asserted three patents against Patent Owner in *ASM IP Holding B.V. v. Hitachi Kokusai Elec., Inc.*, No. 3:17-cv-6879 (N.D. Cal. Dec. 1, 2017). Patent Owner has filed IPRs on those asserted patents. The following lists the asserted U.S. Patent Nos. and the respective IPR numbers: 7,833,352 (IPR2018-01357), 7,537,662 (IPR2018-01151), 7,018,478 (IPR2019-00099).

To date, no other judicial or administrative matters are known to Patent Owner that would affect, or be affected by, a decision in this IPR.

**III. Counsel (37 C.F.R. § 42.8(b)(3)) and Service Information (37 C.F.R. § 42.8(b)(3)-(4))**

Patent Owner designates Dion M. Bregman (Reg. No. 45,645) as lead counsel for this matter, and designates Michael J. Lyons (Reg. No. 37,386) and Jason E. Gettleman (Reg. No. 55,202) as back-up counsel for this matter.

Postal mailings and hand-deliveries for lead and back-up counsel should be addressed to: Morgan, Lewis & Bockius LLP, 1400 Page Mill Road, Palo Alto, CA 94304 (Telephone: 650.843.4000; Fax: 650.843.4001).

Pursuant to 37 C.F.R. § 42.8(b)(4), Patent Owner consents to e-mail service  
at: HIKE-IPR@morganlewis.com.

Respectfully Submitted,

Dated: December 21, 2018

/ Dion M. Bregman /  
Dion M. Bregman, Reg. No. 45,645

**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6(e)(4), lead counsel for Patent Owner hereby certifies that on December 21, 2018, a copy of this PATENT OWNER'S MANDATORY NOTICES was served via the email correspondence address of record for Petitioner's counsel of record:

Kerry S. Taylor  
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Respectfully Submitted,

Dated: December 21, 2018

/ Dion M. Bregman /  
Dion M. Bregman, Reg. No. 45,645