# UNITED STATES PATENT AND TRADEMARK OFFICE

### BEFORE THE PATENT TRIAL AND APPEAL BOARD

# CMI CORP. Petitioner

v.

# PATENT OF YOSHIHARU HIRAKATA and SHUNPEI YAMAZAKI

Patent Owner

CASE IPR2013-00068 PATENT 8,068,204

#### MANDATORY NOTICES BY PATENT OWNER UNDER 37 CFR § 42.8

Pursuant to 37 CFR § 42.8(a)(2), Patent Owner Semiconductor Energy Laboratory Co.,

Ltd., submits the following mandatory notices:

#### (1) Real Party-in-Interest

The real party-in-interest for the Patent Owner is Semiconductor Energy Laboratory Co., Ltd., a Japanese Corporation with its principal place of business located at 398, Hase, Atsugi-shi,

Kanagawa-ken, 243-0036 Japan.

OCKF

RM

The Board appears to have incorrectly identified Yoshiharu Hirakata and Shunpei Yamazaki as the Patent Owner in the caption of the NOTICE OF FILING DATE ACCORDED TO PETITION AND TIME FOR FILING PATENT OWNER PRELIMINARY RESPONSE mailed December 7, 2012. Mr. Hirakata and Dr. Yamazaki were inventors named in the patent but not the Patent Owner. However, Semiconductor Energy Laboratory Co., Ltd., is the Patent Owner and real party-in-interest, by virtue of an assignment recorded with the Patent and Trademark Office at reel 009581, frame 0943. See, MPEP § 306.

- 2 -

Accordingly, the Patent Owner requests correction of the caption and that future mailings properly reflect Semiconductor Energy Laboratory Co., Ltd., as the Patent Owner.

#### (2) Related Matters

U.S. Patent No. 8,068,204 was asserted against Petitioner Chi Mei Innolux in a civil action styled *Semiconductor Energy Laboratory Co., Ltd. v. Chimei Innolux Corp.*, et al., Case No. SACV 12-0021-JST (C.D. Cal).

The following U.S. application claims benefit of the priority of the '204 patent's filing date: U.S. Application Serial No. 13/304,660.

In addition, Inter Partes Review No. IPR2013-00066 was filed by Petitioner with respect to the parent U.S. Patent No. 7,876,413.

# (3) Lead and Back-up Counsel

Lead Counsel	Back-up Counsel
Mark J. Murphy	Edward D. Manzo
Reg. No. 34,225	Reg. No. 28,139
Husch Blackwell LLP 120 South Riverside Plaza, suite 2200 Chicago, Illinois 60606	Husch Blackwell LLP 120 South Riverside Plaza, suite 2200 Chicago, Illinois 60606
mark.murphy@huschblackwell.com (312) 526-1533 (voice) (312) 655-1501 (facsimile)	edward.manzo@huschblackwell.com (312) 526-1535 (voice) (312) 655-1501 (facsimile)

(4) Service

OCKF

R

Δ

Please address all correspondence in this matter to lead and backup counsel at the address

provided above.

Respectfully submitted,

Mark J. Murphy Reg. No. 34,225

Husch Blackwell LLP 120 South Riverside Plaza Chicago, Illinois 60606 (312) 526-1533

Customer No. 24628

# **CERTIFICATE OF SERVICE**

I certify that the foregoing MANDATORY NOTICES OF PATENT OWNER UNDER 37 CFR § 42.8 was served on the Petitioner by Federal Express Standard Overnight at the following addresses on December 19, 2012.

> Scott A. McKeown Oblon, Spivak, McClelland, Maier & Neustadt, L.L.P. 1940 Duke Street Alexandria, VA 22314

Gregory S. Cordrey Jeffer Mangels Butler & Mitchell LLP 3 Park Plaza, Suite 1100 Irvine, CA 92614-2592

Δ