

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SEMICONDUCTOR COMPONENTS INDUSTRIES, LLC d/b/a
ON SEMICONDUCTOR
Petitioner

v.

POWER INTEGRATIONS, INC.
Patent Owner

Case No. IPR2016-01600
Patent 7,834,605

**PETITIONER'S REVISED MANDATORY NOTICES
UNDER 37 C.F.R. § 42.8**

Pursuant to 37 C.F.R. § 42.8, Petitioner submits the following revised Mandatory Notices in support of the Petition for IPR of U.S. Patent 7,834,605.

I. MANDATORY NOTICES

Real Party in Interest: The real parties in interest are: (i) ON Semiconductor Corporation, (ii) Semiconductor Components Industries, LLC, doing business as ON Semiconductor, and — as of September 19, 2016 — (iii) Fairchild Semiconductor International, Inc., (iv) Fairchild Semiconductor Corporation, (v) Fairchild (Taiwan) Corporation, and (vi) System-General Corporation.

On November 18, 2015, ON Semiconductor Corporation, Falcon Operations Sub, Inc., and Fairchild Semiconductor International, Inc. (“Fairchild”) entered into an Agreement and Plan of Merger, which called for Falcon Operations Sub, Inc. to be merged with and into Fairchild, with Fairchild surviving as a wholly-owned subsidiary of ON Semiconductor Corporation. On August 25, 2016, ON Semiconductor Corporation received notice that the U.S. Federal Trade Commission (“FTC”) accepted a proposed consent order for public comment and terminated the Hart-Scott-Rodino waiting period applicable to the proposed merger with Fairchild. (See Exhibit 1011). On September 16, 2016, ON Semiconductor Corporation received confirmation that clearance related to the completion of its proposed merger from the Ministry of Commerce in the People’s Republic of China had been obtained and that ON Semiconductor was entitled to close the

transactions under the law of the People's Republic of China. (See Exhibit 1012). The merger was closed on September 19, 2016, at which time Falcon Operations Sub, Inc., which was previously identified as a real party in interest, was merged with and into Fairchild and ceased to exist. Fairchild and its subsidiaries had no role in the decision to file the Petition, the content of the Petition, or the preparation of the Petition. Fairchild and its subsidiaries did not contribute in any manner to the funding for the Petition. The following entities are identified as additional real parties in interest in this Revised Mandatory Notice, and became real parties in interest as of the close of the merger on September 19, 2016: Fairchild Semiconductor International, Inc., Fairchild Semiconductor Corporation, Fairchild (Taiwan) Corporation, and System-General Corporation. Fairchild Semiconductor International, Inc., Fairchild Semiconductor Corporation, Fairchild (Taiwan) Corporation, and System-General Corporation were not real parties in interest or a privy of Petitioner as of the filing of the Petition or at any time before the close of the merger on September 19, 2016.

Although System-General Corporation has not been a named party in litigation involving other patents owned by Patent Owner, System-General Corporation is named herein as a real party in interest because a defendant in a lawsuit entitled *Power Integrations, Inc. v. System General Corp.*, No. 5:04-cv-02851 (N.D. Cal.) was identified as "System General USA", and System-General

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Corporation is the existing legal entity that appears to be the closest match for the party that is described as "System General USA" in *Power Integrations, Inc. v. System General Corp.*, No. 5:04-cv-02851 (N.D. Cal.). Petitioner's investigation has not identified an entity with the name "System General USA."

Because the merger closed after the filing of the Petition, the identification of additional real parties in interest due to the closing of the merger has no bearing on the application of Section 315(b). In *Synopsys, Inc. v. Mentor Graphics Corp.*, Case IPR2012-00042, slip op. at 12 (PTAB February 22, 2014) (Paper 60), the Board held that the PTO rule implementing Section 315(b) "makes clear that it is only privity relationships up until the time a petition is filed that matter; any later-acquired privies are irrelevant." Similarly, when evaluating an alleged later-acquired real party-in-interest, the Board held that "it is only relationships up until the time a petition is filed that matter." *Id.* at 15. Similarly, in *Arris Group, LLC v. TQ Delta, LLC*, IPR2016-00430, Paper No. 9, at 7, the Board held that Section 315(b) "is concerned with privity relationships up until the time a petition is filed." At the time of the filing of the Petition, neither the Petitioner, nor any party then qualifying as a privy or real party in interest, had been served with a complaint alleging infringement of U.S. Patent No. 7,834,605.

Related Matters: The '605 Patent was involved in a lawsuit entitled *Power Integrations, Inc. v. Fairchild Semi. Int'l Inc.*, No. 1:08-cv-00309 (D. Del.) ("D.

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Del. Litigation”). The outcome of this lawsuit is pending appeal in *Power Integrations, Inc. v. Fairchild Semi. Int'l., Inc.*, No. CAFC-15-1329.¹ With respect to the above related matter, ON Semiconductor was not involved in any way with the matter before September 19, 2016.

ON Semiconductor has filed petitions for IPR against other patents held by Patent Owner, including U.S. Patent 6,107,851 (IPR2016-01598 and IPR2016-01599); U.S. Patent 6,212,079 (IPR2016-00809, IPR2016-01590, IPR2016-01592); U.S. Patent 6,538,908 (IPR2016-00995 and IPR2016-01597); U.S. Patent 6,249,876 (IPR2016-01588 and IPR2016-01589); and U.S. Patent No. 8,115,457 (IPR2016-01594 and IPR2016-01595).

Finally, in Patent Owner's Supplemental Mandatory Notices filed September 20, 2016 (Paper No. 11) in IPR2016-00809, Patent Owner identified IPR2016-01833, *Semiconductor Components Industries, LLC d/b/a ON Semiconductor v. In-Depth Test LLC*, because, according to Patent Owner, that proceeding “may raise an issue in common with the present IPR matter regarding application of a bar under 35 U.S.C. § 315(b) and the issue as to whether or not Fairchild Semiconductor Corporation is a real party in interest or a privy of Petitioner.” *Id.*

¹ Associated appeal *Power Integrations, Inc. v. Fairchild Semi. Int'l., Inc.*, No. CAFC-15-1388 was consolidated with No. CAFC-15-1329.

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