### 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 IPR2016-00809 Case IPR2016-00995 Case IPR2016-01589 Case IPR2016-01597

## PATENT OWNER POWER INTEGRATIONS' OPPOSITION TO MOTION TO STAY

DOCKET

## OPPOSITION TO MOTION TO STAY

## EXHIBIT LIST IPR2016-00809

| Exhibit No. | Description  |
|-------------|--|
| PI2001      | Intentionally omitted.   |
| PI2002      | Intentionally omitted.   |
| PI2003      | Intentionally omitted.   |
| PI2004      | Intentionally omitted.   |
| PI2005      | Completed verdict form, Dkt. No. 551, in Power Integrations, Inc.<br>v. Fairchild Semiconductor International, Inc. et al., Case No. 09-<br>cv-05235-MMC, N.D. Cal., dated Mar. 4, 2014.   |
| PI2006      | Completed damages verdict form, Dkt. No. 918, in Power<br>Integrations, Inc. v. Fairchild Semiconductor International, Inc. et<br>al., Case No. 09-cv-05235-MMC, N.D. Cal., dated Dec. 17, 2015.   |
| PI2007      | Trial testimony of Dr. Gu-Yeon Wei offered by Defendants, in<br>Power Integrations, Inc. v. Fairchild Semiconductor International,<br>Inc. et al., Case No. 09-cv-05235-MMC, N.D. Cal., on Feb. 20,<br>2014.   |
| PI2008      | Continued trial testimony of Dr. Gu-Yeon Wei offered by<br>Defendants, in Power Integrations, Inc. v. Fairchild Semiconductor<br>International, Inc. et al., Case No. 09-cv-05235-MMC, N.D. Cal.,<br>on Feb. 24, 2014.   |
| PI2009      | Trial testimony of Dr. Arthur Kelley offered by Patent Owner, in<br>Power Integrations, Inc. v. Fairchild Semiconductor International,<br>Inc. et al., Case No. 09-cv-05235-MMC, N.D. Cal., on Feb. 24,<br>2014  |
| PI2010      | Deposition of Balu Balakrishnan, In the Matter of: Certain power<br>supply controllers and products containing the same, Investigation<br>No. 337-TA-541, United States International Trade Commission,<br>from Oct. 25, 2005.   |
| PI2011      | Xunweu Zhou et al., "Improved Light Load Efficiency for<br>Synchronous Rectifier Buck Converter," in 1 Fourteenth Annual<br>Applied Power Electronics Conference and Exposition, IEEE, at<br>295 (2000) ("Zhou").  |
| PI2012      | U.S. Patent No. 4,459,651 to Fenter ("Fenter").  |
| PI2013      | U.S. Patent No. 4,772,995 to Gautherin et al. ("Gautherin").   |
| PI2014      | Fairchild's renewed motion for judgment as a matter of law, new<br>trial, and/or remittitur pursuant to Federal Rules of Civil Procedure<br>50 and 59, Dkt. No. 596, in Power Integrations, Inc. v. Fairchild<br>Semiconductor International, Inc. et al., Case No. 09-cv-05235- |

|        | MMC, N.D. Cal., filed Jun. 27, 2014.   |
|--------|--|
| PI2015 | Power Integrations' opposition to Fairchild's renewed motion for judgment as a matter of law, new trial, and/or remittitur, Dkt. No. |
|        | 601, in Power Integrations, Inc. v. Fairchild Semiconductor  |
|        | International, Inc. et al., Case No. 09-cv-05235-MMC, N.D. Cal.,   |
|        | filed July 18, 2014.   |
| PI2016 | Order re: Post-trial motions, Dkt. No. 632, in Power Integrations,   |
|        | Inc. v. Fairchild Semiconductor International, Inc. et al., Case No.   |
|        | 09-cv-05235-MMC, N.D. Cal., entered Sep. 9, 2014.  |
| PI2017 | Excerpts from Mohan et al., Power Electronics: Converters,   |
|        | Applications, and Design, 2d ed., John Wiley & Sons, Inc., 1995, pp. 161-172, 301-353, 571-595.                                      |
| PI2018 | Agreement and Plan of Merger, by and among ON Semiconductor  |
|        | Corporation, Falcon Operations Sub, Inc., and Fairchild  |
|        | Semiconductor International, Inc., dated as of Nov. 18, 2015, and  |
|        | filed with the Securities and Exchange Commission on same date.  |
| PI2019 | Complaint for Patent Infringement, in Power Integrations, Inc. v.  |
|        | Fairchild Semiconductor International, Inc. et al., Case No. 09-cv-  |
|        | 05235-MMC, N.D. Cal., filed Nov. 4, 2009.  |
| PI2020 | Joint Case Management Statement, Dkt. No. 38, in Power   |
|        | Integrations, Inc. v. Fairchild Semiconductor International, Inc. et al., Case No. 09-cv-05235-MMC, N.D. Cal., filed Feb. 26, 2010.  |
| PI2021 | Excerpts from Gray et al.," Analysis and Design of Analog  |
|        | Integrated Circuits, 3d. Ed., John Wiley & Sons, Inc., 1993, pp. 59-<br>66.  |
| PI2022 | Press release by Fairchild, "Fairchild Announces Successful  |
|        | Completion of Tender Offer for System General," dated Feb. 8, 2007.  |
| PI2023 | Tender Offer Statement, filed with the United States Securities and  |
|        | Exchange Commission, dated Feb. 19, 2016.  |
| PI2024 | Tender Offer Statement, filed with the United States Securities and  |
|        | Exchange Commission, dated June 24, 2016.  |
| PI2025 | Press Release by ON Semiconductor, "ON Semiconductor to  |
|        | Acquire Fairchild Semiconductor for \$2.4B in Cash," dated Nov. 18, 2015.  |
| PI2026 | Confidentiality Agreement, between ON Semiconductor Corp. and  |
|        | Fairchild Semiconductor International, Inc., Sep. 14, 2015, filed  |
|        | with the Securities and Exchange Commission as Exhibit $(d)(2)$ to a   |
|        | Tender Offer Statement filed Dec. 4, 2016.   |

## OPPOSITION TO MOTION TO STAY

| PI2027 | Transcript of Teleconference between the Board and Parties on July 13, 2016    |
|--------|--|
| PI2028 | Declaration of Howard G. Pollack in Support of Patent Owner's                  |
|        | Motion for Pro Hac Vice Admission's  |
| PI2029 | Declaration of Frank E. Scherkenbach in Support of Patent                      |
|        | Owner's Motion for Pro Hac Vice Admission                                      |
| PI2030 | Deposition of Dr. Vijay Madisetti conducted on Nov. 16, 2016 in IPR2016-00809. |
| PI2031 | Declaration of William Bohannon.   |
| PI2032 | Declaration of David Michael Matthews.   |
| PI2033 | E-mail correspondence between counsel in IPR2016-00809                         |
|        | regarding Petitioner's disclosure of merger closing before trial institution.  |
| PI2034 | Patent Owner e-mail request to Board for permission to file motion             |
|        | for discovery related to privity issue sent Nov. 2, 2016.                      |
| PI2035 | One Watt Initiative: A Global Effort to Reduce Leaking Electricity,            |
|        | Meier & LeBot (1999).  |
| PI2036 | President Bush Executive Order 13221. [Power Integrations, Inc. v.             |
|        | Fairchild Semiconductor International, Inc. et al., Case No. 09-cv-            |
|        | 05235-MMC, N.D. Cal., admitted trial exhibit PX-1819]                          |
| PI2037 | Meier, "Reducing Leaking Electricity to a Trickle," Home Energy                |
|        | Magazine Online May/June 1999. [Power Integrations, Inc. v.                    |
|        | Fairchild Semiconductor International, Inc. et al., Case No. 09-cv-            |
|        | 05235-MMC, N.D. Cal., admitted trial exhibit PX-1895]                          |
| PI2038 | Reducing Standby Power Consumption, Tso-Min Chen (System                       |
|        | General). [Power Integrations, Inc. v. Fairchild Semiconductor                 |
|        | International, Inc. et al., Case No. 09-cv-05235-MMC, N.D. Cal.,               |
|        | admitted trial exhibit PX-1833]  |
| PI2039 | "W the Vampire Slayer," Richard Miniter, Wall Street Journal,                  |
|        | Aug. 17, 2001. [Power Integrations, Inc. v. Fairchild                          |
|        | Semiconductor International, Inc. et al., Case No. 09-cv-05235-                |
|        | MMC, N.D. Cal., admitted trial exhibit PX-1900]                                |
| PI2040 | Datasheet for TOP242-249 TOPSwitch®-GX Family: Extended                        |
|        | Power, Design Flexible, EcoSmart®, Integrated Off-line Switcher,               |
|        | Nov. 2005. [Power Integrations, Inc. v. Fairchild Semiconductor                |
|        | International, Inc. et al., Case No. 09-cv-05235-MMC, N.D. Cal.,               |
|        | admitted trial exhibit PX-0121]  |
| PI2041 | Power Integrations press release for TOPSwitch®-GX. [Power                     |
|        | Integrations, Inc. v. Fairchild Semiconductor International, Inc. et           |

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|        | al., Case No. 09-cv-05235-MMC, N.D. Cal., admitted trial exhibit     |
|--------|--|
|        | PX-1669]   |
| PI2042 | Power Integrations press release on analogZone award for DAK-32.     |
|        | [Power Integrations, Inc. v. Fairchild Semiconductor International,  |
|        | Inc. et al., Case No. 09-cv-05235-MMC, N.D. Cal., admitted trial     |
|        | exhibit PX-0278]   |
| PI2043 | Datasheet for TOP232-234 TOPSwitch®-FX Family Power, July            |
|        | 2001 [Power Integrations, Inc. v. Fairchild Semiconductor            |
|        | International, Inc. et al., Case No. 09-cv-05235-MMC, N.D. Cal.,     |
|        | admitted trial exhibit PX-0123]                                      |
| PI2044 | SG6841 Datasheet. [Power Integrations, Inc. v. Fairchild             |
|        | Semiconductor International, Inc. et al., Case No. 09-cv-05235-      |
|        | MMC, N.D. Cal., admitted trial exhibit PX-0118]                      |
| PI2045 | List of all Fairchild products found to infringe the '079 patent.    |
|        | [Power Integrations, Inc. v. Fairchild Semiconductor International,  |
|        | Inc. et al., Case No. 09-cv-05235-MMC, N.D. Cal., admitted trial     |
|        | exhibit PX-1894]   |
| PI2046 | Application Note AN4148: Audible Noise Reduction Techniques          |
|        | for FPS Applications, Fairchild Semiconductor, © 2005. [Power        |
|        | Integrations, Inc. v. Fairchild Semiconductor International, Inc. et |
|        | al., Case No. 09-cv-05235-MMC, N.D. Cal., admitted trial exhibit     |
|        | PX-1593]   |
| PI2047 | William Bohannon, curriculum vitae.                                  |
| PI2048 | Patent Owner's Submitted Translation of Oda.                         |
| PI2049 | Energizer No. E91 Datasheet.   |
| PI2050 | Everready Lithium L91 Application Manual, Nov. 6, 2001.              |
| PI2051 | Cambridge Dictionary, "function." Retrieved November 18, 2016        |
|        | from http://dictionary.cambridge.org/us/dictionary/english/function  |
| PI2052 | "Function." Merriam-Webster.com. Merriam-Webster, n.d. Web.          |
|        | 17 Nov. 2016. (https://www.merriam-webster.                          |
|        | com/dictionary/function)   |
| PI2053 | function. (n.d.). Dictionary.com Unabridged. Retrieved November      |
|        | 18, 2016 from Dictionary.com website                                 |
|        | http://www.dictionary.com/browse/function                            |
| PI2054 | Trial testimony given on Dec. 8, 2015 (Volume 2) in Power            |
|        | Integrations, Inc. v. Fairchild Semiconductor International, Inc. et |
|        | al., Case No. 09-cv-05235-MMC, N.D. Cal.                             |
| PI2055 | Trial testimony given on Dec. 9, 2015 (Volume 3) in Power            |
|        | Integrations, Inc. v. Fairchild Semiconductor International, Inc. et |

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