

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UPI SEMICONDUCTOR CORPORATION, Petitioner,

v.

FORCE MOS TECHNOLOGY CO., LTD., Patent Owner.

Inter Partes Review No. IPR2025-00920

U.S. Patent 7,812,409

DECLARATION OF CATHERINE TSENG

DECLARATION OF CATHERINE TSENG

I, Catherine Tseng, declares as follows:

1. I am a citizen of the Republic of China (ROC), residing in Hsinchu County, Taiwan, ROC.
2. Unless otherwise stated herein, I have personal knowledge of the facts and circumstances provided herein, and if called upon to testify, I could and would testify competently to the statements made herein.
3. I am Legal Manager of Legal & IP Department at uPI Semiconductor Corporation (“uPI”).
4. I have a Bachelor of Laws (LL.B.) degree from Chiao Tung University School of Law (now National Yang Ming Chiao Tung University School of Law), Taiwan, ROC.
5. As Manager of Legal & IP Department, my responsibilities include managing all matters that touch on legal issues in which uPI is involved anywhere in the world, engaging and working with outside counsels, and coordinating necessary activities within uPI to support uPI’s claims or defenses in such matters.
6. uPI is a company organized and incorporated under the laws of Taiwan, ROC.
7. uPI’s common stock is listed on the Taiwan Stock Exchange.

8. ASUSTek (“ASUS”) is a minority shareholder of uPI, owning about 20% of uPI’s common stock.

9. The chairman and two directors serving on uPI’s Board of Directors (collectively, “ASUS-affiliated directors”) are believed also corporate officers of ASUS.

10. uPI and ASUS operate independently of each other.

11. The ASUS-affiliated directors are not involved in uPI’s day-to-day operations.

12. uPI is a supplier of electronic circuits or components (“uPI Products”), including a type of power electronic devices that are referred to in the electronic industry as “trenched MOS field-effect transistors” (“trenched MOSFETs”).

13. uPI Products are typically components that are incorporated into circuit boards by end-users (“Customers”).

14. uPI Products are not sold directly to Customers, but to distributors; Customers purchase uPI products from the distributors.

15. ASUS is among more than 300 Customers who regularly purchase uPI Products -- including trench MOSFETs -- from uPI’s distributors.

16. Like any uPI Customer purchasing uPI Products through uPI distributors, ASUS does not receive any preferential treatment from uPI over the other Customers.

17. uPI has agreements with its distributors to indemnify their Customers against specified injuries, including injuries arising from infringement by a uPI Product of a third-party patent.

18. I believe that most – if not all -- of uPI's distributors have agreements with their Customers to indemnify their Customers of substantially the same injuries covered by uPI's indemnification agreements with the distributors.

19. Upon the request by a Customer who has purchased uPI Products from a distributor, uPI will issue the Customer a "Letter of Indemnification," so as to assure and to inform the Customer that uPI will step into the shoes of its distributors under the terms, conditions and scope of uPI's indemnification specified in the Letter of Indemnification.

20. The terms, conditions and scope set forth in uPI's Letter of Indemnification are believed to be standard and customary in the industry, i.e., believed to be not different in any material manner from those offered by uPI's competitors.

21. uPI's Letter of Indemnification does not obligate uPI to file any *Inter Partes Review* against any third-party patent in the U.S. Patent and Trademark Office.

22. On May 9, 2024, Stanley Wu, a uPI sales representative, brought to my attention an email message ("ASUS Notification Email") that was sent to Stanley earlier that day.

23. The ASUS Notification Email (Ex. 1011) was sent by Michelle Hsu, Director of Legal Affairs Center at ASUS, and was addressed to Stanley Wu and Ann Chang (another uPI sales representative).

24. In the ASUS Notification Email, Ms. Hsu provided ASUS's "formal notice" to uPI that Force MOS Technology ("Force MOS") had identified two uPI trench MOSFETs (QM3016AM and QM3058M6) to be infringing three Force MOS patents, including the '409 Patent.

25. Attached to the ASUS Notification Email is a document (Ex. 1012) entitled "Plaintiff's First Amended Infringement Contention Claim Chart for U.S. Patent No. 7,812,409."

26. On the same day (May 9, 2024), Stanley Wu introduced me to Ms. Hsu

27. In subsequent email messages with Ms. Hsu on May 9, 2024 or shortly thereafter, I learned for the first time:

- a. the case *Force MOS Technology Co., Ltd. v. ASUSTeK Computer, Inc.*, Case No. 2:22-cv-00460-JRG (“EDTX litigation”), in the U.S. District Court, Eastern District of Texas;
- b. Ex. 1012 was served on ASUS on May 8, 2024, as part of Force MOS’s infringement contentions;
- c. Force MOS’s infringement contentions named 9 trenched MOSFETs, supplied by uPI and 6 other suppliers (collectively, “Supplier Group”); and
- d. ASUS notified by email members of the Supplier Group on May 9, 2024, believed individually and simultaneously, except the two whose products were named in Force MOS’s Complaint filed at the beginning of the EDTX litigation.

28. As my office is charged with handling all legal affairs at uPI, I believe what I learned from Ms. Hsu the first time on May 9, 2024 were also not previously known by others at uPI.

29. On May 30, 2024, uPI issued ASUS its customary Letter of Indemnification (Ex. 1013).

30. The Letter of Indemnification issued to ASUS on May 30, 2024 is substantially the same as that uPI would issue to any other uPI Customer.

31. In the EDTX litigation, the Supplier Group reimburses ASUS for all fees and costs expended, pro-rated among members of the Supplier Group, based solely on the number of accused infringement counts on their respective products.

32. Since May 9, 2024, from time to time, the Supplier Group receives updates regarding the EDTX litigation from ASUS's outside counsel, Charles McMahon; these updates include the email messages from Charles McMahon on December 4, 2024 and February 15, 2025 (believed to be Exs. 2007 and 2008).

33. In January, 2025, Force MOS withdrew its infringement contentions against two members of the Supplier Group; subsequently, the reimbursement scheme is reset on the same previous basis among the remaining members of the Supplier Group.

34. Thus, in the EDTX litigation, uPI receives the same treatment as any other member in the Supplier Group.

35. It was after May 9, 2024 that I became aware of the *inter partes* review ("Inergy IPR"; IPR2024-00094), which was filed on

October 27, 2023 by Inergy Technology, Inc.; Inergy Technology, Inc. is another supplier of trench MOSFETs.

36. uPI did not participate at any time in the funding, directing or controlling of the preparation, filing, or any subsequent prosecution of the Inergy IPR.

37. By the time I learned about the EDTX litigation, Markman Hearing was already held on April 11, 2024, a *Sotera* stipulation was already filed in the Inergy IPR by Inergy on April 17, 2024, and close of fact discovery was set less than 2 weeks on May 20, 2024, I felt that uPI - as merely one of 7 suppliers of the Supplier Group – was not given a meaningful chance of preparing and presenting non-infringement and invalidity defenses.

38. I was not aware of, nor was uPI served, Patent Owner's Request for Production of December 6, 2023.

39. On February 7, 2025, a jury trial began in the EDTX litigation.

40. A jury verdict was entered on February 13, 2025 in the EDTX litigation, in which the jury found infringement of the '409 Patent by uPI's QM3016AM trench MOSFET.

41. Throughout the EDTX litigation, Force MOS did not name uPI as a defendant; in that regard, Force MOS did not name as defendant any member of the Supplier Group.

42. Since the jury verdict, many uPI Customers have requested for Letters of Indemnification for the trenched MOSFETs involved in the EDTX litigation.

43. I am concerned that, even with uPI's Letters of Indemnification in hand, many uPI Customers, including ASUS, may prefer to purchase trenched MOSFETs from other suppliers not involved in the EDTX litigation over uPI's trenched MOSFETs.

44. Thus, in March 2025, I engaged separate outside counsels to prepare and to file an *inter partes review* (IPR) on the '409 Patent.

45. Under my sole direction, and without funding, direction, or control from ASUS or from any other members of the Supplier Group, uPI's separate outside counsels filed this IPR (IPR2025-00920) on April 24, 2025 on behalf of uPI.

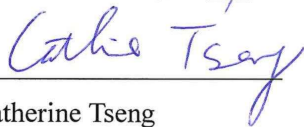
46. I had no knowledge of the prior art asserted in this IPR against the claims of the '409 Patent until after uPI engaged its separate outside counsels in March, 2025; I became aware of the prior art only shortly before the filing of this IPR on April 24, 2025.

47. I had kept uPI's preparation for filing of this IPR on a need-to-know basis; I am not aware that any person or entity knowledgeable of uPI's preparation for filing of this IPR had learned of the prior art asserted in the claims of the '409 Patent prior to filing of this IPR on April 24, 2025.

48. I have no knowledge as to whether ASUS, Inergy, or anyone who is related to the filing of the Inergy IPR, knew of the prior art asserted against the claims of the '409 Patent in this IPR.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on August 27, 2025 in Hsinchu County, Taiwan, Republic of China


Catherine Tseng