From:	Nicholas T. Matich
To:	Trials
Cc:	Fulghum, Roger; Daniel Anderson; Barazesh, Ellyar; Speegle, Mark; Greenthread-OnSemi-MS
Subject:	Request for Exception from 37 C.F.R. § 42.23(b) IPR2023-01242, IPR2023-01243, IPR2023-01244
Date:	Friday, August 30, 2024 1:56:01 PM

IPR2023-01242, IPR2023-01243, IPR2023-01244

Your Honors,

After Greenthread (the Patent Owner) filed its POR, additional highly relevant testimony became available in parallel district court actions. One of the Defendants made admissions contrary to Petitioners' theory here (and its own similar theory in the parallel IPRs). *See, e.g., Texas Instruments Inc. v. Greenthread LLC,* IPR2024-00771 Paper 16 at 7 (July 22, 2024) (citing Exhibit 2022). That evidence was public and of record in certain parallel Board proceedings before Petitioner's reply. As Petitioner represented to the District Court, this new evidence "become[s] part of the prosecution history" of the Challenged Patents which the Board should consider. *Greenthread LLC* v. *On Semiconductor Corp. et al*., 23-443 (D. Del.) Dkt. No. 53 at 6. Furthermore, the fact that another major semiconductor company who filed petitions highly similar to Petitioner's admits the flaw in their common invalidity theory is objective evidence of non-obviousness. *Vulcan Eng'g Co. v. Fata Aluminium, Inc.*, 278 F.3d 1366, 1373 (Fed. Cir. 2002) ("Appreciation by contemporaries skilled in the field of the invention is a useful indicator of whether the invention would have been obvious…"). Greenthread requests to make this additional evidence, which did not exist at the time of Greenthread's POR, of record to these proceedings and address the evidence in its sur-reply, notwithstanding 37 C.F.R. § 42.23(b).

If a call with the Board would be helpful, the parties can provide their availability.

Petitioner OnSemi's Position:

Patent Owner's request should be denied under 37 C.F.R. § 42.23(b), which prohibits Patent Owner from submitting additional evidence with its Sur-Reply other than deposition transcripts of reply witness cross-examination. While the Board is permitted to waive the provisions of § 42.23(b), it may only do so "in the interest of resolving [a] proceeding in a just, speedy, and inexpensive manner." *Liquidia Tech. v. United Therapeutics Corp.*, IPR2021-00406, Paper 50 at 5 (PTAB March 3, 2022); 37 C.F.R. §§ 42.5(b), 42.1(b). Greenthread does not explain why granting its request would advance "the interest of resolving [a] proceeding in a just, speedy, and inexpensive manner," and—on its face—Greenthread's introduction of untimely new evidence would not serve that interest. Greenthread has not identified the "additional evidence" it seeks to introduce into the present proceedings (IPR2023-01242, -01243, and -01244), but the citation to Exhibit 2022 from IPR2024-00771 suggests that Greenthread seeks to introduce the same Exhibit 2022 in these IPRs. If Exhibit 2022 in the -00771 IPR is what Greenthread seeks to admit, that would be improper because this exhibit includes testimony from an unrelated party in a proceeding that does not involve onsemi as a party. Because onsemi did not sponsor or endorse the testimony in any way, and onsemi did not have an opportunity to cross examine the witness at issue, Exhibit 2022 from the -00771 IPR is inadmissible hearsay that cannot be used in onsemi's IPRs. Greenthread has not identified any hearsay exception that would apply to this third-party testimony.

A request to admit Exhibit 2022 from IPR2024-00771 is also untimely because the testimony was (apparently) obtained by Greenthread on June 7, 2024, almost three months ago. If this testimony was particularly relevant, then Greenthread should have sought to have it considered in this proceeding months ago, which would have given onsemi a fair chance to address the testimony in its

Petitioner's Replies (filed on August 12). Allowing Greenthread to belatedly introduce this evidence now, when it has been in Greenthread's possession for months, would be prejudicial to onsemi and would reward Greenthread's delay.

Finally, Greenthread's statement that "Petitioner represented to the District Court [] this new evidence 'become[s] part of the prosecution history' of the Challenged Patents which the Board should consider" is wrong factually and as a matter of law. What Petitioner represented to the District Court was that ***patent owner's statements*** (i.e., statements by Greenthread) in IPR proceedings become part of the prosecution history. *See Greenthread LLC* v. *On Semiconductor Corp. et al*., 23-443 (D. Del.) Dkt. No. 53 at 6 (quoting *Aylus Networks, Inc. v. Apple Inc.*, 856 F.3d 1353, 1364 (Fed. Cir. 2017)). Testimony from third parties does not become part of the prosecution history, and this is not a basis to allow Greenthread to ignore 37 C.F.R. § 42.23(b).

Sincerely,

Nick Matich

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