UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SEMICONDUCTOR COMPONENTS INDUSTRIES, LLC and TEXAS INSTRUMENTS INCORPORATED,
Petitioner,
v.

GREENTHREAD, LLC,
Patent Owner

IPR2023-01242[1]
U.S. Patent No. 11,121,222

PETITIONER'S RESPONSIVE POST-REMAND BRIEF

[1] Texas Instruments Incorporated, which filed a petition in IPR2024-00673, has been joined as a petitioner in this proceeding.

TABLE OF CONTENTS

I. BACKGROUND 3
II. LEGAL STANDARD 5
III. ARGUMENT 6
a. onsemi and Intel Are Not Privies 6
1. The Intel litigation did not involve onsemi products 6
2. onsemi had no ability to control and did not control the Intel litigation 9
3. Greenthread does not have "some evidence" that onsemi is in privity with Intel 10
b. Greenthread's criticism of Mr. Muphy's testimony is baseless 11
1. Mr. Murphy did not admit a lack of knowledge 12
2. Mr. Murphy performed an adequate investigation 12
3. Narrowly tailored instruction not to answer were proper 14
4. Mr. Murphy appropriately consulted onsemi's legal department 14
5. Semiconductor Components Industries **is** Petitioner onsemi 14
IV. CONCLUSION 15

Discovery has confirmed what Semiconductor Components Industries, LLC ("Petitioner" or "onsemi") has maintained throughout: Intel and onsemi are not in privity. The evidence is undisputed that "onsemi does not currently and has never sold any of the Intel Accused Products"[2] and "onsemi does not currently and has never sold any component of the Intel Accused Products." EX2103 (Second Murphy Dec'l), ¶7. Because there is no evidence of any connection between onsemi and that prior litigation, the Board should reinstate its February 2025 Final Written Decision finding all challenged claims unpatentable.

The evidentiary record shows that all of Greenthread's speculation about privity between onsemi and Intel is baseless. Greenthread does not (and cannot) dispute that onsemi was not aware of the Intel litigation until Friday, April 21, 2023, when Greenthread sued onsemi. EX2103, ¶¶9-10. Because the Intel litigation was dismissed the very next Monday, April 24, 2023, as a matter of timing, it would have been impossible for onsemi to be involved in the Intel litigation, much less exercise any control over it. The record also shows that onsemi does not supply the Intel Accused Products or components thereof. Tellingly, Greenthread has never

---

[2] The "Intel Accused Products" are the products "listed on pages 4–8 of IPR1242, Exhibit 2048, which are the Intel 'products accused of practicing the challenged claims' in Patent Owner's prior litigation." Paper 111, 10 n. 5.

identified an onsemi part that it contends is a component of an Intel Accused Product. Because onsemi was not involved in the Intel litigation and because no onsemi parts were at issue, depriving onsemi of its day in court as a supposed privy of Intel would be fundamentally unfair. *See WesternGeco LLC v. ION Geophysical Corp.*, 889 F.3d 1308, 1319 (Fed. Cir. 2018) ("But, importantly, the reach of privity cannot extend beyond the limits of due process.").

Greenthread's criticism of onsemi's proffered evidence is meritless. As ordered by the Board, onsemi produced evidence confirming that there are no sales agreements or indemnification agreements "between Petitioner and Intel for the Intel Accused Products." Paper 111, 10; EX2103, ¶7. No such documents exist because "onsemi has never sold any of the Intel Accused Products or any component of any of the Intel Accused Products to Intel (or to anyone else)." *Id*. Setting the facts aside, Greenthread nonetheless argues that onsemi (and onsemi's declarant, Mr. Matt Murphy) should have done more investigation to establish that onsemi has never sold components of the Intel Accused Products. *See* Paper 117, 6-13. This argument misstates the factual record: as onsemi's Vice President of Sales, Americas — with 25 years of experience with the company — Mr. Murphy is familiar with onsemi's product offerings, and he knows that "[n]one of the parts we sell would be part of a[n] Intel CPU." EX2104, 26:9-13; *see also* EX2103, ¶¶ 3, 7.

I. BACKGROUND

Without any notice, Greenthread sued onsemi on April 21, 2023. onsemi filed IPR petitions against the asserted patents three months later ("the first wave IPRs"). EX2020 (Complaint filed April 21, 2023); Paper 2 (Petition filed July 27, 2023). In December 2023, onsemi filed additional IPR petitions challenging related patents. *See* IPR2024-00263, -00264, -00265, and -00266 ("the second wave IPRs"). In April 2025, the Director granted in part Greenthread's Request for Director Review and remanded the first wave IPRs back for additional discovery on the purported privity between onsemi and Intel. *See e.g.*, IPR2023-01242, Paper 94. Accordingly, the Board ordered onsemi to provide discovery on sales and indemnification agreements "for the Intel Accused Products" (or a declaration showing that those do not exist), "the time by which Petitioner became aware of the Intel litigation," whether onsemi supplied "any product, or component of a product, accused of infringement in the Intel litigation," and whether onsemi controlled or was in a position to control "Intel's defense of that litigation." Paper 111, 10.

As the Board instructed, onsemi provided a declaration from its Vice President of Sales, Americas, Mr. Matthew Murphy. EX2103. Mr. Murphy has been "employed by onsemi and its predecessor company in various positions for more than twenty-five years," and is "familiar with onsemi's product portfolio and

sales of onsemi's products to a wide variety of companies," including Intel. *Id*., ¶4. Mr. Murphy confirmed that onsemi has no responsive documents to produce:

> Because onsemi has never sold any of the Intel Accused Products or any component of any of the Intel Accused Products to Intel (or to anyone else), I can confirm that onsemi has never signed and does not possess any customer agreements, sales agreements, indemnification agreements, or any other documents concerning the sale of the Intel Accused Products.

Id., ¶7. Mr. Murphy also confirmed that onsemi did not receive an indemnification demand from Intel, and that onsemi only become aware of Greenthread's prior litigation with Intel when Greenthread sued onsemi on April 21, 2023, one business day before the Intel litigation was dismissed. *Id*. ¶¶8-10. Mr. Murphy also consulted with onsemi's legal department to confirm that onsemi did not receive an indemnification demand from Intel and the date when onsemi became aware of the Intel litigation. *Id*.

Greenthread deposed Mr. Murphy on July 23, 2025. Mr. Murphy testified that "[n]one of the products listed in Exhibit 2048 [(Greenthread's infringement contentions against Intel)] are onsemi products." EX2104, 25:15-21. Mr. Murphy also repeatedly explained that the Intel Accused Products do not include any onsemi parts or components. *See e.g.*, *id*., 26:9-13 ("None of the parts we [(onsemi)] sell would be part of a[n] Intel CPU."), 33:20-34:8 ("Q: As you sit here today testifying under penalty of perjury, can you tell me definitively whether any of the products listed on Pages 4 through 8 of Exhibit 2048, include an 2 onsemi part or product? A:

I can confirm they do not."), 35:14-19 ("I can confirm that onsemi does not currently and has never sold any of the Intel accused products. And I can confirm that onsemi does not currently and has never sold any component of the Intel accused products."), 36:15-17 ("I do not sell any of these accused products or any component of those products to Intel."), 83:6-12 ("Q: […] Do you know whether the Intel Atom C2308 in fact included onsemi or Semiconductor Components Industries, LLC parts or elements? […] [A:] I know that it does not include components of onsemi or Semiconductor Components Industries, LLC.").

II. LEGAL STANDARD

"Privity" refers to certain limited exceptions to the "deep-rooted historic tradition that everyone should have his own day in court." *Taylor v. Sturgell*, 553 U.S. 880, 892–93 and 894 n.8 (2008) (quotation omitted). For IPRs, the privity analysis "seeks to determine whether the relationship between the purported 'privy' and the relevant other party is sufficiently close such that both should be bound by the trial outcome and related estoppels." PTAB Consolidated Trial Practice Guide, November 2019 ("TPG") at 14-15. Consistent with this directive, it is established that "a manufacturer-customer relationship alone does not establish privity, even with indemnity provisions." *Samsung Electronics Co. Ltd. v. Netlist Inc.*, IPR2022-00615, Paper 64 at 23 (PTAB, June 30, 2023) (citation omitted). Instead, "the privity inquiry in this context naturally focuses on the relationship between the named IPR

petitioner and the party in the prior lawsuit." *WesternGeco*, 889 F.3d at 1319. "For example, it is important to determine whether the petitioner and the prior litigant's relationship—as it relates to the lawsuit—is sufficiently close that it can be fairly said that the petitioner had a full and fair opportunity to litigate the validity of the patent *in that lawsuit*." *Id*. (emphasis added).

III. ARGUMENT

a. onsemi and Intel Are Not Privies

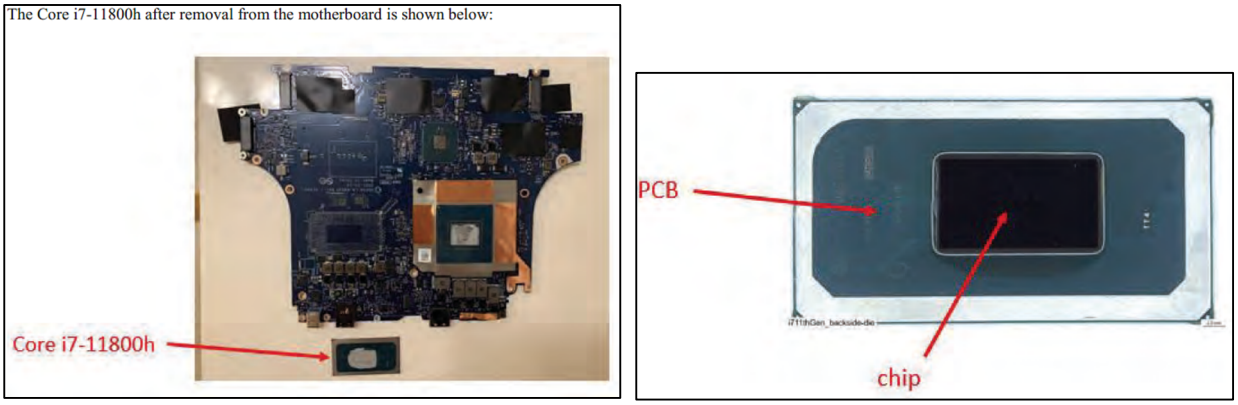
None of the traditional privity considerations exist. No onsemi products — whether standalone products or components of an Intel Accused Product — were at issue in the Intel litigation; indeed, to this day, Greenthread has still *never* identified an onsemi product at issue in the Intel litigation. Moreover, onsemi was not aware of the Intel litigation until one business day before the lawsuit was dismissed, and Intel did not request indemnification from onsemi. There is no factual or legal basis for a determination that onsemi and Intel are "sufficiently close such that both should be bound by the trial outcome and related estoppels." *See* TPG, 14-15.

1. The Intel litigation did not involve onsemi products

Discovery has confirmed that onsemi did not supply the Intel Accused Products or any component thereof. Despite its recent admission that onsemi does not supply the Intel Accused Products (i.e., CPUs and flash memory) to Intel, Greenthread now suggests that onsemi's theoretical supply of unidentified *components* of the Intel Accused Products to Intel creates privity. *Id*., 7, 8. But this

argument ignores Mr. Murphy's unrebutted and repeated testimony that onsemi does not in fact sell to Intel (or any other party) any components of the Intel Accused Products. EX2103, ¶7; EX2104, 26:9-13 ("None of the parts we [(onsemi)] sell would be part of a[n] Intel CPU."), 33:20-34:8, 35:14-19, 36:15-17, 83:6-12.

Greenthread's previous analysis of the Intel Accused Products further demonstrates that Greenthread itself knows that onsemi products are not "components" of the Intel Accused Products. *Contra* Paper 117, 8. In the Intel litigation, Greenthread's infringement contentions included an extremely detailed teardown and analysis of an exemplary Intel Accused Product. *See* EX2048, 52-56.



Id., 52-53. Because the Intel products are each a solid piece of silicon manufactured by Intel ("chip," above right) without any external discrete components of any third party, including onsemi, Greenthread's own analysis confirms Mr. Murphy's testimony that no onsemi product is a component of an Intel Accused Product. *Id*.

If a hypothetical onsemi product was somehow a component of one of Intel's chips, Greenthread's teardown analysis and robust party discovery in the Intel

litigation would have revealed it, and Greenthread would have identified that component here. But despite ample opportunity, Greenthread has *never* identified any onsemi product that is a component of an Intel Accused Product. Contrary to Greenthread's attorney speculation that some such component *may* exist, the only record evidence is Mr. Murphy's clear and unrebutted testimony: "None of the parts we [(onsemi)] sell would be part of a[n] Intel CPU." EX2104, 26:9-13.

Greenthread's convoluted and unprecedented privity theory also relies on an incomplete daisy-chain of purported licenses. Greenthread states that "Petitioner received a sublicense as a 'have made vendor' to make and sell products to Intel under Intel's license with PO" (Paper 117, 3). This is incorrect. Intel does not have a "license with PO." Instead, PO has a contract with RPX that gives RPX the right to grant a sublicense to Intel. But, Greenthread has never produced an actual sublicense between RPX and Intel. Instead, Greenthread relies on an inadmissible hearsay declaration from RPX. EX2028, ¶5. It is startling that Greenthread contends that the combination of an unproduced RPX-Intel sublicense (assuming that it exists) and an unidentified, hypothetical onsemi component (that does not exist) creates a time bar for onsemi's IPRs. As a matter of fundamental fairness, onsemi cannot be deprived of its day in court based on such speculation. *See WesternGeco*, 889 F.3d at 1319 ("As informed by *Taylor* and other cases, the standards for the privity inquiry must be grounded in due process.").

2. *onsemi had no ability to control and did not control the Intel litigation*

As onsemi has stated from the beginning, Intel never requested indemnification from Petitioner with respect to PO. Paper 11, 10 n.2. Discovery has further confirmed this: "Intel has never tendered a patent infringement indemnification request to onsemi." EX2103, ¶4. Regardless of the indemnification rights that may exist under onsemi's Terms of Sale, the fact remains that Intel did not seek indemnification from onsemi (because no onsemi products were at issue).

Beyond a lack of indemnity, "no one at onsemi was aware of the Intel Litigation before April 21[,] 2023." EX2103, ¶9. This timing matters because Greenthread and Intel filed a joint motion to dismiss the Intel Litigation on April 24, 2023 which was the next business day following Greenthread's suit against onsemi. *Compare Greenthread, LLC v. Intel Corporation*, 3:22-cv-02001, ECF 50-51 (D. Or. Apr. 24, 2023), *with Greenthread, LLC v. ON Semiconductor Corporation et al.*, 1:23-cv-00443 ECF 1 (D. Del. Apr. 21, 2023). It is also notable that the RPX agreement that is the source of Greenthread's privity argument was signed weeks earlier, on April 7, 2023. EX2022, 15. Because Greenthread and Intel resolved their dispute at least fourteen days before onsemi became aware of the Intel litigation, it would not be credible for Greenthread to suggest that onsemi knew of or had any role in the Intel litigation, and Greenthread appears to no longer dispute this point.

Because onsemi had no role in the Intel litigation, fundamental fairness prevents any attempt to bind onsemi as a privy to Intel. "[I]t is important to determine whether the petitioner and the prior litigant's relationship—as it relates to the lawsuit—is sufficiently close that it can be fairly said that the petitioner had a full and fair opportunity to litigate the validity of the patent in that lawsuit." *WesternGeco*, 889 F.3d at 1319. Before being sued by Greenthread, onsemi had no opportunity to litigate the validity of the challenged patents, and due process requires that onsemi have its own day in court. *See Taylor*, 553 U.S. 880, 892–93.

3. Greenthread does not have "some evidence" that onsemi is in privity with Intel

The full record confirms that Greenthread has not "produced some evidence to support its argument that Intel should be named as a privy so as to have put the issue into dispute." *See* Paper 94 at 3. What Greenthread touts as evidence of privity with Intel is nothing but failed speculation:

- First, Greenthread relies on the fact that Intel is a customer of onsemi. Paper 117, 2. This argument fails because "a manufacturer-customer relationship alone does not establish privity[.]" *Samsung Electronics*, IPR2022-00615, Paper 64 at 23 (citing *Wi-Fi One*, 887 F.3d at 1340–41).
- Second, Greenthread points to an alleged sublicense to Intel through Greenthread's agreement with RPX. Paper 117, 3 (citing EX2022, 3). This argument fails on multiple levels: Greenthread has not produced the actual

sublicense from RPX to Intel; an agreement between RPX and Greenthread cannot create privity between onsemi and Intel; and this RPX agreement does nothing to show a connection between onsemi and the Intel litigation.

- Third, Greenthread suggests that onemi's provision of custom products to unspecified customers and onsemi's collaboration with Intel implies privity. Paper 117, 3. But generally collaborating and making custom products is irrelevant. What matters for privity is that onsemi did ***not*** make the Intel Accused Products or components thereof. *See* EX2103, ¶7.
- Fourth, Greenthread points to the indemnification provisions in onsemi's general T&Cs, implying that Intel may have been entitled to indemnity from onsemi. Paper 117, 3. But discovery has confirmed that Intel ***never*** sought indemnity from onsemi for the Intel Litigation (EX2103, ¶8), which makes sense because no onsemi products were at issue in the case (*id*., ¶7).

Greenthread's speculative and disproven arguments are not sufficient under *Worlds* or any other known jurisprudence to indicate that onsemi is time-barred.

b. Greenthread's criticism of Mr. Muphy's testimony is baseless

Left with no facts or law, Greenthread resorts to criticizing Mr. Murphy. These criticisms uniformly lack merit and do not impact the privity analysis. Nonetheless, certain of Greenthread's mischaracterizations must be addressed.

1. Mr. Murphy did not admit a lack of knowledge

Pushing the boundaries of candor, Greenthread relies on mistaken testimony clarified in a signed errata sheet to allege that "Mr. Murphy clearly admitted that he does not know" whether the Intel Accused Products include an onsemi part. Paper 117, 8 (citing EX2104, 62:3-17). Both before and after this misstatement, Mr. Murphy testified that onsemi does not supply components of the Intel Accused Products. *Supra*, p. 4-5. But, Mr. Murphy misunderstood one line of questions and answered in a way that suggested he did not know whether the Intel Accused Products included onsemi components. EX2104, 62:3-17. Mr. Murphy corrected this misunderstanding both on redirect and in the errata to his deposition. *Id*., 83:6-84:11, and p. 104. The full record thus shows that Mr. Murphy knows that the Intel Accused Products ***do not*** include onsemi components. *See e.g.*, *id*, 33:20-34:8 ("Q: As you sit here today testifying under penalty of perjury, can you tell me definitively whether any of the products listed on Pages 4 through 8 of Exhibit 2048, include an onsemi part or product? A: I can confirm they do not.").

2. Mr. Murphy performed an adequate investigation

Greenthread argues that Mr. Murphy should have done more to confirm that onsemi does not sell components of the Intel Accused Products. Paper 117, 6-14. But Mr. Murphy is a Vice President in sales for onsemi and has worked for onsemi (and its predecessor) for over 25 years. EX2103, ¶2. In that capacity, Mr. Murphy

is exactly the right person to confirm the unsurprising conclusion that "[n]one of the parts we [(onsemi)] sell would be part of a (*sic*) Intel CPU." EX2104, 26:9-13.

Greenthread also ignores Mr. Murphy's testimony that he "looked at a view of what [onsemi] shipped" to Intel to "confirm what [he] had already suspected." *Id*., 19:18-20:14; *contra* Paper 117, 7-8. That Mr. Murphy could not recite by memory the specific parts by number that onsemi sells to Intel does not change the fact that Mr. Murphy did investigate the products sold by onsemi to Intel. *Contra id*., 8. All of Greenthread's attorney bluster about Mr. Murphy not talking to people more familiar with onsemi's sales to Intel is meaningless. Mr. Murphy had access to and reviewed a list of products sold to Intel—between that list and his decades of experience at onsemi, there was no need for Mr. Murphy to consult with anyone else.

Greenthread argues that onsemi should have produced documents proving the ***absence*** of specific sales to Intel. Paper 117, 14-15. Unsurprisingly, onsemi does not maintain a document describing what onsemi *does not sell* to Intel. Instead, and as recognized in the Board's discovery order, the best source of proof for this *negative* point—*i.e.*, that onsemi *does not supply* the Intel Accused Products or components thereof—is testimony from a person knowledgeable about onsemi's business. Mr. Murphy's declaration and deposition testimony resolves this question, and it is not reasonable for Greenthread to demand that onsemi produce documents about irrelevant business between onsemi and Intel.

3. Narrowly tailored instruction not to answer were proper

Greenthread quotes *from its own attorney statements* to allege that Mr. Murphy was told not to answer questions about his investigation. Paper 117, 6-7. The transcript disproves Greenthread's arguments. Mr. Murphy was allowed to answer "generally about the type of things he did" regarding his investigation. *See* EX2104, 15:8-15. The instruction not to answer concerned questions calling for privileged communications, such as "asking [Mr. Muphy] directly what counsel asked him to do and what was communicated with counsel[.]" *Id*.

4. Mr. Murphy appropriately consulted onsemi's legal department

Greenthread wrongly emphasizes that Mr. Murphy did not "ask" onsemi's legal department certain questions. Paper 117, 13-14. But Mr. Murphy testified that he did not "ask" certain questions because legal department affirmatively ***told*** him the information at issue. EX2104, 96:1-10. It makes no difference whether Mr. Murphy "asked" for information or was "told" the information.

*5. Semiconductor Components Industries **is** Petitioner onsemi*

Even though not the subject of Mr. Murphy's declaration, Greenthread asked Mr. Murphy questions about onsemi's corporate structure, and Mr. Murphy lacked knowledge about onsemi's legal entity structure. *See e.g.*, *id*., 59:7-60:6; 77:6-11, 90:10-18. As a non-lawyer, Mr. Murphy was understandably unaware of the legal details of how "onsemi" relates to Semiconductor Components Industries, LLC. *See*

id., 80:11-15 ("Q: And in any of your work, do you ever make a distinction between onsemi and Semiconductor Components LLC? […] [A:] No, I do not."). Greenthread's questioning on this extraneous subject created unnecessary confusion, which is reflected in Greenthread's misguided arguments about potential sales by Semiconductor Components Industries, LLC. Paper 117, 12.

The caption of Greenthread's brief (Paper 117) shows the problem in Greenthread's argument: Semiconductor Components Industries, LLC is not "a subsidiary of Petitioner." Semiconductor Components Industries, LLC ***is*** Petitioner. "onsemi" is a d/b/a used by Semiconductor Components Industries, LLC. Thus, Greenthread's suggestion that Mr. Murphy should have investigated Semiconductor Components Industries, LLC—distinct from onsemi—is nonsensical. *Id*.

Moreover, Greenthread's confusion has no bearing on the substantive privity dispute. Mr. Murphy confirmed that none "of the subsidiaries and affiliates that use the onsemi d/b/a" ever sold to Intel "any of the accused Intel products set out in Exhibit 2048," or "any part or element or component of the accused Intel product set out in Exhibit 2048." EX2104, 87:14-88:6.

IV. CONCLUSION

onsemi has never been in privity with Intel for purposes of the litigation between Intel and Greenthread. Petitioner respectfully requests that the Board reinstate its Final Written Decision that all challenged claims are unpatentable.

Respectfully submitted,

Dated: August 26, 2025

/*Roger Fulghum*/
Roger Fulghum
Reg. No. 39,678

Counsel for Petitioner
Semiconductor Components
Industries, LLC

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 26th day of August, 2025, **PETITIONER'S RESPONSIVE POST-REMAND BRIEF** was served by email on the following counsel for Patent Owner and the Joined Petitioner:

Greenthread-OnSemi-MS@mckoolsmith.com

awhitehurst@mckoolsmith.com

ajairam@mckoolsmith.com

nozarkar@mckoolsmith.com

shejny@mckoolsmith.com

IPR12189-0088IP1@fr.com

PTABInbound@fr.com

griswold@fr.com

bisenius@fr.com

Dated: August 26, 2025

/*Roger Fulghum*/
Roger Fulghum
Reg. No. 39,678

Counsel for Petitioner
Semiconductor Components Industries, LLC