Transcript of Hearing

Date: September 18, 2025
Case: Semiconductor Components Industries, LLC, et al. -v- Greenthread, LLC (PTAB)

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SEMICONDUCTOR COMPONENTS	)
INDUSTRIES, LLC, et al	)
	)
	)
vs.	)
	)
GREENTHREAD, LLC	)

TELEPHONIC HEARING

REGARDING IPR2023-01242, 01243, 01244 and

IPR 2024-00263, 00264, 00265, 00266

September 18, 2025

REPORTED BY:

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1 TELEPHONIC APPEARANCES

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ALSO PRESENT:

Mr. Joshua Engel

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JUDGE ULLAGADDI: Just so we have it on the record, who is on the line for Patent Owner, and who will be speaking?

MR. WHITEHURST: Good morning, Your Honor. This is Alan Whitehurst from McKool Smith for the Patent Owner, Greenthread, and I will be speaking today.

JUDGE ULLAGADDI: Okay. Thank you. And who is on the line for Petitioner, and who will be speaking?

MR. FULGHUM: Good morning, Your Honor. This is Roger Fulghum from Petitioner, and with me on the line are my co-counsel, Mark Speegle, Allyar Barazesh, Daniel Anderson and Joshua Engel of Semiconductoer Components Industries, LLC. And I will be speaking.

JUDGE ULLAGADDI: Thank you. Can I also confirm that all parties who have dialed in are permitted to be here? We are going to be discussing some confidential information. Your Honor, this is Josh Griswold, on behalf of Texas Industries, the joint Petitioner. We've signed on to the Protective Order, so I believe we're authorized to be here.

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MR. FULGHUM: Your Honor, this is Roger Fulghum for Petitioner, and all persons associated with Petitioner are authorized to be here.

JUDGE ULLAGADDI: Thank you. Okay. We've allocated one hour for this telephonic hearing, 30 minutes for each side, but we'll allocate more time if our questions cut significantly into either party's arguments.

Petitioner will present its main case. Thereafter, Patent Owner will present its main case. Petitioner may respond with a rebuttal, and Patent Owner may close with a surrebuttal. Neither party may allocate more than 15 minutes to its rebuttal.

I'd like to attend to matters of administration first. Whichever party obtained the court reporter, please file the transcript as speedily as possible and please remain on the line at the conclusion of our hearing to provide spellings of proper names and whatnot. That would be much appreciated.

Before we begin, can I confirm with Petitioner's counsel the entities comprising Petitioner are Semiconductor Components Industries, Texas

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Industries, and the undisputed RPIs are Semiconductor Components Industries, Texas Instruments and ON Semiconductor Corporation in the 1200 series of cases?

MR. FULGHUM: This is Roger Fulghum for Petitioner. That is correct.

JUDGE ULLAGADDI: Can I also confirm with Petitioner's counsel, Semiconductor Components Industries, LLC is the Petitioner and Semiconductor Components Industries and ON Semiconductor Corporation are the undisputed RPIs in the 200 series cases?

MR. FULGHUM: This is Roger Fulghum for Petitioner. That is correct.

JUDGE ULLAGADDI: Patent Owner's counsel, Mr. Whitehurst, do you agree with this identification of Petitioner's entities and undisputed RPIs?

MR. WHITEHURST: We do, Your Honor.

JUDGE ULLAGADDI: Okay. Excellent. In that case, when you're ready, counsel for Petitioner, you may begin.

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1 MR. FULGHUM: This is Roger Fulghum for
2 Petitioner. What I would like to do is split my time,
3 20 minutes and then 10 minutes. With that, if the Board
4 is ready, I will begin.
5 This is Roger Fulghum for Petitioner,
6 Semiconductor Components Industries, LLC. And may it
7 please the Board, I think it would be best to start with
8 a discussion of the framework for this analysis and for
9 the framework of privity. It is also helpful to start
10 with the Supreme Court opinion in Taylor vs Sturgell,
11 which this Board has cited on multiple occasions. The
12 Supreme Court in that case recognizes the deep-rooted
13 historic tradition that everyone should have his own day
14 in court.
15 The exceptions to that deep-rooted
16 historic tradition are generally laid out in Taylor vs
17 Sturgell, and we have come to know those exceptions
18 under the heading of "Privity." Privity, in the context
19 of an IPR proceeding, comes into play as a result of
20 Section 315(b) and the time bar that is set out in
21 Section 315(b).
22 The Federal Circuit has identified the

1 standards for privity in the 315(b) context, and this
2 Board has cited to those standards and applied them in
3 these proceedings.
4 In the Institution decision -- by the way,
5 when I give citations today, I'm going to be citing to
6 IPR 2023-01242. Although there is some variation among
7 the various IPRs, I'll be sticking to 1242.
8 For example, in the Institution decision
9 in the 1242 case, the Board recognized, citing to the
10 WesternGeco case, that privity concerns "Whether the
11 Petitioner and the prior litigants' relationship as it
12 relates to the earlier lawsuit is sufficiently close
13 that it can be fairly said that the Petitioner had a
14 full and fair opportunity to litigate the validity of
15 the patent in that lawsuit."
16 And the Board also cited to a more recent
17 case at the PTAB, Google, LLC vs DDC Technology, LLC at
18 the bottom of page 11 of that Institution decision. And
19 the Board stated, "That relationship must be related to
20 an earlier lawsuit and be sufficiently close that it can
21 be fairly said the Petitioner had a full and fair
22 opportunity to litigate the validity of the patent in

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1 that lawsuit."
2 So what we can see from the case law, the
3 controlling case law in this area, is that the analysis
4 is not just an analysis of whether the Petitioner and
5 the purported privy had ever done business together, but
6 the analysis must concern the relationship between the
7 Petitioner, the purported privy and whether the
8 Petitioner had any ability or was involved in any manner
9 in the previous litigation.
10 Another issue that we deal with in these
11 proceedings is the burden shifting that is in place as a
12 result of the Worlds decision. In Worlds, the Federal
13 Circuit said that the privity identification of
14 Petitioner is accepted unless the Patent Owner has come
15 forward with some evidence that would suggest there is a
16 privy.
17 Now, I would respectfully suggest here --
18 and our position at the outset is that the Patent Owner
19 has not come forward with some evidence that would carry
20 its burden that there is a privity relationship between
21 Petitioner and Intel. That was the finding of this
22 Board at the institution stage. It was also the finding

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1 of this Board at the final written decision. And none
2 of the facts here have improved in any way for Patent
3 Owner in that regard. I also take issue with any
4 suggestion from Patent Owner that the Acting Director
5 has made a determination that the Patent Owner has
6 already carried its burden.
7 If you look at the Acting Director's order
8 from April 2025 on page 3 of that order, the Acting
9 Director states that one of the tasks on remand for the
10 Board at the bottom of page 3 is the determination of
11 whether Patent Owner has produced some evidence to
12 support its argument that Intel should be named as a
13 privy so as to have put the issue into dispute.
14 If the Acting Director had determined that
15 Patent Owner had carried its burden, the Acting Director
16 surely would have ruled so. But, instead, she directed
17 this Board to make that determination in the first
18 instance.
19 Patent Owner has never carried its burden
20 in that regard, and we'll talk about why. But let me be
21 clear about something. And I'm going to talk about this
22 in more detail. Regardless of who has the burden -- and

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1 we will talk about it both ways. Regardless of who has
2 the burden in this case, Petitioner is not a privy of
3 Intel, and that is established through the record and
4 through the privy theory that's at issue in this case.
5 First, let's talk about whether the Patent
6 Owner has provided some evidence that would suggest
7 there is a privity relationship between Petitioner and
8 Intel so as to shift the burden in the Worlds case. We
9 would respectfully submit that for three reasons, at
10 least three reasons, there is no privity relationship
11 between Petitioner and Intel.
12 The most important of which is that
13 Petitioner had no involvement whatsoever in the previous
14 litigation. The previous litigation was a lawsuit filed
15 by Patent Owner against Intel. It was filed on
16 February 1, 2022. It was dismissed almost 15 months
17 later, on April 24, 2023. Patent Owner sued Petitioner
18 on Friday, April 21st, so as a matter of timing, logic
19 and fact, we know that Petitioner had no role in the
20 Intel litigation and was not even aware of the Intel
21 litigation. This issue is dispositive of this privity
22 inquiry, and we could all stop right now.

1 The WesternGeco case, the Google case that
2 I cited previously, tells us that the point of the
3 privity in the 315(b) context is to prevent Petitioner
4 from having a second bite at the apple because of
5 Petitioner's involvement in the previous litigation.
6 There was no involvement, no awareness of the previous
7 litigation on Petitioner's part. And I want the Board
8 to notice a couple of items.
9 The Patent Owner does not contest this and
10 will not contest this during its presentation today.
11 We've provided a Declarant who stated, of course, in
12 paragraphs 9 through 10 of his declaration, Mr. Matthew
13 Murphy -- that declaration is part of the record. It is
14 Exhibit 2103, paragraphs 9 and 10. He states that there
15 was no involvement of Petitioner -- no awareness of
16 Petitioner in the Intel litigation. Patent Owner took
17 the deposition of Mr. Murphy and asked zero questions of
18 Mr. Murphy about this issue. Not a single one.
19 Patent Owner was also afforded two briefs
20 on the privity issue totaling 30 pages. Patent Owner
21 did not devote a single sentence to the issue of whether
22 Petitioner was in any manner involved in the Intel

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1 litigation. And that's because this issue is
2 undisputed, and it is dispositive.
3 The second issue that I'd like to raise
4 with regard to the burden has to do with whether there
5 were any products, subcomponents or technology of
6 Petitioner involved in the Intel litigation. And the
7 answer is there were none. And we know that for a
8 couple of reasons. First, that is what Mr. Murphy
9 testified to in his declaration, which is provided on
10 paragraph 7 of his declaration. We also know that
11 because Patent Owner was involved in litigation with
12 Intel for 15 months, conducted discovery in that period,
13 and provided infringement contentions. The infringement
14 contentions, which are in the record at Exhibit 2048, do
15 not identify any onsemi product subcomponents or
16 technology that make up any part of the accusations with
17 respect to Intel litigation.
18 I would also note that Patent Owner
19 actually tore down an Intel processor and conducted an
20 expensive forensic examination of that Intel processor.
21 That is in the record at pages 53 through 56 of
22 Exhibit 2048. And you would think that if the

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1 technology of Petitioner were at issue, Patent Owner
2 would have raised that to show that there was some
3 involvement in some way with Petitioner in that matter,
4 and Patent Owner has come forward with no evidence
5 whatsoever in that regard.
6 And the third item with respect to whether
7 the burden has been shifted concerns indemnification
8 requests. There has been none. And we know that
9 because Mr. Murphy provided in his declaration, at
10 paragraph 8, a clear identification that there were no
11 indemnification requests. In fact, in onsemi's entire
12 history of the company, onsemi has never received an
13 indemnification request from Intel for any issue. And
14 that makes sense.
15 If onsemi's products, subcomponents or
16 technology were at issue in the Intel litigation, Intel
17 would have sent an indemnification request to onsemi
18 that says, hey, your products are at issue; come defend
19 them. That never happened because onsemi's products
20 were not at issue.
21 All of the features of privity in the
22 315(b) context are absolutely absent, and in that

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1 regard, Patent Owner has not carried its burden under
2 Worlds. Let me just pivot and talk about the evidence
3 in this record.
4 If the Board finds that Patent Owner has
5 carried its burden, if Patent Owner has carried its
6 burden, we have carried our burden of demonstrating that
7 Petitioner and Intel are not privies. And that is for
8 three reasons.
9 The first reason is that Petitioner had no
10 involvement whatsoever in the Intel litigation.
11 Mr. Murphy testifies to that in his declaration at
12 paragraphs 9 and 10. We also know that's true as a
13 matter of timing, logic and fact, and that issue is
14 absolutely dispositive of this privity inquiry.
15 The second issue, as we also know, that no
16 onsemi components, subcomponents or technology were at
17 issue in the Intel litigation. Mr. Murphy testified to
18 this in paragraph 7 of his declaration. And we've heard
19 no evidence to the contrary from Greenthread or from
20 Patent Owner. Patent Owner simply suggests, well, it
21 might be in there somewhere without any proof that it's
22 actually in there. And it also makes no technological

1 sense that one chip would be somehow within another
2 chip.
3 These chips are indivisible units and it
4 makes no -- it's not understandable that somehow an
5 onsemi chip is somehow embedded within an Intel chip,
6 and Mr. Murphy confirmed to the contrary, that no onsemi
7 technology, subcomponent or component is involved in the
8 Intel-accused products.
9 And then, finally, another piece of the
10 puzzle that demonstrates that we have carried our burden
11 to demonstrate that Intel and onsemi are not privies is
12 the lack of an indemnification request. Intel has never
13 made an indemnification request to onsemi for any issue.
14 Mr. Murphy testified to that at paragraph 8 of his
15 declaration.
16 Regardless of who has the burden, we have
17 carried the burden. Petitioner and Intel are not
18 privies, and there is no basis for barring Petitioner
19 with respect to this proceeding.
20 Before I conclude my opening presentation,
21 let me also make just a few comments about the privity
22 theory that's at issue in this case.

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1 As I understand the privity theory, the
2 privity theory is predicated on the notion that there is
3 a daisy chain of license agreements that start with
4 Patent Owner and somehow continue all the way down the
5 line and end with "have made" rights between Intel and
6 Petitioner.
7 Well, let's take a look and just discuss
8 those agreements.
9 The first agreement in the daisy chain is
10 a contract between Patent Owner and RPX. RPX is a third
11 party. RPX is not here. Petitioner has no dealings
12 with RPX that are relevant to this discussion. And
13 Petitioner was not even aware of this contract until
14 this proceeding had been filed and this privity issue
15 had been raised by Patent Owner for the first time.
16 That contract gives RPX the right to issue a sublicense
17 to Intel, but that sublicense, to the extent it even
18 exists, has never been provided. It is not in the
19 record.
20 And you would expect, quite frankly, for
21 there to be a privity finding that would bar a party
22 from having its day in court, you would expect all of

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1 the relevant agreements demonstrating this license
2 relationship to be in the record; and they are not. We
3 don't know the scope of the license. We don't know the
4 scope of the "have made" rights, and this is fatal to
5 this analysis, among all the other failings in this
6 privity analysis.
7 I would respectfully suggest to the Board
8 that there can be no privity finding here, and I'll
9 conclude with just a few comments.
10 First, we would respectfully suggest that
11 there's no case and no basis for a privity finding when
12 Petitioner had no involvement and no role in the
13 previous litigation. No case of the Board or the
14 Federal Circuit stands for that. We would also suggest
15 that there is no case and no basis for a privity finding
16 when the technology of the second party was not at issue
17 in the previous lawsuit involving the first party. No
18 Federal Circuit case and no decision of this Board has
19 ever found that. And we would also suggest that there
20 is no basis for and no precedent for a privity finding
21 when the supposed agreements that underscore the
22 supposed privity relationship are not even part of the

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1 record.
2 No decision of the Federal Circuit or this
3 Board has ever found privity in that situation. There
4 is no privity here, and we would respectfully request
5 that the Board, with respect to the first wave of IPRs,
6 that's the 1200 series from 2023, find that there is no
7 privity and reinstate its final written decision, which
8 found that all of the asserted claims were unpatentable.
9 With respect to the second wave of IPRs,
10 that's the 200 series from 2024, we would respectfully
11 request that the Board issue a final written decision,
12 finding all those challenged claims unpatentable, and
13 also finding that there is no privity.
14 I would be happy to answer any questions,
15 and I will reserve the remainder of my time.
16 JUDGE ULLAGADDI: Thank you, Counsel. Let
17 me put you all on hold and confer with the Panel to see
18 if we have any questions.
19 (Pause)
20 It looks like the Panel doesn't have any
21 questions. You've got about 12 minutes for your
22 rebuttal.

1 Mr. Whitehurst, would you like to reserve
2 any time for rebuttal?
3 MR. WHITEHURST: Yes, Your Honor. I would
4 like to do the same as Petitioner's counsel did and use
5 20 minutes and reserve 10.
6 JUDGE ULLAGADDI: Okay. When you're
7 ready, you may begin.
8 MR. WHITEHURST: Yes. May it please Your
9 Honors, as we saw during the Monolithic hearing, it's
10 not as simple as Petitioner makes it sound. I'm going
11 to start with Exhibit 2006 this morning to show four
12 things.
13 First, that there is at least some
14 evidence that Petitioner is in privity with Intel. Two,
15 that onsemi sold to Intel a component of the products
16 accused during the Intel litigation. Three, I'm also
17 going to use Exhibit 2006 to show why onsemi has not
18 complied with its discovery obligations in these
19 proceedings. And, finally, fourth, I'm going to use
20 Exhibit 2006 to show why onsemi has not produced any
21 actual evidence to meet its burden on the privity issue.
22 Exhibit 2006 is one of the exhibits that

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1 we focused on in our director review. It is a data
2 sheet for an onsemi chip for Intel's Atom, Alder Lake
3 and Tiger Lake processors, and we know from Figure 2 in
4 Exhibit 2006, that onsemi makes a component of the
5 products that were accused in the Intel litigation.
6 Now, when you look at the face of
7 Exhibit 2006, you can see that the onsemi chip is a chip
8 for CPUs, and as we explained in our Director Review
9 Request, onsemi makes controllers for the Intel
10 processors and sells these chips to Intel. These
11 controllers regulate the power in the Intel processors.
12 Now, when you look at Figure 2 of the data
13 sheet, which is Exhibit 2006, you'll see how Figure 2
14 shows how the processor has both an onsemi chip and an
15 Intel chip. On the left is the controller chip sold by
16 onsemi to Intel, and on the right is the Intel chip.
17 Now, we know from the data sheet that the
18 controller chip was specifically and specially designed
19 for Intel's proprietary interface called IMVP8. And
20 this interface --
21 JUDGE ULLAGADDI: Counsel, can I ask a
22 question about this?

1 MR. WHITEHURST: Yes, Your Honor.
2 JUDGE ULLAGADDI: So is it Patent Owner's
3 position that it's enough for the onsemi chip to be next
4 to the Intel chip, that it does not need to be
5 incorporated within?
6 MR. WHITEHURST: That's correct, Your
7 Honor. And as we'll show, this is exactly what we
8 accused in the Intel litigation.
9 When you look at the infringement
10 contentions, Exhibit 2048, we explicitly said made in
11 whole or in part by Intel. So in the Intel litigation,
12 we were not just accusing chips made wholly by Intel but
13 also chips that were part of the accused CPU, such as
14 the chip that we see in Exhibit 2006.
15 So in this instance where you have a
16 controller chip that is working with the Intel chip, it
17 was accused in the Intel litigation, and it's part of
18 the accused CPU. So in this instance, yes, it would be
19 sufficient for privity purposes because it was part of
20 what was accused in the Intel litigation.
21 And we know from the data sheet that this
22 was a custom-built chip for Intel. Onsemi was working

1 as part of a partnership with Intel using Intel's
2 proprietary interface, the very interface that was used
3 in Intel's Atom, Alder Lake and Tiger Lake processors.
4 And when we filed our Director Review Request, we used
5 this data sheet, Exhibit 2006, to explain how onsemi
6 makes custom products for Intel.
7 If you look at Paper 90, page 2, you'll
8 see where, in our Director Review Request, we cited to
9 the data sheet that we're discussing this morning. It
10 was front and center in the director review and a large
11 part of why the Director determined that the Board
12 abused its discretion. And after considering this data
13 sheet, the Director remanded these proceedings for
14 discovery for documents, such as sales agreements and
15 indemnification agreements related to products accused
16 of practicing the challenged claims.
17 But after remanding this for additional
18 discovery, Petitioner has stonewalled Patent Owner on
19 the agreements that relate to the very chip that was
20 front and center in our Director Review Request.
21 Now, I mentioned just now the infringement
22 contentions from the Intel litigation. And if you look

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1 at the infringement contentions in the Intel litigation,
2 you can see that Greenthread explicitly mentioned that
3 it was accusing both chips made by Intel and third
4 parties. On page 3 it says Intel-accused CPUs include
5 all CPUs designed or manufactured, in whole or in part,
6 by Intel.
7 So Greenthread was accusing both chips
8 made by Intel and not made by Intel. And if you look at
9 the definition of Intel-accused CPUs, it says it
10 includes the products and processors labeled as Alder
11 Lake, Tiger Lake, and Atom. But you can see that in the
12 infringement contentions they're referred to as
13 processors or products.
14 So the accused CPUs, which are so
15 important, were more than just Intel chips. In order
16 for the processor to work, there had to be a controller
17 or some other chip that regulates the power and clock
18 signal.
19 So we see right here on the face of the
20 infringement contentions that the accused CPUs included
21 both the Intel chip and other chips that were sold with
22 it. Now, if you look at page 10 of the Discovery Order,

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1 which is Paper 111, as I discussed during the Monolithic
2 hearing last week, we saw that Section A mentions the
3 Intel-accused products. And then, like we discussed
4 last week, Section B has three subparts. And if you
5 look at subpart 2, you can see that it says whether
6 Petitioner was the supplier of any product or component
7 of a product accused of infringement in the Intel
8 litigation.
9 Now, Intel should have known that its
10 controller chip was a component of a product when we
11 relied on Exhibit 2006 in our director review, and we
12 made the same point during the onsemi wave 2 hearing on
13 May 6, 2025. And it just doesn't make sense that we
14 would mention Exhibit 2006 in our Director Review
15 Request as a reason why there was privity, the Director
16 agreed with us that it was an abuse of discretion, and
17 then we would still be denied discovery on the very
18 controller chip that we mentioned in our Director Review
19 Request.
20 But if you look at paragraph 7 of Matthew
21 Murphy's declaration, that's exactly what onsemi did.
22 The declaration, which is Exhibit 2103, if you look at

1 Exhibit 7, onsemi took an overly narrow view of
2 Intel-accused products to mean just Intel chips and not
3 the onsemi chips that are sold with the Intel chips as
4 part of the processor or CPU.
5 Now, if there was any doubt from
6 paragraph 7 of the declaration, you can look --
7 JUDGE ULLAGADDI: Counsel, quick question
8 for you.
9 So am I understanding that the heart of
10 the dispute here is that -- whether the onsemi chips are
11 inside or next to the Intel-accused products?
12 MR. WHITEHURST: Well, I don't know if
13 that's the issue as much as did onsemi partner with
14 Intel to make a controller chip that was part of the
15 accused CPUs. And if you look at Figure 2 of
16 Exhibit 2006, you see a diagram of how the onsemi
17 controller chip is part of Intel's CPU, and you can see
18 how the controller chip is what's regulating the clock
19 signal and the power in the accused CPUs.
20 And, Your Honor, that is what we submit is
21 important here, that we see right on Figure 2 of
22 Exhibit 2006, which was front and center in our Director

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1 Review Request, that onsemi was working to make
2 custom-built chips for the Intel-accused CPU.
3 And we don't have a case here where onsemi
4 says we don't know whether our chip was part of the
5 accused CPUs. Instead, we have a situation where they
6 made a conscious decision to narrowly read Intel-accused
7 products to mean just the Intel chip, even though the
8 infringement contention says something different. And
9 if you look at Mr. Murphy's deposition testimony, which
10 is Exhibit 2104, you can see that he confirmed during
11 his deposition that onsemi made no effort to determine
12 what onsemi chips are sold to Intel for use in the Atom,
13 Alder Lake and Tiger Lake processors. You can see this
14 on pages 26 to 28 of his deposition transcript. You can
15 see on page 26 he did not contact Intel but, more
16 importantly, you can see on page 28 that as part of his
17 investigation, he did not speak with anyone at onsemi
18 about these chips which were custom built for the Atom,
19 Alder and Tiger Lake processors that were accused in the
20 Intel litigation.
21 Now, this is a very risky strategy, to not
22 investigate the onsemi chips in Intel CPUs, when we know

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1 the director considered Exhibit 2006 and agreed with
2 Intel that it is relevant to the privity issue.
3 Now, I want to flag something for Your
4 Honors.
5 If you look on page 2 of onsemi's Director
6 Review Response, which is Paper 91, you see a lot of the
7 arguments that we heard this morning. Onsemi tried to
8 argue that its chips were not accused in the Intel
9 litigation, and the Director rejected that argument.
10 And if you look, you'll see that they argued the same
11 things that we heard this morning.
12 But the point here is we have the Director
13 remanding for additional discovery on this privity issue
14 on Exhibit 2006, and then you have Mr. Murphy and onsemi
15 never investigating any of those chips, any of these
16 sales agreements, any of the indemnification agreements
17 with Intel for the onsemi chips which were in the
18 Intel-accused product.
19 And by narrowly construing Intel-accused
20 products to mean just an Intel chip and not the onsemi
21 chip, which was part of it, onsemi stonewalled
22 Greenthread on the very discovery that the Director

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1 requested.
2 Now, when we look at Worlds, the Federal
3 Circuit remanded for additional discovery, and there was
4 no additional discovery and the Board terminated the
5 proceedings. And the Board should do the same thing.
6 Onsemi was given a second chance to produce actual
7 evidence on the onsemi chips mentioned in Exhibit 2006,
8 and they chose not to do it. And onsemi needs to live
9 with that choice.
10 The Director already determined that they
11 were relevant to the privity issue. We produced
12 onsemi's standard terms and conditions, and it includes
13 an indemnification clause. We've also cited to the
14 license agreement for why onsemi would have been
15 licensed with the "have made" provisions in that
16 license, and onsemi never produced any other sales or
17 indemnification agreement for these chips to show that
18 it did not agree to indemnify Intel. They also did not
19 produce any documents or actual evidence to show that it
20 didn't sell the controller chips to Intel. In fact,
21 they didn't investigate them at all.
22 So, on the record, onsemi did not produce

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1 any actual evidence for the chips that are shown in
2 Exhibit 2006 and that were mentioned in our Director
3 Review Request in order to meet their burden that
4 they're not time barred.
5 And with my remaining time, I want to
6 address the point that Mr. Fulghum was arguing, that
7 they did not participate or have any control over the
8 Intel litigation. But the Board already said in Worlds,
9 our remand that this is not required for privity. While
10 it may be relevant to the privity inquiry, it's not
11 controlling, and in fact, we see in the privity remand
12 an instance where the litigation -- the proceedings were
13 terminated and the Petitioner did not have control
14 over -- or at least there was no evidence that the
15 Petitioner had control over the previous litigation.
16 So when we look at Worlds, not only the
17 Federal Circuit decision but also what the Board did on
18 remand, we see why in this instance it's appropriate to
19 terminate all these proceedings because onsemi did not
20 produce any actual evidence for the controller chips in
21 order to meet their burden that they're not time barred.
22 Unless there are any questions from the

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1 Panel, I'll reserve my remaining time.
2 JUDGE ULLAGADDI: Thank you, Counsel. I
3 think that means you have 13 minutes for surrebuttal.
4 It seems the Panel does not have any
5 questions, so if we want to return to Petitioner's
6 counsel, you have about 12 minutes.
7 EXAMINATION
8 MR. FULGHUM: Thank you, Your Honor.
9 Roger Fulghum for Petitioner Semiconductor Components
10 Industries, LLC.
11 Let's start with Exhibit 2006 which,
12 according to Patent Owner, was referenced in its
13 Director Review Decision. Let me point out a couple
14 things about Exhibit 2006.
15 It was never referenced in 30 pages of
16 privity briefing. So whatever argument there is with
17 regard to Exhibit 2006 has been waived. It was also
18 never the subject -- was not the subject of any
19 questioning in Mr. Murphy's deposition. And we all know
20 why that is.
21 Patent Owner did not want to ask about it
22 because they didn't want to have Mr. Murphy testify to

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1 it and explain what Exhibit 2006 is. And I think the
2 Board recognizes what Exhibit 2006 is. This is a
3 publicly available data sheet that shows customers how
4 to use an onsemi chip called an NCP81248 with an Intel
5 chip. These products are not sold to Intel. They are
6 sold to customers who put together the onsemi chips with
7 the Intel chips to make a product such as a computer
8 system.
9 These are two different chips. They are
10 not one and the same. And you can see that on Figure 2.
11 Figure 2 is titled Typical DrMoS Application Diagram,
12 and you can see the Intel chip on the right and the
13 NCP81248 on the left. Yes, they work together. Yes,
14 they were designed to work together. That does not
15 establish privity.
16 Also, this product, the 81248, was not at
17 issue in the Intel litigation, and we know that because
18 there's a listing of Intel products that are at issue in
19 the Intel litigation, and the NCP81248 is not part of
20 that listing.
21 In the infringement contention, the
22 infringement contention states -- and this is on page 3

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in the middle at Exhibit 2048. Intel-accused CPUs include all CPUs designed or manufactured, in whole or in part, by Intel. The NCP81248 is not a chip -- a CPU, a subcomponent designed or manufactured, in whole or in part, by Intel.

In addition, the NCP81248 is not a secret. Anyone with an internet connection can pull up this data sheet, along with hundreds of data sheets of onsemi and their products. If Patent Owner had wished to accuse the NCP81248 of infringement in the Intel case, it could have. It didn't. It was never accused. It is not part of an Intel product.

JUDGE OBERMANN: Counsel, this is Judge Obermann. Could I get you to elaborate for a moment about the Worlds decision and whether or not under Worlds, we still need to look at -- you know, regardless of whether your chip was in there, do we still need to look under Worlds at whether or not your client was in a position to control or actually controlled the litigation?

MR. FULGHUM: Okay, let's talk about the Worlds case for a second.

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1 The fact that Petitioner was not involved
2 in, aware of or in any way participating in the Intel
3 litigation is dispositive. That -- that cannot be
4 argued away, and Patent Owner just admitted that
5 Petitioner had no role in it, and that resolves the
6 issue.
7 What Patent Owner continues to point to --
8 and I listened to the argument in the Monolithic Power
9 Systems case last week. What Patent Owner continues to
10 point to is a remand decision of the Board when the
11 Worlds case was returned to the Board for a
12 determination. That remand decision is Paper 64 in IPR
13 2015-01264. And let's be clear about something.
14 That remand decision did not relate to
15 privity. It related to whether there was a Real Party
16 in Interest, an RPI, that was not named. The Real Party
17 in Interest standard and the privity standard are two
18 different things. So what counsel is doing is confusing
19 these issues in a way that is not applicable. And I'll
20 ask the Board to ask counsel for Patent Owner about this
21 issue when he stands up again.
22 If you look, for example, at page 33 and

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1 footnote 10, there's some argument here about
2 involvement in the previous case. In footnote 10, the
3 Board says the argument that it would be unfair for us
4 to bind Petitioner to the District Court litigation via
5 the indemnification provisions and because Petitioner
6 allegedly lacked control over the litigation is
7 misplaced. Such arguments might pertain to a privity
8 analysis, but the issue before us is RPI and focuses on
9 Activision's relationship for the IPRs, not Petitioner's
10 relationship to the District Court litigation.
11 In an RPI analysis, the focus is on the
12 IPR, who was behind it, who funded it, who was -- who
13 can be considered a Real Party in Interest for that IPR.
14 That is not the analysis for privity. Privity concerns
15 whether the Petitioner is attempting to get a second
16 bite at the apple, and it necessarily involves, as
17 WesternGeco tells us, as Google vs TDC Technology tells
18 us, it necessarily involves an analysis of the previous
19 litigation.
20 So to sum up, Patent Owner's entire Worlds
21 remand analysis, which this Board heard in the MPS case
22 last week and this Board just heard today, is entirely

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1 inapposite -- entirely inapposite and does not apply in
2 any manner. Patent Owner is confusing Real Party in
3 Interest with privity, and they are two different
4 things. WesternGeco and the other cases tell us that
5 there has to be some involvement because what we're
6 trying to do is make sure that the party who is in
7 second place is not exercising a second bite at the
8 apple, and that clearly, clearly did not occur here.
9 I think I've said all that I need to say
10 about NCP81248. These are two separate products. This
11 product is sold to customers other than Intel so they
12 can marry these two products together and make a
13 computer system. This is not accused, was never
14 accused, and if it were accused, you'd expect it to be
15 named, of course, and it was not.
16 The fact that NCP81248 is not part of the
17 Intel -- not part of an Intel product is also plainly
18 contradicted by Mr. Murphy's declaration and
19 Mr. Murphy's testimony. The Board will see at the
20 bottom of page 4 of our submission on privity, there's a
21 lengthy listing of Mr. Murphy's statements on the record
22 about subcomponents and what subcomponents could

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1 possibly exist in an Intel CPU, and there are none. And
2 he states over and over again that there are none.
3 I just think it's entirely curious that
4 Exhibit 2006 was never the subject of any questioning,
5 and to say here on the basis of no evidence that it's
6 part of an Intel CPU should be entirely disregarded.
7 Any suggestion that Petitioner did not comply with its
8 discovery obligations in this matter is absolutely false
9 and is not well-taken.
10 We complied with the Board's directive.
11 The Board's directive was to tell us about the
12 Intel-accused products, whether onsemi had any
13 involvement with those Intel-accused products with
14 regard to selling those products or any subcomponents
15 thereof and to tell us whether onsemi had any
16 involvement in the previous litigation or received an
17 indemnification request. We provided all of that
18 evidence through Mr. Murphy's declaration. We also made
19 Mr. Murphy available for a deposition where all those
20 questions could be answered a second time, and they
21 were, in fact, answered.
22 We have complied with our discovery

1 obligations in every respect in this regard. Now, with
2 regard to Murphy's declaration, I'll also note that the
3 Board, in its decision setting out discovery, said that
4 Mr. Murphy's declaration was the kind of discovery that
5 could elucidate and help answer this question. This is
6 on page 4 of Paper 111. And this relates to a previous
7 version of Mr. Murphy's declaration. We actually added
8 more content in what we called the second version, which
9 is in the record at 2103.
10 Exhibit 1058, on its face, appears to be
11 the very type of evidence that may facilitate the fair
12 and efficient resolution of the outstanding privity
13 dispute in accordance with the Director's mandate.
14 So to sum up, we have complied with our
15 discovery obligations. Onsemi, Petitioner, had no
16 involvement whatsoever in the Intel litigation, was not
17 even aware of it. That issue is dispositive. No onsemi
18 parts, subcomponents or technology were issued in the
19 Intel litigation. Onsemi never received an
20 indemnification request. There is no privity whatsoever
21 between onsemi and Intel.
22 And that will conclude my comments.

1 JUDGE ULLAGADDI: Thank you, Counsel. I
2 don't think the Panel has any further questions for you,
3 so we will return to Mr. Whitehurst. I think you've got
4 about 13 minutes or so.
5 EXAMINATION
6 MR. WHITEHURST: Yes. May it please Your
7 Honors, Petitioner still has not produced any actual
8 evidence that there was not a legal relationship with
9 Intel.
10 JUDGE ULLAGADDI: Counsel -- sorry. The
11 Panel would like you to address at some point during
12 your discussion -- I'm sorry to interrupt you -- the
13 privity/RPI distinction in Worlds that Petitioner's
14 counsel was referring to. It doesn't have to be right
15 now but whenever you're ready. Thank you.
16 MR. WHITEHURST: Yes, Your Honor.
17 Whether it's RPI or privity, the relevant
18 inquiry is whether there was a legal relationship, and
19 Petitioner still has not produced any actual evidence
20 that there was not a legal relationship with Intel.
21 Onsemi had an opportunity to produce
22 actual evidence on this issue. It had an opportunity to

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1 produce actual evidence regarding Exhibit 2006, but it
2 chose not to.
3 Now, we just heard some arguments about
4 Exhibit 2006, but everything we just heard is purely
5 attorney argument. It's not a declaration. It's not a
6 deposition transcript. I want to go to the deposition
7 transcript of Mr. Murphy to show you what is in the
8 record.
9 If you look at page 28 (distorted audio)
10 and you look at 8 to 22, you can see where we asked
11 Mr. Murphy, "Well, I'm just asking as part of your
12 investigation, did you speak with anyone in-house at
13 onsemi about whether or not they knew whether any of the
14 Intel products listed on pages 4 through 8 of
15 Exhibit 2048 include onsemi parts?" And he answered
16 "No."
17 And then later, on page -- excuse me. On
18 page 62, and if you look at lines 3 to 17, you'll see
19 where we specifically asked Mr. Murphy about the
20 Intel-accused products. You can see where we asked him,
21 "Do you know whether or not the Intel Atom C2308
22 processor includes any parts or elements whatsoever

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1 manufactured and sold by onsemi?" And he answered "No."
2 We asked him the same question for the
3 Atom C2316 processor. He answered "No." And then we
4 asked him, "And would your answer be the same for the
5 rest of the processors that are listed on pages" -- I
6 believe it was 4 through 8 of Exhibit 2048, and he
7 answered "Yes."
8 So you can see, when you look at what is
9 in the record, that we asked Mr. Murphy about this very
10 point during his deposition, and you can see the
11 strategy that onsemi took to not investigate these
12 chips. He never looked into them. He never provided
13 any information, never provided any actual evidence on
14 this point, whether there was a legal relationship.
15 Now, if you look what is in the record,
16 you'll see Exhibit 2010, and I believe if you look at
17 Section 7, you'll see where we produced onsemi's
18 standard Terms and Conditions, and it includes an
19 indemnification clause. And we asked Mr. Murphy about
20 the standard Terms and Conditions on page 45 of his
21 deposition and if you look at lines 2 through 22, he
22 confirmed that what Greenthread has pointed to applies

1 to all customers and all sales, and he wasn't aware of
2 any different agreements for sales made by onsemi to
3 Intel.
4 So you can see in the record how we
5 produced at least some evidence of why there was a legal
6 relationship between Intel and onsemi for the very
7 products that were accused in the Intel litigation.
8 You can also see from the record how
9 Mr. Murphy chose to not investigate those chips or
10 investigate the sales agreements or investigate the
11 indemnification agreements for those chips. When you
12 have a situation like this, where Patent Owner has
13 produced some evidence of the legal relationship and
14 Petitioner has made a deliberate choice to not
15 investigate or produce some actual evidence to the
16 contrary, there's only one possible outcome under
17 Worlds, and that's termination of the proceedings
18 because Petitioner did not produce actual evidence that
19 they were not in privity with a time-barred party.
20 So you can see, looking at the record, how
21 we produced actual evidence of the legal relationship,
22 and Petitioner, when asked about the details, couldn't

1 provide anything to the contrary.
2 And with that, I will conclude my
3 presentation, unless there are any questions from the
4 Board.
5 JUDGE ULLAGADDI: Thank you, Counsel. Let
6 me put you on hold and confer.
7 MR. FULGHUM: Your Honor, this is Roger
8 Fulghum. I'd like to have a minute, if the Board will
9 allow it, to address the Q and A on page 62 that was
10 just referenced.
11 JUDGE ULLAGADDI: Let me confer with the
12 Panel to see what they think.
13 (Pause)
14 JUDGE ULLAGADDI: Okay, Mr. Fulghum, the
15 Panel will allow you to make a brief argument, and
16 Mr. Whitehurst, you may respond.
17 MR. FULGHUM: Yeah, with regard to what's
18 on page 62, there are two questions, and it is
19 apparent -- and we've provided an errata to this
20 point -- that Mr. Murphy did not either hear or
21 understand the question. Mr. Murphy's answers here are
22 directly contrary to his declaration, his testimony

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before these two questions and his extensive testimony after -- both before and after these two questions.

So we provided an errata. You can see that on the last page of the Exhibit 2103. Mr. Murphy explains his answers and provides a correction. You can also tell that Mr. Murphy did not hear or understand the question from the previous question. This is the question that bridges pages 61 to 62.

The question is similar or the same as the first of these two questions, "Do you know whether or not the Intel" -- go on and on. Mr. Murphy's answer is "One more time."

So it was a telephone deposition. He didn't hear it. Two more questions came out. He gave answers he clearly did not hear or understand, and that explains his answers. It is disappointing that Patent Owner would raise these two Q and As without also referencing the errata, but it's something I felt compelled to do.

And that concludes my comments.

JUDGE ULLAGADDI: Thank you, Counsel. Mr. Whitehurst?

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1 MR. WHITEHURST: Yes, Your Honors.
2 The errata doesn't change anything here.
3 Whether the witness understood the question or not, he
4 was clearly asked about the processors that were accused
5 in the Intel-accused products, and he could not provide
6 any additional information about them during his
7 deposition. You can see on both page 28 and the
8 questions that were asked on 62, that when we asked
9 about these products, he couldn't provide any additional
10 information about any of the onsemi chips.
11 So whether it's the testimony that he
12 actually said during the deposition or the substantive
13 change that he made during -- in his errata, it doesn't
14 change the reality that when we sought to obtain
15 additional discovery on these chips, we were
16 stonewalled. We weren't provided any additional
17 information to the contrary, other than what we had
18 alleged and pointed to and raised during our Director
19 Review Request and what we said from the very beginning,
20 that there was a legal relationship between onsemi and
21 Intel for the products that were accused in the Intel
22 litigation.

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And I have nothing more to add unless the Board has any questions.

JUDGE ULLAGADDI: Thank you, Counsel. I'll confer with the Panel and get back to you all.

(Pause)

JUDGE ULLAGADDI: Okay. Thank you all very much. Your arguments were very helpful to us. We'll take them under consideration and prepare our decisions shortly. If you could please file the transcript as soon as possible, I can't emphasize that enough, it would be very helpful for us. And if you could all stay on the line, or some of you stay on the line, and the Panel will drop off and whatever the court reporter needs, if you could provide that. That would be great.

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STATE OF TEXAS
COUNTY OF HARRIS

REPORTER'S CERTIFICATE
TELEPHONIC HEARING
September 18, 2025

I, the undersigned Certified Shorthand Reporter in and for the State of Texas, certify that the facts stated in the foregoing pages are true and correct.

I further certify that I am neither attorney or counsel for, related to, nor employed by any parties to the action in which this testimony is taken and, further, that I am not a relative or employee of any counsel employed by the parties hereto or financially interested in the action.

SUBSCRIBED AND SWORN TO under my hand and seal of office on this the 18th day of September, 2025.

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