Fulghum, Roger

From: Nicholas T. Matich <nmatich@McKoolSmith.com>
Sent: Wednesday, October 11, 2023 5:31 PM
To: Fulghum, Roger
Cc: DL Greenthread, LLC v. onsemi; Speegle, Mark; Greenthread-OnSemi-MS
Subject: Re: Semiconductor Components Industries LLC (d.b.a. OnSemi) v. Greenthread IPR2023-01242, IPR2023-01243, IPR2023-01244

[EXTERNAL EMAIL]

Roger

Does OnSemi intend to argue that sales to Intel and [redacted] are licensed?

Best
Nick

McKool Smith | Nicholas T. Matich
Principal | Washington, DC | Tel: (202) 370-8301 | Mobile: (703) 863-7922

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From: Fulghum, Roger <Roger.Fulghum@BakerBotts.com>
Sent: Wednesday, October 11, 2023 3:25:43 PM
To: Nicholas T. Matich <nmatich@McKoolSmith.com>
Cc: DL Greenthread, LLC v. onsemi <dlgreenthreadvonsemi@BakerBotts.com>; Speegle, Mark <mark.speegle@bakerbotts.com>; Greenthread-OnSemi-MS <Greenthread-OnSemi-MS@mckoolsmith.com>
Subject: RE: Semiconductor Components Industries LLC (d.b.a. OnSemi) v. Greenthread IPR2023-01242, IPR2023-01243, IPR2023-01244

Nick,

As I told you when we talked by telephone, I received your first e-mail late last week and have been traveling since that time. Also, I told you that my client was out the office this week. Nevertheless, you indicated that this matter was urgent because of the upcoming due date for Greenthread to file a patent owner preliminary response. I would note, however, that onsemi filed its petitions on July 27, which was more than two months before your e-mail of October 5. It is not clear why you waited more than two months to raise the issue below, but now demand an immediate response to your e-mail. The fact that you delayed in raising this issue until now demonstrates that this issue is not meritorious or urgent.

I talked to onsemi about your request. onsemi will not withdraw its petitions or produce documents. onsemi has identified all of the real parties-in-interest in its petitions. Your suggestion that each of [redacted] [redacted] and Intel is a real party-in-interest because certain documents and web pages state that one or more of these companies is an OEM customer of onsemi has no merit whatsoever. Your e-mail includes a citation to Paper 40 in *Samsung Electronics Co. Ltd. v. Netlist Inc.*, IPR2022-00615. Later in that proceeding, the Board ***rejected*** the argument that a "standard customer-manufacturer relationship" caused the customer to be a real party in interest. Paper 64 (which is attached) at 14. The

Samsung decision thus confirms that onsemi's customers — who are not and have not contributed in any respect with the preparation, funding, or control of onsemi's IPR petitions or IPR proceedings —are not real parties-in-interest.

Your statement about the supposed "joint defense group" is factually wrong. onsemi has not signed a joint defense agreement for this matter, and onsemi did not coordinate in any manner with any other defendant on the preparation of the IPR petitions on the '842 and '222 patents.

Let me know if you would like to discuss this issue further.

Regards, Roger Fulghum.

From: Nicholas T. Matich <nmatich@McKoolSmith.com>
Sent: Tuesday, October 10, 2023 4:44 PM
To: Fulghum, Roger <Roger.Fulghum@BakerBotts.com>
Cc: DL Greenthread, LLC v. onsemi <dlgreenthreadvonsemi@BakerBotts.com>; Speegle, Mark <mark.speegle@bakerbotts.com>; Greenthread-OnSemi-MS <Greenthread-OnSemi-MS@mckoolsmith.com>
Subject: Re: Semiconductor Components Industries LLC (d.b.a. OnSemi) v. Greenthread IPR2023-01242, IPR2023-01243, IPR2023-01244

[EXTERNAL EMAIL]

Roger,

Thank you for speaking just now. As I explain in the email below and on our call, it is On Semi's burden to show that its petition is not time barred and that it has named all RPIs. You confirmed that tomorrow you will give us On Semi's position on whether it intends to produce evidence sufficient to carry its burden.

Sincerely,
Nick

McKool Smith | Nicholas T. Matich
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From: Nicholas T. Matich <nmatich@McKoolSmith.com>
Sent: Tuesday, October 10, 2023 6:36:13 AM
To: roger.fulghum@bakerbotts.com <roger.fulghum@bakerbotts.com>
Cc: dlgreenthreadvonsemi@BakerBotts.com <dlgreenthreadvonsemi@BakerBotts.com>; mark.speegle@bakerbotts.com <mark.speegle@bakerbotts.com>; Greenthread-OnSemi-MS <Greenthread-OnSemi-MS@mckoolsmith.com>
Subject: Re: Semiconductor Components Industries LLC (d.b.a. OnSemi) v. Greenthread IPR2023-01242, IPR2023-01243, IPR2023-01244

Roger,

Following up on the below.

Nick

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Principal | Washington, DC | Tel: (202) 370-8301 | Mobile: (703) 863-7922

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From: Nicholas T. Matich <nmatich@McKoolSmith.com>
Sent: Monday, October 9, 2023 8:06:58 AM
To: roger.fulghum@bakerbotts.com <roger.fulghum@bakerbotts.com>
Cc: dlgreenthreadvonsemi@BakerBotts.com <dlgreenthreadvonsemi@BakerBotts.com>; mark.speegle@bakerbotts.com <mark.speegle@bakerbotts.com>; Greenthread-OnSemi-MS <Greenthread-OnSemi-MS@mckoolsmith.com>
Subject: Re: Semiconductor Components Industries LLC (d.b.a. OnSemi) v. Greenthread IPR2023-01242, IPR2023-01243, IPR2023-01244

Roger,

Please let me know when we can expect a response on the below.

Sincerely,
Nick Matich

MCKOOL SMITH

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From: Nicholas T. Matich <nmatich@McKoolSmith.com>
Sent: Thursday, October 5, 2023 12:45:30 PM
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Cc: dlgreenthreadvonsemi@BakerBotts.com <dlgreenthreadvonsemi@BakerBotts.com>; mark.speegle@bakerbotts.com <mark.speegle@bakerbotts.com>; Greenthread-OnSemi-MS <Greenthread-OnSemi-MS@mckoolsmith.com>
Subject: Semiconductor Components Industries LLC (d.b.a. OnSemi) v. Greenthread IPR2023-01242, IPR2023-01243, IPR2023-01244

Dear Roger,

As the petitioner in the above captioned matters, OnSemi has the burden of identifying all real parties in interest (RPIs) in the petition and demonstrating that the petitions are not time barred. *Samsung Electronics Co. Ltd. v. Netlist Inc.*, IPR2022-00615, Paper 40 (Director Vidal Feb. 3, 2023) (quoting *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242 Fed. Cir. 2018) ("[T]he IPR petitioner bears the burden of persuasion to demonstrate that its petitions are not time-barred under § 315(b) based on a complaint served on a real party in interest more than a year earlier.")); 35 U.S.C. § 322(a). The petitions should be withdrawn because they do not to meet these requirements.

First, as the petitions themselves indicate, more than one year before the filing of these petitions, Intel, [redacted] and [redacted] were served with complaints alleging infringement of the patents at issue. These companies appear to be OnSemi customers for whom OnSemi makes specially designed products. *See e.g.* https://www.onsemi.com/download/data-sheet/pdf/ncp81255-d.pdf; https://www.onsemi.com/download/data-sheet/pdf/ena2221-d.pdf; https://finance.yahoo.com/news/invested-1000-semiconductor-corp-decade-123012312.html ("Top OEM customers include … [redacted] … Intel, [redacted] OnSemi 2017 Annual Report at 11 (listing "[redacted] and "[redacted] as "Representative OEM Customers"). Further, OnSemi's standard purchase agreement provides for indemnification of its customers. https://www.onsemi.com/site/pdf/ONSEMI_T&C.pdf. Therefore, OnSemi should either withdraw these petitions or produce documents demonstrating that Intel, [redacted] and [redacted] are not RPIs or privies, including all agreements between OnSemi and these companies.

Second, we understand that there is a joint defense agreement among OnSemi and defendants in other actions involving these patents. OnSemi has challenged claims which have not been asserted against it, but which have been asserted against other defendants, indicating that these petitions were likely filed with an eye to the interests of parties who are not named in the petitions. Therefore, even if these petitions are not time barred for the reasons above, they fail to name all RPIs. OnSemi should (1) withdraw its petitions, (2) amend its petitions to include these parties as RPIs, or (3) produce any joint defense agreement and any communications with other members of the joint defense group relating to the patents at issue (including under a privilege log if necessary) so that we can evaluate any claim by OnSemi that it is acting independently. *Mitek Sys., Inc. v. United Servs. Auto. Ass'n*, No. IPR2020-00882, 2020 WL 4375112, at *7 (P.T.A.B. July 30, 2020) ("granting USAA's request for any joint defense or common interest agreements").

Sincerely,
Nick Matich

McKool Smith | Nicholas T. Matich
Principal | Washington | Tel: (202) 370-8301 | Mobile: (703) 863-7922

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