From: Trials
To: Fulghum, Roger; Trials
Cc: Greenthread-OnSemi-MS; Alan Whitehurst; Arvind Jairam; Neil Ozarkar; Stuart McCommas; Nicholas T. Matich; Barazesh, Ellyar; Speegle, Mark
Subject: RE: Request for Telephone Conference in IPR2023-01242, IPR2023-01243, IPR2023-01244 - Semiconductor Components Industries, LLC v. Greenthread, LLC
Date: Monday, November 27, 2023 12:57:59 PM

Counsel,

From the Board –

In each of the above-referenced proceedings, Petitioner is authorized to file a preliminary reply and supporting evidence, and Patent Owner is authorized to file a preliminary sur-reply and supporting evidence. The briefs and supporting evidence are limited to the issue of whether the Petition is time-barred. No new testimonial evidence is permitted.

Petitioner's preliminary reply may be filed on or before December 13, 2023, and may be no more than 10 pages. Patent Owner's preliminary sur-reply may be filed on or before January 10, 2024, and may be no more than 10 pages.

No conference call with the panel is necessary at this time.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Fulghum, Roger <Roger.Fulghum@BakerBotts.com>
Sent: Thursday, November 16, 2023 1:22 PM
To: Trials <Trials@USPTO.GOV>
Cc: Greenthread-OnSemi-MS <Greenthread-OnSemi-MS@mckoolsmith.com>; awhitehurst@mckoolsmith.com; Arvind Jairam <ajairam@McKoolSmith.com>; Neil Ozarkar <nozarkar@McKoolSmith.com>; SMccommas@mckoolsmith.com; Nicholas T. Matich <nmatich@McKoolSmith.com>; Barazesh, Ellyar <ellyar.barazesh@bakerbotts.com>; Speegle, Mark <mark.speegle@bakerbotts.com>
Subject: Request for Telephone Conference in IPR2023-01242, IPR2023-01243, IPR2023-01244 - Semiconductor Components Industries, LLC v. Greenthread, LLC

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Dear Board,

Petitioner respectfully requests that the Board set a telephone conference in IPR2023-01242,

IPR2023-01243, and IPR2023-01244 to address two issues. The first issue is Petitioner's request to file a Pre-Institution Preliminary Reply addressing the Section 315(b) privity arguments raised by Patent Owner in Patent Owner's Preliminary Responses (POPRs). The second issue is Patent Owner's practice of over-sealing the entirety of its POPRs (including all exhibits) and motions for additional discovery (including all exhibits).

Petitioner's Request for a Preliminary Reply:

Petitioner's Position:

With respect to leave to file a Pre-Institution Preliminary Reply in IPR2023-01242, IPR2023-01243, and IPR2023-01244, Petitioner submits that a Reply is necessary because Patent Owner's lengthy arguments in its POPRs could not have been anticipated in the Petitions. Patent Owner's entire POPR concerns a theory of privity that is entirely novel and that has never been adopted by this Board or any court. In addition, the theory of privity is premised on an agreement -- between Patent Owner and RPX -- that Petitioner had not even seen at the time that Petitioner filed its Petitions and that was only provided to Petitioner in redacted form two weeks ago. Petitioner also respectfully submits that a Preliminary Reply is necessary here because Patent Owner is attempting to use a procedural bar to prevent Petitioner from moving forward with an IPR petition, and the POPRs includes several factual and legal mischaracterizations that should be addressed in a Reply. Good cause exists for authorizing Petitioner to file a Preliminary Reply in order to address the respective parties' lack of involvement in the IPR proceedings, the law of privity, the background facts, and the inapplicability of privity to the facts. Because Patent Owner submitted 25 pages of arguments in its POPRs on the privity bar argument, Petitioner proposes that its Reply be limited to 20 pages and be due in three weeks.

Patent Owner's Position:

Patent Owner's POPR argument is not "novel." It is squarely addressed by a precedential decision of the Board. Petitioner is time barred, because it is a party to, or beneficiary of, multiple "agreements directly related to the product accused of infringing the patent at issue in this proceeding" that put it in privity with time-barred parties. *Ventex Co. v. Columbia Sportswear North America, Inc.*, IPR2017-00651, Paper 148 (PTAB Jan. 24, 2019) (precedential)).

The first set of agreements (Petitioner's indemnity agreements with [redacted] and Intel) are in its exclusive possession, because Petitioner refused to produce them. Patent Owner offered to give Petitioner the other agreement (Patent Owner's license) two months before it filed its petition, but Petitioner ignored the offer. Ex. 2029. Then, Patent Owner actually gave Petitioner the agreement not "in redacted form two weeks ago," but unredacted, in September, and without any request from Petitioner, once discovery opened in district court. Ex. 2044.

Regardless, the Board need not address any "novel" arguments. Petitioner bears the burden of proof on the timeliness of its petition. The Petition should be denied for the simple reason that Petitioner came forward with ***no evidence*** regarding an issue on which it bears the burden, even after seeing Patent Owner's supposedly novel arguments in Patent Owner's email correspondence and motion to compel. Allowing a reply and new evidence in these circumstances would be unfair to

parties who diligently raise issues and encourage petitioners to sandbag on the timeliness of their petitions, knowing that they can always come forward with cherry-picked evidence after seeing a POPR.

Petitioner's Comments on Over-Sealing of Materials:

Petitioner's Position:

With respect to the over-sealing of materials, Petitioner submits that Patent Owner's sealing motions have resulted in the entirety of several submissions in this proceeding being placed under seal, including Patent Owner's recently filed POPRs and motions for additional discovery. At best, the only material that should be sealed are those materials that are truly confidential, and the sealing of materials in their entirety is contrary to public policy. Petitioner does not object to maintaining Patent Owner's License and the RPX declaration under seal.

Patent Owner's Position:

Patent Owner does not object (and never has objected) to unsealing the parties briefing with appropriate redactions. [redacted] Patent Owner and Petitioner have reached a compromise to allow certain of Petitioner's in-house counsel to see these documents with limited redactions. Patent Owner requests entry of a modified protective order reflecting the parties' compromise.

The parties are available for a telephone conference regarding these issues on the following dates:

- Monday, November 20, after 12 p.m. (Central)
- Tuesday, November 21, at any time
- Wednesday, November 22, at any time

Thanks, Roger Fulghum
Lead Counsel for Petitioner

Confidentiality Notice:

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