PUBLIC VERSION

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SEMICONDUCTOR COMPONENTS INDUSTRIES, LLC, and
TEXAS INSTRUMENTS INCORPORATED,
Petitioners,

v.

GREENTHREAD, LLC,
Patent Owner.

_____

Case: IPR2023-01244[1]
U.S. Patent No. 11,121,222

_____

PATENT OWNER'S POST-REMAND BRIEF CONCERNING BOARD-ORDERED DISCOVERY

[1] Texas Instruments Incorporated, which filed a petition in IPR2024-00674, has been joined as a petitioner in this proceeding

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I. INTRODUCTION

In response to the Board's issued discovery Order ("Order," Paper 106), onsemi ("Petitioner") offered a single declaration (EX2103), unaccompanied by any other documents or evidence, of onsemi employee Mark Murphy, who admitted he was not knowledgeable about—and had not investigated—many of the key issues addressed by the Board. In doing so, Petitioner paid lip service to Director Stewart's discovery instructions and did not comply with the directive and intent of the Order. Petitioner was given yet another opportunity to rebut PO's arguments that Petitioner's relationship with Intel gives rise to a privity finding that bars this IPR, and instead of offering definitive evidence, Petitioner merely repackaged attorney arguments found lacking by the Director. PO has been severely prejudiced by having to (i) litigate this full IPR proceeding that should have never been instituted, (ii) request Director Review, and finally (iii) receive the discovery it requested over a year-and-a-half ago. But even now, Petitioner's privity positions *still* remains in question, and the Board should find that the Petition is time-barred and terminate this IPR.

II. BACKGROUND

A. Legal Standard

Petitioner ultimately bears the burden to prove that (1) it properly identified all real-parties-in-interest and (2) its petition is not time-barred. *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237,1246 (Fed. Cir. 2018). But when PO "brings into

question the accuracy of Petitioner's [RPI] identification," the Board can no longer rely on Petitioner's representations. *Id.* at 1242. This is a low bar for patent owners. *Id.* at 1244 (holding that "a patent owner must produce *some* evidence that *tends* to show that a particular third party should be named a real party in interest.") (emphasis original)[2]. Once PO has "put this issue into dispute," Petitioner has to produce "actual evidence" to prove lack of privity, rather than rely upon "attorney argument." *Id.* at 1244 n.8, 1246.

B. Evidence of onsemi's Relationship with Intel

To this point, PO has presented far more than "some evidence" that time-barred parties, including Intel,[3] should have been named as RPI in the Petition. PO served Intel with an infringement complaint on February 1, 2022, which is more than one year before the present Petition was filed. EX2018. It is undisputed that Intel is one of Petitioner's customers. EX2009 at 2 (listing Intel as a "[t]op OEM customer"); *see also* EX2104 at 63:15-17, 38:1-3. Intel confirms that Petitioner is one of its

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[2] All emphases added unless otherwise noted.

[3] PO maintains that Petitioner is in privity with both [redacted] and [redacted] two other time-barred parties. PO also maintains that discovery should have been granted as to these parties for at least the reasons presented in PO's portion of the Joint Paper Concerning Additional Discovery. *See* Paper 108 at 2-5.

suppliers. EX2004 at 10-13. As a result, Petitioner received a sublicense as a "have made vendor" to make and sell products to Intel under Intel's license with PO. EX2022 at 3. Petitioner also makes custom products for its OEM customers. EX2053; EX2104 at 29:2-13. Mr. Murphy confirmed that Petitioner "collaborate[s] with Intel on special projects." *Id.* at 46:12-15; *see also* EX2006-08 (onsemi products made specifically to integrate with Intel's "proprietary interface").

Per its "Standard Terms and Conditions of Sale" (T&Cs), Petitioner indemnifies its customers. EX2010. These T&Cs apply to all onsemi sales and every customer, including Intel. EX2104 at 43:19-44:6, 45:14-46:5 ("Q. Are you aware as to whether or not there is a different agreement in place for sales made by onsemi to Intel? A. No."). Mr. Murphy confirmed that the indemnity provisions of Petitioner's Standard T&Cs require Petitioner to "indemnify a buyer based upon a claim of patent infringement of a product purchased from onsemi." *Id.* at 74:15-22.

C. Director Review and the Board's Discovery Order

PO was granted Director Review of the Board's now-vacated Final Written Decision ("DR," Paper 91) based, in large part, on the Board's denial of PO's original discovery motion. Director Stewart found, based on PO's earlier evidence, "Petitioner was a supplier of a time-barred party, Intel," and agreed with PO that "discovery would yield useful information on the privity issue." *Id.* at 3. In effectuating the Director's directive, the Board ordered Petitioner to produce

"documents sufficient to show the asserted privity relationship between Petitioner and Intel," including, but not limited to, a declaration. Order at 10. Petitioner offered nothing beyond a declaration.

III. ARGUMENT

Director Stewart ordered discovery that would "yield useful information on the privity issue." DR at 3. Instead, Petitioner submitted a boilerplate declaration that parrots attorney argument and falls short of any plausible definition of an investigation. Petitioner did not comply with the directive or intent of the Director's—and the Board's—discovery orders, and as a result, has failed to present any meaningful evidence disproving Intel's status as an RPI to this IPR.

A. Mr. Murphy's Declaration is Nothing More Than Repackaged Attorney Argument

"Attorney argument is not evidence." *Icon Health & Fitness, Inc. v. Strava, Inc.*, 849 F.3d 1034, 1043 (Fed. Cir. 2017). Nor is declaration testimony submitted by a witness that merely repeats its previously-offered attorney argument without providing any additional detail, documentation, or substantiation to those arguments.

Here, Mr. Murphy is merely the corporate mouthpiece for Petitioner's attorney arguments. When asked about his role in preparing the declaration, Mr. Murphy admitted that "the Legal Department convey[ed] to [him] what is stated in [his] declaration." EX2104 at 99:13-17. When asked if he actually wrote this

declaration, Mr. Murphy could not offer a simple "yes." All he could confirm was that "[i]t was prepared with" Petitioner's in-house counsel. *Id.* at 11:20-21.

Elsewhere, after discussing the declaration's statements concerning his "investigation" into Petitioner's indemnity obligations and history, Mr. Murphy was asked if this was "part of the Legal Department's contribution to your declaration." EX2104 at 96:11-12. Mr. Murphy avoided the question altogether and proceeded to just re-read the paragraph (¶8) verbatim from the declaration. *Id.* at 96:13-97:20. This was, in fact, a thorny issue in Mr. Murphy's deposition after he admitted that he did *not* have independent knowledge nor did he ask counsel whether Petitioner had received indemnification requests in any litigation—Intel or otherwise. *Id.* at 50:3-20. Mr. Murphy confirmed this on redirect, explaining that "in connection with what is in Paragraph 8," he "did not ask" any questions, but "was told that this is the case." *Id.* at 85:10-86:8. There is simply no way Mr. Murphy could have "confirmed" his prior understanding with Petitioner's legal department. EX2103 at ¶8. The only "knowledge" that Mr. Murphy had on the subject was based on what counsel represented to him and drafted in the declaration. *See* EX2104 at 94:12-96:10 ("Q. Well then, how could you have consulted with onsemi's Legal Department and received confirmation about no receipt of an indemnity request if you didn't ask the question? ***A. They told me.***").

Petitioner has taken the same exact attorney arguments the Director has previously ruled are insufficient to rebut PO's offered evidence and given them a new face. Rather than taking the opportunity afforded by the Director and the Board to get out from under the cloud of "attorney argument," Petitioner submitted a boilerplate declaration that fails to address the Board's concerns. Mr. Murphy said nothing beyond what Petitioner's counsel has previously argued to the Board, and this "evidence" should not be considered in the Board's determination whether the Petition is time-barred.

B. Mr. Murphy Conducted a Superficial "Investigation"

The Board ordered Petitioner to produce documents "sufficient to show the asserted privity relationship between [it] and Intel." Order at 10. Nothing Petitioner did in response would qualify as "sufficient." At every step of his "investigation," Mr. Murphy testified to doing the bare minimum. As explained below in detail, he did not contact anyone within the company or at Intel to discuss whether any Intel parts (accused or otherwise) included Petitioner's components. All Mr. Murphy "confirmed" was that Petitioner does not sell the Intel Accused Products (IAPs) *to* Intel, something that PO has never alleged.

It is telling that when first questioned on whether and to what extent of investigation he performed, Mr. Murphy was instructed by counsel not to answer. EX2104 at 13:15-15:15 ("[Y]ou are instructing the witness not to answer the

question as to what type of investigation he did when preparing this declaration."). Mr. Murphy conducted no real investigation, and Petitioner tried to deflect from that.

1. Mr. Murphy Reviewed the List of Intel Accused Products and Nothing Else

Petitioner failed to comply with the directive and intent of the Board's discovery Order (Paper 111), instead following the most literal reading possible. Mr. Murphy explained that *all* he did was "read Exhibit [2048,] Pages 4 through 8." EX2104 at 15:21-16:11. Mr. Murphy "***did nothing after that***"—he and in-house counsel "updated the second declaration and ***that was it***." *Id.* at 18:4-12. These were the only "boundaries of the investigation that [Mr. Murphy] performed." *Id.* at 18:19-19:2. Mr. Murphy quickly reviewed the list of IAPs and determined that they do not sell those products to Intel. *Id.* at 20:21-21:3. Of course, that literal reading of the Board's Order is preposterous, so, unsurprisingly, this did not take "very long" and was done in "[l]ess than an hour." *Id.* at 19:18-20:6. But PO has never accused Petitioner of selling the complete IAPs, and for Mr. Murphy to focus his entire investigation on this hyper-literal point certainly does not "yield useful information" for the Board to consider. Basically, Mr. Murphy briefly looked at the list of IAPs, concluded "we are not Intel," and stopped there. *Id.* at 20:21-21:21 (agreeing that his investigation "did [not] really even require" reviewing the list of IAPs, since he "know[s] for a fact that onsemi doesn't actually sell Intel processors back to Intel.").

Petitioner has not established whether or not it was the "supplier of any … ***component*** of a product[] accused in the Intel litigation," as required by the Board. Order at 10. Mr. Murphy admitted he "did no further investigation" to "determine whether any of the Intel processors" listed in Exhibit 2048 "include a product made or sold by onsemi." EX2104 at 26:14-27:1. Later, he tried to "confirm that all of the Intel processors listed … do not include an onsemi chip, MOSFET or transistor element," but instead of describing the investigation he conducted on the matter, Mr. Murphy offered nothing beyond his "understanding" and that he has "been at onsemi for a long time," but admitted that he did not "know specifically what parts Intel buys from onsemi." *Id.* at 34:4-14, 53:9-11. Mr. Murphy also failed to investigate whether Petitioner sells certain other components—namely, ASICs, SIPs, and integrated passive devices—to Intel. *Id.* at 42:2-43:18; EX2053.

Mr. Murphy clearly admitted that he does not "know whether or not the Intel Atom C2308"—or any of the other processors included in the list of IAPs—"includes any parts or elements whatsoever manufactured and sold by onsemi." EX2104 at 62:3-17. He had no "understanding of what these Intel Atom processors

include physically." *Id.* at 87:8-10. Nor could he.[4] Mr. Murphy (and presumably no one else at onsemi) has "ever seen a parts list for an Intel Atom C2308" or the other IAPs. *Id.* at 88:15-89:8. Petitioner undertook no efforts to learn whether any of its parts are incorporated into Intel processors. Petitioner reviewed no parts lists, data sheets, and never asked Intel. *Id.* at 89:10-15. As a result, Petitioner's "investigation" into its relationship with Intel is far from thorough and severely lacking.

2. Mr. Murphy Consulted With No One at onsemi or Intel

Petitioner selected Mr. Murphy to serve as the spokesperson for its attorney argument, even though he did nothing to inform himself of the relevant facts. He repeatedly admitted that he spoke with no one at onsemi about the company's

[4] When examined on re-direct by Petitioner's counsel, Mr. Murphy tried to recant his prior testimony that he could not definitively state whether any of the IAPs include components made or sold by Intel. Now, he testified that he "know[s] that they do not." *See* EX2104 at 83:6-84:11. Mr. Murphy denied that he "answer[ed] that question differently during [his] prior testimony," and instead claims that he "need[ed] to correct" a "misunderstanding." *Id.* Tellingly, Petitioner's counsel asked no follow-up questions to understand *how* or *why* Mr. Murphy was so resolute in his answers and instead opted to move on to a different subject.

relationship with Intel (aside from accepting in-house counsel's representations wholesale), nor did he reach out to Petitioner's known contacts at Intel.

Because Intel is one of Petitioner's OEM customers, there are members of Mr. Murphy's sales team "responsible for communicating with Intel." EX2104 at 38:10-13. Significantly, these people were "better positioned" to answer questions related to products Petitioner currently sells to Intel and other details of their business relationship. *Id.* at 24:20-25:2. These members of Mr. Murphy's sales team "communicate with employees for Intel regarding issues related to onsemi products." *Id.* at 52:8-11; EX2103 at ¶8. These issues include, but are not limited to, "[q]uality issues, market conditions, [and] technical questions," EX2104 at 52:12-53:1, but Mr. Murphy was "not the right person" to explain the "context of those types of discussions," *id.* at 54:12-55:2. Yet, Mr. Murphy never "consult[ed] with any of these people … in the preparation of [the] declaration." *Id.* at 25:5-8. He did not "speak with anyone in-house at onsemi about whether or not they knew whether any of the [IAPs]… include onsemi parts." *Id.* at 28:8-22, 19:8-11.

Mr. Murphy also spoke to no one at onsemi about the company's financial arrangements with Intel. He never asked (1) "whether or not Intel had a special set of Terms and Conditions related to sales," EX2104 at 46:1-5, (2) "whether Intel had ever submitted an indemnification request to onsemi in connection with" PO's prior litigation against Intel, *id*. at 50:7-10, or (3) "whether onsemi had ever received an

indemnification request in connection with any other litigation," *id*. at 50:16-20. Mr. Murphy later admitted that he did not know "how to find documents showing the [T&Cs] of sales" to Intel, but that somebody else would. *Id.* at 65:11-14.

Mr. Murphy never asked his "team member who works with Intel to reach out to Intel as part of [his] investigation," EX2104 at 98:16-20, and tellingly, he never went straight to the best source of information—Intel itself. Mr. Murphy did not "speak with anyone at Intel about the [IAPs]," *id.* at 19:14-17, including "contact[ing] Intel to find out if they purchased onsemi parts or products for use in the processors" or whether "any of the processors … include a product made or sold by onsemi" that Intel would have acquired from another supplier or distributor, *id.* at 27:3-7, 31:2-6. As mentioned previously, he never "ask[ed] Intel for a parts list for each of the [IAPs] as part of [the] investigation." *Id.* at 89:9-12. When asked if he "contact[ed] Intel *at all* as part of [the] investigation, Mr. Murphy answered clearly, "***No***." *Id.* at 89:13-15. The Board should not reward Petitioner for sticking its head in the sand.

The declarant Petitioner offered to respond to the Board's Order was not properly equipped to handle the discovery request. Aside from his background and cursory review of the list of IAPs, Mr. Murphy lacked the requisite knowledge to make the claims included in his declaration. There are other people employed at onsemi and Intel with more relevant information, and the fact that Mr. Murphy spoke to none of them indicates the hollowness of his investigation.

3. Mr. Murphy Performed No Investigation into Sales Made by Resellers, Subsidiaries, Affiliates, or Other Direct Sales to Intel

Just as Mr. Murphy failed to inquire of his sales team, others at onsemi, or Intel itself, he never investigated whether any of Petitioner's affiliates, subsidiaries, or third-party resellers provide parts that Intel then incorporates into its products. Mr. Murphy only informed himself of the bare fact that Petitioner does not sell the IAPs themselves and effectively turned a blind eye toward any indirect sales to Intel.

Mr. Murphy first explained that Semiconductor Components Industries, LLC ("SCI"), a subsidiary of Petitioner, "resell[s] its products," EX2104 at 56:15-22, but then, oddly, later claimed he "[didn't] know the answer to that question," *id.* at 60:2-6. It is telling that Mr. Murphy performed no investigation into this subsidiary and how it operates as part of preparing the declaration. *Id.* at 64:4-10, 58:22-59:2. Further, he did not investigate any *other* affiliates or subsidiaries of Petitioner. *Id.* at 93:17-94:2. As a result, Mr. Murphy utterly failed to investigate "whether any of the affiliates and subsidiaries, as listed in Line 1 of [EX2010], make or sell any parts or components and then sell them to Intel." *Id.* at 91:8-16. He gave the same answer for the specific subsidiary, SCI. *Id.* at 60:16-61:7.

Because Mr. Murphy never contacted Intel nor reviewed Intel parts lists as part of his investigation, he did not know "whether Intel purchases onsemi products from a reseller for use in [Intel's] products." EX2104 at 30:13-17. He did acknowledge that Petitioner does sell products to third-party resellers and

distributors, but did not investigate whether they, in turn, sell Petitioner's products to Intel. *Id.* at 55:19-56:8. That Mr. Murphy never investigated any of Petitioner's affiliates, resellers, or distributors similarly reflects that his investigation was incomplete and inadequate to satisfy the Board's discovery Order.

4. Mr. Murphy Admitted to Not Investigating Terms and Conditions of Sale and Whether onsemi Indemnifies its Customers

Last, Mr. Murphy confirmed that he did no investigation whatsoever into Petitioner's Terms and Conditions of Sale, indemnity clauses contained therein, or Petitioner's indemnity obligations to Intel and other customers. As discussed already, Mr. Murphy relied entirely on what counsel "told" him and had drafted in the declaration concerning any indemnity requests. EX2104 at 85:10-86:8, 94:12-96:10.

Tellingly, Mr. Murphy could not have conducted any investigation himself. He does not "know how to find documents showing the [T&Cs] of sale" between Petitioner and Intel, EX2104 at 65:11-14, and because of that, he did not even "***try to locate*** any documents including those [T&Cs] of sales made to Intel as part of [his] investigation," *id.* at 44:15-18. Furthermore, he never directed anybody on his sales team to "try and find documents showing [T&Cs] of sales to Intel," *id.* at 44:19-45:1, nor did he "ask anyone in the Legal Department to collect any documents" concerning the same, *id.* at 65:20-66:7. Mr. Murphy performed the same "investigation" related to indemnification requests. When asked if he ever asked Petitioner's Legal Department "whether Intel had ever submitted an indemnification

request to onsemi in connection with the Intel litigation," the answer was clear: "***I didn't, no***." *Id.* at 50:3-10. The answer was the exact same for "indemnification request[s] in connection with any other litigation." *Id.* at 50:11-20 ("***No***.").

On every relevant subject, Petitioner's investigation was a non-investigation. Petitioner offered the testimony of a single corporate declarant, who repeatedly testified that he lacked knowledge on key subjects related to Petitioner's relationship with Intel. Even worse, he did nothing to inform himself. Instead, Mr. Murphy relied solely on what counsel told him and drafted in the declaration.

C. Petitioner Presented No Evidence Supporting Mr. Murphy's Statements

The Board ordered Petitioner to produce "[d]ocuments sufficient to show the asserted privity relationship between Petitioner and Intel." Order at 10. Not only does Mr. Murphy's conclusory declaration fail to satisfy the Order, but Petitioner offered no accompanying documents to substantiate the claims made by its declarant. While the Board only ordered Petitioner to produce sales and indemnification agreements "for the [IAPs]," any agreements or communications between Petitioner and Intel for *other* products would necessarily speak to the "asserted privity relationship." *Id.* The Board mentioned "documents" separate from, and in addition to, "declarations[] and deposition transcripts." *Id.* at 11. Further, any documents reviewed or created as part of any investigation into Petitioner's relationship with Intel should have been produced to substantiate any assertion made in the declaration.

Throughout his deposition, Mr. Murphy confirmed that there would be documents to support (or not support) the assertions he made in the declaration. *E.g.*, EX2104 at 44:7-13 ("Q. So, if onsemi sold any products to Intel, there would be documents showing those standards and [T&Cs] of sale, right? [A.] ***Yes, I think there is.***") But he never even attempted to "locate any documents" and never asked for help from his sales team or Petitioner's Legal Department to "collect any documents showing onsemi [T&Cs] of sale to products sold to Intel." *Id.* at 44:15-18, 65:20-66:7. This is just one example where Mr. Murphy's "investigation" would have yielded documents that needed to be produced to corroborate his declaration. Instead, Petitioner provided zero responsive documents and relied entirely on its boilerplate, attorney-generated declaration.

IV. CONCLUSION

PO has sufficiently put the privity issue into dispute, and Petitioner has now had more than enough opportunities to prove that its products are not included in the IAPs, or that its relationship with Intel does not give rise to a privity finding. Petitioner has failed at every step of the process. This has caused a lengthy and expensive sideshow that should have been resolved in PO's favor at the institution phase. For these reasons, Petitioner has *still* failed to meet its burden by failing to comply with the Discovery Order and the Director's remand instructions, and the Board should terminate this proceeding as time-barred.

Dated: August 12, 2025

Respectfully submitted,

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that a copy of this **PATENT OWNER'S POST-REMAND BRIEF CONCERNING BOARD-ORDERED DISCOVERY** has been served on Petitioner via email on the following counsel of record for Petitioner:

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