From:	Weidenfeller, Scott
To:	Arvind Jairam; david.bluestone@bfkn.com; OSRAM-GREENTHREAD@lockelord.com
Cc:	Greenthread-Omnivision-MS; Greenthread-Cirrus-MS; Greenthread-ams-OSRAM-MS; Paul, Rajesh; Park, Han; Sharma, Anupam; bgreene@duanemorris.com; waliddell@duanemorris.com; dnguyen@lockelord.com; emma.bennett@lockelord.com
Subject:	RE: Cirrus Logic Inc. et al. v. Greenthread LLC, IPR2024-00001, -00016, -00017, -00018, 00019, 00020, 0021
Date:	Friday, December 22, 2023 10:24:01 AM
Attachments:	image001.png image002.png

Hello, Arvind.

We are unable to respond substantively before 12:00 ET today, less than 20 hours after you sent your email late on a Thursday while many of us are traveling for the holidays. We will let you know our position on Tuesday or Wednesday next week.

Scott

From: Arvind Jairam <ajairam@McKoolSmith.com>
Sent: Thursday, December 21, 2023 4:19 PM
To: Weidenfeller, Scott <SWeidenfeller@cov.com>; david.bluestone@bfkn.com; OSRAM-GREENTHREAD@lockelord.com
Cc: Greenthread-Omnivision-MS <Greenthread-Omnivision-MS@mckoolsmith.com>; Greenthread-Cirrus-MS <Greenthread-Cirrus-MS@mckoolsmith.com>; Greenthread-ams-OSRAM-MS <Greenthread-ams-OSRAM-MS@mckoolsmith.com>; Paul, Rajesh <RPaul@cov.com>; Park, Han <HPark@cov.com>; Sharma, Anupam <asharma@cov.com>; bgreene@duanemorris.com; waliddell@duanemorris.com; dnguyen@lockelord.com; emma.bennett@lockelord.com
Subject: RE: Cirrus Logic Inc. et al. v. Greenthread LLC, IPR2024-00001, -00016, -00017, -00018, 00019, 00020, 0021

[EXTERNAL]
Counsel,

Patent Owner intends to file a motion to seal, which will seek to seal Patent Owner's motion for additional discovery and licensing-related exhibits that Patent Owner will be filing. Please let us know, by noon Eastern tomorrow, whether Petitioner will oppose the motion to seal.

Best,
Arvind

McKool Smith | Arvind Jairam
Senior Counsel | Washington, D.C. | Tel: (202) 370-8324

NOTICE OF CONFIDENTIALITY: The information contained in and transmitted with this e-mail is SUBJECT TO THE ATTORNEY-CLIENT and ATTORNEY WORK PRODUCT PRIVILEGE and is CONFIDENTIAL. It is intended only for the individual or entity designated above. You are hereby notified that any dissemination, distribution, copying, use or reliance upon the information contained in and transmitted with this e-mail by or to anyone other than the addressee designated above by the sender is unauthorized and strictly prohibited. If you have received this e-mail in error, please notify the sender by reply immediately. Any e-mail erroneously transmitted to you should be immediately destroyed.

From: Trials <Trials@USPTO.GOV>
Sent: Thursday, December 21, 2023 10:38 AM
To: Trials <Trials@USPTO.GOV>; Nicholas T. Matich <nmatich@McKoolSmith.com>
Cc: Greenthread-Omnivision-MS <Greenthread-Omnivision-MS@mckoolsmith.com>; Greenthread-Cirrus-MS <Greenthread-Cirrus-MS@mckoolsmith.com>; Greenthread-ams-OSRAM-MS <Greenthread-ams-OSRAM-MS@mckoolsmith.com>; OSRAM-GREENTHREAD@lockelord.com; Paul, Rajesh <RPaul@cov.com>; Park, Han <HPark@cov.com>; Sharma, Anupam <asharma@cov.com>; bgreene@duanemorris.com; waliddell@duanemorris.com; dnguyen@lockelord.com; emma.bennett@lockelord.com; david.bluestone@bfkn.com; Weidenfeller, Scott <SWeidenfeller@cov.com>
Subject: RE: Cirrus Logic Inc. et al. v. Greenthread LLC, IPR2024-00001, -00016, -00017, -00018, 00019, 00020, 0021

Counsel,

No conference call is necessary. Patent Owner is authorized to file a motion for additional discovery, limited to 15 pages, in each proceeding. Patent Owner's motion shall be filed no later than January 4, 2024. The motion shall include a list of proposed discovery requests, and that list shall not count against the page limit. The motion should discuss the individual requests, the application to those requests of the factors in *Garmin International, Inc. v. Cuozzo Speed Technologies LLC*, IPR2012-00001, Paper 26, at 6–7 (PTAB Mar. 5, 2013), and the extent to which the requested discovery is in the interests of justice under currently controlling case law regarding privity and real party-in-interest issues.

Petitioner is authorized to file an opposition, also limited to 15 pages, in each proceeding. Petitioner's opposition shall be filed no later than 2 weeks after Patent Owner's motion is filed. If Petitioner files an opposition, Patent Owner is authorized to file a reply, limited to 5 pages, in each proceeding. Patent Owner's reply shall be filed no later than 1 week after Petitioner's opposition is filed.

Regards,

Andrew Kellogg,
Supervisory Paralegal
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
(571)272-7822

From: Trials <Trials@USPTO.GOV>
Sent: Wednesday, November 1, 2023 10:23 AM
To: Nicholas T. Matich <nmatich@McKoolSmith.com>; Trials <Trials@USPTO.GOV>
Cc: Greenthread-Omnivision-MS <Greenthread-Omnivision-MS@mckoolsmith.com>; Greenthread-Cirrus-MS <Greenthread-Cirrus-MS@mckoolsmith.com>; Greenthread-ams-OSRAM-MS

<Greenthread-ams-OSRAM-MS@mckoolsmith.com>; OSRAM-GREENTHREAD@lockelord.com; Paul, Rajesh <RPaul@cov.com>; Park, Han <HPark@cov.com>; Sharma, Anupam <asharma@cov.com>; bgreene@duanemorris.com; waliddell@duanemorris.com; dnguyen@lockelord.com; emma.bennett@lockelord.com; david.bluestone@bfkn.com; Weidenfeller, Scott <SWeidenfeller@cov.com>
Subject: RE: Cirrus Logic Inc. et al. v. Greenthread LLC, IPR2024-00001, -00016, -00017, -00018, 00019, 00020, 0021

Good morning counsel,

There are no judge panels assigned to the above-referenced cases. Your e-mail will be shared with the judge panel(s) once assigned.

Regards,

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

From: Nicholas T. Matich <nmatich@McKoolSmith.com>
Sent: Wednesday, November 1, 2023 9:43 AM
To: Trials <Trials@USPTO.GOV>
Cc: Greenthread-Omnivision-MS <Greenthread-Omnivision-MS@mckoolsmith.com>; Greenthread-Cirrus-MS <Greenthread-Cirrus-MS@mckoolsmith.com>; Greenthread-ams-OSRAM-MS <Greenthread-ams-OSRAM-MS@mckoolsmith.com>; OSRAM-GREENTHREAD@lockelord.com; Paul, Rajesh <RPaul@cov.com>; Nicholas T. Matich <nmatich@McKoolSmith.com>; Park, Han <HPark@cov.com>; Sharma, Anupam <asharma@cov.com>; bgreene@duanemorris.com; waliddell@duanemorris.com; dnguyen@lockelord.com; emma.bennett@lockelord.com; david.bluestone@bfkn.com; Weidenfeller, Scott <SWeidenfeller@cov.com>
Subject: Cirrus Logic Inc. et al. v. Greenthread LLC, IPR2024-00001, -00016, -00017, -00018, 00019, 00020, 0021

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

IPR2024-00001, -00016, -00017, -00018, 00019, 00020, 0021

Your Honors,

Patent Owner Greenthread LLC requests a conference call with the Board so that it may request authorization to file a motion for additional discovery in the above-referenced proceedings. The proposed additional discovery pertains to whether the Petitions are time barred under 35 U.S.C. § 315(b). Patent Owner's request is similar to the discovery Patent Owner seeks in Semiconductor Components Industries LLC (d.b.a. OnSemi) v. Greenthread, IPR2023-01242, IPR2023-01243,

IPR2023-01244, where the Board already granted leave for Patent Owner to file motions for additional discovery.

Intel and Sony (by virtue of Sony's RPI relationship with Dell) are time-barred from filing a petition on the patents at issue. Samsung is time-barred with respect to U.S. Patents 8,421,195 at issue in IPR2024-00017 and 9,190,502 at issue in IPR2024-00018. Intel, Sony, and Samsung are also Patent Owner's licensees. Publicly available information indicates that at least one of Cirrus Logic, Inc., OmniVision Technologies, Inc., and ams Sensors USA, Inc. (the Petitions refer to these entities collectively as "Petitioner") (and/or GlobalFoundries U.S., which is listed as an RPI in the Petitions) is a manufacturer/supplier to each for Intel, Samsung, and Sony. For example, RPI Global Foundries recently said publicly to investors that it manufactures products for Intel, Samsung, and Sony. Petitioner OmniVision supplies to Intel the OV9282 image sensor, which is accused in the currently pending litigation against OmniVision. Petitioner Cirrus Logic has publicly disclosed that Sony and Samsung are its customers. If, as it appears, Petitioners (and RPI GlobalFoundries) are acting on behalf of Patent Owner's licensees under the "have made" clause of the licenses, then Petitioners (and RPI GlobalFoundries) are in privity with the time-barred licensees. Thus, the instant Petitions would be time-barred.

Patent Owner seeks discovery of:
1. The identity of products Petitioner (and RPI GlobalFoundries U.S.) sold to or made for Intel, Sony, or Samsung.

2. Agreements between Petitioner (and RPI GlobalFoundries U.S.) and Intel, Dell, and/or Sony relating to the products Petitioner sells to Intel, Dell, and/or Sony, including sales contracts and design agreements.

3. Communications between Petitioner (or its affiliates) and Intel, Dell, and/or Sony relating to the design of products Petitioner makes for them.

4. Whether each Petitioner entity believes that it is making or selling products under Patent Owner's licenses to Intel, Sony, or Samsung, including whether it intends to assert the defense of license with regards to any products in this the concurrent district court litigation (or future litigation as to GlobalFoundries).

Patent Owner met and conferred with Petitioner prior to sending the present email.

Petitioner's position: Petitioner opposes Patent Owner's request. The request is nothing more than a fishing expedition that would waste both party and administrative resources. On its face, the request violates at least two *Garmin* factors.

First, Patent Owner has not met its burden to show by "more than a possibility and mere allegation that something useful will be discovered" under factor one. Other than the OmniVision OV9282, which is an accused product for the OmniVision litigation (and is thus, by Patent Owner's own contentions, outside the scope of the licenses Patent Owner has with the time-barred parties), Patent Owner is not pointing to specific products at issue in the prior cases that would lead to a

privity issue. Instead, they are seeking broad and generic discovery without a reasonable basis to believe they will find evidence of privity.

Second, Patent Owner's request number four, which asks Petitioners to identify whether "it is making or selling products under Patent Owner's licenses . . . , *including whether it intends to assert the defense of license with regards to any products in this [sic] the concurrent district court litigation*," seeks Petitioners' "litigation positions or the underlying basis for those positions" in violation of *Garmin* factor two.

If the Board would find it helpful, the parties are available for a conference call during the following dates:
Thursday and Friday, Nov. 2-3

If the above dates do not work, then the parties are happy to provide alternative dates for the conference.

Respectfully,
Nick Matich
Counsel for Patent Owner Greenthread LLC

MCKOOL SMITH

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

NOTICE OF CONFIDENTIALITY: The information contained in and transmitted with this e-mail is SUBJECT TO THE ATTORNEY-CLIENT and ATTORNEY WORK PRODUCT PRIVILEGE and is CONFIDENTIAL. It is intended only for the individual or entity designated above. You are hereby notified that any dissemination, distribution, copying, use or reliance upon the information contained in and transmitted with this e-mail by or to anyone other than the addressee designated above by the sender is unauthorized and strictly prohibited. If you have received this e-mail in error, please notify the sender by reply immediately. Any e-mail erroneously transmitted to you should be immediately destroyed.