From:	Trials
To:	Arvind Jairam; Trials
Cc:	Fulghum, Roger; Speegle, Mark; Barazesh, Ellyar; Daniel.Anderson@andersonpatents.com; DL Greenthread, LLC v. onsemi; Greenthread-OnSemi-MS
Subject:	RE: IPR2024-00263, -00264, -00265, -00266
Date:	Tuesday, February 20, 2024 12:34:06 PM
Attachments:	image001.png image002.png

Counsel,

From the Board –

Patent Owner is authorized to file a 3-page request for authorization to file a motion for additional discovery in the four identified cases. With its request, Patent Owner may file as exhibits relevant briefing from IPR2023-01242, -01243, and/or -01244 that highlight the parties' arguments for and against such additional discovery. Petitioner is authorized to file a 3-page opposition to Patent Owner's request and may include as exhibits any relevant briefing that was not submitted in support of Patent Owner's request.

Patent Owner's request for authorization is due on or before 2/27/2024 and Petitioner's Opposition, if any, is due on or before March 5, 2024.

Regards,

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

From: Arvind Jairam <ajairam@McKoolSmith.com>
Sent: Thursday, February 15, 2024 11:32 AM
To: Trials <Trials@USPTO.GOV>
Cc: Fulghum, Roger <Roger.Fulghum@BakerBotts.com>; Speegle, Mark <mark.speegle@bakerbotts.com>; Barazesh, Ellyar <ellyar.barazesh@bakerbotts.com>; Daniel.Anderson@andersonpatents.com; DL Greenthread, LLC v. onsemi <dlgreenthreadvonsemi@BakerBotts.com>; Greenthread-OnSemi-MS <Greenthread-OnSemi-MS@mckoolsmith.com>
Subject: IPR2024-00263, -00264, -00265, -00266

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IPR2024-00263, -00264, -00265, -00266

Your Honors,

Patent Owner Greenthread LLC requests authorization to file a motion for additional discovery in the above-referenced proceedings. Alternatively, given that the parties have already completed briefing regarding the same additional discovery issue in prior IPRs (IPR2023-01242, -01243, -01244), the parties seek guidance on whether and how the Board may make of record in the present proceedings the parties' briefing from the prior IPRs. Specifically, Greenthread wishes to preserve this discovery issue for appeal in the present proceedings, and the parties would like to avoid the expense and time of going through the same briefing as before if there is a way for the Board to make the earlier proceedings' briefing of record in the present proceedings, to save resources on the part of the parties and also the Board.

The proposed additional discovery pertains to whether the petitions in the above captioned proceedings are time barred under 35 U.S.C. § 315(b). Publicly available information indicates that Petitioner sells custom products to Intel, Dell, and Sony, and indemnifies them for claims of patent infringement. All three companies (i.e. Intel, Dell, and Sony) are time barred. Therefore, if any of the three companies is in privity with Petitioner, the petitions are time barred.

Patent Owner seeks discovery of:

1. agreements between petitioner (or its affiliates) and Intel, Dell, and Sony relating to the products Petitioner sells to Intel, Dell, and Sony, including sales contracts and design agreements

2. communications between petitioner (or its affiliates) and Intel, Dell, or Sony relating to the design of products Petitioner makes for them

3. whether OnSemi intends to take the position in the district court litigation involving the challenged patents, that OnSemi's sales to Intel and/or Sony are licensed under prior licenses to Intel and/or Sony.

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

<u>Petitioner's position</u>: For the same reasons Petitioner previously raised in the related IPRs, Petitioner does not agree that any discovery in these IPRs is warranted, and therefore does not believe that a conference call or any briefing is needed. However, Petitioner is not opposed to Patent Owner's request to "make the earlier proceedings' briefing of record in the present proceedings, to save resources on the part of the parties and also the Board," and to "preserve this discovery issue for appeal."

The parties can provide availability for a conference call with the Board if so desired by the Board.

Respectfully,
Arvind Jairam
Counsel for Patent Owner

McKool Smith

Arvind Jairam
Principal

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