

PUBLIC VERSION

From: Fulghum, Roger <Roger.Fulghum@BakerBotts.com>
Sent: Wednesday, November 15, 2023 10:01 PM
To: Nicholas T. Matich; Tanya Wood; DL Greenthread, LLC v. onsemi; Greenthread-OnSemi-MS
Cc: Speegle, Mark; Daniel.Anderson@andersonpatents.com
Subject: RE: Semiconductor v. Greenthread IPR2023-01242, -01243 and -01244 - Patent Owner's Preliminary Responses

Nick,

In view of your guidance on in-house counsel, we have revised the e-mail to the Board:

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).

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]

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.

[Patent Owner's position]

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

From: Nicholas T. Matich <nmatich@McKoolSmith.com>
Sent: Wednesday, November 15, 2023 7:39 PM
To: Fulghum, Roger <Roger.Fulghum@BakerBotts.com>; Tanya Wood <twood@McKoolSmith.com>; DL Greenthread, LLC v. onsemi <dlgreenthreadvonsemi@BakerBotts.com>; Greenthread-OnSemi-MS <Greenthread-OnSemi-MS@mckoolsmith.com>
Cc: Speegle, Mark <mark.speegle@bakerbotts.com>; Daniel.Anderson@andersonpatents.com
Subject: Re: Semiconductor v. Greenthread IPR2023-01242, -01243 and -01244 - Patent Owner's Preliminary Responses

[EXTERNAL EMAIL]

Roger,

Regarding the reply, we will provide our position for the email tomorrow.

As for the sealing issue, we do not object to you sharing the briefs with your in house counsel. [REDACTED]

As for redacting the briefs, we don't object. However our understanding is that the board directs parties to redact when it chooses.

Does the above moot the sealing issue? If not, please explain why and we will provide our position on this issue as well tomorrow.

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

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: Fulghum, Roger <Roger.Fulghum@BakerBotts.com>
Sent: Wednesday, November 15, 2023 7:01 PM
To: Tanya Wood <twood@McKoolSmith.com>; DL Greenthread, LLC v. onsemi <dlgreenthreadvonsemi@BakerBotts.com>; Greenthread-OnSemi-MS <Greenthread-OnSemi-MS@mckoolsmith.com>; Nicholas T. Matich <nmatich@McKoolSmith.com>
Cc: Speegle, Mark <mark.speegle@bakerbotts.com>; Daniel.Anderson@andersonpatents.com
<Daniel.Anderson@andersonpatents.com>
Subject: RE: Semiconductor v. Greenthread IPR2023-01242, -01243 and -01244 - Patent Owner's Preliminary Responses

Counsel,

Petitioner onsemi will request a telephone conference with the Board to address two issues: (1) Petitioner's request to file a Pre-Institution Preliminary Reply addressing Patent Owner's privity arguments in each of IPR2023-01242, IPR2023-01243, and IPR2023-01244. (2) Petitioner's request to file a Pre-Institution Preliminary Reply addressing Patent Owner's privity arguments in each of IPR2023-01242, IPR2023-01243, and IPR2023-01244. Greenthread Ex. 2051, p. 2
Semiconductor v. Greenthread

01243, and IPR2023-01244; and (2) Patent Owner's practice of over-sealing of materials in IPR2023-01242, IPR2023-01243, and IPR2023-01244. A draft e-mail to the Board on these issues is below. Please add Patent Owner's position and availability for a telephone conference so that Petitioner may promptly raise these important issues with the Board.

We also note that we have been unable to share Greenthread's Patent Owner Preliminary Responses with our client onsemi. As noted below, we plan to raise this issue with the board unless Greenthread provides permission for us to share the entirety of the POPR, including all exhibits, with our client.

We plan to send the e-mail below at noon Central tomorrow (Thursday).

Thanks, Roger Fulghum

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).

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. As for a due date, Petitioner proposes that the due date be set for the date that is three weeks after Petitioner is permitted to share the POPRs with its client. Because Patent Owner has filed the POPRs under seal as a result of purportedly confidential information of RPX, Petitioner has thus far not been able to share the POPRs with its client. As a matter of procedural fairness, and to permit effective client communication and representation of Petitioner, Petitioner must be able to share the POPRs with its client in order to work with the client on the draft of the Reply.

[Patent Owner'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 motion for additional discovery. At best, the only material that should be sealed are those materials that are truly confidential. As noted above, we have thus far been unable to share the POPRs with our client. This puts the Petitioner in the ironic and procedurally unfair position of purportedly being in privity on the basis of arguments and other evidence that it cannot see. In addition to requesting permission to share the POPRs, Petitioner requests that Patent Owner be ordered to file redacted versions of materials previous filed under seal in which the redactions are limited to materials that are truly confidential.

[Patent Owner's position]

[REDACTED]

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

From: Tanya Wood <twood@McKoolSmith.com>
Sent: Tuesday, November 14, 2023 6:27 PM
To: Fulghum, Roger <Roger.Fulghum@BakerBotts.com>; Speegle, Mark <mark.speegle@bakerbotts.com>;
Daniel.Anderson@andersonpatents.com; DL Greenthread, LLC v. onsemi <dlgreenthreadvonsemi@BakerBotts.com>
Cc: Greenthread-OnSemi-MS <Greenthread-OnSemi-MS@mckoolsmith.com>
Subject: Semiconductor v. Greenthread IPR2023-01242, -01243 and -01244 - Patent Owner's Preliminary Responses

[EXTERNAL EMAIL]

PROTECTIVE ORDER MATERIAL

Counsel,

Courtesy copies of today's filings in the above-captioned *inter partes* review matters are now available for download from our secure ftp site.

The folder titled "2023 11 14 IPR2023-01242 -01243 -01244 POPR [PROTECTIVE ORDER MATERIAL].zip" may be accessed with the following login credentials:

[REDACTED]

Please let me know if you have any difficulties accessing these documents.

Thank you.

Tanya

McKool Smith

Tanya Wood
Senior Paralegal
Washington, D.C.
Tel: (202) 378-8331
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.



Confidentiality Notice:

The information contained in this email and any attachments is intended only for the recipient[s] listed above and may be privileged and confidential. Any dissemination, copying, or use of or reliance upon such information by or to anyone other than the recipient[s] listed above is prohibited. If you have received this message in error, please notify the sender immediately at the email address above and destroy any and all copies of this message.