

From: [Arvind Jairam](#)
To: [Trials](#)
Cc: [Fulghum, Roger](#); [Speegle, Mark](#); [Barazesh, Ellyar](#); Daniel.Anderson@andersonpatents.com; [DL Greenthread, LLC v. onsemi](#); [Greenthread-OnSemi-MS](#)
Subject: Semiconductor Components Industries LLC v. Greenthread LLC, IPR2024-00263, -00264, -00265, -00266
Date: Thursday, March 21, 2024 5:12:59 PM
Attachments: [image574831.png](#)
[image516841.png](#)

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

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

Your Honors,

Patent Owner in the above captioned IPRs requests an extension of the deadline for its POPR, currently due March 28. The above captioned IPRs raise substantially the same issue of timeliness under 315(b) as other IPRs against related patents filed by the same petitioner (IPR2023-01242, -01243, -01244). The Panel's institution decision in those cases is the subject of a pending petition for Director review. The outcome of the Director Review process is likely to substantially affect Patent Owner's POPR. Therefore, Patent Owner requests an extension for filing of its POPR until two weeks after the Director acts on Patent Owner's petition. In the alternative, Patent Owner requests a two week extension to file its POPR.

Patent Owner met and conferred with Petitioner prior to sending the present email. Patent Owner has explained to Petitioner that Petitioner has added excessive and inappropriate argument to its position (below) in this email.

Petitioner's Position

"Petitioner is opposed to the requested extension.

First, the extension requested by Patent Owner is unnecessary. If the Director grants PO's Director review request, PO could approach the Board in IPR2024-00263, -00264, -00265, -00266 for appropriate guidance in view of the grant. If necessary, the PO could take this action after the PO has filed its patent owner preliminary response and even after institution. Thus, there is no need to wait for a ruling from the Director on a request filed in another IPR.

Second, it is unlikely that the Director will grant PO's Director review request, as PO's request for Director Review is based on an extreme position on privity that is not supported by facts or law.

Third, an extension of the due date to file a patent owner preliminary response would have the effect of extending the due date for an institution decision (35 U.S.C. 314(b)) and the due date for a final written decision (35 U.S.C. 316(a)(11)), which is not appropriate in view

of the fact that a request for Director Review does not stay the proceeding that is itself the subject of the request. Moreover, extending the timing for institution will prejudice Petitioner as PO has opposed Petitioner's motion to stay the co-pending district court case on the basis, inter alia, that the present IPRs have not yet been instituted.

Fourth, Petitioner is concerned that PO is attempting to circumvent the word count limits by seeking the benefit of its prior (failed) privity argument without actually briefing that argument in this proceeding. PO is adopting a wait-and-see approach in which PO may pivot to a secondary set of arguments if the pending Director review requests are denied.

In sum, no extension is necessary or warranted. If the Director grants the pending Director review requests in IPR2023-01242, -01243, -01244, the PO can take appropriate action in IPR2024-00263, -00264, -00265, -00266 and without regard to the procedural status of this later set of IPR proceedings."

Respectfully,
Arvind Jairam
Counsel for Patent Owner

McKool Smith

Arvind Jairam
Principal
Washington, D.C.
Tel: (202) 370-8324
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.