PUBLIC VERSION

[redacted]

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SEMICONDUCTOR COMPONENTS INDUSTRIES, LLC,
Petitioner

v.

GREENTHREAD, LLC,
Patent Owner

Case: IPR2024-00265
U.S. Patent No. 9,190,502

PATENT OWNER'S REQUEST TO FILE A MOTION FOR ADDITIONAL DISCOVERY PURSUANT TO 37 C.F.R. §§ 42.51(B)(2)(I)

[redacted]

EXHIBIT LIST

Exhibit No.	Description	Submitted Previously?
Ex. 2001	*Greenthread, LLC v. Intel Corp.*, No. 6:22-cv-00105-ADA, Dkt. 7 (summons returned executed) (W.D. Tex. Feb. 7, 2022)	
Ex. 2002	**[SEALED]** Email communication from Petitioner's counsel to Patent Owner's counsel October 16, 2023	
Ex. 2003	Presentation entitled "Accelerating the Journey Towards a Sustainable Ecosystem" (2023) available at Petitioner's website at https://www.onsemi.com/site/pdf/2023_Analyst_Day_Presentation.pdf	
Ex. 2004	"Clock Devices for Servers" (Aug. 2020) available at https://cdrdv2-public.intel.com/620306/620306_Clock_Devices_For_Server_Rv1p3.pdf	
Ex. 2005	On Semiconductor Corporation Form 10-K filing with U.S. Securities and Exchange Commission for the fiscal year ended December 31, 2016	
Ex. 2006	ON Semiconductor data sheet entitled "NCP81248 Three-Rail Controller with Intel Proprietary Interface for IMVP8 CPU Applications" (Feb. 2018) available at https://www.onsemi.com/pdf/datasheet/ncp81248-d.pdf	
Ex. 2007	onsemi data sheet entitled "+ 1 Phase Output Controller with SVID Interface for Computer CPU Applications" (May 2023) available at https://www.onsemi.com/download/data-sheet/pdf/ncp81566-d.pdf	

[redacted]

Exhibit No.	Description	Submitted Previously?
Ex. 2008	Onsemi data sheet entitled "+ 2 Phase Output Controller with SVID Interface for Computer CPU Applications (May 2023) available at https://www.onsemi.com/download/data-sheet/pdf/ncp81567-d.pdf	
Ex. 2009	Article entitled "If You Invested $1000 in ON Semiconductor Corp. a Decade Ago, This is How Much It'd Be Worth Now," May 8, 2023 available at https://finance.yahoo.com/news/invested-1000-semiconductor-corp-decade-123012312.html	
Ex. 2010	Onsemi Standard Terms and Conditions of Sale, Rev.08102021 available at https://www.onsemi.com/site/pdf/ONSEMI_T&C.pdf	
Ex. 2011	Plaintiff's First Set of Common Interrogatories to Defendants ON Semiconductor Corporation and Monolithic Power Services, Inc., Et Al., *Greenthread, LLC v. ON Semiconductor Corp.*, No. 23-443-RGA (D. Del.) (served Sept. 27, 2023)	
Ex. 2012	Plaintiff's First Set of Common Requests for the Production of Documents to Defendants ON Semiconductor Corporation and Monolithic Power Services, Inc., Et Al., *Greenthread, LLC v. ON Semiconductor Corp.*, No. 23-443-RGA (D. Del.) (served Sept. 27, 2023)	
Ex. 2013	Definition of "privity" in Black's Law Dictionary (11th ed. 2019) available from Westlaw at westlaw.com	
Ex. 2014	**[SEALED]** Email communication from Petitioner's counsel to Patent Owner's counsel October 11, 2023	
Ex. 2015	Plaintiff's Identification of Accused Products and Asserted Patents, *Greenthread, LLC v. ON Semiconductor Corp.*, No. 23-443-RGA (D. Del.) (served Oct. 12, 2023)	

[redacted]

Exhibit No.	Description	Submitted Previously?
Ex. 2016	Petition (Paper 2) in *Sony Group Corp. v. Greenthread, LLC*, IPR2023-00324	
Ex. 2017	Petition (Paper 1) in *Sony Group Corp. v. Greenthread, LLC*, IPR2023-00376	
Ex. 2018	*Greenthread, LLC v. Intel Corp.*, No. 6:22-cv-00105-ADA, Dkt. 1 (Complaint) (W.D. Tex. Jan. 27, 2022)	
Ex. 2019	*Greenthread, LLC v. Dell Inc.*, No. 6:22-cv-105-ADA, Dkt. 120 (Second Amended Complaint)	
Ex. 2020	*Greenthread, LLC v. ON Semiconductor Corp.*, No. 23-443-RGA, Dkt. 1 (Complaint with accompanying exhibits) (D. Del. Apr. 21, 2023)	
Ex. 2021	*Greenthread, LLC v. ON Semiconductor Corp.*, No. 23-443-RGA, Dkt. 24 (Scheduling Order) (D. Del. Sept. 11, 2023)	
Ex. 2022	**[SEALED]** Confidential agreement	
Ex. 2023	Petition (Paper 1) in *Intel Corp. v. Greenthread LLC*, IPR2023-00308	
Ex. 2024	Petition (Paper 1) in *Intel Corp. v. Greenthread LLC*, IPR2023-00420	
Ex. 2025	Petition (Paper 1) in *Intel Corp. v. Greenthread LLC*, IPR2023-00552	
Ex. 2026	Petition (Paper 1) in *Dell Techs. Inc. v. Greenthread LLC*, IPR2023-00506	
Ex. 2027	Petition (Paper 1) in *Dell Techs. Inc. v. Greenthread LLC*, IPR2023-00509	

[redacted]

Exhibit No.	Description	Submitted Previously?
Ex. 2028	**[SEALED]** Confidential declaration	
Ex. 2029	**[SEALED]** Email communication from Patent Owner's counsel to Petitioner's counsel between May 26 to June 1, 2023	
Ex. 2030	Web pages from websites of Onsemi (www.onsemi.com), Mouser Electronics, Inc. (www.mouser.com), Rochester Electronics (www.rocelec.com), and DigiKey Corporation (www.digikey.com) (URLs for web pages are indicated on respective pages)	
Ex. 2031	*Greenthread, LLC v. Intel Corp.*, No. 6:22-cv-00105-ADA, Dkt. 113 (Redacted Memorandum Opinion and Order) (W.D. Tex. Dec. 27, 2022)	
Ex. 2032	*Greenthread, LLC v. Intel Corp.*, 6:22-cv-00105-ADA, Dkt. 38 (First Amended Complaint for Patent Infringement) (W.D. Tex., filed Apr. 29, 2022)	
Ex. 2033	*Greenthread, LLC v. Intel Corp.*, 6:22-cv-00105-ADA, Dkt. 38-8 (Greenthread's Amended Preliminary Infringement Contentions) (W.D. Tex., filed Apr. 29, 2022)	
Ex. 2034	*Greenthread, LLC v. Intel Corp.*, 6:22-cv-00105-ADA, Dkt. 38-12 (Exs. D-1, D-2, D-3, D-6 to Greenthread's Preliminary Infringement Contentions) (W.D. Tex., filed Apr. 29, 2022)	
Ex. 2035	Plaintiff's Supplemental Identification of Asserted Patents and Accused Products in *Greenthread, LLC v. ON Semiconductor Corp.*, No. 23-443-RGA (served to Petitioner's counsel on Nov. 10, 2023)	
Ex. 2036	Webpage regarding iFixIt, PlayStation 5 Teardown (https://www.ifixit.com/Teardown/PlayStation+5+Teardown/138280)	

[redacted]

Exhibit No.	Description	Submitted Previously?
Ex. 2037	Webpage from Mouser Electronics, Inc. for NCP252160 (https://www.mouser.com/ProductDetail/onsemi/NCP252160MNTWG?qs=sPbYRqrBIVkc9klNZ2pXbg%3D%3D)	
Ex. 2038	Webpage from DigiKey for NCP252160 (https://www.digikey.com/en/products/detail/onsemi/NCP252160MNTWG/15859992)	
Ex. 2039	Webpage from Mouser Electronics, Inc. for NB3L202K (https://www.mouser.com/ProductDetail/onsemi/NB3L202KMNTXG?qs=z6PAvqrnkvR8PcLN2EnUzg%3D%3D)	
Ex. 2040	Webpage from DigiKey for NB3L202K (https://www.digikey.com/en/products/detail/onsemi/NB3L202KMNTXG/7220446)	
Ex. 2041	Definition of "agent" in Black's Law Dictionary (11th ed. 2019) available from Westlaw at westlaw.com	
Ex. 2042	*Greenthread, LLC v. Intel Corp.*, 6:22-cv-00105-ADA, Dkt. 135 (Motion for Admission Pro Hac Vice of L. Popovski on Behalf of Sony) (W.D. Tex., filed January 30, 2023)	
Ex. 2043	[RESERVED]	
Ex. 2044	Email communication from Patent Owner to Petitioner's litigation counsel dated September 13, 2023	
Ex. 2045	*Greenthread, LLC v. Intel Corp.*, 6:22-cv-00105-ADA, Dkt. 49 (Notice of Appearance of Additional Counsel) (W.D. Tex., filed June 9, 2022)	
Ex. 2046	[RESERVED]	

[redacted]

Exhibit No.	Description	Submitted Previously?
Ex. 2047	[RESERVED]	
Ex. 2048	*Greenthread, LLC v. Intel Corp.*, 6:22-cv-00105-ADA, Dkt. 120-8 (Greenthread's Amended Preliminary Infringement Contentions) (W.D. Tex., filed Jan. 23, 2023)	
Ex. 2049	**[SEALED]** Email communications between Petitioner's counsel and Patent Owner's counsel, dated Oct. 31, 2023 - Nov. 1, 2023	
Ex. 2050	**[SEALED]** Email communications between Petitioner's counsel and Patent Owner's counsel, dated Nov. 2-7, 2023	
Ex. 2051	**[SEALED]** Email communications between Petitioner's counsel and Patent Owner's counsel, dated Nov. 14-15, 2023	
Ex. 2052	**[SEALED]** Email communications between Petitioner's counsel and Patent Owner's counsel, dated Dec. 12-13, 2023	
Ex. 2053	Web page from website of Onsemi (https://www.onsemi.com/products/custom-assp/soc-sip-custom-products)	
Ex. 2054	Greenthread, LLC v. ON Semiconductor Corp., No. 23-443-RGA, Dkt. 36 (Second Amended Complaint) (D. Del. Nov. 22, 2023)	
Ex. 2055	Greenthread, LLC v. ON Semiconductor Corp., No. 23-443-RGA, Dkt. 42 (Defendants' Answer, Affirmative Defenses, and Counterclaims to Plaintiff's Second Amended Complaint) (D. Del. Dec. 20, 2023)	
Ex. 2056	**[SEALED]** Email communications between the Board, Petitioner's counsel and Patent Owner's counsel dated November 27, 2023	

[redacted]

Exhibit No.	Description	Submitted Previously?
Ex. 2057-2900	[RESERVED]	
Ex. 2901	**[SEALED]** IPR2023-01242 Patent Owner's Motion for Additional Discovery, Paper 8	
Ex. 2902	**[SEALED]** IPR2023-01242 Petitioner's Opposition to Patent Owner's Motion for Additional Discovery, Paper 11	
Ex. 2903	**[SEALED]** IPR2023-01242 Patent Owner's Reply In Support of PO's Motion for Additional Discovery, Paper 14	
Ex. 2904	**[SEALED]** IPR2023-01242 Order Denying Patent Owner's Motion for Additional Discovery, Paper 30	
Ex. 2905	**[SEALED]** IPR2023-01243 Patent Owner's Motion for Additional Discovery, Paper 7	
Ex. 2906	**[SEALED]** IPR2023-01243 Petitioner's Opposition to Patent Owner's Motion for Additional Discovery, Paper 10	
Ex. 2907	**[SEALED]** IPR2023-01243 Patent Owner's Reply In Support of PO's Motion for Additional Discovery, Paper 13	
Ex. 2908	**[SEALED]** IPR2023-01243 Order Denying Patent Owner's Motion for Additional Discovery, Paper 29	
Ex. 2909	**[SEALED]** IPR2023-01244 Patent Owner's Motion for Additional Discovery, Paper 8	
Ex. 2910	**[SEALED]** IPR2023-01244 Petitioner's Opposition to Patent Owner's Motion for Additional Discovery, Paper 11	
Ex. 2911	**[SEALED]** IPR2023-01244 Patent Owner's Reply In Support of PO's Motion for Additional Discovery, Paper 14	

[redacted]

Exhibit No.	Description	Submitted Previously?
Ex. 2912	**[SEALED]** IPR2023-01244 Order Denying Patent Owner's Motion for Additional Discovery, Paper 30	

[redacted]

As authorized by the Board via email February 20, 2024, Greenthread, LLC ("PO") submits this request for authorization ("Request") to file a motion for additional discovery pursuant to 37 C.F.R. § 42.51(b)(2)(i) regarding Petitioner's[1] relationship with Intel Corp. ("Intel"), [redacted] ("[redacted]"), and [redacted] ("[redacted]") (collectively, "Time Barred Entities"). The parties completed briefing regarding the same discovery issue in prior IPRs, including IPR2023-01242, -01243, and -01244. *See* Exs. 2901-2904 (briefing from IPR2023-01242); *see also* Exs. 2905-2912 (similar from IPR2023-01243 and -01244).

Background: It is undisputed that Petitioner has a pre-existing substantive relationship with the Time Barred Entities, and that at least two of the Time Barred Entities are time-barred under 35 U.S.C. § 315(b). Exs. 2003-2008, 2014, 3-4; Ex. 2902, 2906, 2910.[2] PO has submitted evidence that Petitioner makes custom products for Time Barred Entities, Exs. 2006, 2015, 2053, 2010 at 9, and that some of these products are components of previously accused products and are again accused in the co-pending district court litigation, Ex. 2036, 11; Ex. 2019, ¶¶12, 28-

[1] "Petitioner" here, and throughout, refers to Petitioner and its RPIs. Petitioner identified ON Semiconductor Corporation as an RPI. Pet. (Paper 1), 1.

[2] Citations in this Request to Exhibits 2901 and up cite to corresponding documents from each of the three prior IPRs.

[redacted]

30, 36, 79, 85, 101-104; Ex. 2048, 18. Further, PO has submitted evidence that Petitioner acts as a "have made" vendor under the license to two of the Time Barred Entities. Ex. 2022, 2; Ex. 2028.

Requested Discovery: Petitioner has refused to provide information regarding its relationships with Time Barred Entities and PO seeks to file a motion for narrowly tailored discovery on that issue. PO requests Petitioner's agreements and communications with Time Barred Entities relating to the products it sells to them. Second, PO requests one interrogatory regarding whether Petitioner intends to claim in district court the benefit of prior licenses to Time Barred Entities. PO will seek the same discovery sought in the prior IPRs. *See e.g.*, Ex. 2901 at Appendix A.

***Garmin* Factors:** Greenthread's requests satisfy the *Garmin* Factors.

First Factor: It is undisputed that Petitioner and Time Barred Entities have an established customer manufacturer relationship and that such relationships can create privity. *See, e.g.*, *Volkswagen Grp. of Am. Inc. v. Argina Tech. Ltd.*, IPR2021-01263 Paper 16 (PTAB Jan. 21, 2022). Here, it is undisputed that Petitioner does generally indemnify its customers and makes custom products for them. *E.g.*, Ex. 2010. The documents PO requests will show the exact terms of Petitioner's relationship with the Time Barred Entities, including indemnification provisions, exclusivity arrangements, joint design efforts, and the specific custom products Petitioner makes for the Time Barred Entities. *See e.g.*, Ex. 2901 at 8-11.

[redacted]

Second Factor: Although PO seeks to know whether Petitioner contends that it is licensed to PO's patents, the fact that a request covers a litigation position is not dispositive. This case presents the unusual circumstance in which Petitioner's license defense is highly relevant to the time-bar issue here, because by operating as a seller of custom products to the Time Barred Entities, Petitioner acts as their agent and is thus in privity with them. *See, e.g.*, *In re Google LLC*, 949 F.3d 1338, 1346 (Fed. Cir. 2020); *John St. Leasehold, LLC v. Cap. Mgmt. Res., L.P.*, 283 F.3d 73, 75 (2d Cir. 2002). *See e.g.*, Ex. 2901 at 11-12.

Third Factor: The information sought is not reasonably available through other means. PO can only obtain Petitioner's contracts and communications with the Time Barred Entities through discovery, because they are not publicly available. *See e.g.*, Ex. 2901 at 12-14.

Fourth Factor: PO's requests are straightforward. *See e.g.*, Ex. 2901 at 14.

First Factor: PO's requests are not burdensome. The discovery is limited to agreements and communications directly relating to the relationship between Petitioner and the Time Barred Entities and answering one straightforward interrogatory. *See e.g.*, Ex. 2901 at 14-15.

Relief Requested: For at least the foregoing reasons, PO requests that it be permitted to file a motion for additional discovery.

[redacted]

Dated: February 27, 2024

Respectfully submitted,

/Alan L. Whitehurst/

Alan L. Whitehurst
Reg. No. 43,263
awhitehurst@mckoolsmith.com
Nicholas T. Matich
Reg. No. L1,373
nmatich@mckoolsmith.com
Arvind Jairam
Reg. No. 62,759
ajairam@mckoolsmith.com
Stuart McCommas
Reg. No. 71,834
smccommas@mckoolsmith.com
McKool Smith, P.C.
1999 K St. NW, Suite 600
Washington, DC 20006
Telephone: (202) 370-8300
Facsimile: (202) 370-8344

Archis "Neil" Ozarkar
Reg. No. 71,265
nozarkar@mckoolsmith.com
McKool Smith, P.C.
600 Travis Street, Suite 7000
Houston, TX 77002
Telephone: (713) 485-7300
Facsimile: (713) 485-7344

CERTIFICATION OF SERVICE

The undersigned hereby certifies that a copy of this **PATENT OWNER'S REQUEST TO FILE A MOTION FOR ADDITIONAL DISCOVERY PURSUANT TO 37 C.F.R. §§ 42.51(B)(2)(I)** has been served on Petitioner via email on the following counsel of record for Petitioner:

Roger Fulghum
Roger.Fulghum@BakerBotts.com
BAKER BOTTS L.L.P.
One Shell Plaza
910 Louisiana Street
Houston, TX 77002
T.: (713) 229-1234

Mark Speegle
Mark.Speegle@BakerBotts.com
Ellyar Y. Barazesh
Ellyar.Barazesh@BakerBotts.com
BAKER BOTTS L.L.P.
401 South First Street, Suite 1300
Austin, TX 78704
T: (512) 322-2500

Daniel Anderson
Daniel.Anderson@andersonpatents.com
1930 S. Alma School Road, Suite A200
Mesa, AZ 85210
T: (602) 516-8265

dlgreenthreadvonsemi@bakerbotts.com

Dated: February 27, 2024 By: */Alan L. Whitehurst/*
Alan L. Whitehurst, Reg. No. 43,263