PUBLIC VERSION

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SEMICONDUCTOR COMPONENTS INDUSTRIES, LLC,
Petitioner,

v.

GREENTHREAD, LLC,
Patent Owner.

IPR2023-01242
U.S. Patent No. 11,121,222

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

[redacted]

PUBLIC VERSION

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EXHIBIT LIST

Exhibit No.	Description
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	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
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

Exhibit No.	Description
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	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)
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)

Exhibit No.	Description
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. Jul. 6, 2023)
Ex. 2021	*Greenthread, LLC v. ON Semiconductor Corp.*, No. 23-443-RGA, Dkt. 24 (Scheduling Order) (D. Del. Sept. 11, 2023)
Ex. 2022	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

I. INTRODUCTION

As authorized by the Board via email, Patent Owner Greenthread, LLC ("PO") submits this Motion for Additional Discovery pursuant to 37 C.F.R. § 42.51(b)(2)(i). Petitioner wants to preserve the possibility of taking inconsistent positions before the Board and in district court. On one hand, ***before the Board***, Petitioner claims it is not in privity with its customers, Intel Corp. ("Intel"), [redacted] [redacted].[1] If it admitted that it was in privity with those parties, its Petition (Paper 1) would be time-barred.

On the other hand, ***in district court***, Petitioner wants to have the benefit of Intel's and [redacted] licenses to reduce its potential damages. It therefore refuses to say whether it plans to raise a license defense in district court (at least until this IPR is instituted). If Petitioner claims the benefit of Intel's and [redacted] licenses, then it and they would have a "legally recognized interest in the same subject matter (such as a transaction, proceeding, or piece of property)"—specifically, the licenses and onsemi's sales to Intel and [redacted] Ex. 2013, 1 (Black's Law Dictionary (11th ed. 2019). That is literally the very definition of privity. *Id.* PO believes that Petitioner ***is*** in privity with Intel and [redacted] by virtue of these licenses and their other extensive

[1] The Intel, [redacted] and [redacted] entities are identified in the Definitions section of the proposed discovery requests provided at Appendix A.

business relationships, so the Petition is time-barred. At minimum, it is unfair for Petitioner to benefit from and Intel's legal rights, while disclaiming privity.

PO's proposed discovery is narrowly tailored to address Petitioner's relationships with Intel, , and the unfairness of Petitioner's gamesmanship. First, PO requests Petitioner's[2] agreements and communications with Intel, relating to the products it sells to them. Second, Petitioner seeks to pose one interrogatory striking at the heart of the privity inquiry—whether Petitioner intends to claim in district court the benefit of prior licenses to Intel and/or The requested additional discovery is therefore in the interests of justice.

II. BACKGROUND

PO is requesting additional discovery to ascertain whether Petitioner can carry its burden of showing that the Petition is not time-barred. The patents-at-issue here and in two related proceedings were previously challenged by Intel, .

A. Prior Intel, Litigations and IPRs

This proceeding, two related IPR proceedings, and the district court case involve two related patents: U.S. Patent Nos. 11,121,222 and 10,510,842. Pet., § II.B (Related Matters section). PO served Intel and with a complaint for

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

infringement of, *inter alia*, the ’222 and ’842 patents on February 1, 2022, triggering the clock for a one-year IPR bar under 35 U.S.C. § 315(b) regarding Intel and Ex. 2001, 2, 4. In its case against Intel, PO accused various Intel CPUs. Ex. 2018, ¶¶47-48. Petitioner’s and Intel’s documents show that Petitioner’s products are “optimized for” (and are apparently are components of) Intel’s CPUs. Ex. 2008, 1.

PO’s case against was based on, among other things, sale of products. informed PO that it was indemnified by and was represented by separate counsel specifically for products, presumably paid for by Further, filed IPR petitions against the ’222 and ’842 patents (discussed further below) expressly naming as an RPI. Ex. 2016, 7; Ex. 2017, 7. PO later amended the complaint to add as a party on January 23, 2023. Ex. 2019.

Intel and also filed IPR petitions against the ’222 and ’842 patents. Pet., § II.B; Exs. 2023-2027. The Intel, IPRs were terminated due to settlement, and confidential settlement agreements (including license agreements) were submitted to the Board as exhibits (accessible to the Board and parties only). *E.g.*, *Intel Corp. v. Greenthread, LLC*, IPR2023-00420, Ex. 2001; *Intel Corp. v. Greenthread, LLC*, IPR2023-00552, Ex. 2001; . PO produced the

licenses (submitted here as Exhibit 2022) between PO and Intel/ from those proceedings to Petitioner with Bates labels beginning at GT-DDEL-0000001.

B. Petitioner and/or its RPI Supply Products to Intel,

Petitioner supplies products to Intel, . For example, multiple investor disclosures list as among Petitioner's most significant customers and numerous product descriptions on Petitioner's website indicate that they are made specifically for use with Intel products.[3] Sales to Intel and are likely licensed under the Intel and licenses. *See* Ex. 2022.

[3] *See, e.g.*, Ex. 2003, 102 (presentation obtained from Petitioner's website, showing and as customers of Petitioner); Ex. 2004, 10 (Intel document showing ON Semiconductor as a supplier to Intel); Ex. 2005, 11 (ON Semiconductor's SEC Form 10-K filing, listing and as "customers and end-users" of ON Semiconductor); Ex. 2006, 1 (data sheet obtained from ON Semiconductor's website, describing ON Semiconductor's product as including an "Intel Proprietary Interface"); Ex. 2007, 1 (data sheet obtained from Petitioner's website, describing Petitioner's product as being "optimized for Intel's IMVP9.2 CPUs"); *see also* Ex. 2008, 1 (data sheet obtained from Petitioner's website, describing Petitioner's product as being "optimized for Intel's IMVP9.2 CPUs");

C. These Proceedings and Pending Discovery Requests

Petitioner filed its petitions—which bear a striking resemblance to the petitions in Intel's terminated IPRs—very early in the district court proceedings, indeed before discovery had even begun. Accordingly, PO has received no relevant discovery in district court. In this matter, PO requested that Petitioner provide the discovery requested in this Motion. Petitioner refused. Ex. 2014. Since district court discovery opened, PO also has served discovery requests that would require production of this information (among other things). Specifically, in district court, PO's Common Interrogatory 2 and RFP Nos. 40, 41, 42 call for (among other things) Petitioner to provide its agreements with Intel and [redacted] Common Interrogatory Nos. 4 and 6 require Petitioner to state (among other things) whether it contends that sales to Intel and [redacted] are licensed, and RFP No. 21 requires Petitioner to produce (among other things) documents relevant to that contention. Ex. 2012, 13, 15-16; Ex. 2011, 9-11. Petitioner has declined to state whether it will produce the requested information in the district court litigation. Ex. 2002.

Ex. 2009 (stating that ON Semiconductor's "[t]op OEM customers include … [redacted] … Intel, [redacted]

D. Accused Products and Infringement Contentions

PO expects that sales to Intel and [redacted] will be at issue in the district court litigation. PO obtained a reverse engineering report showing infringement by an exemplary product sold by Petitioner. Ex. 2020, 93-248. However, the patents-in-suit in the litigation and at issue here cover the design of individual transistors. The type of device in which an infringing transistor is located is irrelevant for most claims, making many categories of products with transistors potentially relevant. For example, the complaint against Petitioner alleges that "[t]he infringing structures within semiconductor devices have application in many types of devices designed and manufactured by ON Semiconductor, including discrete & power modules, … wireless connectivity, and timing, logic, and memory devices." Ex. 2020, ¶14. An Intel document indicates that Petitioner is one of its suppliers of "Clock Devices," i.e., the "timing … devices" mentioned in the complaint. Ex. 2004, 1, 3, 10.

On October 12, 2023, PO served an initial identification of accused products naming products believed to have been sold to Intel and [redacted] Ex. 2015. However, the scope of accused products in the district court case has not been determined. PO's initial infringement contentions are not due until December 13, 2023, and final infringement contentions are not due until October 15, 2024. Ex. 2021, 4-5. PO expects that the list of accused products will expand during discovery. *Arigna Tech. Ltd. v. Volkswagen AG*, No. 2:21-cv-00054, 2022 WL 2761288, at *2 (E.D. Tex.

Jan. 19, 2022) ("'It is expected that during [] discovery, infringement contentions may be clarified or refined' based upon information produced during discovery.").

III. THE REQUESTED DISCOVERY

PO requests discovery that goes to the status of Intel, as RPIs and/or privies of Petitioner. If any of those third parties is deemed an RPI or privy of Petitioner, this petition is time-barred by 35 U.S.C. §315(b). Specifically, PO seeks the following discovery (*see* Appendix A):

> 1. All agreements between i) Petitioner and/or its affiliates and ii) Intel, (or their affiliates), relating to the products Petitioner and/or its affiliates sells to Intel, , including sales contracts and design agreements.
>
> 2. All communications between i) Petitioner and/or its affiliates and ii) Intel, (or their affiliates), relating to the design of products Petitioner and/or its affiliates make for them.
>
> 3. An interrogatory answer stating whether Petitioner will assert that its sales to Intel and/or are licensed.

IV. THE INTERESTS OF JUSTICE SUPPORT GRANTING THE REQUESTED DISCOVERY

The Board applies a five-factor "necessary in the interest of justice" standard ("the *Garmin* factors") regarding motions for additional discovery. *See Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6–7 (PTAB Mar. 5, 2013). The factors are: (1) the request is based on more than a mere possibility of finding something useful; (2) the request does not seek the litigation positions of the

other party; (3) the information is not reasonably available through other means; (4) the request is easily understandable; and (5) the request is not overly burdensome to answer. *Id.* Here, the requested discovery will advance the interests of justice by uncovering information relevant to whether the Petition is time-barred and preventing Petitioner from taking inconsistent positions before the Board and in district court. Office Trial Practice Guide (Nov. 2019) ("TPG"), 12-18, 28.

A. There is More Than a Possibility or Mere Allegation That the Requested Discovery Will Yield Useful Information

This Motion meets the first *Garmin* factor, as explained below.

1. If Petitioner Claims the Benefit of the [redacted] and Intel Licenses, It Is in Privity with [redacted] and Intel.

The statutory requirement for petitioners to identify all RPIs and privies is "to safeguard patent owners from having to defend their patents against belated administrative attacks by related parties via § 315(b)." *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1350 (Fed. Cir. 2018). The Office TPG states that "[t]he notion of '***privity' is more expansive***, encompassing parties that do not necessarily need to be identified in the petition as a 'real party-in-interest'" and "[t]he Office intends to evaluate what parties constitute 'privies' in a manner consistent with the ***flexible and equitable considerations*** established under federal caselaw." TPG, 14 (emphasis added). In *AIT*, the Federal Circuit cited the Supreme Court's non-exhaustive list of factors for identifying a privy relationship. *AIT*, 897

F.3d at 1360) (Reyna, J., concurring) (citing *Taylor v. Sturgell*, 553 U.S. 880, 894-95 (2008)). "Analysis under ***any one of*** the factors can support a finding of privity." *Ventex Co., Ltd., v. Columbia Sportswear N. Am., Inc.*, IPR2017-00651, Paper 152 at 12 (PTAB Jan. 24, 2019) (precedential) (emphasis added). One *AIT* factor is especially relevant here: whether Petitioner and Intel, have a relevant "pre-existing substantive legal relationship." *AIT*, F.3d at 1360.

Petitioner's "pre-existing substantive legal relationship" with Intel/ goes to the heart of the time-barred status of the Petition and the district court case—the right to practice PO's patent. Under the Intel/ licenses, Petitioner may (and apparently does) take actions that would otherwise infringe, but for the fact that they are done on behalf of Intel/ For example, under the license Intel and can "have made" products that practice the patents-in-suit, including components for their own products. Ex. 2022, 2-3, 5. Petitioner is apparently the one whom Intel and "have ma[ke]" products embodying the invention under the license. Petitioner cannot claim that Intel and are strangers, here, while also asserting to be acting on their behalf in district court.

Further, that Petitioner also makes infringing products for unlicensed parties, and therefore may have an additional interest in challenging the patent is irrelevant. "[I]n drafting § 315(b), Congress 'chose language that bars petitions where proxies or privies would benefit from an instituted IPR ***even where the petitioning party***

might separately have its own interest in initiating an IPR.'" *PayPal, Inc. v. Personalweb Techs., LLC*, IPR2019-01111, Paper 27 at 26 (PTAB Nov. 22, 2019) (emphasis added; citing *Power Integrations, Inc. v. Semiconductor Comps. Indus., LLC*, 926 F.3d 1306, 1316 (Fed. Cir. 2019) and *AIT*, 897 F.3d at 1347).

2. The Discovery Requests will Yield Critical Information

The discovery requests will likely yield useful information regarding whether Petitioner has met its burden. As explained above, there can be little dispute that Intel, are, at a minimum, Petitioner's customers. *Supra* Section II.B. The facts suggest far more. For example, Petitioner has specifically named and among its major customers in multiple investor disclosures, including to the SEC. Ex. 2005, 11; Ex. 2003, 102. Regarding Intel, Petitioner's products are described in data sheets as being "optimized for Intel's … CPUs," and including an "Intel Proprietary Interface." *Supra* Section II.B (citing Exs. 2006-2008).[4]

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[4] Additionally, Petitioner's standard purchase agreement provides for indemnification of its customers. Ex. 2010, 3. Presumably customers as large as Intel, obtained terms at least as good as Petitioner's form contract. Indemnification is a factor favoring finding of an RPI or privity relationship. *PayPal*, IPR2019-01111, Paper 27 at 22-24.

The requested documents will show the extent of Petitioner's collaboration with the time-barred parties. They will also identify the specific products Petitioner sells to Intel, and which Intel, products include Petitioner's components. This will shed light on whether Petitioner's products were components of products accused in the prior litigation and whether Petitioner's sales to Intel, are likely to be accused in the litigation against Petitioner.

Finally, PO's third request (*supra* Section III) goes precisely to the issue of whether Petitioner will be claiming the benefit of a prior license, which would likely establish a privy relationship. Therefore, the requested discovery is clearly useful.

B. The Second *Garmin* Factor Favors PO

The first two discovery requests (requests for agreements and communications, *supra* Section III) do not seek litigation positions. To the extent Petitioner may contend that the third discovery request (*id.*) seeks Petitioner's litigation positions, PO seeks that discovery request to prevent the manifest unfairness of Petitioner taking directly contrary positions in two proceedings. It is essential that Petitioner provide this information ***now***, to prevent the unfairness of Petitioner changing its position ***later*** in district court. The Board should not allow

Petitioner to gain an unfair advantage by saying one thing in district court and another thing (or not saying anything, when it has the burden) at the PTAB.[5]

C. The Requested Information Is Not Reasonably Available Through Other Means

The third *Garmin* factor favors granting the discovery requests, because the information sought is not reasonably available through other means. Most obviously, Petitioner's position vis-à-vis the Intel and licenses is not public and is uniquely within Petitioner's possession. Only Petitioner knows what defenses it plans to raise. Likewise, the precise nature of Petitioner's relationship with Intel, , and which products Petitioner sells to them can only be known by looking at the requested agreements and communications. PO has investigated the RPI/privy issue to the extent possible via publicly available information and needs the information sought by the discovery requests to ascertain the full nature of the

[5] Even if the Board declines to compel Petitioner to state its position with respect to the Intel and licenses, Petitioner's refusal to answer itself means that the Petition should be dismissed. Petitioner has the burden of showing that its Petition is not time-barred, and that burden cannot be satisfied with silence in these circumstances. *Samsung Electronics Co. Ltd. v. Netlist Inc.*, IPR2022-00615, Paper 40 at 2 (Director Vidal Feb. 3, 2023).

relationship between Petitioner and Intel/. Without discovery, PO cannot know, for example, if or how Petitioner and its customers collaborate on product design, which customers buy which products, and which of Petitioner's products are incorporated into which Intel, products.

Furthermore, although some of this information may be available in district court ***later***, parties frequently update their interrogatory responses and litigation positions over the course of the case. PO needs the information ***now*** and in connection with ***this proceeding*** to prevent Petitioner from taking inconsistent positions here and in district court. Additionally, Petitioner has not said whether it will produce the information in district court and its outright refusal to produce the information here indicates it will not produce it. If Petitioner provides the relevant information in district court and consents to PO using the information here, PO will withdraw the instant Motion as moot. In the meantime, the Board should grant PO's requested discovery to stop Petitioner's gamesmanship.

To the extent Petitioner contends that PO's discovery requests are untimely, Petitioner is incorrect. "[T]he IPR ***petitioner bears the burden*** of persuasion to demonstrate that its petitions are not time-barred." *Samsung*, IPR2022-00615, Paper 40 at 2 (Director Vidal Feb. 3, 2023) (quoting *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242 Fed. Cir. 2018)) (emphasis added); 35 U.S.C. § 322(a)(2). Suggesting that PO has an obligation to raise issues relating to Petitioner's RPIs and privies flips

the burden of proof. PO cannot determine the nature of Petitioner's relationships without discovery and does not have an obligation to do so. Petitioner has offered ***no*** explanation of why the Petition is not time-barred. Petitioner has not disputed that it sells to Intel and or said whether it will claim the benefit of their licenses. Accordingly, if Petitioner fails to provide discovery, the Petition should still be dismissed, because Petitioner has failed to carry its burden that it is not time-barred.

Finally, even if PO had an obligation to investigate or prove anything with respect to Petitioner's RPIs or privies—it does not—whether Petitioner intends to claim the benefit of the Intel and licenses is information uniquely within its possession. No amount of investigation would give PO the answer and there is no reason that Petitioner cannot answer the question now. It is Petitioner's delay and/or refusal to provide the information that has necessitated this Motion.

D. The Requests Are Easily Understandable

As set forth in Appendix A, the three discovery requests and the instructions regarding them are straightforward.

E. The Requests Are Not Overly Burdensome

Patent Owner's requested discovery is limited to agreements and communications relating to products sold to Intel, , and whether Petitioner intends to claim the benefit of prior licenses. The narrowly-tailored nature of this discovery ensures that Petitioner will not suffer an undue burden in complying

with the requests. The first two requests (requests for production) are requests for specific types of agreements and communications. If Petitioner claims that these documents are too numerous to produce, it would only underscore the extent of its relationship with Intel, and the need for the documents. Regarding the third request (the interrogatory), Petitioner should be able to easily state whether or not it intends to claim the benefit of prior licenses, and its apparent unwillingness to confirm or deny this—or perhaps take inconsistent positions at the PTAB and in district court—cannot be attributed to anything burdensome to Petitioner.

In district court, PO has already requested documents relating to these requests, which cuts against any burden argument that Petitioner may present. In other words, Petitioner needs to provide the responses anyway, and it is Petitioner's refusal to provide the responses now to preserve its options later (*supra* Section IV.C) that necessitates this Motion.

V. TIMING OF DISCOVERY RESPONSES

If additional discovery is granted, PO requests that Petitioner be ordered to submit all the requested discovery by November 8, 2023, to provide PO sufficient time to review the discovery before filing its POPR on November 14, 2023.

VI. CONCLUSION

Therefore, the Board should grant the requested discovery requests.

Dated: October 17, 2023

Respectfully submitted,

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that a copy of this **PATENT OWNER'S 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:

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Dated: October 17, 2023

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APPENDIX A

PUBLIC VERSION

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SEMICONDUCTOR COMPONENTS INDUSTRIES, LLC,
Petitioner,

v.

GREENTHREAD, LLC,
Patent Owner.

IPR2023-01242
U.S. Patent No. 11,121,222

PATENT OWNER'S PROPOSED DISCOVERY REQUESTS TO PETITIONER

INSTRUCTIONS

1. If you withhold information based on privilege, work product protection, common interest privilege, or other exemption from discovery, provide a privilege log stating the date, the type of information withheld (e.g., document, email, phone call) with a brief description, the participants/recipients, and for written communications, the author.

2. This should not be covered by any request, but just to be clear, Petitioner does not need to log or produce communications solely between it and its litigation and/or IPR counsel from Baker Botts L.L.P and/or Ashby & Geddes.

DEFINITIONS

1. "Petitioner" means Semiconductor Components Industries, LLC, d/b/a onsemi, and/or its attorneys, officers, and employees.

2. "Intel" means Intel Corporation and/or its attorneys, officers, and employees.

3. [redacted] and/or their attorneys, officers, and employees.

4. "[redacted] means [redacted], and/or their attorneys, officers, and employees.

REQUESTS FOR PRODUCTION

Request for Production No. 1

All agreements between i) Petitioner and/or its affiliates and ii) Intel, [redacted] and/or [redacted] (or their affiliates), relating to the products Petitioner and/or its affiliates sells to Intel, [redacted], including sales contracts and design agreements.

Request for Production No. 2

All communications between i) Petitioner and/or its affiliates and ii) Intel, [redacted] (or their affiliates), relating to the design of products Petitioner and/or its affiliates make for them.

INTERROGATORIES

Interrogatory No. 1

State whether Petitioner will assert in the district court litigation involving the patent challenged in this IPR proceeding, that its sales to Intel and/or [redacted] are licensed.

Dated: October 17, 2023

Respectfully submitted,

/Alan Whitehurst/

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