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 REPLY POST-HEARING BRIEF CONCERNING BOARD-ORDERED DISCOVERY

TABLE OF CONTENTS

I. INTRODUCTION 1

II. ARGUMENT 2

A. Petitioner Submitted the Same Attorney Argument as "Evidence" that the Director Has Already Rejected 3

1. Petitioner's Witness Relied Entirely on Counsel's Representations 3

2. Petitioner's Declaration Reveals a Concerted Effort Among Counsel for Greenthread Petitioners 4

3. Petitioner Has Provided No Documents to Support its Arguments 5

B. Petitioner Has Failed to Prove that it Does Not Supply Any Components of the IAPs 6

C. Greenthread is Not Demanding that Petitioner "Prove a Negative" 10

D. Petitioner's Indemnity-Related Arguments Are Misplaced 11

E. Greenthread Maintains that the Time-Bar Issue Could Be Decided on the Existing Record, *Before* the Ordered Discovery 12

F. Policy Considerations and Fairness Support Greenthread 13

III. CONCLUSION 14

I. INTRODUCTION

Petitioner's Response Brief (Paper 71, "Response") doubles down on its tired (and already rejected) attorney arguments, despite being given the opportunity by the Board to produce evidence that would help it carry its burden of proof on the privity issue. Petitioner's so-called "evidence" and its Response arguments are insufficient. Instead of addressing and investigating each charge in the Board's Discovery Order (Paper 63, "Disc. Order"), Petitioner narrowly focused on the supposed absence of specific agreements and a direct indemnity request for PO's previous litigation against Intel. Not only did Petitioner fail to corroborate any of the counsel-generated statements in the declaration, but the declaration failed to address the threshold question: *Do any of the Intel Accused Products (IAPs) include products or components sold by Petitioner?*

Petitioner's declarant failed to conduct any semblance of an investigation into whether the IAPs include Petitioner's products or components. Despite Petitioner's protestation, this was not an oppressive task nor was Petitioner required to prove a "negative point." Response at 13. Petitioner could have easily contacted its best bet for exoneration—***Intel itself***—since Petitioner has established business relationships and communication channels with Intel. Even worse, Petitioner never even contacted its ***own employees*** responsible for communicating with Intel and maintaining its Intel client relationship. Instead, Petitioner has left too many questions unanswered

and simply given short shrift to the Discovery Order by having a corporate representative rubber-stamp the points provided by counsel.

Petitioner's non-existent "investigation" completely ignores the spirit of the Director's decision and the Board's Order on remand. The process of seeking to obtain relevant discovery from Petitioner in this proceeding has been contentious and ultimately unsuccessful, and it has been expensive and time-consuming for PO and the Board. Moreover, had these IPRs been filed today, institution would have been denied in each and every case in view of the settled expectations of the parties. PO respectfully requests that this IPR be terminated because of Petitioner's repeated failure to provide any meaningful evidence of a lack of privity between it and time barred parties, including Intel.

II. ARGUMENT

As explained in PO's Supplemental Brief, it is ***Petitioner***—not PO—that bears the burden of proving that (1) it properly identified all real-parties-in-interest and (2) the Petition is not time-barred. *See* Paper 68 ("PO Brief") at 1-2. The Director herself agreed that PO has done more than enough to challenge Petitioner's RPI identification. It is now up to the Board to consider Petitioner's supposed "evidence." But when given the chance, Petitioner merely focused on direct sales and indemnity agreements between Petitioner and Intel for the IAPs, and regurgitated the same attorney argument it has offered since filing the Petition.

Petitioner wrongly accuses PO of speculating whether Petitioner's products are incorporated into any Intel products (accused or otherwise). But it is *Petitioner* that failed to comply with the Board's Order. Petitioner was given a final opportunity to disprove PO's privity allegations, but because it did not properly and adequately investigate whether the IAPs include products or components sold by Petitioner, this question is still unanswered. This uncertainty should count against Petitioner, who is (a) closer to the source of proof, *i.e.*, Intel, and (b) bears the burden of proof. This information is in Petitioner's possession—***not*** PO's.

A. Petitioner Submitted the Same Attorney Argument as "Evidence" that the Director Has Already Rejected

As explained in PO's Supplemental Brief, Petitioner's "discovery" (and its Response Brief) offers the same attorney argument that it has presented since opposing PO's original discovery motion in October 2023. *See* Paper 11. In repeating those same arguments now—while offering no further details, new information, or documentary support—Petitioner apparently believes that its previous arguments will meet its burden.

1. Petitioner's Witness Relied Entirely on Counsel's Representations

Petitioner's witness, Mr. Murphy, could not confirm that he himself wrote the declaration (EX2914). *See* EX2915 (Murphy Tr.) at 11:20-21. Mr. Murphy further admitted that he relied upon what "the Legal Department convey[ed]" to him,

instead of performing his own investigation on many of the topics discussed in "his" declaration. *Id.* at 99:13-17; *see also id.* at 85:10-86:8, 94:12-97:20.

Additionally, the declaration is entirely bereft of any detail concerning Mr. Murphy's "investigation" or other steps taken to "confirm that onsemi has never sold … any component of the [IAPs]." EX2914 at ¶7. In fact, all Mr. Murphy ever did was "consult[] with onsemi's legal department," *i.e.*, the very team that apparently drafted his declaration.

2. Petitioner's Declaration Reveals a Concerted Effort Among Counsel for Greenthread Petitioners

Even more telling that this is the same attorney argument is the fact that each of the declarations (offered by Onsemi, Cirrus Logic, OmniVision, GlobalFoundries, and MPS) closely track one another, are approximately the same, *short* length, and are presented in the same form with the issues discussed in nearly identical order. Then, during depositions two weeks later, each witnessed discussed various details of their supposed investigation and drafting process. But as explained above, none of these details that would differentiate the declarations are found in the declarations themselves. Not only do these boilerplate declarations simply parrot the very same attorney argument rejected by the Director, but they show that counsel drafted these declarations, and then asked their respective witnesses to "confirm" what was already written. The similarity between the declarations is uncanny, reflecting each

petitioner's effort to substitute attorney argument for "investigation" and to again deny PO the discovery it was granted by the Director and ordered by the Board.

3. Petitioner Has Provided No Documents to Support its Arguments

Finally, the fact that Petitioner has produced ***zero*** accompanying documents with its declaration indicates that Petitioner did the bare minimum by simply giving a new face to its attorney arguments. But as the party with the burden of proof on the issue, the party performing the actual "investigation," and party in control of any documentary evidence that would prove or disprove its privity position, Petitioner has offered no evidence whatsoever. The underlying litigation between the parties has been stayed since April 2024, which only heightens the role of the discovery process in this IPR proceeding. PO has had no other means to acquire the evidence the Board needs to make a complete RPI/privity determination. But now that the Director and the Board have ordered this discovery, Petitioner has offered nothing besides its unsubstantiated declarations.

In fact, Mr. Murphy never even attempted to "locate any documents" nor asked his sales team or the legal department to "collect any documents showing onsemi [T&Cs] of sale to products sold to Intel." EX2915 at 44:15-18, 65:20-66:7. As explained in PO's Post-Remand Brief, this is just one instance where a reasonable investigation would have yielded documents responsive to the Board's Order.

Petitioner lambasts PO for requiring that it prove a "negative point." Response at 13 While PO disagrees, *see infra*, §II.C, even if it were true, Petitioner has offered nothing that would help it disprove Intel's status as an RPI to this IPR. It has not produced a shred of documentary evidence in connection with this dispute, and, as the party bearing the burden of proof, it cannot prevail.

B. Petitioner Has Failed to Prove that it Does Not Supply Any Components of the IAPs

As explained at length in PO's Supplemental Brief, any investigation into Petitioner's supplier relationship with Intel was cabined solely to whether or not there are direct sales or indemnity agreements for the complete IAPs themselves. Once that "investigation" turned up empty, Petitioner irrationally concluded that it has never supplied any *components* of the IAPs. *See* EX2915 at 25:12-51 (testifying it was not "necessary to investigate" components). But when this was held up to the light, Petitioner seemingly attacked PO for suggesting that there may be some unidentified components from Petitioner in the IAPs. It was not PO who put this focus on "components" of the IAPs. The Board's Order required that Petitioner produce "[d]ocuments sufficient to show the asserted privity relationship between Petitioner and Intel," including "whether Petitioner was the supplier of any … component of a product[] accused of infringement in the Intel Litigation." Disc. Order at 6. Petitioner was given the opportunity to investigate the truth of its assertions, but failed to do so. These conclusory, attorney-generated statements are

insufficient to meet Petitioner's burden of proof, and Petitioner's minimal (at best) investigation demonstrates Petitioner's disregard for this portion of the Board's Order.

Throughout its Response, Petitioner is seemingly taken aback by PO's suggestion that Petitioner should have reached out to Intel to confirm its understanding of what is or is not included as components of the IAPs. Not only does Petitioner maintain communication with Intel, but it is the best source of proof to confirm or deny the matter. *See*, *e.g.*, IPR2024-00001, Paper 94 at 11 (offering declarant's admission that "***Intel know[s] best*** about what is included and not included in its own products."). However, Petitioner, as the party with the burden of proof and with close ties to Intel, refused to ask this simple question. This begs the question: ***Why?***

Mr. Murphy admitted that he "did no further investigation" into "whether of the [IAPs] include a product made or sold by onsemi." EX2915 at 26:14-27:1. He testified to not "speak[ing] with anyone in-house at onsemi about whether or not they knew whether any of the [IAPs] … include onsemi parts," *id.* at 28:8-22, even though there are people "better positioned" than him to answer questions related to Petitioner's business with Intel, *id.* at 24:20-25:8. In fact, "someone on [his] own team communicate[s] with employees for Intel regarding issues related to onsemi products." *Id.* at 52:8-11, 38:1-13. This alone proves that Petitioner has open lines

of communication with Intel that could have confirmed its privity position. The following discourse reveals how bare Mr. Murphy's investigation actually was:

> Q. Sure. Did you speak with anyone else at onsemi about the [IAPs]?
>
> A. No. …
>
> Q. ***Did you speak with anyone at Intel about the [IAPs]?***
>
> A. ***No.***
>
> Q. How long did it take you to complete your investigation? And by investigation I mean your review of Pages 4 through 8 of Exhibit 2048.
>
> A. Not very long. I -- I also looked at a view of what we had shipped. But, that is all that I did.
>
> Q. And about how long did that entire process take?
>
> A. Not long.
>
> Q. ***Less than an hour?***
>
> A. ***Yes.***

EX2915 at 19:8-20:6; *see also id.* at 31:2-6. Further, Mr. Murphy never asked Intel for a parts list for the IAPs. *Id.* at 89:9-15. This would not have been a burdensome task for Mr. Murphy or the members of his sales team that manage Petitioner's relationship with Intel.

Petitioner's discussion of Mr. Murphy's errata sheet and re-direct testimony (Response at 12) does nothing to move the needle here. First, Mr. Murphy completely changed his testimony on re-direct, and counsel proceeded to move to a new subject without asking any follow-up questions of how he "misunderstood" the earlier line of questioning from PO's counsel. EX2915 at 83:6-84:11. Second, the reason for the errata sheet is based in large part on this misguided re-direct testimony. Third, Petitioner has "attempted to excise [] portions of his testimony. … [S]uch alterations are improper." *MaxLinear, Inc. v. Cresta Tech. Corp.*, IPR2015-00592, Paper 87 at 14 (PTAB Apr. 17, 2019). The Board does "not favor[] the submission of errata sheets that make substantive changes in testimony." *Samsung Elecs. Co. Ltd. v. Neonode Smartphone LLC*, IPR2021-00145, Paper 54 at 3 (PTAB Jan. 25, 2022) (listing prior Board decisions). "A deposition is not a take home examination" and "differs from interrogatories" and the declaration offered here. *Greenway v. Int'l Paper Co.*, 144 F.R.D. 322, 325 (W.D. La. 1992). Mr. Murphy "cannot alter what was said under oath" by offering a more "artful response" after the fact. *Id.*

Rather than taking the straightforward step of contacting Intel itself (or even the salespeople and engineers that communicate with Intel) to discern the true answer to the Board's inquiry, Petitioner took a head-in-the-sand approach. This bare minimum "investigation" leaves too many questions unanswered and does not help Petitioner satisfy its burden on the RPI/privity issue. Moreover, these

actions fail to properly respond to the discovery ordered by the Director and to the Order issued by the Board.

C. Greenthread is Not Demanding that Petitioner "Prove a Negative"

Petitioner criticizes PO for trying to make it prove a "negative point." Response at 13. But that is premised on a few fundamental flaws. ***One***, PO is not imposing this burden on Petitioner; that comes from case law and the Discovery Order issued by the Board. ***Two***, to try and prove a negative means: there is no conceivable (or discoverable) proof available to show that none of Petitioner's products are included in an IAP. That is not the case here. Petitioner tries to meet its burden by offering boilerplate declaration statements, but as explained above, that is insufficient for the task at hand. Instead, PO has offered a handful of other sources of documentary proof that would shed more light on the issue: agreements or communications between Petitioner and Intel for non-accused products, documents reviewed or created as part of this so-called investigation, internal correspondence related to Petitioner's investigation, or other documents mentioned by Mr. Murphy. *See* PO Brief at 14-15. Further, PO has already explained (and various declarants agreed) that ***Intel itself*** is the best source of proof on this issue. Petitioner could have put this issue to rest and proven whether it supplies Intel with any IAP components by contacting Intel. Petitioner could have done this at a much earlier point in the proceeding, but even when given the chance now, it has failed to do so.

D. Petitioner's Indemnity-Related Arguments Are Misplaced

Petitioner devotes a substantial portion of its Response to arguing whether or not it ever received a specific indemnity request during the pendency of PO's previous litigation against Intel. But just because Intel never tendered an indemnity request does not excuse Petitioner for its conduct or any contractual obligations. Intel was not bound to tender indemnity to Petitioner if it believed it was in the best position to defend the case. In fact, Petitioner tacitly agrees with how Intel defended that litigation, since the later petitions offered by Petitioner nearly mirror the petitions, asserted references, and arguments offered by Intel's counsel. Notably, one of onsemi's petitions includes a massive transcription error from Intel's petitions. *See* IPR2023-01244, Paper 1 at 4 ("Intel concurrently submits a Power of Attorney…").

Moreover, PO has demonstrated that Petitioner's terms and conditions include indemnity provisions for sales made to Intel. Mr. Murphy confirmed that Petitioner's Standard T&Cs (EX2010) apply to all customers, including Intel, and that this language requires Petitioner to "indemnify a buyer based upon a claim of patent infringement of a product purchased from onsemi." EX2915 at 43:19-44:6, 45:14-46:5, 74:15-22. However, he performed no investigation into these terms and did not "try to locate any documents including those [T&Cs] of sales made to Intel." *Id*. at 65:11-14; *see also* PO Brief at 13-14 (collecting deposition admissions).

Last, he never inquired "whether Intel had ever submitted an indemnification request to onsemi [for] the Intel litigation" or "any other litigation." *Id.* at 50:3-20.

Further, PO and the Board have no way of knowing whether indemnity would come into play in this case because ***Petitioner did not truly investigate whether its products were incorporated into the IAPs***. *See* § II.B, *supra*. Petitioner has failed to produce any documentary evidence as to this threshold issue. Without fully knowing whether Petitioner supplied components of the IAPs, the Board cannot make a correct determination as to Petitioner's indemnity obligations to Intel. That Petitioner's declarant asserted that Intel never tendered an indemnity request is inconsequential given Petitioner's failure to comply with other prongs of the Order.

E. Greenthread Maintains that the Time-Bar Issue Could Be Decided on the Existing Record, *Before* the Ordered Discovery

Before the Board's Discovery Order (June 2025), Petitioner refused to produce any "actual evidence": **(1)** when requested by PO after the wave 1 petitions were filed; **(2)** when opposing PO's original discovery motions; **(3)** when requested by the Board to provide "supporting evidence" with its Preliminary Replies; **(4)** when filing its later, post-institution Replies; **(5)** when responding to either of PO's Director Review requests; **(6)** when requesting rehearing of the granted Director Review in May 2025; or **(7)** at any other time during the pendency of these IPRs. This was never a burdensome endeavor, as Petitioner's second declaration was less than four full pages and took a matter of a few hours to prepare (including

Mr. Murphy's "investigation"). But now that Petitioner has been gifted a final opportunity by the Director and the Board to produce documents sufficient to disprove Intel's status as RPI to this proceeding, Petitioner has thumbed its nose at the Order. Thus, Petitioner has *still* failed to carry its burden on this issue.

F. Policy Considerations and Fairness Support Greenthread

Finally, basic policy considerations and notions of fairness support PO's position that Petitioner has not complied with the Discovery Order. At the end of the day, Petitioner submitted a single, self-serving declaration from an unprepared witness—nothing else. The Director and the Board have ordered Petitioner to produce responsive documentary evidence, and instead of doing so, Petitioner took the narrowest possible reading of the Order, addressed each point in a matter of a few lines, and attached nothing to support those statements.

The extent of "discovery" offered here defies the entire rationale and motivation behind a meaningful discovery process at the PTAB. If this is considered "sufficient," it will have a chilling effect on parties making privity and time bar arguments under 35 U.S.C. § 315(b). In instances like this, it is ***petitioners***, not patent owners, that have access to the evidence. This would set precedent for allowing petitioners to flout well-reasoned discovery requests, like PO has done in these IPRs, and drive up the costs to the parties and the Board by litigating a full IPR when it may very well should have never been instituted in the first place. Here, PO sought

to resolve this issue ***early*** in the case. PO made substantiated arguments to Petitioner's counsel and requested counter-evidence. When these requests proved futile, PO was authorized to file discovery motions—*all before* its POPRs were due. Those requests were wrongly denied, but even still, Petitioner waited until the eleventh hour to provide any evidence whatsoever to disprove the time-barred parties' status as RPIs to this proceeding.

Petitioner should have been more forthcoming with evidence along the way. If the district court case had not been stayed, PO would have filed motions to compel compliance and Petitioner ordered to produce responsive documents. PO does not have that option here. This supposedly efficient alternative to district court litigation has been anything but, and if the Board accepts this minimal level of "evidence" to overcome an allegation of privity, then there will never be a finding of privity in similar circumstances.

III. CONCLUSION

The "discovery" that Petitioner was ordered to produce revealed nothing more than the same attorney argument that it has touted for the past two years. Petitioner's superficial "investigation" into the threshold question of whether it supplies any component of the IAPs has left too many questions unanswered at this stage of the IPR proceeding. Petitioner has not carried its burden of proof on the

RPI/privity issue, despite being given a final chance to do so, and as a result, this proceeding should be terminated.

Dated: September 2, 2025

Respectfully submitted,

/Alan Whitehurst/

Alan Whitehurst
Reg. No. 43,263
awhitehurst@mckoolsmith.com
Arvind Jairam
Reg. No. 62,759
ajairam@mckoolsmith.com
MCKOOL SMITH, P.C.
1717 K St. NW, Suite 1000
Washington, DC 20006
Telephone: (202) 370-8300
Facsimile: (202) 370-8344

Scott W. Hejny
Reg. No. 45,882
shejny@mckoolsmith.com
MCKOOL SMITH, P.C.
300 Crescent Court, Suite 2100
Dallas, TX 75201
Telephone: (214) 978-4000
Facsimile: (214) 978-4044

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

Counsel for Patent Owner
Greenthread, LLC

CERTIFICATION OF SERVICE

The undersigned hereby certifies that a copy of this **PATENT OWNER'S REPLY POST-HEARING BRIEF CONCERNING BOARD-ORDERED DISCOVERY** has been served on Petitioner via email on the following counsel of record for Petitioner:

Roger Fulghum
Roger.Fulghum@BakerBotts.com
Michael Hawes
Michael.Hawes@BakerBotts.com
BAKER BOTTS L.L.P.
One Shell Plaza
910 Louisiana Street
Houston, TX 77002

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

Daniel Anderson
Daniel.Anderson@andersonpatents.com
1930 S. Alma School Road, Suite A200
Mesa, AZ 85210

Eliot D. Williams
Eliot.Williams@BakerBotts.com
700 K Street, NW Washington, DC 20006

dlgreenthreadvonsemi@bakerbotts.com

Dated: September 2, 2025 By: */Alan Whitehurst/*
Alan Whitehurst, Reg. No. 43,263