

From: [Nicholas T. Matich](#)
To: [Josh Griswold](#); [Neil Ozarkar](#); IPR12189-0086IP1; PTAB Inbound; [Rick Bisenius](#)
Cc: [Greenthread-TI-MS](#)
Subject: RE: Texas Instruments Incorporated v Greenthread LLC - IPR2024-00672, IPR2024-00673, IPR2024-00674 (12189-0086IP1)
Date: Thursday, April 18, 2024 6:48:04 PM
Attachments: [image003.png](#)
[image004.png](#)
[DRAFT TI IPR protective order.docx](#)

Josh,

I think you misunderstand our position. TI has the burden to prove that its petition is timely. TI is indisputably a supplier to time-barred parties and it is well established that supplier relationships can create privity. Since TI has the burden of proof, TI must produce evidence regarding the nature of those relationships to show that they do not create privity. That includes contracts with the parties and communications among them. Indemnity is merely one aspect of that relationship that is relevant. If TI chooses not to produce evidence to meet its burden, its petition should be dismissed.

Our email below, identifies TI products as components of previously accused products. There is no requirement that party's product be named in prior litigation to establish privity.

Regarding the interrogatory, we have identified the accused products to TI. TI is in a better position than we are to know which of those products are sold to time barred parties. TI's interrogatory is therefore unduly burdensome and impossible to answer, because TI has not produced all of its sales data. Nevertheless, we will update the interrogatory response to include a 33(d) reference to sales data TI had produced and our infringement contentions.

Regarding the licenses, we have already produced them in the district court and we have no objection to TI's IPR counsel seeing those documents under the terms of the EDTX protective order. If you wish us to produce them as part of this proceeding, please let us know if you consent to the attached PO.

Regarding OnSemi, please produce your communications with Onsemi after the filings of OnSemi's IPRs.

Regarding the other JDG issues, there is no court-ordered coordination regarding invalidity contentions. All such coordination was voluntary, particularly with Monolithic Power and Cirrus Logic who are not before the EDTX Court. Please produce all agreements and communications with them or confirm that TI is in privity with those parties.

McKool Smith | Nicholas T. Matich

Principal | Washington | Tel: (202) 370-8301 | Mobile: (703) 863-7922

From: Josh Griswold <griswold@fr.com>

Sent: Thursday, April 18, 2024 10:02 AM

To: Nicholas T. Matich <nmatich@McKoolSmith.com>; Neil Ozarkar <nozarkar@McKoolSmith.com>; IPR12189-0086IP1 <IPR12189-0086IP1@fr.com>; PTAB Inbound <PTABInbound@fr.com>; Rick Bisenius <bisenius@fr.com>

Cc: Greenthread-TI-MS <Greenthread-TI-MS@mckoolsmith.com>

Subject: RE: Texas Instruments Incorporated v Greenthread LLC - IPR2024-00672, IPR2024-00673, IPR2024-00674 (12189-0086IP1)

Nick,

I appreciate your further explanation, but you're overlooking that TI's products were not implicated in any of the prior suits. As mentioned, we did not see any reference to TI or a TI product in the infringement contentions. Thus, I fail to see the relevance of our indemnity terms if TI's products weren't implicated.

As to Greenthread's failure to take a position on whether any products TI may sell to the prior defendants are covered by the patents or their respective licenses, consider Defendant's Interrogatory No. 3. The interrogatory asks Greenthread to "[i]dentify each product that Greenthread, or any company holding a license to the Patents-in-Suit, made, used, offered for sale or sold that Greenthread alleges embodies or uses any alleged invention covered by the Patents-in-Suit." I understand that, for TI, Greenthread has not substantively responded identifying any products. Thus, if Greenthread believes it is accusing a TI product sold to Intel, Dell, Sony or Samsung that is covered by a patent in suit and a license, please identify the product and produce the license so that we may evaluate your claims.

Regarding Onsemi, Onsemi is not a member of the JDG. TI has had no communications with Onsemi concerning the IPRs prior to Onsemi's filings.

Finally, I'm confused by your allegation that joint invalidity contentions are indicative of RPI. Director Vidal has recently clarified that court ordered case-management coordination, such as joint contentions and claim construction, doesn't even create the type of "significant relationship" contemplated by Valve in a General Plastics analysis.

Again, we've considered your allegations, and we are comfortable with our determination on RPI/privities.

Best regards,

Josh Griswold, Counsel for TI

From: Nicholas T. Matich <nmatich@McKoolSmith.com>
Sent: Monday, April 15, 2024 7:53 AM
To: Josh Griswold <griswold@fr.com>; Neil Ozarkar <nozarkar@McKoolSmith.com>; IPR12189-0086IP1 <IPR12189-0086IP1@fr.com>; PTAB Inbound <PTABInbound@fr.com>; Rick Bisenius <bisenius@fr.com>
Cc: Greenthread-TI-MS <Greenthread-TI-MS@mckoolsmith.com>
Subject: RE: Texas Instruments Incorporated v Greenthread LLC - IPR2024-00672, IPR2024-00673, IPR2024-00674 (12189-0086IP1)

Josh,

Thank you for your email. However, to meet its burden under 315(b), TI needs to produce evidence, not merely attorney argument. TI has not done that.

If the time-barred parties actually agreed to TI's standard terms, we are entitled to see a document reflecting their agreement, not just TI's website. Your statement that they "would have been sold" under those terms is not evidence that they actually were. Further, since TI apparently collaborates with these parties regarding the products, it is unlikely that TI's "standard" terms applied and TI must provide evidence regarding the nature and extent of that collaboration, including correspondence between the parties regarding the design of relevant products.

We do not understand your statement that Greenthread has "refused to take a position" whether TI's products sold to Intel, Sony, and Samsung are licensed. License is an affirmative defense, not an element of Greenthread's case. We have not had occasion to take a position on this issue in the district court case, because TI has not asserted a license defense. If TI asserts a license defense, we would not dispute that sales covered by the Intel, Sony, and Samsung licenses are in fact licensed. We have already produced the licenses in the district court action and would do so here if it would be helpful to TI.

Regarding the joint defense group, you say that "there has been no input or cooperation by the joint defense group in our preparation of *copies* of Onsemi's petitions." The relevant question is whether TI worked with Onsemi in preparing the *original* petition. Further, TI has jointly worked on its invalidity contentions with Cirrus Logic, Omnivision, and MPS. If those parties are time-barred (which they are) TI should be time-barred as well. We reiterate our request for the joint defense agreement.

Finally, I would note that our requests also apply in IPR2024-00771, IPR2024-00772, IPR2024-00773, and IPR2024-00774.

Nick

McKool Smith | Nicholas T. Matich
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From: Josh Griswold <griswold@fr.com>
Sent: Friday, April 12, 2024 7:50 PM
To: Neil Ozarkar <nozarkar@McKoolSmith.com>; IPR12189-0086IP1 <IPR12189-0086IP1@fr.com>; PTAB Inbound <PTABInbound@fr.com>; Rick Bisenius <bisenius@fr.com>
Cc: Greenthread-TI-MS <Greenthread-TI-MS@mckoolsmith.com>
Subject: RE: Texas Instruments Incorporated v Greenthread LLC - IPR2024-00672, IPR2024-00673, IPR2024-00674 (12189-0086IP1)

Colleagues,

We have investigated the allegations in your email below, and we are comfortable that we have identified the correct real parties in interest and privies. We will not withdraw the petitions.

TI was not involved in any of the prior suits you mention, nor is it even clear that TI's products were implicated in those suits. In our review of the infringement contentions for these cases, we saw no reference to Texas Instruments or a TI-produced semiconductor. It is well established that by simply being a manufacturer and customer, parties aren't in privity.

Moreover, any product sold by TI to Intel, Dell, Sony or Samsung would have been sold under TI's standard terms and conditions or an agreement consistent with these terms and conditions. TI's standard terms and conditions are linked [here](#). You'll see that the indemnity clause only covers direct infringement by TI's products and is only triggered if the indemnified party promptly informs TI of the claim. Neither condition was met. Thus, TI was not obligated to indemnify the prior parties.

As to licenses, we understand that Greenthread has refused to take a position in discovery in the district court on whether any products TI may sell to these entities are covered by the patents or their respective licenses. If Greenthread believes it is accusing a TI product sold to Intel, Dell, Sony or Samsung that is covered by a patent in suit and a license, please identify the product and produce the license so that we may evaluate your

claims.

We have provided the relevant terms and conditions noted above. We cannot agree to your remaining requests that TI produce all agreements, all documents and a declaration, as the requests are overly broad, unduly burdensome and improperly seek litigation positions.

Regarding the joint defense group, as you well know, several of the JDG members filed their own IPRs. Our petitions are copies of Onsemi's IPRs, and there has been no input or cooperation by the joint defense group in our preparation of copies of Onsemi's petitions.

Finally, as you appreciate, because our petitions are copies filed with a motion to join, if Onsemi is found not to be barred from its filing, whether or not TI is barred, TI may still join Onsemi's proceedings.

Best regards,

Josh Griswold, Counsel for TI

Joshua A. Griswold

Office Managing Principal ■ Fish & Richardson P.C.

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From: Neil Ozarkar <pozarkar@McKoolSmith.com>

Sent: Monday, March 25, 2024 5:49 PM

To: IPR12189-0086IP1 <IPR12189-0086IP1@fr.com>; PTAB Inbound <PTABInbound@fr.com>; Josh Griswold <griswold@fr.com>; Rick Bisenius <bisenius@fr.com>

Cc: Greenthread-TI-MS <Greenthread-TI-MS@mckoolsmith.com>

Subject: Texas Instruments Incorporated v Greenthread LLC - IPR2024-00672, IPR2024-00673, IPR2024-00674 (12189-0086IP1)

[This email originated outside of F&R.]

Counsel for TI,

Petitioner in the above-captioned matters has the burden of identifying all real parties in interest (RPIs) in the petitions and demonstrating that the petitions are not time barred. *Samsung Electronics Co. Ltd. v. Netlist Inc.*, IPR2022-00615, Paper 40 (Director Vidal Feb. 3, 2023) (quoting *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242 Fed. Cir. 2018); 35 U.S.C. § 322(a). The petitions should be withdrawn because they do not meet these requirements.

More than one year before the filing of these petitions, Intel and Dell were served with complaints alleging infringement of Greenthread's patents at issue. Sony was an RPI of Dell. Samsung was served with a complaint alleging infringement of the '195 patent more than one year ago. As the attached documents and links that follow indicate, TI is a supplier to at least Intel, Dell, and Sony. See, e.g., <https://www.ifixit.com/Teardown/PlayStation+5+Teardown/138280> (TI products in the Sony PlayStation 5); <https://www.ti.com/tool/TIDA-020003>; <https://www.ti.com/lit/ug/slvuaj8/slvuaj8.pdf> (TI product "designed specifically" for an Intel product); <https://www.ti.com/lit/an/sluaa54b/sluaa54b.pdf>; <https://www.dell.com/support/home/en-us/drivers/driversdetails?driverid=gvh3c>; <https://www.dell.com/support/home/en-ee/drivers/driversdetails?driverid=0fp8y>. TI's discovery responses in litigation further confirm that TI is a supplier to at least Intel and Sony. These may be obtained through TI's litigation counsel. Therefore, petitioner may be operating, in part, under Greenthread's licenses to Intel, Dell, and/or Sony. Accordingly, petitioner is in privity with at least one of Intel, Dell, and/or Sony (or they are RPIs) and the petitions are time barred.

If petitioner does not withdraw its petitions, then petitioner should produce:

- (1) All agreements with Intel, Sony, Dell, or Samsung relating to transistor products sold to or made for them or the prior litigations.
- (2) All communications with Intel, Sony, Dell, or Samsung relating to such products or the prior litigations.

Further, petitioner should provide a sworn declaration stating whether it believes any of its activities are covered by Greenthread's licenses.

Second, we understand that there is a joint defense agreement among defendants in district court actions involving these patents. Therefore, petitioner should (1) withdraw its petitions, (2) amend the petitions to include the other defendants as RPIs, or (3) produce any joint defense agreement and any communications with other members of the joint defense group relating to the patents at issue (including under a privilege log if necessary) so that we can evaluate any claim by petitioner that other defendants were not involved in these IPRs. *Mitek Sys., Inc. v. United Servs. Auto. Ass'n*, No. IPR2020-00882, 2020 WL 4375112, at *7 (P.T.A.B. July 30, 2020) ("granting USAA's request for any joint defense or common interest agreements").

Regards,
Neil Ozarkar



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