

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SONY GROUP CORPORATION

Petitioner

v.

GREENTHREAD, LLC

(record) Patent Owner

Patent No. 10,734,481

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**SUBMISSION ADDRESSING MULTIPLE PETITIONS**

This is a submission under the *Patent Trial and Appeal Board Consolidated Trial Practice Guide November 2019* (pp. 57-59) addressing the presentation of multiple petitions. The present petition is being filed subsequent to the filing of *Intel Corp. v. Greenthread, LLC*, IPR2023-00260 (November 28, 2022), filed by a different petitioner, also addressing U.S. Pat. No. 10,734,481 (“the ’481 patent”).

A second *inter partes* review addressing the same patent is warranted under *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, Case IPR2016-01357 (Paper 19)(PTAB September 6, 2017)(Precedential as to §II.B.4.i); *see also Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, -00063, -00084 (PTAB Apr. 2, 2019) (Paper 11) (precedential)(applying *General Plastic* where the petitioners are not identical). The *General Plastic* factors are addressed as follows:

***“1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;”***

The petition in IPR2023-00260 was filed by Intel Corporation (“Intel”), a different petitioner from the present petition (Sony Group Corporation). The petition in IPR2023-00260 addresses only claims 1-9, 13-18, 20-27, and 31-35, while the present petition addresses all claims 1-36.

The difference in petitioners and claims is significant, and weighs in favor of considering the present petition on the merits. The petitioner in IPR2023-00260, Intel, is a named defendant in a co-pending lawsuit by record Patent Owner

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Greenthread, LLC (“Greenthread”), namely *Greenthread, LLC v. Intel Corporation et al*, Case No. 6-22-cv-00105 (W.D. Tex.), filed January 27, 2022 (“the West-Texas Litigation”). In that litigation, Intel is accused of infringement of the ’481 patent for its own activities related to processors and certain semiconductor technologies. (Ex. 1015, ¶¶46-48). Furthermore, co-defendants Dell Inc. and Dell Technologies Inc. (together “Dell”) are accused of infringement for their alleged incorporation of “Intel Accused Products into Dell’s products”. (Ex. 1015, ¶¶49-52).

In a subsequent Amended Complaint (April 29, 2022), Greenthread also accused Dell of infringement for incorporation of “Sony image sensors”. (Ex. 1016, ¶¶76-81)(Ex. 1017). In particular, Greenthread specifically accused Dell of infringing, based on its use of Sony image sensors, claims not challenged by in IPR2023-00260 but challenged in the present petition, specifically claims 19 and 36. These claims recite the further limitation “wherein the device is an image sensor”. The accused products allegedly containing the accused Sony image sensor are also sold to other customers not involved in the West-Texas Litigation. (*e.g.* compare Ex. 1028 with Ex. 1016, ¶80). The present petitioner thus has an independent commercial interest in pursuing an inter partes review of the ’481 patent, and in particular, the claims directed to image sensors that are not addressed in IPR2023-00260.

The present petition also presents distinct prior art. The petition in IPR2022-

00260 presents prior art challenges over Kawagoe, Wieczorek, Wolf, and Gupta.<sup>1</sup> Each of these references is directed to general semiconductor techniques for the formation of transistors and other devices. (IPR2022-00260, Ex. 1007, Abstract)(IPR2022-00260, Ex. 1008, Title)(IPR2022-00260, Ex. 1006, ¶¶0002)(Ex. 1014, Abstract). In contrast, both the Miyagawa and Silverbrook devices of the present petition are directed to chips that have image-sensor capabilities (Ex. 1011, Abstract)(Ex. 1004, Fig. 15), as relevant to the accused Sony image sensors. (Ex. 1016, ¶¶76-81)(Ex. 1017).

Because the present petition is submitted by a different petitioner with distinct commercial interests, and addresses claims asserted in a co-pending litigation but not addressed in the first petition, using prior art specifically directed to the subject matter of those interests and claims, this factor weighs strongly against discretionary denial.

***“2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have***

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<sup>1</sup> **Kawagoe** is U.S. Patent No. 6,043,114 (IPR2022-00260, Ex. 1007); **Wieczorek** is U.S. Patent Application Publication 2003/0183856 (IPR2022-00260, Ex. 1006); **Wolf** is Stanley Wolf and Richard N. Tauber, *Silicon Processing for the VLSI Era*, Lattice Press (2000) (IPR2022-00260, Exs. 1008A-D); **Gupta** is U.S. Patent No. 6,163,877 (IPR2022-00260, Ex. 1014).

***known of it;”***

The Petitioner was aware of the prior art asserted in the second petition (and indeed had already completed a first draft of the second petition) at the time of filing of the first petition. Because the two petitions are filed relatively close in time by different petitioners, however, this factor does not weigh in favor of discretionary denial.

***“3. whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review in the first petition;”***

The Petitioner has not received a preliminary response or institution decision related to the first petition. This factor thus weighs against discretionary denial.

***‘4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;”***

The Petitioner learned of the prior art references in the present petition at various times after April 29, 2022 (when Greenthread filed its Amended Complaint including accused Sony image sensors) and October 17, 2022. Petitioner has been diligently working on the preparation of petitions since June, 2022. Because the petitioners are different and the present Petitioner has filed its petition with 19 days of the prior petition, there is no undue delay this factor weighs against discretionary denial.

***“5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;”***

Petitioner is filing the present petition within 19 days of the filing of the first petition. This time was necessary to finish drafting of the present petition and evaluate differences between the first-filed petition and the present petition. This factor weighs against discretionary denial.

***“6. the finite resources of the Board; and”***

Petitioner is not in a position to gauge the resources of the Board, but believes the interests of the parties and the public justify a second petition as described herein.

***“7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.”***

Because the petitions are presented by separate petitioners and there is no motion for joinder, there should be no impact on the one-year deadline and this factor thus weighs against discretionary denial.

In sum, because the Petitioners, their respective interests, the prior art and the claims differ between proceedings, the Board should not exercise its discretion to decline institution.

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|--------------------------------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Date: <u>December 17, 2022</u> | <u>/Matthew A. Smith/ (RN 49,003)</u><br>Matthew A. Smith<br>SMITH BALUCH LLP<br>700 Pennsylvania Ave. SE, 2nd Floor<br>Washington, DC 20003<br>(202) 669-6207<br>smith@smithbaluch.com<br><br><i>Counsel for Petitioner</i> |
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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that the foregoing Submission Regarding Multiple Petitions, was served by Express Mail on December 17, 2022, on the Patent Owner's counsel of record at the United States Patent & Trademark Office having the following address:

MUNCK WILSON MANDALA L.L.P  
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DALLAS, TX  
UNITED STATES

Date: December 17, 2022

/Matthew A. Smith/ (RN 49,003)

