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Subject:	Director Review of Semiconductor Components Industries LLC v. Greenthread LLC IPR2023-01242, -01243, and -01244
Date:	Monday, February 26, 2024 5:03:35 PM
Attachments:	image688330.png image829505.png 2024 02 26 IPR2023-01242 (222#1) [SEALED] Request for Director Review.pdf 2024 02 26 IPR2023-01242 (222#1) PO Motion to Seal Request for Director Review.pdf 2024 02 26 IPR2023-01243 (842) [SEALED] Request for Director Review.pdf 2024 02 26 IPR2023-01243 (842) PO Motion to Seal Request for Director Review.pdf 2024 02 26 IPR2023-01244 (222#2) [SEALED] Request for Director Review.pdf 2024 02 26 IPR2023-01244 (222#2) PO Motion to Seal Request for Director Review.pdf

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Dear Director Vidal:

Patent Owner Greenthread, LLC respectfully seeks Director Review of a Board panel's decisions to grant institution of three related IPRs (IPR2023-01242, -01243, and -01244) that challenge claims of U.S. Patent Nos. 11,121,222 and 10,510,842. Attached are Greenthread's requests for Director review filed today and accompanying motions to seal.

As explained in the requests, the Board's institution decisions are irreconcilable with at least two decisions from the Federal Circuit: *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237 (Fed. Cir. 2018) and *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375 (Fed. Cir. 2015). Under *Worlds*, the petitioner bears the burden of proof regarding the timeliness of its petition under section 315(b). Under *Dynamic Drinkware*, the party with the burden of proof on an issue loses when no evidence supports a finding in its favor.

Here, Greenthread put into the record evidence showing that Petitioner is in privity with a time-barred party, Intel. Petitioner put in *no evidence* whatsoever regarding its relationship Intel. Since Petitioner bears the burden of proof and had no evidence to support a finding in its favor, the panel abused its discretion by instituting trial.

First, the panel erred by placing the burden of proof on Greenthread to show that the petition was not timely. The panel discounted the evidence Greenthread submitted showing that Intel and Petitioner are in privity, and said that Greenthread had not satisfied its burden, because it had not pointed to *further* evidence that they are in privity. The further evidence the panel said that Greenthread needed included confidential contracts and communications between Petitioner and Intel. However, the panel had denied Greenthread's motion to compel discovery of those very same documents on the grounds that they would not be "useful" in the privity analysis. In addition to being irreconcilable with Federal Circuit precedent, the panel's two decisions are irreconcilable with themselves.

Second, the panel applied the wrong legal standard in its privity analysis. The undisputed record

shows that Petitioner manufactures licensed products for Intel under a license between Greenthread and Intel. Under well-established law from numerous courts of appeals, including the Federal Circuit, Petitioner is therefore acting as Intel's agent with regard to products that would otherwise infringe and is therefore in privity with Intel.

The only issue that Greenthread submits for Director review is the timeliness of the petition, including the two errors identified above.

The Director should grant review and issue an order denying the petition as untimely, because Petitioner had multiple opportunities to put in evidence to meet its burden, but chose not to do so. In the alternative, the Director should vacate the institution decision, clarify the standard for privity, and reverse the panel's decision on Greenthread's discovery motion so that the Board can evaluate privity on a complete record.

Patent Owner has concurrently filed the attached requests for Director Review via P-TACTS in each of the above-identified IPR proceedings.

Sincerely,
Nick Matich
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