

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SEMICONDUCTOR COMPONENTS INDUSTRIES, LLC, and TEXAS
INSTRUMENTS INCORPORATED,
Petitioner,

v.

GREENTHREAD, LLC,
Patent Owner.

IPR2023-01242¹
U.S. Patent No. 11,121,222

**PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO
STRIKE NEW EXHIBITS SUBMITTED WITH
PATENT OWNER'S SUR-REPLY**

¹ Texas Instruments Incorporated, which filed a petition in IPR2024-00673, has
been joined as a petitioner in this proceeding.

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EXHIBIT LIST

Exhibit No.	Description	Submitted Previously?
Ex. 2001	<i>Greenthread, LLC v. Intel Corp.</i> , No. 6:22-cv-00105-ADA, Dkt. 7 (summons returned executed) (W.D. Tex. Feb. 7, 2022)	X
Ex. 2002	Email communication from Petitioner’s counsel to Patent Owner’s counsel October 16, 2023	X
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	X
Ex. 2004	“Clock Devices for Servers” (Aug. 2020) available at https://cdrdv2-public.intel.com/620306/620306_Clock_Devices_For_Server_Rv1p3.pdf	X
Ex. 2005	On Semiconductor Corporation Form 10-K filing with U.S. Securities and Exchange Commission for the fiscal year ended December 31, 2016	X
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	X
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/datasheet/pdf/ncp81566-d.pdf	X

Exhibit No.	Description	Submitted Previously?
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	X
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	X
Ex. 2010	Onsemi Standard Terms and Conditions of Sale, Rev.08102021 available at https://www.onsemi.com/site/pdf/ONSEMI_T&C.pdf	X
Ex. 2011	Plaintiff’s First Set of Common Interrogatories to Defendants ON Semiconductor Corporation and Monolithic Power Services, Inc., Et Al., <i>Greenthread, LLC v. ON Semiconductor Corp.</i> , No. 23-443-RGA (D. Del.) (served Sept. 27, 2023)	X
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., <i>Greenthread, LLC v. ON Semiconductor Corp.</i> , No. 23-443-RGA (D. Del.) (served Sept. 27, 2023)	X
Ex. 2013	Definition of “privity” in Black’s Law Dictionary (11 th ed. 2019) available from Westlaw at westlaw.com	X
Ex. 2014	Email communication from Petitioner’s counsel to Patent Owner’s counsel October 11, 2023	X
Ex. 2015	Plaintiff’s Identification of Accused Products and Asserted Patents, <i>Greenthread, LLC v. ON Semiconductor Corp.</i> , No. 23-443-RGA (D. Del.) (served Oct. 12, 2023)	X

Exhibit No.	Description	Submitted Previously?
Ex. 2016	Petition (Paper 2) in <i>Sony Group Corp. v. Greenthread, LLC</i> , IPR2023-00324	X
Ex. 2017	Petition (Paper 1) in <i>Sony Group Corp. v. Greenthread, LLC</i> , IPR2023-00376	X
Ex. 2018	<i>Greenthread, LLC v. Intel Corp.</i> , No. 6:22-cv-00105-ADA, Dkt. 1 (Complaint) (W.D. Tex. Jan. 27, 2022)	X
Ex. 2019	<i>Greenthread, LLC v. Dell Inc.</i> , No. 6:22-cv-105-ADA, Dkt. 120 (Second Amended Complaint)	X
Ex. 2020	<i>Greenthread, LLC v. ON Semiconductor Corp.</i> , No. 23-443-RGA, Dkt. 1 (Complaint with accompanying exhibits) (D. Del. Apr. 21, 2023)	X
Ex. 2021	<i>Greenthread, LLC v. ON Semiconductor Corp.</i> , No. 23-443-RGA, Dkt. 24 (Scheduling Order) (D. Del. Sept. 11, 2023)	X
Ex. 2022	Confidential agreement	X
Ex. 2023	Petition (Paper 1) in <i>Intel Corp. v. Greenthread LLC</i> , IPR2023-00308	X
Ex. 2024	Petition (Paper 1) in <i>Intel Corp. v. Greenthread LLC</i> , IPR2023-00420	X
Ex. 2025	Petition (Paper 1) in <i>Intel Corp. v. Greenthread LLC</i> , IPR2023-00552	X
Ex. 2026	Petition (Paper 1) in <i>Dell Techs. Inc. v. Greenthread LLC</i> , IPR2023-00506	X
Ex. 2027	Petition (Paper 1) in <i>Dell Techs. Inc. v. Greenthread LLC</i> , IPR2023-00509	X

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Ex. 2028	Confidential declaration	X
Ex. 2029	Email communication from Patent Owner's counsel to Petitioner's counsel between May 26 to June 1, 2023	X
Ex. 2030	Web pages from websites of Onsemi (www.onsemi.com), Mouser Electronics, Inc. (www.mouser.com), Rochester Electronics (www.rocelec.com), and DigiKey Corporation (www.digikey.com) (URLs for web pages are indicated on respective pages)	X
Ex. 2031	<i>Greenthread, LLC v. Intel Corp.</i> , No. 6:22-cv-00105-ADA, Dkt. 113 (Redacted Memorandum Opinion and Order) (W.D. Tex. Dec. 27, 2022)	X
Ex. 2032	<i>Greenthread, LLC v. Intel Corp.</i> , 6:22-cv-00105-ADA, Dkt. 38 (First Amended Complaint for Patent Infringement) (W.D. Tex., filed Apr. 29, 2022)	X
Ex. 2033	<i>Greenthread, LLC v. Intel Corp.</i> , 6:22-cv-00105-ADA, Dkt. 38-8 (Greenthread's Amended Preliminary Infringement Contentions) (W.D. Tex., filed Apr. 29, 2022)	X
Ex. 2034	<i>Greenthread, LLC v. Intel Corp.</i> , 6:22-cv-00105-ADA, Dkt. 38-12 (Exs. D-1, D-2, D-3, D-6 to Greenthread's Preliminary Infringement Contentions) (W.D. Tex., filed Apr. 29, 2022)	X
Ex. 2035	Plaintiff's Supplemental Identification of Asserted Patents and Accused Products in <i>Greenthread, LLC v. ON Semiconductor Corp.</i> , No. 23-443-RGA (served to Petitioner's counsel on Nov. 10, 2023)	X
Ex. 2036	Webpage regarding iFixIt, PlayStation 5 Teardown (https://www.ifixit.com/Teardown/PlayStation+5+Teardown/138280)	X

Exhibit No.	Description	Submitted Previously?
Ex. 2037	Webpage from Mouser Electronics, Inc. for NCP252160 (https://www.mouser.com/ProductDetail/onsemi/NCP252160MNTWG?qs=sPbYRqrBIVkc9klNZ2pXbg%3D%3D)	X
Ex. 2038	Webpage from DigiKey for NCP252160 (https://www.digikey.com/en/products/detail/onsemi/NCP252160MNTWG/15859992)	X
Ex. 2039	Webpage from Mouser Electronics, Inc. for NB3L202K (https://www.mouser.com/ProductDetail/onsemi/NB3L202KMNTXG?qs=z6PAvqrnkvrR8PcLN2EnUzg%3D%3D)	X
Ex. 2040	Webpage from DigiKey for NB3L202K (https://www.digikey.com/en/products/detail/onsemi/NB3L202KMNTXG/7220446)	X
Ex. 2041	Definition of “agent” in Black’s Law Dictionary (11 th ed. 2019) available from Westlaw at westlaw.com	X
Ex. 2042	<i>Greenthread, LLC v. Intel Corp.</i> , 6:22-cv-00105-ADA, Dkt. 135 (Motion for Admission Pro Hac Vice of L. Popovski on Behalf of Sony) (W.D. Tex., filed January 30, 2023)	X
Ex. 2043	[RESERVED]	
Ex. 2044	Email communication from Patent Owner to Petitioner’s litigation counsel dated September 13, 2023	X
Ex. 2045	<i>Greenthread, LLC v. Intel Corp.</i> , 6:22-cv-00105-ADA, Dkt. 49 (Notice of Appearance of Additional Counsel) (W.D. Tex., filed June 9, 2022)	X
Ex. 2046	[RESERVED]	

Exhibit No.	Description	Submitted Previously?
Ex. 2047	[RESERVED]	
Ex. 2048	<i>Greenthread, LLC v. Intel Corp.</i> , 6:22-cv-00105-ADA, Dkt. 120-8 (Greenthread’s Amended Preliminary Infringement Contentions) (W.D. Tex., filed Jan. 23, 2023)	X
Ex. 2049	Email communications between Petitioner’s counsel and Patent Owner’s counsel, dated Oct. 31, 2023 - Nov. 1, 2023	X
Ex. 2050	Email communications between Petitioner’s counsel and Patent Owner’s counsel, dated Nov. 2-7, 2023	X
Ex. 2051	Email communications between Petitioner’s counsel and Patent Owner’s counsel, dated Nov. 14-15, 2023	X
Ex. 2052	Email communications between Petitioner’s counsel and Patent Owner’s counsel, dated Dec. 12-13, 2023	X
Ex. 2053	Web page from website of Onsemi (https://www.onsemi.com/products/custom-assp/soc-sip-custom-products)	X
Ex. 2054	<i>Greenthread, LLC v. ON Semiconductor Corp.</i> , No. 23-443-RGA, Dkt. 36 (Second Amended Complaint) (D. Del. Nov. 22, 2023)	X
Ex. 2055	<i>Greenthread, LLC v. ON Semiconductor Corp.</i> , No. 23-443-RGA, Dkt. 42 (Defendants’ Answer, Affirmative Defenses, and Counterclaims to Plaintiff’s Second Amended Complaint) (D. Del. Dec. 20, 2023)	X
Ex. 2056	Email communications between the Board, Petitioner’s counsel and Patent Owner’s counsel dated November 27, 2023	X
Ex. 2057	Declaration of Dr. Alexander Glew	X

Exhibit No.	Description	Submitted Previously?
Ex. 2058	Transcript of Deposition of Dr. Travis Blalock in IPR2013-01242, -01243, -01244	X
Ex. 2059	Excerpts from Chen, J. Y., <u>CMOS Devices and Technology for VLSI</u> , Prentice-Hall (1990)	X
Ex. 2060	U.S. Patent No. 5,384,476 (“Nishizawa”)	X
Ex. 2061	CV of Dr. Alexander Glew	X
Ex. 2062	U.S. Patent No. 8,421,195	X
Ex. 2063	U.S. Patent No. 9,190,502	X
Ex. 2064	U.S. Patent No. 10,510,842	X
Ex. 2065	U.S. Patent No. 10,734,481	X
Ex. 2066	U.S. Patent No. 11,316,014	X
Ex. 2067	File History of U.S. Patent No. 8,421,195	X
Ex. 2068	File History of U.S. Patent No. 9,190,502	X
Ex. 2069	File History of U.S. Patent No. 10,510,842	X
Ex. 2070	File History of U.S. Patent No. 10,734,481	X

Exhibit No.	Description	Submitted Previously?
Ex. 2071	File History of U.S. Patent No. 11,316,014	X
Ex. 2072	Declaration of Phil John	X
Ex. 2073	Statista Information	X
Ex. 2074	Petition in <i>Sony Group Corp. v. Greenthread, LLC</i> , IPR2023-00325	X
Ex. 2075	Petition in <i>Sony Group Corp. v. Greenthread, LLC</i> , IPR2023-00375	X
Ex. 2076	[RESERVED]	
Ex. 2077	<i>Greenthread, LLC v. Cirrus Logic Inc.</i> , No. 1:23-cv-369-DC-DTG, Dkt. 53 (Claim Construction Order and Memorandum in Support Thereof) (W.D. Tex. Mar. 13, 2024)	X
Ex. 2078	<i>Greenthread, LLC v. Cirrus Logic Inc.</i> , No. 1:23-cv-369-DC-DTG, Dkt. 37 (Opening Claim Construction Brief by Greenthread) (W.D. Tex. Nov. 27, 2023)	X
Ex. 2079	<i>Greenthread, LLC v. Samsung Elecs. Co.</i> , No. 2:19-CV-00147-JRG, 2020 WL 1911200 (Claim Construction Memorandum Opinion and Order) (E.D. Tex. Apr. 20, 2020)	X
Ex. 2080	Exhibit 2022 in <i>Texas Instruments Inc. v. Greenthread LLC</i> , IPR2024-00771 (including excerpts of the Deposition Transcript of Scott Warrick taken on June 7, 2024 along with marked Exhibits 3-5 in <i>Greenthread, LLC vs. Cirrus Logic, Inc.</i> , 1:23-cv-00369-DC (W.D. Tex.))	X

Exhibit No.	Description	Submitted Previously?
Ex. 2081	Email communications between the Board, Petitioner's counsel and Patent Owner's counsel dated August 13, 2024	X
Ex. 2082	Email communication to the Board from Petitioner's counsel and Patent Owner's counsel dated August 30, 2024	

I. INTRODUCTION

The Petition fails because it does not show the “aid carrier movement” claim limitation in the prior art. The Petition argues that “carriers [must move] in a particular direction” and that any dopant gradient inherently exerts a sufficient force in the proper direction to “aid carrier movement.” Pet., 22, 59 (emphasis added; brackets in original). That theory fell apart, because the undisputed record is that different gradients exert forces of different magnitudes and in different directions. Carrier movement is only “aided” if the gradient’s force is sufficient to overcome other forces acting on the carriers, such as the resistance of the silicon. Even Petitioner now admits: “‘graded’ does not mean ‘aided.’” Paper 62 (Pet. Reply), 9.

In its Reply, Petitioner changed its argument and drops its “must move” locution and inherency theory. Petitioner now says that any force from a gradient is inherent and that any force will “aid carrier movement.” Under Petitioner’s theory, even if a gradient’s force is overwhelmed by other forces or is pushing opposite to the movement of the carriers, the force still “aids carrier movement.” Paper 62, 7 (“any given electric field will aid electron movement...”), 9 (“‘graded’ does not meant ‘aided,’ but ‘graded’ does mean ‘electric field,’ and an ‘electric field’ means ‘aided’ in one direction”). This new “characterization” of the claim language is not in the Petition and both Petitioner’s theories are wrong.

Petitioner’s expert Dr. Blalock admitted that the force of a gradient does not necessarily cause a carrier to move, let alone move in a specified direction. He said the “net” force is what determines movement and that he did not consider any forces besides the gradient. Ex. 2058, 188:16-189:16. Dr. Blalock previously offered a construction requiring that carriers move in a specified direction, plainly contradicting Petitioner’s new “any force” theory. *See Dell Technologies Inc., v. Greenthread, LLC*, IPR2023-00509, Ex. 1003 at 22 (agreeing that “aid carrier movement from” means “to sweep the carriers from”). The uncontroverted evidence is “if two forces are acting on an object in opposite directions, both forces cannot aid its movement.” Ex. 2057, 29. There are “always” other forces acting on a carrier so a gradient alone will not inherently aid carrier movement. Ex. 1052, 87:14-88:7.

Thus, since the Petition is fatally defective, Petitioner’s Reply offers a new construction that tries to expand the scope of “aid carrier movement” to encompass any force at all. This construction is not only new, it is illogical and contradicted by the evidence. Instead of facing the issue head on, Petitioner now moves to strike legal authority and deposition testimony attached as exhibits to Greenthread’s sur-reply. These exhibits highlight the fallacy in Petitioner’s “any force” construction. Petitioner’s motion should be denied. Legal authority, particularly from courts addressing analogous claim construction issues, must be considered. And harmful testimony revealing flaws in Petitioner’s new construction should not be ignored.

II. ARGUMENT

A. Petitioner's Reply proffers a new claim construction

Petitioner says its Reply does not seek a new claim construction and that Greenthread mischaracterizes its arguments. Paper 76, 3-7. But Greenthread simply quotes Petitioner's words. In its POR, Greenthread explains that any gradient does not inherently aid carrier movement: "graded does not mean aided." Paper 47, 13. Greenthread then explains that the Petition ignores this fact, and simply points to a gradient without proving it is sufficient to aid carrier movement. *See id.*, 13-20. In its Reply, Petitioner says it "disagree[s] with PO's characterization of the 'aid carrier movement' limitation." Paper 62, 2 (emphasis added). Yet, Petitioner then admits "'graded' does not mean 'aided,'" and for the first time instead argues "'graded' does mean 'electric field,' and an 'electric field' means 'aided' in one direction." *Id.*, 9 (emphasis added). Petitioner also says that there is "no dispute among the experts." *Id.* What a term "means" and how it is "characteriz[ed]" are plainly claim construction. If there is "no dispute among the experts" on the facts, Petitioner's Reply arguments can only be about claim construction.

B. Petitioner's rehashed merits arguments fail

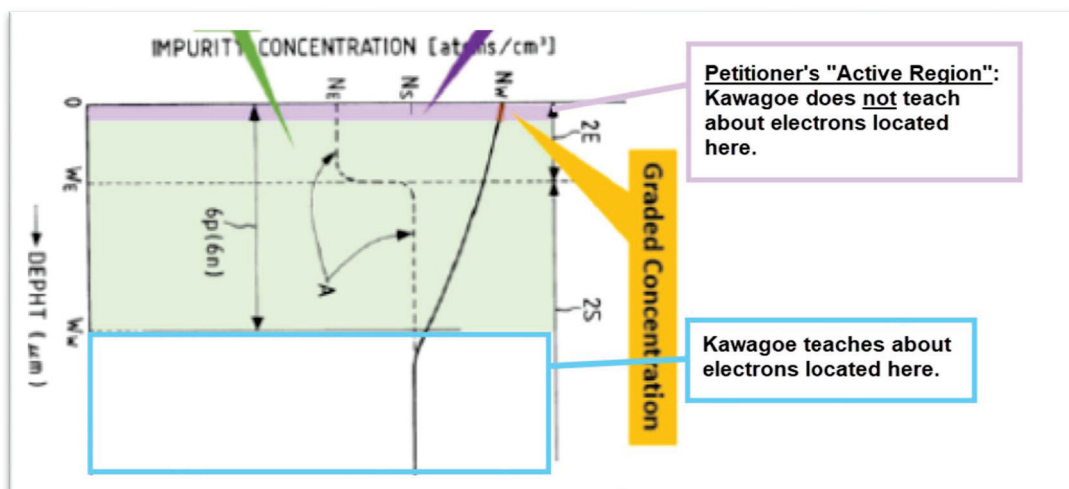
Petitioner uses the bulk of its brief as a sur-sur-reply to re-argue the merits of its Petition. Petitioner's arguments highlight the deficiencies in the Petition.

First, Petitioner still has no rejoinder to the fact that the "net" force is what

determines carrier movement. Ex. 2058, 188:16-189:16. The uncontroverted evidence is that “if two forces are acting on an object in opposite directions, both forces cannot aid its movement.” Ex. 2057, 29. Petitioner says these other forces are “unspecified,” but it is Petitioner’s job to “specify” them and account for them *in the Petition*. Paper 76, 6. Petitioner drafted the Petition without mentioning any other forces that a POSITA would understand to exist—like the inherent resistance of silicon. Both experts identified examples of these forces, and the uncontroverted evidence is that such forces are “always” present. Ex. 2058, 132:12; Ex. 1052, 87:14-88:7. The Petition simply failed to account for them.

Second, Petitioner says it “explained how Kawagoe met the limitation notwithstanding PO’s arguments.” Paper 76, 6. That is wrong. In its Motion, Petitioner reproduces Kawagoe’s figures and points to a **section** as the “**active region**.” *Id.* Yet, as shown below in annotations to Petitioner’s image, Kawagoe does not describe aiding carrier movement in the “**active region**.” Kawagoe’s description is limited to carriers well outside the active region. The Petition is explicit that Kawagoe “refers to electrons produced in the **large substrate body below the wells**.” Pet., 21 n.7. The carriers Kawagoe discusses are ““prevented from entering the **p-well**,”” and are thus below it. Paper 47, 23 (*quoting* Ex. 1007, 16:7-11). When Petitioner alleges that “Kawagoe explicitly describes downward-sloping graded dopant concentrations that aid the movement of carriers,” it does not

cite anything in Kawagoe discussing moving carriers from the active region. Paper 76, 6. The un rebutted testimony from Dr. Glew is instead that Kawagoe “doesn’t disclose” moving carriers from the active region. Ex. 1052, 122:6-9, 121:11-17. Since Petitioner is not proposing to modify Kawagoe and Kawagoe has no teaching about moving carriers from the active region, the Kawagoe grounds fail.



Even if Petitioner could overcome this deficiency, Petitioner’s Kawagoe grounds still fail, because Petitioner points to an “active region” and “substrate” with the same doping type. Paper 65, 11-14. The claims require the opposite.

C. Exhibits 2077-2079 and 2081 fall outside the scope of § 42.23(b)

37 C.F.R. § 42.23(b) provides that a sur-reply “may not be accompanied by new evidence.” Exhibits 2077-2079 are not “evidence.” They are legal authority, opinions from U.S. District Courts, and one related court filing. There is no prohibition—in § 42.23(b) or otherwise—on including “new” legal authority in a sur-reply. Legal authority cited for its persuasive value is not “new evidence.” For example, Courts of Appeals do not hear “new evidence” but expressly allow parties

to rely on new legal authority. *See, e.g.*, Fed. R. App. P. 32.1, Committee Notes (“[A] court of appeals may not prohibit a party from citing an unpublished opinion of a federal court for its persuasive value or for any other reason.”). Greenthread could have simply cited these public records and avoided Petitioner’s unreasonable objections. Instead, it attached them as exhibits for the convenience of the Board. *See, e.g., id.* (“[A] party who cites an opinion of a federal court must provide a copy of that opinion.”). The fact that Greenthread cited legal authority and included copies as exhibits is not a basis for refusing to consider the authority.

During the Parties’ call with the Board, Petitioner admitted Exhibits 2077-2079 were proper as legal authority. Now Petitioner reverses course, but none of the cases Petitioner cites support striking legal authority under § 42.23(b). Petitioner appears to have reversed course only to use the bulk of its brief as an improper sur-sur-reply attempting to justify its new claim construction position.

Exhibit 2081 is proper for the same reason. It is the Parties’ communications with the Board, not “new evidence” under § 42.23(b). Greenthread attached Exhibit 2081 to make it part of the record. Section 42.23(b) does not allow Petitioner to send “off-the-record” communications to the Board, shielded from public view and appellate review. And even if § 42.23(b) applied to Exhibits 2077-2079 or 2081, the Board should waive it here. First, ignoring relevant legal authority and allowing off-the-record communications with the Board does not advance the goal of resolving

the parties' dispute in a "just, speedy, and inexpensive manner." Second, Petitioner advances a new claim construction in its Reply that is directly opposite two well-reasoned district court opinions. The Board "would be remiss to overlook a[] district court's construction of the same claim terms." *See Finisar Corp. v. DirecTV Grp., Inc.*, 523 F.3d 1323, 1329 (Fed. Cir. 2008).

D. Exhibit 2080 is proper

The evidence in Exhibit 2080 is devastating to Petitioner. The corporate representative of Cirrus Logic—another large semiconductor company which has filed nearly identical IPRs—admitted that Petitioner's and Cirrus' common invalidity theory is wrong. The evidence is admissible as part of the prosecution history of the patents, objective evidence of nonobviousness, and to counter Petitioner's new claim construction.² Barring Greenthread from citing responsive

² The testimony provides responsive evidence of how a POSITA would understand the claims. Ex. 2080, 95:2-96:13 ("Q. Can you tell me if the gradient there would aid carrier movement downward? ... A. I cannot tell you that. ... Q. Is ... that because there's other things that might affect carrier movement besides the gradient? A. Yes.") (emphasis added). Petitioner does not dispute Cirrus's representative is a POSITA. *See* Ex. 2080, 155:6-7 ("I started with Motorola in [19]97 and I have been in the industry since").

evidence in its sur-reply would violate the APA. *See In re NuVasive, Inc.*, 841 F.3d 966, 973 (Fed. Cir. 2016). Petitioner’s counter arguments all fail.

First, Petitioner complains that Greenthread should have “alerted” it about the Cirrus testimony earlier. Paper 76, 8. But this was unnecessary, at least because Petitioner had access to the testimony before its Reply. Petitioner does not deny that it actually knew about the testimony beforehand, because Petitioner has been carefully monitoring other IPRs regarding the same patents. By the time of Petitioner’s Reply, Greenthread had already relied on the testimony (Ex. 2080) in public filings in the parallel IPRs, and explained how Cirrus admits critical flaws in the petitioners’ nearly identical arguments. *See Texas Instruments v. Greenthread, LLC*, IPR2024-000771, Paper 16 (P.T.A.B. July 22, 2024) (including as Ex. 2022 the Cirrus testimony). Petitioner did not lack notice of the Cirrus testimony. Petitioner just chose to ignore it in the hopes it would not become an issue here.

Even if Petitioner truly was unaware of the testimony when it filed its Reply, the correct remedy is supplemental briefing, not striking the evidence. Greenthread is under no obligation to affirmatively “alert” Petitioner to public documents in parallel IPRs before citing them here. The Board’s rules do not notify Greenthread that it had any such obligation and striking Greenthread’s evidence because it did not “alert” Petitioner by a certain date would violate due process and the APA. *See* 5 U.S. Code § 55(b)(1) (requiring that a party be “timely informed” of “the time,

place, and nature” of proceedings).

By contrast to the prejudice Greenthread would suffer from granting Petitioner’s motion, the prejudice Petitioner claims to suffer is manufactured. Almost a month before filing its sur-reply, Greenthread did “alert” Petitioner to the new evidence and requested waiver of § 42.23(b). *See* Ex. 2082. If Petitioner believed it had been prejudiced, Petitioner could have sought to depose Cirrus and/or requested supplemental briefing to address the testimony. Petitioner did neither and moved to strike instead. There is no justification for that strategy, except to avoid the merits. Briefing and deciding the instant motion is at least as burdensome—probably more burdensome—than granting Petitioner a supplemental brief on the testimony would have been. The Board should spend its resources on the merits, and not reward Petitioner’s efforts to avoid them. *See Cerner Corp. v. Clinicomp Int’l, Inc.*, 2019 WL 5608331, at *1 (P.T.A.B. Oct. 30, 2019) (“[M]ore time is ordinarily lost in listening to arguments as to the admissibility of evidence...than would be consumed in taking the evidence proffered.”) (cleaned up).

Second, Petitioner says the Cirrus testimony is “hearsay.” Paper 76 at 8-10. Again, Petitioner manufactures its objection to avoid the merits. Petitioner could have requested to depose Cirrus. Then, the testimony would not be “hearsay.” If parties could simply waive a deposition and then strike testimony as “hearsay” no testimonial evidence would ever come before the Board.

Even if Petitioner’s hearsay objection were not manufactured, it would still be meritless. Greenthread offers the Cirrus testimony, in part, as objective evidence of nonobviousness.³ Third-party statements offered as objective indicia of non-obviousness are not hearsay. *See Hynix Semiconductor Inc. v. Rambus Inc.*, 2009 WL 112834, at *14 (N.D. Cal. Jan. 16, 2009) (“[T]he article does not constitute hearsay because it was admitted not for its truth, but as a proper secondary consideration of non-obviousness in the form of praise from others in the industry.”). Petitioner offers no authority to the contrary. The Cirrus testimony also is not hearsay because it is a statement against interest. *See* Fed. R. Evid. 804(b)(3). Petitioner and Cirrus both infringe Greenthread’s patents and want them invalidated.

Petitioner also says—without supporting authority—that third-party testimony is not part of a prosecution history. That is wrong. The MPEP specifically authorizes testimonial evidence to support objective indicia of non-obviousness. *See* MPEP § 716.01(c). Thus, the testimony is admissible as part of the file history too.

III. CONCLUSION

Petitioner’s motion should be denied.

³ Petitioner does not deny that the testimony is an objective indicator of non-obviousness.

Dated: October 17, 2024

Respectfully submitted,

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that a copy of this **PATENT OWNER'S
OPPOSITION TO PETITIONER'S MOTION TO STRIKE NEW EXHIBITS
SUBMITTED WITH PATENT OWNER'S SUR-REPLY** has been served on
Petitioner via email on the following counsel of record for Petitioner:

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Dated: October 17, 2024

By: /Alan Whitehurst/
Alan Whitehurst, Reg. No. 43,263