

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

IPR2023-01243¹
U.S. Patent No. 10,510,842

**PETITIONER'S AUTHORIZED RESPONSE TO
DIRECTOR REVIEW REQUEST**

¹ Texas Instruments Incorporated, which filed a petition in IPR2024-00672, has been joined as a petitioner in this proceeding.

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Patent Owner’s Request for Director Review (“Req.”) should not be granted.

I. PATENT OWNER (“PO”) DID NOT PUT PRIVACY IN DISPUTE

Applying Federal Circuit law, the Board held that PO “had not provided a sufficient factual basis upon which to conclude” a prior litigant was time barred, or that, or that “Petitioner and Intel [] were privies, based on any of its theories regarding privacy.” Paper 82, 9-10; *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1244 (Fed. Cir. 2018). The Board’s rulings in the institution decision and final written decision (FWD) were well supported. Paper 82, 8-12; Paper 31, 8-20. Because PO’s flawed privacy theory did not put privacy in dispute, the Board did not reach the supposed question of whether “petitioner [can] meet its burden to prove that it is not time-barred by presenting zero ‘actual evidence’ on this issue.” Req., 1.

PO’s flawed privacy theory ignores privacy’s purpose. “Privacy” refers to the set of relationships that warrant an exception to the rule of due process that every party gets its day in court. *Taylor v. Sturgell*, 553 U.S. 880, 894 n.8 (2008). In the IPR context, the Federal Circuit held that “it is important to determine whether the petitioner and the prior litigant’s relationship—as *it relates to the lawsuit*—is sufficiently close that it can be fairly said that the petitioner had a full and fair opportunity to litigate the validity of the patent in that lawsuit.” *WesternGeco LLC v. ION Geophysical Corp.*, 889 F.3d 1308, 1319 (Fed. Cir. 2018) (emphasis added). Here, Petitioner had no notice, opportunity, or reason to litigate in Intel’s prior cases

(and vice-versa). Indeed, by virtue of PO's agreement with RPX, PO fully resolved its claims against Intel without any involvement from Petitioner, weeks before suing Petitioner, and months before Petitioner filed this IPR. *See, e.g.*, Req., 3; EX2022, 15 (RPX agreement dated April 7, 2023); EX2020, 14 (Complaint against Petitioner dated April 21, 2023); Paper 2 (Petition filed July 27, 2023). PO's allegation of privity between Petitioner and Intel on these facts is nonsensical. Moreover, PO's customer-manufacturer relationship arguments also fail. PO alleged no more than a standard customer-manufacturing relationship between Petitioner and Intel, which does not create privity. *WesternGeco LLC*, 889 F.3d at 1319-22; *Wi-Fi One, LLC v. Broadcom Corp.*, 887 F.3d 1329, 1340–41 (Fed. Cir. 2018).

And Petitioner ***does*** “dispute that it made Intel products accused in the *Intel* litigation.” Req., 1; Paper 21, 5 (“[C]ontrary to PO’s vague assertions on pages 13-15 of its POPR, there is no evidence that onsemi products were ‘at issue’ or otherwise accused of infringement in any previous case.”). At most, PO alleged that Petitioner products are ***compatible*** with ***some*** Intel CPUs or are “components” of certain Intel products, but not necessarily the products accused in PO’s litigation with Intel. Paper 17, 14-15 (citing EX2006); Paper 46, 52. PO recognized this, hedging that “even if none of the products currently accused by model number were sold to Licensees, the district court litigation is in its early stages and stayed.” Paper 46, 53. At bottom, PO fails to demonstrate any rational connection between Petitioner and

the prior Intel litigation. Instead, patent owner sued independent companies with independent products, and, as a matter of due process, each independent company should get its own day in court. *Taylor*, 553 U.S. at 892-93.

II. PO HAS ONLY ITSELF TO BLAME FOR LACKING DISCOVERY

The Board denied PO's pre-institution Motion for Additional Discovery because PO "fail[ed] to show that its proposed discovery requests seek information that would be useful in determining whether" prior litigants were "a privy of Petitioner pursuant to § 315(b)." Paper 29, 6-13. PO's proposed discovery was also overbroad. Paper 29, 3 (requesting "All agreements...", "All communications..."). Nonetheless, the Board gave PO the opportunity to "renew or tailor its request for additional discovery" after institution. Paper 82 (FWD), 11. PO chose not to do so. PO cannot now complain about a lack of discovery when PO failed to follow PTAB procedure and request that discovery. Req., 6-7. Moreover, PO's suggestion of a "pocket veto" ignores reality. *Id.*, 6. The Petition was filed in July 2023. PO did not "request[] that Petitioner provide information" related to an alleged time bar until October 2023. Req., 3; EX2014. PO did not file its Motion for Additional Discovery until October 17, which was less than a month before the POPR due date. Papers 7 and 17. PO's delay was the cause of PO's timing issues. In sum, PO's lack of discovery in this proceeding was due to PO's improper requests, PO's delay, and PO's failure to renew tailored requests—not because of any error by the Board.

III. THE BOARD PROPERLY CONSIDERED EX3001 AND EX3002

The Board considered EX3001 and EX3002 in its denial of PO's pre-institution Motion of Additional Discovery to address Petitioner's arguments about inconsistencies in PO's IPR and district court positions. Paper 29, 8; Paper 10, 6. The Board did not "bolster its decision to institute" with the exhibits because the Board did not rely on the exhibits in the institution decision. Req., 10; Paper 31.

IV. PETITIONER DID NOT RAISE A NEW CLAIM CONSTRUCTION

The Board struck exhibits EX2077-79 because PO's asserted basis for filing these exhibits with its Sur-Reply was flawed. EX2077-79 were also improperly filed with PO's Sur-Reply. 37 C.F.R. § 42.23(b). Petitioner *did not* introduce a new claim construction in its Reply. Paper 78, 5-7. To manufacture a claim construction dispute (in its Request and prior briefing), PO took Petitioner's factual arguments about "any given electric field" out of context. In context, Petitioner was explaining how electric fields work. Paper 61, 7 ("It thus makes no sense to say an electric field would impede all movement (nor aid all movement): any given electric field will aid electron movement in one direction and impede electron movement in the opposite direction."). The Board agreed that Petitioner provided "factual explanations, not claim construction arguments." Paper 78, 6-7. In addition, striking EX2077-2079 does not mean the Board "overlook[ed] a district court's construction of the same claim terms." Req., 11. The claim construction dispute in this IPR centered on the

phrase “to aid carrier movement,” and a district court applied the “plain and ordinary meaning” in EX2077. EX2077, 81. EX2078 is a brief submitted by PO, and EX2079 did not construe the term. As for EX2077, PO mischaracterizes statements from the district court’s resolution of an indefiniteness challenge to a different term as being a supposed construction. Paper 64, 4 (citing EX2077, 39-40); Req., 11-12.

V. THE BOARD PROPERLY CONSIDERED EX1054

PO’s argument that the Board’s reliance on “an excerpt from a still-pending continuation application” (EX1054) “demonstrates the Board’s proclivity to only consider evidence that favors one party of the other” is wrong. Req., 14. Petitioner simply submitted EX1054 with its Reply to support its factual explanations, and the Board correctly considered it. Paper 61 (Reply), 6; Paper 82 (FWD), 35.

VI. THE BOARD ADDRESSED ALL OF PO’S TIMELY ARGUMENTS

PO conflates the Board’s treatment of PO’s arguments about the location of Kawagoe’s *carriers* with the Board’s treatment of arguments about the location of Kawagoe’s graded dopant concentration. Req., 14-15. The Board’s analysis recognized that the system claims at issue do not require an act of moving a carrier. Paper 82, 36-37. Thus, there is no need for Petitioner to show carriers would be present in a given location. Nonetheless, the Board recognized “even if an alpha ray strike were required, Nishizawa indicates that the alpha ray strike could produce electrons near the surface of the CMOS device.” *Id.*, 44.

Dated: March 20, 2025

Respectfully submitted,

/Roger Fulghum/

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 20th day of March, 2025,
**PETITIONER'S AUTHORIZED RESPONSE TO PATENT OWNER'S
REQUEST FOR DIRECTOR REVIEW** was served by email on the following
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