

PUBLIC VERSION

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.

IPR2023-01242 (Patent 11,121,222 B2)

IPR2023-01243 (Patent 10,510,842 B2)

IPR2023-01244 (Patent 11,121,222 B2)¹

Before KRISTEN L. DROESCH, GRACE KARAFFA OBERMANN,
DONNA M. PRAISS, and MONICA S. ULLAGADDI,
*Administrative Patent Judges.*²

OBERMANN, *Administrative Patent Judge.*

ORDER

Conduct of the Proceeding

*Denying Patent Owner's Request for Authorization To Move to
Strike Exhibit 1058; Ordering Post-Remand Discovery in View of
Joint Statement (Paper 108); and Sua Sponte Ordering Post-Remand Briefs*
37 C.F.R. § 42.5

¹ Texas Instruments Inc. has been joined as petitioner based on petitions filed in IPR2024-00672, IPR2024-00673, and IPR2024-00674.

² This Order addresses issues identical across the cases, therefore, we enter the same order in each case. The listing of Judges does not extend any panel. The parties may use this style heading in any paper filed pursuant to this Order, provided such heading includes a footnote attesting "the word-for-word identical paper is filed in each proceeding identified in the heading."

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I. BACKGROUND

On April 24, 2025, the Director granted review of the Final Written Decisions issued in these proceedings. *See* IPR2023-01242 (“IPR1242”), Paper 94 (“Director’s Decision” or “Dir. Dec.”).³ The Director observed that, “[p]rior to institution, Patent Owner argued that the petitions were untimely under 35 U.S.C. § 315(b) due to a district court complaint served on Petitioner’s privy, Intel Corporation (‘Intel’), more than one year before the Petitions were filed.” IPR1242, Dir. Dec. 2 (citing Paper 56, 7–25). The Director held the Board abused its discretion by denying discovery into that privity issue. *Id.* at 2–3.

On that basis, the Director vacated and remanded the proceedings to the Board with express “instructions to allow discovery” on the question whether Petitioner is in privity with a specific, time-barred non-party, “Intel.” *Id.* at 3. The Director observed that “Patent Owner’s requested discovery was broad” and, further, instructed that “the Board either should have allowed whatever narrower discovery was appropriate or made it clear that Patent Owner could amend or resubmit its discovery motions.” *Id.*

On May 22, 2025, the Director denied Petitioner’s request for rehearing. IPR1242, Paper 106. The next day, on May 23, 2025, the Board asked the parties to submit a joint statement setting forth their “respective positions on the scope of any additional discovery required in each proceeding” to satisfy the mandate of the Director’s Decision. IPR1242, Ex. 3014. On May 30, 2025, the parties filed a Joint Paper Concerning

³ For convenience, we cite papers and exhibits filed in IPR2023-01242. Similar documents are of record in IPR2024-01243 and IPR2024-01244.

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Additional Discovery, which sets forth their differing views on the matter.
IPR1242, Paper 108 (“Joint Statement”).

With the Joint Statement, Petitioner filed a new declaration prepared for these proceedings. IPR1242, Ex. 1058. On June 5, 2025, Patent Owner submitted a request for authorization to move to strike Exhibit 1058, arguing that its submission was “procedurally improper.” IPR1242, Ex. 3015.

This Order⁴ denies Patent Owner’s request for authorization to move to strike Exhibit 1058, orders post-remand discovery in view of the Joint Statement, and *sua sponte* orders post-remand briefs. Any changes to the discovery and briefing schedules below must be approved by the Board.

II. DISCUSSION

A. Patent Owner’s Request for Authorization to Move to Strike Exhibit 1058

In support of the Joint Statement, Petitioner filed the Declaration of Mr. Mathew Murphy, who is Petitioner’s domestic Vice President of Sales. IPR1242, Ex. 1058 ¶ 3. Patent Owner requests authorization to move to strike Exhibit 1058, observing that the Board’s instructions pertaining to the Joint Statement did not invite either party “to submit its own, new evidence at this stage of the proceeding.” IPR1242, Ex. 3015; *see generally* Joint Statement (IPR1242, Paper 108).

⁴ Concurrently herewith, we issue related orders in IPR2024-00017, IPR2024-00018, IPR2024-00021, IPR2024-00263, IPR2024-00264, IPR2024-00265, IPR2024-00266, IPR2024-00468, IPR2024-00469, IPR2024-00470, IPR2024-00550, IPR2024-00551, IPR2024-00552, and IPR2024-00553. Final written decisions in other related cases (namely, IPR2024-00001, IPR2024-00016, IPR2024-00019, and IPR2024-00020) are the subject of pending requests for Director review.

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Petitioner responds that Mr. Murphy's declaration "is squarely responsive to the discovery that the Director specifically contemplated, e.g., 'any indemnification agreements between Petitioner and Intel and the terms and conditions of sale agreements between Petitioner and Intel related to products accused of practicing the challenged claims.'" IPR1242, Ex. 3015 (quoting IPR1242, Dir. Dec. 3).

We agree with Patent Owner that neither party was expressly authorized to file new evidence with the Joint Statement. IPR1242, Ex. 3015. By submitting Exhibit 1058 with the Joint Statement, Petitioner not only assumes that we will "side with Petitioner's view on the scope of discovery" (*id.*), but also attempts to discharge its discovery burdens "in the interest of time" (Joint Statement 12 (IPR1242, Paper 108 at 12)). Against that backdrop, we agree with Patent Owner that "Petitioner's submission [is] procedurally improper." IPR1242, Ex. 3015.

We do not agree, however, that admitting Exhibit 1058 "would circumvent the Director's (and the Board's) clear mandate to provide additional discovery." IPR1242, Ex. 3015. To the contrary, Exhibit 1058 on its face appears to be the very type of evidence that may facilitate the fair and efficient resolution of the outstanding privity dispute in accordance with the Director's mandate. *See generally* IPR1242, Ex. 1058.

Although the timing of Petitioner's submission of Exhibit 1058 is technically improper, we agree with Petitioner that Patent Owner, by arguing that Exhibit 1058 should be purged from the record, effectively complains "that Petitioner has provided *too much* discovery." IPR1242, Ex. 3015. (Petitioner's emphasis). Furthermore, in view of the post-remand discovery

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and briefing schedules set forth below, purging Exhibit 1058 from the record would be a pointless endeavor because Petitioner properly may produce the same evidence during the post-remand discovery period and, if it does so, may cite and explain that evidence in its responsive post-remand brief.

For the above reasons, we deny Patent Owner's request for authorization to file a motion to strike Exhibit 1058. The Board will consider Exhibit 1058 only to the extent cited and explained in a post-remand brief.

B. Parameters for Post-Remand Discovery

The Director observed that "Patent Owner's requested discovery was broad" and, on that basis, instructed that "the Board either should have allowed whatever narrower discovery was appropriate or made it clear that Patent Owner could amend or resubmit its discovery motions." IPR1242, Dir. Dec. 3. Importantly, the Director remanded "to the Board with instructions to allow discovery, narrowly tailored to the privity issue," then "determine on the full record," only "after Petitioner provides to Patent Owner the discovery that the Board authorizes," whether the Petitions are time-barred. *Id.* at 3, 6.

In the next subsections, we in turn address (1) Patent Owner's position that the Director's Decision supports broad post-remand discovery on Petitioner's asserted relationships with Intel, [REDACTED] and [REDACTED] (Joint Statement 5 (IPR1242, Paper 108 at 5)), (2) Patent Owner's incongruous position that the record is "closed" and Petitioner should be barred from producing any "actual evidence" on the privity issue (IPR1242, Ex. 3015); and (3) the parameters for post-remand discovery.

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1. Director's Decision Relates to Intel but not [REDACTED] or [REDACTED]

The parties disagree about the scope of additional discovery that is necessary and appropriate in view of the Director's Decision. *See generally* Joint Statement (IPR1242, Paper 108) (setting forth the parties' differing views). Patent Owner seeks discovery pertaining to asserted privity relationships between Petitioner and Intel, [REDACTED] and [REDACTED] *Id.* at 5. Petitioner, by contrast, argues that post-remand discovery, in view of the Director's Decision, should be limited to the asserted privity relationship between itself and Intel. *Id.* at 11.

Petitioner has the better position. Patent Owner repeatedly and erroneously suggests that the Director instructed the Board to allow discovery pertaining to Petitioner's alleged relationships with [REDACTED] and [REDACTED] Joint Statement 1, 6 (IPR1242, Paper 108 at 1, 6). To the contrary, as Petitioner points out, the Director expressly limited the instructions about post-remand discovery to Petitioner's alleged relationship with "Intel." *Id.* at 7 (quoting IPR1242, Dir. Dec. 3).

To be clear, the Director's instructions state that "the privity analysis focuses on the products at issue in the prior litigation and Petitioner's" alleged participation, or opportunity to participate, "in that prior litigation." Joint Statement 8 (IPR1242, Paper 108 at 8) (quoting IPR1242, Dir. Dec. 3) (Petitioner's emphasis omitted). The Director refers to Intel six times, but never to [REDACTED] or [REDACTED] including when discussing the appropriate scope of discovery on remand as including "agreements between Petitioner and Intel accused of practicing the challenged claims." IPR1242, Dir. Dec. 2–3. The "products accused" are "the 'Intel Accused Products' listed on pages 4–8 of

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Exhibit 2048, which are the Intel ‘products accused of practicing the challenged claims’ in Patent Owner’s prior litigation.” Joint Statement 7 (IPR1242, Paper 108 at 7).

As to [REDACTED] we agree with Petitioner that Patent Owner’s request for Director Review did not allege a privity relationship with [REDACTED] in fact, Patent Owner has never alleged in these proceedings that Petitioner is in privity with [REDACTED] *Id.* at 9 (and citations therein). Further, “Patent Owner’s privity theory, by its own terms, does not extend to [REDACTED] *Id.* at 10. Simply put, Patent Owner has never argued, much less offered objective proof, that the asserted “license rights” central to Patent Owner’s theory of privity extend to [REDACTED] *Id.* at 9–10 (citing IPR1242, Ex. 2022).

As to [REDACTED] we agree with Petitioner that “Patent Owner did not add [REDACTED] as a party to the prior litigation until the filing of a second amended complaint on January 23, 2023, which was less than a year before Petitioner filed” petitions in the instant proceedings. *Id.* at 10. Any relationship between Petitioner and [REDACTED] therefore, “does not implicate the time bar of 35 U.S.C. [§] 315(b)” and “any privity-related additional discovery regarding [REDACTED] would be irrelevant and thus unnecessary.” *Id.*

Under these circumstances, Petitioner’s position on the appropriate scope of post-remand discovery comports with the Director’s Decision. Before laying out the precise scope and timing of post-remand discovery, however, we first dispose of Patent Owner’s additional view, set forth in the Joint Statement, that “the record is closed” and Petitioner should be barred from producing any “actual evidence” in the post-remand period. *Id.* at 6.

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2. Patent Owner's Position that "the Record is Closed"

We expressly acknowledge Patent Owner's view that "the record is closed" and Petitioner should not be afforded an opportunity to produce any "actual evidence" to rebut the information that, as the Director indicated, shifts to Petitioner the burden of production on whether Petitioner is in privity with Intel. Joint Statement 6 (IPR1242, Paper 108 at 6); *see id.* at 4 (citing *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1244 (Fed. Cir. 2018)); *see also* IPR1242, Dir. Dec. 3 (indicating that Patent Owner met its burden of producing evidence sufficient to create a rebuttable presumption that Petitioner is in privity with time-barred entity Intel). We reject Patent Owner's view for two independent reasons.

First, Patent Owner's view violates the spirit and intent of the Director's Decision. Under Patent Owner's view, the Director could have reversed the Board outright and entered judgment in favor of Patent Owner based on the existing record without a remand. Instead, the Director remanded these cases to the Board with express instructions to reopen the record to allow Petitioner to produce evidence in furtherance of the development of a "full record" upon which the Board should reevaluate the privity dispute. IPR1242, Dir. Dec. 3. In particular, the Directed made crystal clear that on remand the Board should "allow discovery" on the privity dispute and "issue a decision on remand" based "on the full record" only "after Petitioner provides to Patent Owner the discovery that the Board authorizes." *Id.* at 3, 6. Plainly, Petitioner's intent to produce new evidence better aligns with the Director's Decision than Patent Owner's preference of

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resolving privity on the “closed” record without allowing Petitioner to produce any “actual evidence.” Joint Statement 6 (IPR1242, Paper 108 at 6).

Second, allowing Petitioner to produce new evidence is the most efficient and equitable course of action. We are sensitive to the fact that the Board’s decision, early on in these proceedings, to deny Patent Owner’s request for authorization to seek additional discovery on the privity issue, directly resulted in Petitioner’s failure to produce evidence that may illuminate the correct result on privity. IPR1242, Dir. Dec. 3.

Resolving the privity dispute on a “full record” after providing “Patent Owner the discovery that the Board authorizes” promotes the interests of justice, corrects the negative results of any error, and is appropriate given the potentially dispositive nature of the dispute. *Id.* Resolving the dispute on the existing record, by contrast, opens the door to further error that may lead to additional delay in reaching final resolution. *See* Joint Statement 6 (IPR1242, Paper 108 at 6) (Patent Owner’s view that “Petitioner should not now be allowed another bite at the apple to comply with its burden to show lack of privity”).

We determine that post-remand discovery is warranted in view of the clear mandate of the Director’s Decision. *See* IPR1242, Dir. Dec. 3, 6 (remanding “to the Board with instructions to allow discovery” on the privity dispute and to “issue a decision on remand” based “on the full record” only “after Petitioner provides to Patent Owner the discovery that the Board authorizes”). No conference call is necessary. *See* Joint Statement 1 (IPR1242, Paper 108 at 1) (parties’ conflicting positions on whether a conference call should be conducted).

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3. Scope and Timing of Post-Remand Discovery

Petitioner is instructed to provide the following discovery to Patent Owner by July 2, 2025:

- (a) The following documents:
 - a. Sales agreements between Petitioner and Intel for the Intel Accused Products;⁵ and
 - b. Indemnification agreements between Petitioner and Intel for the Intel Accused Products. *See* IPR1242, Dir. Dec. 3; Joint Statement 11 (IPR1242, Paper 108 at 11) (indicating Petitioner’s ability and willingness to produce such discovery).
- (b) Documents sufficient to show the asserted privity relationship between Petitioner and Intel, including any new declaration(s) that establish that “no documents responsive to” Subsection (a) above “exist” (Joint Statement 12 (IPR1242, Paper 108 at 12)), as well as any documents and new declaration(s) that establish (1) the time by which Petitioner became aware of the Intel litigation referenced in the Director’s Decision; (2) whether Petitioner was the supplier of any product, or component of a product, accused of infringement in the Intel litigation; and (3) whether Petitioner was in a position to control, or actually controlled, Intel’s defense of that litigation.
- (c) To the extent Patent Owner requests routine discovery in the form of cross-examination of any declarant(s) produced by Petitioner pursuant to Subsection (b) above, such requests shall be submitted no later than July 9, 2025, and all cross-examination (in the form of deposition(s)) shall be completed by July 29, 2025.

⁵ We agree with Petitioner that the “products accused” consist of “the ‘Intel Accused Products’ listed on pages 4–8 of IPR1242, Exhibit 2048, which are the Intel “products accused of practicing the challenged claims’ in Patent Owner’s prior litigation. Joint Statement 7 (IPR1242, Paper 108 at 7).

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C. Sua Sponte Order for Post-Remand Briefs

The Board *sua sponte* determines that post-remand briefs on the privity issue would be helpful to the panel in reaching an efficient and fair resolution of the instant cases in view of the Director's Decision. In particular, after post-remand discovery is completed according to the above parameters, the Board will consider new evidence only to the extent that it is cited and explained in a post-remand brief. Accordingly, we order post-remand briefs, and an optional telephonic privity hearing, as set forth below.

1. Patent Owner's Post-Remand Brief

No later than August 12, 2025, Patent Owner shall file a Post-Remand Brief, not to exceed fifteen (15) pages in length, that explains Patent Owner's position that Petitioner is in privity with time-barred entity Intel. In particular, the Brief should address in detail Patent Owner's assertion that Petitioner is a supplier of products to Intel that are the subject of the licensing agreement in the record. IPR1242, Ex. 2022. This brief may be supported by evidence of record as well as any documents, declarations, and deposition transcripts produced pursuant to the discovery ordered above. No other new evidence may accompany this brief.

2. Petitioner's Responsive Post-Remand Brief

No later than August 26, 2025, Petitioner shall file a Responsive Post-Remand Brief, not to exceed fifteen (15) pages in length. Petitioner may use this brief to respond to information presented in Patent Owner's Post-Remand Brief and to raise any other information that, in Petitioner's view, bears on the privity dispute. This brief may be supported by evidence of record as well as any documents, declarations, and deposition transcripts

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produced pursuant to the discovery ordered above. No other new evidence may accompany this brief.

3. Patent Owner's Reply Post-Remand Brief

No later than September 2, 2025, Patent Owner shall file a Reply Post-Remand Brief, not to exceed fifteen (15) pages in length, limited to rebutting the information presented in Petitioner's Responsive Post-Remand Brief. No new evidence may be filed in support of this brief.

4. Optional Hearing on the Privity Dispute

No later than September 4, 2025, the parties shall meet, confer, and jointly file a paper that presents their respective positions (or the parties' joint position if an agreement is reached) about whether the Board should conduct a telephonic hearing on the privity dispute. The joint paper shall provide times during the week of September 8, 2025, during which counsel for both parties are available for a teleconference, if one is requested.

III. ORDER

It is

ORDERED that Patent Owner's Request for Authorization to Move to Strike Exhibit 1058 is *denied*;

FURTHER ORDERED that post-remand discovery shall commence and be completed according to the parameters set forth herein;

FURTHER ORDERED that Patent Owner's Post-Remand Brief, Petitioner's Responsive Post-Remand Brief, and Patent Owner's Reply Post-Remand Brief shall be filed in compliance with the instructions set forth herein;

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FURTHER ORDERED that the parties shall file a joint paper addressing the optional hearing on the privity dispute as set forth herein;

FURTHER ORDERED that any changes to the discovery and briefing schedules set forth herein must be approved by the Board; and

FURTHER ORDERED that, within five (5) business days of the date of entry of this order, the parties shall file a redacted, public version of this Order.

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