UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SEMICONDUCTOR COMPONENTS INDUSTRIES, LLC,
Petitioner

v.

GREENTHREAD, LLC,
Patent Owner

Case: IPR2023-01244
U.S. Patent No. 11,121,222

PATENT OWNER'S MOTION TO SEAL PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE PURSUANT TO 37 C.F.R. §§ 42.14 & 42.54

Pursuant to 37 C.F.R. §§ 42.14 and 42.54, Patent Owner, Greenthread, LLC ("Patent Owner") respectfully submits this Motion to Seal. In accordance with the Office Trial Practice Guide ("TPG"), Patent Owner moves to seal Petitioner's Reply to Patent Owner's Preliminary Response (filed on December 13, 2023 by opposing counsel, as Paper 22) in its entirety, subject to later filing of a redacted version. Patent Owner has conferred with Petitioner, and, despite representing that Petitioner's brief contains confidential license information, Petitioner said it would not file a motion to seal and insisted that Patent Owner do so if Patent Owner wanted its information to remain confidential.

I. GOOD CAUSE EXISTS

The TPG states that "a document or thing will be made publicly available, unless a party files a motion to seal that is then granted by the Board." Office Trial Practice Guide (Nov. 2019) at 19; *see also* 35 U.S.C. §316(a)(7). "The document or thing will be protected on receipt of the motion and remain so, pending the outcome of the decision on motion." *Id.* The TPG states that "protective orders may be issued for good cause by the Board to protect a party from disclosing confidential information." *Id.* at 20 (citing C.F.R. § 42.54). Here, there is good cause for sealing Petitioner's Reply to Patent Owner's Preliminary Response because as explained below, that document contains sensitive, confidential, and non-public business

information, including licensing information regarding the identities of parties in license agreements and the terms of the license agreements.

Petitioner has shifted positions many times regarding whether Patent Owner's confidential information should remain confidential. On October 31, 2023, Patent Owner requested permission from Petitioner to file its motion for additional discovery under seal, because it would discuss a confidential license. Ex. 2049 (October 31, 2023 email from Patent Owner's counsel to Petitioner's counsel). Then, without explanation, Petitioner filed an *opposition* to the motion to which it had previously consented. Paper 21. Patent Owner tried to moot the dispute by offering redactions, but Petitioner would not agree. Ex. 2050 (November 7, 2023 email from Petitioner's counsel to Patent Owner's counsel); Ex. 2051 (November 15, 2023 email from Petitioner's counsel to Patent Owner's counsel).

Finally, the day Petitioner filed its Reply to Patent Owner's Preliminary Response, Petitioner indicated via email that its goal was to make public the identity of a third-party who was involved with Patent Owner's licenses. Ex. 2052 (November 13, 2023 email from Petitioner's counsel to Patent Owner's counsel). Petitioner has not provided any reason why that third-party's identity should be made public and publicizing the third-party's identity could harm both it and Patent Owner. Therefore, good cause exists for the information to remain under seal.

II. CERTIFICATION OF NON-PUBLICATION

To the best of Patent Owner's knowledge, the information sought to be sealed by this Motion has not been made publicly available.

III. PROTECTIVE ORDER

Patent Owner previously requested (in a Motion to Seal, Paper 7, filed at the time of Patent Owner's motion for additional discovery) entry of the Default Protective Order, found in the Office Trial Practice Guide at Appendix B. Patent Owner now moots its request upon Paper 7 and instead respectfully requests entry of the Protective Order (attached hereto as Attachment A). It is respectfully requested that this Protective Order govern the materials in this proceeding. Upon entry of this Protective Order, Patent Owner designates Petitioner's Reply to Patent Owner's Preliminary Response in its entirety as "PROTECTIVE ORDER MATERIAL."

IV. CONCLUSION

For at least the foregoing reasons, Patent Owner requests that the Board seal Petitioner's Reply to Patent Owner's Preliminary Response in its entirety.

Dated: December 14, 2023

Respectfully submitted,

/Alan L. Whitehurst/

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that a copy of this **PATENT OWNER'S MOTION TO SEAL PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE PURSUANT TO 37 C.F.R. §§ 42.14 & 42.54** has been served on Petitioner via email on the following counsel of record for Petitioner:

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Dated: December 14, 2023 By: */Alan L. Whitehurst/*
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APPENDIX A

PROTECTIVE ORDER

The following Protective Order will govern the filing and treatment of confidential information in the proceeding:

Protective Order

This protective order governs the treatment and filing of confidential information, including documents and testimony.

1. Confidential information shall be clearly marked "PROTECTIVE ORDER MATERIAL." Such materials shall be referred to as the "Confidential" category of materials. An additional category of confidentiality, encompassing materials even more sensitive than materials in the "Confidential" category, is the "Attorneys' Eyes Only" category. The "Attorneys' Eyes Only" category applies to materials such as licensing materials of a first party, whose disclosure to in-house counsel of an opposing party would create a substantial risk of serious harm to the first party. Materials shall be in the "Attorneys' Eyes Only" category, and shall be handled according to the rules applicable to this higher-sensitivity category, if either: (a) the materials are marked "PROTECTIVE ORDER MATERIAL / ATTORNEYS' EYES ONLY"; or (b) the materials are any of the following: Paper 8 in this proceeding (Patent Owner's Motion for Additional Discovery Pursuant to 37 C.F.R. § 42.51(B)(2)(I)); Paper 11 in this

proceeding (Petitioner's Opposition To Patent Owner's Motion for Additional Discovery); Paper 14 in this proceeding (Patent Owner's Reply In Support Of Motion for Additional Discovery); Paper 18 in this proceeding (Patent Owner's Preliminary Response Pursuant to 35 U.S.C. § 313 and 37 C.F.R. § 42.107); Ex. 2022 in this proceeding; Ex. 2028 in this proceeding.

2. Access to confidential information (unless the confidential information is in the "Attorneys' Eyes Only" category) is limited to the following individuals who have executed the acknowledgment appended to this order:

(A) Parties. Persons who are owners of a patent involved in the proceeding and other persons who are named parties to the proceeding.

(B) Party Representatives. Representatives of record for a party in the proceeding.

(C) Experts. Retained experts of a party in the proceeding who further certify in the Acknowledgement that they are not a competitor to any party, or a consultant for, or employed by, such a competitor with respect to the subject matter of the proceeding.

(D) In-house counsel. In-house counsel of a party.

(E) Support Personnel. Administrative assistants, clerical staff, court reporters and other support personnel of the foregoing persons who are

reasonably necessary to assist those persons in the proceeding shall not be required to sign an Acknowledgement, but shall be informed of the terms and requirements of the Protective Order by the person they are supporting who receives confidential information.

(F) The Office. Employees and representatives of the United States Patent and Trademark Office who have a need for access to the confidential information shall have such access without the requirement to sign an Acknowledgement. Such employees and representatives shall include the Director, members of the Board and their clerical staff, other support personnel, court reporters, and other persons acting on behalf of the Office.

3. Employees (e.g., corporate officers), consultants, or other persons performing work for a party, other than those persons identified above in section 2(A)–(E), shall be extended access to confidential information in the "Confidential" category only upon agreement of the parties or by order of the Board upon a motion brought by the party seeking to disclose confidential information to that person and after signing the Acknowledgment. The party opposing disclosure to that person shall have the burden of proving that such person should be restricted from access to confidential information.

4. Access to confidential information in the "Attorneys' Eyes Only" category is limited to the following individuals who have executed the acknowledgment appended to this order:

(A) Parties. Persons who are owners of a patent involved in the proceeding and other persons who are named parties to the proceeding.

(B) Party Representatives. Representatives of record for a party in the proceeding.

(C) Experts. Retained experts of a party in the proceeding who further certify in the Acknowledgement that they are not a competitor to any party, or a consultant for, or employed by, such a competitor with respect to the subject matter of the proceeding.

(D) Support Personnel. Administrative assistants, clerical staff, court reporters and other support personnel of the foregoing persons who are reasonably necessary to assist those persons in the proceeding shall not be required to sign an Acknowledgement, but shall be informed of the terms and requirements of the Protective Order by the person they are supporting who receives confidential information.

(E) The Office. Employees and representatives of the United States Patent and Trademark Office who have a need for access to the confidential

information shall have such access without the requirement to sign an Acknowledgement. Such employees and representatives shall include the Director, members of the Board and their clerical staff, other support personnel, court reporters, and other persons acting on behalf of the Office.

5. Employees (e.g., corporate officers), consultants, or other persons performing work for a party, other than those persons identified above in section 4(A)–(D), shall be extended access to confidential information in the "Attorneys' Eyes Only" category only upon agreement of the parties or by order of the Board upon a motion brought by the party seeking to disclose confidential information to that person and after signing the Acknowledgment. The party opposing disclosure to that person shall have the burden of proving that such person should be restricted from access to confidential information.

6. Persons receiving confidential information, whether in the "Confidential" category or the "Attorneys' Eyes Only" category, shall use reasonable efforts to maintain the confidentiality of the information, including:

(A) Maintaining such information in a secure location to which persons not authorized to receive the information shall not have access;

(B) Otherwise using reasonable efforts to maintain the confidentiality of the information, which efforts shall be no less rigorous than those the recipient

uses to maintain the confidentiality of information not received from the disclosing party;

(C) Ensuring that support personnel of the recipient who have access to the confidential information understand and abide by the obligation to maintain the confidentiality of information received that is designated as confidential; and

(D) Limiting the copying of confidential information to a reasonable number of copies needed for conduct of the proceeding and maintaining a record of the locations of such copies.

7. Persons receiving confidential information, whether in the "Confidential" category or the "Attorneys' Eyes Only" category, shall use the following procedures to maintain the confidentiality of the information:

A) Documents and Information Filed With the Board.

(i) A party may file documents or information with the Board along with a Motion to Seal. The Motion to Seal should provide a non-confidential description of the nature of the confidential information that is under seal, and set forth the reasons why the information is confidential and should not be made available to the public. A party may challenge the confidentiality of the information by opposing the Motion to Seal. The documents or

information shall remain under seal unless the Board determines that some or all of it does not qualify for confidential treatment.

(ii) Where confidentiality is alleged as to some but not all of the information submitted to the Board, the submitting party shall file confidential and non-confidential versions of its submission, together with a Motion to Seal the confidential version setting forth the reasons why the information redacted from the non-confidential version is confidential and should not be made available to the public. A party may challenge the confidentiality of the information by opposing the Motion to Seal. The non-confidential version of the submission shall clearly indicate the locations of information that has been redacted. The confidential version of the submission shall be filed under seal. The redacted information shall remain under seal unless the Board determines that some or all of the redacted information does not qualify for confidential treatment.

(B) Documents and Information Exchanged Among the Parties. Documents (including deposition transcripts) and other information designated as confidential that are disclosed to another party during discovery or other proceedings before the Board shall be clearly marked as "PROTECTIVE ORDER MATERIAL" or "PROTECTIVE ORDER MATERIAL /

ATTORNEYS' EYES ONLY" and shall be produced in a manner that maintains its confidentiality.

6. Within 60 days after the final disposition of this action, including the exhaustion of all appeals and motions, each party receiving confidential information, whether in the "Confidential" category or the "Attorneys' Eyes Only" category, must return, or certify the destruction of, all copies of the confidential information to the producing party.

(k) Standard Acknowledgement of Protective Order. The following form may be used to acknowledge a protective order and gain access to information covered by the protective order:

Standard Acknowledgment for Access to Protective Order Material

I _____, affirm that I have read the Protective Order; that I will abide by its terms; that I will use the confidential information only in connection with this proceeding and for no other purpose; that I will only allow access to support staff who are reasonably necessary to assist me in this proceeding; that prior to any disclosure to such support staff I informed or will inform them of the requirements of the Protective Order; that I am personally responsible for the requirements of the terms of the Protective Order and I agree to submit to the jurisdiction of the Office and the United States District Court for the Eastern District of Virginia for purposes of enforcing the terms of the Protective Order and providing remedies for its breach.

By: _____

Dated:

APPENDIX B

~~DEFAULT~~ PROTECTIVE ORDER

The following ~~Default~~ Protective Order will govern the filing and treatment of confidential information in the proceeding:

~~Default~~ Protective Order

This protective order governs the treatment and filing of confidential information, including documents and testimony.

1. Confidential information shall be clearly marked "PROTECTIVE ORDER MATERIAL." Such materials shall be referred to as the "Confidential" category of materials. An additional category of confidentiality, encompassing materials even more sensitive than materials in the "Confidential" category, is the "Attorneys' Eyes Only" category. The "Attorneys' Eyes Only" category applies to materials such as licensing materials of a first party, whose disclosure to in-house counsel of an opposing party would create a substantial risk of serious harm to the first party. Materials shall be in the "Attorneys' Eyes Only" category, and shall be handled according to the rules applicable to this higher-sensitivity category, if either: (a) the materials are marked "PROTECTIVE ORDER MATERIAL / ATTORNEYS' EYES ONLY"; or (b) the materials are any of the following: Paper 8 in this proceeding (Patent Owner's Motion for Additional Discovery Pursuant to 37 C.F.R. § 42.51(B)(2)(I)); Paper 11 in this

proceeding (Petitioner's Opposition To Patent Owner's Motion for Additional Discovery); Paper 14 in this proceeding (Patent Owner's Reply In Support Of Motion for Additional Discovery); Paper 18 in this proceeding (Patent Owner's Preliminary Response Pursuant to 35 U.S.C. § 313 and 37 C.F.R. § 42.107); Ex. 2022 in this proceeding; Ex. 2028 in this proceeding.

2. Access to confidential information (unless the confidential information is in the "Attorneys' Eyes Only" category) is limited to the following individuals who have executed the acknowledgment appended to this order:

(A) Parties. Persons who are owners of a patent involved in the proceeding and other persons who are named parties to the proceeding.

(B) Party Representatives. Representatives of record for a party in the proceeding.

(C) Experts. Retained experts of a party in the proceeding who further certify in the Acknowledgement that they are not a competitor to any party, or a consultant for, or employed by, such a competitor with respect to the subject matter of the proceeding.

(D) In-house counsel. In-house counsel of a party.

(E) Support Personnel. Administrative assistants, clerical staff, court reporters and other support personnel of the foregoing persons who are reasonably necessary to assist those persons in the proceeding shall not be

required to sign an Acknowledgement, but shall be informed of the terms and requirements of the Protective Order by the person they are supporting who receives confidential information.

(F) The Office. Employees and representatives of the United States Patent and Trademark Office who have a need for access to the confidential information shall have such access without the requirement to sign an Acknowledgement. Such employees and representatives shall include the Director, members of the Board and their clerical staff, other support personnel, court reporters, and other persons acting on behalf of the Office.

3. Employees (e.g., corporate officers), consultants, or other persons performing work for a party, other than those persons identified above in ~~(d)~~section ~~(~~2~~)~~(A)–(E), shall be extended access to confidential information in the "Confidential" category only upon agreement of the parties or by order of the Board upon a motion brought by the party seeking to disclose confidential information to that person and after signing the Acknowledgment. The party opposing disclosure to that person shall have the burden of proving that such person should be restricted from access to confidential information.

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5. Employees (e.g., corporate officers), consultants, or other persons performing work for a party, other than those persons identified above in section 4(A)–(D), shall be extended access to confidential information in the "Attorneys' Eyes Only" category only upon agreement of the parties or by order of the Board upon a motion brought by the party seeking to disclose confidential information to that person and after signing the Acknowledgment. The party opposing disclosure to that person shall have the burden of proving that such person should be restricted from access to confidential information.

46.Persons receiving confidential information, whether in the "Confidential" category or the "Attorneys' Eyes Only" category, shall use reasonable efforts to maintain the confidentiality of the information, including:

(A) Maintaining such information in a secure location to which persons not authorized to receive the information shall not have access;

(B) Otherwise using reasonable efforts to maintain the confidentiality of the information, which efforts shall be no less rigorous than those the recipient uses to maintain the confidentiality of information not received from the disclosing party;

(C) Ensuring that support personnel of the recipient who have access to the confidential information understand and abide by the obligation to maintain

the confidentiality of information received that is designated as confidential; and

(D) Limiting the copying of confidential information to a reasonable number of copies needed for conduct of the proceeding and maintaining a record of the locations of such copies.

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(ii) Where confidentiality is alleged as to some but not all of the information submitted to the Board, the submitting party shall file confidential and non-confidential versions of its submission, together with a Motion to Seal the

confidential version setting forth the reasons why the information redacted from the non-confidential version is confidential and should not be made available to the public. A party may challenge the confidentiality of the information by opposing the Motion to Seal. The non-confidential version of the submission shall clearly indicate the locations of information that has been redacted. The confidential version of the submission shall be filed under seal. The redacted information shall remain under seal unless the Board determines that some or all of the redacted information does not qualify for confidential treatment.

(B) Documents and Information Exchanged Among the Parties. Documents (including deposition transcripts) and other information designated as confidential that are disclosed to another party during discovery or other proceedings before the Board shall be clearly marked as "PROTECTIVE ORDER MATERIAL" or "PROTECTIVE ORDER MATERIAL / ATTORNEYS' EYES ONLY" and shall be produced in a manner that maintains its confidentiality.

6. Within 60 days after the final disposition of this action, including the exhaustion of all appeals and motions, each party receiving confidential information, whether in the "Confidential" category or the "Attorneys' Eyes

Only" category, must return, or certify the destruction of, all copies of the confidential information to the producing party.

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By: _____

Dated: