**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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

v.

GREENTHREAD, LLC,
Patent Owner.

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IPR2023-01244[1]
U.S. Patent No. 11,121,222

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

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[1] Texas Instruments Incorporated, which filed a petition in IPR2024-00674, has been joined as a petitioner in this proceeding.

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## EXHIBIT LIST

| Exhibit No. | Description | Submitted Previously? |
|---|---|---|
| Ex. 2001 | *Greenthread, LLC v. Intel Corp.*, 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/data-sheet/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., *Greenthread, LLC v. ON Semiconductor Corp.*, 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., *Greenthread, LLC v. ON Semiconductor Corp.*, No. 23-443-RGA (D. Del.) (served Sept. 27, 2023) | X |
| Ex. 2013 | Definition of "privity" in Black's Law Dictionary (11th 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, *Greenthread, LLC v. ON Semiconductor Corp.*, No. 23-443-RGA (D. Del.) (served Oct. 12, 2023) | X |

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| Ex. 2016 | Petition (Paper 2) in *Sony Group Corp. v. Greenthread, LLC*, IPR2023-00324 | X |
| Ex. 2017 | Petition (Paper 1) in *Sony Group Corp. v. Greenthread, LLC*, IPR2023-00376 | X |
| Ex. 2018 | *Greenthread, LLC v. Intel Corp.*, No. 6:22-cv-00105-ADA, Dkt. 1 (Complaint) (W.D. Tex. Jan. 27, 2022) | X |
| Ex. 2019 | *Greenthread, LLC v. Dell Inc.*, No. 6:22-cv-105-ADA, Dkt. 120 (Second Amended Complaint) | X |
| Ex. 2020 | *Greenthread, LLC v. ON Semiconductor Corp.*, No. 23-443-RGA, Dkt. 1 (Complaint with accompanying exhibits) (D. Del. Apr. 21, 2023) | X |
| Ex. 2021 | *Greenthread, LLC v. ON Semiconductor Corp.*, 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 *Intel Corp. v. Greenthread LLC*, IPR2023-00308 | X |
| Ex. 2024 | Petition (Paper 1) in *Intel Corp. v. Greenthread LLC*, IPR2023-00420 | X |
| Ex. 2025 | Petition (Paper 1) in *Intel Corp. v. Greenthread LLC*, IPR2023-00552 | X |
| Ex. 2026 | Petition (Paper 1) in *Dell Techs. Inc. v. Greenthread LLC*, IPR2023-00506 | X |
| Ex. 2027 | Petition (Paper 1) in *Dell Techs. Inc. v. Greenthread LLC*, 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 | *Greenthread, LLC v. Intel Corp.*, No. 6:22-cv-00105-ADA, Dkt. 113 (Redacted Memorandum Opinion and Order) (W.D. Tex. Dec. 27, 2022) | X |
| Ex. 2032 | *Greenthread, LLC v. Intel Corp.*, 6:22-cv-00105-ADA, Dkt. 38 (First Amended Complaint for Patent Infringement) (W.D. Tex., filed Apr. 29, 2022) | X |
| Ex. 2033 | *Greenthread, LLC v. Intel Corp.*, 6:22-cv-00105-ADA, Dkt. 38-8 (Greenthread's Amended Preliminary Infringement Contentions) (W.D. Tex., filed Apr. 29, 2022) | X |
| Ex. 2034 | *Greenthread, LLC v. Intel Corp.*, 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 *Greenthread, LLC v. ON Semiconductor Corp.*, 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=z6PAvqrnkvR8PcLN2EnUzg%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 (11th ed. 2019) available from Westlaw at westlaw.com | X |
| Ex. 2042 | *Greenthread, LLC v. Intel Corp.*, 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 | *Greenthread, LLC v. Intel Corp.*, 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? |
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| Ex. 2047 | [RESERVED] | |
| Ex. 2048 | *Greenthread, LLC v. Intel Corp.*, 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 | Greenthread, LLC v. ON Semiconductor Corp., No. 23-443-RGA, Dkt. 36 (Second Amended Complaint) (D. Del. Nov. 22, 2023) | X |
| Ex. 2055 | Greenthread, LLC v. ON Semiconductor Corp., 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., CMOS Devices and Technology for VLSI, 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? |
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| 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 *Sony Group Corp. v. Greenthread*, LLC, IPR2023-00325 | X |
| Ex. 2075 | Petition in *Sony Group Corp. v. Greenthread, LLC*, IPR2023-00375 | X |
| Ex. 2076 | [RESERVED] | |
| Ex. 2077 | *Greenthread, LLC v. Cirrus Logic Inc.*, 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 | [RESERVED] | |
| Ex. 2079 | *Greenthread, LLC v. Samsung Elecs. Co.*, 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 *Texas Instruments Inc. v. Greenthread LLC*, IPR2024-00771 (including excerpts of the Deposition Transcript of Scott Warrick taken on June 7, 2024 along with marked Exhibits 3-5 in *Greenthread, LLC vs. Cirrus Logic, Inc.*, 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 the movement of carriers" claim limitation in the prior art. The Petition claims that *any* dopant gradient "create[s] an inherent built-in unidirectional electric field" that exerts sufficient force in the proper direction to "*move[] carriers* deep into the substrate." Pet., 26-27 (emphasis added; cleaned up). 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 61 (Pet. Reply), 8.

In its Reply, Petitioner changed its argument and drops its "*moves carriers*" 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 61, 6 ("any given electric field will aid electron movement..."), 8 ("'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 the movement of carriers" 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 75, 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 46, 12. 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.*, 12-17. In its Reply, Petitioner says it "disagrees with PO's *characterization* of the 'aid the movement of carriers' limitation." Paper 61, 3 (emphasis added). Petitioner then admits "'graded' does not meant 'aided,'" and for the first time instead argues "'graded' does *mean* 'electric field,' and an 'electric field' *means* 'aided' in one direction." *Id.*, 8 (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.

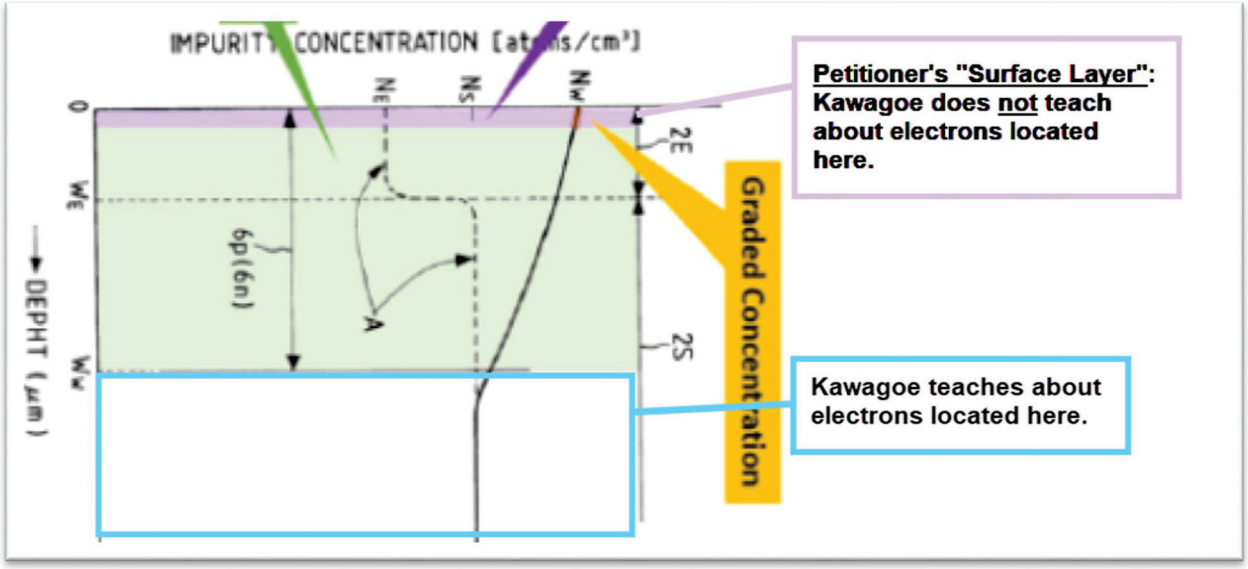
### B. Petitioner's rehashed merits arguments fail

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 75, 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 Sakai-Kawagoe met the limitation notwithstanding PO's arguments." Paper 75, 6. That is wrong. In its Motion, Petitioner reproduces Sakai and Kawagoes' figures and points to a **section** of Kawagoe's Fig. 17 as the "**surface layer**." *Id.* Yet, as shown below in annotations to Fig. 17, Kawagoe does not describe aiding carrier movement in the "**surface layer**." Kawagoe's description is limited to carriers well outside the surface layer. Specifically, Kawagoe refers to electrons produced in the **large substrate body below the wells**. *See* Ex. 1007, 16:2-11. The carriers Kawagoe discusses are "'prevented from entering the **p-well**,'" and are thus below it. Paper 46, 21 (*quoting* Ex. 1007, 16:7-11). When Petitioner alleges that "the Sakai-Kawagoe structure has

a downward-sloping graded dopant concentration" that aids carrier movement, it does not cite anything in Kawagoe discussing moving carriers *from the surface layer*. Paper 75, 6. The unrebutted testimony from Dr. Glew is instead that Kawagoe "doesn't disclose" moving carriers from the surface layer. Ex. 1052, 122:6-9, 121:11-17. Since Petitioner Sakai and Kawagoe have no teaching about moving carriers *from the surface layer*, the Sakai and Kawagoe grounds fail.




### 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 and 2079 are not "evidence." They are legal authority, *opinions from U.S. District Courts*. 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 and 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 evidence in its sur-reply would violate the APA. *See In re NuVasive, Inc.*, 841 F.3d

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[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 <u>*aid carrier movement*</u> 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").

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 75, 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 75 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.

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[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