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Paper 79
Entered: November 8, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SEMICONDUCTOR COMPONENTS INDUSTRIES, LLC,
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 GRACE KARAFFA OBERMANN, MONICA S. ULLAGADDI, and JULIA HEANEY, *Administrative Patent Judges*.

PER CURIAM.

ORDER

Granting Petitioner's Motion to Strike

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[1] The combined caption is for administrative convenience only and does not indicate that IPR2023-01242, IPR2023-01243, and IPR2023-01244 have been joined. The parties are not authorized to use this caption without express permission of the Board.

I. INTRODUCTION

In response to Petitioner's email of September 30, 2024 (Ex. 3002) requesting authorization to file a motion to strike Exhibits 2077–2081, we held a conference call with counsel for the parties on October 4, 2024. Having heard and considered the parties' arguments, we authorized and Petitioner filed a Motion to Strike New Exhibits Submitted with Patent Owner's Sur-Reply ("Motion" or "Mot."). *See., e.g.*, IPR2023-01242, Paper 76. Patent Owner filed its Opposition to Petitioner's Motion to Strike. *See, e.g.,* IPR2024-01242, Paper 77 ("Opp."). For the reasons below, Petitioner's Motion to Strike is granted.

II. PETITIONER'S ARGUMENTS

Petitioner contends that "Exhibits 2077-2081 are newly filed exhibits and none of them are 'deposition transcripts of the cross-examination of any reply witness;' these exhibits are therefore improper and should be stricken." Mot. 1 (citing 37 C.F.R. § 42.23(b); *Ford Motor Company v. Safe Driving Technologies LLC*, IPR2021-01446, Paper 28, 82–83 (Mar. 10, 2023) (new sur-reply evidence not permitted)).

Exhibits 2077, 2078, and 2079

According to Petitioner,

> Exhibit 2077 is a claim construction order from a district court litigation between [Patent Owner] and Cirrus Logic—***not involving Petitioner***—that issued on March 13, 2024; Exhibit 2078 is a claim construction brief filed by [Patent Owner] in that litigation, dated December 14, 2023; and Exhibit 2079 is a claim construction order from a district court litigation between [Patent Owner] and Samsung Electronics—again, ***not involving Petitioner***—that issued on April 20, 2020.

Mot. 1–2 (citing Exs. 2077–2079) (emphases added). Petitioner argues that Patent Owner should not be allowed "to submit untimely exhibits 'to respond to arguments first introduced in Petitioner's Reply,' and specifically, due to an alleged 'new claim construction' raised by Petitioner." *Id.* at 3. Petitioner argues that Patent Owner's argument "fails because Petitioner has been consistent with its claim construction throughout this proceeding." *Id.* Petitioner further argues that "[b]ecause there are no new claim construction arguments, there is no justification for waiving 37 C.F.R. § 42.23(b) for Exhibits 2077–2081." *Id.* at 7.

Petitioner also contends that "even ignoring the flaw in [Patent Owner's] original premise, these exhibits should still be str[icken]." *Id.* Petitioner notes that Exhibits 2077, 2078, and 2079 "are documents that issued on March 13, 2024, December 14, 2023, and April 20, 2020" and thus, Patent Owner "had possession of these documents for months prior to filing its [Patent Owner Response] on May 20, 2024, with ample opportunity to submit them with that brief, if they were relevant." *Id.* According to Petitioner, Patent Owner "now attempts to belatedly submit them as evidence, prejudicing Petitioner because Petitioner's opportunity for merits briefing has closed." *Id.*

Exhibits 2080 and 2081

Petitioner contends that "Exhibit 2080 [contains] excerpts of a deposition transcript of a Cirrus Logic corporate representative from the above-noted district court litigation between [Patent Owner] and Cirrus Logic, obtained by [Patent Owner] on June 7, 2024." Mot. 2 (citing Ex.

2080). Petitioner argues that Patent Owner's submission of "Exhibit 2080 is a deposition transcript from a district court litigation . . . not involving Petitioner" and that Patent Owner "could have contacted the Board at that time to request it be made of record in this proceeding," thus giving "Petitioner . . . the opportunity to address it in its [Petitioner's] Reply," which was filed on August 12. *Id.* Petitioner further argues that the testimony presented in Exhibit 2080 concerns prior art that is not at issue in the above-captioned proceedings, and includes "inadmissible hearsay" because "Exhibit 2080 constitutes incomplete portions of testimony from an unrelated party in a district court litigation that did not and does not involve Petitioner as a party," nor did Petitioner "sponsor or endorse the testimony" or "have an opportunity to cross examine the witness." *Id.* at 8–9.

Petitioner also disputes Patent Owner's position that "Exhibit 2080 should be admitted as a statement against interest, because Petitioner is allegedly 'in a joint defense group' with Cirrus Logic" at least because Petitioner alleges that it is not part of a joint defense group in the above-captioned matters. Mot. 9 (citing PO Sur-Reply 6, n.4). Petitioner also disputes that "[a]ny argument that Exhibit 2080 should be admitted as 'evidence of secondary indicia of non-obviousness' is similarly wrong" because "there is no hearsay exception for secondary indicia." *Id.* at 10. Finally, Petitioner argues that "Exhibit 2080 is not admissible as 'part of the prosecution history' of the subject patent." *Id.*

Petitioner further contends that "Exhibit 2081 is a copy of email communication between the Board and the Parties" which "the Board is

already in possession of this email, rendering its submission as evidence with the Sur-Reply unnecessary and improper." *Id.* at 1 (citing Ex. 2081), 8.

III. PATENT OWNER'S ARGUMENTS

Patent Owner opposes Petitioner's Motion because it contends that Petitioner's claim construction position changed between its Petition and Petitioner's Reply. Opp. 1. In particular, Patent Owner argues that "[t]he 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.'" *Id.* (citing Pet. 22, 59 (emphasis and bracketing added by Patent Owner)). Patent Owner further argues that "Petitioner changed its argument and drops its 'must move' locution and inherency theory" and "now [asserts] that any force from a gradient is inherent and that any force will 'aid carrier movement.'" *Id.* Patent Owner further contends that "Petitioner's Reply offers a new construction that tries to expand the scope of 'aid carrier movement' to encompass any force at all." *Id.* at 2.

Exhibits 2077, 2078, and 2079

Patent Owner further argues that "Exhibits 2077-2079 are not 'evidence'" because "[t]hey are legal authority, opinions from U.S. District Courts, and one related court filing" and "[t]here is no prohibition—in § 42.23(b) or otherwise—on including 'new' legal authority in a sur-reply." Opp. 5. Patent Owner argues that it "could have simply cited these public records and avoided Petitioner's unreasonable objections" but that "[i]nstead, it attached them as exhibits for the convenience of the Board." Id. at 6.

Exhibits 2080 and 2081

Patent Owner argues that "[t]he evidence in Exhibit 2080 is devastating to Petitioner" because "[t]he 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." Opp. 7. Patent Owner further argues that "[t]he evidence is admissible as part of the prosecution history of the patents, objective evidence of nonobviousness, and to counter Petitioner's new claim construction." *Id.* (footnote omitted).

Patent Owner further contends that "Exhibit 2081 is proper" because "[i]t is the Parties' communications with the Board, not 'new evidence' under § 42.23(b)." Opp. 6. Patent Owner argues that it "attached Exhibit 2081 to make it part of the record" and "[s]ection 42.23(b) does not allow Petitioner to send 'off-the-record' communications to the Board, shielded from public view and appellate review."

IV. ANALYSIS

Our Consolidated Trial Practice Guide ("CTPG") states that a motion to strike may be an appropriate vehicle when a brief "is accompanied by belatedly presented evidence." CTPG 80–81. Reviewing the facts discussed above, we determine that Petitioner's motion has merit. Even if motions to strike are "an exceptional remedy that . . . will be granted rarely," *id.* at 80, we determine that Patent Owner's actions are exceptional and warrant the remedy.

With regard to Patent Owner's contention that Petitioner's claim construction positions have changed between the Petition and Petitioner's

Reply, Patent Owner's counsel did not persuasively explain that change during our conference call. Nor does Patent Owner's Opposition (Opp. 3) make clear that there is any substantive change in Petitioner's claim construction position. We find more persuasive Petitioner's assertion that the statements in its Reply concerning "aid carrier movement" are factual explanations, not claim construction arguments. *See* Mot. 4. As such, we see no reason to consider Exhibits 2077–2081 in these proceedings.

Exhibits 2077–2079

Even assuming, *arguendo*, that we agree with Patent Owner that Exhibits 2077–2079 constitute "legal authority, opinions from U.S. District Courts, and one related court filing" that were "attached . . . as exhibits for the convenience of the Board" (Opp. 5–6), that circumstance, standing alone, does not answer whether we should allow their submission so late in this proceeding. We are not persuaded that these exhibits are relevant based on Patent Owner's argument because Exhibits 2077 and Exhibit 2079 are claim construction orders and Exhibit 2078 is a claim construction brief from district court litigations between Patent Owner and parties that are *not* Petitioner. We further agree with Petitioner that these documents were available for months prior to Patent Owner filing its Patent Owner Response, and that allowing their submission at this late stage would be prejudicial to Petitioner, given that Petitioner's opportunity for merits briefing has closed. *See* Mot. 7–8.

Exhibits 2080 and 2081

As discussed above, we determine that Patent Owner has not demonstrated a justification for waiving 37 C.F.R. § 42.23(b) to allow new evidence (Exs. 2080 and 2081), because we do not find persuasive its argument that Petitioner changed its claim construction position. In addition, we are persuaded that the testimony presented in Exhibit 2080 concerns prior art that is not at issue in the above-captioned proceedings, and includes "inadmissible hearsay" because "Exhibit 2080 constitutes incomplete portions of testimony from an unrelated party in a district court litigation that did not and does not involve Petitioner as a party," nor did Petitioner "sponsor or endorse the testimony" or "have an opportunity to cross examine the witness." Mot. 8–9. The CTPG makes clear that "[d]iscovery is a tool to develop a fair record and to aid the Board in assessing the credibility of witnesses," and that "a party presenting a witness's testimony by affidavit should arrange to make the witness available for cross-examination. This applies to witnesses employed by a party as well as experts and non-party witnesses." CTPG 22–23.

We disagree with Patent Owner's argument that Exhibit 2080 is admissible as part of the prosecution history of the patents or objective evidence of nonobviousness. Opp. 10. Patent Owner does not provide sufficient evidence to support the position that otherwise inadmissible hearsay would be made admissible if it relates to the prosecution history or objective evidence of nonobviousness.

With respect to Exhibit 2081, the Board is able to make email communications between the Board and the parties of record of its own accord, particularly upon request, as will be done in the above-identified proceedings as a 3000-series exhibit.

V. ORDER

Accordingly, it is hereby:

ORDERED that Petitioner's Motions to Strike in IPR2023-01242, IPR2023-01243, and IPR2023-01244 are granted; and

FURTHER ORDERED that Exhibits 2077, 2078, 2079, 2080, and 2081 are stricken from each of the IPR2023-01242, IPR2023-01243, and IPR2023-01244 proceedings.

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