UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SEMICONDUCTOR COMPONENTS INDUSTRIES, LLC; AND
TEXAS INSTRUMENTS INCORPORATED,
Petitioners,

v.

GREENTHREAD LLC
Patent Owner

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

PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW OF FINAL WRITTEN DECISION 37 C.F.R. § 42.75

[1] Texas Instruments Incorporated, which filed a petition in IPR2024-00674, has been joined as a party to 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

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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
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

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Ex. 2027	Petition (Paper 1) in *Dell Techs. Inc. v. Greenthread LLC*, IPR2023-00509	X
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
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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

Exhibit No.	Description	Submitted Previously?
Ex. 2036	Webpage regarding iFixIt, PlayStation 5 Teardown (https://www.ifixit.com/Teardown/PlayStation+5+Teardown/138280)	X
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
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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
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Ex. 2044	Email communication from Patent Owner to Petitioner's litigation counsel dated September 13, 2023	X

Exhibit No.	Description	Submitted Previously?
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
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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

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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
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

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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
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
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Ex. 2075	Petition in *Sony Group Corp. v. Greenthread, LLC*, IPR2023-00375	X
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Exhibit No.	Description	Submitted Previously?
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
Ex. 2081	Email communications between the Board, Petitioner's counsel and Patent Owner's counsel dated August 13, 2024	X
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Ex. 2083-2099	[RESERVED]	
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I. INTRODUCTION

Director Review should be granted because the Board abused its discretion by first denying discovery on whether Petitioner is in "privity" with a time-barred party, and then shifting the burden to Patent Owner ("PO") to prove that privity exists. The Federal Circuit made it clear in *Worlds v. Bungie* that this is reversible legal error.

This Request presents an important legal question: when a petitioner has manufactured accused products for a time-barred party, can the petitioner ***meet its burden*** to prove that it is ***not*** time-barred by presenting ***zero*** "actual evidence" on this issue? PO is filing substantially similar requests in IPR2023-01242 and -01243, and this legal question applies to 18 other pending IPRs that are also time-barred.

35 U.S.C. § 315(b) bars an IPR if the petitioner's "privy" was sued more than one year earlier. Here, PO sued Intel, and Petitioner filed its IPR more than one year later. Petitioner does *not* dispute that it made Intel products accused in the *Intel* litigation ("Accused Products"). PO filed a motion for discovery on Petitioner's indemnification obligations for the Accused Products. But just like in *Worlds*, the Board denied this critical discovery.

Without the benefit of the requested discovery, PO maintained its position in its POPR that Petitioner's indemnification agreements created privity with Intel. The Board allowed Petitioner to file "a preliminary reply ***and supporting evidence***" on this issue. But Petitioner provided ***no*** "actual evidence" to rebut PO's allegations.

In its ID and FWD, the Board ruled that PO did not adequately prove the relevant terms of the indemnification agreement that Petitioner refused to produce.

By shielding Petitioner from critical discovery, the Board effectively shifted the burden to PO on this statutory gate-keeping issue. Once PO produced "evidence to sufficiently put this issue into dispute," Petitioner could no longer rely on just attorney argument. *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1244 n.8 & 1246 (Fed. Cir. 2018). Petitioner had to produce affidavits, declarations, or other "actual evidence." Under *Worlds*, the Board committed legal error by denying discovery, and then not requiring Petitioner to submit "actual evidence" to prove lack of privity. *Id.* Not only was this an abuse of discretion, it presents an important issue of law and policy. Without Director reversal, the Board's decision allows petitioners to evade relevant discovery and bypass the statutory time bar.

The Board's subsequent actions compounded this error. The Board abused its discretion by relying on its *own* evidence in its ID and FWD. Next, the Board improperly excluded claim construction orders that were merely cited to rebut Petitioner' new claim construction. Finally, the Board refused to consider PO's arguments, which were clearly set forth in the POR. This pattern of behavior presents an important legal and policy issue as it highlights a recurring problem in IPR proceedings. The Board must be impartial and consider legal authority and properly presented arguments.

II. BACKGROUND

PO served a complaint for patent infringement on Intel on February 1, 2022. Ex. 2001, 2. To settle the *Intel* litigation, PO granted RPX a license, and Intel (and others) a sublicense, to PO's patents. Ex. 2022, 16. According to RPX, the sub-licensees "acquired the full scope of sublicensable rights PO granted to RPX." Ex. 2028, ¶5. These licenses granted the sublicensees the right to "have made" or "purchase" "any Licensed Product and Service." Ex. 2022, 3. Thus, PO granted a limited sublicense to Intel's "have made vendors." *Id.*, 5.

It is undisputed that Intel is one of Petitioner's customers. Paper 11 (Pet. Opp. to PO Disc. Mot.) at 10. Petitioner makes products specific to Intel's "propriety interface"—*i.e.*, these products may only integrate with Intel products. Ex. 2006. Petitioner advertises that it makes "Custom Product[s]" for its customers and indemnifies its customers for claims of patent infringement. Ex. 2053; Ex. 2010, 3. Therefore, it is undisputed that Petitioner acts as Intel's "have made vendor" under its license with PO.

On July 27, 2023, more than one year after the complaint was served on Intel, Petitioner filed this IPR. PO requested that Petitioner provide information supporting its contention that the Petition was not time-barred. Ex. 2014, 3-4. Petitioner refused. *Id.*, 1. Next, PO filed a motion seeking discovery concerning Petitioner's relationships with the sub-licensees. Paper 8. PO requested that the

Board promptly grant the motion "to provide PO sufficient time to review the discovery before filing its POPR." *Id.* at 15. Instead, the Board waited nearly three months—until two weeks before the ID due date—to deny the motion *in toto*. Paper 30. The IPR was then instituted on February 12, 2024. Paper 32.

PO timely sought Director Review of the ID, contending that the petition should be dismissed under 35 U.S.C. § 315(b). Paper 37. This request was denied—without reason—by the former Director. Paper 43. The Board issued its FWD on February 11, 2025. Paper 83.

III. LEGAL STANDARD

Director Review is appropriate when the FWD "present[s] (a) an abuse of discretion, (b) important issues of law or policy, (c) erroneous findings of material fact, or (d) erroneous conclusions of law." USPTO, Director Review process, §§ 2.B, 5.A. "An abuse of discretion may be established by showing [the Board] made a clear error of judgment in weighing relevant factors or exercised its discretion based upon an error of law or clearly erroneous factual findings." *Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1350 (Fed. Cir. 2001).

IV. ARGUMENT

Director Review is clearly appropriate and the Board's FWD should be reversed. The Board abused its discretion and committed reversible legal error by denying discovery on Petitioner's privity with Intel, and then shifting the burden to

PO to prove that privity exits. The Board further abused its discretion by introducing its own evidence, excluding highly-relevant claim construction orders, and refusing to consider so-called "belated" arguments that were clearly presented in the POR.

A. The Board Abused Its Discretion by Denying Discovery on Privity, and Then Shifting the Burden to PO to Prove That Privity Exists

An IPR "may not be instituted if the petition…is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent." 35 U.S.C. § 315(b). "[P]etitioner bears the burden of persuasion to demonstrate that its petitions are not time-barred." *Samsung Elecs. Co. Ltd. v. Netlist, Inc.*, IPR2022-00615, Paper 40 at 2 (PTAB Feb. 3, 2023) (Director Review) (quoting *Worlds*).

The Federal Circuit recognized in *Worlds* that the "[P]etitioner will usually be in a better position, at least relative to the [PO], to access evidence relevant to the real-party-in-interest inquiry." 903 F.3d at 1243. For this reason, it would be unfair to create "a presumption that would disfavor the party that likely has inferior access to potential sources of proof." *Id*.

The Court went on to explain that, as a "practical" matter, it is acceptable for the Board to not "question [P]etitioner's identification of the real parties in interest unless and until a [PO] *has chosen to raise the issue*." *Id*. at 1243-44 (emphasis added). But once PO "reasonably brings into question the accuracy of Petitioner's identification of the real parties in interest," *id*. at 1242, 1244, the Petitioner fully

bears the burden of persuasion to prove otherwise, *id.* at 1246. The Board may not rely on "attorney argument as evidence." *Id*. (citing *Icon Health & Fitness, Inc. v. Strava, Inc.*, 849 F.3d 1034, 1043 (Fed. Cir. 2017)). Rather, the Petitioner must present affidavits, declarations, or other "actual evidence" to meet its burden. *Id*.

From the outset, PO has maintained that Petitioner's customer-supplier relationship with Intel creates "privity." Paper 8 (PO Disc. Mot.) at 8-11; Paper 14 (PO Reply ISO Disc. Mot.) at 2-4; Paper 18 (POPR) at 12-20; Paper 28 (Prelim. Sur-Reply) at 1-10; Paper 46 (POR) at 42-57; Paper 64 (PO Sur-Reply) at 16-17. Whether a particular relationship creates privity is a "highly fact-dependent question." *Apps. in Internet Time, LLC v. RPX Corp.*, IPR2015-01750, Paper 128 at 7 (PTAB Oct. 2, 2020) (precedential). But here, Petitioner produced ***no*** "actual evidence" to meet its burden.

In order to address this "highly fact-dependent question," PO moved for discovery regarding Petitioner's indemnification agreements beyond Petitioner's publicly-available "Standard Terms and Conditions of Sale" ("Standard T&Cs"). Paper 8 at 10; *see also* Ex. 2010. The Board effectively "pocket vetoed" this request by waiting until after the POPR due date, and *just two weeks* before the ID due date, to rule on the motion. Paper 30. Presumably, the Board had already begun writing its ID when it denied the motion entirely.

Without the benefit of the requested discovery, PO explained in its POPR that the Standard T&Cs created privity between Intel and Petitioner. Paper 18 at 18-19. PO also asserted that because Intel was a "significant" customer, it presumably received more "generous" terms than Petitioner's "standard" terms. *Id.*; *see also* Paper 28 at 4-5.

The Board gave Petitioner the chance to rebut these allegations by authorizing "a preliminary reply ***and supporting evidence***." Ex. 2056, 1 (emphasis added). But in its preliminary reply, Petitioner relied entirely on "attorney argument." Paper 28 at 10. Petitioner did not submit any affidavits, declarations, or other "actual evidence," as required by *Worlds*. Even more concerning, Petitioner ***never*** denied that there were other indemnification agreements with Intel with more "generous" terms. Paper 11 at 7-14; Paper 22 (Pet. Auth. Reply to POPR) at 5-7. Petitioner had the opportunity to produce affidavits, declarations, or other "actual evidence," but failed to do so.

After denying the requested discovery, the Board cited the ***absence*** of evidence in the record in its ID and FWD to rule that the petitions were not time-barred. Paper 32 at 17 ("[PO] does not direct us to any such more generous terms in the evidence presently of record."), 18 ("[PO] has not directed us to any evidence…"), 21 ("[PO] does not direct us to any evidence…"); *see also* Paper 83 at 56-57 ("In our [ID], we determined [PO] had not provided a sufficient factual

basis upon which to question Petitioner's representation that it is not time barred…"). Even worse, the Board chastised PO because "it did not renew or tailor its request for additional discovery during trial." *Id*. at 58. But ironically, only Petitioner had access to this evidence, and the Board thwarted PO's discovery request. Moreover, it was not PO's burden to produce this evidence. Petitioner had the burden to produce "actual evidence," but never did.

This lack of evidence "cuts against the party bearing the burden of proof on these issues." *Ventex Co., Ltd. v. Columbia Sportswear N. Am., Inc.*, IPR2017-00789, Paper 148 at 14 (PTAB Jan. 24, 2019). Here, that party is Petitioner, ***not*** PO. In its preliminary reply, Petitioner used the Standard T&Cs as a "straw man." Meanwhile, Petitioner ***never*** denied there were additional indemnification agreements with more "generous" terms. Petitioner had the opportunity to produce them, but chose not to. In situations like this, the Board should have inferred that "the agreement [did] not support [Petitioner] in meeting its burden regarding the identification of all real parties in interest." *Volkswagen Grp. of Am., Inc. v. Arigna Tech. Ltd.*, IPR2021-01263, 2022 WL 211526, at *4 n.4 (PTAB Jan. 21, 2022).

The Federal Circuit's decision in *Worlds* is directly on point. In *Worlds*, the Board denied discovery on the real-party-in-interest. 903 F.3d at 1240. Here, the Board did the same thing (Paper 30). In *Worlds*, PO had to file its POPR without the benefit of the discovery. *Id*. Here, PO had to do the same (Paper 18). In *Worlds*,

PO presented evidence in its POPR that "sufficiently put this issue into dispute." *Id*. at 1244 n.8. Here, PO did the same (Paper 18 at 9-10). In *Worlds*, Petitioner relied entirely on "attorney argument," and failed to produce any affidavits, declarations, or other "actual evidence." *Id*. at 1246. Here, Petitioner did the same (Paper 22). In *Worlds*, the Board instituted the IPR because the PO did not present sufficient evidence. *Id*. at 1240. Here, the Board did the same (Paper 32 at 16-21). Under these exact same circumstances, the Federal Circuit held the Board committed reversible legal error. *Id*. at 1239. Because Petitioner had the burden to submit "actual evidence," but failed to do so, the Director should reverse the Board's FWD and terminate this IPR proceeding.

B. The Board Abused Its Discretion by Introducing Its Own Evidence, Excluding Claim Construction Orders, and Refusing to Consider PO's Arguments

Throughout this proceeding, the Board introduced its own evidence, while excluding claim construction orders that were merely cited to rebut Petitioner's belated claim construction. This is troubling because the Board must be impartial and consider legal authority and properly presented arguments. The Board abused its discretion by repeatedly failing to do this.

The Board did not rule on PO's discovery request until two weeks before the ID due date. *Compare* Paper 30 (Jan. 26, 2024) *with* Paper 32 (Feb. 12, 2024). Presumably the Board had already begun writing its ID by this time. Whether the

Board purposely delayed its ruling until after PO's POPR was due, or the Board did not consider the motion until after it already begun writing, the Board's actions deprived PO of the opportunity to discover and present highly-relevant evidence.

Possibly realizing its mistake, the Board attempted to bolster its decision to institute by introducing new evidence and arguments that were never raised by the Petitioner. While the Board deprived PO of critical evidence by denying the discovery motion, it deemed it appropriate to side with the Petitioner and inject additional evidence and new arguments on Petitioner's behalf. Strangely, the Board introduced district court pleadings (Exs. 3001 & 3002) purportedly showing that "[PO] ha[d] not pleaded the affirmative defense of *res judicata* or collateral estoppel" in the concurrent litigation between the parties. Paper 30 at 8. The Board introduced this evidence in order to distinguish caselaw that PO cited in its POPR. Paper 32 at 19-20. But there is not even a single mention of these "affirmative defenses" in either of Petitioner's pre-institution briefs (Papers 11 & 22).

Turning to the merits, the Challenged Claims require a "graded dopant concentration" ("GDC") to "aid carrier movement" ("ACM") from an "active region" to deeper in the substrate. Ex. 1001 at 8:21-39. In its POR, PO pointed out that not all GDCs "aid carrier movement" from an "active region," and that Petitioner failed to prove that the prior art meets this limitation. Paper 46 at 12-27. In its Reply, Petitioner argued *for the first time* that it "disagrees with PO's

characterization [*i.e.*, construction] of the [ACM] limitation." Paper 61 at 3. More specifically, Petitioner relied on a misreading of the prosecution history to argue that "***any*** given electric field will aid electron movement." *Id*. at 6 (emphasis added). Petitioner further argued that the claim term "'graded' does ***mean*** 'electric field,' and an 'electric field' ***means*** 'aided' in one direction." *Id.* at 8 (emphasis added).

As PO explained in its Sur-Reply, Petitioner had never previously argued that the ACM limitation would be satisfied by *any* field that pushes in *any* direction. Paper 64 at 2-3. This argument about the scope and meaning of the ACM limitation did not relate to a "factual dispute." Rather it was an improper "new claim construction [that] was not in the Petition and Greenthread had no basis to expect it or chance to address it with its own expert testimony or other evidence." *Id*. at 2.

In its Sur-Reply, PO cited claim construction orders for the *sole* purpose of rebutting this improper new claim construction. *Id.* at 4 n.3 ("[PO] only included exhibits now to respond to arguments first introduced in Petitioner's Reply."). PO cited to *two* claim construction orders from *two* different district courts construing the disputed claim language to say the *opposite* of what Petitioner said in its Reply (Exs. 2077 & 2079).

The Federal Circuit has explained that the Board "would be remiss to overlook a[] district court's construction of the same claim terms." *Finisar Corp. v. DirecTV Grp., Inc.*, 523 F.3d 1323, 1329 (Fed. Cir. 2008). Not only did the Board refuse to

consider the district court claim constructions, but the Board deprived PO of the opportunity to respond to a new claim construction that PO could not have foreseen.

The Board excluded the claim construction orders under 37 C.F.R. § 42.23(b). But this rule *only* apples to "new evidence." The claim construction orders (Exs. 2077 & 2079) were not "new evidence," and they fall outside of the scope of § 42.23(b). Rather, they are legal authority, *opinions from U.S. District Courts*, and one related court filing. 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* 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."). PO 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. *Id.* ("[A] party who cites an opinion of a federal court must provide a copy of that opinion."). The fact that PO 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* that Exs. 2077 and 2079 were proper as legal authority. Despite that, the Board authorized Petitioner to move to strike, thus giving Petitioner the chance to reverse course on the issue.

Paper 75. Yet none of the cases that Petitioner cited in its Motion support the Board striking *legal authority* under § 42.23(b). Petitioner appears to have reversed course so that it could use the bulk of its brief as an improper sur-sur-reply attempting to justify its new claim construction position. *Id.* at 3-7. Further, Petitioner argued that it would be "prejudice[d]" by the introduction of this legal authority because the claim construction orders had issued before PO filed its POR. *Id.* at 7. The "prejudice" that Petitioner claimed it would suffer was entirely manufactured. After all, *Petitioner* was the party—*not* PO—who belatedly injected its claim construction argument after the POR, and would've been aware of the publicly-available claim construction orders that predated its Reply by 5 months and 4 years, respectively. If any party was prejudiced here, it was *PO—not* Petitioner.

Even if the Director chooses to treat the claim construction orders as "evidence" under § 42.23(b), which they are not, the Federal Circuit has recognized that when a party relies on a new claim construction argument, the affected party—here, PO—is permitted to introduce evidence to rebut it. *Apple Inc. v. Omni MedSci, Inc.*, 2024 WL 3084509, at *5-6 (Fed. Cir. June 21, 2024) (holding that the "Board abused its discretion when it refused" to consider a party's arguments in response to a "newly raised claim construction"); *Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374, 1376, 1384 (Fed. Cir. 2023). While these decisions addressed the situation where a PO introduced a claim construction in its Response, the same should be true when a

petitioner introduces a claim construction in its Reply. *Cf. Musculoskeletal Transplant Found. v. MiMedx Grp., Inc.*, IPR2015-00664, Paper 35 at 2-4 (PTAB Mar. 9, 2016) (granting PO authorization to file *Markman* hearing transcript in response to Petitioner introducing other evidence and argument concerning claim construction filed in Petitioner's Reply).

After the Board excluded the claim construction orders, the Board deemed it appropriate to introduce its own evidence on this same point in its FWD. More specifically, the Board introduced an excerpt from a still-pending continuation application (Ex. 3011). This further demonstrates the Board's proclivity to only consider evidence that favors one party over the other. *See* 5 U.S.C. § 556(b)(3) (requiring APA proceedings be conducted in an "impartial manner"); *Marshall v. Jerrico*, 446 U.S. 238, 242, 100 S.Ct. 1610, 1613 (1980) (holding that Due Process clause imposes a "requirement of neutrality in adjudicative proceedings").

Even worse, the Board expressly refused to consider PO's arguments regarding whether the prior art "aids carrier movement" ***from*** the "active region." In its FWD, the Board contends that they were "first presented in [PO's] Sur-Reply." Paper 83 at 51. But the Board either missed, or turned a blind eye to the fact that these arguments were clearly set forth in the POR. There, PO argued that "the carriers that Kawagoe's [GDC] affects are in the wrong place." Paper 46 at 22. PO presented extensive evidence demonstrating how Kawagoe is "describing electrons

'produced in the large substrate body below the wells,'" not carriers in the "active regions." *Id.* PO *elaborated* on this argument on pages 9-11 of its Sur-Reply, rather than *introduce* it for the first time. The Board's outright refusal to consider this argument is a clear abuse of discretion, and it further demonstrates the Board's proclivity of favoring one party over the other.

The Board repeatedly violated the basic principles of fairness by denying critical discovery, introducing its own evidence, excluding claim construction orders, and refusing to consider PO's arguments. When Petitioner made new claim construction arguments, PO was permitted to rely on legal authority to rebut them. The claim constructions were directly on point and highly-relevant, and the Board abused its discretion by excluding them and refusing to consider them. Additionally, the Board abused its discretion by refusing to consider related arguments that were clearly set forth in the POR.

V. CONCLUSION

For at least the foregoing reasons, PO respectfully requests that the Director grant review, reverse the Board's FWD, and terminate this IPR proceeding.

Date: March 13, 2025

Respectfully submitted,

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CERTIFICATION OF PAGE LIMIT

The undersigned hereby certifies that the above-captioned **REQUEST FOR DIRECTOR REVIEW** complies with the page limits of § 42.24(a)(1)(v) because it does not contain more than 15 pages. This paper also complies with the typeface requirements of 37 C.F.R. § 42.6(a)(2)(ii) and the type style requirements of 37 C.F.R. § 42.6(a)(2)(iii) and (iv).

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