

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: IPR2023-01244¹
U.S. Patent No. 11,121,222

**PATENT OWNER'S AUTHORIZED RESPONSE TO
PETITIONER'S REQUEST FOR REHEARING OF
DIRECTOR REVIEW DECISION**

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

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Petitioner’s Rehearing Request (Paper 99) should be denied and this proceeding terminated, without additional discovery, because PO sufficiently raised the “privity” issue in its POPR and POR (Papers 18 & 46), and Petitioner presented *zero* “actual evidence” in its Preliminary Reply and Petitioner’s Reply (Papers 22 & 61) to meet its burden that it is not time-barred. The Panel misapplied *Worlds* and committed the same legal error in both its ID and FWD (Papers 32 & 83).

To remand this IPR for additional discovery and effectively give Petitioner a “do over” would reward Petitioner for its calculated decision to hide the relevant facts. PO has already been prejudiced by IPRs that should never have been instituted, and to reopen them would only compound that prejudice. In its Director Review Request (Paper 88), PO presented two separate legal questions:

- (1) Did the Panel commit legal error by “not requiring Petitioner to submit ‘actual evidence’ to prove lack of privity”?
- (2) Did the Panel commit legal error by denying discovery on privity?

Petitioner’s Rehearing Request does not address the first legal question. Instead, it focuses *solely* on the second question—the Panel’s denial of PO’s discovery request—with numerous flawed arguments. As explained below,

- (1) PO never waived its discovery request. PO renewed its privity arguments and was never required to file a post-institution motion;
- (2) The Current Director may correct clear legal error when, as here, the Former Director summarily denied the earlier Director Review request without any substantive analysis;

- (3) When a *different* panel in a *different* IPR issued a *different* discovery order, it did not fix the legal error here; and
- (4) The Director may terminate this IPR now and moot the discovery issue entirely.

I. PO Never Waived its Privity Arguments and Discovery Request

The Panel committed legal error by (1) denying PO’s discovery request, and then (2) misapplying *Worlds* in **both** its ID and FWD. In its POPR, PO produced *more* than enough evidence to sufficiently raise the privity issue. *See* POPR, 2-4, 9-10, 14-18. The Panel misapplied *Worlds* in its ID and committed legal error by not requiring Petitioner to produce “actual evidence.” PO renewed its privity arguments in its POR, and the Panel committed the same legal error in its FWD. POR, 39-55; *see also* PO Sur-Reply (Paper 64), 16-17. In order to fix these legal errors, the Director was permitted to order additional discovery. But as explained below (and in PO’s Director Review Request), the Director may also terminate this IPR now without any additional discovery.

PO never waived the privity issue or its original discovery request. Petitioner does *not* cite a single case where a pre-institution discovery motion was waived if it was not refiled post-institution. All of Petitioner’s cites relate to supposed “waiver” of substantive arguments about the merits. *See Nuvasive* (“fail[ure] to challenge public accessibility” post-institution constituted waiver on appeal); *3G Licensing* (specific “argument relying on [a reference] changed post-institution”); *IOENGINE*

(“forfeit[ing] its proposed claim construction by not presenting it to the Board”); *Broadcom* (supposedly waived argument was not waived and was, in fact, “supported by substantial evidence”). While these cases generically mention “waiver,” they clearly do not apply to PO’s discovery motion.

Furthermore, the privity question is *not* just a “pre-institution” issue. As the Panel correctly stated, “reconsideration of the time-bar in the [FWD] is...part of the decision to institute.” FWD, 57 (cleaned up). When the discovery motion was denied, PO maintained its privity arguments in its POR and never waived the privity issue or its discovery motion.

II. The Current Director May—and Should—Correct Legal Error that Was Never Substantively Addressed by the Former Director

The Former Director never substantively addressed the legal error in the ID. Instead, the Former Director summarily denied PO’s Request for Director Review with just a single word. ID-DR (Paper 43). This summary denial was akin to a Rule 36 affirmance or a denial of certiorari and provided *no* analysis whatsoever.

None of the cases cited by Petitioner relate to this situation where the legal error was *not* substantively addressed. *See, e.g., Vicor* (“direct conflict between the Board’s fact findings in [separate] reexaminations”); *BASF Corp.* (the Board “fail[ed] to provide a reasoned explanation for reaching an inconsistent finding regarding” a prior art reference). The Former Director made *no* fact findings or legal conclusions. It was simply a summary denial with nothing more.

Petitioner’s accusations are meritless. The Director did *not* “reverse course,” when the Former Director never took a position on the legal error. The Director did *not* issue an “inconsistent” decision or act “arbitrarily or capriciously.” Rather, the Director carefully analyzed an important gate-keeping issue that the Former Director failed to address. Because the Former Director never substantively addressed the Panel’s legal error, the Director may fix that legal error by ordering additional discovery, or even better, terminating this IPR *now*.

III. A *Different* Order by a *Different* Panel in a *Different* IPR Did Not Fix the Legal Error in this IPR

Petitioner makes the convoluted argument that a *different* order by a *different* panel in a *later* IPR, somehow created a heightened obligation for PO to re-file a motion that was previously denied.² This makes *no* sense, and Petitioner does *not* cite a single case or other authority to support its position. The Panel in this IPR committed legal error when it denied PO’s discovery request. The Panel also committed legal error in its ID and FWD when it misapplied *Worlds* and did not require Petitioner to produce “actual evidence.” The Director may fix these legal errors by ordering additional discovery, or terminating this IPR *now*.

² Petitioner introduced new evidence (Ex. 1057) in its Rehearing Request without Director authorization. *See* Director Review Process, §§ 3.E, 5.C.ii. Any arguments concerning the “waiver” issue are procedurally improper and should be disregarded.

IV. The Director May Terminate this IPR Without Any Additional Discovery

Petitioner alleges that the Director abused her discretion by ordering additional discovery. This is clearly false, but the discovery may not be needed anyway. The Panel committed clear legal error in both its ID and FWD, and the Director can (1) fix those legal errors by terminating this IPR now, and (2) moot the discovery issue altogether.

Petitioner knew about its burden under *Worlds*—and PO’s evidence on the privity issue—*before* PO filed its discovery motion. Ex. 2014, 3-4. PO presented *more* than “enough evidence to sufficiently put this issue into dispute.” POR, 39-55 (citing Exs. 2003-2010, 2022, 2036, 2053). Petitioner, however, repeatedly refused to produce “actual evidence”: (1) when requested by PO (Ex. 2014); (2) when asked by the Panel to provide “supporting evidence” with its Preliminary Reply (Ex. 2056); (3) when it filed its later Reply; (4) when it responded to the Director Review Request; and (5) when it filed this Rehearing Request. Without “actual evidence,” Petitioner cannot possibly have met its burden that it is not time-barred.

Petitioner should not be rewarded for its calculated decision to not produce any “actual evidence,” and the prejudice it caused PO. The most appropriate remedy is to terminate this IPR now. If, however, the Director remands this IPR for additional discovery, the Director should make it clear that the discovery is not limited to just Intel, but also includes the other time-barred parties. POR, 37-42.

Date: May 16, 2025

Respectfully submitted,

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CERTIFICATION OF PAGE LIMIT

The undersigned hereby certifies that the above-captioned **RESPONSE TO PETITIONER'S REQUEST FOR REHEARING OF DIRECTOR REVIEW DECISION** complies with the page limit (5) set forth in the Board's authorization email. 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).

Dated: May 16, 2025

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S RESPONSE TO PETITIONER'S REQUEST FOR REHEARING OF DIRECTOR REVIEW DECISION** has been served on Petitioner via email on the following counsel of record for Petitioners

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