PUBLIC VERSION

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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

JOINT PAPER CONCERNING ADDITIONAL DISCOVERY

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

Pursuant to the Board's May 23, 2025 authorization e-mail (Ex. 3012), the Parties submit this joint paper concerning the scope of additional discovery that satisfies the mandate of the Director's remand Decision (Paper 91). The Parties have conferred but were unable to come to agreement on the proper scope of additional discovery. The respective positions of the Parties are below.

Petitioner respectfully requests that the Board set a telephone conference on the topic of additional discovery and to set a briefing schedule on the issues set out in the Acting Director's order. Patent Owner does not believe that a telephone conference is necessary at this time and the Board can determine the scope and schedule of discovery based on the Parties' respective positions presented herein.

Patent Owner's Position

The April 24, 2025 Order from the Director remanded the current IPRs (IPR2023-01242, -01243, and -01244) to the Board to allow narrowly tailored discovery concerning the privity issue. Paper 91, 3. This includes, per the Order, any (i) indemnification agreements with and (ii) terms and conditions of sales agreements between Petitioner and the parties in privity with Petitioner. *Id*.

While the Order specifically mentions Intel, PO has *consistently* sought discovery from three entities and their affiliates: Intel, and [2] Each of these entities is a time-barred party pursuant to 35 U.S.C. § 315(b), and each is in privity with, or should have been named as a RPI by, Petitioner. As explained in each of PO's major papers (Disc. Mot, Paper 8; POPR, Paper 18; POR, Paper 46):

- PO served Intel and with an infringement complaint on February 1, 2022. EX2018. PO filed a First Amended Complaint (FAC) on April 29, 2022, further alleging that infringed PO's patents based, in part, on components incorporated into products.[3] EX2032, ¶¶ 18, 60, 76-81 ("also incorporates further image sensors…that integrates into [its] laptops, desktops, and other computing devices."); *see also* EX2033, 3-8, 17-19 (listing Intel, Intel, and accused products); EX2034 (exemplary claim chart). For this reason, discovery concerning

[2] *See* PO Disc. Mot. (Paper 8), 2-7 (discussing all three time-barred entities); POPR (Paper 18), 12-19 (providing evidence for each time-barred entity); PO Prelim. Sur-Reply (Paper 28), 1, 8 (discussing Intel and 10 (discussing POR (Paper 46), 37-42 (providing evidence for each time-barred entity).

[3] After the FAC, additional counsel appeared for with respect to products. EX2045. then filed its own IPRs (IPR2023-00324, -00325, -00375, and -00376) against the patents asserted against the products. Each of these petitions named as a real-party-in-interest. *E.g.*, EX2017, 7. PO then added to the litigation, EX2019 (Second Amended Complaint), and counsel for appeared on behalf, EX2042.

Petitioner's relationship with is highly relevant, since various image sensors were accused more than one year before the current Petition.

- PO settled with each of Intel, and and these parties acquired the right to "have made" or "purchase" "any Licensed Product and Service." EX2022, 3. By extension, their suppliers received a sublicense as "have made vendors" (and "Covered Third Party") to make and sell products to Intel, and *Id.*, 5.
- Petitioner ***admits*** that each of Intel, and are its customers. Petitioner's Opp. to PO Disc. Mot. (Paper 11), 10; *see also* EX2003, 12; EX2009, 2 (listing Intel, and as "[t]op OEM customers"); EX2004, 10-13 (Intel presentation listing Petitioner as supplier); EX2005, 11 (listing and as "[r]epresentative OEM customers"). Petitioner makes custom products for its OEM customers. EX2053. Petitioner's "Standard Terms and Conditions of Sale" provide that it indemnifies its customers. EX2010, 3. Petitioner has ***never denied*** that it has indemnity obligations for accused products sold to Intel, and
- Specifically, some of the same products that were at issue in the *Intel-* litigation are accused against Petitioner. For example, Petitioner's NCP252160 chip is a component in the PlayStation (EX2036, 11), which was accused in the litigation. *See* EX2019, ¶¶ 28-30, 79, 84, 101-

104; EX2048, 18. Petitioner's own data sheets describe various controllers and amplifiers "optimized for Intel's…CPUs," and include an "Intel Proprietary Interface." EX2006-08. These products, plus other chips identified by Intel, are accused in the OnSemi litigation. EX2004, 10-13.

For at least these reasons, PO has "produc[ed] *some* evidence that tends to show" that Petitioner is in privity with all three entities. *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1244 (Fed. Cir. 2018). Therefore, discovery should not be limited solely to the privity relationship with Intel. The original requests for additional discovery are telling, and show that PO requested, and per the Order on Director Review, is entitled to, discovery concerning the relationship between Petitioner and Intel, and PO Disc. Mot., Appendix A, 2 (requesting "All agreements between i) Petitioner and/or its affiliates and ii) Intel, and/or (or their affiliates), relating to the products Petitioner and/or its affiliates sells to Intel, and/or including sales contracts and design agreements," "All communications between i) Petitioner and/or its affiliates and ii) Intel, and/or (or their affiliates), relating to the design of products Petitioner and/or its affiliates make for them," and an Interrogatory requesting that Petitioner "State whether [it] will assert in the district court litigation involving the patent challenged in this IPR proceeding, that its sales to Intel and/or are licensed.").

In view of the Director's guidance that discovery be "narrowly tailored," PO proposes the following discovery requests[4] that focus on terms and conditions of sale and indemnity provisions and communications related to Petitioner products sold to Intel, and

1. All sales agreements (containing terms and conditions of sale) and/or indemnification agreements related to Petitioner's products sold to Intel, and/or

2. All communications between (i) Petitioner and (ii) Intel, and/or relating to indemnification concerning products that Petitioner makes for, or sells to, Intel, and/or

PO understands that Petitioner seeks to limit the additional, Director-ordered discovery *solely* to Intel. This is improper since PO—as noted above—consistently sought, and was denied, discovery related to Petitioner's products made for and sold to all parties in privity with Petitioner, including Intel, and To find otherwise would be to, again, deny PO discovery necessary to determine whether this Petition is time-barred under § 315(b).

[4] In an effort to narrow the scope of discovery, PO has removed its original "Interrogatory No. 1" and removed from the scope of the requests all agreements/communications relating to design of products.

Petitioner has also suggested that it may seek to introduce a declaration in support of its response to PO's discovery requests.[5] This would be improper because, outside of the discovery ordered by the Director, the evidentiary record is closed and Petitioner has failed to avail itself of each and every opportunity to provide this type of declaratory evidence throughout this proceeding—despite suggesting that it would do so, but never following through during the remainder of the IPR. Petitioner's Prelim. Reply (Paper 22), 10. Petitioner should not now be allowed another bite at the apple to comply with its burden to show lack of privity—which it has consistently declined since the filing of the Petition.

Petitioner has known of its burden to produce "actual evidence" since even before PO filed its original discovery motion in October 2023. Petitioner has had ample opportunities to do so, and to permit Petitioner to file any sort of declaration (or other evidence that would support its position) *now*, would unfairly prejudice PO. Specifically, Petitioner refused to produce "actual evidence": (1) when requested by PO (Ex. 2014); (2) when opposing PO's original discovery motion (Paper 11); (3) when requested by the Board to provide "supporting evidence" with

[5] Additionally, during the Parties' meet and confer process, Petitioner indicated that it may submit an Exhibit with its portion of this Joint Statement. PO objects to any new evidence presented by Petitioner at this point in the proceeding. New evidence was not invited by the Board in its email requesting the Parties' positions on additional discovery, and the evidentiary record is closed for Petitioner who could have, but failed to, present any evidence of this nature in this proceeding.

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its Preliminary Reply (Ex. 2056; Paper 22); (4) when it filed its later, post-institution Reply (Paper 61); (5) when it responded to PO's Director Review Request (Paper 89); (6) when it filed its Director Review Rehearing Request (Paper 99); or (7) at any other time during the pendency of this IPR. Petitioner cannot drag its feet on producing any actual evidence to satisfy its burden, only to change course at the eleventh hour.

Petitioner's Position

The outer boundary of additional discovery is set out in the Director's Decision Granting Director Review (Paper 94 in IPR2023-01242[6]): "discovery, narrowly tailored to the privity issue, such as any indemnification agreements between Petitioner and Intel and the terms and conditions of sale agreements between Petitioner and Intel related to products accused of practicing the challenged claims." Paper 94 at 3. Consistent with the Director's instructions, Petitioner submits that the Board should limit additional discovery to the "Intel Accused Products" listed on pages 4-8 of Exhibit 2048, which are the Intel "products accused of practicing the challenged claims" in Patent Owner's prior litigation. Exhibit 2048 is Patent Owner's infringement contentions from its prior litigation against Intel.

[6] Petitioner's citations herein are to the paper and exhibit numbers of IPR2023-01242, unless otherwise noted. The content of the equivalent papers and exhibits in the IPR2023-01243 and IPR2023-01244 is substantively the same.

Limiting the scope of additional discovery to the Intel Accused Products of the prior Intel litigation is appropriate because the privity analysis focuses on the products at issue in the ***prior litigation*** and Petitioner's hypothetical participation in that ***prior litigation***. *See WesternGeco LLC v. ION Geophysical Corp.*, 889 F.3d 1308, 1318-1319 (Fed. Cir. 2018); *Taylor v. Sturgell*, 553 U.S. 880, 892, 898 (2008) (explaining that privity operates by "'preclud[ing] parties from contesting matters that they have had a full and fair opportunity to litigate'"). The Federal Circuit in *WesternGeco* explained that privity concerns "whether the petitioner and the prior litigant's relationship—***as it relates to the lawsuit***—is sufficiently close that it can be ***fairly said that the petitioner had a full and fair opportunity to litigate the validity of the patent in that lawsuit***," and "whether the petitioner is simply serving as a proxy to allow another party to litigate the patent validity question that the other party raised in an ***earlier filed litigation***." *WesternGeco*, 889 F.3d at 1319 (emphasis added); *see also Uniloc 2017 LLC v. Facebook Inc.*, 989 F.3d 1018, 1028 (Fed. Cir. 2021) (explaining that the privity inquiry must "ensur[e][] that the petitioner is not unfairly limited in its ability to lodge its challenges if it has not had a full and fair opportunity to do so already.").

Petitioner respectfully submits that the Board should not order additional discovery related to As an initial matter, Patent Owner's request for Director Review of the Final Written Decision (as well as its request for Director

Review of the Institution Decision) did not allege a privity relationship with and the Director's decision granting Director Review did not address *See* Paper 37 (Request for Director Review of Institution Decision), Paper 90 (Request for Director Review of Final Written Decision), Paper 94 (Decision Granting Director Review). Indeed, it is dispositive that Patent Owner has *never* alleged in this proceeding that Petitioner was in privity with *See* Paper 8 (Motion for Additional Discovery); Paper 14 (Reply in Support of Motion for Additional Discovery); Paper 18 (Patent Owner's Preliminary Response) at 7-20; *id.* at 9 (failing to allege privity with concluding "[t]hus, the Petition is untimely if Petitioner is in privity with either Intel or Paper 28 (Patent Owner's Preliminary Sur-Reply); Paper 47 (Patent Owner's Response) at 39-59; *id.* at 47 (failing to allege privity with concluding "[t]hus, the Petition is untimely if Petitioner is in privity with Intel, or Paper 65 (Patent Owner's Sur-Reply). Patent Owner has also never identified any products allegedly supplied by Petitioner that Patent Owner accused of infringement in Patent Owner's prior district court litigation with *Id.*

Importantly, Patent Owner has never argued that Patent Owner's agreement with RPX of EX2022—which is central to Patent Owner's privity theory—granted any "have made" rights from which Petitioner allegedly benefits. The "have made" license rights purportedly created by EX2022 are a central link in Patent

Owner's attenuated privity theory. lack of "have made" license rights is demonstrated by the fact that is not listed as one of the two "Initial Licensees" of EX2022. EX2022 at 16. Thus Patent Owner's privity theory, by its own terms, does not extend to and additional discovery regarding is unwarranted.

The Board should also not order additional discovery as to Because does not implicate the time bar of 35 U.S.C. 315(b), any privity-related additional discovery regarding would be irrelevant and thus unnecessary. *Shark Ninja Operating LLC v. iRobot Corp.*, IPR2020-00734, Paper 11 at 18 (PTAB Oct. 6, 2020) (Precedential). Patent Owner did not add as a party to the prior litigation until the filing of a second amended complaint on January 23, 2023, which was less than a year before Petitioner filed the petition of this proceeding on July 27, 2023. Paper 2 (Petition); EX2019 (Second Amended Complaint), EX2032 (First Amended Complaint), EX2018 (Complaint). Thus, the time bar associated with § 315(b) is not implicated with respect to and no additional discovery with respect to should be granted as a matter of basic relevance. *Shark Ninja*, IPR2020-00734, Paper 11 at 18; *see also Google LLC v. DDC Technology, LLC*, IPR2023-00707, Paper 39 (Public version of Paper 27) at 38-40 (PTAB Oct. 25, 2023) (declining to consider real party in interest (RPI) in view of *Shark Ninja* when the alleged RPI was added to related litigation in an amended complaint within one year of the petition's filing date).

The Board has repeatedly found that [redacted] was not time-barred under § 315(b) when the Petitioner filed its petition, and the Director's Decision Granting Director Review did not disturb this finding. Paper 32 (Institution Decision) at 13-14, 22; Paper 84 (Final Written Decision), 68-71; Paper 94 (Decision Granting Director Review). Indeed, neither Patent Owner's request for Director Review, nor the Director's decision granting Director Review addresses [redacted] in any substantive detail. *See* Paper 37 (Request for Director Review of Institution Decision), Paper 90 (Request for Director Review of Final Written Decision), Paper 94 (Decision Granting Director Review). The Board's correct analysis thus further supports why additional discovery with respect to [redacted] is unnecessary.

Because the proper scope of additional discovery concerns the Intel Accused Products of Patent Owner's prior litigation against Intel, Petitioner respectfully submits that the Board order that Petitioner provide the following additional discovery:

A. Additional Discovery

Petitioner respectfully submits that the appropriate scope of additional discovery on remand should be limited to the following requests for production:

1. Sales agreements between Petitioner and Intel for the Intel Accused Products.
2. Indemnification agreements between Petitioner and Intel for the Intel Accused Products.

[redacted]

3. Communications between Petitioner and Intel regarding indemnification of Intel by Petitioner for the Intel Accused Products.

Given the Acting Director's order to expeditiously resolve this proceeding on remand, and in the interest of time, Petitioner hereby states that no documents responsive to any of the above properly tailored requests for production exist. Petitioner has further provided a sworn declaration by Petitioner's Vice President of Sales, Matthew Murphy, to confirm the absence of any such documents. A copy of the declaration is being filed herewith at Exhibit 1058 in each of IPR2023-1242, -1243, and -1244. Petitioner is willing to make Mr. Murphy available for a deposition of no more than 2 hours limited in scope to the topics in Mr. Murphy's declaration *(i.e.*, Petitioner's involvement with the Intel Accused Products).

Date: May 30, 2025 Respectfully submitted,

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that the foregoing **JOINT PAPER CONCERNING ADDITIONAL DISCOVERY** has been served on Petitioner via email on the following counsel of record for Petitioners

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