

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CIRRUS LOGIC, INC.;
OMNIVISION TECHNOLOGIES, INC.; AND
TEXAS INSTRUMENTS INC.,
Petitioners,

v.

GREENTHREAD, LLC,
Patent Owner.

Case: IPR2024-00001¹
U.S. Patent No. 10,734,481

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

¹ Texas Instruments, Inc., which filed a petition in IPR2024-00772, has been joined as a party to this proceeding.

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EXHIBIT LIST

Exhibit No.	Description	Submitted Previously
Ex. 2001	<i>Greenthread, LLC v. Intel Corp.</i> , No. 6:22-cv-00105-ADA, Dkt. 1 (Complaint) (W.D. Tex. Jan. 27, 2022)	X
Ex. 2002	Definition of “privity” in Black’s Law Dictionary (11 th ed. 2019) available from Westlaw at westlaw.com	X
Ex. 2003	<i>Greenthread, LLC v. Intel Corp.</i> , 6:22-cv-00105-ADA, Dkt. 38 (First Amended Complaint for Patent Infringement) (W.D. Tex., filed Apr. 29, 2022)	X
Ex. 2004	<i>Greenthread, LLC v. Intel Corp.</i> , No. 6:22-cv-00105-ADA, Dkt. 113 (Redacted Memorandum Opinion and Order) (W.D. Tex. Dec. 27, 2022)	X
Ex. 2005	<i>Greenthread, LLC v. Intel Corp.</i> , 6:22-cv-00105-ADA, Dkt. 38-8 (Greenthread’s Amended Preliminary Infringement Contentions) (W.D. Tex., filed Apr. 29, 2022)	X
Ex. 2006	<i>Greenthread, LLC v. Intel Corp.</i> , 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. 2007	<i>Greenthread, LLC v. Intel Corp.</i> , 6:22-cv-00105-ADA, Dkt. 49 (Notice of Appearance of Additional Counsel) (W.D. Tex., filed June 9, 2022)	X
Ex. 2008	Petition (Paper 1) in <i>Sony Group Corp. v. Greenthread, LLC</i> , IPR2023-00376	X

Exhibit No.	Description	Submitted Previously
Ex. 2009	<i>Greenthread, LLC v. Dell Inc.</i> , No. 6:22-cv-105-ADA, Dkt. 120 (Second Amended Complaint)	X
Ex. 2010	<i>Greenthread, LLC v. Intel Corp.</i> , 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. 2011	Email communication from Patent Owner's counsel to Petitioner's counsel dated October 20, 2023	X
Ex. 2012	Email Attachment – Cirrus Logic Technical Support Article Number 000207340	X
Ex. 2013	Email Attachment - Cirrus Logic Investor Presentation as of April 28, 2015	X
Ex. 2014	Email Attachment - GlobalFoundries 2022 Capital Markets Day, available at https://investors.gf.com/static-files/65f5f1b9-2aea-47a3-8455-10413c6560f4	X
Ex. 2015	Email Attachment - Intel RealSense Product Family D400 Series, dated 2019	X
Ex. 2016	Email communication from Petitioner's counsel to Patent Owner's counsel dated October 24, 2023	X
Ex. 2017	Email communication from Patent Owner's counsel to Board, copying Petitioner's counsel dated November 1, 2023	X
Ex. 2018	<i>Greenthread, LLC v. Cirrus Logic, Inc.</i> , No. 1:23-cv-00369 (Supplemental Preliminary Infringement Contentions) (W.D. Tex., served Oct. 13, 2023)	X
Ex. 2019	<i>Greenthread, LLC v. Cirrus Logic, Inc.</i> , No. 1:23-cv-00369, Dkt. 29 (Scheduling Order) (W.D. Tex. Aug. 18, 2023)	X

Exhibit No.	Description	Submitted Previously
Ex. 2020	Article entitled “Cirrus Logic Helps Ease PC Industry Transition to New MIPI SoundWire® Interface” available at https://investor.cirrus.com/news-and-events/investor-news/news-details/2023/Cirrus-Logic-Helps-Ease-PC-Industry-Transition-to-New-MIPI-SoundWire-Interface/default.aspx	X
Ex. 2021	<i>Greenthread, LLC v. Intel Corp.</i> , 6:22-cv-00105-ADA, Dkt. 120-8, Greenthread’s Amended Preliminary Infringement Contentions (W.D. Tex., filed Jan. 23, 2023)	X
Ex. 2022	Confidential agreement	X
Ex. 2023	CS42L42, Low Power Audio Codec with SoundWire and Audio Processing, available at https://www.cirrus.com/pubs/proBulletin/cs42l43-cs36l56-bulletin.pdf	X
Ex. 2024	Cirrus Logic Immersive PC Audio Solution, available at https://www.cirrus.com/pubs/proBulletin/cs42l43-cs36l56-bulletin.pdf	X
Ex. 2025	Cirrus Logic – What Drives Our Success, available at https://investor.cirrus.com/company-overview/what-drives-our-success/default.aspx	X
Ex. 2026	Cirrus Logic, Inc. Terms and Conditions of Sale, available at https://www.cirrus.com/legal/productterms/	X
Ex. 2027	<i>Greenthread, LLC v. OmniVision Technologies Inc.</i> ; 2:23-cv-212, Dkt. 1 (Complaint) (E.D. Tex May 10, 2023)	X
Ex. 2028	Confidential declaration	X

Exhibit No.	Description	Submitted Previously
Ex. 2029	<i>Greenthread, LLC v. OmniVision Technologies Inc.</i> , 2:23-00212, Preliminary Infringement Contentions for OmniVision Technologies Inc.	X
Ex. 2030	Deep Dive Teardown of the PlayStation VR2 CFIZVR1 VR Headset, available at https://www.techinsights.com/blog/deep-dive-teardown-playstation-vr2-cfi-zvr1-vr-headset	X
Ex. 2031	Intel RealSense Product Family D400 Series, dated September 2023	X
Ex. 2032	Confidential declaration	X
Ex. 2033	GlobalFoundries Annual Report on Form 20-F for the fiscal year ended December 31, 2022, available at https://investors.gf.com/static-files/cc73efd0-09c1-442a-b4dd-0bcb74610e31	X
Ex. 2034	Confidential agreement	X
Ex. 2035	TechInsights Report on Sony Xperia 5111	X
Ex. 2036	TechInsights Report Ad	X
Ex. 2037	Email communication from Petitioner's counsel to Patent Owner's counsel dated between January 9, 2024 through January 10, 2024	X
Ex. 2038	Email communication from Petitioner's counsel to Patent Owner's counsel dated between October 20, 2023 through October 31, 2023	X

Exhibit No.	Description	Submitted Previously
Ex. 2039	<i>Greenthread, LLC v. Intel Corp.</i> , No. 6:22-cv-00105-ADA, Dkt. 7 (summons returned executed) (W.D. Tex. Feb. 7, 2022)	X
Ex. 2040	Petition (Paper 2) in <i>Sony Group Corp. v. Greenthread, LLC</i> , IPR2023-00324	X
Ex. 2041	Petition (Paper 3) in <i>Sony Group Corp. v. Greenthread, LLC</i> , IPR2023-00325	X
Ex. 2042	Petition (Paper 1) in <i>Sony Group Corp. v. Greenthread, LLC</i> , IPR2023-00375	X
Ex. 2043	<i>Greenthread, LLC v. OmniVision Technologies Inc.</i> ; 2:23-cv-212 (OmniVision's Responses and Objections to Greenthread's Fourth Set of Common Interrogatories)	X
Ex. 2044	Email communication from Petitioner's counsel to Patent Owner's counsel dated between November 28, 2023 through December 6, 2023	X
Ex. 2045	Samsung Supplier List, dated June 8, 2022, available at https://image-us.samsung.com/SamsungUS/home/pdf/062822/2022_Supplier_List_220608_F.pdf	X
Ex. 2046	Email communication to Petitioner's counsel attaching production dated October 5, 2023	X
Ex. 2047	Email communication to Petitioner's counsel attaching production dated June 30, 2023	X
Ex. 2048	<i>Greenthread, LLC v. Samsung Electronics Co., Ltd. et al</i> , EDTX-2-19-cv-00147, Dkt. 1 (Complaint) (E.D.Tex., April 30, 2019)	X

Exhibit No.	Description	Submitted Previously
Ex. 2049	<i>Greenthread, LLC v. Samsung Electronics Co., Ltd. et al</i> , EDTX-2-19-cv-00147, Dkt. 6 (Order granting Motion for Extension of Time, and Waiver of Foreign Service Requirement) (E.D.Tex., May 31, 2019)	X
Ex. 2050	Correspondence from Patent Owner's counsel to Petitioner's counsel dated May 4, 2023	X
Ex. 2051	Webpage from DigiKey for Cirrus Logic CS35L41 (https://www.digikey.com/en/products/detail/cirrus-logic-inc/CS35L41-CWZR/16377919)	X
Ex. 2052	Webpage from DigiKey for Cirrus Logic CS40L25 (https://www.mouser.com/ProductDetail/Cirrus-Logic/CS40L25-CWZR?qs=xZ%2FP%252Ba9zWqYWfeisEtcaTA%3D%3D)	X
Ex. 2053	Webpage from Mouser for Cirrus Logic CS40L25 (https://www.mouser.com/ProductDetail/Cirrus-Logic/CS40L25-CWZR?qs=xZ%2FP%252Ba9zWqYWfeisEtcaTA%3D%3D)	X
Ex. 2054	Webpage from ArduCam for OmniVision OV9282 (https://www.arducam.com/product/ov9282-monochrome-globalshutter-camera-module-depthai-oak/)	X
Ex. 2055	Webpage from Uctronics for OmniVision OV9282 (https://www.uctronics.com/ov9282-monochrome-global-shutter-camera-module-depthai-oak.html)	X
Ex. 2056	Excerpts of the Deposition Transcript of Scott Warrick taken on June 7, 2024 along with marked Exhibits 3-5 in <i>Greenthread, LLC v. Cirrus Logic, Inc.</i> , 1:23-cv-00369-DC (W.D. Tex.)	X

Exhibit No.	Description	Submitted Previously
Ex. 2057	Declaration of Dr. Alexander Glew	X
Ex. 2058	Transcript of Deposition of Dr. Sanjay Banerjee taken on July 19, 2024	X
Ex. 2059	Excerpts from Chen, J. Y., <u>CMOS Devices and Technology for VLSI</u> , 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. 11,121,222	X
Ex. 2065	U.S. Patent No. 10,510,842	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. 11,121,222	X

Exhibit No.	Description	Submitted Previously
Ex. 2070	File History of U.S. Patent No. 10,510,842	X
Ex. 2071	File History of U.S. Patent No. 11,316,014	X
Ex. 2072	Declaration of Mohan Rao	X
Ex. 2073	Statista Information	X
Ex. 2074	<i>Greenthread, LLC v. Cirrus Logic Inc.</i> , 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. 2075	<i>Greenthread, LLC v. Samsung Electronics Co., Ltd. Et Al.</i> , 2:19-cv-00147, Dkt. No. 67 (Claim Construction Memorandum Opinion and Order) (E.D. Tex. Apr. 20, 2020)	X
Ex. 2076	<i>Intel Corp. v. Greenthread LLC</i> , IPR2023-00420, Ex. 1003 (Dr. Blalock Declaration), Dec. 28, 2022	X
Ex. 2077	<i>Greenthread, LLC v. Cirrus Logic, Inc.</i> , No. 1:23-cv-00369-DC, Dkt. 86 (W.D. Tex. Jul. 11, 2024)	X
Ex. 2078	Transcript of Deposition of Dr. Sanjay Banerjee, taken on December 6, 2024	X
Ex. 2079	Demonstratives of Patent Owner Greenthread, LLC	X

I. INTRODUCTION

Director Review should be granted and this proceeding terminated, without discovery, because PO sufficiently raised the “privity” issue in its POPR and POR (Papers 15 & 45), and Petitioners presented *zero* “actual evidence” in their Preliminary Reply and Petitioner’s Reply (Papers 19 & 54) to meet their burden that it is not time-barred. The Panel misapplied *Worlds* and committed the same legal error in both its ID and FWD (Papers 29 & 78).

This Request presents the *same* two legal questions at-issue in related IPRs filed by OnSemi (IPR2023-01242, -01243, -01244, “OnSemi IPRs”):

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

The Director already granted Director Review for the OnSemi IPRs, and the Director should do the same here. The Panel in this IPR committed the same legal error.

Without the benefit of *any* discovery, PO presented evidence that “tends to show” that Cirrus Logic (CL), OmniVision (OV), and GlobalFoundries (GF) were in privity with Intel. In other words, there are *at least three* independent bases for why the Petition is time-barred. CL, OV, and GF were fully aware of *Worlds* and their burden to produce “actual evidence.” Yet they repeatedly refused to do so. Instead, they relied entirely on “attorney argument.” The Panel’s reliance on this “attorney argument” was clear legal error.

To remand this IPR for discovery and effectively give Petitioners a “do over” would reward them for their calculated decision to hide the underlying facts. PO has already been prejudiced by IPRs that should never have been instituted, and to reopen them would only compound that prejudice. The most appropriate remedy is to terminate this IPR now. If this IPR is remanded for discovery, the Director should specify that the discovery is not limited to Intel, but also includes CL, OV, and GF’s relationships with [REDACTED].²

II. BACKGROUND

A. The *Intel* [REDACTED] Litigation

PO served a complaint for patent infringement on Intel and [REDACTED] in February 2022. EX2001; EX2039. PO served a First Amended Complaint (FAC) on Intel and [REDACTED] on April 29, 2022, expressly accusing [REDACTED] components in [REDACTED] products. EX2003, ¶¶76-81. PO served a Second Amended Complaint on Intel, [REDACTED] [REDACTED] in January 2023. EX2009. PO settled the *Intel* [REDACTED] litigation by granting a license to RPX, listing Intel as an “Initial Licensee.” EX2022, 16 (Intel license).

According to RPX, Intel “acquired the full scope of sublicensable rights PO

² PO also presented evidence that privity exists between [REDACTED] and each of CL, OV, and GF. *See* POPR, 3-9, 11-13; POR, 34-39. For purposes of this Request, PO has focused on just the privity with Intel.

granted to RPX.” EX2028, ¶5. Thus, Intel acquired the right to “have made” or “purchase” “any Licensed Product and Service.” EX2022, 3. Furthermore, CL, OV, and GF received a sublicense as “have made vendors” (and “Covered Third Party”) to make and sell products to Intel. *Id.*, 5.

B. Evidence of Cirrus Logic’s Privity with Intel

PO cites evidence that CL collaborates with Intel to manufacture audio chips that are compatible with Intel’s processors for use in laptops. POPR, 9-10; POR, 45 (citing EX2020). For example, CL’s audio chips are part of an audio system that Intel refers to as “SoundWire-ready Intel reference design.” EX2020. CL boasts that its “engineers work closely” with companies like Intel to make these custom products. EX2025. CL has never denied that it sells its chips for incorporation into Intel’s products. *See* Pet. Disc. Opp. (Paper 11), 8. More specifically, CL did not deny that it sells “parts” to “distributors” that then sell them to Intel. *Id.*

CL’s audio chips were accused in PO’s lawsuit against CL, and they were also accused (or could have been accused) in the *Intel* [REDACTED] litigation. EX2018, 4 (accusing audio chip CS42L2, which is the predecessor to CS42L43). Because CL is a “fabless” semiconductor company, CL works with GF to manufacture its chips. EX2032, ¶¶4-5 (CL corporate representative).

PO also cites evidence that CL had a duty to indemnify Intel for any infringement claims against CL’s audio chips. POPR, 10; POR, 38, 45 (citing

EX2026). CL's standard "Terms and Conditions of Sale" provide for indemnification of its customers. EX2026, 4-5 ("Intellectual Property Indemnification"). Petitioners have never denied this. *See* Prelim. Reply, 9-10.

PO also cites evidence that CL was a third-party beneficiary of the Intel license. POPR, 5-6, 10; POR, 35-37 (citing EX2022). More specifically, Intel was licensed to make products for CL, and *vice versa*, CL was licensed to make products for Intel. *See* EX2022, 5 ("have-made vendors" and "Covered Third Party"). This explains why CL's counsel sent an email that an accused chip was "clearly a licensed product." POPR, 10; POR, 38, 45 (citing EX2037).

C. Evidence of OmniVision's Privity with Intel

PO cites evidence that OV collaborates with Intel to manufacture chips that are compatible with Intel's products. POPR, 12; POR, 39, 45 (citing EX2015). For example, OV sells its OV9282 image sensor for use in Intel's RealSense D400 camera systems. EX2015, 34, 36; EX2031, 43-44, 46-47. OV has never denied that it sells chips for incorporation into Intel's products. *See* Pet. Disc. Opp., 8-9. More specifically, OV did not deny that it sells "production volumes of [OV] products" to "distributors or third-party subcontractors" that then sell them to Intel. *Id.*

OV's sensor chips were accused in PO's lawsuit against OV, and they were also accused (or could have been accused) in the *Intel* [REDACTED] litigation. EX2029, 8. OV has never denied that OV had a duty to indemnify Intel for any infringement

claims against OV's chips. *See* Prelim. Reply, 9-10.

PO also cites evidence that OV was a third-party beneficiary of the Intel license. POPR, 5-6, 12-13; POR, 35-37 (citing EX2022). More specifically, Intel was licensed to make products for OV, and *vice versa*, OV was licensed to make products for Intel. *See* EX2022, 5 ("have-made vendors" and "Covered Third Party"). OV never denied that Intel is one of its customers. Pet. Disc. Opp., 8-9. And OV has claimed that PO's licenses would exhaust PO's infringement claims against OV's products. POPR, 12-13, POR, 39 (citing EX2043, 7).

D. Evidence of GlobalFoundries' Privity with Intel

GF is a real-party-in-interest to this IPR.³ Pet. (Paper 1), 1. PO cites evidence that GF manufactures chips for Intel. POPR, 13; POR, 40, 45 (citing EX2014, 19). In fact, GF "focuses on producing ICs for other companies, rather than those of its own design." EX2033, 12. GF has never denied that it fabricates chips for Intel *directly*, and that it fabricated the very chips that were accused in the *Intel* litigation. *See* Pet. Disc. Opp., 9. Additionally, GF has never denied that it fabricates the CL and OV chips that CL and OV provide to Intel. *Id.*

³ Covington & Burling LLP represents both CL and GF in this IPR. Oral Hearing Tr. (Paper 76), 4:15-21. Additionally, GF's in-house counsel has attended depositions and hearings. *Id.*; EX1063, 5, 9; EX1066, 2; EX2058, 9; EX2078, 6.

PO also cites evidence that GF had a duty to defend and indemnify Intel, CL, and OV for any infringement claims against their chips. POPR, 13; POR, 40, 45 (citing EX2033, 24) (“many of [its] agreements...require [GF] to defend such parties against certain [IP] infringement claims and indemnify them for damages.”). Moreover, GF has never denied that it had a duty to defend and indemnify chips and products that were accused in the *Intel* [REDACTED] litigation. *See* Pet. Disc. Opp., 9.

PO also cites evidence that GF was a third-party beneficiary of the Intel license. POPR, 5-6; POR, 35-37 (citing EX2022). More specifically, GF was licensed to make products for Intel. *See* EX2022, 5 (“have-made vendors” and “Covered Third Party”). The license that PO granted to Intel would presumably cover and exhaust any patent infringement claims against the chips that GF manufactured for use in Intel products. *Id.* GF has never denied this.

E. PO’s Discovery Requests

One week after the Petition was filed, PO emailed Petitioners’ counsel about the privity issue.

Petitioners...have the burden of identifying all real parties in interest (RPIs) in the petition and demonstrating that the petitions are not time barred....

If petitioners do not withdraw its petitions, then each petitioner and Global Foundries should produce:

- (1) All agreements with Intel, [REDACTED] relating to transistor products sold to or made for them or the prior litigations.

- (2) All communications with these Intel, [REDACTED]
[REDACTED] relating to such products or the prior litigations.

EX2011. Petitioners and GF were fully aware of *Worlds* and the requirement to produce “actual evidence” early in this IPR. Petitioners “object[ed]” to PO’s discovery request and refused to produce any evidence. EX2016.

PO filed a motion seeking discovery about CL, OV, and GF’s relationships with [REDACTED] Intel, [REDACTED]. Paper 9. PO requested that the Board move expeditiously “because the POPRs...[would] be due during the briefing of PO’s motion.” *Id.*, 15. Instead, the Board waited nearly three months to deny the motion. Paper 18. PO had to file its POPR without any additional discovery, but still presented sufficient evidence to put the privity issue into dispute. POPR, 3-15.

The Board instituted this IPR (Paper 29), and PO timely sought Director Review of the ID (Paper 32). This request was summarily denied—without reason—by the former Director. Paper 34. PO maintained its discovery motion and privity arguments post-institution. In fact, PO devoted nearly half of its POR to this critical, gate-keeping issue, and PO provided additional argument any evidence why the Petition is time-barred. POR, 34-61. The Board issued its FWD (Paper 78) during the pendency of PO’s Director Review request in the OnSemi IPRs.

F. Director Review Decision in the OnSemi IPRs

The Director recently granted review in the OnSemi IPRs. IPR2023-01242 (Paper 94) (“OnSemi Decision”). There, the Director vacated the FWDs and

determined that the Board “abused its discretion in denying [PO’s] discovery motions.” OnSemi Decision, 3. The Director explained that it was error for the Board to deny PO’s motion and then rely upon the “absence of evidence as a basis not to find a privity relationship.” *Id.* Here, PO’s Discovery Motion and the Board’s Order denying the requested discovery are virtually identical to those in the OnSemi IPRs. *Compare* Papers 9 and 18 *with* IPR2023-01242, Papers 8 and 30.

In the OnSemi IPRs, OnSemi filed a request for rehearing, arguing that the Director abused her discretion by granting discovery on the privity issue. IPR2023-01242, Paper 103 (May 8, 2025). PO filed a response explaining why it is not necessary to order discovery and the Director should terminate the OnSemi IPRs now without discovery. IPR2023-01242, Paper 104 (May 16, 2025).

III. ARGUMENT

The relevant facts and procedural history in this IPR are substantially identical to the OnSemi IPRs, and Director Review should be granted in this IPR for the same reasons. Like the OnSemi IPRs, the Panel committed legal error by denying PO’s discovery request, and then faulting PO for not producing enough evidence. But it was *not* PO’s burden to prove privity.

Here, like in the OnSemi IPRs, PO sufficiently raised the privity issue in its POPR and POR. CL, OV, and GF knew about *Worlds*, but then produced *zero* “actual evidence.” Instead, they relied entirely on “attorney argument.” The Panel’s

reliance on this “attorney argument” was clear legal error.

PO has been severely prejudiced by IPRs that should have never been instituted, and the most appropriate remedy is to terminate this IPR now. If this IPR is remanded for discovery, the Director should specify that the discovery includes CL, OV, and GF’s relationships with [REDACTED] Intel, [REDACTED].

A. PO Sufficiently Raised the “Privity” Issue in Its POPR and POR

The Federal Circuit made it clear that it is a very low bar to sufficiently dispute privity. *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1244 (Fed. Cir. 2018). PO does *not* have to prove privity. Rather, all PO has to do is “produce *some* evidence that tends to show that a particular third party should be named a real party in interest.” *Id.* (emphasis original). This must be more than a “mere assertion.” *Id.* PO has done exactly that. *See* PO Disc. Mot., 3-9; POPR, 4-13; POR, 34-40.

In *Worlds*, the Federal Circuit did more than just clarify the law. The Federal Circuit analyzed PO’s evidence, and determined that PO had “presented *more than enough* evidence to sufficiently put [the privity] issue into dispute.” *Worlds*, 903 F.3d at 1244 n.8 (emphasis added). This is important because it proves that PO *also* produced enough evidence to sufficiently raise the privity issue.

First, this IPR was filed more than one year after a complaint was served on Intel. POPR, 4. Petitioners do *not* dispute that Intel is a time-barred party.

Second, just like in *Worlds*, PO produced evidence that tends to show that CL

sold audio chips (directly or indirectly) to Intel for use in Intel's audio system that were accused (or could have been accused) in the *Intel* [REDACTED] litigation, and that CL had a duty to defend and indemnify Intel against patent infringement claims by PO. EX2018; EX2020; EX2025; EX2026; EX2032. PO also produced evidence that CL was licensed under the Intel license. EX2022; EX2037.

Third, just like in *Worlds*, PO produced evidence that tends to show that OV sold image sensor chips (directly or indirectly) to Intel for use in Intel's camera systems that were accused (or could have been accused) in the *Intel* [REDACTED] litigation, and that CL had a duty to defend and indemnify Intel against patent infringement claims by PO. EX2015; EX2029; EX2031. PO also produced evidence that OV was licensed under the Intel license. EX2022; EX2043.

Fourth, just like in *Worlds*, PO produced evidence that tends to show that GF fabricated Intel chips that were accused (or could have been accused) in the *Intel* [REDACTED] litigation, and that GF had a duty to defend and indemnify Intel against patent infringement claims by PO. EX2014; EX2033. PO also produced evidence that GF was licensed under the Intel license. EX2022.

Finally, the Challenged Patent was asserted against Intel more than one year before this IPR was filed. *See* EX2001, ¶2 (Complaint); EX2003, ¶2 (FAC).

In *Worlds*, the patent owner produced *only* three forms of evidence:

- (1) a development agreement showing that Bungie developed a video game called “Destiny”;
- (2) a letter that Worlds might add “Destiny” to the Activision litigation; and
- (3) the fact that the five patents asserted in the Activision litigation were the same five patents in the IPRs.

Id. at 1244. By comparing Worlds’ evidence to PO’s evidence, it is readily apparent that PO has already met the low bar in *Worlds*. Like Worlds did, PO has already produced evidence that:

- (1) CL, OV, and GF developed products for Intel;
- (2) these products were accused (or might have been accused) in the *Intel* [REDACTED] litigation; and
- (3) the patent at-issue in this IPR was also asserted in the *Intel* [REDACTED] litigation.

While PO does not have access to all of the development agreements, CL, OV, and GF could have easily produced them in order to prove that they were not in privity with Intel. CL, OV, and GF had numerous opportunities to produce “actual evidence.” The fact that they did *not* produce and evidence supports PO, not CL, OV, and GF. To fault PO for not producing enough evidence, and instead relying on Petitioners’ “attorney argument,” was clear legal error. As the Director correctly noted, PO cannot be faulted for evidence that Petitioners and GF refused to produce. *See* OnSemi Decision, 3 (“the Board denied [PO’s] motions and then cited the absence of evidence as a basis not to find a privity relationship.”).

B. Petitioners Produced Zero “Actual Evidence” to Meet Its Burden That It is Not Time-Barred

Because PO sufficiently raised the privity issue, Petitioners and GF were required to produce “actual evidence” to prove that they were not time-barred. *Worlds*, 903 F.3d at 1242. Petitioners knew about the Intel license before filing their Petitions. *See* EX2047 (6/30/23); EX2046 (10/5/23). Yet Petitioners and GF baldly claimed that they were “not barred or estopped from requesting IPR of the Challenged Claims.” Pet., 5.

PO contacted Petitioners and GF’s counsel immediately after the Petition was filed. EX2011. PO requested that Petitioner and GF provide discovery about their relationships with [REDACTED] Intel, [REDACTED]. *Id.* At this point, Petitioners were fully aware of *Worlds* and the requirement to produce “actual evidence.” But Petitioners refused to produce *any* evidence, and *merely argued* that “none of Petitioners had any discussions...regarding the prior litigations” and that “Petitioners have no knowledge as to what products made or sold by [Intel] are covered by [PO’s] licenses.” EX2016.

The Board authorized a Preliminary Reply and gave Petitioners the chance to rebut the evidence presented in the POPR, even though privity was something “Petitioner[s] could have reasonably foreseen” when filing its Petition. *Sandoz Inc. v. Abbvie Biotech. Ltd.*, IPR2018-00002, Paper 11 at 3 (PTAB Mar. 6, 2018). But Petitioners still relied entirely on “attorney argument,” despite previously offering

to “submit a declaration attesting to these facts.” *See generally* Prelim. Reply; Pet. Disc. Opp., 5 n.2. Petitioners offered **zero** “actual evidence.” Instead they merely argued that PO made “unsupported assertions” regarding Petitioners’ commercial relationships with Intel. Prelim. Reply, 4. Even more concerning, Petitioners **never** denied that there were other indemnification agreements with its customers that would provide more specific terms than Petitioners’ standard terms. *Id.*, 9-10.

The Panel relied on the “attorney argument” and instituted this IPR. But throughout this IPR, Petitioners have repeatedly refused to produce *any* “actual evidence”: (1) when requested by PO (EX2011); (2) when opposing PO’s discovery motion (Paper 11); (3) when authorized to file a Preliminary Reply (Paper 19); (4) when it filed its later Reply (Paper 54); or (5) any other time during the pendency of this IPR, including after the Director granted review in the OnSemi IPRs.

Under these circumstances, the Board should have realized that the underlying evidence would *not* support Petitioners’ privity arguments. *See Volkswagen Grp. of Am., Inc. v. Arigna Tech. Ltd.*, IPR2021-01263, 2022 WL 211526, at *4 n.4 (PTAB Jan. 21, 2022) (agreeing that a petitioner’s failure to produce its indemnification agreements “may suggest that the agreement does not support” petitioner in meeting its burden). “Failure to prove [a] matter...means that the party with the burden of persuasion loses on that point.” *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378-79 (Fed. Cir. 2015). Without *any* “actual evidence,” Petitioners

cannot possibly have met their burden that the Petition is not time-barred.

C. Under *Worlds*, the Most Appropriate Remedy is to Terminate this IPR Now

In *Worlds*, the Federal Circuit remanded for discovery on the privity issue. 903 F.3d at 1246-47. But at the time of the *Worlds* appeal, the law was not settled that once a PO sufficiently raises the privity issue, the Petitioners *must* produce an affidavit, declaration, or other “actual evidence” in order to meet its burden that it is not time-barred. *Id.* at 1246. Here, Petitioners and GF were fully aware of *Worlds*. Yet they made the calculated decision to rely entirely on “attorney argument” in their Response to PO’s Discovery Motion, Preliminary Reply, and post-institution Reply. Their decision to not produce *any* evidence is fatal to this IPR.

When, as here, a petitioner has not produced the relevant agreements, this lack of evidence affirmatively “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, 2019 WL 858745, at *6 (PTAB Jan. 24, 2019) (precedential). Petitioners and GF had ample opportunity to produce agreements, communications, or other “actual evidence,” but they chose otherwise. Under these circumstances, the Panel should have inferred that these agreements are unfavorable to CL, OV, and GF. Instead, the Panel rewarded them for their lack of production. Even worse, the Panel improperly credited the “attorney argument,” while rejecting the evidence provided by PO. This was clear legal error.

PO has already been prejudiced by IPRs that should never have been instituted, and to reopen them would only compound that prejudice. Petitioners and GF should not be rewarded for their calculated decision to not produce any “actual evidence,” and the prejudice it caused PO. Because Petitioners were fully aware of *Worlds* and the consequences of relying entirely on “attorney argument,” the most appropriate remedy is to terminate this IPR now.

D. At a Minimum, this IPR Should Be Remanded for Discovery on the Privity Issue

As the Director correctly noted in the OnSemi IPRs, the Panel abused its discretion by denying discovery on the privity issue. OnSemi Decision, 3. If this IPR is remanded for discovery, the Director should specify that the discovery is not limited to Intel, and that it also includes CL, OV, and GF’s relationships with [REDACTED]. While this Director Review Request has focused on Intel, PO’s original discovery request also included CL, OV, and GF’s relationships with [REDACTED], and these relationships are highly relevant to the privity issue. PO Disc. Mot., 10-13, Appx. A.

IV. CONCLUSION

For the reasons above, PO respectfully requests that the Director grant review, reverse the Board’s FWD, and terminate this IPR proceeding now.

Date: May 22, 2025

Respectfully submitted,

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CERTIFICATION OF PAGE LIMIT

The undersigned hereby certifies that the above-captioned **PATENT OWNER'S 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).

Dated: May 22, 2025

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