

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CIRRUS LOGIC, INC.;
OMNIVISION TECHNOLOGIES, INC.; AND
TEXAS INSTRUMENTS INCORPORATED,
Petitioner,

v.

GREENTHREAD LLC,
Patent Owner.

Case No. IPR2024-00001¹
Patent No. 10,734,481

**PETITIONER’S AUTHORIZED RESPONSE TO
DIRECTOR REVIEW REQUEST**

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

Greenthread LLC’s (“PO”) Request for Director Review (“Req.”) seeking termination or remand of this IPR should be denied. PO misrepresents the Director Review Order in the ONSemi IPRs (IPR2023-01242, -01243, -01244, Paper 94; “Order”). PO is clearly mistaken—in the ONSemi IPRs, the Director ***denied a similar request from PO to terminate the IPRs at issue.*** Order at 1; IPR2023-01242, Paper 90 at 15. Instead, the Director remanded the case for “narrowly tailored” discovery focused solely on Intel. Order at 3. The Director asked for an assessment of “whether ***Patent Owner has produced some evidence*** to support its argument that Intel should be named as a privy ***so as to have put the issue into dispute.***” *Id.* (emphasis added). In the present case, termination is not an appropriate remedy for either issue PO raises: the IPR can continue with TI even if Petitioners were time-barred, and more discovery, not termination, is appropriate if discovery should have been provided. Furthermore, a remand for further discovery by PO is unwarranted here. ***First***, PO asserted merely days ago that “no additional discovery is needed” from Petitioners when it was offered by the Board in five related IPRs involving the same parties and the same allegations of privity. *E.g.*, IPR2024-00017, Ex. 3011. Thus, PO’s assertion that the case should be remanded for further discovery, akin to the ONSemi IPRs, is untenable. ***Second***, the Order permitted discovery only as to Intel, not any other parties, based on similar arguments (limited to Intel) by PO. Req. at 2 & n.2. PO thus is not entitled to any of the relief it now seeks.

I. PO FAILED TO PROVIDE “SOME EVIDENCE” OF PRIVACY

A. PO did not sufficiently raise the privacy issue

“[T]he board generally accepts an IPR petitioner’s identification of the real parties in interest at the time the petition is filed.” *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1241 (2018). To successfully challenge this identification, “a patent owner must produce some evidence to support its argument that a particular third party should be named a real party in interest.” *Id.* at 1242. PO fails to satisfy this burden of production. PO itself acknowledged the deficiency of its evidence in its motion for additional discovery, admitting that the information it required was “not reasonably available through other means” and that, without discovery, PO “cannot know . . . if or how any Petitioner and its customers collaborate on product design, which customers buy which products, and which of that Petitioner’s products are incorporated into which” products. Paper 9 at 13–14.

In *Worlds*, the patent owner provided evidence that the petitioner’s “legal reviews” “shall be subject to prior review and approval” of the third party. *Worlds*, 903 F.3d at 1244–45. In contrast, PO neither argues nor provides evidence showing authority by Intel to influence or control Petitioners’ conduct (or vice versa). At most, PO merely points to the following: (1) Intel may have purchased and used Petitioners’ products in its accused products; (2) Petitioners may have been obligated to indemnify Intel in certain circumstances; and (3) Intel’s licensing terms, including

“have made” rights, encompass products provided to Intel by Petitioners that “could have been accused” of infringement. Req. at 3–5, 9–10.²

None of these assertions show privity. As the Federal Circuit explained, “the standards for the privity inquiry must be grounded in due process.” *WesternGeco LLC v. ION Geophysical Corp.*, 889 F.3d 1308, 1319 (Fed. Cir. 2018). A prior litigant may be a privy to a petitioner if the petitioner had a full and fair opportunity to litigate the validity of the patent in the prior litigant’s lawsuit, or if the petitioner is serving as a proxy of the prior litigant. *Id.* Here, Petitioners did not receive notice or have the opportunity to litigate in Intel’s prior case, and Petitioners are not acting as a proxy for Intel. *See* Paper 19 at 6. **First**, the assertion that Petitioners may have “indirectly” sold products to Intel for inclusion in products that “could have been accused” in the prior Intel litigation lacks evidentiary support and remains speculative. *See Worlds*, 903 F.3d at 1244. Moreover, a customer-manufacturer relationship is not sufficient to give rise to privity. *See WesternGeco*, 889 F.3d at 1319–22; *Wi-Fi One, LLC v. Broadcom Corp.*, 887 F.3d 1329, 1340–41 (Fed. Cir. 2018). **Second**, indemnity obligations are not sufficient to give rise to privity. *See*

² Here, unlike in *Volkswagen*, PO did not come forward with “compelling evidence” that a third party was a real party in interest. *Volkswagen Grp. of Am., Inc. v. Arigna Tech. Ltd.*, IPR2021-01263, Paper 16 at 7 (P.T.A.B. Jan. 21, 2022).

WesternGeco, 889 F.3d at 1321; *Wi-Fi One*, 887 F.3d 1340–41. **Third**, PO’s argument that privity exists simply because Intel’s license with PO encompasses any product Petitioners may provide to Intel incorrectly implies that every transaction between a manufacturer and its customers automatically establishes privity. Such an expansive reasoning has been previously dismissed by the Federal Circuit. *See WesternGeco*, 889 F.3d at 1319–22; *Wi-Fi One*, 887 F.3d 1340–41. Furthermore, PO misleadingly cites an email pertaining to another third party, incorrectly suggesting that it is related to Intel. Req. at 4 (citing Ex. 2037).

Acknowledging its failure to adequately present the privity issue, PO criticizes Petitioners for producing “**zero** ‘actual evidence.’” Req. at 13 (emphasis in original). However, Petitioners had no obligation to provide evidence because (as the Board properly concluded) PO had not raised a sufficiently substantial privity issue. Paper 18 at 19. Moreover, contrary to PO’s assertion that PO “cannot be faulted for evidence that [Petitioners] refused to produce,” Req. at 11, it is important to note that PO chose not to pursue discovery despite the Board offering an identical opportunity for additional discovery in co-pending IPRs involving the same parties and same allegations of privity. *E.g.*, IPR2023-00017, Ex. 3011. Indeed, PO explicitly stated that “no additional discovery is needed.” *Id.* It is unsurprising that PO preferred to forgo discovery: Petitioners had represented (and offered to provide a declaration if needed) that Petitioners did not engage in any communications with

Intel regarding its litigation with PO, any resulting license agreements, related indemnity demands, or any IPRs concerning PO's patents. Paper 11 at 4–5 & n.2.

B. The Director Review Order in the ONSemi IPRs confirms that the Director should deny Director Review

Director Review should be denied despite PO's assertion that "Director Review should be granted in this IPR for the same reasons" based on the argument that "[t]he relevant facts and procedural history in this IPR are substantially identical to the ONSemi IPRs." Req. at 8. **First**, the Director denied PO's request to terminate the ONSemi IPRs, instead remanding the case for further discovery. Order at 1. The Director should likewise deny PO's request to terminate the current IPR. PO's assertion of prejudice is unconvincing, as it fails to identify any prejudice beyond the mere initiation of the IPR. Moreover, PO's argument for terminating this IPR under *Worlds* is misplaced, as the Federal Circuit did not terminate the IPR in that case. *See Worlds*, 903 F.3d at 1248. Additionally, *Ventex* is distinguishable because the patent owner in *Ventex* pointed to evidence demonstrating that the petitioner was "serving as a proxy" for a third party that was funding the IPR for the petitioner. *Ventex Co., Ltd. v. Columbia Sportswear N. Am., Inc.*, IPR2017-00651, Paper 148 at 13 (P.T.A.B. Jan. 24, 2019) (precedential). **Second**, while the Director remanded the ONSemi IPRs to permit PO to pursue further discovery, IPR2023-01242, Paper 94 at 6, a similar remand is unwarranted here because PO declined the opportunity for discovery because it was not "needed." *E.g.*, IPR2023-00017, Ex. 3011.

Date: June 2, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6(e), I certify that on June 2, 2025, Petitioner's Authorized Response To Director Review Request was served by email on the following counsel for Patent Owner:

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