

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CIRRUS LOGIC, INC.,
OMNIVISION TECHNOLOGIES, INC., and
TEXAS INSTRUMENTS INC.,
Petitioner,

v.

GREENTHREAD, LLC.,
Patent Owner.

IPR2024-00001 (Patent 10,734,481 B2)
IPR2024-00016 (Patent 10,510,842 B2)¹

Before KRISTEN L. DROESCH, GRACE KARAFFA OBERMANN,
DONNA M. PRAISS, MONICA S. ULLAGADDI, and JULIA HEANEY,
Administrative Patent Judges.^{2, 3}

OBERMANN, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
Ordering Post-Remand Discovery and Briefs
37 C.F.R. § 42.5

¹ Texas Instruments Incorporated, which filed a petition in IPR2024-00772, was joined as a petitioner in IPR2024-00001. IPR2024-00001, Paper 52.

² Because this Order addresses issues identical across the cases identified in the caption, we exercise our discretion and enter the same order in each case. The parties may use this style heading in any paper filed pursuant to this Order, provided such heading includes a footnote attesting “the word-for-word identical paper is filed in each proceeding identified in the heading.”

³ The listing of judges does not expand any panel.

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On April 22, 2025, the Board entered Final Written Decisions in both proceedings. *See* IPR2024-00001 (“IPR0001”), Papers 78, 80; IPR2024-00016 (“IPR0016”), Papers 74, 76.

On July 23, 2025, the Director granted Patent Owner’s request for review, vacated the Final Written Decisions, and remanded to the Board for further proceedings. IPR0001, Paper 89; IPR0016, Paper 85 (“Director’s Decision”). The Director’s Decision remands “to the Board with instructions to allow discovery, narrowly tailored to” a privity issue relating to an alleged relationship between Petitioner and a non-party, Intel, “as the Board already has authorized in” a number of related cases.⁴

This Order authorizes post-remand discovery and briefs consistent with the Director’s instructions.

A. Post-Remand Discovery

Consistent with the Director’s Decision, we order Petitioner to provide the following discovery to Patent Owner in these two proceedings:

(a) The following documents:

- a. Sales agreements between Petitioner and Intel for the Intel Accused Products;⁵ and

⁴ The related cases are IPR2023-01242, IPR2023-01243, IPR2023-01244, IPR2024-00017, IPR2024-00018, IPR2024-00019, IPR2024-00020, IPR2024-00021, IPR2024-00263, IPR2024-00264, IPR2024-00265, IPR2024-00266, IPR2024-00468, IPR2024-00469, IPR2024-00470, IPR2024-00550, IPR2024-00551, IPR2024-00552, and IPR2024-00553.

⁵ The “products accused” consist of “the ‘Intel Accused Products’” identified on pages 4–8 of IPR0001, Exhibit 2021, namely, the Intel “products accused of practicing the challenged claims” in Patent Owner’s prior litigation.

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b. Indemnification agreements between Petitioner and Intel for the Intel Accused Products. *See* IPR2023-01242, Paper 94, 3.

(b) Documents sufficient to show the asserted privity relationship between Petitioner and Intel, including any new declaration(s) that establish that no documents responsive to Subsection (a) above exist, as well as any documents and new declaration(s) that establish (1) the time by which Petitioner became aware of the Intel litigation referenced in the Director's Decision; (2) whether Petitioner was the supplier of any product, or component of a product, accused of infringement in the Intel litigation; and (3) whether Petitioner was in a position to control, or actually controlled, Intel's defense of that litigation.

We previously ordered Petitioner to produce the identical discovery to Patent Owner by July 11, 2025, in IPR2024-00017 (Paper 87, 6), IPR2024-00018 (Paper 87, 6), IPR2024-00019 (Paper 83, 6), IPR2024-00020 (Paper 80, 6), and IPR2024-00021 (Paper 83, 6). Petitioner's production pursuant to the orders entered in those related cases shall be deemed to fully discharge its duty of production in these two instant proceedings.

We also previously authorized Patent Owner to request routine discovery in the form of cross-examination of any declarant(s) produced by Petitioner pursuant to Subsection (b) above in the related cases. IPR2024-00017 (Paper 87, 6), IPR2024-00018 (Paper 87, 6), IPR2024-00019 (Paper 83, 6), IPR2024-00020 (Paper 80, 6), and IPR2024-00021 (Paper 83, 6). Petitioner's compliance with the routine discovery authorized by the orders entered in those related cases shall be deemed to fully discharge its discovery burden in these two proceedings.

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B. Post-Remand Briefs

The Board *sua sponte* determines that post-remand briefs on the privity issue would be helpful to the panel in reaching an efficient and fair resolution of the two instant cases in view of the Director's Decision. The parties may file new evidence as exhibits, consisting solely of documents, declarations, and deposition transcripts produced in accordance with the above parameters. The Board, however, will consider such new evidence only to the extent that it is cited and explained in a post-remand brief.

We order post-remand briefs, and an optional telephonic privity hearing, as set forth below.

1. Patent Owner's Post-Remand Brief

No later than August 12, 2025, Patent Owner shall file a Post-Remand Brief, not to exceed fifteen (15) pages in length, that explains Patent Owner's position that Petitioner is in privity with time-barred entity Intel. In particular, the Brief should address in detail Patent Owner's assertion that Petitioner is a supplier of products to Intel that are the subject of the licensing agreement in the record. IPR0001, Ex. 2022. This brief may be supported by evidence of record as well as the filing of any documents, declarations, and deposition transcripts produced pursuant to the discovery ordered above. No other new evidence may accompany this brief.

2. Petitioner's Responsive Post-Remand Brief

No later than August 26, 2025, Petitioner shall file a Responsive Post-Remand Brief, not to exceed fifteen (15) pages in length. Petitioner may use this brief to respond to information presented in Patent Owner's Post-Remand Brief and to raise any other information that, in Petitioner's view,

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bears on the privity dispute. This brief may be supported by evidence of record as well as the filing of any documents, declarations, and deposition transcripts produced pursuant to the discovery ordered above. No other new evidence may accompany this brief.

3. Patent Owner's Reply Post-Remand Brief

No later than September 2, 2025, Patent Owner shall file a Reply Post-Remand Brief, not to exceed fifteen (15) pages in length, limited to rebutting the information presented in Petitioner's Responsive Post-Remand Brief. No new evidence may be filed in support of this brief.

4. Optional Hearing on the Privity Dispute

No later than September 4, 2025, the parties shall meet, confer, and jointly file a paper that presents their respective positions (or the parties' joint position if an agreement is reached) about whether the Board should conduct a telephonic hearing on the privity dispute. The joint paper shall provide times during the week of September 8, 2025, during which counsel for both parties are available for a teleconference, if one is requested.

C. Schedule Changes

The parties should contact the Board as soon as practical if any changes to the post-remand discovery and briefing schedules are necessary. Any changes to these schedules must be approved by the Board.

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ORDER

It is

ORDERED that post-remand discovery shall commence and be completed according to the parameters set forth herein;

FURTHER ORDERED that Patent Owner's Post-Remand Brief, Petitioner's Responsive Post-Remand Brief, and Patent Owner's Reply Post-Remand Brief shall be filed in compliance with the instructions set forth herein;

FURTHER ORDERED that the parties shall file a joint paper addressing the optional hearing on the privity dispute as set forth herein;

FURTHER ORDERED that any changes to the discovery and briefing schedules set forth herein must be approved by the Board.

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