PUBLIC VERSION

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CIRRUS LOGIC, INC.;
OMNIVISION TECHNOLOGIES, INC.;
Petitioners

v.

GREENTHREAD, LLC,
Patent Owner

Case: IPR2024-00016
U.S. Patent No. 10,510,842

PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW

[redacted]

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EXHIBIT LIST

Exhibit No.	Description	Submitted Previously?
Ex. 2001	*Greenthread, LLC v. Intel Corp.*, 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 (11th ed. 2019) available from Westlaw at westlaw.com	X
Ex. 2003	*Greenthread, LLC v. Intel Corp.*, 6:22-cv-00105-ADA, Dkt. 38 (First Amended Complaint for Patent Infringement) (W.D. Tex., filed Apr. 29, 2022)	X
Ex. 2004	*Greenthread, LLC v. Intel Corp.*, No. 6:22-cv-00105-ADA, Dkt. 113 (Redacted Memorandum Opinion and Order) (W.D. Tex. Dec. 27, 2022)	X
Ex. 2005	*Greenthread, LLC v. Intel Corp.*, 6:22-cv-00105-ADA, Dkt. 38-8 (Greenthread's Amended Preliminary Infringement Contentions) (W.D. Tex., filed Apr. 29, 2022)	X
Ex. 2006	*Greenthread, LLC v. Intel Corp.*, 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	*Greenthread, LLC v. Intel Corp.*, 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 *Sony Group Corp. v. Greenthread, LLC*, IPR2023-00376	X

[redacted]

Exhibit No.	Description	Submitted Previously?
Ex. 2009	*Greenthread, LLC v. Dell Inc.*, No. 6:22-cv-105-ADA, Dkt. 120 (Second Amended Complaint)	X
Ex. 2010	*Greenthread, LLC v. Intel Corp.*, 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	**[SEALED]** 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	**[SEALED]** 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	*Greenthread, LLC v. Cirrus Logic, Inc.*, No. 1:23-cv-00369 (Supplemental Preliminary Infringement Contentions) (W.D. Tex., served Oct. 13, 2023)	X

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Exhibit No.	Description	Submitted Previously?
Ex. 2019	*Greenthread, LLC v. Cirrus Logic, Inc.*, No. 1:23-cv-00369, Dkt. 29 (Scheduling Order) (W.D. Tex. Aug. 18, 2023)	X
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	*Greenthread, LLC v. Intel Corp.*, 6:22-cv-00105-ADA, Dkt. 120-8, Greenthread's Amended Preliminary Infringement Contentions (W.D. Tex., filed Jan. 23, 2023)	X
Ex. 2022	**[SEALED]** 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	*Greenthread, LLC v. OmniVision Technologies Inc.*; 2:23-cv-212, Dkt. 1 (Complaint) (E.D. Tex May 10, 2023)	X

[redacted]

Exhibit No.	Description	Submitted Previously?
Ex. 2028	**[SEALED]** Confidential declaration	X
Ex. 2029	*Greenthread, LLC v. OmniVision Technologies Inc.*, 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	**[SEALED]** 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	**[SEALED]** Confidential agreement	X
Ex. 2035	TechInsights Report on Sony Xperia 5111	X
Ex. 2036	TechInsights Report Ad	X
Ex. 2037	**[SEALED]** Email communication from Petitioner's counsel to Patent Owner's counsel dated between January 9, 2024 through January 10, 2024	X

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Exhibit No.	Description	Submitted Previously?
Ex. 2038	**[SEALED]** Email communication from Petitioner's counsel to Patent Owner's counsel dated between October 20, 2023 through October 31, 2023	X
Ex. 2039	*Greenthread, LLC v. Intel Corp.*, No. 6:22-cv-00105-ADA, Dkt. 7 (summons returned executed) (W.D. Tex. Feb. 7, 2022)	X
Ex. 2040	Petition (Paper 2) in *Sony Group Corp. v. Greenthread, LLC*, IPR2023-00324	X
Ex. 2041	Petition (Paper 3) in *Sony Group Corp. v. Greenthread, LLC*, IPR2023-00325	X
Ex. 2042	Petition (Paper 1) in *Sony Group Corp. v. Greenthread, LLC*, IPR2023-00375	X
Ex. 2043	*Greenthread, LLC v. OmniVision Technologies Inc.*; 2:23-cv-212 (OmniVision's Responses and Objections to Greenthread's Fourth Set of Common Interrogatories)	X
Ex. 2044	**[SEALED]** 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	**[SEALED]** Email communication to Petitioner's counsel attaching production dated June 30, 2023	X

[redacted]

Exhibit No.	Description	Submitted Previously?
Ex. 2048	*Greenthread, LLC v. Samsung Electronics Co., Ltd. et al*, EDTX-2-19-cv-00147, Dkt. 1 (Complaint) (E.D.Tex., April 30, 2019)	X
Ex. 2049	*Greenthread, LLC v. Samsung Electronics Co., Ltd. et al*, 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	**[SEALED]** 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

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This case cleanly presents an important and recurring legal question: Whether a petitioner satisfies its burden under § 315(b) when it puts no evidence in the record. *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1243–44 (Fed. Cir. 2018). The panel below abused its discretion by repeatedly and explicitly placing the § 315(b) burden on Patent Owner ("Greenthread"). Paper 30 at 17 ("Patent Owner does not … direct us to any evidence"); 19 ("Patent Owner does not direct us to any evidence …"); 23 ("Patent Owner does not direct us to evidence …"). Patent owners do not have the burden to prove that the Petition is timely. Petitioners have that burden.

On the record before the panel, a named real-party-in-interest ("RPI") to these proceedings, Global Foundries U.S., Inc. ("Global Foundries"), has <u>*the same relationship*</u> with Petitioner Cirrus Logic Inc. ("Cirrus Logic") as it has with time-barred party, Intel Corporation ("Intel"). Global Foundries is a custom manufacturer for both. Petitioners never differentiated their relationship with Global Foundries from Intel's relationship with Global Foundries. Therefore, if Global Foundries is an RPI here, it should have been in the prior litigation as well. Institution should have been denied accordingly. That is not what happened.

The panel's institution decision was contrary not only to *Worlds*, but also its own prior order in the proceeding. Greenthread had sought Global Foundries' contracts with Intel and Petitioners, to show that Global Foundries made previously accused products for Intel, and therefore plays the same role in both this case, and

the prior case against Intel. Paper 10 at 11. The panel denied Greenthread's request because—according to the panel—knowing what products Global Foundries made for Intel would not be "useful in determining whether … GlobalFoundries" is in privity with Intel. Paper 19 at 11-12. Then, in its institution decision, the panel said the *opposite*. Not only are the Global Foundries contracts "useful" in the privity analysis, the panel said that they are *essential*. The panel faulted Greenthread for not identifying "any particular product" that Global Foundries makes for Intel. Paper 31 at 17, 19. That was wrong, because it is not Greenthread's burden to identify a "particular product."

Worse, the panel's conflicting decision put Greenthread in a *Catch-22*. Greenthread does not know which specific products Global Foundries makes for Intel and, absent discovery, has no way to find out. Global Foundries *does* know which products it makes for Intel *and has never denied that it made the previously accused products for Intel*. Instead of simply ordering Petitioners to provide the information, the panel held that (1) Greenthread can't get the evidence, and (2) since Greenthread can't get the evidence, Petitioners' are deemed to have satisfied their burden under § 315(b). The result is that, *no matter what the evidence would show, the petitioner wins*.

Unless the Director steps in, this *Catch-22* will play out again and again. Petitioners will simply assert, as Petitioners did here, that their petitions are not time

barred, knowing that Patent Owners *cannot* and the Board *will not* scrutinize those claims, even when the record suggests that the claims are inaccurate. The panel decision should be reversed.

I. BACKGROUND

Dr. Mohan Rao is Greenthread's founder and inventor on the challenged patents. After earning a Ph.D. in India where he was raised, Dr. Rao immigrated to the United States in the 1970s. In America, Dr. Rao earned a *second* Ph.D., studying under Nobel Prize winner Jack Kilby. Ex 2001, ¶39. Dr. Rao then spent several decades at Texas Instruments ("TI"), rising to become one of 12 Senior Fellows out of TI's 20,000 engineers. *Id.* ¶40. Some of Dr. Rao's work at TI is featured in the Smithsonian and he is a named inventor on over 100 U.S. patents. *Id.* ¶42. After leaving TI, Dr. Rao continued his inventive work at several companies he founded, including Greenthread. Greenthread owns a family of patents titled "Semiconductor Devices with Graded Dopant Regions," for which Dr. Rao is the sole inventor and which Greenthread has licensed to seven different companies, including two without litigation. *See, e.g.*, Exs. 2027, ¶¶ 26-39; 2022; 2028; 2047.

Relevant here, on February 3, 2022 Greenthread served Intel with a complaint alleging infringement of the challenged patents. Ex. 2001; 2039. Greenthread and Intel settled their dispute and Greenthread granted Intel a license to the challenged patents, by way of sublicense through RPX Corp. Ex. 2022. Among other things,

Greenthread granted Intel the right to "have made" by others licensed products. Greenthread also granted a limited sublicense to Intel's "have made" vendors, such as Global Foundries. Ex. 2022, 2-3.

A. Global Foundries relationship with Intel and Cirrus Logic.

The undisputed record shows that Global Foundries has a pre-existing substantive relationship with Intel that, on the current record, is no different than its relationship with Petitioner Cirrus Logic. Global Foundries publicly says that it manufactures products for both time-barred Intel and Petitioner Cirrus Logic. Ex. 2014, 19, 73. Here, Greenthread has accused products Global Foundries makes for Cirrus Logic in the District Court[1] and Petitioners admit that Global Foundries' relationship with Cirrus Logic regarding these products makes it an RPI. Pet. at 1.

The products Global Foundries makes are not off-the shelf commodities, but "highly complex and sophisticated" microprocessors. Global Foundries' products are made to its customers' specifications. It describes itself as a "pure-play foundry" which is "focuse[d] on producing ICs for other companies, rather than those of its own design." Ex. 2033 at 12, 35. Additionally, Global Foundries' investor disclosures state that "many of [Global Foundries] agreements with [its] customers … require [Global Foundries] to defend such parties against certain intellectual

[1] *See Greenthread LLC v. Cirrus Logic Inc.*, 23-cv-00369 (W.D. Tex.) Dkt. 1-8 at 59 (reverse engineering report showing "Die foundry" as "Global Foundries").

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property infringement claims and indemnify them for damages." Ex. 2033, 40. Finally, it is undisputed that Global Foundries acts as Intel's "have made" vendor and sublicensee under Greenthread's license to Intel. Ex. 2022, 2-3. Greenthread has searched public information exhaustively to determine whether Global Foundries makes any of the Intel products it previously accused, but has found no information one way or the other. Petitioners will neither confirm nor deny that Global Foundries makes the Intel products that were accused in the prior litigation.

B. Proceedings Below

On October 11, 2023, Petitioners filed the instant Petition which did not substantively address their timeliness or Petitioners' relationship with any time-barred party. Shortly thereafter, Greenthread notified Petitioners that Global Foundries' relationship with Intel (and others) created a time bar under § 315(b). Ex. 2038, at 7-8. Petitioners refused to provide any discovery or withdraw its petition. *Id.* at 1, 6. On November 1, 2023 Greenthread emailed the Board requesting permission to file a motion seeking discovery of Global Foundries' contracts with Intel and its communications with Intel regarding the design of the products it makes for Intel. Ex. 1045. The same day, a Board paralegal responded "There are no judge panels assigned to the above-referenced cases. Your e-mail will be shared with the judge panel(s) once assigned." *Id.*

Seven weeks later, the panel authorized Greenthread to file its motion. *Id.* Greenthread filed its motion the next day. Paper 10. On January 24, 2024, Greenthread filed its POPR, which focused exclusively on § 315(b). After seeing Greenthread's POPR, Petitioners requested a preliminary reply and the opportunity to present additional evidence on the timeliness of its petition. The Board authorized Petitioners to file "a preliminary reply *and supporting evidence*." Petitioners filed their preliminary reply, with ten pages of attorney argument, *but no evidence*. *See* Paper 20 (Petitioner's Reply to Patent Owner's Preliminary Response). Petitioners' *did not deny* that Global Foundries made the Intel products accused in the prior litigation or that Global Foundries had the same indemnity obligations in that case, as here.[2]

On January 26, 2024, three months after Greenthread had filed its discovery motion, the Panel denied Greenthread's motion *in toto*. Paper 19. The panel said

[2] Petitioners offered to put in a declaration about their communications with Intel, but never did. Paper 20 at 4. *Worlds* instructed that the Board may not rely on hypothetical declarations described by attorneys. Bluntly, "Attorney argument is not evidence." 903 F.3d at 1246. If Petitioners' *had* put in a declaration then Greenthread could have deposed the declarant, which may be why Petitioners described a hypothetical declaration rather than submitting an actual declaration. Regardless, the hypothetical declaration Petitioners described should not change the outcome here, because it did not describe the products Global Foundries makes for Intel or the nature of Global Foundries' contracts with Intel and Cirrus Logic. *Id.*

that the requested discovery would not "be useful in determining whether Petitioners or Global Foundries have a close relationship with … Intel." Paper 19, 13.

On April 23, 2024, the panel issued decisions instituting IPR of the challenged patents. Paper 30. Regarding the timeliness of the petition, the panel repeatedly faulted Greenthread for "not direct[ing] us to any evidence" regarding the specific products Global Foundries makes for Intel and Cirrus Logic and the specific terms on which it makes them. *E.g.*, Paper 19 at 17, 18, 22. The panel did not reconcile this statement with its earlier denial of Greenthread's discovery motion or its holding that the information would not "be useful in" the privity analysis. Paper 19, 13.

II. LEGAL STANDARD

A party may seek Director Review of a panel's institution decision for "(a) an abuse of discretion or (b) important issues of law or policy." Revised Interim Director Review Process 2.B. "An abuse of discretion may be established by showing that the [panel] made a clear error of judgment in weighing relevant factors or exercised its discretion based upon an error of law or clearly erroneous factual findings." *Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1350 (Fed. Cir. 2001).

III. ARGUMENT

Director Review is appropriate. The panel below abused its discretion by placing the burden of proof regarding the timeliness of the petition on Greenthread.

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A. The panel misapplied the burden of proof.

Customer-supplier/manufacturer relationships *can* and *do* create privity under § 315(b). *E.g.*, *Ventex Co., Ltd. v. Columbia Sportswear N. Am., Inc.,* IPR2017-00789, Paper 148 at 14, (PTAB Jan. 24, 2019) (precedential)*; Volkswagen Grp. of Am. Inc. v. Argina Tech. Ltd.*, IPR2021-01263 Paper 16 (PTAB Jan. 21, 2022). Indeed, *this case* is an example of a customer-manufacturer relationship creating privity. Global Foundries is Cirrus Logic's manufacturer and Petitioners admit that Global Foundries is an RPI to these proceedings.

All the evidence in the record indicates that Global Foundries has *the same* relationship with Cirrus Logic as with Intel, including the same indemnification obligations. Exs. 2014, 19, 73; 2033, 40.[3] Petitioners "bear[] the ultimate burden of persuasion to show that its petitions are not time-barred under § 315(b)." *Worlds*, 903 F.3d at 1242. Therefore, Petitioners' failure to differentiate the Cirrus Logic-Global Foundries relationship from the Intel-Global Foundries relationship, combined with the admission that Global Foundries is an RPI here, dooms the petition.

In cases where a petitioner fails to come forward with relevant evidence, the Board has said that the "lack of evidence" "cuts against the party bearing the burden

[3] Even if, on a full record, Global Foundries was not an RPI to the prior proceedings, but merely in privity with Intel, institution should have been denied.

of proof on these issues." *Ventex Co., Ltd. v. Columbia Sportswear N. Am., Inc.*, IPR2017-00789, Paper 148 at 14 (PTAB Jan. 24, 2019) (precedential). For example, in *Volkswagen Grp. v. Argina Tech. Ltd.*, IPR2021-01263 Paper 16 at 10 n.4. (PTAB Jan. 21, 2022), the Board said that when a customer "has not produced its agreement with" its supplier, the Board can infer "that the agreement does not support [the petitioner] in meeting its burden" regarding timeliness. The Federal Circuit has also said that "[f]ailure to prove the matter as required by the applicable standard 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). Here, the panel's institution decision does the exact opposite of what these binding precedents require. The panel held that the absence of documents "cuts against" Greenthread, who does not have the burden of proof, and repeatedly faulted Greenthread for failing to cite to evidence that only Global Foundries, Intel, or Cirrus Logic possess.

First, the panel acknowledged that "[a]n agreement by a petitioner to indemnify a third party in an earlier infringement suit can give rise to a privity relationship between the petitioner and that third party." Paper 30 at 22. Greenthread pointed to Global Foundries' statement in its annual report that that "many of [Global Foundries] agreements with [its] customers … require [Global Foundries] to defend such parties against certain intellectual property infringement

claims and indemnify them for damages." Ex. 2033, 40. However, instead of faulting Petitioners for failing to come forward with Global Foundries' agreements, the panel faulted *Greenthread* for "not explain[ing] why the [indemnity] terms and conditions to which it directs us" create privity. Paper 30 at 22. Offering that explanation is Petitioners' burden, not Greenthread's. Petitioners, not Greenthread, have the documents that would offer the explanation the Board said was missing. Greenthread asked the panel to compel Petitioners to produce those documents, but the panel denied Greenthread's motion. Paper 19 at 15-16.

Greenthread also argued that Global Foundries is in privity with Intel, because it acts as Intel's manufacturing agent and exercises Intel's rights under a license to Greenthread's patents. Again, the panel shifted the burden to Greenthread. As with indemnity, the panel acknowledged that an agent-principal relationship creates privity. *Id.* at 15. The panel cited Federal Circuit authority that manufacturing "equipment based on information and instructions provided by" another party is "suggestive of an agency relationship." *Id.* (citing *In re Google LLC*, 949 F.3d 1338, 1345 (Fed. Cir. 2022)). Finally, the panel also acknowledged that Global Foundries "produc[es] ICs for other companies, rather than those of its own design." *Id.* at 17.

Nevertheless, the panel said that Greenthread's argument "lacks factual support in the record," because Greenthread did not point to "any *particular* product," Global Foundries made for Intel. Paper 30 at 17-18. (emphasis added).

Again, it is Petitioner's burden to point to "factual support in the record," not Greenthread's. Moreover, even if Greenthread had such a burden, Greenthread moved for discovery to provide "factual support in the record," which the panel denied. Only Global Foundries knows what products it makes for Intel and if Global Foundries chooses not to say, it should "cut[] against" Petitioners, because they have the evidence. *Ventex*, IPR2017-00789, Paper 148 at 14 (precedential).[4]

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[4] Although the panel seemed to acknowledge that a principal-agent relationship creates privity, it also said, that "the case law cited by Patent Owner does not apply," because in those cases "the alleged privy was the party asserting a defense of res judicata or collateral estoppel, not the party against whom collateral estoppel was asserted." Paper 30 at 16. But, the legal standard for privity does not depend on who is making the argument and the panel did not otherwise distinguish the mountain of case law holding that a principal and agent are in privity "if the prior [lawsuit] concerned a matter within the agency.'" *Herrion v. Children's Hosp. Nat. Med. Ctr.*, 448 F. App'x 71, 73 (D.C. Cir. 2011); *see, e.g.*, *Herrion v. Children's Hosp. Nat. Med. Ctr.*, 786 F. Supp. 2d 359, 371 n.9 (D.D.C.) (citing cases from the Supreme Court, First, Second, Third, Fifth, Sixth, Seventh, Ninth, Eleventh, and D.C. Circuits); *see also* Paper 16 at 22-25. Here, a key issue is whether products Global Foundries makes were at issue in the prior suit, which is "a matter within the agency." The panel's suggestion (without explanation) that a different standard of privity applies in a § 315(b) analysis was wrong. The Board has long applied the general common law standard described in the cases Greenthread cited.

The panel also suggested that, to establish privity, Greenthread needed to show that Global Foundries controlled Intel's prior litigation with Greenthread. *Id.* at 15. Assuming control of the prior litigation is an essential element of privity (it is not) *Petitioners* should have to come forward with evidence regarding control, not Greenthread. Regardless, the panel's argument started from the wrong premise. Control over prior litigation is <u>*sufficient*</u>, but not <u>*necessary*</u> to establish privity. *Taylor v. Sturgell*, identifies a "pre-existing 'substantive legal relationship'" (like the Intel-Global Foundries relationship) as <u>*one*</u> reason to find privity and litigation via "proxy" or "control over the [prior] litigation" as a <u>*different*</u> reasons to find privity. 553 U.S. at 894-95 (cleaned up.). "Preclusion is

[redacted]

B. Intervention by the Director is necessary to bring uniformity to the application of § 315(b).

By refusing to look at the relevant contracts the panel here set itself apart from the rest of the Board. Greenthread is not aware of any post-*Worlds* cases (except cases involving Greenthread) in which the Board found that a petitioner in a customer-manufacturer relationship with a time barred party had met its § 315(b) burden without having the relevant contracts in the record. In *WesternGeco LLC v. ION Geophysical Corp*., "the Board reviewed the purchase agreements as well as relevant business correspondence." 889 F.3d 1308, 1321 (Fed. Cir. 2018). In *Samsung Electronics Co. Ltd. v. Netlist Inc.*, the Board likewise examined "indemnification correspondence" and the actual contracts. IPR2022-00615, Paper 64 at 14-15 (PTAB Jun. 30, 2023). The panel relied on *Wi-Fi One, LLC v. Broadcom Corp.* 887 F.3d 1329, 1340 (Fed. Cir. 2018), but that case is irrelevant, as it was decided before *Worlds* <u>*and*</u> before the Director's decision in *Samsung v. Netlist*, IPR2022-00615, Paper 40 (Dir. Vidal Feb. 3, 2023). The panel here created a split of authority at the Board and clear guidance from the Director is necessary.

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extended or denied in an effort to protect conflicting property interests [like patent rights] *rather than an effort to implement concepts of participation or representation.*" Wright & Miller (3d ed.) § 4448 Persons Affected by Preclusion (emphasis added). The Board has rejected the argument that the petitioner was not in privity when it "was not placed on notice of the infringement" previously and could not "control the [prior] District Court litigation." *Bungie Inc. v. Worlds Inc.*, IPR2015-01264, Paper 64 at 38, 44 (PTAB Jan. 14, 2020).

[redacted]

C. Intervention by the Director is necessary to ensure the fairness of AIA proceedings.

Not only uniformity, but fairness is at stake in this petition for Director Review. Petitioners have never denied that Global Foundries *does* make products for Intel that were accused in the prior litigation or that Global Foundries does make products accused in the instant litigation. Petitioners' failure to deny these facts is telling—and provides a roadmap for future petitioners. If the facts on privity are questionable for a petitioner, then silence, even when you bear the burden of proof, will be a winning strategy.

Even Greenthread's extensive research into all publicly available information about Global Foundries relationships couldn't meet the burden the panel's decision places on patent owners. If the panel's view of the law prevails, § 315(b) will be practically irrelevant. Patent owners will virtually never have the kind of fine grain information the panel required here, *just to get discovery*. Petitioners will know that staying silent will likely carry the day, even if, on a full factual record, they may lose. Petitioners' superior "access evidence relevant to the real-party-in-interest inquiry" is part of why petitioners bear the burden of proof. *Worlds*, 903 F.3d at 1243. The Director should apply the burden as the only way to make § 315(b) enforceable.

[redacted]

IV. CONCLUSION

For the foregoing reasons, the Director should reverse the panel's institution decision. In the alternative, the Director should vacate the institution decision and remand for a new decision following discovery.

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Respectfully submitted,

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CERTIFICATION OF SERVICE

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