IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CIRRUS LOGIC, INC.;
OMNIVISION TECHNOLOGIES, INC.; AND
AMS-OSRAM USA INC.,
Petitioner,

v.

GREENTHREAD, LLC,
Patent Owner.

Case No. IPR2024-00017
Patent No. 8,421,195

JOINT MOTION TO TERMINATE PROCEEDING AS TO AMS-OSRAM USA INC. UNDER 35 U.S.C. § 317 AND 37 C.F.R. § 42.72, 42.74

I. STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72 and 42.74, Petitioner ams-OSRAM USA Inc. and Patent Owner Greenthread LLC jointly move to terminate the present *inter partes* review proceeding as to Petitioner ams-OSRAM as a result of a Settlement and License Agreement ("the Settlement Agreement"). The Settlement Agreement completely resolves all pending controversies between ams-OSRAM and Greenthread concerning the Challenged Patent.

Petitioners Cirrus Logic, Inc. and OmniVision Technologies Inc. do not object to this request.

ams-OSRAM and Greenthread are concurrently filing a true copy of their written Settlement Agreement under 37 C.F.R. § 42.74(b). ams-OSRAM and Greenthread further jointly certify that there are no other agreements, or understandings, oral or written, between them, including any collateral agreements, made in connection with, or in contemplation of, the termination of ams-OSRAM from this proceeding as set forth in 35 U.S.C. § 317(b).

II. STATEMENT OF FACTS

Greenthread asserted the Challenged Patent against ams-OSRAM on April 19, 2023 in *Greenthread v. OSRAM GmbH et al.*, Case No. 2:23-cv-00179 (E.D. Tex.). This petition was filed in October 2023 and no institution decision has been made.

On March 27, 2024, ams-OSRAM and Greenthread entered into a Settlement and License Agreement all pending controversies between the two parties.

III. GOOD CAUSE EXISTS TO TERMINATE THE ABOVE-CAPTIONED IPR AS TO AMS-OSRAM USA INC.

Under 35 U.S.C. § 317(a), "[a]n *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed." Similarly, under 37 C.F.R. § 42.72, "[t]he Board may terminate a trial without rendering a final written decision, where appropriate . . . pursuant to a joint request under 35 U.S.C. 317(a)." Termination of this IPR as to ams-OSRAM is appropriate because ams-OSRAM and Greenthread have settled their dispute concerning the Challenged Patent and the Board has not made any decision on the merits of the proceeding. Therefore, under 35 U.S.C. § 317(a), the Board should terminate this proceeding with respect to ams-OSRAM.

IV. CONCLUSION

For the foregoing reasons, ams-OSRAM and Greenthread respectfully request that the Board grant this Joint Motion to Terminate the above-captioned IPR proceeding as to ams-OSRAM. ams-OSRAM and Greenthread also request that the Board grant their Joint Motion to File the Settlement Agreement under seal as business confidential and keep it separate.

Dated: April 10, 2024

Respectfully Submitted,

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CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. § 42.6(e), the undersigned certifies that on April 10, 2024, a complete and entire copy of this Joint Motion To Terminate Proceeding as to ams-OSRAM USA Inc., was served on Patent Owner electronically via email to counsel for the Patent Owner:

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