PUBLIC VERSION

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CIRRUS LOGIC, INC.;
OMNIVISION TECHNOLOGIES, INC.;
AND AMS SENSORS USA INC.,
Petitioner,
v.

GREENTHREAD, LLC,
Patent Owner.

IPR2024-00017
U.S. Patent No. 8,421,195

PATENT OWNER'S PRELIMINARY RESPONSE PURSUANT TO 35 U.S.C. § 313 AND 37 C.F.R. § 42.107

[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

[redacted]

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

[redacted]

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)	
Ex. 2040	Petition (Paper 2) in *Sony Group Corp. v. Greenthread, LLC*, IPR2023-00324	
Ex. 2041	Petition (Paper 3) in *Sony Group Corp. v. Greenthread, LLC*, IPR2023-00325	
Ex. 2042	Petition (Paper 1) in *Sony Group Corp. v. Greenthread, LLC*, IPR2023-00375	
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)	
Ex. 2044	**[SEALED]** Email communication from Petitioner's counsel to Patent Owner's counsel dated between November 28, 2023 through December 6, 2023	
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	
Ex. 2046	Email communication to Petitioner's counsel attaching production dated October 5, 2023	
Ex. 2047	**[SEALED]** Email communication to Petitioner's counsel attaching production dated June 30, 2023	

[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)	
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)	
Ex. 2050	**[SEALED]** Correspondence from Patent Owner's counsel to Petitioner's counsel dated May 4, 2023	
Ex. 2051	Webpage from DigiKey for Cirrus Logic CS35L41 (https://www.digikey.com/en/products/detail/cirrus-logic-inc/CS35L41-CWZR/16377919)	
Ex. 2052	Webpage from DigiKey for Cirrus Logic CS40L25 (https://www.mouser.com/ProductDetail/Cirrus-Logic/CS40L25-CWZR?qs=xZ%2FP%252Ba9zWqYWfeisEtcaTA%3D%3D)	
Ex. 2053	Webpage from Mouser for Cirrus Logic CS40L25 (https://www.mouser.com/ProductDetail/Cirrus-Logic/CS40L25-CWZR?qs=xZ%2FP%252Ba9zWqYWfeisEtcaTA%3D%3D)	
Ex. 2054	Webpage from ArduCam for OmniVision OV9282 (https://www.arducam.com/product/ov9282-monochrome-globalshutter-camera-module-depthai-oak/)	
Ex. 2055	Webpage from Uctronics for OmniVision OV9282 (https://www.uctronics.com/ov9282-monochrome-global-shutter-camera-module-depthai-oak.html)	

[redacted]

I. INTRODUCTION

Greenthread, LLC ("Patent Owner," "PO," or "Greenthread") submits this Preliminary Response in accordance with 35 U.S.C. § 313 and 37 C.F.R. § 42.107, responding to the Petition for *Inter Partes* Review ("Petition," Paper 1) of U.S. Patent No. 8,421,195 ("the Challenged Patent") filed by OmniVision Technologies Inc., ("OV"), AMS Sensors UA Inc., ("AMS"), Cirrus Logic, Inc ("CL") (collectively OV, AMS, and CL and the identified real parties in interest to the Petition are "Petitioners"). This Petition is one of seven petitions Petitioners have filed against the Greenthread Patents,[1] which claim priority from the same original application. (Collectively all of Petitioners' petitions against Greenthread's patents are "the Petitions"). Each of the Petitions name GlobalFoundries U.S., Inc. ("GF") and two AMS affiliates as real parties in interest.

Each Petition addresses timeliness with only Petitioners' unsupported and unexplained assertion that "Petitioner [sic] is not barred or estopped from requesting

[1] IPR2024-00016 (U.S. Pat. No. 10,510,842); IPR2024-00001 (U.S. Pat. No. 10,734,481); IPR2024-00017 (U.S. Pat. No. 8,421,195); IPR2024-00018 (U.S. Pat. No. 9,190,502); IPR2024-00019 (U.S. Pat. No. 11,316,014); IPR2024-00020 (U.S. Pat. No. 11,121,222); IPR2024-00021 (U.S. Pat. No. 11,121,222).

[redacted]

IPR of the Challenged Claims." Paper 1 at 5. All of the Petitions should be dismissed because they are untimely.

Immediately after being served with the first three Petitions, Greenthread notified Petitioners that it disputed the Petitions' timeliness. Greenthread provided specific evidence and argument supporting its position, including the fact that Petitioners are operating as sub-licensees of time-barred parties. Petitioners responded that the single conclusory sentence in their Petitions regarding timeliness "demonstrate[s] that the petitions are not time barred." Ex. 2011, 1. Petitioners offered no further evidence or explanation to support their claim.

Then, Petitioners filed *four more* Petitions with the same unsupported conclusory statement regarding the Petitions' timeliness. In other words, Petitioners made the *knowing* decision to provide *no* evidence and *no* argument that the Petitions are timely, even after seeing Greenthread's position. Even after Greenthread moved to compel the production of relevant evidence, Petitioners *still* failed to provide any evidence at all. Since Petitioners deliberately chose to ignore a disputed issue on which they bear the burden of proof, the Board should dismiss the Petitions.

Should the Board choose to consider the merits of the Petitions' timeliness—which it should not do in light of Petitioners' decision to ignore the issue entirely—the Board should find that the Petitions are not timely, because Petitioners are in privity with three time-barred parties: [redacted]"),

[redacted]

Intel Corporation ("Intel"), [redacted] or their affiliates (collectively "Licensees"). All three companies are time-barred and licensed to Greenthread's patents. Petitioners manufacture custom products for Licensees and operate as limited sub-licensees to the Greenthread Patents by virtue of Petitioners' contracts with Licensees.

By making custom licensed products for Licensees, Petitioners step into their shoes, and serves as their "agent," by exercising Licensees "have made" rights under the license. Petitioners and Licensees also become "preceding and succeeding owners of" licensed (or infringing) products. Moreover, Petitioners apparently indemnify the time-barred parties for these custom goods. Finally, a number of the products accused in the current district court proceedings were also at issue in the prior litigation with Licensees that gave rise to the time bar. Thus, Petitioners have a "pre-existing substantive legal relationship" with Licensees giving rise to privity. *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1360 (Fed. Cir. 2018) (hereinafter "*AIT*").

II. BACKGROUND

A. Prior Litigation Involving the Challenged Patents

1. [redacted] Litigation

On April 30, 2019, Greenthread filed a complaint against [redacted] in the Eastern District of Texas alleging infringement of the '195 patent, the '502 patent,

and other patents not at issue in the Petitions. On July 8, 2020, Greenthread and settled the litigation and Greenthread granted a license to as described below.

2. Intel- - Litigation

On February 1, 2022, Greenthread served Intel and . and with a complaint filed in the Western District of Texas alleging infringement all of the Challenged Patents, except the '014 patent. Ex. 2001 (Complaint), 1-4; Ex. 2039 (Returned Summons). After the '014 patent issued, Greenthread filed a First Amended Complaint against and Intel which it served via ECF on April 29, 2022. Ex. 2003. The cases against Intel and were severed and the case against Intel was transferred to the District of Oregon. Ex. 2004, 22. The litigation remained in Texas and continued in parallel with the *Intel* litigation.

was a real-party-in-interest to the litigation. Greenthread's allegations in the First Amended Complaint against (i.e. the April 29 complaint) were based on, among other things, components in products. Ex. 2003, ¶¶18, 60, 76-81; Ex. 2005, 8 ("Accused Products"), 18-20 (section entitled Accused Products"); Ex. 2006, 1-34. After Greenthread served the April 29 complaint accusing products, additional counsel stepped in to represent with respect to products. Ex. 2007. then filed its own

IPRs against the Challenged Patents that had been asserted against products. Ex. 2008 (IPR2023-00376, Petition), Ex. 2040 (IPR2023-00324, Petition), Ex. 2041 (IPR2023-00325, Petition), Ex. 2042 (IPR2023-00375, Petition). The petitions named as a real-party-in-interest. *E.g.*, Ex. 2008, 7; Ex. 2040, 7; Ex. 2041, 7; Ex. 2042, 8. Afterwards, Greenthread added as a party to the litigation. Ex. 2009. After was added to the case, counsel for products appeared in the case for . Ex. 2010. other counsel did not represent . Greenthread and Intel, settled their disputes and Greenthread granted and Intel licenses as described below.

3. Greenthread Licenses to , Intel, and

As part of the settlements, Greenthread granted , Intel, and releases for past infringement and a license to Greenthread's patents, by way of sublicense through RPX Corporation ("RPX") ("Licenses"). Ex. 2022, 2. Greenthread licensed (and two other companies) in one agreement signed July 8, 2020. Ex. 2034. Greenthread signed the second agreement, licensing and Intel and , on April 7, 2023. Ex. 2022. The two agreements are similar in all relevant respects. In a parallel IPR, RPX submitted an affidavit stating: "By operation of their membership agreements with RPX, Intel and acquired the full scope of sublicensable rights Greenthread granted to RPX at the time the RPX-Greenthread Agreement was executed." Ex. 2028.

[redacted]

The Licenses grant Licensees (i.e. [redacted], Intel, and [redacted], via RPX) the right "to make, have made, use, have used, sell, … offer for sale, have offered for sale, have sold, … import, have imported, own, order, … purchase, … obtain, keep, acquire, receive, … and otherwise exploit or dispose of any Licensed Product and Service." Ex. 2022, 3 (definition of "Patent License"); Ex. 2034, 3 (definition of "Patent License"); *see also* Ex. 2028.

The Licenses define "Licensed Product and Service" to include "any product … made, have made, used, purchased, provided, hosted, sold, leased, licensed, distributed, transmitted, exported, imported or offered for sale, lease, or import or otherwise exploited or disposed of by or on behalf of" Licensees. Ex. 2022, 2; Ex. 2034, 2.

The Licenses cover all of Greenthread's patents, including the Challenged Patent. *See* Ex. 2022, 3-4 ("'Patents' shall mean ….") and 17 (listing patents); *see also* Ex. 2034, 3 ("'Patents' shall mean ….") and 15 (listing patents).

Accordingly, "any product" Licensees "have made" by Petitioners or "purchase" from Petitioners is a "Licensed Product or Service" which Licensees have the right to "use, … sell, … obtain, … acquire, … receive, … and otherwise exploit." Ex. 2022, 2-3; *see also* Ex. 2034, 2-3.

[redacted]

B. Petitioners' Relationship with Patent Owner's Licensees and the Co-Pending District Court Proceedings

Patent Owner is currently involved in district court litigation against CL, OV, and AMS. Each of the district court actions was filed before any of these petitions was filed.

1. Cirrus Logic

a. Litigation against Cirrus Logic

On March 31, Greenthread filed a complaint in the U.S. District Court for the Western District of Texas alleging that CL infringes each of the Challenged Patents. Greenthread's preliminary infringement contentions identified, among other products, CL's CS35L41, CS40L25 and CS42L42. Ex. 2018, 4.

Under the scheduling order in the Cirrus Logic litigation, discovery does not open until after the *Markman* hearing, which has not yet occurred. Greenthread has not had the opportunity to obtain any discovery in district court relevant to whether these petitions are time barred. Greenthread has served only preliminary infringement contentions in the district court. Ex. 2018. Greenthread's final infringement contentions are not due until March 21, 2024. Ex. 2019, 2.

b. Accused CL product sales overlap with prior litigation.

[redacted] and [redacted] are major CL customers. A CL investor presentation lists [redacted] and [redacted] as among its "Tier One Customers." Ex. 2013, 5.

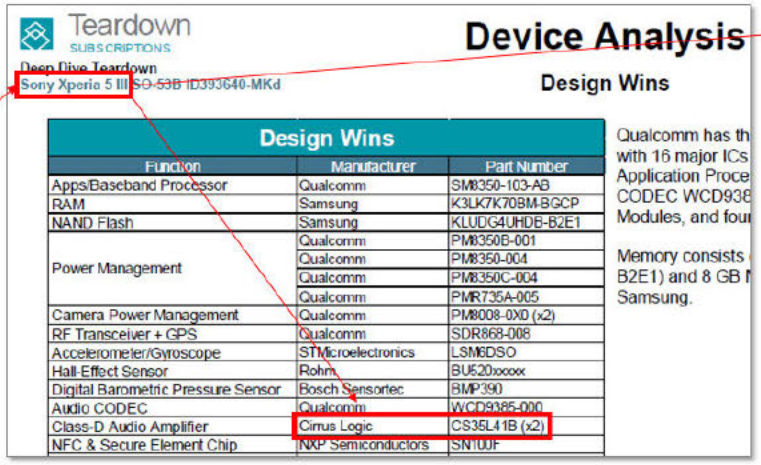
[redacted]

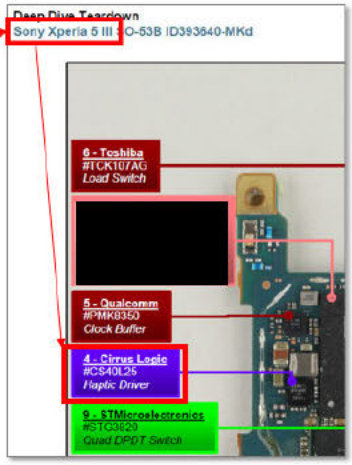
In 2022, [redacted] published a list of its suppliers, confirming that Cirrus Logic "agreed to be disclosed" as a supplier. Ex. 2045, 1.

Cirrus Logic chips, including those currently accused, are incorporated into numerous [redacted] products, including products accused in the *Sony* litigation. For example, CS35L41 and CS40L25 are both currently accused, Ex. 2018 at 4, and both are components of the [redacted] handset, which was accused in the *Sony* litigation. Compare Ex. 2021, 17-18 with Ex. 2035 at 2, 10, 63, 64 with Ex. 2018 at 4.

[redacted]

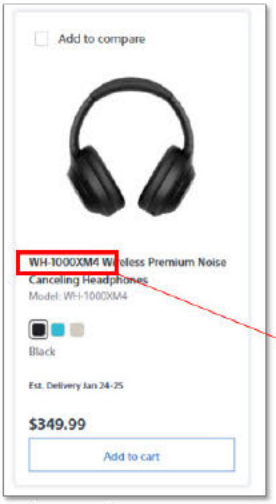
Sony Complaint
(Ex. 2021 at 17)



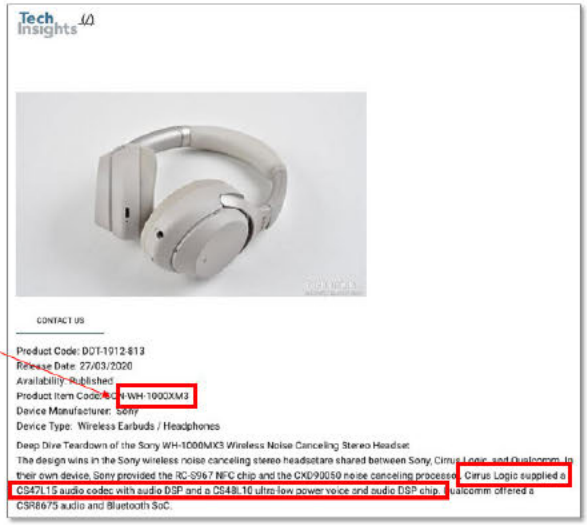


Xperia Teardown (Ex. 2035 at 2, 63)

The previously accused [redacted] also includes two CL audio codec chips. Greenthread has not yet obtained discovery regarding these chips. However, Greenthread has accused other CL audio codec chips, such as CS42L42, and may accuse these chips once it obtains discovery.



[redacted] Complaint
(Ex. 2021 at 17)



WH-1000XM Teardown (Ex. 2036)

On August 2, 2023, Cirrus Logic announced that it "is collaborating with industry leader[] Intel" to make its CS42L43 product a part of an "Intel® reference

[redacted]

design." Ex. 2020, 1. Cirrus Logic has yet not made public the "Intel reference design" or any technical information on the CS42L43. That information has not been produced in discovery either. The CS42L43 is the apparent next generation of the currently accused CS42L42. Ex. 2018 at 4. Accordingly, Greenthread may accuse the CS42L43 once it obtains discovery.

c. Cirrus Logic works closely with and indemnifies Licensees.

CL says that its "engineers work closely with" product teams at electronics manufacturers to make "custom" products. Ex. 2025. CL's standard sales agreements include indemnification of its customer. Ex. 2026, 1, 4-5. CL admits that it indemnifies Licensees, but claims that the indemnification arrangement is not "straightforward." Paper 11, 8.

d. Cirrus Logic admits to being a sub-licensee under the Licenses.

After CL received the [redacted] license, CL has insisted that some of its products are licensed, because they are manufactured by one of the other companies licensed in that agreement. CL says it "intend[s] to continue treating the product as a licensed product." Ex. 2037, 1.

[redacted]

2. OmniVision

a. Litigation against OmniVision

On May 10, 2023, Greenthread filed a complaint in the U.S. District Court for the Eastern District of Texas alleging that OmniVision infringes the Challenged Patents. Ex. 2027. On July 6, 2023, Greenthread served its infringement contentions identifying, among other OmniVision products, the OV9282 and OV7261 image sensors. Ex. 2029, 6, 8.

b. Accused OV Product sales overlap with prior litigation.

The [redacted] was an accused product in the [redacted] litigation. Ex. 2021, 18. The currently accused OV7261 is a component of the [redacted]

[2] Greenthread here cites a public advertisement from the reverse engineering firm TechInsights regarding its report on the [redacted], which states that the report shows [redacted] using "[t]wo B&W cameras by OmniVision." Ex. 2030, 1. Greenthread understands that this refers to the OV7261, however, obtaining the full report would cost $25,000.

[redacted]

[redacted] Accused products that are gaming products include [redacted] Playstation 4, and associated perhieral equipment.

Sony Complaint
(Ex. 2021 at 18)

Deep Dive Teardown of the [redacted] CFI-ZVR1 VR Headset

(https://library.techinsights.com/reverse-engineering/analysis-view/DDT-2303-806?web)

Share This Post

The Sony PlayStation VR2 is a second-generation VR headset by Sony, dedicated for use with PlayStation consoles. The second generation features higher resolution displays with a 10% wider Field-of-view than the first generation.
For the first time, Sony used internal and external IR cameras. Two B&W cameras by OmniVision, with an IR emitter LEDs set, are placed in the display assembly for eye-tracking functionality. Four IR external cameras were placed in front of the headset to observe the surroundings and track body movement and were equipped with a Sony sensor. Both controllers have a set of IR emitter LEDs, which allow hand and finger tracking with IR cameras.

[redacted] (Ex. 2030)

OmniVision also sells the accused OV9282 to Intel who incorporates it into its RealSense D400 series stereo vision depth camera system. Ex. 2015, 34.

Table 3-13. Wide Left and Right Imager Properties

Parameter	Camera Sensor Properties
Image Sensor	OmniVision OV9282
Active Pixels	1280 X 800
Sensor Aspect Ratio	8:5

Intel Realsense Datasheet (Ex. 2015 at 34)

c. OV claims the benefit of the Licenses.

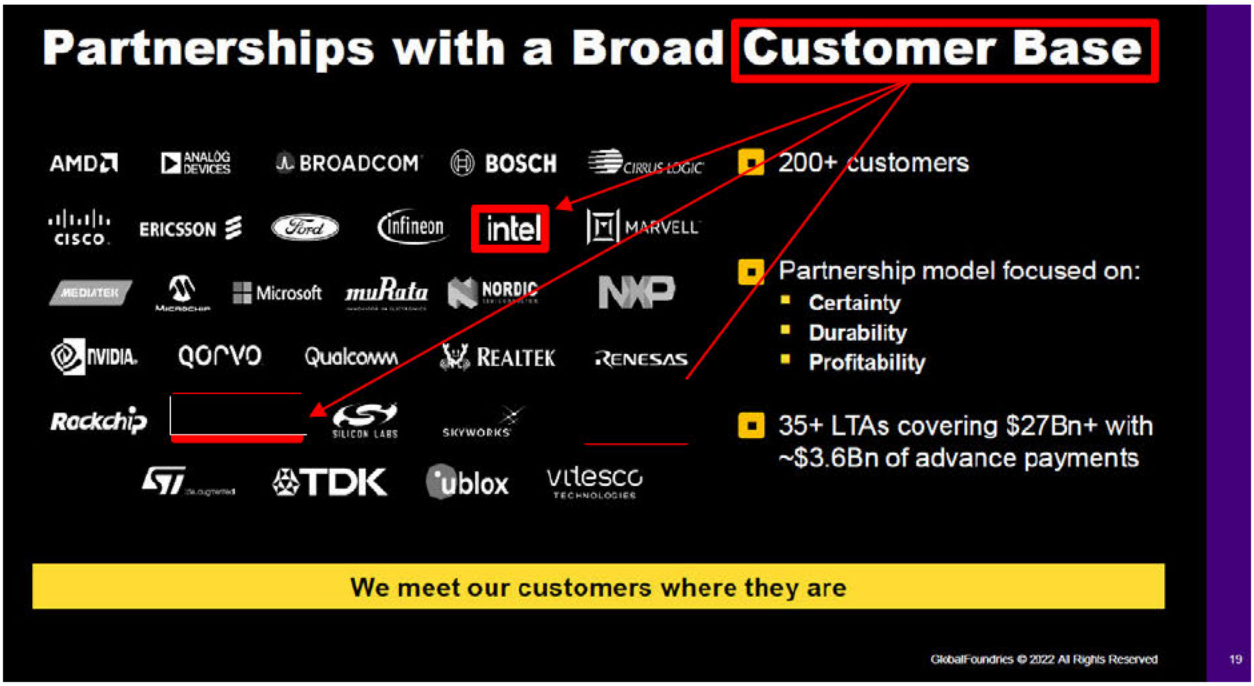
In response to one of Greenthread's interrogatories, OV said it intends to assert a license or exhaustion defense based on sales to [redacted] and/or Intel. Ex. 2043, 6-7. When Greenthread asked OV which products were licensed, OV responded: "Greenthread is in the best position to address its own license agreements and

[redacted]

whether OmniVision is a beneficiary in some manner. Please let us know which OmniVision products Greenthread believes are already licensed." Ex. 2044, 1.

3. Global Foundries creates custom products for Licensees and Indemnifies them.

Global Foundries investor materials state that it manufactures products under contract for all three Licensees. Ex. 2014, 19.



Additionally, Global Foundries' investor disclosures state that its primary business is manufacturing to specifications provided by its customers. GF 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.

GF "defend[s]" its customers against "intellectual property infringement claims and indemnify[ies] them for damages." Ex. 2033, 24.

[redacted]

C. These Proceedings

On October 11, 2023, Petitioners filed the first petition in these proceedings, IPR2024-00016; IPR2024-00001 followed on October 12 and IPR2024-00017 followed on October 18. On October 20, 2023 Greenthread notified Petitioners that the Petitions are time barred by virtue of Petitioners' contracts with Licensees. Ex. 2011, 1. Greenthread's email included much of the evidence of Petitioners relationships with Licensees discussed above and pointed Petitioners to the Licenses, which they had already received in discovery.[3] Greenthread requested that Petitioners withdraw their petitions or at a minimum provide discovery into whether the petitions are time barred.

On October 24, 2023, Petitioners responded that they "have demonstrated that the petitions are not time barred" and that they "object to" Greenthread's request for discovery. Ex. 2016, 1.

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[3] Petitioners were aware of the Licenses before filing any of the Petitions. On May 2, 2023 Greenthread's counsel offered to produce the Licenses to CL. Ex. 2050, 1. CL responded that it had no significant liability and was not interested. Greenthread nevertheless served CL with copies of the Licenses on October 5, 2023. Ex. 2046. Greenthread served OV with copies of the Licenses on June 30, 2023. Ex. 2047.

[redacted]

On October 27, Petitioners filed four more petitions, IPR2024-00018, IPR2024-00019, IPR2024-00020, and IPR2024-00021. In spite of the parties' correspondence, these petitions included the identical assertion that "Petitioner [sic] is not barred or estopped from requesting IPR of the Challenged Claims" unsupported by any argument or evidence whatsoever. IPR2024-00018, Paper 1 (Petition), 4; IPR2024-00019, Paper 1 (Petition), 4; IPR2024-00020, Paper 1 (Petition), 4; IPR2024-00021, Paper 1 (Petition), 4. The same day, Greenthread informed Petitioners that its objections to the first three IPRs applied equally to the additional four. Ex. 2038, 3-4.

On November 1, Greenthread emailed the Board to "request authorization to file a motion for additional discovery." Ex. 2017. The Board authorized Greenthread to file a motion for discovery on December 21. Greenthread filed its motion the next day. The Board has not ruled on the motion, but need not do so if it dismisses the Petition as Greenthread requests below.

III. The Petition should be dismissed under 35 U.S.C. § 315(b).

Section 315(b) provides that "[a]n inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent." 35 U.S.C. § 315(b). "[T]he IPR petitioner bears the burden of persuasion to demonstrate that its petitions are not

[redacted]

time-barred" under § 315(b). *Samsung Electronics Co. Ltd. v. Netlist, Inc.*, IPR2022-00615, Paper 40 at 2 (PTAB Feb. 3, 2023) (quoting *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242 Fed. Cir. 2018)).

To dispute the timeliness of the petition, "a patent owner must produce *some* evidence that" a petition is time barred—but only "*some*." *Worlds*, 903 F.3d at 1244 (emphasis in original). There is no "rebuttable presumption that formally shifts a burden of production to the patent owner" or a presumption that a petition is timely because a petitioner asserts that it is. *Id.* at 1242. Such a presumption would be unfair, because it would "disfavor the party that likely has inferior access to potential sources of proof." *Id.* at 1244. As in this case, a patent owner is unlikely to know the details (or even existence) of a petitioner's relationships that might give rise to privity. Once the patent owner has "presented evidence sufficient to put" the timeliness of the petition "into dispute," "the Board c[an] no longer merely rely upon" the petitioner's assertion that its petition is timely. *Id.* at 1246. Throughout the proceeding, the "burden remains with the petitioner to establish" that its petition is timely. *Id.* at 1242.

Here, a complaint alleging infringement of the '195 and '502 patents was filed against [redacted] on April 30, 2019, and service was effectuated by May 31, 2019. Ex. 2048; Ex. 2049. Intel and [redacted] were served with a complaint alleging infringement of the Challenged Patents except the '014 patent on February 1, 2022.

[redacted]

Ex. 2001, 2, 4; Ex. 2039. [redacted] was a real-party-in-interest (RPI) to the First Amended Complaint against Intel and [redacted] served by ECF on April 29, 2022 alleging infringement of all the Challenged Patents. Ex. 2003; Ex. 2008, 7. Thus, the Petitions are untimely if any Petitioner is in privity with [redacted], Intel, or [redacted].

Greenthread has disputed the timeliness of the Petition with evidence showing that Petitioner is in privity with [redacted], Intel, and [redacted]. Therefore, Greenthread has satisfied its burden under *Worlds*. Petitioners have offered no evidence or argument whatsoever to controvert Patent Owner's evidence or demonstrate the timeliness of its Petition. Accordingly, the Petition should be dismissed.

A. The Petitions should be dismissed, because Petitioners have not attempted to carry their burden.

1. Patent Owner has satisfied its "practical" burden under *Worlds*.

There can be no serious dispute that Patent Owner here has met its initial "practical" burden under *Worlds*. *Worlds*, 903 F.3d at 1243-44. Petitioners indisputably supply accused products to Licensees. Ex. 2035 at 2, 10, 63, 64; Ex. 2030, 1; Ex. 2015, 34. Some of these products, such as those GF manufactures, are custom made for Licensees. Ex. 2014, 19. CL "collaborates" with Intel and makes "custom" products for its customers. Ex. 2020, 1. A number of these products were at issue in the litigation with Licensees, including the Cirrus Logic CS35L41 and

[redacted]

CS40L25, which were components of the [redacted] handset accused in the [redacted] litigation (compare Ex. 2021, 17-18 with Ex. 2035 at 2, 10, 63, 64 with Ex. 2018 at 4), the OmniVision OV7261, which is a component of the [redacted] accused in the [redacted] litigation (compare Ex. 2021, 18 with Ex. 2030 with Ex. 2029, 8), and the OmniVision OV9282, which is a component of Intel's RealSense D400 series stereo vision depth camera system (compare Ex. 2015, 34 with Ex. 2029, 8.). Petitioners do not dispute, and even acknowledge, that sales of accused products to Licensees are licensed. CL has expressly said that some of its products are licensed by the same agreement licensing [redacted]. Ex. 2037, 1. OV has said that Greenthread is "in the best position" to determine whether OV is licensed. Ex. 2044, 1. The other Petitioners claim to "have no knowledge" regarding whether they are licensed, in spite of having the Licenses. Ex. 2038, 6. Finally, Petitioners owe indemnity obligations to Licensees for these products. Ex. 2026, 1, 4-5; Ex. 2033, 24.

2. Petitioners has done nothing to satisfy its burden under Section 315(b).

"Failure to prove [a] matter … means that the party with the burden of persuasion loses on that point—thus, if the fact trier of the issue is left uncertain, the party with the burden loses." *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378–79 (Fed. Cir. 2015). Here, Petitioners "lose[]," because (1) they have the burden to show that the Petitions are timely and (2) Petitioners deliberately

chose to ignore the issue, even after Patent Owner expressly identified it to them. *Id.* In short, Petitioners have not even attempted to meet their burden.

The instant Petition, like all seven of the Petitions, simply asserts, without support or explanation, that "Petitioner [sic] is not barred or estopped from requesting IPR of the Challenged Claims on the grounds identified in this Petition." Pet., 5. That is inadequate. Mere "attorney argument that itself fail[s] to cite evidence" cannot meet Petitioners' burden. *Worlds*, 903 F.3d at 1246. Further, Patent Owner provided Petitioners the opportunity to come forward with evidence or explanation for the timeliness of the Petitions—*before they filed four of the Petitions*. Patent Owner even sought to compel the production of relevant evidence. Paper 9 (PO's Motion for Additional Discovery). However, Petitioners refused to provide any discovery whatsoever or put into the record a single piece of evidence. With no evidence to support the timeliness of the Petitions, Petitioners "lose[]." *Dynamic Drinkware*, 800 F.3d at 1379.

Indeed, not only do Petitioners lose in the *absence* of any evidence, the "lack of evidence" that would presumably be in Petitioners' possession, such as their contracts with Licensees, 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). Therefore, the Board can reasonably infer from Petitioners'

[redacted]

resistance to providing evidence to meet their burden that the evidence (not in the record) is unfavorable to Petitioners.

3. Petitioners cannot show timeliness by asserting that they have "standard" relationships.

Petitioners claim that they are not in privity with Licensees' because they "have standard, arms-length relationships with their customers." Paper 11, 7. That is incorrect. There is no "standard" relationship that evades privity. Privity "is a 'highly fact-dependent question.'" *Apps. in Internet Time, LLC v. RPX Corp.*, IPR2015-01750, Paper 128 at 7 (PTAB Oct. 2, 2020) ("*AIT*") (precedential).

Customer-supplier relationships *can* and frequently *do* create privity. *See, 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); *Ericsson Inc. v. Regents of Univ. of Minn.*, IPR2017-01197, Paper 56 at 8, 10 (PTAB Sept. 18, 2020).

A petitioner's failure to produce pertinent documents regarding its customer-supplier relationships precludes institution. For example, in *Volkswagen*, 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." IPR2021-01263, Paper 16 at 10 n.4. In *Ventex* the Board said that failure to produce the agreements "cuts against the party bearing the burden of proof on these issues." IPR2017-00789, Paper 148 at 14. Similarly, in *Bungie Inc. v. Worlds*

Inc., on remand, the Board said that "making any findings [regarding communications between the petitioner and putative privy] would require us to speculate because Petitioner has not produced evidence." IPR2015-01264, Paper 64 at 40 (PTAB Jan. 14, 2020). Petitioners cannot prevail on a "fact-dependent question" when they offer no evidence to support a finding of facts. *AIT*, IPR2015-01750, Paper 128 at 7.

Further, Petitioners do not dispute that "an indemnity relationship is the type of relationship that can establish privity" or that they have such indemnity obligations. *Ericsson*, IPR2017-01197, Paper 56 at 8, 10 (PTAB Sept. 18, 2020). CL just claims that its indemnity obligations are not "straightforward." Paper 11, 8. GF admits indemnifying its customers and does not dispute that its obligations are "straightforward." Ex. 2033, 24. The other petitioners do not deny owing indemnity to Licensees and offer no explanation of why their indemnity obligations to Licensees would not be dispositive here. Since Petitioners bear the burden of persuasion, their failure to produce the contracts is dispositive.[4]

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[4] In a parallel proceeding, the Board said that Greenthread's failure to raise a res judicata defense in district court in response to invalidity counterclaims undermined Greenthread's § 315(b) argument. IPR2023-01242, Paper 31 at 8. The panel's statement was incorrect. When a patent owner and the same alleged infringer are

[redacted]

B. The Petition should be dismissed, because evidence of record shows that the Petition is time-barred.

The Board need not evaluate whether Patent Owner's evidence suffices to show that the Petition are time-barred, because Petitioners bear the burden of proof on that issue and have not even attempted to meet their burden. If the Board chooses to look at the evidence of record, however, it is clear that the Petitions are time-barred.

Whether two parties are privies with respect to one another is evaluated under the "common law" framework set forth in *Taylor v. Sturgell*, 553 U.S. 880 (2008). *WesternGeco LLC v. ION Geophysical Corp.*, 889 F.3d 1308, 1317 (Fed. Cir. 2018); *see also* Office Trial Practice Guide at 13 (citing *Taylor*). *Taylor* identifies "a variety

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involved in successive litigation regarding the same patent, the alleged infringer may re-assert an invalidity defense if the accused products in the second litigation are materially different than those in the first litigation. *Hallco Mfg. Co. v. Foster*, 256 F.3d 1290, 1297 (Fed. Cir. 2001). Here, Greenthread is alleging infringement based on some products that were at issue in the prior litigation, but also other products that are materially different. Therefore, even if Greenthread were litigating against Intel or [redacted] themselves, those parties would be able to re-assert their invalidity defenses, because the products in the litigations are different.

of pre-existing 'substantive legal relationship[s]' between" two parties that can create privity. *Taylor*, 553 U.S. at 894 (alterations in original). Among them are when two parties are "preceding and succeeding owners of property" and when one party acts as the "agent" for the other. *Id.* at 894-95. "[A]n indemnity relationship is [also] the type of relationship that can establish privity," particularly when the indemnity obligations "directly relate to the" accused products. *Ericsson Inc. v. Regents of Univ. of Minnesota*, IPR2017-01197, Paper 56 at 8, 10 (PTAB Sept. 18, 2020). Here, Petitioners are in privity with Licensees. Since Licensees are time-barred, Petitioners are likewise time-barred.

1. Petitioners acts as Licensees' "agent" for Licensees' "have made" rights.

Petitioners are in privity with Licensees, because, by virtue of their contracts with Licensees, they exercise Licensees' rights under the Licenses and are thus Licensees' agents.

It is well established that "agents and principals are in privity for res judicata purposes 'if the prior action concerned a matter within the agency.'" *Herrion v. Children's Hosp. Nat. Med. Ctr.*, 448 F. App'x 71, 73 (D.C. Cir. 2011). The D.C. Circuit is "hardly alone in this approach to privity between principals and their agents." *Herrion v. Children's Hosp. Nat. Med. Ctr.*, 786 F. Supp. 2d 359, 371 n.9 (D.D.C.), *aff'd*, 448 F. App'x 71 (D.C. Cir. 2011). Courts around the country have held similarly and the leading treatise on Federal procedure agrees. *Id.* (citing cases

from the Supreme Court, First, Second, Third, Fifth, Sixth, Seventh, Ninth, and Eleventh Circuits); *Wright & Miller* § 4460 (3d ed.).

For example, in *John St. Leasehold, LLC v. Cap. Mgmt. Res., L.P.*, 283 F.3d 73, 75 (2d Cir. 2002), the FDIC contracted with asset managers to exercise its rights as receiver for a failed bank. The Second Circuit held that the asset managers were the FDIC's agents, acting within "the scope of their agency," and thus "in privity with the" FDIC. *Id.* at 75.

Likewise in *Fiumara v. Fireman's Fund Ins. Companies*, 746 F.2d 87, 87 (1st Cir. 1984), a motel operator sued his fire insurer for denying his claim. The motel operator lost and then sued the *contractors* the insurer used to investigate his claim. *Id.* The First Circuit affirmed summary judgment for the contractors, holding that the contractors were "acting as agents of the" insurer and therefore "clearly qualify as persons in privity." *Id.* at 92.

Finally, *In re Google LLC*, 949 F.3d 1338, 1346 (Fed. Cir. 2020) the Federal Circuit said that contracts between Google and an internet service provider to "[a]ssembl[e] equipment based on information and instructions provided by" Google were "suggestive of an agency relationship."[5]

[5] The contractors were not "conducting Google's business within the meaning of the [venue] statute," but that is irrelevant for purposes of agency. *Id.* at 1346.

Here, Petitioners are in the same position as the (1) contract asset managers in *John St. Leasehold* acting on behalf of the FDIC and (2) the contract investigators acting on behalf of the insurance company in *Fiumara*, because Petitioners are likewise exercising the contractual rights of another party as its agent. The specific contractual rights are different—controlling the operation of a failed bank, investigating a fire, and making licensed products—but privity does not turn on the nature or scope of the agency. Here, Licensees could exercise their license rights by making the accused products themselves, but choose to "have [the accused products] made" by Petitioners instead, just as the FDIC or insurer could have exercised their rights directly, but chose to employ an agent. For privity, what matters is not the scope or nature of the agency, but whether "the prior action concerned a matter within the agency." *Herrion*, 448 F. App'x at 73. Here, the manufacture of licensed or accused goods is obviously relevant to these proceedings.

Furthermore, as in *Google*, Petitioners "[a]ssembl[e] equipment"—or manufacture accused products—at Petitioners' instruction. For example, when GF "produc[es] ICs for other companies, rather than those of its own design," or when CL makes "custom" products, their actions are legally indistinguishable from the contractors in *Google* assembling equipment at Google's direction. Ex. 2033 at 12, 35. Therefore, Petitioners are Licensees' agent and is in privity with Licensees. *Herrion*, 448 F. App'x at 73.

[redacted]

Finally, to be in privity with Licensees, Petitioners do not need to be Licensees' agent for these proceedings or the prior proceedings. What matters is whether Petitioners are agents with respect to the facts giving rise to the parties' dispute. In all of the examples cited above—*Herrion, St. John's Leasehold, Fiumara*, and *Google*—the party held to be in privity was an agent with respects to the fact underlying the dispute, *not the prior litigation*. Nothing in any of those cases indicates that the party in privity was an agent with respect to the prior litigation.

Moreover, the Board has rejected the argument that § 315(b) "should not apply if a petitioner was not placed on notice of the [prior] infringement allegation" or if the petitioner lacked "the opportunity to participate in and control the District Court litigation." *Bungie*, IPR2015-01264, Paper 64 at 44. To the extent that control is relevant, it is Petitioners' burden to show that they *did not* control the prior litigation. There is no evidence in the record to support such a finding, and "the lack of evidence [on that point] also precludes [the Board] from being able to find that Petitioner has met its burden." *Id.* at 35.

2. Petitioners and Licensees are "preceding and succeeding owners of property" and parties to sales of accused goods.

It is undisputed that Petitioners on the one hand and Licensees on the other are "preceding and succeeding owners of" the licensed and/or infringing products,

[redacted]

because Petitioners products are indisputably components of Licensees' products.[6] *Taylor*, 553 U.S. at 894.

Petitioners also do not dispute that several of these Licensee products were accused in the prior litigation, including [redacted] phones. GF has not identified what products it makes for Licensees, but GF products, such as accused Intel or [redacted] chips, may actually *be* Licensees' products, not just components.[7]

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[6] Petitioners apparently sell at least some of these accused models to parties other than licensees, such as Digikey and Mouser Electronics. Exs. 2051-2055. These sales and sales of other accused products are the subject of the current district court litigation.

[7] Even if none of the products currently accused by model number were sold to Licensees, the district court litigation is in its early stages. In the case against Cirrus Logic, final infringement contentions are not due until March 21, 2024, and Greenthread has a pending motion to compel OV to make its technical information available. *Greenthread, LLC v. OmniVision Technologies Inc.*, 2:23-00212, Dkt. No. 94 (E.D.Tex., Dec. 19, 2023). "'It is expected that during [] discovery, infringement contentions may be clarified or refined' based upon information

[redacted]

Under the America Invents Act ("AIA"), privity "extend[s] to parties to transactions and other activities relating to the property in question," i.e., infringing goods. *WesternGeco LLC v. ION Geophysical Corp.*, 889 F.3d 1308, 1318 (Fed. Cir. 2018) (quoting legislative history of the AIA). Here, the "transactions … in question" are the sales Petitioners make to Licensees and "the property in question" is the goods conveyed in those sales. *Id.* Each sale of accused products to Licensees is a "transaction" regarding a piece of "property" which puts Petitioners and Licensees in privity. *WesternGeco*, 889 F.3d at 1318.

In their opposition to Greenthread's discovery motion, CL and OV tried to distance themselves from Licensees, by claiming to sell to Licensees through "distributors." Paper 11, 8, 9. This argument fails.

First, GF does not claim to sell through distributors. It makes products for Licensees, according to Licensees' specifications. Ex. 2033 at 12, 35. Since GF is in privity with Licensees, the Petitions are time barred, even if CL and OV are not independently in privity. 35 U.S.C. § 315(b).

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produced during discovery." *Arigna Tech. Ltd. v. Volkswagen AG*, No. 2:21-cv-00054, 2022 WL 2761288, at *2 (E.D. Tex. Jan. 19, 2022)).

[redacted]

Second, CL and OV do not dispute that their products are components in Licensee products, including products accused in the prior litigation. If CL and OV believe that there is some relevance to their use of distributors, they must provide evidence showing how their products are sold and their contracts with Licensees and/or "distributors." For example, Petitioners do not provide evidence, showing whether *all* the relevant products are sold through distributors. Petitioners also do not indicate whether any "distributors" are Licensees' contractors, such as third-parties who assemble Licensees products.

Third, even if CL's and OV's claims were supported by evidence, selling through distributors does not change the fact that CL and OV have direct relationships with Licensees and make the products *for* Licensees. CL says that its "engineers work closely with" product teams at electronics manufacturers to make "custom" products. Ex. 2025. CL "collaborat[es]" with Intel. Ex. 2020, 1. Additionally, CL acknowledges that it owes indemnity to Licensees. CL just asserts that its obligation is not "straightforward." Paper 11, 8.

Finally, how CL's and OV's products end up in Licensee's products is irrelevant. CL and OV they are still preceding owners of property that was previously accused and is accused again, even if the property flows through another party.

[redacted]

a. Petitioners and RPI are beneficiaries of Licensees' "agreement[] directly related" to the accused products.

"[A]greements directly related to the product accused of infringing the patent at issue in this proceeding" satisfy *Taylor's* "pre-existing substantive legal relationship" test. *Ventex Co. v. Columbia Sportswear North America, Inc.*, IPR2017-00651, Paper 148 (PTAB Jan. 24, 2019) (precedential)). Here, Petitioners operate under and are beneficiaries of Licensees' agreements with Patent Owner. That agreement is "directly related to" the accused products. *Id.*

Under the Licenses, "any product" Licensees "have made" by a Petitioner or "purchase" from Petitioner is a "Licensed Product or Service" which Licensees have the right to "use, … sell, … obtain, … acquire, … receive, … and otherwise exploit." Ex. 2022, 2-3; Ex. 2034, 2-3. Furthermore, the license grants a limited sublicense to Licensees' "have-made vendors" (for the limited purposes of making products for Licensees). Ex. 2022, 5; Ex. 2034, 5. Petitioners are such vendors and therefore are (limited) sublicensees of Licensees under the Licenses. Even if that were not the case, "have-made vendors" are entitled to a limited implied license. *See LaserDynamics, Inc. v. Quanta Computer, Inc.*, 694 F.3d 51, 73 (Fed. Cir. 2012). Therefore, Petitioners are beneficiaries of Licensees' "agreements directly related to the product accused of infringing the patent at issue in this proceeding" satisfying

[redacted]

Taylor's "pre-existing substantive legal relationship" test. *Ventex Co.*, IPR2017-00651, Paper 148 (precedential).

b. Petitioners' licensed sales encumber otherwise infringing articles.

Under the doctrine of exhaustion, a licensed "sale is treated, for purposes of patent exhaustion, as if the patentee made the sale itself. The result: The sale exhausts the patentee's rights *in that item*." *Impression Prod., Inc. v. Lexmark Int'l, Inc.*, 581 U.S. 360, 376 (2017) (emphasis added). Therefore, after Petitioners sell a product under the Licenses, any downstream user of the article sold would have an exhaustion defense against Patent Owner. Put differently, the "property" of which Petitioners and Licensees are "preceding and succeeding owners" becomes encumbered under the doctrine of exhaustion. *Taylor*, 553 U.S. at 894. Further, it does not matter whether the products were accused in the instant litigation *or whether Petitioners even asserts a license defense*. Petitioners still limit Patent owner's rights vis-à-vis the "property" they sell under the Licenses by giving future owners an exhaustion defense. Thus, Petitioners effectively provide rights to third-parties under the Licenses and, therefore, is in privity with Licensees.

3. Petitioners' indemnity obligations to Licensees support a finding of privity.

"[A]n indemnity relationship is the type of relationship that can establish privity," particularly when the indemnity obligations "directly relate to the" accused

[redacted]

products. *Ericsson*, IPR2017-01197, Paper 56 at 8, 10. Here, CL does not dispute that it indemnifies Licensees, but instead claims that its indemnity obligation is not "straightforward." Paper 11, 8. CL does not say what is not "straightforward" about its indemnity obligations and does not deny that they apply to accused products. If CL believes that its indemnity obligations do not create privity, it must explain why and produce the relevant documents

GF also admits that it indemnifies its customers. GF does not characterize its obligations in any way which would negate a finding of privity. Ex. 2033, 24. To the contrary, it says that in the past these indemnity obligations have been significant costs to the company. *Id.*

C. Basic fairness and the policy underlying the AIA support dismissing the petition.

1. Petitioners are trying to take inconsistent positions before the Board and in district court.

"[T]o protect the integrity of the judicial process," "courts have uniformly … prohibit[ed] parties deliberately changing [litigation] positions according to the exigencies of the moment." *New Hampshire v. Maine*, 532 U.S. 742, 750 (2001). Here, Petitioners admit that they plan to change their position about whether they are beneficiaries of the Licenses. Petitioners want to disclaim the Licenses now, but assert a license defense later. Petitioners claim that they "may have justifiable reasons" for doing so. Paper 11, 11. However, Petitioners do not say what those

[redacted]

"reasons" could be other than "exigencies of the moment." *New Hampshire*, 532 U.S. at 750. The Board should reject Petitioners' cynical positions of convenience.

In all events, Petitioners are not just preserving the *possibility* of taking inconsistent positions, they are taking inconsistent positions *right now*. CL currently claims to be (partially) licensed under the same agreement in which Greenthread licensed [redacted]. Ex. 2037, 1. Petitioners stepped into Licensees' shoes by contracting to make and sell products under the Licenses. Petitioners should not be able to take those shoes off when standing before the Board, only to put them back on again when they appear in district court.[8]

[8] Petitioners cannot make the Petition timely by disclaiming a license defense. Whether or not a Petitioner actually asserts its license defense, Petitioners still have been acting under the Licenses and reaping benefits from it, such as not owing any indemnity to Licensees. *Supra* § III.B.2. Petitioners also have been selling goods subject to exhaustion, thereby limiting Patent Owner's rights, whether or not Petitioner disclaims any license. *Supra* § III.B.2.b. Petitioners cannot turn privity on and off based on the "exigencies of the moment." *New Hampshire*, 532 U.S. at 750.

[redacted]

2. Petitioners' other interests are irrelevant.

"Congress 'chose language that bars petitions where proxies or privies would *benefit* from an instituted IPR, even where the petitioning party might separately have its own interest in initiating an IPR.'" *Power Integrations, Inc. v. Semiconductor Comps. Indus., LLC*, 926 F.3d 1306, 1316 (Fed. Cir. 2019) (emphasis in original); *RPX Corp. v. Applications in Internet Time LLC*, IPR2015-01750, Paper 128 at 10 (PTAB Oct. 2, 2020) (precedential) (same). Therefore, the fact that the Petitioners benefit from a license that does not cover *all* of Petitioners' sales is irrelevant. Petitioners *still benefit* from the license (and exercises Licensees' "have made" rights). Therefore, Petitioners are in privity with Licensees. Petitioners will have the opportunity to challenge the validity of the Challenged Patent in district court. The only question before the Board is whether Petitioners can avail themselves of *additional* challenges here. The answer Congress provided in § 315(b) is "no."

3. Petitioners should not receive a preliminary reply or be allowed to submit new evidence.

A preliminary reply is only justified on a showing of "good cause." Office Trial Practice Guide at 13. A reply is not appropriate to address arguments "Petitioner could have reasonably foreseen" when filing its petition. *Sandoz Inc. v. Abbvie Biotechnology Ltd.*, IPR2018-00002, Paper 11 at 3 (PTAB Mar. 6, 2018). A reply pertaining to something that the petitioner is "required by [the Board's] rules"

to address in the petition is especially inappropriate. *Minka Lighting, Inc. v. Vaxcel Int'l Co., Ltd.*, IPR2019-00802, Paper 8 at 3 (PTAB June 27, 2019).

Here, there is no "good cause" for a preliminary reply. Greenthread's arguments are not just something that Petitioners "reasonably could have foreseen," Greenthread *actually informed* Petitioners about these arguments before four of the Petitions were filed. Ex. 2011, 1. Even then, Petitioners chose to offer nothing more than the conclusory statement that the Petitions are not time barred. *See, e.g.*, IPR2024-00018, Paper 1 (Petition), 4.

Petitioners also could have come forward with evidence in response to Greenthread's discovery requests, especially after seeing Greenthread's motion to compel. Instead, Petitioners have chosen to stand by their single conclusory sentence.

Additionally, (if a preliminary reply is permitted) it would prejudice Greenthread to allow Petitioners to submit additional evidence. If Petitioners had seriously attempted to meet their burden, Greenthread's POPR would have looked very different. Most obviously, Greenthread could have devoted pages in its POPR to analyzing Petitioners' evidence. Or, Greenthread could have raised entirely different arguments. Greenthread should not be forced to address new evidence in a short sur-reply. Allowing Petitioners to submit evidence now, would effectively

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re-write the Petitions and deprive Greenthread of its right to file a POPR. 35 U.S.C. § 314(b)(1).

Adding additional pages to Greenthread's sur-reply would not cure the prejudice, because Greenthread should not be forced to incur additional costs briefing issues Petitioners unreasonably failed to raise. The Board also should not be compelled to wade through still more papers. The Board should insist that petitioners come forward to support the timeliness of the petitions at the outset.

Finally, postponing a decision on the timeliness of the Petitions until the final written decision stage would prejudice Greenthread. Defending this proceeding will be extremely costly and potentially delay resolution of the parties' dispute if Petitioners seek to stay the district court cases. Indeed, the privity issues will make this IPR more costly to litigate and time intensive for the Board to adjudicate than a normal IPR. The timeliness of the Petition is a threshold issue that Petitioners could have and should have addressed in their Petitions—or at least by cooperating in discovery. 37 C.F.R. § 42.104(a). Petitioners did neither, and the Board should not reward that strategy by giving Petitioners yet another opportunity to carry their burden.

Finally, if the Board simply denies the Petitions under §315(b), it could also deny Patent Owner's motion for additional discovery as moot.

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4. The Board should disregard Petitioners' proffer of declarations.

In their opposition to Greenthread's discovery motion, Petitioners proffered a declaration stating that they had not discussed regarding these proceedings or the district court cases with Licensees. Paper 11 at 5 n.2. The proffer is irrelevant, because even if it is accurate, the Petitions are untimely. No part of Greenthread's argument depends on Petitioners and Licensees communicating about the litigation. The, Board has rejected the argument that § 315(b) "should not apply if a petitioner was not placed on notice of the [prior] infringement allegation" or if the petitioner lacked "the opportunity to participate in and control the District Court litigation." *Bungie Inc. v. Worlds Inc.* IPR2015-01264, Paper 64 at 44 (PTAB Jan. 14, 2020). Here, Petitioners did not need to communicate with Licensees to get the benefit of the Licenses.

IV. CONCLUSION

For the foregoing reasons, institution of the Petition should be denied. If institution is denied, the Board could deny Patent Owner's motion for additional discovery as moot.

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Respectfully submitted,

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. §42.24(d), Patent Owner hereby certifies that the word count for the foregoing **PATENT OWNER'S PRELIMINARY RESPONSE** is 7,455 words, which is within the limit set in 37 C.F.R. §42.24(b)(1). This word count does not include the table of contents, table of authorities, exhibit list, certificate of word count, and certificate of service. This word count was prepared using Microsoft Word.

Dated: February 7, 2024

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CERTIFICATION OF SERVICE

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