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.

IPR2023-00019
U.S. Patent No. 11,316,014

PATENT OWNER'S MOTION FOR ADDITIONAL DISCOVERY PURSUANT TO 37 C.F.R. § 42.51(B)(2)(I)

TABLE OF CONTENTS

EXHIBIT LIST iv

I. INTRODUCTION 1

II. BACKGROUND 2

A. Prior Litigation Involving the Challenged Patents 2

1. [redacted] Litigation 2

2. Intel-[redacted]-[redacted] Litigation 3

3. Greenthread Licenses to [redacted] Intel, and [redacted] 4

B. These Proceedings 5

C. Petitioners' Relationship with Patent Owner's Licensees and the Current and Co-Pending Proceedings 6

1. Cirrus Logic 6

2. Omnivision 8

3. Global Foundries 9

III. THE REQUESTED DISCOVERY 9

IV. THE INTERESTS OF JUSTICE SUPPORT GRANTING THE REQUESTED DISCOVERY 10

A. There is More Than a Possibility or Mere Allegation That the Requested Discovery Will Yield Useful Information 10

B. The Second *Garmin* Factor Favors PO 13

C. The Requested Information Is Not Reasonably Available Through Other Means 13

D. The Requests Are Easily Understandable 14

E. The Requests Are Not Overly Burdensome 14

V. TIMING OF DISCOVERY RESPONSES 15

VI. CONCLUSION.....15

TABLE OF AUTHORITIES

Page(s)

CASES

Bungie Inc. v. Worlds Inc.,
IPR2015-01264, Paper 64 (PTAB Jan. 14, 2020) 11

Ericsson Inc. v. Regents of Univ. of Minnesota,
IPR2017-01197, Paper 56 (PTAB Sept. 18, 2020).....12

Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC,
IPR2012-00001, Paper 26 (PTAB Mar. 5, 2013).....10

Herrion v. Children's Hosp. Nat. Med. Ctr.,
448 F. App'x 71 (D.C. Cir. 2011).....12

In re Google LLC,
949 F.3d 1338 (Fed. Cir. 2020) 11

Taylor v. Sturgell,
553 U.S. 880 (2008).....2, 10, 12

Ventex Co. v. Columbia Sportswear North America, Inc.,
IPR2017-00651, Paper 148 (PTAB Jan. 24, 2019) 10, 11, 13

WesternGeco LLC v. ION Geophysical Corp.,
889 F.3d 1308 (Fed. Cir. 2018) 10

STATUTES

35 U.S.C. §315(b) 5, 6, 9, 14

OTHER AUTHORITIES

37 C.F.R. § 42.51(b)(2)(i).....1

EXHIBIT LIST

Exhibit No.	Description
Ex. 2001	*Greenthread, LLC v. Intel Corp.*, No. 6:22-cv-00105-ADA, Dkt. 7 (summons returned executed) (W.D. Tex. Feb. 7, 2022)
Ex. 2002	Definition of "privity" in Black's Law Dictionary (11th ed. 2019) available from Westlaw at westlaw.com
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)
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)
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)
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)
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)
Ex. 2008	Petition (Paper 1) in *Sony Group Corp. v. Greenthread, LLC*, IPR2023-00376
Ex. 2009	*Greenthread, LLC v. Dell Inc.*, No. 6:22-cv-105-ADA, Dkt. 120 (Second Amended Complaint)
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)

Exhibit No.	Description
Ex. 2011	Email communication from Patent Owner's counsel to Petitioner's counsel dated October 20, 2023
Ex. 2012	Email Attachment – Cirrus Logic Technical Support Article Number 000207340
Ex. 2013	Email Attachment - Cirrus Logic Investor Presentation as of April 28, 2015
Ex. 2014	Email Attachment - GlobalFoundries 2022 Capital Markets Day, available at https://investors.gf.com/static-files/65f5f1b9-2aea-47a3-8455-10413c6560f4
Ex. 2015	Email Attachment - Intel RealSense Product Family D400 Series, dated 2019
Ex. 2016	Email communication from Petitioner's counsel to Patent Owner's counsel dated October 24, 2023
Ex. 2017	Email communication from Patent Owner's counsel to Board, copying Petitioner's counsel dated November 1, 2023
Ex. 2018	*Greenthread, LLC v. Intel Corp.*, No. 6:22-cv-00105-ADA, Dkt. 1 (Complaint) (W.D. Tex. Jan. 27, 2022)
Ex. 2019	*Greenthread, LLC v. Cirrus Logic, Inc.*, No. 1:23-cv-00369, Dkt. 29 (Scheduling Order) (W.D. Tex. Aug. 18, 2023)
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
Ex. 2021	*Greenthread, LLC v. Intel Corp.*, 6:22-cv-00105-ADA, Dkt. 120-8, Greenthread's Amended Preliminary Infringement Contentions
Ex. 2022	[SEALED] Confidential agreement

Exhibit No.	Description
Ex. 2023	CS42L42, Low Power Audio Codec with SoundWire and Audio Processing, available at https://www.cirrus.com/pubs/proBulletin/cs42l43-cs36l56-bulletin.pdf
Ex. 2024	Cirrus Logic Immersive PC Audio Solution, available at https://www.cirrus.com/pubs/proBulletin/cs42l43-cs36l56-bulletin.pdf
Ex. 2025	Cirrus Logic – What Drives Our Success, available at https://investor.cirrus.com/company-overview/what-drives-our-success/default.aspx
Ex. 2026	Cirrus Logic, Inc. Terms and Conditions of Sale, available at https://www.cirrus.com/legal/productterms/
Ex. 2027	*Greenthread, LLC v. Omnivision Technologies Inc.*; 2:23-cv-212, Dkt. 1 (Complaint) (E.D. Tex May 10, 2023)
Ex. 2028	[SEALED] Confidential declaration
Ex. 2029	*Greenthread, LLC v. Omnivision Technologies Inc.*, 2:23-00212, Preliminary Infringement Contentions for OmniVision Technologies Inc.
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
Ex. 2031	Intel RealSense Product Family D400 Series, dated September 2023
Ex. 2032	[SEALED] Confidential declaration
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
Ex. 2034	[SEALED] Confidential agreement

Exhibit No.	Description
Ex. 2035	TechInsights Report on Sony Xerpia 5111
Ex. 2036	TechInsights Report Ad

I. INTRODUCTION

Patent Owner Greenthread, LLC ("PO") submits this Motion for Additional Discovery pursuant to 37 C.F.R. § 42.51(b)(2)(i) and as authorized by the Board via email on December 21, 2023. Petitioners[1] have extensive relationships with time-barred parties Intel, [redacted] [redacted] and [redacted].[2] Among other things, Petitioners manufacture and design components of products accused in prior litigation against those parties. Worse, Petitioners want to take inconsistent positions before the Board and in district court. On one hand, ***before the Board***, Petitioners claim they are not in privity with Intel, [redacted], (collectivily "Licensees") each of whom have a license ("Licenses") to the Challenged Patents.[3]

On the other hand, ***in district court***, Petitioners want to have the benefit of the Licenses to reduce potential damages. Therefore Petitioners refuse to say whether

---

[1] Here and throughout, "Petitioner" refers to Petitioners and their RPIs, including RPI GlobalFoundries U.S., Inc. ("GF"), as identified in the Definitions section of the proposed discovery requests provided at Appendix A.

[2] The Intel, [redacted] and [redacted] entities are identified in the Definitions section of the proposed discovery requests provided at Appendix A.

[3] The Challenged Patents are identified in the Definitions section of the proposed discovery requests provided at Appendix A.

they plan to raise a license defense in district court (at least until these IPRs are instituted). If Petitioners claim the benefit of the Licenses, then they are Licensees' sublicensees and exercising Licensee's rights. That puts them in privity. *See Taylor v. Sturgell*, 553 U.S. 880 (2008). It is unfair for Petitioners to cloak themselves Licensees' legal rights, while disclaiming privity.

PO's proposed discovery is narrowly tailored to address Petitioners' relationships with Licensees and to cut through the unfairness of Petitioners' gamesmanship. First, PO requests Petitioners' agreements and communications with Licensees and [redacted] relating to the products they sell or manufacture for them. Second, PO seeks to pose one interrogatory striking at the heart of the privity inquiry—whether any Petitioner intends to claim in district court the benefit of the Licenses. The requested additional discovery is therefore in the interests of justice.

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 challenged '195 and '502 patents. On July 8, 2020, Greenthread and [redacted] settled the [redacted] litigation, by granting a license to [redacted] through RPX Corporation ("RPX") as described below.

2. Intel-[redacted] Litigation

On February 1, 2022, Greenthread served Intel and [redacted] with a complaint (Ex. 2018) for infringement of each of the Challenged Patents, except the '014 patent. Ex. 2001, 1-4. After the '014 issued, Greenthread filed a First Amended Complaint against [redacted] and Intel which it served via ECF on April 29, 2022. Ex. 2003. The original case against Intel and [redacted] was severed and the case against Intel was transferred from the Western District of Texas to the District of Oregon. Ex. 2004, 22. The [redacted] litigation remained in Texas and continued in parallel with the *Intel* litigation.

[redacted] was a real-party-in-interest to the [redacted] litigation. Greenthread's allegations in the First Amended Complaint against [redacted] were based on, among other things, [redacted] components in [redacted] products. Ex. 2003, ¶¶18, 60, 76-81; Ex. 2005, 8 ("[redacted] Accused Products"), 18-20 (section entitled [redacted] Accused Products"); Ex. 2006, 1-34. After Patent Owner accused [redacted] products, additional counsel stepped in to represent [redacted] with respect to [redacted] products. Ex. 2007. [redacted] then filed its own IPRs against the Challenged Patents, which had been asserted against [redacted] products. Ex. 2008. The [redacted] petition named [redacted] as a real-party-in-interest. Ex. 2008, 7. Afterwards, Patent Owner added [redacted] as a party to [redacted] litigation. Ex. 2009. After [redacted] was added to the case, [redacted] counsel for [redacted]

products appeared in the case for [redacted] Ex. 2010. [redacted] other counsel did not represent [redacted]. Greenthread and Intel, [redacted], and [redacted] settled their disputes.

3. Greenthread Licenses to [redacted], Intel, and [redacted]

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

The licenses grant Licensees the right "to make, have made, use, have used, sell, … offer for sale, have offered for sale, have sold, … import, have imported, … and otherwise exploit or dispose of any Licensed Product and Service." Ex. 2022, 2 (definition of "Patent License"); *see also* Ex. 2034, 2; Ex. 2028. The Licenses define "Licensed Product and Service" to include "any product … made, have made, used, purchased, provided, … or otherwise exploited or disposed of by or on behalf of" Licensees. Ex. 2022, 2. The license covers all of the Challenged Patents. *See id.*, 3

("'Patents' shall mean …."). Accordingly, "any product" Licensees "have made" by any Petitioner or "purchase" from Petitioner is a "Licensed Product or Service" which Licensees have the right to "use, … sell, … obtain, … and otherwise exploit." *Id.*, 2-3.

B. These Proceedings

On October 11, 2023, Petitioners filed the first petition in these proceedings, IPR2024-00016. The -00016 petition contains no evidence or explanation regarding its timeliness and § 315(b), just the bald statement that the petition is timely. IPR2024-00016, Paper 1, §IV. IPR2024-00001 followed on October 12 and IPR2024-00017 on October 18 with the same bald statement. IPR2024-00001, Paper 1, §IV; IPR2024-00017, Paper 1, §IV. Two days later, Greenthread informed Petitioners that they and GF "may be operating, in part, under" the Licenses and that "the petitions are [therefore] time barred." Ex. 2011. Greenthread's email included much of the evidence discussed below, including that Omnivision sells OV9282, among other products, to Intel, that Cirrus Logic supplies to [redacted] and [redacted] and that Global Foundries serves as a contract manufacturer for all three Licensees. Exs. 2012-2015. Greenthread requested that Petitioners withdraw their petitions or at a minimum provide discovery into whether the petitions are time barred. Ex. 2011. On October 24, 2023, Petitioners responded refusing to withdraw the petitions or provide any discovery. Ex. 2016, 1.

On October 27, Petitioners filed four more petitions, IPR2024-00018, IPR2024-00019, IPR2024-00020, and IPR2024-00021, containing the identical statement regarding timeliness and § 315(b) as the original two Petitions. On November 1, Greenthread emailed the Board to "request authorization to file a motion for additional discovery," and providing both parties' positions on the request. Ex. 2017. On December 21, 2023, the Board authorized the instant motion, which Greenthread filed the next day.

C. Petitioners' Relationship with Patent Owner's Licensees and the Current and Co-Pending Proceedings

Patent Owner is currently involved in district court litigation against all three Petitioners. Each of the district court actions was filed before any of these petitions was filed. Patent Owner has not sued Global Foundries or accused it of infringement of the Challenged Patents.

1. Cirrus Logic

On March 31, 2023, Greenthread filed a complaint in the U.S. District Court for the Western District of Texas alleging that Cirrus Logic infringes each of the Challenged Patents. Greenthread has served only preliminary infringement contentions in the district court. Ex. 2018. Greenthread's final infringement contentions are due March 21, 2024. Ex. 2019, 2.

Cirrus Logic chips, including those currently accused, are incorporated into numerous [redacted] products accused in the [redacted] litigation. For example, CS35L41 and

CS40L25 are both currently accused and both are components in several versions of the [redacted] Xperia handset, which was accused in the [redacted] litigation. *Compare* Ex. 2021, 17-18 *with* Ex. 2035 at 2, 10, 63, 64 *with* Ex. 2018 at 4. The accused [redacted] WH1000X also includes two Cirrus Logic chips about which Greenthread has yet to receive discovery. *Compare* Ex. 2021, 19 *with* Ex. 2036 at 1 *with* Ex. 2018 at 4.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 design." Ex. 2020, 1. The CS42L43 is the apparent next generation following the CS42L42, which is accused in the *Cirrus Logic* litigation. Ex. 2018 at 4. Both chips are audio codec chips for integration with the same industry standard. Exs. 2023, 2024. Since discovery has not opened in the *Cirrus Logic* case, Greenthread has received no discovery on the CS42L43.

A Cirrus Logic investor presentation lists [redacted] and [redacted] as among its "Tier One Customers." Ex. 2013, 5. Further, Cirrus Logic indemnifies its customers. Cirrus Logic's standard "Terms and Conditions of Sale" state that they "apply to all quotations made by and purchase orders acknowledged in writing by Cirrus Logic." Ex. 2026, 1. The sales agreements states that "Cirrus Logic shall defend any proceeding brought against Buyer if and to the extent that the proceeding is based on a claim that any Products supplied by Cirrus Logic directly infringe any

… United States … patent." *Id*. at 10. It also says that Cirrus Logic "shall pay all damages and costs finally awarded" in such a proceeding. *Id.*

2. 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. Omnivision sells the accused OV7261 to [redacted] who incorporates it into at least the [redacted]. Ex. 2030.[4] [redacted] was an accused product in the [redacted] litigation. Ex. 2021, 18. Omnivision also sells the accused OV9282 to Intel who incorporates the accused OV9282 into at least its RealSense D400 series stereo vision depth camera system. Ex. 2031, 43 (Table 3-14).

[4] Greenthread here cites a public advertisement from the reverse engineering firm TechInsights regarding its report on the [redacted]. The advertisement states that [redacted] uses "[t]wo B&W cameras by OmniVision." Ex. 2030, 1. Greenthread understands that the report, which costs $25,000, discloses that at least one chip is the OV7261.

3. Global Foundries

Petitioners identified Global Foundries as a real party in interest to these proceedings. Petition (Paper 1), 2. Global Foundries' investor materials state that it manufactures products under contract for Intel, [redacted], and [redacted]. Ex. 2014, 19. 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 property infringement claims and indemnify them for damages." Ex. 2033, 40.

III. THE REQUESTED DISCOVERY

PO requests discovery that goes to the status of Licensees and [redacted] as RPIs and/or privies of any Petitioner. If any of those third parties is deemed an RPI or privy of a Petitioner, this petition is time-barred by 35 U.S.C. §315(b). Specifically, PO seeks discovery regarding (summarized; *see* Appendix A):

> 1. Agreements between i) any Petitioner and/or its affiliates and ii) a Licensee or [redacted] (or their affiliates), relating to the products that Petitioner and/or its affiliates sells to, manufactures for, or designs with or for, Licenees or [redacted].
>
> 2. All communications between i) any Petitioner and/or its affiliates and ii) any Licensee or [redacted] (or their affiliates), relating to Patent Owner or the products that Petitioner and/or its affiliates sells, makes, or designs to, for, or with any Licensee or [redacted]
>
> 3. Whether any of Petitioners' activities are licensed or exhaust PO's rights.

IV. THE INTERESTS OF JUSTICE SUPPORT GRANTING THE REQUESTED DISCOVERY

The Board applies the familiar five-factor "necessary in the interest of justice" standard ("the *Garmin* factors") regarding motions for additional discovery. *See Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6–7 (PTAB Mar. 5, 2013).

A. There is More Than a Possibility or Mere Allegation That the Requested Discovery Will Yield Useful Information

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). "[A] variety of pre-existing 'substantive legal relationship[s]' between" two parties 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]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 at 12 (PTAB Jan. 24, 2019) (precedential)).

As related above, Petitioners have extensive "pre-existing substantive legal relationship" with time-barred Licensees including by selling, making, and desiging

products with or for Licensees. Many of these products were components of accused products in prior litigation with Licensees. *Supra* II.C. Petitioners' agreements and communications with Licensees will show the precise nature of those relationships.

For example, Cirrus Logic has said that its "engineers work closely with [OEM] product teams," to build "*custom*" products. Ex. 2025. Similiarly, in a sworn declaration, Cirrus Logic has said that Global Foundries is responsible for the design of the infringing aspects of its products. Ex. 2032, ¶4. If that is true with respect to Cirrus Logic, it may also be true with respect to products Global Foundries makes or made for Licensees.

Further, making "custom" products and "work[ing] closely with" Licensees "product teams" indicates that Petitioners and Licensees may have an exclusive manufacturing agreement for some products and/or products are actually jointly designed. Ex. 2025. The panel found this type of relationship relevant in *Ventex*. IPR2017-00651, Paper 148 at 13. Additionally, when a party makes custom products it often includes intellectual property "clearance" provisions of the type that the panel found relevant in *Bungie Inc. v. Worlds Inc.*, IPR2015-01264, Paper 64 at 40 (PTAB Jan. 14, 2020).

Further, contracts to "[a]ssembl[e] equipment based on information and instructions provided by" another party are "suggestive of an agency relationship." *In re Google LLC*, 949 F.3d 1338, 1346 (Fed. Cir. 2020). 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). Petitioners' manufacturing of accused products for Licensees may be similar to the assembling of equipment in *Google* and thus establish an agency relationship and privity. Whether Petitioners contend that they are acting as "have made" vendors under the Licenses would also be relevant to whether Petitioners are Licensees' agents.

Petitioners' statements indicate that they indemnify their customers like Licensees. *Supra* Exs. 2026, 2033. Presumably major customers such as Licensees would have gotten similar or better terms to what Petitioners provide as a matter of course. Those indemnity agreements would support a finding of privity. *Ericsson Inc. v. Regents of Univ. of Minnesota*, IPR2017-01197, Paper 56 at 8, 10 (PTAB Sept. 18, 2020).

Further, confirmation of Petitioners' sales of accused products to Licensees would show that they and Licensees are "preceeding and succeeding owners of property," specifically accused or licensed or infringing goods. *Taylor*, 553 U.S. at 894. The sales information and agreements would also show that sales of products to Licensees are "have made" under the Licenses (even if Petitioners dispute that for now to avoid privity). That would make Petitioners the beneficiaries of an

agreement "directly related" to the accused products, i.e. the Licenses. *Ventex*, IPR2017-00651, Paper 148 13.

B. The Second *Garmin* Factor Favors PO

The first two discovery requests (requests for agreements and communications, *supra* Section III) do not seek litigation positions. To the extent Petitioners may contend that the third discovery request (*id.*) seeks Petitioners' litigation positions, PO seeks that discovery request to prevent the manifest unfairness of Petitioners taking directly contrary positions in two proceedings—i.e. arguing no privity here, but asserting a license defense in district court. It is essential that Petitioners provide this information ***now***, to prevent the unfairness of Petitioners changing their positions ***later*** in district court. The Board should not allow Petitioners to gain an unfair advantage by saying one thing in district court and another thing at the PTAB.

C. The Requested Information Is Not Reasonably Available Through Other Means

The third *Garmin* factor favors granting the discovery requests, because the information sought is not reasonably available through other means. Most obviously, whether any Petitioner contends it is a "have made" vendor under a License is information only in its possession. Likewise, the precise nature of any Petitioner's relationship with Licensees and [redacted], and which products that Petitioner

sells to them can only be known by looking at the requested agreements and communications.

PO has investigated the RPI/privy issue to the extent possible via publicly available information and needs the information sought by the discovery requests to ascertain the exact nature of the relationship between each Petitioner and the time-barred parties. Without discovery, PO cannot know, for example, if or how any Petitioner and its customers collaborate on product design, which customers buy which products, and which of that Petitioner's products are incorporated into which Licensee or [redacted] products.

Furthermore, institution is a threshold issue. IPR "may not be instituted if the petition" is untimely. 35 U.S.C. § 315(b). PO needs the information ***now* to prevent Petitioner's gamesmanship** and in connection with ***this proceeding***. Further PO has no other means to obtain discovery regarding GF, because PO has not sued GF.

D. The Requests Are Easily Understandable

As set forth in Appendix A, the three discovery requests are straightforward.

E. The Requests Are Not Overly Burdensome

Patent Owner's requested discovery is limited to agreements and communications relating to products sold to time barred parties, and whether any Petitioner intends to claim the benefit of the Licenses. The narrowly-tailored nature of this discovery ensures that Petitioners will not suffer an undue burden in

complying with the requests. The first two requests (requests for production) are requests for specific types of agreements and communications. If any Petitioner claims that these documents are too numerous to produce, it would only underscore the extent of its relationship with Licensees and the need for the documents. Regarding the third request (the interrogatory), each Petitioner should be able to easily state whether or not it intends to claim the benefit of prior licenses, and its apparent unwillingness to confirm or deny this—or perhaps take inconsistent positions at the PTAB and in district court—cannot be attributed to anything burdensome to Petitioners.

Additionally, in district court, PO has requested or will request the same documents, which cuts against any burden argument that Petitioners may present. In other words, Petitioners need to provide the responses anyway.

V. TIMING OF DISCOVERY RESPONSES

If additional discovery is granted, PO requests that Petitioner be ordered to submit all the requested discovery immediately, because the POPRs in several of these proceedings will be due during the briefing of PO's motion.

VI. CONCLUSION

Therefore, the Board should grant the requested discovery requests.

Dated: December 22, 2023

Respectfully submitted,

/Alan Whitehurst/

Alan Whitehurst
Reg. No. 43,263
awhitehurst@mckoolsmith.com
Nicholas T. Matich
Reg. No. L1,373
nmatich@mckoolsmith.com
Arvind Jairam
Reg. No. 62,759
ajairam@mckoolsmith.com
Stuart McCommas
Reg. No. 71,834
smccommas@mckoolsmith.com
MCKOOL SMITH, P.C.
1999 K St. NW, Suite 600
Washington, DC 20006
Telephone: (202) 370-8300
Facsimile: (202) 370-8344

Archis "Neil" Ozarkar
Reg. No. 71,265
nozarkar@mckoolsmith.com
MCKOOL SMITH, P.C.
600 Travis Street, Suite 600
Houston, TX 77002
Telephone: (713) 485-7300
Facsimile: (713) 485-7344

Counsel for Patent Owner

CERTIFICATION OF SERVICE

The undersigned hereby certifies that a copy of this **PATENT OWNER'S MOTION FOR ADDITIONAL DISCOVERY PURSUANT TO 37 C.F.R. § 42.51(B)(2)(I)** has been served on Petitioner via email on the following counsel of record for Petitioner:

Scott Weidenfeller (No. 54,531)
sweidenfeller@cov.com
Covington & Burling LLP
One CityCenter,
850 Tenth Street, NW
Washington, DC 20001-4956
Telephone: (202) 662-5923
Facsimile: (202) 778-5923

Anupam Sharma (No. 55,609)
asharma@cov.com
Covington & Burling LLP
3000 El Camino Real,
5 Palo Alto Square,
Palo Alto, CA 94306
Telephone: (650) 632-4720
Facsimile: (650) 632-4800

Raj Paul (No. 64,492)
rpaul@cov.com
Covington & Burling LLP
One CityCenter,
850 Tenth Street, NW
Washington, DC 20001-4956
Telephone: (202) 662-5740
Facsimile: (202) 778-5923

Bert Greene (No. 48,366)
bgreene@duanemorris.com
Andrew Liddell (No. 65,693)

waliddell@duanemorris.com
DUANE MORRIS LLP
Las Cimas IV
900 S. Capital of Texas Hwy., Suite 300, Austin, TX 78746
Telephone: (512) 277-2246
Facsimile: (512)277-2301

Daniel G. Nguyen (No. 42,933)
dnguyen@lockelord.com
Emma A. Bennett (No. 80,631)
emma.bennett@lockelord.com
LOCKE LORD LLP
600 Travis St., Suite 2800
Houston, Texas 77002
Telephone: (713) 226-1200
Facsimile: (214) 223-3717

David H. Bluestone (No. 44,542)
david.bluestone@bfkn.com
Barack Ferrazzano Kirschbaum & Nagelberg LLP
200 West Madison St., Suite 3900
Chicago, Illinois 60606
Telephone: (312) 984-3106
Facsimile: (312) 984-3150

Dated: December 22, 2023 By: */Alan Whitehurst/*
Alan Whitehurst, Reg. No. 43,263

APPENDIX A

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.

IPR2024-00019
U.S. Patent No. 11,316,014

PATENT OWNER'S PROPOSED DISCOVERY REQUESTS TO PETITIONER

INSTRUCTIONS

1. If you withhold information based on privilege, work product protection, common interest privilege, or other exemption from discovery, provide a privilege log stating the date, the type of information withheld (e.g., document, email, phone call) with a brief description, the participants/recipients, and for written communications, the author.

2. This should not be covered by any request, but just to be clear, any Petitioner does not need to log or produce communications solely between it and its litigation and/or IPR counsel from Covington & Burling LLP, Duane Morris LLP, Locke Lorde LLP and/or Barack Ferrazzano Kirschbaum & Nagelberg LLP.

DEFINITIONS

1. "OV" means OmniVision Technologies, Inc. and/or its affiliates.

2. "CL" means Cirrus Logic, Inc. and/or its affiliates.

3. "AMS" means ams Sensors USA, Inc., OSRAM GmbH, ams-OSRAM AG, collectively, and/or its affiliates.

4. "GF" means GlobalFoundries U.S., Inc. and/or its affiliates.

5. "Petitioner" means any petitioner or real party in interest to these proceedings, including OV, CL, AMS, and GF.

6. "Intel" means Intel Corporation and/or its affiliates.

7. "[redacted], their affiliates.

8. "[redacted]" means [redacted], their affiliates.

9. "[redacted]" means [redacted]. and its affiliates

10. "Licensees" mean Intel, [redacted], and [redacted] (individually "Licensee").

11. "Challenged Patents" means any patent challenged in these proceedings, including U.S. Patent Nos. 8,421,195; 9,190,502; 10,510,842; 10,734,481; 11,121,222; and 11,316,014.

REQUESTS FOR PRODUCTION

Request for Production No. 1

All agreements between i) any Petitioner and/or its affiliates and ii) any Licensee or [redacted] (or their affiliates), relating to the products that Petitioner and/or its affiliates sells, makes, or designs to, for, or with any Licensee or [redacted], including sales contracts, purchase orders, and design agreements.

Request for Production No. 2

All communications between i) any Petitioner and/or its affiliates and ii) any Licensee or [redacted] (or their affiliates), relating to Patent Owner or the products that Petitioner and/or its affiliates sells, makes, or designs to, for, or with any Licensee or [redacted], including specifications, plans, drawings, (including drafts of the forgoing), test results, documents identifying the finished product into which Petitioner's product is incorporated and any documents showing the involvement and/or role of Petitioner and/or Licensee or [redacted] with respect to the product, such as communications between engineers working for a Petitioner and engineers working for a Licensee.

INTERROGATORIES

Interrogatory No. 1

State whether any Petitioner condends that any of its activities are licensed to or exhaust Patent Owner's rights in a Challenged Patent.

Dated: December 22, 2023

Respectfully submitted,

/Alan Whitehurst/

Alan Whitehurst
Reg. No. 43,263
awhitehurst@mckoolsmith.com
Nicholas T. Matich
Reg. No. L1,373
nmatich@mckoolsmith.com
Arvind Jairam
Reg. No. 62,759
ajairam@mckoolsmith.com
Stuart McCommas
Reg. No. 71,834
smccommas@mckoolsmith.com
MCKOOL SMITH, P.C.
1999 K St. NW, Suite 600
Washington, DC 20006
Telephone: (202) 370-8300
Facsimile: (202) 370-8344

Archis "Neil" Ozarkar
Reg. No. 71,265
nozarkar@mckoolsmith.com
McKool Smith, P.C.
600 Travis Street, Suite 600
Houston, TX 77002
Telephone: (713) 485-7300

Counsel for Patent Owner