Trials@uspto.gov
571-272-7822

Paper 28
Date: April 18, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

GREENTHREAD, LLC,
Patent Owner.

IPR2024-00001 (Patent 10,734,481 B2)
IPR2024-00016 (Patent 10,510,842 B2)
IPR2024-00017 (Patent 8,421,195 B2)
IPR2024-00018 (Patent 9,190,502 B2)
IPR2024-00019 (Patent 11,316,014 B2)
IPR2024-00020 (Patent 11,121,222 B2)
IPR2024-00021 (Patent 11,121,222 B2)[1]

Before DONNA M. PRAISS, KRISTINA M. KALAN,
JON B. TORNQUIST, JEFFREY W. ABRAHAM,
MONICA S. ULLAGADDI, and JULIA HEANEY,
Administrative Patent Judges.[2]

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[1] The parties are not authorized to use this style caption.
[2] This is not an expanded panel. The panel for IPR2024-00001 and IPR2024-00017 includes Judges Kalan, Tornquist, and Ullagaddi. The panel for IPR2024-00016 and IPR2024-00019 includes Judges Tornquist, Ullagaddi, and Heaney. The panel for IPR2024-00018 includes Judges Tornquist, Abraham, and Ullagaddi. The panel for IPR2024-00020 and IPR2024-00021 includes Judges Praiss, Tornquist, and Ullagaddi.

PER CURIAM.

ORDER
Settlement as to ams-OSRAM USA Inc. Prior to Institution of Trial
37 C.F.R. § 42.74

I. INTRODUCTION

With the Board's authorization, Petitioner ams-OSRAM USA Inc. ("ams-OSRAM") and Greenthread LLC ("Patent Owner") filed a Joint Motion to Terminate Proceeding as to ams-OSRAM USA Inc. in each of the above-identified proceedings. Paper 25 ("Joint Motion").[3] In support of each Joint Motion, ams-OSRAM and Patent Owner filed a copy of the Settlement and License Agreement (Ex. 1056, "Settlement Agreement") and a Joint Request That Agreement Be Treated as Business Confidential Information and Be Kept Separate (Paper 26 ("Joint Request")) pursuant to 37 C.F.R. § 42.74.

II. DISCUSSION

In the Joint Motions, ams-OSRAM and Patent Owner represent that they have reached an agreement to jointly seek termination of the above-

[3] This Order cites to papers and exhibits in IPR2024-00001. Corresponding items were filed in IPR2024-00016, IPR2024-00017, IPR2024-00018, IPR2024-00019, IPR2024-00020, and IPR2024-00021.

identified *inter partes* review proceedings with respect to ams-OSRAM, that the "Settlement Agreement completely resolves all pending controversies between ams-OSRAM and Greenthread concerning the Challenged Patent[s]," and that the filed copy of the Settlement Agreement is a "true copy." Paper 25, 1. ams-OSRAM and Patent Owner "certify that there are no other agreements, or understandings, oral or written, between them, including any collateral agreements, made in connection with, or in contemplation of, the termination of ams-OSRAM from th[ese] proceeding[s] as set forth in 35 U.S.C. § 317(b)." *Id.*

These proceedings are at an early stage, and we have not yet decided whether to institute trial in any of the proceedings. In view of the early stage of the proceedings and the settlement between ams-OSRAM and Patent Owner, we determine that good cause exists to terminate the proceedings as to ams-OSRAM. Cirrus Logic, Inc. and OmniVision Technologies, Inc. remain as Petitioner in the proceedings.

In the Joint Requests, ams-OSRAM and Patent Owner request that the Settlement Agreement be treated as business confidential information and be kept separate from the files of the patents involved in these *inter partes* review proceedings. Paper 26, 1. ams-OSRAM and Patent Owner further "request that the Board inform them if anyone seeks production of the agreements and afford them an opportunity to address whether such request is supported by good cause." *Id.*

We grant-in-part the Joint Requests. After reviewing the Settlement Agreement between ams-OSRAM and Patent Owner, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement as business confidential information pursuant to 37 C.F.R. § 42.74(c).

However, we deny the portion of the Joint Requests requesting that the Board inform ams-OSRAM and Patent Owner if anyone seeks production of the agreements and afford them an opportunity to address whether such request is supported by good cause. Neither the statute nor the rule includes such a requirement.

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motion to Terminate Proceeding as to ams-OSRAM USA Inc. in each of the above-identified proceedings is *granted*, and the proceedings are *terminated* only as to ams-OSRAM USA Inc.;

FURTHER ORDERED that Cirrus Logic, Inc. and OmniVision Technologies, Inc. will remain as Petitioner in each of the above-identified proceedings, and the proceedings will continue;

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IPR2024-00021 (Patent 11,121,222 B2)

FURTHER ORDERED that the Joint Request That Agreement Be Treated as Business Confidential Information and Be Kept Separate in each of the above-identified proceedings is *granted-in-part* and *denied-in-part*, in the manner described above, and the Settlement Agreement shall be kept separate from the files of Patents 10,734,481 B2; 10,510,842 B2; 8,421,195 B2; 9,190,502 B2; 11,316,014 B2; and 11,121,222 B2 and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 37 C.F.R. § 42.74(c);

FURTHER ORDERED that Cirrus Logic, Inc. and OmniVision Technologies, Inc. shall file Updated Mandatory Notices within three (3) business days of this Order, indicating which real parties-in-interest remain in the proceedings; and

FURTHER ORDERED that the caption for each of the above-identified proceedings is modified as set forth in the attached Appendix, and the remaining parties shall use this caption in all further filings.

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FOR PETITIONER:

Scott C. Weidenfeller
Anupam Sharma
Raj Paul
COVINGTON & BURLING LLP
sweidenfeller@cov.com
asharma@cov.com
rpaul@cov.com

Bert Greene
Andrew Liddell
DUANE MORRIS LLP
bgreene@duanemorris.com
waliddell@duanemorris.com

Daniel G. Nguyen
Emma A. Bennett
LOCKE LORD LLP
dnguyen@lockelord.com
emma.bennett@lockelord.com

David H. Bluestone
BENESCH FRIEDLANDER COPLAN & ARONOFF LLP
dbluestone@beneschlaw.com

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FOR PATENT OWNER:

Alan Whitehurst
Nicholas T. Matich
Arvind Jairam
Stuart McCommas
Archis "Neil" Ozarkar
MCKOOL SMITH, P.C.
awhitehurst@mckoolsmith.com
nmatich@mckoolsmith.com
ajairam@mckoolsmith.com
smccommas@mckoolsmith.com
nozarkar@mckoolsmith.com