PUBLIC VERSION

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SEMICONDUCTOR COMPONENTS INDUSTRIES, LLC,
Petitioner,

v.

GREENTHREAD LLC,
Patent Owner

Case IPR2023-01244
U.S. Patent No. 11,121,222

PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION FOR ADDITIONAL DISCOVERY

I. INTRODUCTION

Patent Owner ("PO") Greenthread LLC's motion for additional discovery (Paper 8) ("motion") should be denied. Petitioner has no real party-in-interest (RPI) or privity relationship with Intel, and no additional discovery is necessary to confirm this fact. Petitioner was not involved in any of the *inter partes* review (IPR) proceedings involving PO's patents filed by Intel, and PO did not exercise any direction, control, or funding of those IPRs; likewise, Intel, were not and are not involved in this IPR and have not exercised any direction, control, or funding of this IPR. *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1342–43 (Fed. Cir. 2018); *WesternGeco LLC v. ION Geophysical Corp.*, 889 F.3d 1308, 1319-21 (Fed. Cir. 2018); *Union 2017 LLC v Facebook Inc.*, 989 F.3d 1018, 1028-1029 (Fed. Cir. 2021). Moreover, considering that PO *settled* with each of Intel, well before PO filed this petition, there is no explanation as to why Intel, would have any interest in this petition. *See infra*, Section II.

PO's motion is premised on a factual misstatement. At the top of page 4 of PO's motion, PO refers to "licenses (submitted here as Exhibit 2022) between PO and Intel/ PO refers to the Intel/ "license" at least a dozen more times throughout its motion. Here is the problem: EX2022 is not "licenses . . . between PO and Intel/ Instead, EX2022 is an agreement between PO and RPX. Intel

and [redacted] are not parties to EX2022. Petitioner, for its part, has never even seen EX2022. Petitioner's undersigned outside counsel was only provided with a copy of EX2022 last month during discovery in the corresponding Delaware litigation, which was well after the petition in this proceeding was filed. Thus, PO's statement to the Board that EX2022 is a license "between" PO and each of Intel and [redacted] is false and misleading, especially considering that PO did not inform the Board that EX2022 is actually an agreement with RPX.

At best, Petitioner has a standard manufacturer/customer relationship with Intel, [redacted], and such a relationship does not create an RPI or privity relationship. *Samsung Electronics Co. Ltd. v. Netlist Inc.,* IPR2022-00615, Paper 64 at 22-26 (PTAB, June 30, 2023). It is legally and factually impossible for Petitioner to be in privity with Intel, [redacted] based on an agreement that (a) Petitioner has never seen; (b) to which Petitioner is not a party; and (c) to which none of Intel, [redacted] are parties. The exceptionally attenuated facts in PO's motion do not suggest privity and do not support a discovery fishing expedition.

II. BACKGROUND

PO sued Intel, [redacted] for infringement of U.S. Patent Nos. 11,121,222 and 10,510,842 in 2022. Petition (Paper 2) at 2-3 (Mandatory Notices). Intel, [redacted] and [redacted] each filed their own IPR petitions against the '222 and '842 patents in December 2022, January 2023, and February 2023. After the parties settled, those

proceedings were jointly terminated in May 2023. *Id.*; *see* IPR2023-00420, Paper 10 and IPR2023-00552, Paper 10 (Granting Joint Motions to Terminate Intel '222 patent IPRs); IPR2023-00308, Paper 11 (Intel '842 IPR); IPR2023-00324, Paper 10 ([redacted] '222 IPR); IPR2023-00376, Paper 10 ([redacted] '842 IPR); IPR2023-00509, Paper 10 ([redacted] '222 IPR); and IPR2023-00506, Paper 11 ([redacted] '842 IPR). When requesting that these IPRs be terminated, PO represented that it "settled all disputes relating to the Patent[s]-in-Suit" with each of Intel, [redacted]. IPR2023-00420, Paper 8 at 3 (Joint Motion to Terminate IPR on '222 patent with Intel); IPR2023-00308, Paper 9 at 3 ('842 IPR with Intel); IPR2023-00324, Paper 8 at 2 ('222 IPR with [redacted] IPR2023-00376, Paper 8 at 2 ('842 IPR with [redacted] IPR2023-00509, Paper 8 at 2 ('222 IPR with [redacted] and IPR2023-00506, Paper 9 at 2 ('842 IPR with [redacted]

PO sued Petitioner for infringement of the '222 and '842 patents in April 2023. Petitioner promptly filed IPR petitions against these patents in July 2023. *See Greenthread, LLC v. ON Semiconductor Corporation and Semiconductor Components Industries, LLC*, 1:23-cv-00443 (D. Del) (complaint filed April 21, 2023); IPR2023-01242; IPR2023-01243; IPR2023-01244.

On October 5, 2023, more than two months after Petitioner filed its petitions, PO alleged by e-mail that Petitioner was in privity with or an RPI of Intel, [redacted] and [redacted] because each of Intel, [redacted] are "OnSemi customers." PO demanded

that Petitioner either withdraw the petitions or produce discovery to prove a negative, *i.e.*, "documents demonstrating that Intel, [redacted] are not RPIs or privies, including all agreements between OnSemi and these companies." EX2014 at 3-4. Petitioner's allegation came as a surprise and was puzzling, at best. As of October 5, when PO sent its accusatory e-mail, PO had identified only a single allegedly infringing onsemi product in its Complaint in the Delaware litigation and that product has never been sold to any of Intel, [redacted].

On October 11, Petitioner reiterated to PO that Petitioner correctly identified all RPIs and had not signed a joint defense agreement for this matter. EX2014 at 1-2. Minutes later, PO responded with a single line e-mail: "Does OnSemi intend to argue that sales to Intel and [redacted] are licensed?" EX1046. PO then sent a further e-mail later that evening stating that it intended to seek authorization from the Board for additional discovery, including Petitioner's litigation position regarding whether Petitioner "intends to claim that its sales to Intel and [redacted] are licensed." EX1047. On October 12, PO, for the first time, identified allegedly infringing products "believed to have been sold to Intel and [redacted] Motion at 6; EX2015.

III. PO HAS MANUFACTURED A LICENSE DEFENSE ISSUE

PO's emphasis on the supposed Intel and [redacted] "licenses" is entirely misplaced and manufactured by PO for the sake of this motion. First, EX2022 is not a license between Greenthread and each of [redacted] and Intel. EX2022 is an agreement

between Greenthread *and RPX*. Intel and [redacted] are not parties to EX2022. Although EX2022 suggests that RPX may offer a sublicense to each of Intel and [redacted] that sublicense has not been provided and neither has any further sublicense grant from either of Intel or [redacted] to Petitioner.

Moreover, Petitioner itself has never seen EX2022. PO filed its motion under seal and would not give permission to Petitioner's undersigned outside counsel to provide a copy of EX2022 to Petitioner's in-house personnel, with the result being that only Petitioner's outside counsel has seen EX2022. It is beyond unreasonable for PO to base its discovery demand on an agreement that Petitioner has not seen and that involves two parties — PO and RPX — with whom Petitioner has no relationship that is in any manner relevant to this proceeding.

Moreover, the party who should determine whether Petitioner is licensed *is PO*, the party who owns the patents and who issued the license to RPX in EX2022. Indeed, in its motion, PO states that "[s]ales to Intel and [redacted] are likely licensed under the Intel and [redacted] licenses." Motion at 4. Although PO equivocates with the word "likely," it is unclear why discovery on any license issue is necessary in view of this (somewhat) clear statement on page 4 of PO's motion.

In addition, PO wants to have it both ways on the license issue. On page 4 of its Motion, PO states "[s]ales to Intel and [redacted] are likely licensed under the Intel and [redacted] licenses." Motion at 4. But, just two pages later, PO states that, "[o]n

October 12, 2023, PO served an initial identification of accused products naming products believed to have been sold to Intel and [redacted] Mot. at 6. How is it possible that PO can accuse products of infringement that are licensed? This startling and unexplainable inconsistency demonstrates that PO's "license" issue is manufactured for this motion to create a supposed hook for a nonexistent privity relationship.

In any event, whether Petitioner ultimately asserts a license defense in the district court has no bearing on the resolution of this motion. In *Taylor v. Sturgell*, the Supreme Court set out the "[t]he substantive legal relationships justifying preclusion [, which] are sometimes collectively referred to as 'privity.'" 553 U.S. 880, 894 at n.8 (2008). None of the circumstances supporting non-party preclusion in *Taylor* involve a factual scenario that is remotely similar to that presented in this motion. PO is seeking to bar a stranger to an agreement between PO and RPX from enforcing its legal rights because that stranger to the agreement sold goods on an arms-length basis to a customer, and RPX had contracted with PO for the right to offer a patent sublicense to that customer. And with all due respect to Henry Campbell Black, *Taylor v. Sturgell* controls, not Black's Law Dictionary. No panel of this Board and no Court has ever found that privity exists on the facts of this motion. Because the facts of this motion do not create a privity relationship, PO's motion for additional discovery should be denied.

IV. THE *GARMIN* FACTORS SUPPORT DENYING PATENT OWNER'S REQUEST

The factors in *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6-7 (PTAB Mar. 5, 2013) (precedential) all favor denying PO's motion for additional discovery.

A. Factor 1: More Than a Possibility and Mere Allegation

No additional discovery is necessary to assess whether the RPX license (EX2022) implicates a time bar. It does not. As explained above, Petitioner is not a party to EX2022, and there is no basis in the caselaw to conclude that a party in Petitioner's position is a "privy" to two other non-parties to the agreement (Intel and [redacted] under *Taylor v. Sturgell*.

There is also no need for discovery related to Petitioner's alleged manufacturer-customer relationship. Standard manufacturer-customer relationships do not trigger RPI or privity bars. *See Samsung Electronics,* IPR2022-00615, Paper 64 at 23 ("As stated in the Institution Decision, Petitioner provides compelling authority that a manufacturer-customer relationship alone does not establish privity, even with indemnity provisions.") (citing *Wi-Fi One, LLC v. Broadcom Corp*., 887 F.3d 1329, 1340–41 (Fed. Cir. 2018); *WesternGeco,* 889 F.3d at 1321–22. None of PO's evidence goes further than showing such a typical arms-length relationship between companies in the marketplace. For example, EX2003 is a presentation that lists over seventy customers of Petitioner, two of which are [redacted] (EX2003

at 12); EX2005 is a 10-K listing over seventy "representative OEM customers and end-users," with [redacted] listed (EX2005 at 11); and EX2009 is a Zacks article (with no author identified) naming Intel, [redacted] as customers along with twelve other companies (EX2009 at 2). EX2004 is an Intel presentation identifying a Petitioner product as one of several products compatible with an Intel product (EX2004 at 10); and EX2006-EX2008 are data sheets for Petitioner products that are compatible with Intel CPUs. None of this is remarkable in the least.

That Petitioner "specifically named [redacted] among its major customers in multiple investor disclosures, including to the SEC" (Motion at 10) does not show that Petitioner's relationship with these entities is anything other than a standard supplier/customer relationship, and certainly does not indicate anything more. Indeed, as noted above, [redacted] are listed on the 10-K form among over seventy "representative OEM customers and end-users." EX2005 at 11. And that "Petitioner's products are described in data sheets as being 'optimized for Intel's . . . CPUs,'" and includes "an 'Intel Proprietary Interface'" (Motion at 10) is similarly irrelevant. That a product is compatible with customer products is not enough to indicate any RPI or privity relationship. *See Assa Abloy AB v. CPC Patent Tech. Pty., Ltd.*, IPR2022-01093, Paper 20 at 25-27 (PTAB Feb. 2, 2023).

The fact that EX2010, Petitioner's standard purchase agreement, "provides for indemnification of its customers" does not establish an RPI or privity relationship

between Petitioner and its customers or a need for additional discovery. PO's reliance on *Paypal* to state that "indemnification is a factor favoring finding of an RPI or privity relationship" mischaracterizes *Paypal*, which was cabined to specific facts that are not present in this proceeding.[1] Indeed, *Paypal* itself states that "the mere existence of an indemnity agreement might not be enough to find privity." *Paypal, Inc. v. Personalweb Tech., LLC*, IPR2019-01093, Paper 27 at 18 (PTAB Nov. 27, 2019). And as the Federal Circuit explained in *WesternGeco*, the "non-specific nature" of indemnification provisions, like those of the standard agreement (EX2010), as well as the lack of any requests for indemnity as to the '222 and '842

[1] In *Paypal*, district court cases involving Amazon and Amazon's customers were involved in an multidistrict litigation ("MDL") proceeding. *Paypal, Inc. v. Personalweb Tech., LLC*, IPR2019-01093, Paper 27 at 5, 9 (PTAB Nov. 27, 2019). Amazon defended the customer petitioners in the MDL and argued in the MDL that it was in privity with the customer petitioners. Rather than an "ambiguous and undefined" obligation to indemnify (as in *WesternGeco*), "Amazon actually assumed control of the lawsuits involving its customers, defended them, and secured relief on their behalf." *Id.* at 15-19. None of these facts is present here.

patents between Petitioner and any of Intel, [redacted][2], cuts against a finding of privity or RPI and is therefore an improper basis for additional discovery. *WesternGeco,* 889 F.3d at 1319-21.

PO's reasoning that additional discovery is necessary because it will "identify the specific products Petitioner sells to Intel, [redacted] and which Intel, [redacted] or [redacted] products include Petitioner's components" and "shed light on whether Petitioner's products were components of products accused in the prior litigation and whether Petitioner's sales to Intel, [redacted] are likely to be accused in the litigation against Petitioner" is wholly irrelevant. PO is already aware that Intel, [redacted] are customers of Petitioner, and PO has an agreement with RPX that PO believes licenses such sales. Motion at 4-7; EX2022. PO has not explained why information on specific products is necessary in view of what PO already has in its possession, and how such information would relate to this proceeding. Indeed, PO appears to acknowledge that its requested discovery is only relevant to the district court proceeding as such discovery will show "whether Petitioner's sales to Intel,

[2] None of Intel, [redacted] requested indemnification from Petitioner with respect to PO, and Petitioner has not and will not request indemnification from Intel, [redacted] or [redacted] with regard to PO.

are likely to be accused in the litigation against Petitioner." Motion at 11.

At bottom, none of the information or reasoning of PO's motion shows "beyond speculation" that something useful will be uncovered. *Garmin*, Paper 26 at 6. Factor 1 therefore weighs against granting additional discovery.

B. Factor 2: Seeking Litigation Positions

PO acknowledges that its third discovery request wrongly seeks Petitioner's litigation position. Motion at 11-12; PTAB Consolidated Trial Practice Guide ("CTPG") (November 2019) at 26 ("Asking for the other party's litigation positions and underlying basis for those positions is not necessary in the interest of justice"). To overcome this admission, PO raises the argument that it is merely seeking Petitioner's litigation position to prevent Petitioner from changing positions later. As explained, however, whether Petitioner later makes a license defense has no bearing on this motion. PO has already conceded that sales to Intel and are "likely licensed," and Petitioner's license analysis in the parallel litigation matter would involve documents that have not yet been produced by PO.

C. Factor 3: Ability to Generate Equivalent Information

Although PO states that the "information sought is not reasonably available through other means" because "Petitioner's position vis-à-vis the Intel and licenses is not public and is uniquely within Petitioner's possession," this is plainly

not true. PO has a position on the requested issue and provided it on page 4 of its motion: "Sales to Intel and [redacted] are likely licensed under the Intel and [redacted] licenses." Because PO has already generated equivalent information (with just a smidge of unexplained equivocation with the word "likely"), Factor 3 weighs against granting additional discovery. In addition, PO does not explain whether PO has already generated equivalent information — concerning agreements and communications between Petitioner and each Intel, [redacted] — from PO's now resolved district court disputes with each of Intel, [redacted]

D. Factor 4: Easily Understandable Instructions

PO's discovery is not easily understandable. As discussed above, PO is asking that Petitioner be forced to respond to an interrogatory concerning an agreement that Petitioner has never seen. Moreover, the interrogatory concerns a potential affirmative defense in litigation and the response that may depend on the content of other documents that have not been provided. Factor 4 therefore weighs against granting additional discovery.

E. Factor 5: Requests Not Overly Burdensome to Answer

PO's requests are overly burdensome because PO is requesting *all agreements* Petitioner has with Intel, [redacted] relating to products it sells to each, and *all communications* Petitioner has ever had with Intel, [redacted] relating to the design of products Petitioner makes for each. The requests are not limited in scope

to any certain products, to any time period, or in any manner that would shed light on whether Petitioner is a privy of Intel, for this IPR petition. Whether Petitioner communicated with for example, about a product at some point in the past has no bearing on whether Petitioner and are privies for this IPR petition.

PO's statement that "[i]f Petitioner claims that these documents are too numerous to produce, it would only underscore the extent of its relationship with Intel, and the need for the documents" (Motion at 15) is disingenuous and fails to appreciate the volume of agreements and communications that occur between operating companies in standard supplier/customer relationships. Petitioner sells a wide range of semiconductor products across several business lines, and it is simply not reasonable and highly burdensome to chase down every communication concerning every product that would fall within the scope of PO's exceptionally burdensome requests.

Petitioner also respectfully submits that the Board should disregard PO's various arguments about what might be produced in the parallel district court proceeding. PO's motion concerns *this proceeding*. The scope of PO's requested additional discovery is inappropriate *in this proceeding* because it is not narrowly tailored to issues associated *with this proceeding*. And it is not "Petitioner's refusal to provide responses" that necessitated PO's motion. To the contrary, PO's motion

is rooted in PO's three-part strategy of (a) Step One: allege in the district court that products allegedly sold by Petitioner to Intel and [redacted] infringe the '222 and '842 patents; (b) Step Two: state in this proceeding that such sales are "likely licensed" (despite the allegation of infringement in the district court); and (c) Step Three: argue in this proceeding that the "likely license[]" is sufficient for privity and a springboard for additional discovery. This see-through strategy is entirely circular and does not establish privity between Petitioner and any party who is not already named as an RPI.

PO's delay also weighs heavily against granting its motion. *Douglas Dynamics, LLC v. Meyer Prods. LLC*, IPR2015-01839, Paper 29 at 8-9 (PTAB July 26, 2016). PO does not explain why it waited over two months from when the petitions were filed to raise its privity or RPI argument that is based on (a) the RPX agreement (EX2022) that PO is a party to and has been in possession of since at least April 2023 when the agreement was executed and (b) public information about Petitioner's customers. That PO has been aware of the information forming the basis for its motion from well before the filing of the petitions underscores PO's delay. Factor 5 weighs against granting additional discovery.

V. REPRESENTATIONS

Petitioner represents that it was not involved in any of the IPR proceedings involving PO's patents filed by Intel, [redacted]. Petitioner represents that none

of Intel, [redacted] (1) have or had any input, involvement, direction, or control regarding the decision to file the Petition in this proceeding, the prior art relied on in the Petition, or the arguments presented by the Petitioner, or (2) funded or will fund this IPR. None of Intel, [redacted] is an RPI of Petitioner or in privity with Petitioner. Petitioner correctly identified all RPIs in the Petition.

VI. PO'S REQUESTED TIMING OF DISCOVERY RESPONSES

To the extent additional discovery is granted, PO's requested discovery deadline of November 8, 2023 does not provide Petitioner with adequate time for production. As noted, PO delayed over two months before raising any RPI or privity argument and should not have the benefit of an expedited schedule due to its own failings. Should additional discovery be granted, Petitioner respectfully requests that an appropriate discovery schedule be determined at that time.

VII. CONCLUSION

PO's motion should be denied for at least the foregoing reasons.

Dated: October 31, 2023

Respectfully submitted,

/s/ Roger Fulghum
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CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. § 42.6(e), the undersigned certifies that on October 31, 2023, a complete and entire copy of the foregoing **PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION FOR ADDITIONAL DISCOVERY** and supporting exhibits were served on Patent Owner via electronic mail at the below addresses:

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October 31, 2023
Date

/s/ Roger Fulghum
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