IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

GREENTHREAD, LLC, Plaintiff, v. ON SEMICONDUCTOR CORPORATION and SEMICONDUCTOR COMPONENTS INDUSTRIES, LLC d/b/a ON SEMICONDUCTOR LLC, Defendants.	C.A. No. 23-cv-443-RGA-LDH

PLAINTIFF'S GREENTHREAD, LLC'S OPPOSITION TO DEFENDANTS' MOTION TO STAY THIS CASE PENDING *INTER PARTES* REVIEW

Dated: March 6, 2024

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The Court should deny Defendants ON Semiconductor Corporation's and Semiconductor Components Industries, LLC's (collectively, "onsemi" or "Defendants") motion to stay this case pending *inter partes* review ("IPR").

First, a stay risks irreparable prejudice to Greenthread. Greenthread's founder and the sole inventor on all of its patents, Dr. Mohan Rao, [redacted] Inventor testimony is always a critical part of a patent case, but even more so here, because Defendants assert that the patents are obvious over Dr. Rao's prior patents and the defendant in the related case disputes that Greenthread even owns the patents Dr. Rao assigned to it. Also Dr. Rao will testify to the conception and reduction to practice of his inventions to swear behind some of Defendants' prior art. In short, Dr. Rao's testimony will be the most important part of the entire case and losing his testimony would be devastating.

Moreover, at this stage of the case, it is impossible for Greenthread to preserve Dr. Rao's testimony effectively. Defendant's validity and ownership defenses are undeveloped. Greenthread cannot predict exactly what testimony will be relevant to them.

None of the other usual factors favor a stay. Defendants claim that "every asserted claim is at issue the instituted IPR proceedings," but as Defendants know, that is not the whole story. Br. 3. After receiving Defendants' core technical documents production, Plaintiff Greenthread, LLC's ("Greenthread") served its preliminary infringement contentions in *December* of last year alleging

infringement of *two additional patents* that are *not* at issue in the instituted IPR proceedings.[1] The Court's scheduling order gives Greenthread until *May 16, 2024* to amend its pleadings to conform to the infringement contentions. D.I. 24 at 2. Greenthread has concurrently moved to amend its complaint almost three months before that deadline, but Defendants have inexplicably opposed.

Defendants' brief consists of boilerplate arguments based on PTAB statistics that could be made in almost any patent case, but have little relevance here. Most importantly, the only argument Greenthread made at the institution stage is that the petitions are untimely. The PTAB disagreed, but that says nothing about the merits. No court would assume that because a party lost a motion to dismiss under a statute of limitations, it was likely to lose the case. Greenthread lost on timeliness and nothing else. The fact that the PTAB did not *sua sponte* deny Defendant's petition on the merits does not suggest that Defendants are likely to prevail in the end.

Furthermore, Defendants are virtually alone in being so confident of victory. [redacted] The Court should not credit Defendants' self-serving assumption that they will win at the PTAB when the actions of other sophisticated semiconductor companies show that they had less confidence in prevailing.

Finally, virtually every term in the patents has *already* been *consistently* construed by one or more of the Eastern District of Texas, the District of Oregon, and two different courts in the

[1] U.S. Patent Nos. 11,316,014 ("the '014 Patent") and 10,734,481 ("the '481 Patent").

Western District of Texas. The odds that PTAB proceedings will clarify any claim construction issue is remote.

I. BACKGROUND

Dr. Mohan Rao is Greenthread's founder and inventor on the challenged patents. After earning a Ph.D. in India where he was raised, Dr. Rao immigrated to the United States in the 1970s and earned a second Ph.D., studying under Nobel Prize winner Jack Kilby. SAC ¶39. Dr. Rao then spent several decades at Texas Instruments ("TI"), rising to become one of 12 Senior Fellows out of TI's 20,000 engineers. *Id*. ¶40. Some of Dr. Rao's work at TI is featured in the Smithsonian and he is a named inventor on over 100 U.S. patents. *Id*. ¶42. After leaving TI, Dr. Rao continued his inventive work at several companies he founded, including Greenthread. Greenthread owns a family of patents titled "Semiconductor Devices with Graded Dopant Regions," for which Dr. Rao is the sole inventor and which Greenthread has licensed to seven different companies, including two without litigation.

On April 21, 2023, Greenthread filed this lawsuit against Defendants for infringing U.S. Patents No. 10,510,842 ("the '842 patent") and 11,121,222 ("the '222 patent"). D.I. 1, 13. Defendant served its production of core technical documents on November 13, 2023. D.I. 34. Pursuant to the Court's scheduling order, Greenthread served its initial infringement contentions on December 13, 2023. D.I. 41. In its initial contentions, Greenthread asserted infringement of the '842 patent, the '222 patent, and "*further assert*[*ed*] infringement of U.S. Patent Nos. 10,734,481 and 11,316,014," two other patents in the Greenthread family ("the '481 patent" and "the '014 patent," respectively)." Ex. A (Greenthread's Preliminary Infringement Contentions (Dec. 13,

2023)), at p. 2 (emphasis added); D.I. 41.[2] Greenthread's new allegations were based on additional information disclosed in Defendants production of core technical documents. The Court's scheduling order gives Greenthread until May 16, 2024 to amend its complaint to conform to the infringement contentions.

Meanwhile, on July 27, 2023, Defendant filed IPR petitions against *only* the '842 patent and the '222 patent. Defendant waited another *four and a half months* before filing IPRs against Greenthread's other patents on December 11, 2023.

Greenthread filed patent owner preliminary responses (POPRs) in Defendants' first round of IPR petitions on November 14, 2023. In each POPR, Greenthread limited its argument to the timeliness of the petitions, because, Greenthread believed, Defendants had indisputably failed to carry their burden on that issue.

Under 35 U.S.C. § 315(b), a party is barred from filing an IPR "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." It is well established that the petitioner bears the burden of demonstrating that its petition is timely, including that the petitioner is not in privity with a time barred party. *Worlds Inc. v. Bungie*, Inc., 903 F.3d 1237, 1243–44 (Fed. Cir. 2018). In the instituted IPRs, it is undisputed that [redacted] Ex. B (Patent Owner's Request for Director Review for IPR2023-01242 (Feb. 26, 2024)), at p. 1. However,

[2] Onsemi filed the following IPR petitions on Dec. 11, 2023: IPR2024-00263 and -00264 against the '014 and '481 patents, respectively. PTAB Institution Decisions are not expected until June 28, 2024.

[redacted]

Nevertheless, on February 12, 2024, the PTAB instituted trial on each of Defendants' initial IPR petitions, because the PTAB said *Greenthread* had purportedly failed to proffer sufficient evidence that Defendant and [redacted] are in privity.[3] On February 26, 2024, Greenthread filed a request for Director Review to correct this clear abuse of discretion. *E.g.*, Ex. B. Greenthread's preliminary response to Defendants' second round of IPRs is not due until March 28, 2024 and institution decisions on those IPRs are not expected until June 28, 2024.

II. LEGAL STANDARD

"The party seeking the stay [pending IPR] bears the burden of demonstrating circumstances that, balanced together, support an exercise of the Court's discretion to stay." *RideShare Displays, Inc. v. Lyft, Inc.*, No. 20-cv-1629-RGA-JLH, 2021 WL 7286931, at *1 (D. Del. Dec. 17, 2021). If the movant fails to "show[] that the equities tilt in its favor, ... the Court [should] deny the [m]otion." *Toshiba Samsung Storage Tech. Korea Corp. v. LG Elecs., Inc.*, 193 F.Supp.3d 345, 353 (D. Del. June 17, 2016).

"Courts generally consider three factors to determine whether a stay is appropriate: (1) whether granting the stay will simplify the issues for trial; (2) the status of the litigation, …; and (3) whether a stay would cause the non-movant to suffer undue prejudice from any delay or allow the movant to gain a clear tactical advantage." *B.E. Tech., LLC v. Twitter, Inc.*, No. 20-cv-621-GBW, 2023 WL 3478567, at *2 (D. Del. May 16, 2023). However, this test "is not a rigid template

[3] *See* D.I. 50-1, Institution Decision for IPR2023-01242, at p. 43; D.I. 50-2, Institution Decision for IPR2023-01243, at p. 38; D.I. 50-3, Institution Decision for IPR2023-01244, at p. 36.

for decision." *TC Tech. LLC v. Sprint Corp.*, No. 16-cv-153-WCB, 2021 WL 4521045, at *4 (D. Del. Oct. 4, 2021) (Bryson, J., sitting by designation). The Court has "'discretionary prerogative to balance considerations beyond those captured by the three-factor stay test.'" *Id.* (quoting *Murata Mach. USA v. Daifuku Co., Ltd.*, 830 F.3d 1357, 1362 (Fed. Cir. 2016)). "[U]ltimately the Court must decide stay requests on a case-by-case basis, and whether a stay should be granted turns in each case on the totality of the circumstances." *British Telecomms. PLC v. IAC/InterActiveCorp*, No. 18-cv-366-WCB, 2020 WL 5517283, at *5 (D. Del. Sept. 11, 2020) (internal citations omitted).

III. ARGUMENT

The Court should deny the motion, because Defendants have not shown that circumstances "support an exercise of the Court's discretion to stay." *RideShare Displays*, 2021 WL 7286931, at *1. Nor have Defendants shown that the "equities tilt in [their] favor." *Toshiba, Inc.*, 193 F.Supp.3d at 353. All of the stay factors weigh *against* a stay.

A. A Stay Would Severely Prejudice Greenthread

A stay risks irreparable and devastating prejudice to Greenthread. In evaluating the prejudice factor, Courts look to see "if there is a 'fair possibility' that a stay would be detrimental to the opposing party." *ImageVision.Net, Inc. v. Internet Payment Exch., Inc.*, No. 12-cv-054-GMS-MPT, 2013 WL 663535, at *5 (D. Del. Feb. 25, 2013) (internal citations omitted). The potential loss of inventor testimony weighs in favor of a stay. *Universal Secure Registry, LLC v. Apple Inc.*, No. 17-cv-585-CFC-SRF, 2018 WL 4486379, at *4 (D. Del. Sept. 19, 2018) ("[T]he health and age of Dr. Weiss weigh against a stay of the litigation at this stage of the proceedings").

Here, Dr. Rao's testimony will be essential to the case, because he is Greenthread's founder and the sole inventor on the patents in suit and his testimony could be dispositive of some of Defendants' invalidity and other defenses. However, Dr. Rao's age and health create the

substantial risk that he would not be able to testify if trial is delayed, particularly since Defendants seek to delay trial past the final written decision for IPR's that have not even been filed yet.

Numerous courts have held that the advanced age and poor health of an inventor weighs heavily against a stay. For example, in *Se-Kure Controls, Inc. v. Vanguard Prod. Grp., Inc.*, No. 02 C 3767, 2009 WL 5174701, at *2 (N.D. Ill. Dec. 18, 2009), the court denied a stay pending appeal that could have mooted claims, because there was only one surviving inventor who had "deteriorating health." The court denied the stay even though the inventor's testimony had "been preserved via video" because "live testimony is generally preferred over deposition testimony." *Id.* Likewise, in *Blazek Sklo Podebrady s.r.o. v. Burton Int'l*, No. CV 08-2354 (RHK/JSM), 2010 WL 11534354, at *3 (D. Minn. June 11, 2010), the court denied a stay where the inventor was 79 years old—the same age as Dr. Rao—and "in poor health." In *Snyders Heart Valve LLC v. St. Jude Med. S.C. Inc.*, No. 18-2030 (JRT/DTS), 2021 WL 1063005, at *4 (D. Minn. Mar. 19, 2021), the court found that even though the plaintiff was a "non-practicing entity," a stay was not warranted because the inventor was "elderly and in poor health." Finally, in *Universal Secure Registry*, 2018 WL 4486379, at *4, another court in this district denied a stay when the sole inventor was 76 years old and "suffer[ed] from congestive heart failure and atrial fibrillation."

The facts here are even more compelling, than the above cases. [redacted] Ex. C (Declaration of Mohan Rao in Support of Greenthread's Response to Defendants' Motion to Stay Pending *Inter Partes* Review of Asserted Patents). [redacted] Except for *Universal Secure Registry*, none of the cases cited above identified a specific health concern for the inventor in

question, as Greenthread has done here. Finally, in none of the cases cited above, *including Universal Secure Registry*, did the plaintiff identify any specific inventor testimony that was important. Here, Dr. Rao's testimony will be essential to the priority date, which would be outcome determinative of some of Defendants' invalidity defenses. Moreover, Defendants' invalidity contentions identify purported prior art for which Dr. Rao is a named inventor. *See* Ex. D, U.S. Pat. Pub. No. 2004/0063288; Ex. E (Defendants' Preliminary Invalidity Contentions (Feb. 2, 2024)), at p. 5, 23. As an inventor on both the patents-in-suit and the purported prior art, Dr. Rao's testimony will be especially probative. Likewise, the defendant in the related case has asserted that Greenthread does not even own the patents that Dr. Rao assigned to it. Nothing prevents Defendants here from adding such a defense to their pleadings.

Moreover, until pleadings and contentions are set, it difficult or impossible for Greenthread to preserve testimony from Dr. Rao now. First, the scope of the parties' dispute about the teachings in the prior art and claims is not fully developed. Therefore, Greenthread does not know what testimony it needs from Dr. Rao regarding what his prior patent application teaches. Second, Defendants' legal theories are also unclear, because they argue that U.S. Pat. Pub. No. 2004/0063288 renders Greenthread's patents invalid as obvious and separately argue that the patent that ultimately issued from the published application, U.S. Patent No. 6,921,943, invalidates Greenthread's patents on a double patenting theory. *See* Ex. E at p. 46-48. Undoubtedly, Dr. Rao will have testimony to give relevant to these theories, but until discovery clarifies what Defendants' are arguing, it is hard to know exactly what testimony would be relevant. Likewise, if Defendants assert an ownership defense, as in the related case, Greenthread does not yet know the basis for doubts as to its ownership of the patents, and cannot preserve relevant testimony.

Finally, if this case is stayed until final written decision of all pending IPRs (assuming all IPRs are even instituted and remain instituted), it would mean that this case would not *resume* until August 2025 when Dr. Rao will be almost 81. Trial would likely not occur until he is 82 or 83.[4] Of course, if the cases remain stayed pending any appeals and possible remands, the risk of losing Dr. Rao's testimony and the prejudice to Greenthread would only grow.

B. A Stay Is Unlikely to Simplify the Issues for Trial

A stay is unlikely to simplify any issues for trial because (1) the instituted IPRs do not cover all the patents at issue, (2) the institution decisions do not indicate that the PTAB is likely to cancel any claims, and (3) the PTAB is unlikely to clarify any claim construction issues.

1. The institution decisions do not indicate the likely outcome on the merits.

The core premise of Defendants' motion is that the institution decisions presage inevitable doom for Greenthread's patents, because (according to Defendants) the PTAB almost always invalidates patents after instituting trial. Br. 5. But, Defendants' argument is based entirely on generic PTAB statistics that are "not especially enlightening" as to how the PTAB will decide any particular case. *Trover Grp., Inc. v. Dedicated Micros USA*, No. 2:13-cv-1047-WCB, 2015 WL 1069179, at *4 (E.D. Tex. Mar. 11, 2015) (Bryson, J., sitting by designation).

The general statistics Defendants cite are especially unhelpful here, because unlike the vast majority of cases where the PTAB has instituted trial, the PTAB has never heard Greenthread's arguments on the merits—just Greenthread's argument that Defendants' petitions were untimely. *E.g.*, D.I. 50-2 at 20 ("At this stage, Patent Owner does not address the merits of Petitioner's

[4] The most recent IPR to be filed against any of the asserted patents was IPR2024-00470 (filed by Monolithic Power Systems) challenging the '222 patent. A Notice of Filing Date was accorded on February 22, 2024. An institution decision is then expected six months after that, with the final written decision, if instituted, being August 22, 2025.

challenges ….”). The PTAB panel disagreed with Greenthread on timeliness, but that does not mean that the panel is likely to side with Defendants once it hears Greenthread’s side of the story on the merits.

Furthermore, other evidence *specific to this case* shows that Defendants’ confidence in prevailing on the merits is misplaced. To preview one argument Greenthread will make on the merits, Greenthread’s licenses are substantial objective indicia of non-obviousness and especially relevant here. *See, e.g.*, *Transocean Offshore Deepwater Drilling, Inc. v. Maersk Drilling USA, Inc.*, 699 F.3d 1340, 1353 (Fed. Cir. 2012); *Metabolite Lab’ys, Inc. v. Lab’y Corp. of Am. Holdings*, 370 F.3d 1354, 1368 (Fed. Cir. 2004). [redacted]

[redacted]

[redacted] Ex. F. Just as [redacted] did, the Court should substantially discount Defendants' assurance that "there will not be a case left to litigate" if the IPRs proceed. Br. 5. If Defendants lose the IPRs, then the stay would only serve to prejudice Greenthread with no countervailing benefit.

Finally, setting aside the merits, it is far from certain that the instituted IPRs will remain instituted. The error the panel committed in its institution decision is obvious and will likely be corrected by the USPTO Director. In the IPR proceedings, Defendant [redacted] and (2) failed to put in any evidence—absolutely none—to support a finding in its favor. *Worlds, Inc.*, 903 F.3d at 1243–44. The parties do not dispute either that point of law or the state of the PTAB record. Nevertheless, the PTAB panel said that *Greenthread* should have put Defendants' contracts and communications with [redacted] into the record and instituted because *Greenthread* had not put in *more* evidence regarding the terms of Defendants' admitted relationship with [redacted]. *E.g.*, D.I. 50-1 at p. 19, 21. But Greenthread did not have that burden or the documents the PTAB panel said were missing. Defendants have both the burden and the documents. Even worse, when Greenthread tried to *compel* Defendants to provide that evidence, the PTAB panel denied Greenthread's motion, because it said that those documents would not be "useful" in assessing privity. *See* Ex. B. at 9; Ex. P (PTAB Order Denying Patent Owner's Motion for Additional Discovery (Jan. 26, 2024)), at p. 9. The panel's decisions are not just legally wrong, but internally inconsistent. *E.g.*, Ex. B at p. 11. Either the documents are relevant to privity and should have been produced or they are irrelevant and Greenthread cannot be faulted for not putting

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[6] [redacted]

them in the record. Both of the panel's decisions cannot be right. The Director will almost certainly correct this clear abuse of discretion.

Defendants argue in a footnote that grants of director review are rare, citing to a news article which says that the odds of Director review are only 2.7% on average. *See* Br. 8 n. 1; D.I. 50-6, "*How Patent Office Director Review Has Reshaped the Rehearing Landscape*," Reuters, Feb. 7, 2024 (https://www.reuters.com/legal/legalindustry/how-patent-office-director-review-has-reshaped-rehearing-landscape-2024-02-07/). The source listed in the article for the statistics is described as "Authors" without further citation. D.I. 50-6 at 5-6. Those statistics conflict with the data actually published by the USPTO, which show that last year, the Director reversed the panel below *in more than 30% of the cases* that came before her.[7] Obviously Greenthread believes its Director Review petitions are meritorious and likely to be granted, but the Court does not need to take Greenthread's word for it. Both Law360 and Bloomberg Law found Greenthread's petitions sufficiently noteworthy to merit coverage.[8] Few other Director Review petitioners could say the same.

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[7] Ex. Q, *Director Review request spreadsheet*, USPTO, Feb. 15, 2024 (https://www.uspto.gov/sites/default/files/documents/director_review_requests_20240215.xlsx). For a description of the spreadsheet, *see Status of Director Review requests*, USPTO (https://www.uspto.gov/patents/patent-trial-and-appeal-board/status-director-review-requests).

> In 2023, the Director denied or dismissed 65 requests and in 31 cases the Director intervened *sua sponte*, granted the request, or ordered rehearing by a new panel. 31/(65+31)=32%. Since 2021, when the Director Review process began, the Director denied or dismissed 283 requests for director and in 51 cases the Director intervened *sua sponte*, granted the request, or ordered rehearing by a new panel. Therefore, even since 2021, the Director review grant rate is 15% (51/(283+51), more than five times higher than what Defendants' claim.

[8] *See* Ex. R, Annelise Gilbert, *Intel Link Blocks Semiconductor Patent Challenges, Director Told*, BLOOMBERG LAW (Feb. 28, 2024), https://www.bloomberglaw.com/bloomberglawnews/ip-law/X8G23CRS000000?bna_news_filter=ip-law#jcite; Ex. S, Adam Lidgett, *Vidal Asked To Review PTAB Decisions In Semiconductor Fight*, LAW360 (Mar. 1, 2024),

2. The instituted IPRs do not cover all patents at issue.

The other central premise of Defendants' motion is that the instituted IPR's "address *every* asserted claim." Br. 4 (emphasis original). But the premise is false. Greenthread added the '481 and '014 patents to its infringement contentions in December of last year. *See* Ex. 1 at 2; D.I. 41. The instituted IPRs *do not* challenge these patents. The Court's scheduling order gave Greenthread until May to amend its pleadings and Greenthread is now doing so, three months before the deadline.

Defendants have *filed* IPR petitions against Greenthread's other patents, but Defendants' motion "rests on speculation that" the PTAB will institute in those cases. *Universal Secure Registry*, 2018 WL 4486379, at *2. There is no reason to assume that the PTAB would reach the same result in those cases. Not only are the claims different, but Greenthread has not even filed its preliminary responses in those cases. Greenthread may make different arguments in those cases and if Greenthread prevails on Director Review, these petitions would also be time barred.

3. The PTAB proceedings will not clarify claim construction.

Defendants argue to this Court that the "IPRs may also simplify claim construction issues." Br. 5. But in front of the PTAB, Defendants' take a different approach. Defendants told the PTAB that they "do[] not believe any terms need be construed." Ex. J at 6; Ex. L at 9; Ex. N at 7. Defendants' case law about the generic possibility of the PTAB simplifying claim construction is irrelevant when Defendants have asked the PTAB not to do any claim construction.

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https://www.law360.com/articles/1808291/vidal-asked-to-review-ptab-decisions-in-semiconductor-fight.

Moreover, Defendants fail to note that virtually every term in all four of the patents at issue here have already be construed by four different courts in three different districts.[9] All of these decisions are consistent with one another and Greenthread does not plan to argue that this Court or the PTAB should do anything differently than these courts did. *Defendants* may ask this Court to deviate from these prior decisions, but any argument that they make is likely an argument that has been considered and rejected by another court. The likelihood that the PTAB proceedings will add anything to the prior proceedings is remote.

C. The Parties Have Already Done Substantial Work on this Case and Substantial Work Will Continue Even if the Case Against Defendants Is Stayed

This case is *not* in its earliest stages. Both parties have "expended [far] more than a *de minimis* amount of effort on the litigation." *SenoRx, Inc. v. Hologic, Inc.*, No. 12-cv-173-LPS-CJB, 2013 WL 144255, at *6 (D. Del. Jan. 11, 2013). Greenthread filed its initial complaint almost a year ago in April of 2023. D.I. 1. Defendants responded with its answer, affirmative defenses, and counterclaims. D.I. 10, 12. The Court ruled on Defendants' motion to dismiss. D.I. 35. Pursuant to the Court's scheduling order (D.I. 24), Greenthread has identified the accused products and each asserted patent (D.I. 27), and Defendants produced core technical documents (although they have resisted full compliance with their obligations) (D.I. 34). Greenthread served its

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[9] Ex. T (Claim Construction Memorandum Opinion and Order in *Greenthread, LLC v. Samsung Elects. Co., Ltd.*, 2:19-cv-00147-JRG (E.D. Tex. Apr. 20, 2020); Ex. U (WDTX Court's preliminary constructions in *Greenthread, LLC v. Intel Corp.*, 6:22-cv-00105-ADA); Ex. V (Findings and Recommendation in *Greenthread, LLC v. Intel Corp.*, 3:22-cv-02001-JR (D. Or. Mar. 16, 2023) at 4); Ex. W (Claim Construction Order in *Greenthread, LLC v. Cirrus Logic, Inc.*, 1-23-cv-00369-DC-DTG (W.D. Tex. Jan. 29, 2024)).

preliminary infringement contentions (Ex. 1; D.I. 41), and onsemi responded with its initial invalidity contentions (D.I. 48). Moreover, by the time Defendants' motion is fully briefed, the parties will be well into the claim construction process. The parties are set to exchange claim terms by March 6, 2024, prepare a joint claim construction chart by March 15, 2024, and Greenthread's opening claim construction brief is due March 22, 2024. A stay would waste all of the effort the parties have put into initial contentions and claim construction briefing. Moreover, since there is a consolidated case pending before the Court against another defendant with six of Greenthread's patents at issue, the claim construction process is going to proceed regardless.

D. Prejudice to Defendants of *Not* Granting a Stay is Irrelevant

Defendants' argument that *they* "will suffer undue prejudice without a stay." Br. 7-8. That argument is a "nonstarter ... because Defendant chose to petition for IPRs in parallel with this suit and chose when they filed their petitions." *RideShare Displays*, 2021 WL 7286931, at *3. Any supposed harm to onsemi is the result of their litigation strategy, and their "failure to articulate a clear hardship or inequity ... weighs against" a stay. *Yodlee, Inc. v. Plaud Techs. Inc.*, No. 14-cv-1445-LPS-CJB, 2017 WL 401896, at *2 (D. Del. Jan. 27, 2017).

E. Defendants' Cited Cases Do Not Support a Stay.

None of the cases Defendants cite support a stay here. Defendants reliance on *TC Tech. LLC*, 2021 WL 4521045, at *4, is misplaced. *See* Br. 4. In *TC Tech.*, that court was deciding whether to grant a stay based on the asserted patents undergoing *ex parte* reexamination where "the examiner ha[d] *already rejected all the asserted claims* in a non-final office action." *Id*. at *5 (emphasis added). Here, the USPTO has not rejected *any* claims. Indeed, it has not heard from Greenthread on the merits at all.

In *British Telecomms.*, 2019 WL 4740156, at *8, IPR had been instituted on "nine of the eleven asserted claims" in *one* single patent. *See* Br. 5. Here, institution decisions have only been made on two of the four *patents*.

In *454 Life Scis. Corp. v. Ion Torrent Sys., Inc.*, C.A. No. 15-595-LPS, 2016 WL 6594083, at *4 (D. Del. Nov. 7, 2016), the court stated that the "case [was] in its very early stages," in part, because the court had not ruled on the defendants' motion to dismiss. *See* Br. 6. Here, the Court *has* ruled on Defendants' motion to dismiss and the case has moved well-beyond that. D.I. 35. Further, the IPR at issue in *454 Life Scis.* had a final written decision due within eight months from the court's ruling. 2016 WL 6594083, at *4. Here, a final written decision in the instituted IPRs is not due for almost a year and, if the Court grants the requested stay covering all IPRs, it could delay proceedings by over a year-and-a-half, due to Defendants strategy of dribbling out their IPRs to maximize the effect of a stay. The prejudice to Greenthread is far greater here.

IV. CONCLUSION

For the reasons explained above, Greenthread respectfully requests that the Court deny onsemi's motion to stay this case pending resolution of any IPR filed against Greenthread's asserted patents.

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Respectfully submitted,

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