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

_____

IPR2024-00264
U.S. Patent No. 10,734,481

_____

PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST TO FILE A MOTION FOR ADDITIONAL DISCOVERY

PUBLIC VERSION

TABLE OF EXHBITS

Exhibit No.	Description
1001	U.S. Patent No. 10,734,481 to Rao (the "'481 Patent")
1002	Prosecution History of the '481 Patent
1003	Declaration of Travis Blalock, PhD
1004	Curriculum Vitae of Travis Blalock, PhD
1005	Publication Declaration of Sean O'Bryan for Maziasz ("O'Bryan Decl.")
1006	U.S. Patent Application Publication No. 2003/0183856 to Wieczorek ("Wieczorek")
1007	U.S. Patent No. 6,043,114 to Kawagoe, et al. ("Kawagoe")
1008A	Stanley Wolf and Richard N. Tauber, *Silicon Processing For The VLSI Era,* Vol 1, Lattice Press (2000) ("Wolf.1")
1008B	Stanley Wolf and Richard N. Tauber, *Silicon Processing For The VLSI Era,* Vol. 2, Lattice Press (2000) ("Wolf.2")
1008C	Stanley Wolf and Richard N. Tauber, *Silicon Processing For The VLSI Era,* Vol. 3, Lattice Press (2000) ("Wolf.3")
1008D	Stanley Wolf and Richard N. Tauber, *Silicon Processing For The VLSI Era,* Vol. 4, Lattice Press (2000) ("Wolf.4")
1009	Wang and Agrawal, *Single Event Upset: An Embedded Tutorial*, 21st Intl Conf on VLSI Design, IEEE 2008 ("Wang")
1010	U.S. Patent No. 4,481,522 to Jastrzebski, et al. ("Jastrzebski")
1011	Publication Declaration of Martin L. Knott for Rabaey ("Knott Decl.")
1012	Publication Declaration of Alyssa G. Resnick for Wolf.1 and Wolf.2 ("Resnick Decl.")
1013	Publication Declaration of Rachel J. Watters for Wolf.3 and Wolf.4 ("Watters Decl.")
1014	U.S. Patent No. 6,163,877 to Gupta ("Gupta")
1015	U.S. Patent No. 6,534,805 to Jin ("Jin")
1016	Excerpts from the Prosecution History of U.S. Patent No. 8,421,195 (the "'195 Patent")
1017	Patent Owner's Proposed Constructions, *Greenthread, LLC, v. Intel Corp.*, Civil Action No. 6:22-cv-105 (W.D. Tex. Sep. 19, 2022)
1018	Defendants' Preliminary Proposed Constructions, *Greenthread, LLC, v. Intel Corp.*, Civil Action No. 6:22-cv-105 (W.D. Tex. Sep. 19, 2022)

Exhibit No.	Description
1019	Defendants' Opening Claim Construction Brief, *Greenthread, LLC, v. Intel Corp.*, Dkt. 82, Civil Action No. 6:22-cv-105 (W.D. Tex. Oct. 10, 2022)
1020	Patent Owner's Responsive Claim Construction Brief, *Greenthread, LLC, v. Intel Corp.*, Dkt. 96, Civil Action No. 6:22-cv-105 (W.D. Tex. Oct. 31, 2022)
1021	Defendants' Reply Claim Construction Brief, *Greenthread, LLC, v. Intel Corp.*, Dkt. 100, Civil Action No. 6:22-cv-105 (W.D. Tex. Nov. 14, 2022)
1022	Sze, *Semiconductor Devices Physics and Technology*, 2d Ed., John Wiley & Sons (2002)
1023	Maziasz and Hayes, *Layout Minimization of CMOS Cells*, Kluwer Academic Publishers (1992) ("Maziasz")
1024	U.S. District Courts – Case Statistics, obtained at https://www.uscourts.gov/statistics-reports/analysis-reports/federal-court-management-statistics, dated March 31, 2023
1025	Rabaey *et al.*, *Digital Integrated Circuits, A Design Perspective,* Prentice Hall Electronics and VLSI Series (2003) ("Rabaey")
1026	Gregory and Shafer, "Latch-Up In CMOS Integrated Circuits," IEEE Transactions on Nuclear Science, Volume 20, Issue 6 (1973)
1027	U.S. Patent Application Publication No. 2007/0045682 to Hong *et al*. ("Hong")
1028	Excerpts from the Prosecution History of U.S. Patent Application No. 10/934,915 (the "'915 App.")
1029	Excerpts from the Prosecution History of U.S. Patent No. 9,190,502 (the "'502 Patent")
1030	Excerpts from the Prosecution History of U.S. Patent Application No. 13/854,319 (the "'319 App.")
1031	U.S. Patent No. 4,160,985 to Kamins *et al.* ("Kamins")
1032	McGraw-Hill Dictionary of Scientific and Technical Terms (2003)
1033	U.S. Patent No. 9,647,070 to Rao (the "'070 Patent")
1034	U.S. Patent Application Publication No. 2003/0030488 to Hueting *et al.* ("Hueting")
1035	[Intentionally Omitted]

Exhibit No.	Description
1036	Proposed Claim Constructionsin the Intel Litigation, *Greenthread, LLC v. Intel Corporation, Dell Inc., and Dell Technologies Inc.*, Civil Action No. 6:22-cv-105 (W.D. Tex.)
1037	Howe and Sodini, *Microelectronics, An Integrated Approach*, Prentice Hall Electronics and VLSI Series (1997) ("Howe")
1038	Hodges *et al.*, *Analysis and Design of Digital Integrated Circuits In Deep Submicron Technology,* 3rd Ed., McGraw-Hill (2004) ("Hodges")
1039	Publication Declaration of Martin L. Knott for Hodges ("Knott Decl.")
1040	Jaeger, *Microelectronic Circuit Design*, McGraw-Hill (1997) ("Jaeger")
1041	Kang and Leblebici, *CMOS Digital Integrated Circuits Analysis and Design*, McGraw-Hill (2003) ("Kang")
1042	U.S. Patent No. 6,614,560 to Silverbrook ("Silverbrook")
1043	Publication Declaration of Sylvia Hall-Ellis for Wolf
1044	Wong, H. P., et al. "CMOS active pixel image sensors fabricated using a 1.8-V, 0.25-µm CMOS technology." IEEE Transactions on Electron Devices 45.4 (1998): 889-894.
1045	Law360 Article "*Stays Pending IPR In Del. District Courts Are Here To Stay*," Kraning and Del Dotto, March 11, 2022.
1046	01242 Paper 32 - Decision granting Inter Partes Review - PO material
1047	01242 Paper 35 - Decision granting Inter Partes Review - public
1048	01243 Paper 31 - Decision granting Inter Partes Review - PO material
1049	01243 Paper 34 - Decision granting Inter Partes Review – public
1050	01244 Paper 32 - Decision granting Inter Partes Review - PO material
1051	01244 Paper 35 - Decision granting Inter Partes Review – public
1052	01242 Paper 22 - Petitioner's Authorized Reply to Patent Owner's Preliminary Response – confidential
1053	01243 Paper 21 - Petitioner's Authorized Reply to Patent Owner's Preliminary Response – confidential
1054	01244 Paper 22 - Petitioner's Authorized Reply to Patent Owner's Preliminary Response - confidential

Because the Board has already rejected an identical motion for additional discovery in prior proceedings (IPR2023-01242, -01243, and -01244, the "Prior IPRs"), Patent Owner ("PO") should not be authorized to pursue additional discovery here. PO does not hide that it is seeking to relitigate "the same discovery issue" that PO lost in the Prior IPRs. Paper 7 at 1. Nor does PO make any argument distinguishing this IPR from the Prior IPRs. As a matter of consistency and fairness—and because the Board's prior decision was legally correct—the prior decision denying PO's motion should control and PO's request should be denied.

I. PO'S FLAWED PRIVITY ARGUMENTS DO NOT WARRANT DISCOVERY

The premise of PO's request is that a bare customer-manufacturer relationship, along with an agreement between PO and RPX Corporation—to which Petitioner is not a party—establishes a privity relationship that bars Petitioner from seeking *inter partes* review. Paper 7 at 1–2. PO is wrong. PO raised identical arguments in the Prior IPRs, and the Board correctly found that PO's privity theories had no merit, regardless of what information PO sought to discover. *See* EX2912 at 9; *see also* EX1046 IPR2023-01242, Paper 32 (confidential) and EX1047 IPR2023-01242, Paper 35 (granting institution, rejecting PO's privity arguments). As such, just like in the Prior IPRs, *Garmin* factors 1 and 2 require denying PO's motion for discovery. *See* EX2912 at 6–13.

A. *The Board correctly found no privity with Intel, [redacted] or [redacted]*

PO's privity arguments have no merit. As the Board correctly stated in the Prior IPRs, "Patent Owner loses sight of the rationale behind the privity provision of § 315(b), which is 'to prevent successive challenges to a patent by those who previously have had the opportunity to make such challenges in prior litigation.'" EX2912 at 6–7 (quoting *WesternGeco LLC v. ION Geophysical Corp.,* 889 F.3d 1308, 1319 (Fed. Cir. 2018)). Because Petitioner was not involved in PO's prior litigations or IPRs involving Intel, [redacted] and [redacted] and none of those parties are participating in this IPR—there is no relevant privity. *Id.* at 6-13.

Because PO has not alleged that Petitioner has anything other than a standard manufacturer-customer relationship with Intel, [redacted] or [redacted] PO's arguments about Petitioner supplying products to these entities are red herrings.[1] As the Board correctly recognized, under "controlling Federal Circuit precedent," a "fairly standard customer-manufacturer relationship" does ***not*** mean "that both [parties] should be bound by the trial outcome and related estoppels." EX2912 at 9 (quoting with alteration *WesternGeco,* 889 F.3d at 1321; citing *Wi-Fi One, LLC v. Broadcom Corp.,* 887 F.3d 1329, 1341 (Fed. Cir. 2018)). Similarly, PO's arguments about the

[1] PO misidentifies statements as "undisputed" when a dispute exists. *See* Paper 7 at 1-2. It is unnecessary to address these improper statements further because they do not undermine the Board's prior sound reasoning for denying additional discovery.

potential assertion of a license defense have no merit. To the contrary—again as the Board correctly recognized—a third-party beneficiary to a contract (as PO alleges Petitioner is in this context) is ***not*** a privy in contract law. *See* EX2912 at 11 n.6 (citing *Pac. Gas & Elec. Co. v. United States,* 838 F.3d 1341, 1350–51 (Fed. Cir. 2016), *Prime Finish, LLC v. Cameo, LLC,* 487 F. App'x 956, 959 (6th Cir. 2012)).

B. *No discovery is necessary*

Discovery into Petitioner's sales relationships with Intel, [redacted] and/or [redacted] is unnecessary because there is no plausible discovery that would cause a time bar to apply in these IPRs. As the Board correctly stated in the prior IPRs:

> Patent Owner's discovery requests seek documents, such as sales agreements, design agreements, and communications about product design, that are characteristic of a standard customer-manufacturer relationship. The requests are not aimed at discovering evidence that would be useful in determining whether Petitioner has a close relationship with Intel, [redacted] or [redacted] *as it relates to the prior infringement litigation and IPRs.*

EX2912 at 9 (emphasis original, citing *WesternGeco,* 889 F.3d at 1319).

II. NO FURTHER BRIEFING IS NECESSARY

PO has not identified any additional issues that need briefing to resolve this dispute. In the Prior IPRs, the Board fully considered and rejected all of PO's arguments, and PO has not explained why a different result would be appropriate in this IPR. Because the Board's prior decision was correct and there are no changed circumstances, there is no reason to waste resources rehashing resolved issues here.

Dated: March 5, 2024

Respectfully submitted,

/Roger Fulghum/

Roger Fulghum
Reg. No. 39,678
Attorney for Petitioner
BAKER BOTTS L.L.P.
One Shell Plaza
910 Louisiana Street
Houston, TX 77002
T: (713) 229-1234
F: (713) 229-1522

PUBLIC VERSION

CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. § 42.6(e), the undersigned certifies that on the 5th day of March, 2024, a complete and entire copy of this **PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST TO FILE A MOTION FOR ADDITIONAL DISCOVERY** was served on Patent Owner electronically via email to counsel for the Patent Owner:

Greenthread-OnSemi-MS@mckoolsmith.com

awhitehurst@mckoolsmith.com

nmatich@mckoolsmith.com

ajairam@mckoolsmith.com

smccommas@mckoolsmith.com

nozarkar@mckoolsmith.com

Dated: March 5, 2024

Respectfully submitted,

/Roger Fulghum/
Roger Fulghum
Reg. No. 39,678