

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SEMICONDUCTOR COMPONENTS INDUSTRIES, LLC.,
Petitioner,

v.

GREENTHREAD, LLC,
Patent Owner.

IPR2024-00263 (Patent 11,316,014 B2)
IPR2024-00264 (Patent 10,734,481 B2)
IPR2024-00265 (Patent 9,190,502 B2)
IPR2024-00266 (Patent 8,421,195 B2)

Before KRISTINA M. KALAN, JON B. TORNQUIST, JEFFREY W.
ABRAHAM, MONICA ULAGADDI, and JULIA HEANEY,
*Administrative Patent Judges.*¹

HEANEY, *Administrative Patent Judge.*

ORDER

Denying Request to File Motion for Additional Discovery
37 C.F.R. § 42.51(B)(2)(i)

¹ This Order addresses similar requests submitted for each of the above-captioned proceedings. We issue one Order to be filed in each proceeding. The listing of Judges here does not expand any of the panels. The parties are not authorized to use this heading style in any subsequent papers.

IPR2024-00263 (Patent 11,316,014 B2)
IPR2024-00264 (Patent 10,734,481 B2)
IPR2024-00265 (Patent 9,190,502 B2)
IPR2024-00266 (Patent 8,421,195 B2)

Greenthread, LLC (“Patent Owner”), with our authorization, filed a Request to File a Motion for Additional Discovery Pursuant to 37 C.F.R. § 42.51(B)(2)(i) (“Request”).² Ex. 3002. Semiconductor Components Industries, LLC (“Petitioner”) opposes. Paper 8 (“Opposition”).

BACKGROUND

Patent Owner seeks additional discovery to support its contention that Petitioner is in privity with its third-party customers, Intel Corp. (“Intel”), Dell Technologies Inc. (“Dell”), and Sony Group Corp. (“Sony”).

Request 1. Patent Owner asserts that Petitioner sells custom products to Intel, Dell, and Sony, and indemnifies them for claims of patent infringement. Ex. 3002. As a consequence, Patent Owner argues, if any of the three companies is in privity with Petitioner, the Petition is time-barred under 35 U.S.C. § 315(b). *Id.*

The parties briefed the same discovery request in IPR2023-01242, -01243, and -01244, and the panel denied the motion. IPR2023-01242, Paper 30.³ Subsequently, the panel determined that the record did not sufficiently show that the petitions were time-barred, and instituted *inter partes* review. IPR2023-01242, Paper 35 at 22. Patent Owner filed a Request for Director Review in each of the prior IPRs. IPR2023-01242, Paper 37. Those requests are pending.

² We cite to the record in IPR2023-00263. Similar papers and exhibits were filed in all four proceedings (hereinafter, “these four proceedings”).

³ We cite to the record in IPR2023-01242. Similar papers and exhibits were filed in all three proceedings (hereinafter, “the prior IPRs”).

IPR2024-00263 (Patent 11,316,014 B2)
IPR2024-00264 (Patent 10,734,481 B2)
IPR2024-00265 (Patent 9,190,502 B2)
IPR2024-00266 (Patent 8,421,195 B2)

In an email request of February 15, 2024, Patent Owner sought authorization in these four proceedings to file a motion for additional discovery. Ex. 3002. In this correspondence, Patent Owner acknowledges that it sought the same additional discovery in the prior IPRs, which request was denied, and indicates that “the parties would like to avoid the expense and time of going through the same briefing as before if there is a way to make the earlier proceeding’s briefing of record in the present proceeding.” *Id.*

The Board subsequently authorized Patent Owner to file a request for authorization to file a motion for additional discovery and Petitioner to file an opposition, and permitted both parties to submit as exhibits the relevant briefing from IPR2023-01242, -01243, and -01244. The parties have filed those papers and exhibits in these four proceedings. *See* Papers 7, 8; Exs. 1046–1054, 2001–2912.

DISCUSSION

Our rules are “construed to secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b). The parties in these four proceedings are the same as in the prior IPRs, and Patent Owner represents that the same discovery is at issue in all of the cases. In view of the Board’s denial of Patent Owner’s motion for additional discovery in the prior IPRs, Patent Owner’s representation that the same discovery is at issue here, and in order to accommodate Patent Owner’s request that the parties avoid the need to go “through the same briefing as before,” we deny Patent Owner’s request for authorization to file a motion for additional discovery. We note, however, that this denial is without prejudice, and Patent Owner

IPR2024-00263 (Patent 11,316,014 B2)
IPR2024-00264 (Patent 10,734,481 B2)
IPR2024-00265 (Patent 9,190,502 B2)
IPR2024-00266 (Patent 8,421,195 B2)

may request authorization to file a motion for additional discovery that generally complies with authorizations previously approved by the Director. *See Samsung Electronics Co. v. Netlist, Inc.*, IPR2022-00615, Paper 40 at 8–10 (denying broad discovery requests that were not tied to specific patents or a specific litigation, but allowing more narrowly tailored requests).

ORDER

Accordingly, it is

ORDERED that Patent Owner’s request to file a motion for additional discovery pursuant to 37 C.F.R. § 42.51(B)(2)(I) is denied without prejudice;

FURTHER ORDERED that Patent Owner may, if it so chooses, contact the Board to request authorization to file a different motion for additional discovery, as discussed above.

IPR2024-00263 (Patent 11,316,014 B2)
IPR2024-00264 (Patent 10,734,481 B2)
IPR2024-00265 (Patent 9,190,502 B2)
IPR2024-00266 (Patent 8,421,195 B2)

PETITIONER:

Roger Fulghum
Mark Speegle
Ellyar Y. Barazesh
BAKER BOTTS L.L.P.
roger.fulghum@bakerbotts.com
mark.speegle@bakerbotts.com
ellyar.barazesh@bakerbotts.com

Daniel Anderson
ERNST, BROWN & DRAPER, PLLC
daniel.anderson@andersonpatents.com

PATENT OWNER:

Alan Whitehurst
Nicholas Theodore Matich, IV
Arvind Jairam
Stuart McCommas
Archis “Neil” Ozarkar
MCKOOL SMITH, PC
awhitehurst@mckoolsmith.com
nmatich@mckoolsmith.com
ajairam@mckoolsmith.com
nozarkar@McKoolSmith.com