UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MONOLITHIC POWER SYSTEMS, INC.,

Petitioner,

v.

GREENTHREAD LLC,

Patent Owner.

IPR2024-00468
U.S. PATENT NO. 8,421,195

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

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Monolithic Power Systems, Inc. ("Petitioner" or "MPS") respectfully requests that the Board deny Patent Owner's Motion for Additional Discovery ("Motion").

Patent Owner sued larger electronic integrators on patents generally related to the physics of semiconductor doping. Those parties filed IPRs and later settled. Patent Owner has since sued smaller component manufacturers (like MPS) and is seeking to prevent IPRs based on the theory that component makers are time-barred.

Patent Owner's arguments—and evidence—do not support its privity argument and, as a consequence, its discovery requests. For privity, at a minimum, Patent Owner must demonstrate that MPS somehow participated in the prior IPRs, participated in the litigation, or that MPS is acting as [redacted] proxy in this IPR. Patent Owner has not demonstrated that this situation is plausible.

Patent Owner's evidence falls short and shows, at most, that MPS makes relatively inexpensive components and that other companies buy them. For example, Patent Owner's supportive evidence [redacted] In addition, Patent Owner's other evidence that MPS made an inexpensive power chip that complied with Intel's processor standards only means that MPS—like countless other component manufacturers—made a chip that works with expensive Intel processors. To argue that MPS controls these parties is

untethered to industry realities and is disconnected to the proper privity analysis for the purposes of 35 U.S.C. § 315(b).

Tellingly, Patent Owner's motion is a rehash of an already-rejected motion it made against another component manufacturer. The Board has already rejected Patent Owner's discovery requests there as purely speculative. It should do the same here.

I. PATENT OWNER'S REQUEST IS UNJUSTIFIED UNDER THE CIRCUMSTANCES

Patent Owner's request departs from clear and well-established precedent that discovery will only be allowed in special circumstances. *Garmin International, Inc. et al. v. Cuozzo Speed Tech.*, IPR2012-00001, pg. 5, Paper No. 26 (Precedential); 37 C.F.R. § 42.51(b)(2) ("Patent Owner, as the moving party, bears the burden of demonstrating that its additional discovery is 'in the interests of justice'"). Here, [redacted]. Patent Owner seeks discovery on the speculative theory that a commodity-component manufacturer (MPS) should be time-barred because [redacted].

Patent Owner's privity theory is untenable on its face. The time-bar privity question is "whether the relationship between the purported 'privy' and the relevant other party is sufficiently close such that both should be bound by the trial outcome and related estoppels." *See* Consolidated Trial Practice Guide November 2019

("CTPG") at 14–15.[1] The concern is to protect a patent holder from successive attacks while still ensuring that a petitioner is not unfairly limited in its ability to lodge challenges before the PTAB had it not had the opportunity to do so. *Power Integrations, Inc. v. Semiconductor Components Indus., LLC*, 926 F.3d 1306, 1315 (Fed. Cir. 2019). The evidence here leads to the rational conclusion that MPS is not in privity with [redacted] and this instant Petition represents its first bite at the apple before the PTAB with regards to invalidity.

MPS manufactures and designs small components that other electronic companies purchase and incorporate into larger and expensive integrated electronic systems. This is apparent from Patent Owner's examples [redacted], EX2020; and MP2953 that is compliant with the INTEL VR12.5 platform, EX2019). [redacted] Similarly, the MP2935 is a relatively inexpensive power chip available on the public

[1] Available at https://www.uspto.gov/TrialPracticeGuideConsolidated.

[2] EX1050 (DigiKey Website listing for MP6924 as low as 86 cents a chip).

[3] EX1051 (Sony website listing for the PlayStation at $449 / $499).

market.[4] It is designed to work with Intel processors according to Intel's standards for voltage regulation (which has nothing to do with the challenged patent, which is directed to semiconductor doping). Countless other companies provide similar components that work with Intel's standards.[5] To argue, as Patent Owner does, that a commodity component supplier jointly designs or otherwise mandates how the [redacted] is made or how Intel designs its processors to such an extent that it should be timed barred here is untethered to industry reality.[6]

Patent Owner's privity argument is far afield from PTAB practice. Patent Owner's argument is, in effect, that every single manufacturer that makes small components is in privity with component purchasers and, as a consequence, is subject to discovery and a time bar under 35 U.S.C. § 315(b). Patent Owner's arguments would subject component manufacturers to extensive discovery by default. Moreover, Patent Owner's privity argument would result in component

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[4] EX1052 (Digikey website listing for MP2935).

[5] EX1053 (Digikey website search for chips compliant with Intel VR 12.5 Platform, showing 167 products from various suppliers with approximate per-chip cost at below $1).

[6] Patent Owner does not make an evidence-based allegation with respect to how [redacted] could be in privity with MPS.

manufacturers being unable to seek recourse before the PTAB whenever a patent owner sued a larger systems integrator, settled before IPRs were decided, then thereafter sued all component suppliers. In all, Patent Owner's position is to deprive component manufacturers the opportunity to seek economical resolution of invalidity via the PTAB, going against the purpose of IPRs. H.R. Rep. No. 112–98, pt. 1, at 40 (2011), 2011 U.S.C.C.A.N. 67, 69 (it was congressional intent that IPRs were meant to be "quick and cost effective alternatives to litigation.").

Tellingly, Patent Owner's argument—raised in an identical motion against a similarly situated component supplier—was strongly repudiated based on similar facts[7] (in a case that Patent Owner failed to bring to the Board's attention in its motion). *See Semiconductor Components Industries, LLC, v. Greenthread, LLC,* IPR2023-01242-44, Paper 31; *see also id.* at EX3100 (Patent Owner requesting director review on its privity arguments); *see also id.* at Paper 44 (director denying Patent Owner's review request). Patent Owner's discovery requests mirror those in

[7] Patent Owner appears to have presented more evidence in *Semiconductor Component Industries* against that Petitioner than it does in this motion against MPS. *See, e.g., Semiconductor Components,* IPR2023-01242-44, pg. 9 Paper 31 (Patent Owner presenting indemnity agreements which also failed to establish burden for discovery).

the denied case.[8] *Compare* IPR2023-01242-44, Paper 31 at 3 *with* Mot. at 6. Furthermore, Patent Owner's argument here are identical to those previously presented (and rejected). *Compare* IPR2023-01242-44, Paper 31 at 6-7 (denying Patent Owner's privity arguments of manufacturing for a party as mere speculation) *with* Mot. at 7-8 (arguing the same speculative privity arguments); *compare* IPR2023-01242-44, Paper 31 at 13 (denying Patent Owner's arguments of unfairness due to purported inconsistent litigation positions) *with* Mot. at 9 (arguing unfairness due to same purported inconsistent litigation positions). Patent Owner's mirrored requests should be denied here as well.

II. *GARMIN* FACTORS WARRANT DENIAL OF THE MOTION

For completeness, provided below is specific analysis under the *Garmin* Factors, all of which weigh heavily towards denying Patent Owner's request.

A. *Garmin Factor 1: More than a mere possibility of finding something useful*

Garmin Factor 1 weighs heavily in MPS's favor.

Factor 1 considers whether the requested discovery provides more than the mere possibility that something useful will be found, and further requires that the requesting party be in possession of evidence showing—beyond speculation—that

[8] A large portion of this order is redacted, but it appears that the requests there are identical to those presented here.

something useful will be uncovered. *Garmin*, IPR2012-00001, at 6. Here, Patent Owner's evidence demonstrates nothing more than pure speculation, and the Board should deny Patent Owner's request as failing under *Garmin* Factor 1 as it has done before. *See Semiconductor Components,* IPR2023-01242-44, Paper 31 (weighing factor 1 against Patent Owner, stating "Patent Owner's assertion is speculative and does not show more than a mere possibility that its discovery requests will uncover useful information").

Patent Owner presented no evidence that indicates that MPS is—or would plausibly be—in privity with [redacted] To find privity for a time-bar, Patent Owner must demonstrate evidence showing that MPS either participated in the prior litigations/IPRs or that MPS is acting as a proxy for time-barred entities [redacted]. *Semiconductor Components,* IPR2023-01242-44, at pg. 6, Paper 31 (citing *WesternGeco LLC v. ION Geophysical Corp*., 889 F.3d 1308, 1319 (Fed. Cir. 2018) for the proposition that the proper inquiry is whether "petitioner had a full and fair opportunity to litigate the validity of the patent"). Rather than present supportive arguments and evidence, Patent Owner focuses on supposed commercial and engineering relationships between MPS as a smaller component manufacturer and [redacted] and [redacted] purchase of commodity-components. *See generally* Mot. at 6-8. Whether other parties purchased MPS's components or whether there is a commercial relationship does not establish an agency relationship relevant to the

privity analysis for 35 U.S.C. § 315(b). *Semiconductor Components,* IPR2023-01242-44, at 12-13, Paper 31. Patent Owner's requests accordingly fail under *Garmin* Factor 1.

Patent Owner's discovery requests demonstrate how far afield its arguments are from the proper privity analysis. Patent Owner seeks agreements relating to MPS's products (RFP No. 1) and communications relating to MPS's products and Patent Owner (RFP No. 2); these discovery requests relating to commercial relationships do not support the argument of privity. *Semiconductor Components,* IPR2023-01242-44, at pg. 11-12, Paper 31. Even worse, Patent Owner's interrogatory (Rog. 1) transparently seeks MPS's litigation position, *i.e.*, whether MPS contends that it is licensed, which bears no relationship to the privity analysis. *Semiconductor Components,* IPR2023-01242-44, at pg. 10, Paper 31. Patent Owner's requests seek discovery that is tangential to privity; its requests are a pure fishing expedition.

The discovery requests Patent Owner opted not to propound demonstrate the impropriety of its motion. Patent Owner does not request discovery on the operative privity question (*i.e.*, MPS's participation in prior litigations/IPRs involving [redacted]). *See, e.g., Wi-Fi One, LLC v. Broadcom Corp.*, 887 F.3d 1329, 1339 (Fed. Cir. 2018) (the privity inquiry "requires sufficient proof that the party in question had sufficient control over the prior proceeding that it could be bound by

the results of that proceeding.") This is because Patent Owner knows MPS did not participate in those prior litigations/IPRs.[9] Indeed, Patent Owner has not alleged that MPS participated in—or was even aware of—the prior litigations/IPRs. (EX1048, *Greenthread, LLC v. Monolithic Power Systems, Inc.*, Case No. 1-23-cv-00579 (complaint); *see also Semiconductor Components,* IPR2023-01242, at pg. 12-13, Paper 31 (finding Patent Owner's failure to do so weighs heavily in favor of denial under Factor 1).) Nor do Patent Owner's requests seek discovery into [redacted] participation in MPS's current IPR. Again, this is because Patent Owner knows [redacted] did not participate in MPS's IPRs. [redacted] would have zero reason to undertake the expense to invalidate Patent Owner's patents using MPS as a proxy. Here, Patent Owner makes no plausible allegation that MPS had any control over the prior proceedings, and there is no evidence tending to demonstrate that MPS was in privity with [redacted]

Finally, Patent Owner's caselaw citations are inapplicable. *In re Google LLC,* 949 F.3d 1338, 1346 (Fed. Cir. 2020) dealt with patent venue, and whether privity exists for a specific server installation in Texas. *Herrion v. Children's Hosp. Nat.*

[9] MPS represented to Patent Owner that no such agreements or awareness of the prior lawsuit exists. (EX1049, Apr. 23 Patent Owner E-Mail to Board.)

Med. Ctr., 786 F. Supp. 2d 359, 371 (D.D.C.), aff'd, 448 F. App'x 71 (D.C. Cir. 2011) dealt with *res judicata* for a specific party (security guards) when plaintiff brought subsequent suit against the security guards' employer (Children's National) on the same operative act. The fact patterns of *Google* and *Herrion* are inapplicable to the privity analysis for 35 USC § 315(b) to determine whether there is a time-barred petitioner. *Ventex Co. v. Columbia Sportswear North America, Inc.*, involved an exclusive supplier—with exclusive manufacturing agreements—for a time-barred party's product. IPR2017-00651, Paper 152[10] at 12 (PTAB Jan. 24, 2019) (stating that Petitioner in *Ventex* "had a preexisting substantive legal relationship in the form of two contracts, a Supplier Agreement with an obligation to indemnify and defend, and an Exclusive Manufacturing Agreement.") *Bungie Inc. v. Worlds Inc.* involved a developer (Bungie) that provided a video game (the game Destiny) to a time-barred game publisher (Activision) who was sued on that very same video game. IPR2015-01264, Paper 64 at 9-10 (PTAB Jan. 14, 2020). Here, MPS provides commodity-level components, one of scores of hundreds of such components incorporated into larger products sold to end users, not the complete product as in *Bungie* and *Ventex*. Finally, Patent Owner's argument regarding *Taylor v. Sturgell,* 553 U.S. 880 (2008) has been recognized by the Board as "self-

[10] Paper 148 is dismissed. Paper 152 is the version available on PTACTs.

contradictory" because the sale of licensed components "cannot give rise to infringement liability." *Semiconductor Components,* IPR2023-01242-44, at pg. 12, Paper 31. None of Patent Owner's cases support its motion.

Factor 1 weighs heavily in favor of denying Patent Owner's motion.

B. *Garmin Factor 2: Whether the request seeks the litigation positions of the other party*

Garmin Factor 2—which considers whether a party is attempting to use PTAB discovery as a pre-text to obtain litigation positions—weighs heavily in favor of MPS. *Garmin*, IPR2012-00001, at 6.

Patent Owner concedes that it is requesting Petitioner's litigation position and wrongly asserts the request is for the interest of fairness. (Mot. at 9.) Naturally, this argument been flatly rejected as blatantly looking for a litigation position. *Semiconductor Components,* IPR2023-01242-44, at pg. 13, Paper 31. Furthermore, Patent Owner has not provided any law or facts that establish that a license defense—especially one to which Petitioner was not a party—establishes any basis for privity. Patent Owner's position reduces to the argument that a license, by its mere existence, establishes privity. This red-line rule contradicts the law. Patent Owner's attempt to use PTAB discovery to obtain MPS's litigation positions should be flatly rejected.

Factor 2 weighs heavily in favor of denying Patent Owner's motion.

C. *Garmin Factor 3: Ability to generate equivalent information by other means*

The Board did not analyze Factors 3-5 in the *Semiconductor Components* case because *Garmin* Factors 1 and 2 weighed so heavily against Patent Owner. *Semiconductor Components,* IPR2023-01242-44, at pg. 13, Paper 31. However, for the sake of completeness, Factors 3-5 are addressed briefly below.

Garmin Factor 3—which considers the parties ability to obtain the information absent PTAB interference—weighs heavily in favor of MPS. *Garmin*, IPR2012-00001, at 5. Patent Owner already has the information it needs. Patent Owner relies on its own previous litigations and its own licenses (to which it concedes Petitioner was not a party). Moreover, Greenthread can only point to its filing of suit against MPS to demonstrate MPS's awareness of Patent Owner. (Mot. at 5.) Further, MPS already informed Patent Owner that it was unaware of, and did not participate in, the prior litigations or IPRs. (EX1049, Patent Owner Apr. 23, 2024 Board E-Mail). The relevant facts necessary to determine a privity relationship related to the licenses and MPS's awareness of the Greenthread litigations have already been established, and Patent Owner cannot receive additional discovery based on pure speculation.

Factor 3 weighs in favor of denying the Motion.

D. *Garmin Factor 4: understandability and complexity of requests*

Factor 4—which considers the understandability and complexity of requests—weighs in favor of MPS. *Garmin*, IPR2012-00001, at 5-6. Although the requests are clear in their language, they ask for all communications with [redacted] on all MPS products. (RFP 2.) This is, on its face, is overbroad (*see* Factor 5) and cannot possibly match any need in this proceeding. This factor weighs in favor of MPS.

E. *Garmin Factor 5: Burden of the requests*

Factor 5—which considers burden—weighs in favor of MPS. *Garmin*, IPR2012-00001, at 5-6. Patent Owner requests all agreements and communications relating to [redacted] RFP 2's request for communications would require MPS to scour all its employees' communications (including its engineering team) with anyone at [redacted] RFP 1's request for agreements appears to encompass, *inter alia*, any and all types of purchases order, specifications, drawings, and/or test results. None of these documents bear any relevance to whether there is a privity to invoke a time-bar.

Factor 5 weighs heavily in favor of denying the Motion.

III. CONCLUSION

For the foregoing reasons, the Motion should be denied.

Dated: September 25, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that true copies of Petitioner's Response to Patent Owner's Motion for Additional Discovery and associated exhibits have been electronically served in their entireties on counsel for patent owner as follows:

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