

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 (Patent 8,421,195 B2)
IPR2024-00469 (Patent 9,190,502 B2)
IPR2024-00470 (Patent 11,121,222 B2)
IPR2024-00550 (Patent 10,510,842 B2)
IPR2024-00551 (Patent 10,734,481 B2)
IPR2024-00552 (Patent 11,121,222 B2)
IPR2024-00553 (Patent 11,316,014 B2)¹

PETITIONER'S RESPONSIVE SUPPLEMENTAL BRIEF

¹ The word-for-word identical paper is filed in each proceeding identified in the heading.

Pursuant to the Board's Order Regarding Supplemental Discovery and Briefs (Paper 69,² "Disc. Order"), Petitioner submits this Response.

Patent Owner has produced ZERO evidence supporting a finding of privity. Conversely, Petitioner has produced evidence clearly establishing that there was no privity. Petitioner has affirmatively established that: (1) it has no sales or indemnity agreements with Intel, (2) it does not supply any products to Intel, (3) it had no knowledge of the lawsuit between Patent Owner and Intel ("the Intel litigation") until after that lawsuit had concluded, (4) its components were not implicated in the Intel litigation, and (5) it did not participate in, control, or have an opportunity to control, the Intel litigation in any way. Neither the Federal Circuit nor the P.T.A.B. has ever held a petitioner barred by privity in such circumstances.

It should be remembered that while the Director gave Patent Owner the opportunity to conduct discovery to see if it could find any support for its privity argument, Patent Owner expressly declined to do so.³ Faced with that peculiar decision, the Board issued its own discovery order, clearly setting forth the information Petitioner was to provide and the documents it was to produce (i.e., sales

² For convenience, Petitioner cites papers and exhibits filed in IPR2024-00468 unless otherwise indicated. Substantially identical papers were filed in the other instant cases. *See also* Disc. Order at 3 nn.1, 4.

³ "Patent Owner unequivocally stated its intention [to] not renew its request for additional discovery, pertaining to any alleged privity relationships between Petitioner and Intel or Sony, in any of the instant cases." Disc. Order at 4 (citing "IPR017," Paper 63 at 2).

and indemnity agreements), if any such documents existed. Petitioner provided clear and complete answers to each question the Board posed and a declaration stating that no such documents existed, as Petitioner had neither sold products to Intel nor indemnified it for anything.

Faced with the fact that there is ***absolutely no evidence*** supporting a privity argument, and substantial evidence “proving the negative,” Patent Owner now has the temerity to argue that Petitioner’s response to the Board’s order, while “superficially [] compliant with the Board’s order,” was somehow deficient. Paper 74 at 4. Having elected not to seek its own discovery, and because the facts revealed by the Board’s discovery requests negate any privity finding, Patent Owner now irrationally contends that Petitioner should have done something more than simply provide the answers to every question the Board posed. And consistent with its practice of misrepresenting the evidence and the law,⁴ Patent Owner falsely pronounces that it “has presented far more than ‘some evidence’ that time-barred parties, including Intel, should have been named as RPI in the Petition.” *Id.* at 2. Let us be clear: Patent Owner has presented ***nothing*** to support that proposition.

I. BACKGROUND

Patent Owner sued Intel on January 27, 2022. EX2001. Patent Owner accused

⁴ See, e.g., Paper 23 (Institution Decision) at 15 (“Patent Owner’s arguments, however, are inconsistent with the representations it made during prosecution.”).

Intel-made processors of infringement. EX2009, ¶ 65. Intel accepted a license agreement with Patent Owner on April 7, 2023, and the parties settled in late April 2023. EX2011; Paper 35 (“PO Resp.”) at 33; *see also Greenthread, LLC v. Intel Corp. et al.*, No. 3:22-cv-02001-JR, ECF No. 51 (D. Or. Apr. 24, 2023).

On May 26, 2023, more than one month later, Patent Owner sued Petitioner. Petitioner first learned of the Intel litigation shortly thereafter, while investigating Patent Owner's allegations. EX2086 (“Summers Decl.”), ¶ 11. In the case against Petitioner, Patent Owner identified the MP2953 as purportedly being related to Intel. PO Resp. at 35. The MP2953, however, is a low-cost chip that merely complies with Intel standards, and countless other companies provide similarly complying components. *See* Paper 42 (“Pet. Reply”) at 26 (citing EX2019; EX1053). And Patent Owner had not mentioned or accused that chip—or any other MPS product—of infringement in the Intel litigation. *See generally* EX2009; EX2005; Pet. Reply at 26. Moreover, Patent Owner had not accused the Intel standards of infringement.

During the pendency of these IPRs, in parallel IPRs on the same patents filed by a different petitioner (Semiconductor Components Industries, LLC, d/b/a “onsemi”), the Director, upon review of the final written decisions holding all challenged claims unpatentable (*see, e.g., Semiconductor Components Indus., LLC v. Greenthread, LLC*, IPR2023-01242, Paper 84), ordered additional, narrowly tailored discovery to the same privity question that Patent Owner has raised here, so

that Patent Owner could use such discovery to attempt to meet its initial burden—to offer more than a “mere assertion” under *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242–44 (Fed. Cir. 2018). *See, e.g., Semiconductor Components Indus., LLC v. Greenthread, LLC*, IPR2023-01242, Paper 94 at 3 (P.T.A.B April 4, 2025) (“Dir. Dec.”). In that decision, the Director clarified that two specific categories of discovery material to the privity analysis should be provided: “*indemnification agreements* between Petitioner and Intel and the terms and conditions of *sales agreements* between Petitioner and Intel related to products accused of practicing the challenged claims.” *Id.* (emphases added).

In light of the Director’s Decision in the onsemi IPRs, the Board asked Patent Owner whether it wanted to take similar discovery in these IPRs, but Patent Owner declined to do so. Disc. Order at 4 (citing “IPR017,” Paper 63 at 2). Presumably perplexed by that decision, the Board *sua sponte* ordered additional discovery into Patent Owner’s privity question. Disc. Order at 6. The Board’s specific instructions were, like the Director’s Order in the onsemi IPRs, focused on indemnity and sales agreements, but slightly broader and directed to five specific topics:

(a) The following documents:

- a. **Sales agreements** between Petitioner and Intel for the Intel Accused Products;[] and
- b. **Indemnification agreements** between Petitioner and Intel for the Intel Accused Products. *See* IPR1242, Dir. Dec. 3.

(b) Documents sufficient to show the asserted privity relationship between Petitioner and Intel, including any new **declaration(s) that establish that no documents responsive to Subsection (a) above exist**, as well as any documents and new declaration(s) that establish (1) the **time by which Petitioner became aware of the Intel litigation** referenced in the Director's Decision; (2) **whether Petitioner was the supplier** of any product, or component of a product, accused of infringement in the Intel litigation; and (3) **whether Petitioner was in a position to control**, or actually controlled, Intel's defense of that litigation.

Id. at 6–7 (emphases added). As ordered, Petitioner investigated and provided a sworn declaration from its Senior Corporate Counsel, Ms. Carly Summers, on all five topics. The declaration explained in pertinent part:

6. . . . There are **no sales agreements** at all between Petitioner and Intel, much less any sales agreements between Petitioner and Intel that would cover any of the Intel Accused Products.

7. . . . There are **no indemnification agreements** at all between Petitioner and Intel, much less any indemnification agreements between Petitioner and Intel that would cover any of the Intel Accused Products.

8. . . . Petitioner was **not the supplier to Intel of any product, or component of a product, accused of infringement** in the Intel litigation. . .

10. . . . Petitioner **first learned** of Patent Owner's litigation against Intel **on or about May 26, 2023**. . . .

12. . . . Petitioner had **no knowledge of, or involvement in, Intel's defense in its litigation against Patent Owner**. Petitioner **did not actually control, nor was it in a position to control**, Intel's defense in that litigation.

Summers Decl., ¶¶ 6–8, 10, 12 (emphases added).

Ms. Summers sat for a deposition on July 29, 2025. *See* EX2087 (“Summers Dep. Tr.”) at 1. Tellingly, Patent Owner did not ask Ms. Summers a single question about Petitioner's knowledge of, or ability to control, the Intel lawsuit. Indeed, Patent Owner largely avoided asking questions about the factors the courts have identified as being relevant to determining privity, instead focusing on irrelevant topics and asking vague questions that reflected either a profound lack of knowledge of the electronics industry or a deliberate plan to confuse the record, or both.

II. LEGAL STANDARD

“[A]n IPR petitioner's initial identification of the real parties in interest should be accepted unless and until disputed by a patent owner. . . . [If disputed, a] patent owner must produce some evidence to support its argument that a particular third party should be named a real party in interest.” *Worlds*, 903 F.3d at 1242. Then, “the IPR petitioner bears the ultimate burden of persuasion to show that its petitions are not time-barred.” *Id.*

“[T]he privity analysis seeks to determine ‘whether the relationship between the purported “privity” and the relevant other party is sufficiently close such that both

should be bound by the trial outcome and related estoppels.” *WesternGeco LLC v. ION Geophysical Corp.*, 889 F.3d 1308, 1318 (Fed. Cir. 2018) (citation omitted).

There is a general rule against nonparty preclusion, but there are some exceptions:

The Supreme Court has provided a non-exhaustive list for examining whether the legal relationship between two parties establishes that one is the privy of the other. The list consists of six categories that create independent exceptions to the common law rule that normally forbids non-party preclusion in litigation: (1) an agreement between the parties to be bound; (2) pre-existing substantive legal relationships between the parties; (3) adequate representation by the named party; (4) the non-party's control of the prior litigation; (5) where the non-party acts as a proxy for the named party to relitigate the same issues; and (6) where special statutory schemes foreclose successive litigation by the non-party (*e.g.*, bankruptcy and probate).

Applications in Internet Time, LLC v. RPX Corp., 897 F.3d 1336, 1360 (Fed. Cir. 2018) (Reyna, J., citing *Taylor v. Sturgell*, 553 U.S. 880, 894 (2008)). Patent Owner has not presented any evidence that even one of those six exceptions is present here. Petitioner, conversely, has presented conclusive evidence that none is present.

Determining privity is a factual and flexible analysis, but the Federal Circuit and the P.T.A.B. have generally focused on four significant factors: whether the petitioner had control over the previous proceeding, indemnity agreements, sales agreements, and, ultimately, the fairness to the petitioner in barring them. *See, e.g.*,

WesternGeco, 889 F.3d at 1319–22 (analyzing control, purchase agreements, and indemnity agreements to determine whether the parties were sufficiently close such that one was given a “full and fair opportunity to litigate the validity of the claims” in the other proceedings); *Aspex Eyewear, Inc. v. Zenni Optical Inc.*, 713 F.3d 1377, 1382 (Fed. Cir. 2013) (“A full and fair opportunity to litigate is the touchstone of any preclusion analysis.”) (citing *Taylor*, 553 U.S. at 892). Patent Owner has not presented any evidence that even one of those four factors supports it. Petitioner, conversely, has presented conclusive evidence that there are no purchase or indemnity agreements, it had no control over the Intel litigation, and it would be profoundly unfair to bar Petitioner’s validity challenges.

III. PETITIONER IS NOT IN PRIVACY WITH INTEL⁵

A. The Most Significant Factors Weigh Against a Finding of Privacy and Patent Owner Entirely Ignores or Misrepresents Each One.

In view of the evidence Petitioner produced pursuant to the five discovery topics, all factors, including those focused on by the Director, show that Petitioner is not a privy of Intel. As described above, in analyzing privacy, the Federal Circuit and P.T.A.B. have generally focused on evidence of control, indemnity agreements,

⁵ The Director and the panel ordered discovery only into privacy with Intel. *See* Dir. Dec. at 3; Disc. Order at 6–8. Patent Owner declined to request any discovery into Sony or Dell, either before or after the Board’s Order on Supplemental Discovery (*see* n. 3 *supra*), and thus, Patent Owner has waived any further argument on the sufficiency of discovery into Petitioner’s relationship with Dell or Sony.

sales agreements, and fairness to the petitioner. *See, e.g., WesternGeco*, 889 F.3d at 1319–22. The Director's Decision focused on two of those factors—indemnity agreements and sales agreements—requiring discovery for “any indemnification agreements between Petitioner and Intel and the terms and conditions of sale agreements between Petitioner and Intel related to products accused of practicing the challenged claims.” Dir. Dec. at 3. The discovery topics addressed in the panel's Discovery Order are also largely directed towards those four significant factors. *See* Disc. Order at 6–7. All four refute Patent Owner's privity claim.

The control factor weighs against privity because Petitioner did not control or direct the lawsuit between Patent Owner and Intel. Ms. Summers confirmed that “Petitioner first learned of Patent Owner's litigation against Intel on or about May 26, 2023,” which was a month *after* the Intel case settled (and was after Intel's own one-year time bar had already run). *See* Summers Decl., ¶¶ 10-11 (answering third discovery topic). Ms. Summers also confirmed that “Petitioner had no knowledge of, or involvement in, Intel's defense in its litigation against Patent Owner. Petitioner did not actually control, nor was it in a position to control, Intel's defense in that litigation.” *Id.*, ¶ 12 (answering fifth topic).

And even if Petitioner had known about and wanted to control the Intel litigation, it could not have because Petitioner has no contractual agreements with Intel that would give it the right of such control. *Id.*, ¶¶ 6-7. Moreover, Petitioner's

products were not implicated in the Intel lawsuit, meaning Petitioner would have had no grounds to step in even if there was such an obligation. Intel-made processors were accused, not lower-level, low-cost components that comply with Intel's standards, and Intel's standards were not accused. *See* EX2009, ¶ 65; Pet. Reply at 26 (citing EX2019; EX1053). Accordingly, there is "no evidence to suggest that [Petitioner] . . . directed, funded, controlled, or influenced" the Intel case. *WesternGeco*, 889 F.3d at 1320. It is common sense—Petitioner could not have controlled the Intel case when it did not even know it was happening.

The legal relationship factors also weigh heavily against privity because Petitioner does not have any indemnity or sales agreements with Intel and is not the supplier to Intel for any product or component which was accused in the Intel litigation. Ms. Summers confirmed that "[t]here are no sales agreements at all between Petitioner and Intel" and "[t]here are no indemnification agreements at all between Petitioner and Intel." Summers Decl., ¶¶ 6, 7 (first and second discovery topics). Ms. Summers further confirmed that "Petitioner was not the supplier to Intel of any product, or component of a product, accused of infringement in the Intel litigation." *Id.*, ¶ 8 (fourth discovery topic). Ms. Summers further confirmed in her deposition that Intel is not a customer of Petitioner. Summers Dep. Tr. at 35:1-4.

The fact that there are no indemnity or sales agreements weighs against privity considering that the Federal Circuit has found no privity even when an indemnity

agreement exists. For example, in *WesternGeco*, the Federal Circuit affirmed that no privity existed even when there was an indemnification clause in a sales agreement because the clause did not specify the meaning of “‘indemnify’ as requiring [the party] . . . to pay for any litigation defense expenses or for any damages related to infringement.” 889 F.3d at 1321. If no privity exists even when an indemnification clause and sales agreement exist, then certainly, no indemnification or sales agreements push the present situation further away from a finding of privity.

Worlds, which Patent Owner relies heavily on, does not instruct otherwise. In *Worlds*, the parties had a development agreement for the product named in the litigation, and that agreement contained an indemnity provision. *Worlds*, 903 F.3d at 1240. The facts here are far different from *Worlds* because there is no indemnity agreement. *See id.* at 1240, 1244–45 (further stating that the Bungie product (Destiny) was a part of the Worlds-Activision litigation and evidence suggested Activision might be controlling and/or funding Bungie's IPRs).

Last, the issue of fairness weighs against privity because it would be profoundly unfair to estop Petitioner from challenging Patent Owner's patents, where Petitioner did not even know of the Intel litigation, did not and could not participate in or control that litigation, had no sales or indemnity agreement with Intel, and whose accused products were never mentioned in that litigation. How could Petitioner be estopped from pursuing IPR proceedings based on a different

company's involvement in a district court litigation that Petitioner never knew about or had any reason to care about?

Accordingly, all of the significant factors definitively weigh against a finding of privity, particularly when there is a general rule against finding nonparty preclusion. None of the six exceptions to the general rule identified in *Taylor* is present here.

Despite the Board's focus on the factors courts have identified as being relevant to the privity issue, Patent Owner either ignores or misrepresents them. For example, Patent Owner's Supplement Brief never mentions Petitioner's knowledge of or ability to order or control the Intel litigation and never mentions fairness. *See* Paper 74 ("PO Supp. Brief") at 1–13. And regarding agreements, Patent Owner entirely misrepresents the scope of Ms. Summer's investigation. *See* PO Supp. Brief at 5–6. Ms. Summer did not merely look for sales and indemnity agreements just for the Intel Accused products ("IAPs"), but instead investigated if Petitioner had *any* sales or indemnity agreements with Intel. *Compare* PO Supp. Brief at 5–6 *with* Summers Decl., ¶¶ 6, 7 (stating there are "no sales [and indemnification] agreements *at all* between Petitioner and Intel" (emphasis added)). Following its usual playbook, Patent Owner falsely suggests that some indemnity agreement *does* exist between Petitioner and Intel. In reality, while Ms. Summers confirmed there are "some instances" where Petitioner's direct sales contracts with companies other than Intel

include an indemnity clause, she *never* suggested an indemnity agreement exists with Intel and her declaration directly refutes Patent Owner's falsehood. *Compare* PO Supp. Brief at 3 (falsely suggesting Petitioner has indemnity agreement with Intel) *with* Summers Dep. Tr. at 31:5–15, Summers Decl., ¶¶ 6, 7.

B. Patent Owner's Supplemental Brief Does Nothing to Support a Privity Finding.

Instead of addressing the relevant factors, Patent Owner spends its supplemental brief attempting to create confusion as to whether Petitioner was the supplier of any product accused of infringement in the Intel litigation. Those attacks are misguided and irrelevant for three reasons.

First, Patent Owner attacks Ms. Summers for not knowing whether Petitioner's products could somehow, through some unknown, hypothetical chain of third-party transactions, wind up in an IAP (*see generally* PO Supp. Brief at 10–13). This point, however, is irrelevant to the privity analysis. Patent Owner does not cite a case showing that a party's product which was not implicated as an accused product in another lawsuit was a dispositive factor for finding privity. Moreover, *it was Patent Owner*—not Petitioner—who collected and presumably examined the IAPs before accusing them of infringement. And yet, despite having years to investigate those specific products, Patent Owner has never claimed, much less produced *any* evidence, that *any* of the IAPs contains *any* of Petitioner's products.

Second, Patent Owner attacks Ms. Summers for not investigating whether

there were indirect sales from Petitioner to Intel (*see generally* PO Supp. Brief at 4–10)—e.g., whether Intel could have been a customer of a customer of Petitioner. But that inquiry is untethered from the privity analysis. Privity has not been found in cases even where there was a *direct* sales relationship because such a sales relationship alone does not show that the parties are “sufficiently close that both should be bound by the trial outcome and related estoppels.” *WesternGeco*, 889 F.3d at 1321. If a standard, direct sales relationship, without more, is not enough to justify privity, then certainly offering a product that some unknown downstream customer, through some unknown string of transactions, might ultimately supply to Intel, cannot serve as the basis for finding privity.

Patent Owner suggests that privity exists when “two parties are ‘preceding and succeeding owners of property,’” but this creative interpretation of *Taylor* is absurd. PO Resp. at 38, 48–49 (citing *Taylor*, 553 U.S. 894–95). If the sale of an electrical component (i.e., a transfer of property) meant that the buyer and seller were always in privity, then Petitioner would be in privity with every single downstream product manufacturer that ever incorporated one of Petitioner's products, and Petitioner would be precluded from filing an IPR if any of those companies had ever been sued. That cannot possibly be true and cannot outweigh the overwhelming evidence showing that there is no privity here, where Petitioner indisputably had no knowledge of, or ability to control, the Intel litigation.

Moreover, even if Patent Owner had produced evidence that any of Petitioner's products *were* in any of the IAPs, that fact would carry little weight in the privity analysis and would certainly not outweigh the predominant factors—control, indemnity and sales agreements, and fairness—which weigh heavily against a finding of privity. The IAPs were Intel-fabricated microprocessors, not low-level components such as Petitioner's tiny power converters and regulators. *See* EX2009, ¶ 65; EX2005; Pet. Reply at 26.

Stepping back, it should be noted that Patent Owner's patents are directed to dopant gradients in specified regions of silicon wafers and the alleged effects such gradients have on charge carriers. As Patent Owner knows—and Ms. Summers testified—Petitioner is a fabless manufacturer. Summers Dep. Tr. at 20:16-17. In other words, Petitioner does not even fabricate its own chips, much less provide microprocessor design or fabrication services for Intel. Petitioner's technology was never involved in Patent Owner's case against Intel. Patent Owner's persistence in pursuing its baseless privity argument in the face of the unequivocal evidence only serves to further demonstrate that it will say *anything* it believes will mislead the Board and avoid or postpone invalidation.

IV. CONCLUSION

There is no privity between Petitioner and Intel. Accordingly, the Petitions are not time-barred.

Dated: August 26, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that true copies of the foregoing **PETITIONER'S RESPONSIVE SUPPLEMENTAL BRIEF** were served in their entirety this 26th day of August, 2025 by electronic mail on the Patent Owner via its attorneys of record:

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