

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MONOLITHIC POWER SYSTEMS, INC.

Petitioner,

v.

GREENTHREAD, LLC,

Patent Owner.

IPR2024-00470

U.S. Patent No. 11,121,222

**PATENT OWNER'S REPLY IN SUPPORT OF ITS
MOTION FOR ADDITIONAL DISCOVERY**

EXHIBIT LIST

Exhibit No.	Description
Ex. 2001	<i>Greenthread, LLC v. Intel Corp.</i> , No. 6:22-cv-00105-ADA, Dkt. 1 (Complaint) (W.D. Tex. Jan. 27, 2022)
Ex. 2002	<i>Greenthread, LLC v. Intel Corp.</i> , No. 6:22-cv-00105-ADA, Dkt. 7 (summons returned executed) (W.D. Tex. Feb. 7, 2022)
Ex. 2003	<i>Greenthread, LLC v. Intel Corp.</i> , 6:22-cv-00105-ADA, Dkt. 38 (First Amended Complaint for Patent Infringement) (W.D. Tex., filed Apr. 29, 2022)
Ex. 2004	<i>Greenthread, LLC v. Intel Corp.</i> , No. 6:22-cv-00105-ADA, Dkt. 113 (Redacted Memorandum Opinion and Order) (W.D. Tex. Dec. 27, 2022)
Ex. 2005	<i>Greenthread, LLC v. Intel Corp.</i> , 6:22-cv-00105-ADA, Dkt. 38-8 (Greenthread's Amended Preliminary Infringement Contentions) (W.D. Tex., filed Apr. 29, 2022)
Ex. 2006	<i>Greenthread, LLC v. Intel Corp.</i> , 6:22-cv-00105-ADA, Dkt. 38-12 (Exs. D-1, D-2, D-3, D-6 to Greenthread's Preliminary Infringement Contentions) (W.D. Tex., filed Apr. 29, 2022)
Ex. 2007	<i>Greenthread, LLC v. Intel Corp.</i> , 6:22-cv-00105-ADA, Dkt. 49 (Notice of Appearance of Additional Counsel) (W.D. Tex., filed June 9, 2022)
Ex. 2008	Petition (Paper 1) in <i>Sony Group Corp. v. Greenthread, LLC</i> , IPR2023-00376
Ex. 2009	<i>Greenthread, LLC v. Dell Inc.</i> , No. 6:22-cv-105-ADA, Dkt. 120 (Second Amended Complaint)
Ex. 2010	<i>Greenthread, LLC v. Intel Corp.</i> , 6:22-cv-00105-ADA, Dkt. 135 (Motion for Admission Pro Hac Vice of L. Popovski on Behalf of Sony) (W.D. Tex., filed January 30, 2023)
Ex. 2011	[SEALED] Confidential agreement
Ex. 2012	[SEALED] Confidential declaration

Exhibit No.	Description
Ex. 2013	February 5, 2024 Neil Ozarkar email to the counsel regarding IPR2014-00468, -00469, -00470
Ex. 2014	February 21, 2024 Miguel Bombach email to counsel regarding IPR2014-00468, -00469, -00470
Ex. 2015	March 6, 2024 Arvind Jairam email to the Board regarding IPR2014-00468, -00469, -00470
Ex. 2016	Greenthread’s December 13, 2023 Preliminary Infringement Contentions to Monolithic
Ex. 2017	Monolithic Power Systems, Inc., Investor/Analyst Day 2018 Presentation
Ex. 2018	Monolithic Power Systems, Inc. Q2 2021 Earnings Call Transcript
Ex. 2019	Monolithic Power Systems, Inc. Data Sheet MP2953B Intel VR12.5 Compliant Controller
Ex. 2020	Monolithic Power Systems, Inc. LinkedIn post regarding Sony PlayStation 5
Ex. 2021	May 2, 2015 Investor’s Business Daily, “Sony PlayStation 4 Chipmaker Monolithic Power Systems Tops Q1 Views”
Ex. 2022	Monolithic Power Systems, Inc. 2023 Form 10-K
Ex. 2023	Petition (Paper 2) in <i>Sony Group Corp. v. Greenthread, LLC</i> , IPR2023-00324
Ex. 2024	Petition (Paper 3) in <i>Sony Group Corp. v. Greenthread, LLC</i> , IPR2023-00325
Ex. 2025	Petition (Paper 1) in <i>Sony Group Corp. v. Greenthread, LLC</i> , IPR2023-00375
Ex. 2026	<i>Greenthread, LLC v. Monolithic Power Systems, Inc.</i> , No. 23-cv-579, Dkt. 1 (Complaint with accompanying exhibits) (D. Del. May 26, 2023)

Exhibit No.	Description
Ex. 2027	<i>Greenthread, LLC v. ON Semiconductor Corp.</i> , No. 23-443-RGA, Dkt. 24 (Scheduling Order) (D. Del. Sept. 11, 2023)
Ex. 2028	Definition of “agent” in Black’s Law Dictionary (11 th ed. 2019) available from Westlaw at westlaw.com

Petitioner's response rests on a narrow and wrong definition of privity. MPS does not have to control Licensees or the prior proceedings to be in privity. Controlling Supreme Court case law and prior Board decisions make clear that control is only one factor in considering privity. This strawman serves only to distract from the core issue in PO's Motion and the gating issue for this proceeding: whether Petitioner may limit its infringement liability by cloaking itself in Licensees rights to "have made" products under their licenses. Whichever way one looks at it, Petitioner has a "pre-existing substantive legal relationship" giving rise to privity.

First, customer-supplier relationships can and frequently do create privity. *See, e.g., Ventex Co., Ltd. v. Columbia Sportswear N. Am., Inc.*, IPR2017-00789, Paper 148 at 14 (PTAB Jan. 24, 2019) (precedential). Second, Petitioner and Licensees are "preceding and succeeding owners of" licensed (or infringing) articles. *Taylor v. Sturgell*, 553 U.S. 880, 894 (2008). Petitioner's use and sale of those articles is what gives rise to liability. Third, Petitioner is acting as a manufacturing "***agent for***" Licensees by exercising Licensees' "have made" rights under the license. *Id.* at 895 (emphasis added).

Petitioner could have mooted a large portion of PO's motion by answering some straightforward questions, such as whether it plans to claim the benefit of the license. Instead, Petitioner claims that its license defense "bears no relationship to the privity analysis." Opposition ("Opp."), 8. But, if Petitioner really believes that,

then it would simply acknowledge that it plans to assert Licensee's rights. Petitioner does not admit it plans to do that, because doing so would jeopardize the Petition. Instead, Petitioner forced PO to file this Motion and now opposes it with irrelevant arguments and misleading statements of fact.

Petitioner is not merely a "commodity-component" manufacturer:

Petitioner's claim that its sales are "commodity" sales begs the question. Opp., 2-6. PO seeks discovery to precisely determine whether the sales are "commodity." PO has presented evidence from MPS's public filings that belies its "commodity" claims: Petitioner has said that its products "typically require a highly technical sales and applications engineering effort" and Petitioner maintains a staff of "applications engineers who work directly with customers' engineers." Ex. 2022, 6. Indeed, MPS's opposition claims that to comply with PO's RFP No. 2 it would need to search its "*engineering team*" communications. Opp., 13 (emphasis added). It is clear that MPS engineers are working directly *with* Licensees on the accused products, and these products are not simply "commodity" products later sold in the public marketplace, such as on the Digikey website.

Even if the transactions are some way "commodity," they are manifestly not "commodity" in the relevant sense, because they are sales made under PO's licenses. Petitioner does not point to any cases where the Board found no privity on these facts, because parties operating under a license do not usually file IPRs. Opp., 4-5.

PO is not arguing here that “every single manufacturer” that makes small components is in privity with the component purchasers (Opp., 4), just Petitioner acting as a “have made” vendor under a license. *See* Mot., 6-8.

Petitioner flips the burden of proof: Petitioner claims that “Patent Owner must demonstrate evidence showing that MPS either participated in the prior litigations/IPR or that MPS is acting as a proxy for time-barred entities.” Opp., 7. Not only is that a myopic view of privity,¹ this argument ignores the fact that ***Petitioner has the burden of proof on the time bar.***

There can be no serious dispute that Greenthread here has met its initial “practical” burden under *Worlds*. *See Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1243-44 (Fed. Cir. 2018). At the very least, it is well-established that customer-supplier relationships can create privity, and there is no dispute that Petitioner and the Licensees have such a relationship. The burden therefore falls on Petitioner to establish that the relationship does *not* create privity. Meeting its burden requires ***Petitioner*** to put into the record evidence about its relationships. Petitioner’s

¹ Greenthread respectfully contends that the purpose of § 315(b) and the privity inquiry is not so narrow as the Board found in *Semiconductor Components Indus., LLC v. Greenthread, LLC*, IPR2023-01242, Paper 31 (PTAB Feb. 5, 2024). *See* POPR (Paper No. 10) at 18-20.

statements do not satisfy its burden on the time bar. *See* Mot., 4. Petitioner’s statements certainly do not justify denying PO the discovery it seeks.

PO requests discovery on the operative privity question: Petitioner claims that “Patent Owner does not request discovery on the operative privity question.” Opp., 8. But, again, Petitioner is artificially limiting the question of privity to solely “MPS’s participation in prior litigations/IPRs.” *Id.* Supreme Court precedent is clear that “a *variety* of pre-existing ‘substantive legal relationship[s]’ between” two parties can create privity. *Taylor*, 553 U.S. at 894 (emphasis added).

“[A]greements directly related to the product accused of infringing the patent at issue in this proceeding” satisfy *Taylor*’s “pre-existing substantive legal relationship” test. *Ventex*, IPR2017-00651, Paper 148 at 12. PO’s RFP No. 1 seeks discovery of these agreements. *See* Mot., 6. Jointly designing products is a type of relationship that may also satisfy this test. *See Ventex*, IPR2017-00651, Paper 148 at 13. PO’s RFP No. 2 seeks targeted discovery of communications regarding the design of the accused products. *See* Mot., 6.

Petitioner’s attempts to distinguish PO’s case law are premature. PO seeks *discovery*, not an ultimate determination of privity. PO needs discovery to determine whether the facts here may be similar to *Google* and the other cases cited by PO. Mot., 7-8. Each of those cases found that the facts PO seeks through the requested *discovery* may establish privity. Without discovery, PO cannot know, for example,

if or how Petitioner and its customers collaborate on product design, the existence of any “have made” and exclusive agreements, and which of Petitioner’s products are incorporated into which Licensee products.

PO’s discovery requests are narrowly tailored: PO’s proposed discovery is narrowly tailored to address Petitioner’s relationships with Licensees and to cut through the unfairness of Petitioner’s gamesmanship. RFP No. 1 seeks MPS’s agreements with Licensees. MPS does not claim that this request is overbroad or unclear. *See Opp.*, 13. At the very least, the Board should order this discovery consistent with the *Garmin* factors. *See Mot.*, 10-11. As discussed *supra*, MPS’s argument that RFP No. 2 would require MPS to scour its engineering team’s communications underscores the extent of the relationship with the Licensees and the relevance and need for this discovery.

Regarding the third request, Petitioner cannot (and does not) claim there is any burden in stating whether or not it intends to claim the benefit of the License. Petitioner’s unwillingness to simply confirm or deny this request demonstrates Petitioner’s recognition of its detrimental relevance to privity and the time bar.

For all these reasons, and those stated in the Motion, PO requests that Petitioner be ordered to submit all the requested discovery immediately.

Dated: May 31, 2024

Respectfully submitted,

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that a copy of this **PATENT OWNER'S
REPLY IN SUPPORT OF ITS MOTION FOR ADDITIONAL DISCOVERY**
has been served on Petitioner via email on the following counsel of record for
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Dated: May 31, 2024

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