

PUBLIC VERSION

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

Before KRISTEN L. DROESCH, GRACE KARAFFA OBERMANN,
DONNA M. PRAISS, MONICA S. ULLAGADDI, and JULIA HEANEY,
Administrative Patent Judges.

OBERMANN, *Administrative Patent Judge.*

ORDER

Conduct of the Proceeding

Ordering Supplemental Discovery and Briefs

37 C.F.R. § 42.5

¹ Because this Order addresses issues identical across the cases identified in the caption, we exercise our discretion and enter the same order in each case. The listing of Judges does not expand any panel. The parties may use this style heading in any paper filed pursuant to this Order, provided such heading includes a footnote attesting “the word-for-word identical paper is filed in each proceeding identified in the heading.”

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This Order² authorizes supplemental discovery and briefs limited to a privity dispute relating to an alleged relationship between Petitioner and a non-party, Intel.

A. The Director's Decision in the First Wave Cases

On April 24, 2025, the Director granted review of the Final Written Decisions issued in IPR2023-01242 (“IPR1242”), IPR2023-01243, and IPR2023-01244 (collectively, “the first wave cases”), which involve a different petitioner compared to the instant cases but challenge patents in the same priority chain as, and which claim subject matter similar to, the patents at issue. *See* IPR1242, Paper 94 (“IPR1242, Dir. Dec.”).³

Specifically, the Director determined that, “[p]rior to institution, Patent Owner argued that the petitions were untimely under 35 U.S.C. § 315(b) due to a district court complaint served on Petitioner’s privity, Intel Corporation (‘Intel’), more than one year before the Petitions were filed.” IPR1242, Dir. Dec. 2 (citing IPR1242, Paper 56, 7–25). The Director held the Board abused its discretion by denying discovery on privity. *Id.* at 2–3.

² Concurrently herewith, we issue related orders in IPR2023-01242, IPR2023-01243, IPR2023-01244, IPR2024-00017, IPR2024-00018, IPR2024-00021, IPR2024-00263, IPR2024-00264, IPR2024-00265, and IPR2024-00266. Final written decisions in other related cases (namely, IPR2024-00001, IPR2024-00016, IPR2024-00019, and IPR2024-00020) are the subject of pending requests for Director review.

³ For convenience, when discussing the first wave cases, we cite papers and exhibits filed in IPR242. Similar papers and exhibits were filed in IPR243 and IPR242.

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On that basis, the Director vacated and remanded the first wave cases to the Board with express “instructions to allow discovery” on the question whether Petitioner is in privity with a specific, time-barred non-party, “Intel.” *Id.* at 3. The Director observed that “Patent Owner’s requested discovery was broad” and, further, instructed that “the Board either should have allowed whatever narrower discovery was appropriate or made it clear that Patent Owner could amend or resubmit its discovery motions.” *Id.*

On May 22, 2025, the Director denied Petitioner’s request for rehearing of the Director’s Decision in the first wave cases. IPR1242, Paper 106.

B. Procedural Background of the Instant Cases

A consolidated final hearing in the instant cases is scheduled for July 9, 2025. IPR2024-00468 (“IPR0468”), Paper 64 at 2.⁴ On April 29, 2025, in view of the Director’s Decision in the first wave cases, the statutory deadline for filing Final Written Decisions in these cases was extended by six months for good cause. IPR0468, Paper 58.

During the pre-institution phases of the instant cases, Patent Owner requested permission to seek discovery on Petitioner’s asserted privity relationships with Intel or █████ IPR0468, Paper 8 at 1. In IPR2024-00468, IPR2024-00469, and IPR2024-00470, the Board issued a Decision Denying

⁴ Substantially identical papers were filed in the other instant cases. For convenience, we refer to papers filed in IPR0468.

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Patent Owner's Motion for Additional Discovery, which was worded similarly to the decision in IP2023-01242 (Paper 30). *See* IPR0468, Paper 21. The Board did not rule on Patent Owner's Motions for Additional Discovery in IPR2024-00550, IPR2024-00551, IPR2024-00552, and IPR2024-00553.

We take note that the privity issues are not identical as between the first wave cases and the instant cases: However, although the instant cases involve a different petitioner than the first wave cases, the arguments made by Patent Owner as to privity in the instant cases, at minimum, overlap with those made in the first wave cases. *Compare* IPR0468, Paper 8 *with* IPR1242, Paper 8.

On May 8, 2025, the Board conducted a teleconference with the parties in the above-captioned proceedings. During the teleconference, the Board inquired as to whether Patent Owner would request additional discovery pursuant to the Director's Decision vacating and remanding the Final Written Decisions issued in the first wave cases. IPR0468, Paper 63 at 2. Patent Owner indicated it would not seek additional discovery, preferring instead to "rest on its papers." *Id.* at 3.

C. Supplemental Discovery

Patent Owner unequivocally stated its intention not renew its request for additional discovery, pertaining to any alleged privity relationships between Petitioner and Intel or [REDACTED] in any of the instant cases. IPR017, Paper 63 at 2. We do not view that statement as diminishing the Board's

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authority to *sua sponte* order discovery, particularly where, as here, doing so may facilitate a fair and efficient resolution of the privity dispute and aligns with the spirit and intent of the Director’s Decision in the first wave cases. *See* 37 C.F.R. § 42.5(a) (codifying Board’s inherent authority to “determine a proper course of conduct” to best “administer the proceeding”).

The Board *sua sponte* determines that supplemental discovery on the privity issue may be helpful to the panel in reaching a fair and efficient resolution of the instant cases. Although the instant cases involve a different petitioner than the first wave cases, the arguments made by Patent Owner as to privity in the instant cases, at minimum, overlap with those made in the first wave cases. *Compare* IPR0468, Paper 8 *with* IPR1242, Paper 8. The Director issued express instructions to the Board to provide discovery on an alleged privity relationship involving Intel in the first wave cases. IPR1242, Dir. Dec. 3, 6. Patent Owner similarly alleges a privity relationship between Petitioner and Intel in the instant cases. IPR0468, Paper 8 at 1.

By ordering additional discovery in the instant cases as to the time-barred non-party (Intel) that was the subject of the Director’s Decision, we strive to avoid a similar error. Where Patent Owner expressly has abandoned its request for additional discovery as to any asserted privity relationship between Petitioner and [REDACTED] (*see* IPR0468, Paper 63 at 2–3), we determine that requiring the same scope of discovery in the instant cases, as is provided in the first wave cases, is warranted in view of the Director’s Decision in the first wave cases.

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Just as in the first wave cases, resolving the privity dispute here, concerning the alleged relationship between Petitioner and Intel, on a “full record” after providing “Patent Owner the discovery that the Board authorizes” promotes the interests of justice, corrects the negative results of any error in denying Patent Owner’s pre-institution request to seek discovery, and is appropriate given the potentially dispositive nature of the dispute. IPR1242, Dir. Dec. 3, 6. Resolving the dispute on the existing record, by contrast, opens the door to error that may lead to delay in reaching a final resolution of the instant cases.

Accordingly, we invoke our inherent authority to administer these proceedings and *sua sponte* order supplemental discovery and briefing as set forth in the instructions below. *See* 37 C.F.R. § 42.5(a) (codifying the Board’s inherent authority to “determine a proper course of conduct” to best “administer the proceeding”).

1. Scope and Timing of Supplemental Discovery

Petitioner is instructed to provide the following discovery to Patent Owner by July 11, 2025:

- (a) The following documents:
 - a. Sales agreements between Petitioner and Intel for the Intel Accused Products;⁵ and

⁵ The “products accused” consist of “the ‘Intel Accused Products’ listed on pages 4–8 of IPR0468, Exhibit 2005, namely, the Intel “products accused of practicing the challenged claims’ in Patent Owner’s prior litigation.

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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.
- (c) To the extent Patent Owner requests routine discovery in the form of cross-examination of any declarant(s) produced by Petitioner pursuant to Subsection (b) above, such requests shall be submitted no later than July 15, 2025, and all cross-examination (in the form of deposition(s)) shall be completed by July 29, 2025.

D. Supplemental Briefs

On June 12, 2025, the parties contacted the Board to address a dispute about Petitioner's request to file a supplemental brief in IPR2024-00550, IPR2024-00551, IPR2024-00552, and IPR2024-00553. IPR550, Ex. 3003. We deny Petitioner's request in favor of requiring supplemental briefs from both parties in all of the instant cases.

The Board *sua sponte* determines that supplemental briefs on the privity issue would be helpful to the panel in reaching an efficient and fair resolution of the instant cases in view of the Director's Decision. In particular, after supplemental discovery is completed according to the above

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parameters, the Board will consider new evidence only to the extent that it is cited and explained in a supplemental brief. Accordingly, we order supplemental briefs, and an optional telephonic privity hearing, as set forth below.

1. Patent Owner's Supplemental Brief

No later than August 12, 2025, Patent Owner shall file a Supplemental Brief, not to exceed fifteen (15) pages in length, that explains Patent Owner's position that Petitioner is in privity with time-barred entity Intel. In particular, the Brief should address in detail Patent Owner's assertion that Petitioner is a supplier of products to Intel that are the subject of the licensing agreement in the record. IPR0468, Ex. 2011. This brief may be supported by evidence of record as well as any documents, declarations, and deposition transcripts produced pursuant to the discovery ordered above. No other new evidence may accompany this brief.

2. Petitioner's Responsive Supplemental Brief

No later than August 26, 2025, Petitioner shall file a Responsive Supplemental Brief, not to exceed fifteen (15) pages in length. Petitioner may use this brief to respond to information presented in Patent Owner's Supplemental Brief and to raise any other information that, in Petitioner's view, bears on the privity dispute. This brief may be supported by evidence of record as well as any documents, declarations, and deposition transcripts produced pursuant to the discovery ordered above. No other new evidence may accompany this brief.

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3. Patent Owner's Reply Supplemental Brief

No later than September 2, 2025, Patent Owner shall file a Reply Supplemental Brief, not to exceed fifteen (15) pages in length, limited to rebutting the information presented in Petitioner's Responsive Supplemental Brief. No new evidence may be filed in support of this brief.

4. Optional Hearing on the Privity Dispute

No later than September 4, 2025, the parties shall meet, confer, and jointly file a paper that presents their respective positions (or the parties' joint position if an agreement is reached) about whether the Board should conduct a telephonic hearing on the privity dispute. The joint paper shall provide times during the week of September 8, 2025, during which counsel for both parties are available for a teleconference, if one is requested.

E. Schedule Changes

The parties should contact the Board as soon as practical if any changes to the supplemental discovery and briefing schedules are necessary. Any changes to these schedules must be approved by the Board.

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ORDER

It is

ORDERED that supplemental discovery shall commence and be completed according to the parameters set forth herein;

FURTHER ORDERED that Patent Owner's Supplemental Brief, Petitioner's Responsive Supplemental Brief, and Patent Owner's Reply Supplemental Brief shall be filed in compliance with the instructions set forth herein;

FURTHER ORDERED that the parties shall file a joint paper addressing the optional hearing on the privity dispute as set forth herein;

FURTHER ORDERED that any changes to the discovery and briefing schedules set forth herein must be approved by the Board; and

FURTHER ORDERED that, within five (5) business days of the date of entry of this order, the parties shall file a redacted, public version of this Order

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