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Paper 45
Entered: May 9, 2025

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*.

ULLAGADDI, *Administrative Patent Judge.*

ORDER
Conduct of Proceeding
37 C.F.R. § 42.5

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[1] This Order addresses similar requests filed in 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 permitted to use this style heading in any subsequent papers.

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 IPR2023-01242, IPR2023-01243, and IPR2023-01244 (collectively "the first wave cases"). IPR2023-01242, Paper 94.[2] Among other things, the Director held that the Board abused its discretion when it denied Patent Owner's Motion for Additional Discovery with respect to an issue of privity. *Id.* at 2.

During the pre-institution phases of the instant cases, Patent Owner requested permission to seek discovery on the same privity issue that was the subject of the Director's Decision in the first wave cases. *Compare* IPR2024-00468, Paper 8 *with* IPR2023-01242, Paper 8. We issued a Decision Denying Patent Owner's Motion for Additional Discovery, which was worded similarly to the Decision in IP2023-01242 (Paper 30), in IPR2024-00468, IPR2024-00469, and IPR2024-00470. IPR2024-00468, paper 21.[3] The Board did not rule on Patent Owner's Motion for Additional Discovery in IPR2024-00550, IPR2024-00551, IPR2024-00552, and IPR2024-00553.

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[2] For brevity, we cite to papers filed in IPR2023-01242. Similar papers were filed IPR2023-01243 and IPR2023-001244.

[3] For brevity, we cite to papers filed IPR2024-00468. Similar papers were filed in IPR2024-00469 and IPR2024-00470.

With respect to each of the above-captioned cases, Patent Owner indicated that it believes the Board made a legal error in its Institution Decisions by failing to shift the burden of production to Petitioner with regard to the issue of privity. As such, Patent Owner did not request additional discovery and indicated that, instead, it would "rest on its papers." Patent Owner also asked for a 1-week extension of time to file its Sur-reply in IPR2024-00550, IPR2024-00551, IPR2024-00552 and IPR2024-00553 in order to address issues of privity and attendant issues raised by the Director's Decision. The Board noted that Petitioner would likely be given the opportunity to file another brief addressing the same issues raised by the Director's Decision, which issued after Petitioner's Reply was filed.

Patent Owner thereafter retracted its request and indicated that it would adhere to the initial scheduling order for filing its Sur-reply. Thus, the Board did not authorize any extension to the time period for filing the Sur-reply, nor did it authorize any additional briefing on the part of Petitioner, at this time. The Board reminded the parties that the panel has authority to order additional briefing in the event that such briefing would be helpful in reaching a decision on the privity dispute. The Board reminded Patent Owner that the Sur-reply must be responsive to Petitioner's Reply.

Petitioner indicated a desire to rest on its papers, and, if a hearing was deemed necessary, a consolidated hearing addressing all the above-captioned cases would be preferred. Patent Owner agreed with this request.

The Board agreed to cancel hearings scheduled for May 16, 2025 and June 25, 2025 and to instead, consolidate the hearing for all of the above-captioned cases and conduct the same on July 9, 2025.

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