UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TEXAS INSTRUMENTS INCORPORATED,
Petitioner,

v.

GREENTHREAD LLC,
Patent Owner.

Case IPR2024-00673
Patent 11,121,222

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

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I. INTRODUCTION

Patent Owner seeks discovery to support its contention that Texas Instruments ("TI") is in privity with prior defendants, Intel[redacted]. Paper 9, 1 ("PO Mot."). Patent Owner asserts that each of the prior defendants are time barred under 35 U.S.C. § 315(b), and, as a consequence, the present Petition is time barred. *Id*. at 1 and 5-6.

The present Petition is a substantive copy of the Petition in IPR2023-01242 and was filed with a motion for joinder to that proceeding. IPR2024-00673, Paper 2. Even ignoring that, if joined, the time bar in 35 U.S.C. § 315(b) does not apply to TI's Petition, Patent Owner's overly broad and baseless arguments for privity do not justify granting the requested discovery. In essence, Patent Owner seeks discovery simply because TI's chips have been incorporated in Intel's[redacted] products. Patent Owner's privity theories are not based in the applicable law, and its similar theories were rejected at institution of IPR2023-01243. *See*, *Semiconductor Components Industries, LLC v. Greenthread, LLC*, IPR2023-01243, Paper 34 (Decision Granting Institution of *Inter Partes* Review) and Paper 43 (Order denying request for Director Review). Thus, Patent Owner's requests fail to seek information that would be useful in determining whether TI is in privity with Intel[redacted].

Moreover, Patent Owner requests are impossibly broad and burdensome, seeking "[a]ll agreements" and "[a]ll communications" between TI and Intel[redacted]

[redacted] about products sold, made or to, for or with Intel[redacted]. And, their request seek litigation positions.

Patent Owner's requested discovery, a speculative fishing expedition, should be denied.

II. ARGUMENT

Patent Owner, as the moving party, bears the burden of demonstrating that its additional discovery is "in the interests of justice." 37 C.F.R. § 42.51(b)(2); *Wi-Fi One, LLC v. Broadcom Corp.*, 887 F.3d 1329, 1339 (Fed. Cir. 2018). Additional discovery is not granted as a matter of course. To the contrary, such discovery is "limited" and reserved for "special circumstances" where warranted. *Google LLC v. CyWee Grp. Ltd.*, IPR2018-01258, Paper 30 at 8 (PTAB June 20, 2019).

Garmin lists five factors that are relevant to whether the requested discovery is in the interests of justice: (1) the request is based on more than a mere possibility of finding something useful; (2) the request does not seek the litigation positions of the other party; (3) the information is not reasonably available through other means; (4) the request is easily understandable; and (5) the request is not overly burdensome to answer. *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 5 (PTAB Mar. 5, 2013) (precedential) ("*Garmin*").

One need only consider *Garmin* factors 1, 2 and 5 to understand why Patent Owner's discovery requests are not in the interests of justice and should be denied.

A. Garmin Factor 1: Patent Owner Fails to Show More Than a Mere Possibility of Finding Something Useful

The present Petition is a substantive copy of the Petition in IPR2023-01242 and was filed with a motion for joinder to that proceeding. IPR2024-00673, Paper 2. If joined, the time bar does not apply to TI's Petition. 35 U.S.C. § 315(b) ("The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c)."). Thus, Patent Owner's assertion that "[i]f Intel[redacted] is deemed an RPI or privy of Petitioner, this petition is time-barred by 35 U.S.C. § 315(b)" is mistaken. PO Mot. 5-6.

Nonetheless, TI correctly identified the real parties-in-interest and privies in the instant Petition. This initial identification should be accepted unless Patent Owner provides "evidence that reasonably brings into question the accuracy of a petitioner's identification." *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242 (Fed. Cir. 2018). "A mere assertion that a third party is an unnamed [privy], without any support for that assertion, is insufficient to put the issue into dispute." *Id*. at 1243-1244. Patent Owner's justification for seeking discovery is just that—a mere assertion that Intel[redacted] are privies without any support. Patent Owner has

failed to show the requested discovery has more than mere possibility of finding something useful, and should be denied.

Privity concerns "whether the petitioner and the prior litigant's relationship – as it relates to the [earlier] lawsuit – is sufficiently close that it can be fairly said that the petitioner had a full and fair opportunity to litigate the validity of the patent in that lawsuit" or "whether the petitioner is simply serving as a proxy to allow another party to litigate the patent validity in question that the other party raised in an earlier filed litigation." *WesternGeco LLC v. ION Geophysics Corp.*, 889 F.3d 1308, 1319 (Fed. Cir. 2018). Patent Owner's basis for discovery focuses on the latter theory of privity.

To be clear, although Patent Owner asserts that "Petitioner manufactures and designs components of products accused in prior litigation against [Intel[redacted]],[redacted]," Patent Owner has not identified, and cannot identify, any TI product that was accused or otherwise implicated in the suits. PO Mot. 1. These prior litigations are relevant only to support Patent Owner's assertion that Intel[redacted] are time barred. Patent Owner's motion does not justify the requested discovery on the basis that TI "had a full and fair opportunity to litigate the validity of the patent in [the Intel[redacted]] lawsuit[s]." *WesternGeco at 1319*.

In support of its requests for discovery into whether TI is "serving as a proxy" to allow Intel[redacted] to re-litigate validity, Patent Owner asserts that TI has

an "extensive relationship with time barred parties Intel[redacted]." Patent Owner's basis for this alleged "extensive relationship" is that "TI sells the several products [sic] to [redacted] who incorporates it [sic] into at least the [redacted]," "TI also designs and, on belief, sells multiple products to Intel, including the TPS65084x PMIC," and "TI further sells multiple products . . . to [redacted] PO Mot. 5.

Patent Owner's seeks discovery because TI's chips may have been sold to Intel[redacted] is too speculative, and fails to show the requested discovery will find something useful. It is unsurprising that TI, one of the largest, multinational semiconductor manufacturers, would have chips incorporated into products sold by other multinational, industry giants such as Intel[redacted]. It is TI's business to sell chips. "[T]he mere existence of some relationship between a petitioner and another entity is not sufficient" to place that petitioner in privity with that entity. *Google LLC v. DDC Tech., LLC*, IPR2023-00707, Paper 27 at 37 (PTAB Oct. 25, 2023); *see also*, *WesternGeco*, 889 F.3d at 1319–22 (a "standard customer-manufacturer relationship" regarding a product "does not necessarily suggest that the relationship is sufficiently close that both" parties should be considered to be in privity); *Wi-Fi One, LLC v. Broadcom Corp.*, 887 F.3d 1329, 1340–41 (Fed. Cir. 2018) (same); *Semiconductor Components Industries, LLC v. Greenthread, LLC*, IPR2023-01243, Paper 34 at 13 (PTAB February 21, 2024) (same).

Patent Owner's further allegation that TI is "making custom products or designing products 'specifically'" for Intel [redacted] and "may have an exclusive manufacturing agreement for some products and/or products are actually jointly designed" is without basis. PO Mot. 7.

Patent Owner references TI's TPS65084x PMIC and a statement in the chip User's Guide as evidence of its assertion. Patent Owner's citation, though, relates only to Intel [redacted]. The quotation of "specifically" is a reference in TI's User's Guide explaining the chip is a "power-management IC designed specifically for the Intel Braswell SoC." Ex. 2017, 1. This citation to the User's Guide mentioning Intel does not support an assertion that TI makes custom products or designs products specifically with or for [redacted]. Thus, Patent Owner has no basis for requesting discovery relevant to [redacted] for anything other than TI's chips appearing in [redacted] products.

Further, Patent Owner's characterization of the TPS65084x PMIC does not support Patent Owner's assertion that TI is making custom products with or for Intel. TI investigated the sales of the TPS65084x PMIC and can confirm that Intel is not identified in the customer field for any sales records for this chip. Moreover, that the chip was "specifically designed" for the Intel Braswell SoC is simply an indication that the chip is compatible with the Intel Braswell SoC, not that the product was jointly designed by TI and Intel. There is an entire industry around making products

compatible with Intel's ubiquitous PC processors. TI's TPS65084x PMIC is just an example of such a product, as are the products identified in Patent Owner's further exhibit (Ex. 2020). In other words, the TPS65084x PMIC and other examples cited by Patent Owner are not examples of custom products designed with or for Intel. Patent Owner has no basis for requesting discovery relevant to Intel for anything other than TI's chips appearing in their products.

In essence, Patent Owner's basis for requesting discovery resolves to evidence that TI's chips have been used in products sold by Intel[redacted]. Patent Owner's assertion that discovery into these sales would yield information relevant to privity is speculative, and fails to show more than a mere possibility of finding something useful. Patent Owner's discovery requests should be denied on this basis alone.

Even still, Patent Owner's overly broad theories of privity, on which its requests for discovery are based, have been debunked in other proceedings. Patent Owner justifies its discovery here by reading *Taylor's* "pre-existing substantive legal relationship" and "agency" tests out of context. PO Mot. 6-8, citing *Taylor v. Sturgell*, 553 U.S. 880 (2008). Patent Owner argues discovery is justified because TI has "extensive 'pre-existing substantive legal relationship[s]' with time-barred [Intel[redacted]] including by selling, making and designing products with or for [Intel [redacted]]," and that those relationships exemplify *Taylor's* basis of privity by

showing "preceding and succeeding owners of property" and "one party act[ing] as the agent for the other." PO Mot. 7. Patent Owner's similar arguments in IPR2023-01243 were rejected at institution, and Patent Owner's request for Director Review of the institution decision was denied. *See*, IPR2023-01243, Paper 34, 12-13 (preceding and succeeding owners of property), 16-19 (agency) and Paper 43 (denying Patent Owner's request for Director Review).

Patent Owner advanced similar privity by "preceding and succeeding owners of property" arguments in IPR2023-01243, asserting that the petitioner there was in privity with prior defendants based on its sales of products to the prior defendants. IPR2023-01243, Paper 34, 12-14. In IPR202-0143 the Board correctly rejected Patent Owner's arguments, observing that the "preceding and succeeding owners of property" basis of *Taylor* "does not extend to the point where all manufacturers of allegedly infringing goods are in privity with the customers who buy those goods." *Id*. at 13, citing *WesternGeco*, 889 F.3d at 1319-22. There was no evidence to suggest the relationship was sufficiently close that both parties should be considered to be in privity. *Id*. The same is true here. There is no evidence that TI has anything but a standard customer-manufacturer relationship with Intel[redacted]. Patent Owner's assertions that TI's relationship with Intel[redacted] rises to the level of privity is speculative, and Patent owner has not shown that discovery into the relationships is likely to yield useful information.

Patent Owner advanced similar privity by agency arguments in IPR2023-01243, asserting that the petitioner there was in privity because it was acting as an agent in connection with petitioner making products for the prior defendants. *See*, IPR2023-01243, Paper 34, 17. There the Board correctly rejected Patent Owner's argument as not applying the applicable legal standard. *Id*. The Board explained that, for purposes of privity under § 315(b), the relevant question is whether the petitioner is acting as an agent for the prior defendant in filing a petition for IPR. *Id*. at 17. As the Federal Circuit explains, the rationale behind § 315(b)'s time bar is "to prevent successive challenges to a patent by those who previously have had the opportunity to make such challenges in prior litigation." *WesternGeco*, 889 F.3d at 1319. "[P]reclusion is appropriate when a nonparty later brings suit as an agent for a party who is bound by a judgment." *Taylor*, 553 U.S. at 895. The relevant question is thus "whether the petitioner is simply serving as a proxy to allow another party to litigate the patent validity question that the other party raised in an earlier filed litigation." *Id.* Petitioners making product for the prior defendants was not an activity that gives rise to privity under § 315(b). *Id*. The same is true here. Patent Owner's allegations of TI's products being incorporated into Intel[redacted] products is evidence that TI is acting as an agent for Intel[redacted] in pursuing this IPR and does not give rise to privity under § 315(b). Patent Owner's assertions of privity on this

basis are speculative, and Patent owner has not shown that discovery into the relationships is likely to yield useful information.

Furthermore, Patent Owner does not explain how the TPS65084x PMIC and other products it identifies as sold to Intel [redacted] are relevant to the present patent or how the Intel [redacted] licenses apply to these products. Even if the products and licenses are relevant, Patent Owner has shown no basis to assert that Intel [redacted] are controlling TI in pursuing this IPR. Such control is necessary for agency based privity. *See Taylor*, 553 U.S. at 906 (cautioning that "preclusion is appropriate only if the putative agent's conduct of the suit is subject to the control of the party who is bound by the prior adjudication"). Additionally, Patent Owner's agency based privity argument make no sense. Intel [redacted] have no reason or incentive to challenge the present patent, because they are licensed. PO Mot. 3-4.

Finally, Patent Owner's Request for Production No. 3 asks for "[a]ll communications and agreements between i) Petitioner . . . and ii) other current or former Petitioners that have filed IPR petitions against Greenthread's Challenged Patents relating to joint defense group work or coordination against Greenthread or its Challenged Patents." This request is so broad as to potentially apply to parties other than Intel [redacted]. Yet the entirety of Patent Owner's motion is focused on TI's supposed relationship with Intel [redacted]. Thus, for this additional reason, Patent Owner has not shown that this request will lead to useful information.

B. Garmin Factor 2: Patent Owner's Requests Seek TI's and Others' Litigation Positions

Patent Owner's Interrogatory No. 1, asking whether TI contends any of its activities are licensed or exhaust Patent Owner's rights in a Challenged Patent, unabashedly seeks TI's litigation positions. Patent Owner argues that it is necessary to seek litigation positions "to prevent the manifest unfairness of Petitioner taking directly contrary positions in two proceedings – i.e. arguing no privity here, but asserting a license defense in district court." PO Mot. 9. Whether TI takes the same position in the district court litigation has no bearing on whether Intel [redacted] are in privity with TI under § 315(b). Patent Owner's request for Interrogatory No. 1 should be denied. *See*, *Garmin*, Paper 26 at 6 ("Asking for the other party's litigation positions and the underlying basis for those positions is not necessarily in the interest of justice.").

Patent Owner's Request for Production No. 3, asking for "[a]ll communications and agreements" with current or former Petitioners relating to joint defense work or coordination against Greenthread or its Challenged Patents, seeks TI's and other joint defense group members' litigation positions. Patent Owner fails to justify its need for such litigation positions. Thus, Patent Owner's request for Request for Production No. 3 should be denied for this yet further reason.

C. Garmin Factor 5: Patent Owner's Requests are Overly Burdensome

Patent Owner's Requests for Production No. 1 and No. 2 are impossibly broad and burdensome, seeking "[a]ll agreements" and "[a]ll communications" between TI and Intel [redacted] "relating to the products that [TI] and/or its affiliates sells" to Intel [redacted]. Beyond simply asking for all agreements (including "purchase orders") and communications between some of the biggest entities in the field, the interrogatories are not time limited or limited to specific products. Compliance with such broad requests would by unduly burdensome. Patent Owner's requests should be denied on this basis.

III. CONCLUSION

Patent Owner has not showing that the requested discovery would be in the interests of justice. *Garmin* factors 1, 2 and 5 to understand why Patent Owner's discovery requests are not in the interests of justice and should be denied.

Respectfully submitted,

Dated: July 1, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on July 1, 2024, a complete and entire copy of this Petitioner's Reply to Patent Owner's Motion for Additional Discovery was provided by email, to the Patent Owner, by serving the correspondence addresses of record as follows:

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