

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TEXAS INSTRUMENTS INCORPORATED,
Petitioner,

v.

GREENTHREAD LLC,
Patent Owner.

IPR2024-00674
Patent No. 11,121,222

**PETITIONER’S MOTION FOR JOINDER UNDER
35 U.S.C. § 315(c), 37 C.F.R. § 42.22, AND § 42.122(b)**

I. STATEMENT OF PRECISE RELIEF REQUESTED

Texas Instruments Incorporated (“Petitioner” or “TI”) respectfully submits this Motion for Joinder concurrently with a Petition (“TI Petition”) for *inter partes* review of U.S. Patent No. 11,121,222 (“the ’222 Patent”).

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b), TI requests institution of an *inter partes* review and joinder with IPR2023-01244 (*Semiconductor Components Industries, LLC d/b/a ON Semiconductor. v. Greenthread LLC* “SCI IPR”), instituted on February 12, 2024. Semiconductor Components Industries does not oppose TI’s joinder to the SCI IPR. TI’s petition is substantively the same as the SCI IPR petition. It challenges the same claims, on the same grounds, relies on the same prior art, and includes the exact same substantive arguments as the SCI IPR¹ and therefore would create no additional burden for the Board, the SCI IPR Petitioner, or Patent Owner if joined. Joinder would therefore lead to an efficient resolution of the validity of the ’222 patent.

TI is currently named as a defendant in *Greenthread, LLC v Texas Instruments Incorporated* in the Eastern District of Texas, Civil Action No. 2-23-cv-00157 filed April 6, 2023. TI has been accused of infringing the ’222 patent. TI has not

¹ The TI Petition includes additional arguments regarding discretionary denial under *Fintiv* based on the specific facts relevant to TI.

previously filed a petition for IPR challenging the validity of the '222 patent.

TI stipulates that if joinder is granted, it will act as an “understudy” and will not assume an active role unless the SCI IPR Petitioner ceases to participate in the proceeding. The SCI IPR Petitioner will maintain the lead role in the proceeding so long as it remains in the proceeding. These limitations will avoid lengthy and duplicative briefing. TI also will not seek additional depositions or deposition time. Joinder will not impact the trial schedule because TI agrees to be bound by the scheduling order in the SCI IPR proceeding.

In fact, joinder will help efficiently resolve the disputes among the parties. By joinder, a single Board decision may dispose of the issues raised in the SCI IPR for all interested parties.

Joinder will not unduly prejudice any party. Because joinder will not add any new substantive issues, delay the schedule, burden deponents, or needlessly increase filings, any additional costs on Patent Owner will be minimal. On the other hand, denial of joinder would prejudice TI. TI’s interests may not be adequately protected in the SCI IPR, particularly if the SCI IPR Petitioner settles with Patent Owner and ceases to participate. TI should be allowed to join in a proceeding affecting a patent asserted against it.

Given the similarities of the proceedings, the lack of undue prejudice to Patent Owner, and the potential benefit to the public and to the Board that would accrue by

TI's cooperative participation, in an understudy role, in the SCI IPR in the event that the SCI IPR Petitioner's participation terminates, the Board should institute IPR and grant TI's Motion for Joinder.

II. ARGUMENT

A. Legal Standards and Applicable Rules

A petitioner may request joinder, without prior authorization, up to one month after the institution date of the proceeding to which joinder is requested. 37 C.F.R. § 42.122(b); *Taiwan Semiconductor Mfg. Co., Ltd. v. Zond LLC*, IPR2014-00781 and IPR2014-00782, Paper 5 at 3 (PTAB May 29, 2014).

The Board has discretion to grant a motion for joinder of a petitioner for *inter partes* review to another *inter partes* review proceeding. See 35 U.S.C. § 315(c). In determining whether to exercise its discretion to grant a motion for joinder, the Board considers: (1) reasons why joinder is appropriate; (2) any new grounds of unpatentability asserted in the petition; (3) what impact (if any) joinder would have on the trial schedule for the existing review; and (4) specifically how briefing and discovery may be simplified. See *Dell, Inc. v. Network-1 Security Solutions, Inc.*, IPR201300385, Paper 17 at 3 (July 29, 2013).

B. TI's Motion for Joinder is Timely

Joinder may be requested "no later than one month after the institution date of any *inter partes* review for which joinder is requested." 37 C.F.R. § 42.122(b).

The SCI IPR was instituted on February 12, 2024. IPR2023-01244. TI's current motion is timely as it is being filed no later than 1 month after the institution date.

C. Petitioner SCI Does Not Oppose Joinder

TI has conferred with Petitioner SCI, and SCI does not oppose TI's joinder to the SCI IPR.

D. The Four Factors Favor Joinder

Each of the four factors weighs in favor of granting TI's Motion for Joinder. TI's Petition is substantively identical to the petition in the SCI IPR; it presents no new grounds of unpatentability. Joinder will have no impact on the pending schedule of the SCI IPR. Moreover, the briefing and discovery will be simplified by resolving all issues in a single proceeding.

1. Joinder of TI Is Appropriate Because It Will Promote an Efficient Determination of the Validity of the '222 Patent Without Prejudice to Any Party

TI seeks to join the SCI IPR in order to ensure that an accused infringer with an active interest in the proceeding remains a party to this IPR if the SCI IPR Petitioner's participation is terminated prior to completion. Thus, joining TI to the SCI IPR is the most practical way to secure the just, speedy, and inexpensive resolution of the challenge to the '222 patent. *See* 37 C.F.R. § 42.1(b).

If TI is joined as a party, the validity of the grounds raised in the SCI IPR can be determined in a single proceeding. Joinder is also appropriate because TI's

petition challenges the validity of the same claims of the '222 patent on identical grounds to those in the SCI IPR. There are no substantive differences between TI's and the SCI IPR Petitioner's Petition, IPR2023-01244, Paper 2 (July 27, 2023). TI also relies on the same supporting evidence in its Petition as is relied on in the SCI IPR. A consolidated proceeding, including TI and the SCI IPR Petitioner, will therefore be more efficient and less wasteful, as only a single trial on these common grounds would be required. *See, e.g., Oracle America Inc. v. Realtime Data LLC*, IPR2016-01672, Paper 13 at 7 (PTAB Mar. 7, 2017) (noting that "joining Oracle's identical challenges to those in the 1002 IPR will lead to greater efficiency while reducing the resources necessary from both Realtime and the Board"). The Board "routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding." *Samsung Elecs. Co., Ltd. v. Raytheon Co.*, IPR2016- 00962, Paper 12 at 9 (PTAB Aug. 24, 2016) (internal quotations and citations omitted).

Joining TI as a party to the SCI IPR would promote the public interest relating to the unpatentability of the '222 patent and not cause any undue prejudice to Patent Owner or the SCI IPR Petitioner. The Patent Owner must respond to the common invalidity grounds identified in the SCI and TI's Petitions regardless of joinder.

2. TI's Petition Does Not Raise Any New Grounds of Unpatentability and Therefore Does Not Add Additional

**Complexity to the Grounds in the SCI IPR Petitioner's
Petition**

TI's Petition challenges the validity of the '222 patent on identical grounds to those in the SCI IPR. *See* IPR2023-01244, Paper 2 (July 27, 2023). TI's supporting materials—including its supporting expert declaration, exhibits, and exhibit numbering—are identical to those presented in the SCI IPR. *See supra* n.2. Accordingly, no new grounds are being introduced. *See Sony Corp. v. Memory Integrity, LLC.*, IPR2015-01353, Paper No. 11 at 5-6 (PTAB Oct. 5, 2015).

Therefore, consolidation of this proceeding with SCI's via joinder of TI's Petition will not raise any new issues of unpatentability and will not impose any additional burden on the Board or Patent Owner, or add additional complexity to the case.

3. Joinder Will Not Affect the Schedule in the SCI IPR

Given that the Board only recently instituted the SCI IPR, joinder of TI would not affect the schedule in any potential forthcoming trial. TI's participation should result in no changes to the schedule.

TI agrees to adhere to all applicable deadlines set forth in the SCI IPR Scheduling Order.

4. Joinder Will Simplify Briefing Because TI Has Agreed to Consolidated Filings and an Understudy Role if the SCI Petitioner Remains

To further prevent joinder from imposing any burden on the SCI IPR Petitioner, Patent Owner, or the Board and to further ensure that there are no changes in the potential trial schedule, TI has agreed, as long as the SCI IPR Petitioner remains a party to the SCI IPR, to take an understudy role, which will simplify briefing and discovery. In this role, TI agrees to the following conditions:

(a) TI shall not make any substantive filing and shall be bound by the filings of the SCI IPR Petitioner, unless a filing concerns termination and settlement, or issues solely involving TI;

(b) TI shall not present any argument or make any presentation at oral hearing unless an issue solely involves TI, or when addressing Board-approved motions that do not affect the SCI IPR Petitioner, or its respective position;

(c) TI shall not seek to cross-examine or defend the cross-examination of any witness, unless the topic of cross-examination concerns issues solely involving TI;

(d) TI shall not seek discovery from Patent Owner on issues not solely involving TI;

(e) TI will not rely on expert testimony beyond that submitted by the SCI IPR Petitioner unless the SCI IPR Petitioner is terminated from the case. If the SCI IPR Petitioner is not terminated from the case, TI agrees to rely entirely on, and be bound by, the expert declarations and depositions in the SCI IPR. Unless and until

the current petitioner in IPR2023-01244 ceases to participate in the instituted SCI IPR, TI will not assume an active role.

Accordingly, due to TI taking only an “understudy” role, Patent Owner and the SCI IPR Petitioner will only need to respond to one principal set of papers, will not require additional time to address additional arguments raised by TI, and can thus proceed with the existing trial schedule. These steps will minimize or eliminate any potential complications or delay that could potentially result from joinder. *See Sony*, Paper No. 11 at 6-7 (granting motion because “joinder would increase efficiency by eliminating duplicative filings and discovery, and would reduce costs and burdens on the parties as well as the Board” where second petitioner agreed to “understudy” role). TI will also abide by any additional conditions the Board deems appropriate for an “understudy” role.

5. Joinder Will Result in No Prejudice to Patent Owner

As noted above, TI’s joining of the SCI IPR proceeding should not result in any prejudice to Patent Owner. No additional grounds or arguments are being introduced, no new evidence or issues are being added, and no additional discovery or briefing or oral argument should be necessary as a result of TI’s joinder. Thus, Patent Owner would not need to expend any additional resources beyond those required in the current SCI IPR.

III. INSTITUTION IS APPROPRIATE UNDER *GENERAL PLASTIC*

General Plastic does not apply here because TI has not previously challenged the '222 patent and seeks to join the SCI IPR in an understudy role. *See General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 15-19 (PTAB Sept. 6, 2017); *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00224, Paper 10 at 4-5 (PTAB Apr. 6, 2020).

Factor 1: Under *General Plastic*, factor 1 considers “whether the same petitioner previously filed a petition directed to the same claims of the same patent.” *General Plastic* at 16. Here, TI has not previously filed a petition against the '222 patent.

TI and the SCI IPR Petitioner are separate, unrelated petitioners, and are not similarly situated for purposes of Factor 1. This factor weighs in favor of institution and against discretionary denial.

Factors 2, 4 and 5: As to the timing examined in these factors, TI did not previously file a first petition prior to its current petition, and while TI became aware of the prior art references in the SCI IPR, it made no serial attack on the '222 patent and has filed this petition for IPR prior to institution. These factors weigh in favor of institution and against discretionary denial.

Factor 3: As TI did not previously file a first petition, this factor weighs in favor of institution and against discretionary denial.

Factors 6 and 7: As stated above, TI seeks to join the SCI IPR and is not raising arguments beyond those raised by the SCI petition. These factors thus weigh in favor of institution, as there should be no material impact on the Board's finite resources or its ability to issue a final determination on the SCI petition within one year.

IV. CONCLUSION

For the foregoing reasons, TI respectfully requests that its Petition for *Inter partes* review of the '222 Patent be instituted and that TI be joined to the SCI IPR proceeding IPR2023-01244.

Respectfully submitted,

Dated March 12, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on March 12, 2024, a complete and entire copy of this Petitioner's Motion for Joinder was provided by Express Mail, to the Patent Owner, by serving the correspondence address of record as follows:

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