UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TEXAS INSTRUMENTS INCORPORATED,
Petitioner,
v.

GREENTHREAD, LLC,
Patent Owner.

IPR2024-00674
U.S. Patent No. 11,121,222

PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION FOR JOINDER

Petitioner Texas Instruments Inc.'s ("TI") motion (Paper 2, "Mot.") to join *Semiconductor Components Industries, LLC d/b/a ON Semiconductor v. Greenthread, LLC*, IPR2023-01244 ("OS IPR"; On Semiconductor is "OS") should be denied for two reasons. First, joinder is prejudicial to Patent Owner Greenthread LLC ("Greenthread") and TI's motion is aimed at obtaining unfair settlement leverage, rather than efficient resolution of a dispute. Second, the TI motion is likely to be moot by the time it is decided.

I. BACKGROUND

Greenthread has four district court actions pending that are relevant here. The defendants in those actions are TI, OS, Cirrus Logic Inc. ("CL"), and Omnivision Technologies, Inc. ("OV").[1]

All four of these defendants have filed IPRs against all six Greenthread patents at issue. CL and OV filed their IPRs jointly. As described in the chart below, the IPRs filed against each patent by OS on the one hand and CL/OV on the other are substantially the same. Both sets of petitions were copied from petitions previously filed by Intel Corporation ("Intel"), which were later dismissed, before Greenthread

[1] *Greenthread, LLC v. Cirrus Logic, Inc.*, Civil Action No. 23-cv-00369 (W.D. Tex.) (filed March 31, 2023); *Greenthread, LLC v Texas Instruments Inc.*, 23-cv-00157 (E.D. Tex.), (filed April 6, 2023); *Greenthread, LLC v. ON Semiconductor Corporation et al.*, 23-cv-00443 (D. Del.) (filed April 21, 2023); *Greenthread, LLC v. OmniVision Technologies, Inc.*, 23-cv-00212 (E.D. Tex.) (filed May 10, 2023).

filed a preliminary response (POPR). *See infra*. OS hired the same expert as Intel, but the CL/OV petitions employ a different expert to make the similar points.

OS filed three petitions in July 2023 ("OS Wave One") challenging two of Greenthread's patents, but initially did not challenge Greenthread's other patents. In October 2023, CL and OV filed petitions challenging all six Greenthread patents and in December 2023 OS filed four more petitions ("OS Wave Two"), challenging the patents not addressed in the OS Wave One petitions.

On November 14, 2023, Greenthread filed its POPR in the OS Wave One IPRs. OS IPR2023-01244, Paper 18. Greenthread's POPRs addressed only the issue of whether OS was in privity with Intel and therefore time-barred. *Id.* On February 12, 2023, the Board instituted trial on the OS Wave One petitions. Greenthread filed petitions for Director Review which remain pending. The Board has not instituted any other proceedings, and Greenthread's POPRs in the OS Wave Two IPRs are not due until the end of this month.

TI's brief states that it "filed this petition for IPR prior to institution" of the OS Wave One petitions. Mot. 8-9. That is incorrect. The OS Wave One IPRs were instituted on February 12, 2024. OS IPR2023-01244, Paper 32. TI filed its Petition (Paper 4) in the instant proceeding and the instant motion *a month later* on March 12, 2024. By the time TI filed the Petition in the instant proceeding, TI knew Greenthread's strategy in the OS Wave One IPRs.

Two days ago, TI filed four more petitions regarding other patents, and moved to join those petitions to the CL/OV proceedings. The relationship among the current proceedings is shown below.

Pending and Prior IPR Proceedings					
Greenthread Patent	**Intel IPR2023-**	**OS IPR2023-**	**TI Joinder IPR2024-**	**CL/OV IPR2023-**	**TI Joinder IPR2024-**
10,510,842	-00308	-01243 (July 2023)	-00672 (March 2024)	-00016 (Oct. 2023)	**None**
11,121,222	-00420	-01242 (July 2023)	-00673 (March 2024)	-00020 (Oct. 2023)	**None**
’222 (Claim 44)	-00552	-01244 (July 2023)	-00674 (March 2024)	-00021 (Oct. 2023)	**None**
10,734,481	-00260	-00264 (Dec. 2023)	**None**	-00001 (Oct. 2023)	-00772 (April 2024)
11,316,014	-00386	-00263 (Dec. 2023)	**None**	-00019 (Oct. 2023)	-00774 (April 2024)
9,190,502	-00541	-00265 (Dec. 2023)	**None**	-00018 (Oct. 2023)	-00773 (April 2024)
8,421,195	-00548	-00266 (Dec. 2023)	**None**	-00017 (Oct. 2023)	-00771 (April 2024)

II. ARGUMENT

A. Joinder would be prejudicial to Greenthread and contrary to public policy favoring settlement.

Greenthread currently intends to file a POPR in the instant TI IPR which would necessarily address different issues than those raised in Greenthread’s POPR in the OS IPR. Although the TI IPR petition is substantially similar to the OS IPR petition, Greenthread’s POPR in the OS IPR did not address the prior art related merits of the petition, just its timeliness and whether OS is in privity with Intel.

Neither of those issues are relevant to the TI IPR and Greenthread's POPR in this proceeding would necessarily address different issues, such as the merits, the timeliness of TI's petition, and other procedural issues unique to TI, such as *Fintiv* factors.

TI waited nearly a year after being sued before filing the instant petition and its joinder motion effectively seeks to skip the institution stage in its own IPR (including a merits review), because it saw that in the OS Wave One IPRs Greenthread focused on procedural issues that are necessarily specific to OS. This tactic unfairly prejudices Greenthread, by allowing TI to free-ride on an institution decision based on circumstances particular to a different challenger and irrelevant to TI's petition.

Furthermore, TI admits that its motion will inhibit Greenthread's ability to settle with OS. Mot. 2. Inhibiting settlement is contrary to the "strong public policy" favoring settlement, particularly because TI's joinder would inhibit settlement, not just of these proceedings and the OS district court case, but also the *four other* OS IPRs that TI has *not* sought to join. Consolidated Office Patent Trial Practice Guide at 86 (2019) ("TPG").

The Board has denied joinder in similar circumstances. For example, in *ZTE (USA) LLC v. Seven Networks, LLC*, IPR2019-00460, Paper 18 at 7 (June 6, 2019), ZTE sought to join proceedings initiated by Samsung that were later terminated due

to settlement. In terminating the *Samsung* proceedings and denying ZTE's joinder motion, the Board noted that the Samsung settlement involved "more than the proceedings sought to be joined" and that ZTE's joinder to a subset of the cases would have inhibited settlement of a larger dispute. *Id.* Therefore, termination of the Samsung proceedings and denial of ZTE's motion to join was "warranted, consistent with the 'strong policy reasons to favor settlement between the parties to a proceeding.'" *Id.* (citing TPG).

Here, TI's tactic is even more unfair ZTE's, because, by joining some proceedings brought by OS and others brought by CL and OV, TI is trying to block settlement with *any* of these defendants unless Greenthread *also* settles with TI. Simply put, TI's joinder motions are about settlement leverage, not efficiency.

B. Joinder is unavailable if Greenthread prevails on Director Review.

Joinder is only permissible "[i]f the Director institutes an inter partes review." 35 U.S.C. § 315(c). When an "IPR has been terminated, there is no proceeding … to join." *ZTE*, IPR2019-00460, Paper 18 at 7. Here, the panel instituted trial in the OS Wave One IPRs, but Greenthread has appealed the institution decision to the Director, arguing that those petitions are untimely under 35 U.S.C. § 315(b), because OS is in privity with Intel. IPR2023-01244, Paper 37. If the Director grants Greenthread's request for Director review and reverses the institution decision in the

OS Wave One IPRs, there will be "no proceeding … to join," and TI's joinder motion should not be granted under 35 U.S.C. § 315(c). *Id.*[2]

TI's joinder motion should also be denied if the Director merely vacates the institution decision in the OS Wave One IPRs and remands for further proceedings here. First, even if there are some further proceedings on remand, there still would be no *instituted* IPR for TI to join. After vacatur, "the Director [will not have] instituted an inter partes review," as § 315(c) requires. She will have determined that institution is not warranted without further proceedings.

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[2] Greenthread filed its request for Director Review on February 26, 2024. *See* IPR2023-01244, Paper 37. Since then, the Director has denied eight petitions that were filed *after* Greenthread's. The fact that the Director has denied later-filed petitions, but not Greenthread's, shows that Greenthread's petition has merit. *Spectrum Solutions, LLC v. DNA Genotek Inc.*, IPR2022-01347, Paper 45 (Director Review Denial Mar. 27, 2024), Paper 44 (Director Review Request Mar. 8, 2024); *Google LLC v. Geoscope Technologies Pte. Ltd.*, IPR2023-01212, Paper 21 (Director Review Denial Mar. 27, 2024), Paper 16 (Director Review Request Mar. 5, 2024); *Google LLC v. Geoscope Technologies Pte. Ltd.*, IPR2023-01211, Paper 21 (Director Review Denial Mar. 27, 2024), Paper 16 (Director Review Request Mar. 5, 2024); *Google LLC v. Geoscope Technologies Pte. Ltd.*, IPR2023-01210, Paper 21 (Director Review Denial Mar. 27, 2024), Paper 16 (Director Review Request Mar. 5, 2024); *Google LLC v. Geoscope Technologies Pte. Ltd.*, IPR2023-01209, Paper 22 (Director Review Denial Mar. 27, 2024), Paper 16 (Director Review Request Mar. 5, 2024); *Apple Inc. v. DoDots Licensing Solutions LLC*, IPR2023-00939, Paper 14 (Director Review Denial Mar. 27, 2024), Paper 13 (Director Review Request Feb. 2, 2024); *Apple Inc. v. DoDots Licensing Solutions LLC*, IPR2023-00938, Paper 15 (Director Review Denial Mar. 27, 2024), Paper 14 (Director Review Request Feb. 2, 2024); *Apple Inc. v. DoDots Licensing Solutions LLC*, IPR2023-00937, Paper 14 (Director Review Denial Mar. 27, 2024), Paper 13 (Director Review Request Jan. 16, 2024).

Additionally, when a second decision is based on a first decision that is subsequently vacated, the second decision must also be vacated. *See Finjan LLC v. SonicWall, Inc.*, 84 F.4th 963, 969 (Fed. Cir. 2023). Therefore, if the Director vacates the OS Wave One IPRs institution decisions, a decision joining TI to the OS IPR would also need to be vacated, because, under § 315(c), the OS Wave One IPR institution decisions are a prerequisite for joining TI to those proceedings.

Finally, if Greenthread and OS settle the OS IPR, TI would not be able to address the issues presented on remand—whether OS is in privity with Intel—because TI does not possess the relevant information. TI would have the burden to establish that the OS IPR petitions were timely, but would be unable to do so, because it does not have OS's contracts and communications with Intel. *See Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242 (Fed. Cir. 2018). Therefore, even if TI were a party to the OS Wave One remand proceedings, without OS as a party, the OS petitions would have to be dismissed.

For example, in *ZTE*, the Board denied ZTE's joinder motion, because the original petitioner, Samsung, had withdrawn from the original IPR, and ZTE would be unable to address the real-party-in-interest and privity issues raised by the patent owner. *See Samsung Electronics Co., Ltd. et al. v. Seven Networks, LLC,* IPR2018-01106, Paper 11 at 4-16 (Sept. 13, 2018). In the ZTE joinder decision, the Board noted that "Samsung submitted confidential documents and declarations regarding

the issues of real party-in-interest and privity" in the original Samsung IPR. *See ZTE*, IPR2019-00460, Paper 18 at 7. "ZTE does not explain how it would have access to the confidential documents and how it would have produced witnesses for cross-examination when Samsung is no longer participating in the Samsung IPR." *Id.*

The same analysis applies here. Joinder is inappropriate, because without OS as part of the case, TI would not have the information necessary to establish the timeliness of the OS IPR. At best, TI would be left to seek third-party discovery from OS and/or Intel, delaying and complicating the proceedings, to no apparent benefit.

III. CONCLUSION

For the forgoing reasons, TI's joinder motion should be denied.

Dated: April 12, 2024

Respectfully submitted,

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that a copy of this **PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION FOR JOINDER** has been served on Petitioner via email on the following counsel of record for Petitioner:

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