UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TEXAS INSTRUMENTS INCORPORATED,
Petitioner,
v.

GREENTHREAD, LLC,
Patent Owner.

IPR2024-00773
U.S. Patent No. 9,190,502

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

Petitioner Texas Instruments Inc.'s ("TI") motion (Paper 2, "Mot.") to join *Cirrus Logic, Inc. and OmniVision Technologies, Inc. v. Greenthread, LLC*, IPR2024-00018 ("CL/OV IPR"; Cirrus Logic is "CL"; OmniVision is "OV") 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, On Semiconductor ("OS"), CL, and 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 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.

[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).

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 IPR2023-01242, 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. Greenthread filed POPRs in OS Wave Two IPRs on May 8, 2024. *See, e.g.*, OS IPR2024-00263, Paper 13.

CL and OV filed seven petitions in October 2023 challenging six of Greenthread's patents. In January and February 2024, Greenthread filed POPRs in the CL/OV IPRs. *See, e.g.*, CL/OV IPR2024-00017, Paper 16. Greenthread's POPRs addressed only the issue of whether CL and OV were each in privity with time-barred entities. *Id.* Between April 23 and May 6, the Board instituted each of the CL/OV IPR petitions. Greenthread filed petitions for Director Review on the institution decisions, which are pending, in each of those seven proceedings on May 7, 2024. *See, e.g.*, CL/OV IPR2024-00017, Paper 33.

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 CL/OV IPR. Although the TI IPR petition is substantially similar to the CL/OV IPR petition, Greenthread’s POPR in the CL/OV IPR did not address the prior art related merits of the petition, just its timeliness and whether CL and OV are each in privity with time-barred entities. 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. Further, Greenthread filed a petition for Director Review on May 7 regarding arguments from the CL/OV IPR. This petition for Director Review regarding issues specific to CL and OV is not relevant to TI.

TI waited almost exactly 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 CL/OV IPRs Greenthread focused on procedural issues that are necessarily specific to those two entities. This tactic unfairly prejudices Greenthread, by allowing TI to free-ride on an institution decision based on circumstances particular to different challengers and irrelevant to TI's petition.

Furthermore, TI admits that its motion will inhibit Greenthread's ability to settle with CL and OV. 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 CL and OV district court cases, but also the *three other* CL/OV 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 CL/OV IPRs, but Greenthread has appealed the institution decisions to the Director, arguing that those petitions are untimely under 35 U.S.C. § 315(b), because CL and OV are each in privity with time-barred entities. CL/OV IPR2024-00017, Paper 33. If the Director grants Greenthread's request for Director review and reverses the

institution decision in the CL/OV 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.*

TI's joinder motion should also be denied if the Director merely vacates the institution decision in the CL/OV 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.

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 CL/OV IPRs institution decisions, a decision joining TI to the CL/OV IPR would also need to be vacated, because, under § 315(c), the CL/OV IPR institution decisions are a prerequisite for joining TI to those proceedings.

Finally, if Greenthread and CL and OV settle the CL/OV IPR, TI would not be able to address the issues presented on remand—whether CL and OV are in privity with time-barred entities—because TI does not possess the relevant information. TI would have the burden to establish that the CL/OV IPR petitions were timely, but would be unable to do so, because it does not have the necessary contracts and communications between CL and OV each individually with the time-

barred entities. *See Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242 (Fed. Cir. 2018). Therefore, even if TI were a party to the CL/OV remand proceedings, without CL and OV as parties to the IPR, the CL/OV 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 CL and OV as part of the case, TI would not have the information necessary to establish the timeliness of the CL and OV IPR. At best, TI would be left to seek third-party discovery from CL, OV, and the time-barred entities, delaying and complicating the proceedings, to no apparent benefit.

III. CONCLUSION

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

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Respectfully submitted,

/Alan Whitehurst/

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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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