From:	Trials
To:	Neil Ozarkar; Trials
Cc:	Nicholas T. Matich; Greenthread-TI-MS; Josh Griswold; Rick Bisenius; IPR12189-0084IP1; IPR12189-0087IP1; IPR12189-0085IP1; IPR12189-0089IP1; PTAB Inbound; IPR12189-0086IP1
Subject:	RE: Texas Instruments Incorporated v Greenthread LLC - IPR2024-00672, -00673, -00674, -00771, -00772, -00773, -00774
Date:	Tuesday, June 11, 2024 2:18:36 PM
Attachments:	image001.png image002.png

Counsel,

From the Board –

Patent Owner's request to file a motion for additional discovery is granted. In each of the above referenced proceedings, Patent Owner is authorized to file a motion for additional discovery of no more than 15 pages, limited to the issue of whether the Petition is time barred, no later than June 17, 2024. Petitioner may file an opposition in each of the above-referenced proceedings of no more than 15 pages, no later than July 1, 2024. Patent Owner may file a reply of no more than 5 pages, no later than July 9, 2024.

No conference call with the panel is necessary at this time.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Neil Ozarkar <nozarkar@McKoolSmith.com>
Sent: Friday, May 31, 2024 6:47 PM
To: Trials <Trials@USPTO.GOV>
Cc: Nicholas T. Matich <nmatich@McKoolSmith.com>; Greenthread-TI-MS <Greenthread-TI-MS@mckoolsmith.com>; Josh Griswold <griswold@fr.com>; Rick Bisenius <bisenius@fr.com>; IPR12189-0084IP1 <IPR12189-0084IP1@fr.com>; IPR12189-0087IP1 <IPR12189-0087IP1@fr.com>; IPR12189-0085IP1 <IPR12189-0085IP1@fr.com>; IPR12189-0089IP1 <IPR12189-0089IP1@fr.com>; PTAB Inbound <PTABInbound@fr.com>; IPR12189-0086IP1 <IPR12189-0086IP1@fr.com>
Subject: Texas Instruments Incorporated v Greenthread LLC - IPR2024-00672, -00673, -00674, -00771, -00772, -00773, -00774

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IPR2024-00672, -00673, -00674, -00771, -00772, -00773, -00774

Your Honors,

Patent Owner Greenthread LLC requests a conference call with the Board so that it may request authorization to file a motion for additional discovery in the above-referenced proceedings. The proposed additional discovery pertains to whether the Petitions are time barred under 35 U.S.C. § 315(b).

Intel, Dell, and Sony (by virtue of Sony's RPI relationship with Dell) are time-barred from filing a petition on the patents at issue. Intel and Sony are also Patent Owner's licensees. Publicly available information indicates that Petitioner Texas Instruments Incorporated is a manufacturer/supplier to at least Intel, Dell, and Sony. If, as it appears, Petitioner is acting on behalf of any of Patent Owner's licensees under the "have made" clause of the licenses, then Petitioner is in privity with the time-barred licensees. Thus, the instant Petitions would be time-barred.

Patent Owner seeks discovery of:

1. Agreements between Petitioner (or its affiliates) and Intel, Dell, and/or Sony relating to transistor products sold to or made for them or the prior litigations.

2. Communications between Petitioner (or its affiliates) and Intel, Dell, and/or Sony relating to such products or the prior litigations.

3. Whether Petitioner intends to take the position in the district court litigation involving the challenged patents, that Petitioner's sales to Intel and/or Sony are licensed under prior licenses to Intel and/or Sony.

4. Communications and agreements relating to joint defense group work or coordination between Petitioner (or its affiliates) and other current or former Petitioners that have filed IPR petitions against Greenthread.

Patent Owner met and conferred with Petitioner prior to sending the present email.

Petitioner's position: Petitioner opposes the requested discovery. The requests are a fishing expedition, overly broad, burdensome, and not tailored to a genuine need. Among other things, Patent Owner has not, either here or in the district court, identified or even agreed that there are any accused products covered by Patent Owner's licenses. Patent Owner has not identified any evidence that Intel, Dell, or Sony have had any involvement in the current IPRs. Furthermore, the requests seek discovery to the impossibly broad subject of agreements and communications concerning "transistor products," as well as seek Petitioner's involvement in a JDG to purportedly support Patent Owner's theory that Petitioner is acting on behalf of the licensees. The requests also improperly seek litigation positions on Petitioner's intended positions in the litigation. Finally, and nonetheless, TI has reviewed its records and confirmed it has no agreements or communications with Intel, Dell or Sony concerning the prior litigations.

If the Board would find it helpful, the parties can present available dates for a conference call when a panel has been set.

Respectfully,
Neil Ozarkar
Counsel for Patent Owner Greenthread LLC

McKool Smith

Neil Ozarkar
Senior Counsel

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