

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TEXAS INSTRUMENTS INCORPORATED,
Petitioner,

v.

GREENTHREAD LLC,
Patent Owner.

IPR2024-00774
Patent No. 11,316,014

**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. 11,316,014 (“the ’014 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 IPR2024-00019 (*Cirrus Logic, Inc.; Omnivision Technologies, Inc.; and Ams Sensors Usa Inc. v. Greenthread LLC* “Cirrus IPR”), institution decision expected on or before May 7, 2024. Cirrus et al. does not oppose TI’s joinder to the Cirrus IPR. TI’s petition is substantively the same as the Cirrus 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 Cirrus IPR¹ and therefore would create no additional burden for the Board, the Cirrus IPR Petitioner, or Patent Owner if joined. Joinder would therefore lead to an efficient resolution of the validity of the ’014 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

¹ The TI Petition includes different arguments regarding discretionary denial under *Fintiv* based on the specific facts relevant to TI, including the *Sotera* stipulation sent to the patent owner by TI.

April 6, 2023. TI has been accused of infringing the '014 patent. TI has not previously filed a petition for IPR challenging the validity of the '014 patent.

TI stipulates that if joinder is granted, it will act as an “understudy” and will not assume an active role unless the Cirrus IPR Petitioner ceases to participate in the proceeding. The Cirrus 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 Cirrus 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 Cirrus 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 Cirrus IPR, particularly if the Cirrus 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 Cirrus IPR in the event that the Cirrus 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-I 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 Cirrus IPR is expected to be instituted on or before May 7, 2024.

IPR2024-00019. TI’s current motion is timely as it is being filed prior to the institution date.

C. Petitioner Cirrus Does Not Oppose Joinder

TI has conferred with Petitioner Cirrus, and Cirrus does not oppose TI’s joinder to the Cirrus 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 Cirrus IPR; it presents no new grounds of unpatentability. Joinder will have no impact on the pending schedule of the Cirrus 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 ‘014 Patent Without Prejudice to Any Party

TI seeks to join the Cirrus IPR in order to ensure that an accused infringer with an active interest in the proceeding remains a party to this IPR if the Cirrus IPR Petitioner’s participation is terminated prior to completion. Thus, joining TI to the Cirrus IPR is the most practical way to secure the just, speedy, and inexpensive resolution of the challenge to the ‘014 patent. *See* 37 C.F.R. § 42.1(b).

If TI is joined as a party, the validity of the grounds raised in the Cirrus 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 '014 patent on identical grounds to those in the Cirrus IPR. There are no substantive differences between TI's and the Cirrus IPR Petitioner's Petition, IPR2024-00019, Paper 1 (October 27, 2023). TI also relies on the same supporting evidence in its Petition as is relied on in the Cirrus IPR. A consolidated proceeding, including TI and the Cirrus 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 Cirrus IPR would promote the public interest relating to the unpatentability of the '014 patent and not cause any undue prejudice to Patent Owner or the Cirrus IPR Petitioner. The Patent Owner must respond to the common invalidity grounds identified in the Cirrus 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 Cirrus IPR Petitioner's Petition

TI's Petition challenges the validity of the '014 patent on identical grounds to those in the Cirrus IPR. *See* IPR2024-00019, Paper 1 (October 27, 2023). TI's supporting materials—including its supporting expert declaration, exhibits, and exhibit numbering—are identical to those presented in the Cirrus 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 Cirrus' 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 Cirrus IPR

Given that the Board has not yet instituted the Cirrus 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 Cirrus IPR Scheduling Order, if instituted.

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

To further prevent joinder from imposing any burden on the Cirrus 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 Cirrus IPR Petitioner remains a party to the Cirrus 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 Cirrus 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 Cirrus 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 Cirrus IPR Petitioner unless the Cirrus IPR Petitioner is terminated from the case.

If the Cirrus 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 Cirrus IPR. Unless and until the current petitioner in IPR2024-00019 ceases to participate in the instituted Cirrus IPR, TI will not assume an active role.

Accordingly, due to TI taking only an “understudy” role, Patent Owner and the Cirrus 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 Cirrus 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 Cirrus IPR.

III. INSTITUTION IS APPROPRIATE UNDER *GENERAL PLASTIC*

General Plastic does not apply here because TI has not previously challenged the '014 patent and seeks to join the Cirrus 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 '014 patent.

TI and the Cirrus 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 Cirrus IPR, it made no serial attack on the '014 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 Cirrus IPR and is not raising arguments beyond those raised by the Cirrus 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 Cirrus petition within one year.

IV. CONCLUSION

For the foregoing reasons, TI respectfully requests that its Petition for *Inter partes* review of the '014 Patent be instituted and that TI be joined to the Cirrus IPR proceeding IPR2024-00019.

Respectfully submitted,

Dated April 10, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on April 10, 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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