

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

SEMICONDUCTOR COMPONENTS INDUSTRIES, LLC, D/B/A ONSEMI and
TEXAS INSTRUMENTS INCORPORATED,¹
Petitioner,

v.

GREENTHREAD, LLC,
Patent Owner.

IPR2023-01242 (Patent 11,121,222 B2)
IPR2023-01243 (Patent 10,510,842 B2)
IPR2023-01244 (Patent 11,121,222 B2)²

Before COKE MORGAN STEWART, *Acting Under Secretary of Commerce for
Intellectual Property and Acting Director of the United States Patent and
Trademark Office.*

ORDER

Granting Director Review, Vacating the Final Written
Decision, and Remanding to the Board for Further Proceedings

¹ Texas Instruments Incorporated, which filed a petition in IPR2024-00673, has been joined as a petitioner in this proceeding. Paper 69.

² This order applies to each of the above-listed proceedings.

IPR2023-01242 (Patent 11,121,222 B2)
IPR2023-01243 (Patent 10,510,842 B2)
IPR2023-01244 (Patent 11,121,222 B2)

Greenthread, LLC (“Patent Owner”) filed requests for Director Review of the Final Written Decisions (“Decisions,” *see* Paper 86³) in the above-captioned cases, and Semiconductor Components Industries, LLC, d/b/a onsemi (“Petitioner”) filed authorized responses to the requests. *See* Paper 90 (“DR Request”); Paper 91. In the requests, Patent Owner argues that Director Review should be granted because, *inter alia*, the Board denied discovery into issues of privity and then shifted the burden of establishing privity to Patent Owner. DR Request 5–9. Patent Owner further argues that the Board erroneously refused to consider certain of Patent Owner’s arguments and improperly excluded relevant district court claim construction orders. *Id.* at 9–15.

Prior to institution, Patent Owner argued that the petitions were untimely under 35 U.S.C. § 315(b) due to a district court complaint served on Petitioner’s privity, Intel Corporation (“Intel”), more than one year before the Petitions were filed. *See* Paper 56, 7–25. Patent Owner also filed motions seeking discovery related to its privity arguments, but the Board denied those motions. *See* Paper 54; Paper 31. The Decisions later faulted Patent Owner for failing to “renew or tailor its request[s] for additional discovery during trial,” and found that Patent Owner failed to present evidence of a privity relationship between Petitioner and Intel. Decision 70.

In its DR Requests, Patent Owner argues that the Board abused its discretion by denying discovery into the privity issue and by “cit[ing] the *absence* of evidence in the record” to find the Petitions were timely filed. DR Request 5–9.

³ All citations are to IPR2023-01242. Similar papers and exhibits were filed in IPR2023-01243 and IPR2023-01244. Citations are to the publicly available redacted versions of the Decision and the parties’ papers.

IPR2023-01242 (Patent 11,121,222 B2)

IPR2023-01243 (Patent 10,510,842 B2)

IPR2023-01244 (Patent 11,121,222 B2)

Petitioner responds that Patent Owner failed to put privity in dispute and made overbroad discovery requests. Paper 91, 1–3.

I agree with Patent Owner that the Board abused its discretion in denying the discovery motions. In the motions, Patent Owner raised more than a mere possibility that discovery would yield useful information on the privity issue given that Petitioner was a supplier of a time-barred party, Intel. *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6 (PTAB Mar. 5, 2013) (precedential). While Patent Owner’s requested discovery was broad, it was not harassing or abusive. Under these circumstances, the Board either should have allowed whatever narrower discovery was appropriate or made it clear that Patent Owner could amend or resubmit its discovery motions. Instead, the Board denied Patent Owner’s motions and then cited the absence of evidence as a basis not to find a privity relationship.

Accordingly, Director Review is granted, and the case is remanded to the Board with instructions to allow discovery, narrowly tailored to the privity issue, such as any indemnification agreements between Petitioner and Intel and the terms and conditions of sale agreements between Petitioner and Intel related to products accused of practicing the challenged claims. The Board should then determine on the full record whether Petitioner has met its burden of demonstrating it is not time-barred under § 315(b); that is, whether Patent Owner has produced some evidence to support its argument that Intel should be named as a privy so as to have put the issue into dispute. *See Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242–44 (Fed. Cir. 2018) (explaining that although it is a petitioner’s burden to show that its petition is not time-barred, a “mere assertion that a third party is an

IPR2023-01242 (Patent 11,121,222 B2)

IPR2023-01243 (Patent 10,510,842 B2)

IPR2023-01244 (Patent 11,121,222 B2)

unnamed real party in interest, without any support for that assertion, is insufficient to put the issue into dispute”).⁴

Patent Owner further argues that the Board abused its discretion by declining to consider certain arguments made in Patent Owner’s Response and Sur-Reply. DR Request 11–15. The Board declined to consider Patent Owner’s arguments “concerning the location of the graded dopant concentration,” finding these arguments untimely as first presented in the Sur-Reply. Decision 45 (citing Patent Owner’s Sur-Reply argument that the prior art’s disclosure refers to “gradients and carriers *outside the active region*”). Patent Owner, however, timely presented these arguments in the Response. *See* Paper 59, 24–25 (arguing that the prior art’s carriers are not in the active regions and, therefore, “the carriers that its graded dopant concentration affects are in the wrong place”).

Accordingly, the Board abused its discretion by not fully addressing the arguments, and on remand, if the petitions are not time-barred, is to consider and address Patent Owner’s arguments concerning the location of the graded concentration.

The Board also granted a motion to strike two district court claim construction orders, and a related claim construction brief that Patent Owner submitted as exhibits with its Sur-Reply, finding the exhibits were evidence and were irrelevant and untimely. Paper 80, 7 (striking Exs. 2077–2079). Patent

⁴ To the extent the Board determines on remand that the petitions are time-barred, the Board should address whether its decision granting joinder should be vacated. *See, e.g., I.M.L. SLU v. WAG Acquisition, LLC*, IPR2016-01658, Paper 46 at 14 (PTAB Feb. 27, 2018) (vacating grant of joinder to a second petitioner after having vacated the decision instituting the proceeding that the second petitioner had joined).

IPR2023-01242 (Patent 11,121,222 B2)

IPR2023-01243 (Patent 10,510,842 B2)

IPR2023-01244 (Patent 11,121,222 B2)

Owner argues that the claim construction orders are relevant, legal authority that the Board should have considered. DR Request 15.

The Office’s trial practice rules provide that the Board will consider prior district court claim construction rulings that are made of record in Board proceedings. *See* 37 C.F.R. § 42.100(b); *see also* Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019) (“CTPG”) 46–47 (quoting Rule 42.100(b)). Although Rule 42.23(b) prohibits the filing of new evidence with a sur-reply other than deposition transcripts of the cross-examination of a reply witness, a legal ruling by another tribunal is not evidentiary in nature. Thus, it is not the type of exhibit that falls within the prohibition against new evidence. Indeed, the Board may take administrative notice of another tribunal’s legal ruling. *See generally* 5 U.S.C. § 556(e) (official notice); *cf.* Fed. Rule Evid. 201(b)(2) (stating that a court “may judicially notice a fact that is not subject to reasonable dispute because it . . . can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned”).

The CTPG explains that, preferably, a party should file a prior district court claim construction determination with the petition, preliminary response, or response. CTPG 47. Patent Owner did not file the claim construction orders until its Sur-Reply, arguing that Petitioner’s Reply included a “new ‘characterization’” of a claim limitation that Petitioner did not provide in the Petition. *See* Paper 77, 1, 3. The Board struck the claim construction orders in part as irrelevant but then addressed the parties’ arguments about that claim limitation in the Decisions. Paper 86, 35–41. The refusal to admit and consider the claim construction orders was legally erroneous because the orders were not “evidence.” The refusal also was an abuse of discretion because the orders were responsive to Petitioner’s

IPR2023-01242 (Patent 11,121,222 B2)

IPR2023-01243 (Patent 10,510,842 B2)

IPR2023-01244 (Patent 11,121,222 B2)

arguments and thus timely. Under the circumstances here, where Patent Owner properly argued that the claim construction dispute between the parties crystallized only in Petitioner’s Reply, the Board should have admitted the district court claim construction rulings and given them “appropriate weight.” CTPG 47.⁵

Accordingly, on remand, if the petitions are not time-barred, the Board is to admit Exhibits 2077 and 2079 and reconsider the parties’ arguments in view of these two exhibits.

Absent good cause, the Board shall issue a decision on remand within 30 days after Petitioner provides to Patent Owner the discovery that the Board authorizes.

In consideration of the foregoing, it is:

ORDERED that Director Review is granted;

FURTHER ORDERED that the Board’s Final Written Decision (Paper 86) is vacated; and

FURTHER ORDERED that the case is remanded to the Board for further proceedings, as appropriate.

⁵ Notwithstanding the CTPG’s guidance that, “[a]fter a trial is instituted, the Board’s rules on supplemental information govern the timing and procedures for submitting claim construction decisions[,]” *see* CTPG 47–48, as noted above, a claim construction decision is not evidence. Thus, a party may file a claim construction decision any time before the oral hearing, though the best practice is to file the decision as early as possible in the proceeding. *Id.* at 48.

IPR2023-01242 (Patent 11,121,222 B2)
IPR2023-01243 (Patent 10,510,842 B2)
IPR2023-01244 (Patent 11,121,222 B2)

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