

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SEMICONDUCTOR COMPONENTS INDUSTRIES, LLC,
Petitioner,

v.

GREENTHREAD, LLC.,
Patent Owner.

IPR2024-00263 (Patent 11,316,014 B2)
IPR2024-00264 (Patent 10,734,481 B2)
IPR2024-00265 (Patent 9,190,502 B2)
IPR2024-00266 (Patent 8,421,195 B2)

Before KRISTEN L. DROESCH, GRACE KARAFFA OBERMANN,
DONNA M. PRAISS, MONICA S. ULLAGADDI, and JULIA HEANEY,
Administrative Patent Judges.¹

OBERMANN, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
Ordering Post-Hearing Discovery and Briefs
37 C.F.R. § 42.5

¹ This Order addresses issues identical across the cases, therefore, we enter the same order in each case. The listing of Judges does not extend any panel. The parties may use this style heading in any paper filed pursuant to this Order, provided such heading includes a footnote attesting “the word-for-word identical paper is filed in each proceeding identified in the heading.”

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This Order² authorizes post-hearing discovery and briefs limited to a privity dispute relating to an alleged relationship between Petitioner and a non-party, Intel.

A. The Director’s Decision in the First Wave Cases

On April 24, 2025, the Director granted review of the Final Written Decisions issued in IPR2023-01242 (“IPR1242”), IPR2023-01243, and IPR2023-01244 (collectively, “the first wave cases”), which involve the same parties as the instant cases and challenge patents in the same priority chain as, and which claim subject matter similar to, the patents at issue in the instant cases. *See* IPR1242, Paper 94 (“IPR1242, Dir. Dec.”).³

Specifically, the Director determined that, “[p]rior 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 privy, Intel Corporation (‘Intel’), more than one year before the Petitions were filed.” IPR1242, Dir. Dec. 2 (citing IPR1242, Paper 56, 7–25). The Director held the Board abused its discretion by denying discovery on privity. *Id.* at 2–3.

² Concurrently herewith, we issue related orders in IPR2023-01242, IPR2023-01243, IPR2023-01244, IPR2024-00017, IPR2024-00018, IPR2024-00021, IPR2024-00468, IPR2024-00469, IPR2024-00470, IPR2024-00550, IPR2024-00551, IPR2024-00552, and IPR2024-00553. Final written decisions in other related cases (namely, IPR2024-00001, IPR2024-00016, IPR2024-00019, and IPR2024-00020) are the subject of pending requests for Director review.

³ For convenience, when discussing the first wave cases, we cite papers and exhibits filed in IPR1242. Similar papers and exhibits were filed in IPR1243 and IPR1242.

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On that basis, the Director vacated and remanded the first wave cases to the Board with express “instructions to allow discovery” on the question whether Petitioner is in privity with a specific, time-barred non-party, “Intel.” *Id.* at 3. The Director observed that “Patent Owner’s requested discovery was broad” and, further, instructed that “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.” *Id.*

On May 22, 2025, the Director denied Petitioner’s request for rehearing of the Director’s Decision in the first wave cases. IPR1242, Paper 106.

B. Procedural Background of the Instant Cases

We held a consolidated final hearing on May 6, 2025. IPR2024-00263 (“IPR0263”), Hearing Tr.^{4,5} On April 29, 2025, in view of the Director’s Decision in the first wave cases, the statutory deadline for filing Final Written Decisions in these cases was extended by six months for good cause. IPR0263, Paper 49.

During the pre-institution phases of the instant cases, Patent Owner requested permission to seek discovery on “the same discovery issue” that was the subject of the Director’s Decision in the first wave cases. IPR0263, Paper 7 at 1. We denied Patent Owner’s request without prejudice and

⁴ “Hearing Tr.” refers to the transcript of the consolidated final hearing held on May 6, 2022, in the instant cases. A copy of the hearing transcript will be entered in the record in due course.

⁵ Substantially identical papers were filed in the other instant cases. For convenience, we refer to papers filed in IPR0263.

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expressly granted Patent Owner authorization to contact the Board if it desired to file a different motion for additional discovery. IPR0263, Paper 11. Patent Owner did not do so, during either the pre-institution or post-institution phases.

On May 1, 2025, we held a teleconference with the parties to discuss the impact of the Director’s Decision on the instant cases. During that teleconference, Patent Owner indicated that, notwithstanding the Director’s Decision, it did not wish to pursue additional discovery in the instant cases, but instead, citing *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237 (Fed. Cir. 2018), argued it is entitled to judgment, as a matter of law, that institution should not have been granted based on the existing record. *See* IPR0263, Ex. 1063, 11:21–12:7 (transcript of teleconference).

During the consolidated final hearing on May 6, 2025, Patent Owner’s counsel reiterated Patent Owner’s decision to pursue no additional discovery in the instant cases, notwithstanding the Director’s Decision in the first wave cases. IPR0263, Hearing Tr. 54:1–25.

C. Post-Hearing Discovery

Patent Owner unequivocally and repeatedly has stated that it will not seek post-hearing discovery in these cases on the “the same discovery issue” that was the subject of the Director’s Decision in the first wave cases. IPR0263, Paper 7 at 1. We do not view those statements as diminishing the Board’s authority to *sua sponte* order discovery, particularly where, as here, doing so may facilitate a fair and efficient resolution of the privity dispute and aligns with the spirit and intent of the Director’s Decision in the first

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wave cases. *See* 37 C.F.R. § 42.5(a) (codifying Board’s inherent authority to “determine a proper course of conduct” to best “administer the proceeding”).

In the first wave cases, the Director issued express instructions to the Board to provide discovery on the same privity dispute as to Intel that is at issue in the instant cases. IPR1242, Dir. Dec. 3, 6; IPR0263, Paper 7 at 1 (“same discovery issue). Against that backdrop, in our view, ordering the same discovery in the instant cases is the most efficient course of action.

In reaching this *sua sponte* decision, we are sensitive to the fact that the Board’s decision, early on in first wave cases, to deny Patent Owner’s request for authorization to seek additional discovery on the privity issue, directly resulted in Petitioner’s failure to produce evidence that may illuminate the correct result on privity. IPR1242, Dir. Dec. 3. By ordering additional discovery in the instant cases, we strive to avoid any similar error.

Just as in the first wave cases, resolving the privity dispute here, concerning the alleged relationship between Petitioner and Intel, on a “full record” after providing “Patent Owner the discovery that the Board authorizes” promotes the interests of justice, corrects the negative results of any error in denying Patent Owner’s pre-institution request to seek discovery, and is appropriate given the potentially dispositive nature of the dispute. *Id.* Resolving the dispute on the existing record, by contrast, opens the door to error that may lead to delay in reaching a final resolution of the instant cases.

Accordingly, we invoke our inherent authority to administer these proceedings and *sua sponte* order post-hearing discovery as set forth in the instructions below. *See* 37 C.F.R. § 42.5(a) (codifying the Board’s inherent

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authority to “determine a proper course of conduct” to best “administer the proceeding”).

1. Scope and Timing of Post-Hearing Discovery

Petitioner is instructed to provide the following discovery to Patent Owner by July 11, 2025:

- (a) The following documents:
 - a. Sales agreements between Petitioner and Intel for the Intel Accused Products;⁶ and
 - b. Indemnification agreements between Petitioner and Intel for the Intel Accused Products. *See* IPR1242, Dir. Dec. 3; IPR1242, Paper 108 at 11 (indicating Petitioner’s ability and willingness to produce such discovery in the first wave cases).
- (b) Documents sufficient to show the asserted privity relationship between Petitioner and Intel, including any new declaration(s) that establish that “no documents responsive to” Subsection (a) above “exist” (IPR1242, Paper 108 at 12), as well as any documents and new declaration(s) that establish (1) the time by which Petitioner became aware of the Intel litigation referenced in the Director’s Decision; (2) whether Petitioner was the supplier of any product, or component of a product, accused of infringement in the Intel litigation; and (3) whether Petitioner was in a position to control, or actually controlled, Intel’s defense of that litigation.
- (c) To the extent Patent Owner requests routine discovery in the form of cross-examination of any declarant(s) produced by Petitioner pursuant to Subsection (b) above, such requests shall be submitted no later than July 15, 2025, and all cross-examination (in the form of deposition(s)) shall be completed by July 29, 2025.

⁶ The “products accused” consist of “the ‘Intel Accused Products’ listed on pages 4–8 of IPR0263, Exhibit 2048, which are the Intel “products accused of practicing the challenged claims’ in Patent Owner’s prior litigation.

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D. Post-Hearing Briefs

The Board *sua sponte* determines that post-hearing briefs on the privity issue would be helpful to the panel in reaching an efficient and fair resolution of the instant cases in view of the Director's Decision. In particular, after post-hearing discovery is completed according to the above parameters, the Board will consider new evidence only to the extent that it is cited and explained in a post-hearing brief. Accordingly, we order post-hearing briefs, and an optional telephonic privity hearing, as set forth below.

1. Patent Owner's Post-Hearing Brief

No later than August 12, 2025, Patent Owner shall file a Post-Hearing Brief, not to exceed fifteen (15) pages in length, that explains Patent Owner's position that Petitioner is in privity with time-barred entity Intel. In particular, the Brief should address in detail Patent Owner's assertion that Petitioner is a supplier of products to Intel that are the subject of the licensing agreement in the record. Ex. 2022 (same exhibit number in IPR0263 and IPR1242). This brief may be supported by evidence of record as well as the filing of any documents, declarations, and deposition transcripts produced pursuant to the discovery ordered above. No other new evidence may accompany this brief.

2. Petitioner's Responsive Post-Hearing Brief

No later than August 26, 2025, Petitioner shall file a Responsive Post-Hearing Brief, not to exceed fifteen (15) pages in length. Petitioner may use this brief to respond to information presented in Patent Owner's Post-Hearing Brief and to raise any other information that, in Petitioner's view, bears on the privity dispute. This brief may be supported by evidence of

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record as well as the filing of any documents, declarations, and deposition transcripts produced pursuant to the discovery ordered above. No other new evidence may accompany this brief.

3. Patent Owner's Reply Post-Hearing Brief

No later than September 2, 2025, Patent Owner shall file a Reply Post-Hearing Brief, not to exceed fifteen (15) pages in length, limited to rebutting the information presented in Petitioner's Responsive Post-Hearing Brief. No new evidence may be filed in support of this brief.

4. Optional Hearing on the Privity Dispute

No later than September 4, 2025, the parties shall meet, confer, and jointly file a paper that presents their respective positions (or the parties' joint position if an agreement is reached) about whether the Board should conduct a telephonic hearing on the privity dispute. The joint paper shall provide times during the week of September 8, 2025, during which counsel for both parties are available for a teleconference, if one is requested.

E. Schedule Changes

The parties should contact the Board as soon as practical if any changes to the post-hearing discovery and briefing schedules are necessary. Any changes to these schedules must be approved by the Board.

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ORDER

It is

ORDERED that post-hearing discovery shall commence and be completed according to the parameters set forth herein;

FURTHER ORDERED that Patent Owner's Post-Hearing Brief, Petitioner's Responsive Post-Hearing Brief, and Patent Owner's Reply Post-Hearing Brief shall be filed in compliance with the instructions set forth herein;

FURTHER ORDERED that the parties shall file a joint paper addressing the optional hearing on the privity dispute as set forth herein; and

FURTHER ORDERED that any changes to the discovery and briefing schedules set forth herein must be approved by the Board.

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