

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

CIRRUS LOGIC, INC., OMNIVISION TECHNOLOGIES, INC., and
TEXAS INSTRUMENTS INCORPORATED,¹
Petitioner,

v.

GREENTHREAD, LLC,
Patent Owner.

IPR2024-00001 (Patent 10,734,481 B2)
IPR2024-00016 (Patent 10,510,842 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 IPR2024-00772, has been joined as a petitioner to IPR2024-00001. IPR2024-00001, Paper 52.

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

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Greenthread, LLC (“Patent Owner”) filed requests for Director Review of the Final Written Decisions (“Decisions,” *see* Paper 80) in the above-captioned cases, and Cirrus Logic, Inc., Omnivision Technologies, Inc., and Texas Instruments Incorporated (“Petitioner”) filed authorized responses to the requests. *See* Paper 84 (“DR Request”); Paper 86.³ 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. These arguments are substantively similar to the arguments raised in IPR2023-01242, IPR2023-01243, and IPR2023-01244 (collectively, the “first set of IPRs”), in which Patent Owner’s Director Review requests were granted, the Board’s final written decisions were vacated, and the cases were remanded to the Board to allow discovery narrowly tailored to the privity issue. *See* IPR2023-01242, Paper 94; *compare* DR Request 9–15, *with* IPR2023-01242, Paper 90, 5–9.

Since Patent Owner filed the DR Request, the Board ordered post-remand discovery in the first set of IPRs and *sua sponte* ordered discovery related to the privity issue in five additional related cases (IPR2024-00017, IPR2024-00018, IPR2024-00019, IPR2024-00020, IPR2024-00021). *See, e.g.*, IPR2024-00017, Paper 89. Given the substantial identity of issues between these cases, the first set of IPRs, and the additional related cases, the best course of action is to vacate the Board’s Decisions and remand these cases to the Board to allow the Board to authorize additional discovery in

³ All citations are to IPR2024-00001. The parties filed similar papers and exhibits in IPR2024-00016. Citations are to the publicly available redacted versions of the Decision and the parties’ papers.

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these cases. Doing so will place all of the related proceedings on similar footing and allow the Board in the first instance to efficiently consider the overlapping issues presented in all the cases.

Accordingly, Director Review is granted, the Board's Decisions are vacated, and the cases are remanded to the Board with instructions to allow discovery, narrowly tailored to the privity issue, as the Board already has authorized in the first set of IPRs and the other related cases. 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 unnamed real party in interest, without any support for that assertion, is insufficient to put the issue into dispute").⁴

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;

⁴ If 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).

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FURTHER ORDERED that the Board's Final Written Decisions (Papers 78, 80; IPR2024-00016, Papers 74, 76) are vacated; and

FURTHER ORDERED that the case is remanded to the Board for further proceedings consistent with this decision.

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