

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

YANGTZE MEMORY TECHNOLOGIES COMPANY, LTD.

Petitioner,

v.

MICRON TECHNOLOGY, INC.

Patent Owner.

Case IPR2025-00099

U.S. Patent No. 10,872,903

**PETITIONER’S MOTION TO UPDATE MANDATORY NOTICE TO ADD
REAL PARTIES-IN-INTEREST**

Pursuant to the Board’s email of February 5, 2025, and in accordance with 37 C.F.R. § 42.20(a), Yangtze Memory Technologies Company, Ltd. (“Petitioner”) respectfully moves to update its mandatory notices to identify an additional real party-in-interest (“RPI”) without changing the filing date of the above-captioned petition.¹ Specifically, Petitioner hereby moves to update its mandatory notices to identify Yangtze Memory Technologies, Inc. (“YMTI”), as a real party-in-interest out of an abundance of caution and without admitting that it is, in fact, a real party-in-interest. Petitioner has conferred with Patent Owner, and Patent Owner has indicated that it does not oppose.

I. The Board Should Allow Petitioner to Update the Real Parties-In-Interest Listing While Maintaining the Original Filing Date

The Federal Circuit has held that the real party-in-interest (“RPI”) requirement of 35 U.S.C. § 312(a) is correctable. “[I]f a petition fails to identify all real parties in interest under § 312(a)(2), the Director can, and does, allow the petitioner to add a real party in interest.” *Wi-Fi One v. Broadcom Corp*, 878 F.3d 1364, 1374, n.9 (Fed. Cir. 2018) (*en banc*). The requirement to identify all RPIs serves “to assist members of the Board in identifying potential conflicts, and to assure proper application of the statutory estoppel provisions.” Office Patent Trial

¹ As permitted by the Board’s email, a substantively identical motion and related papers are being filed in IPR2025-00098 (Patent 8,945,996).

Practice Guide, 77 Fed. Reg. 48,756, 48,759 (Aug. 14, 2012). A lapse in compliance with the requirements of § 312(a) “does not deprive the Board of jurisdiction over the proceeding, or preclude the Board from permitting such lapse to be rectified.” *Lumentum Holdings, Inc. v. Capella Photonics, Inc.*, Case IPR2015-00739, Pap. 38, *5 (precedential). Indeed, the Board has found that allowing petitioners “to update the mandatory notices while maintaining the original filing date promotes the core functions of RPI disclosures and secures a ‘just, speedy, and inexpensive resolution’ of this proceeding.” *Adello Biologics LLC v. Amgen Inc*, PGR2019-00001, Pap. 11, *5 (precedential) (citing 37 C.F.R. § 42.1).

A. 35 U.S.C. 312(a) and 37 C.F.R. § 42 Allow Updates to the RPI Listing While Maintaining a Petition’s Original Filing Date

Section 312 is not a jurisdictional statute. *Lumentum*, *4-5 (relying on *Elekta, Inc. v. Varian Med. Sys., Inc*, IPR2015-01404, Pap. 19). “Section [37 C.F.R. §] 42.106 does not foreclose the Board’s discretion to maintain a petition’s original filing date when a party amends its RPI disclosures because, under § 42.5(b), ‘[t]he Board may waive or suspend’ § 42.106’s filing date provisions.” *Elekta*, *8. In *Elekta*, the Board maintained the petition’s original filing date and allowed petitioner to amend its mandatory notice and add RPIs based on § 42.5(b). *Id.*, *8-10. See § 42.5(a); *Lumentum* at 7 (37 C.F.R. § 42.5(c)(3) “provid[es] the Board discretion to permit late-filing of the updated mandatory notice.”). The Board

therefore has authority to provide the relief sought.

B. No Evidence of Bad Faith, Gamesmanship, or Intentional Concealment by Petitioner

In *Adello*, the Board considered whether any intentional concealment, gamesmanship, or other bad faith by the petitioner was behind its delay in identifying an additional RPI. *Adello*, *4-5; *see also Proppant*, *6. None of those factors is present here. Petitioner acknowledges that parties and individuals involved in proceedings before the Office have a “duty of candor and good faith,” 37. C.F.R. § 42.11(a). With that understanding, Petitioner represents that there was no intentional concealment, gamesmanship, or bad faith in its decision to identify only Petitioner as a real party-in-interest.

Petitioner was the only party with control over the preparation of the petition, and no other party—including YMTI—was involved in the funding or preparation of the Petition or otherwise in this proceeding. Petitioner, however, identifies YMTI as a potential real party-in-interest solely because YMTI is a co-defendant with Petitioner in the related litigation involving the '903 patent, and because YMTI is a subsidiary of Petitioner. YMTI exercises no control over the daily operations of Petitioner, and Petitioner had no obligation to consult with YMTI or obtain its permission to file the present Petition. The Board has found that even parent entities are not RPIs in similar circumstances. *See Mobile Tech, Inc. v. Sennco Solutions, Inc.*, IPR2017-02199, Pap. 9, *8-10; *Puzhen Life USA, LLC v.*

Esip Series 2, LLC, IPR2017-02197, Pap. 13, *3-6.

Accordingly, Petitioner had, and continues to have, a good faith belief that YMTI is not, in fact, an RPI. If, however, YMTI is an RPI, the failure to name it was at most the result of mistaken belief rather than an attempt to circumvent the application of estoppel. Naming YMTI as an RPI will clarify that YMTI will be bound by any estoppel effect flowing from this proceeding and eliminate any doubt about this issue.²

C. No Prejudice to Patent Owner

As in *Adello*, adding the YMTI as an RPI benefits rather than prejudices Patent Owner by ensuring that YMTI is subject to “the relevant statutory restrictions.” *See Adello*, *6. Furthermore, Patent Owner was aware of YMTI before the Petition was filed—Patent Owner named YMTI in its Counterclaims against Petitioner. Thus, there was no concealment of relevant entities. Adding YMTI as an RPI also benefits Patent Owner by preventing any “second bite at the apple” through successive petitions.

Finally, any delay in identifying YMTI has no negative effect on Patent

² Petitioner’s mandatory notice, filed concurrently with this motion, uses language deemed acceptable in *Proppant Express Investments, LLC v. Oren Technologies, LLC*, IPR2017-01917, Pap. 86, *14-16 (precedential) (petitioner adding two parties as RPIs “without admitting that they are in fact real parties-in-interest”).

Owner's ability to challenge the petition. Patent Owner's POPR is not yet due. Had YMTI been named as an RPI originally, Patent Owner would have been in the same position as it is now.

II. The Updated Set of Real Parties-In-Interest Would Not Result in a Time Bar under 35 U.S.C. § 315(b)

Finally, on the date the Petition was filed, neither Petitioner nor YMTI was subject to the § 315(b) time bar. The Petition was filed November 18, 2024, about nine months after Patent Owner filed its original Counterclaims against Petitioner and YMTI in the district court on February 16, 2024. Accordingly, if YMTI is added as an RPI without changing the present petition's filing date, no time bar under § 315(b) would result.

Respectfully submitted,

Dated: February 7, 2025

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing
PETITIONER'S MOTION TO UPDATE MANDATORY NOTICE TO ADD
REAL PARTIES-IN-INTEREST was served via electronic mail to the following
attorneys of record for the Patent Owner listed below:

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