Filed on behalf of: Yangtze Memory Technologies Company, Ltd.

Entered: March 12, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICRON TECHNOLOGY, INC.,
Petitioner,

v.

YANGTZE MEMORY TECHNOLOGIES COMPANY, LTD.,
Patent Owner.

Case IPR2025-00119
Patent 10,879,254

PATENT OWNER'S RESPONSE TO PETITIONER'S RANKING AND EXPLANATION FOR TWO PETITIONS CHALLENGING U.S. PATENT NO. 10,879,254

Patent Owner Yangtze Memory Technologies Company, Ltd. ("YMTC") submits its Response to Petitioner's Ranking and Explanation for Two Petitions Challenging U.S. Patent No. 10,879,254 ("'254 Patent") (Paper 4), filed by Petitioner Micron Technology, Inc. ("Micron").

This is a garden variety case where there should only be one petition on one patent. No exceptional circumstances exist to warrant the rare granting of two petitions on the same patent. Each of Micron's petitions challenges only 18 claims.[1] The challenged claims are not lengthy and the two petitions address the exact same claims. Micron defends its decision to file two petitions on the same claims by pointing to "the number and nature of the claims, and the need to establish priority to a foreign application for the Fujiki reference." But neither justifies the substantial and unnecessary burden on the Board and YMTC associated with having two petitions on the same patent. Micron could and should have presented both grounds in one petition—notably, Micron's petitions used far fewer words (9,596 and 12,083, respectively) than the word count allowed for IPR petitions (14,000). Paper 4 at 2.

I. Background

Absent exceptional circumstances, only one petition should be filed against a single patent. *SolarEdge Techs. Ltd., v. SMA Solar Tech., AG.*, IPR2020-00966,

[1] YMTC has disclaimed claims 1, 5, and 6, so only 15 challenged claims remain.

Paper 9 at 10 (Jan. 11, 2021). The Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019) ("CTPG") provides that "one petition should be sufficient to challenge the claims of a patent in most situations." CTPG at 59. Thus, "multiple petitions by a petitioner are not necessary in the vast majority of cases." *Id.* The CTPG recognizes that multiple petitions filed against the same patent at the same time "may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns." *Id.*

However, the CTPG recognizes two examples where more than one petition may be necessary. *Id.* (emphasis added). They are: (1) when the patent owner has asserted a large number of claims in litigation; and (2) when there is a dispute about priority date requiring arguments under multiple prior art references. *Id.* This "statement does not convey that whenever a priority issue is involved, Petitioner is entitled to file two petitions against the same claims of the same patent. Rather, the operative phrase is 'may be needed, although this should be rare.'" *Square, Inc. v. 4361423 Canada Inc.*, IPR2019-01626, Paper 14 (PTAB March 30, 2020).

II. More Than One Petition Is Not Warranted

Micron has failed to show that this is one of those "rare" circumstances requiring the filing of two petitions against the same claims of the same patent. The CTPG provides that petitioners filing two petitions challenging the same patent should provide "a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should

exercise its discretion to institute additional petitions if it identifies one petition that satisfies petitioner's burden under 35 U.S.C. § 314(a)." CTPG at 60 (encouraging the "petitioner to user a table to aid in identifying the similarities and differences between petitions"). Micron has failed to provide any meaningful explanation of this type, relying instead on 1.5 pages of conclusory assertions. Micron asserts that parallel petitions are justified because: (1) YMTC has allegedly "asserted a large number of claims in litigation," (2) "there is a dispute about priority date," and (3) "any additional burden" on the Board or YMTC is "negligible." Paper 4 at 1-2. Micron is wrong on all counts.

First, both of Micron's petitions challenge the same 18 claims,[2] and after disclaimer, only 15 remain. But 18 claims "generally is not a significantly large number of claims to address in a single petition." *Square*, IPR2019-01626, Paper 14 at 10. The Board routinely receives petitions challenging more than 18 claims in a single petition. *Apple Inc. v. Koss Corp.*, IPR2021-00679, Paper 14 at 12 (Oct. 12, 2021); *see also Fitbit, Inc. v. Koninklijke Philips N.V.*, IPR2020-00772, Paper 14 at 26 & n.8 (Oct. 19, 2020) (In fiscal year 2019, there were about 16 challenged claims per challenged patent.). Indeed, the basic filing fee for an *inter partes* review contemplates challenging up to 20 claims. *See* 37 C.F.R. § 42.15(a)(1), (3).

[2] Only 6 claims of the '254 patent are presently asserted against Micron.

Moreover, the '254 Patent claims are not lengthy, and Micron does not assert that their length posed any problem in presenting two grounds in one petition. Tellingly, Micron was able to address all 18 claims in each petition with room to spare: Micron had over 4,000 words left in IPR2025-00034 and over 2,000 words left in this proceeding (IPR2025-00119). Micron asserts that the number of claims "doesn't tell the whole story" and that many claims "recite fabrication details" that it had to "thoroughly demonstrate" knowledge of the art. Paper 4 at 1-2 (citing claims 3, 5, 6, and 8). But Micron relies on substantially the same alleged "knowledge" in both Petitions (e.g., for claims 2, 3, and 7). Nevertheless, there is nothing about the '254 Patent's claims or the technology of the challenged patent and art that would distinguish it from many cases where one petition is sufficient. *Apple Inc.*, IPR2021-00679, Paper 14 at 12.

Second, Micron argues that "parallel petitions are justified when 'there is a dispute about priority date.'" Paper 4 at 2. In fact, the CTPG states that parallel petitions *may* be justified where there is a priority date dispute, but that such instances are "rare." CTPG at 59. Regardless, the mere possibility of a priority dispute does not entitle Micron to multiple petitions. *Square*, IPR2019-01630, Paper 13 at 9 (The CTPG "does not convey that whenever a priority issue is involved, Petitioner is entitled to file two petitions against the same claims.").

Moreover, although Micron asserts that its second petition raises a priority dispute (Paper 4 at 2), there is no asserted priority dispute in its first-ranked petition (-00034) that would warrant a second petition. *See Dexcom, Inc. v. Abbott Diabetes Care Inc.*, IPR2023-01252, Paper 9 at 12 (Feb. 5, 2024) (denying institution where priority dispute only raised in second petition); *Square*, IPR2019-01630, Paper 13 at 10-11. Micron fails to explain why it needs a second primary reference at all.

Third, Micron asserts that its parallel petitions will impose a "negligible" additional burden on the Board and YMTC because it used the same expert and "[n]either Petition approaches the limit of 14,000 words." Paper 4 at 2. But two petitions on the same patent means two institution decisions, two sets of briefs, two cross-examinations of each declarant, two oral hearings, and two final written decisions. *Dexcom*, Paper 9 at 13-14. This will undoubtably increase the burden on both the Board and YMTC. And Micron's ability to address the challenged claims with room to spare cuts against its parallel petitions: the word counts demonstrate that Micron could and should have raised all grounds in one petition.

Micron's arguments that it should be entitled to two petitions—and as a result, two sets of depositions, two oral hearings, and two bites at the apple—all fail.

III. Conclusion

The Board should not exercise its discretion to institute more than one petition (if it institutes at all).

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 12th day of March, 2025, a true and correct copy of the foregoing **Patent Owner's Response to Petitioner's Ranking and Explanation for Two Petitions Challenging U.S. Patent No. 10,879,254** was served by electronic mail on Petitioner's lead and backup counsel at the following email addresses:

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