

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

Entered: May 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 IPR2025-00244
Patent 10,886,291

**PATENT OWNER'S RESPONSE TO PETITIONER'S RANKING AND
EXPLANATION FOR TWO PETITIONS CHALLENGING
U.S. PATENT NO. 10,886,291**

Exhibit List

Exhibit	Description
2001	Defendants' Preliminary Invalidity Contentions and Document Production Accompanying Invalidity Contentions re YMTC II Asserted Patents (Patent Local Rules 3-3 and 3-4), <i>Yangtze Memory Technologies Company, Ltd. v. Micron Technology, Inc.</i> , No. 3:23-cv- 05792-RFL (N.D. Cal. Nov. 25, 2024) (excerpts)
2002	Civil Minutes, <i>Yangtze Memory Technologies Company, Ltd. v. Micron Technology, Inc.</i> , No. 3:23-cv-05792-RFL (N.D. Cal. Sept. 18, 2024), ECF No. 141
2003	Order Granting Stipulation to Extend Certain Deadlines Pursuant to Patent L.R. 4-2 and the Scheduling Order (ECF No. 141) Pursuant to Civil Local Rule 6-1(b), <i>Yangtze Memory Technologies Company, Ltd. v. Micron Technology, Inc.</i> , No. 3:23-cv-05792-RFL (N.D. Cal. Jan. 8, 2025), ECF No. 194
2004	Order Granting Motion to Stay Case Pending <i>Inter Partes</i> Review, <i>Yangtze Memory Technologies Company, Ltd. v. Micron Technology, Inc.</i> , No. 3:23-cv-05792-RFL (N.D. Cal. Mar. 14, 2025), ECF No. 243
2005	Plaintiff/Counterclaim Defendant Yangtze Memory Technologies Company, Ltd.'s and Counterclaim Defendant Yangtze Memory Technologies, Inc.'s Opposition to Micron's Motion to Stay Case Pending <i>Inter Partes</i> Review and Post-Grant Proceedings, <i>Yangtze Memory Technologies Company, Ltd. v. Micron Technology, Inc.</i> , No. 3:23-cv-05792-RFL (N.D. Cal. Feb. 3, 2025), ECF No. 221
2006	Declaration of Dr. Sunil P. Khatri, Ph.D In Support Of Patent Owner's Preliminary Response ("Khatri")
2007	Curriculum Vitae of Dr. Sunil P. Khatri
2008	Disclaimer in Patent Under 37 C.F.R. § 1.321(a), filed May 9, 2025

Exhibit	Description
2009	Redline comparison of Petitions filed in Case Nos. IPR2005-00244 and IPR2005-00294
2010-2017	RESERVED
2018	Order Granting Motion to Consolidate, <i>Yangtze Memory Technologies Company, Ltd. v. Micron Technology, Inc.</i> , No. 3:23-cv-05792-RFL (N.D. Cal. Aug. 21, 2024), ECF No. 106

Patent Owner Yangtze Memory Technology Company, Ltd. (“YMTC” or “Patent Owner”) submits its Response to Petitioner’s Ranking and Explanation for Two Petitions Challenging U.S. Patent No. 10,886,291 (“’291 Patent”) (Paper 3), filed by Petitioner Micron Technology, Inc. (“Micron” or “Petitioner”).

No exceptional circumstances exist to warrant the rare granting of two petitions on the same patent. Between the two petitions, Petitioner challenges only 19 claims, less than the typical 20. The challenged claims include several overlapping limitations, as reflected in Petitioner’s analysis. Petitioner defends its decision to file two petitions by pointing to “the depth of analysis presented in the petitions, and the petition word limit,” but most of its second petition repeats the material from the first—or in Petitioner’s own words, “repeating the claim 1 analysis.” Petitioner also submitted a single expert declaration for both petitions, signifying significant overlap.

Petitioner fails to justify the burden imposed on the Board and Patent Owner by filing two petitions on the ’291 patent. Two petitions require two institution decisions, two sets of briefs, two cross-examinations of declarants, two oral hearings, and two final written decisions. That increased burden is not warranted here, and Petitioner should not be entitled to two petitions for the ’291 Patent.

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, 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, 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 that more than one petition may be necessary when the patent owner has asserted a large number of claims in litigation. *Id.*

II. More Than One Petition Is Not Warranted

Petitioner has failed to show that this is one of those “rare” circumstances where the Board should allow two petitions on the same patent. The CTPG provides that petitioners 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, 60 (encouraging “petitioner to use a table to aid in identifying the similarities and

differences between petitions”). Petitioner has failed to provide a meaningful explanation, relying instead on conclusory assertions: (1) Patent Owner has allegedly “asserted a large number of claims in litigation,” “*i.e.*, 19 of 20 claims of the ’291 patent,” (2) “the depth of the analysis presented in the petitions,” and (3) “the petition word limit.” IPR2025-00244 (“-244”) Paper 3, 1-2. Petitioner is wrong.

First, Petitioner’s two petitions challenge a total of 19 claims.¹ But the assertion that Petitioner’s 19 challenged claims “is a quantum of claims that could not be addressed in a single petition strains credibility.” *Apple Inc. v. Koss Corp.*, IPR2021-00686, Paper 12, 13 (Oct. 12, 2021) (characterizing a request for multiple petitions for 20 total claims). The Board “routinely receives petitions challenging more than 18 claims.” *Id.*; *see also Fitbit, Inc. v. Koninklijke Philips N.V.*, IPR2020-00772, Paper 14, 26 & n.8 (Oct. 19, 2020) (describing on average 16 claims were challenged per patent in fiscal year 2019). 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). Notably, Petitioner was able to address 18-20 challenged claims in single

¹ The petition for the instant IPR challenges 15 claims, and the petition for IPR2024-00294 challenges 4 claims. Only three claims of the ’291 Patent are presently asserted against Petitioner.

petitions against patents asserted by Patent Owner in the same litigation.²

Moreover, due to the case narrowing requirements ordered by the Court in the district court litigation, Patent Owner now asserts just three claims from the '291 Patent against Petitioner, claims 11, 18, and 19. All three of these claims are challenged by the instant Petition (-244), and none of the claims challenged by the IPR2025-00294 ("-294") Petition are asserted in the district court litigation.

Second, Petitioner asserts that two petitions are necessary "in order to address each of the challenged claims in sufficient detail" in light of the word limit. -244 Paper 3, 2. But Petitioner points to nothing about the "subject matter at issue" (*id.* at 2) in the '291 Patent's claims that would distinguish it from many cases where one petition is sufficient. *See Apple Inc.*, IPR2021-00686, Paper 12, 13.

And while Petitioner says it needs two petitions to complete the analysis, it fails to mention the significant overlap in its analysis across the two petitions, which is partly due to the overlap in limitations between the challenged claims. For example, Petitioner admits that its "analysis of claim 1 is identical in both petitions" (-244 Paper 3, 2), resulting in a majority of the content of the two petitions being nearly identical. *See Ex. 2009*, 16-25, 28-35, and 38-82 (redline showing portions of the second petition (-294) are nearly identical to the first (-244)). Petitioner's

² IPR2025-00191, IPR2025-00117, IPR2025-00228.

analysis of claim 11 consists almost entirely of references back to claim 1. *See* -244 Pet., 92; *see also* -244 Pet., 95 (similar for claims 14-17). Similarly, Petitioner addresses claim 7 on a single page by referring back to claim 6, stating that the limitations of claim 7 are “substantively identical” to corresponding limitations of claim 6. -294 Pet., 80. Likewise, Petitioner addresses fifteen of seventeen limitations of claim 20 by simply referring back to claim 1. -294 Pet., 92-98.

Petitioner even states that claim 1 “limitations mirror many of those in independent claim 20.” -294 Paper 3, 1-2. Indeed, Petitioner submitted a single expert declaration for both petitions. Ex. 1003. Petitioner should not be rewarded with two petitions on the same patent because it chose not to streamline its arguments.

Third, the petitions will impose additional burden on the Board and Patent Owner. Two petitions on the same patent means two institution decisions, two sets of briefs, two cross-examinations of declarants, two oral hearings, and two final written decisions. *See Dexcom, Inc. v. Abbott Diabetes Care Inc.*, IPR2023-01252, Paper 9, 13-14 (Feb. 5, 2024). Petitioner’s repetition across the petitions cuts against its reasoning: Petitioner could and should have raised all grounds in one petition.

For these reasons, Petitioner’s arguments that it should be entitled to two petitions all fail.

III. Conclusion

The Board should not exercise its discretion to institute more than one petition.

Respectfully submitted,

Dated: May 12, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 12th day of May, 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. 10,886,291 and all Exhibits** were served by electronic mail on Petitioner's lead and backup counsel at the following email addresses:

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