

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

Entered: May 19, 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 IPR2025-00294
Patent 10,886,291

PATENT OWNER'S PRELIMINARY RESPONSE

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Exhibit List

Exhibit	Description
2001	DISCLAIMER IN PATENT UNDER 37 C.F.R. § 1.321(a) for U.S. Patent No. 10,886,291 (May 9, 2025)
2002	Power of Attorney Record for Application No. 16/046,847 (July 3, 2024)
2003-2008	RESERVED
2009	Redline comparison of Petitions filed in Case Nos. IPR2025-00244 and IPR2025-00294

I. Introduction

Patent Owner respectfully submits this Preliminary Response to the Petition for *inter partes* review of claims 6-7, 10, and 20 (the “Challenged Claims”) of U.S. Patent No. 10,886,291 (“’291 Patent”) (Ex. 1001). The Board should deny institution of the Petition because Patent Owner Yangtze Memory Technology Company, Ltd. (“YMTC” or “Patent Owner”) disclaimed all Challenged Claims.

II. Patent Owner’s Statutory Disclaimer Under 37 C.F.R. § 1.321(a)

While Patent Owner disagrees with Petitioner’s unpatentability contentions, Patent Owner has disclaimed each of the Challenged Claims under 35 U.S.C. § 253. This statutory disclaimer was effected in compliance with 37 C.F.R. § 1.321(a) by submission of an appropriate Form PTO/SB/43 (Disclaimer in Patent Under 37 C.F.R. § 1.321(a)) on May 9, 2025, a copy of which is attached as Exhibit 2001.

When a patent owner properly records a disclaimer of all patent claims challenged in a petition, binding Board precedent and rules preclude institution. *See Gen. Elec. Co. v. United Techs. Co.*, IPR2017-00491, Paper 9 at 2 (PTAB July 6, 2017) (precedential). “A disclaimer under 35 U.S.C. § 253(a) is ‘considered as part of the original patent’ as of the date on which it is ‘recorded’ in the Office.” *Id.* at 2-3 (citing (35 U.S.C. § 253(a))). For a statutory disclaimer to be recorded in the Office, the disclaimer must:

- (1) Be signed by the patentee, or an attorney or agent of record;

- (2) Identify the patent and complete claim or claims, or term being disclaimed. . . . ;
- (3) State the present extent of patentee's ownership interest in the patent; and
- (4) Be accompanied by the fee set forth in [37 C.F.R.] § 1.20(d).

37 C.F.R. §1.321(a); *see also Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1382 (Fed. Cir. 1998) (holding § 253 disclaimer is immediately “recorded” on the date the USPTO receives a disclaimer meeting the requirements of § 1.321(a), and no further action is required in the USPTO).

Patent Owner complied with 37 C.F.R. § 1.321(a) by submission of Form PTO/SB/43 (“DISCLAIMER IN PATENT UNDER 37 C.F.R. § 1.321(a)”) on May 9, 2025, a copy of which is attached as Exhibit 2001. **First**, the disclaimer form was signed by attorney of record Mark C. Zimmerman (Reg. No. 44,006). Ex. 2001, 1; *see also* Ex. 2002 (establishing Mr. Zimmerman as the attorney of record for Patent Owner YMTC for the patent application that issued as the '291 Patent). **Second**, the disclaimer form identifies the '291 Patent and all of the Challenged Claims (6-7, 10, and 20). Ex. 2001, 1, 3. **Third**, the disclaimer form also identifies that Patent Owner YMTC has a 100% ownership interest in the '291 Patent. Ex. 2001, 1. **Fourth**, Patent Owner paid the required fee set forth in 37 C.F.R. § 1.20(d). *See* Ex. 2001, 5. Accordingly, Patent Owner has met the requirements for an effective disclaimer of all Challenged Claims under 35 U.S.C. § 253 and 37 C.F.R. § 1.321(a).

Binding Board precedent precludes institution of an *inter partes* review proceeding where all challenged claims are disclaimed pre-institution, as here. *See Gen. Elec. Co.*, IPR2017-00491, Paper 9 at 2-3 (“Under 37 C.F.R. § 42.107(e), ‘patent owner may file a statutory disclaimer under 35 U.S.C. [§] 253(a) in compliance with § 1.321(a) of this chapter, disclaiming one or more claims in the patent’ and ‘[n]o *inter partes* review will be instituted based on disclaimed claims.’”). A disclaimer under 35 U.S.C. § 253(a) is “considered as part of the original patent.” *Id.* As such, disclaimed claims are treated as if they never existed, and the Board cannot exercise jurisdiction over disclaimed claims at the pre-institution stage. *Pfizer, Inc. v. UniQure Biopharma B.V.*, IPR2020-00388, Paper 52 at 3 (PTAB Mar. 25, 2021) (citing 37 C.F.R. § 42.107(e)); *Intuitive Surgical, Inc. v. Ethicon LLC*, IPR2018-01248, Paper 7 at 2 n.1, 9-10 (PTAB Feb. 7, 2019); *Vectra Fitness*, 162 F.3d at 1383; *Gen. Elec. Co.*, IPR2017-00491, Paper 9 at 2-3; *Rekor Sys. Inc. v. Vigilant Sols., LLC*, IPR2020-01584, Paper 9 at 5-6 (PTAB Dec. 23, 2020); *Am. Honda Motor Co. v. Intell. Ventures II LLC*, IPR2018-00350, Paper 12 at 4-5 (PTAB June 21, 2018).

Here, Patent Owner disagrees with Petitioner's unpatentability arguments set forth in the Petition and makes the present disclaimer without prejudice to Patent Owner's ability to rebut such arguments, including characterizing and distinguishing the references cited in the Petition, in any forum. The present statutory disclaimer

is not an admission or acquiescence by Patent Owner with regard to the Petition, and should not and cannot be construed as a request for an adverse judgment. Nevertheless, in the interest of judicial and economic efficiency, Patent Owner has filed an effective statutory disclaimer under 35 U.S.C. § 253. Accordingly, the Board should deny institution consistent with the Board's binding precedent.

III. Conclusion

All Challenged Claims of the '291 Patent have been disclaimed. Because “[n]o *inter partes* review will be instituted based on disclaimed claims” (37 C.F.R. § 42.107(e)), Patent Owner respectfully submits that institution of a trial as to the Challenged Claims of the '291 Patent would be improper and requests that the Petition not be instituted.

Respectfully submitted,

Dated: May 19, 2025

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CERTIFICATE OF COMPLIANCE WITH 37 C.F.R. § 42.24

I hereby certify that this Patent Owner's Preliminary Response complies with the word count limitation of 37 C.F.R. § 42.24(b)(1) because the Patent Owner's Preliminary Response contains 852 words using Microsoft Word's counting feature, excluding the cover page, signature block, and the parts of the Patent Owner's Preliminary Response exempted by 37 C.F.R. § 42.24(b)(1).

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 19th day of May, 2025, a true and correct copy of the foregoing **Patent Owner's Preliminary Response and all Exhibits** were served by electronic mail on Petitioner's lead and backup counsel at the following email addresses:

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