

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KINGSTON TECHNOLOGY COMPANY, INC., KINGSTON TECHNOLOGY
CORPORATION, AND KINGSTON DIGITAL, INC.,
Petitioners,

v.

VERVAIN, LLC,
Patent Owner.

IPR2025-00616
U.S. Patent No. 10,950,300

**PATENT OWNER'S CONTINGENT OPPOSITION TO PETITIONER'S
MOTION FOR JOINDER**

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EXHIBIT LIST

Exhibit No.	Description
2001	Declaration of Dr. Sunil Khatri from <i>Phison Electronics Corporation v. Vervain, LLC</i> , IPR2025-00215, Ex. 2001 (P.T.A.B. May 14, 2025) (expert report filed with Patent Owner’s Preliminary Response)
2002	<i>Vervain, LLC v. Western Digital Corp. et al.</i> , No. 6:21-cv-488-ADA, Dkt. 41 (W.D. Tex. Jan. 24, 2022) (Claim Construction Order)
2003	<i>Vervain, LLC v. Kingston Technology Company, Inc., et al.</i> , No. 1:24-cv-254-ADA, Dkt. 19 (W.D. Tex. Jul. 15, 2024) (agreed scheduling order)
2004	<i>Vervain, LLC v. Kingston Technology Company, Inc., et al.</i> , No. 1:24-cv-254-ADA, Dkt. 56 (W.D. Tex. Jan. 28, 2025) (order denying motion to transfer venue)
2005	<i>Vervain, LLC v. Phison Electronics Corporation</i> , No. 1:24-cv-259-ADA, Dkt. 16 (W.D. Tex. Jul. 15, 2024) (agreed scheduling order)
2006	“Judge Albright Patent FAQ,” https://www.txwd.uscourts.gov/for-attorneys/judge-albright-courtroom-faq/ . Accessed December 18, 2024.
2007	Judge Albright’s Standing Order Governing Proceedings (OGP) 4.4—Patent Cases, Filed January 23, 2024.
2008	Preliminary Claim Constructions for <i>Vervain, LLC v. Phison Electronics Corporation</i> , No. 1:24-cv-259-ADA and <i>Vervain, LLC v. Kingston Technology Company, et al.</i> , No. 1:24-cv-254-ADA – email from Mr. Brown received on February 5, 2025.
2009	Markman Hearing Transcript dated February 6, 2025, for <i>Vervain, LLC v. Phison Electronics Corporation</i> , No. 1:24-cv-259-ADA and <i>Vervain, LLC v. Kingston Technology Company, et al.</i> , No. 1:24-cv-254-ADA.

Exhibit No.	Description
2010	<i>Vervain, LLC v. Western Digital Corp. et al.</i> , No. 6:21-cv-00488-ADA, Dkt. 180 (W.D. Tex. Jul. 26, 2023) (Redacted Copy of Order on the Pending Motions and Motions <i>In Limine</i>).
2011	<i>Phison Electronics Corp. v. Vervain, LLC</i> , PGR2024-00047, Paper 9 (P.T.A.B. Mar. 17, 2025) (Decision Denying Institution of Post-Grant Review of U.S. Patent No. 11,830,546)
2012	<i>Phison Electronics Corp. v. Vervain, LLC</i> , PGR2024-00048, Paper 9 (P.T.A.B. April 28, 2025) (Decision Denying Institution of Post-Grant Review of U.S. Patent No. 11,854,612)
2013	Docket Sheet for <i>Vervain, LLC v. Kingston Technology Company, Inc., et al.</i> , No. 1:24-cv-254-ADA (W.D. Tex.). Accessed May 19, 2025.
2014	Excerpts from Kingston’s Final Invalidity Contentions served on February 28, 2025 in <i>Vervain, LLC v. Kingston Technology Company, Inc., et al.</i> , No. 1:24-cv-254-ADA (W.D. Tex.)
2015	“Interim Processes for PTAB Workload Management Memorandum,” issued March 26, 2025, https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf . Accessed May 13, 2025.
2016	Docket Sheet for <i>Vervain, LLC v. Phison Electronics Corporation</i> , No. 1:24-cv-259-ADA (W.D. Tex.). Accessed May 19, 2025.
2017	<i>Vervain, LLC v. Western Digital Corp. et al.</i> , No. 6:21-cv-00488-ADA, Dkt. No. 183, Pretrial Hearing Redacted Transcript (W.D. Tex. Aug. 7, 2023).
2018	Chen et al., <i>Ultra MLC Technology Introduction</i> , Advantech Technical White Paper (Oct. 5, 2012) (“Chen”)
2019	Excerpts from Micheloni et al., <i>Inside NAND Flash Memories</i> (1 st ed. 2010) (“Micheloni”)

Exhibit No.	Description
2020	<i>Vervain v. Western Digital Corp. et al.</i> , No. 6:21-cv-00488-ADA, Dkt. 180 (W.D. Tex. Jul. 26, 2023) (Redacted Copy of Order on the Pending Motions and Motions <i>In Limine</i>).

I. Contingent Opposition To Petitioner’s Motion For Joinder

Vervain, LLC (“Patent Owner” or “Vervain”) respectfully submits this Contingent Opposition to the Motion for Joinder to IPR2025-00215 (Paper 3) filed by Kingston Technology Company, Inc., Kingston Technology Corporation, and Kingston Digital, Inc. (collectively, “Kingston” or “Petitioners”). This Opposition is submitted pursuant to the Board’s Order permitting its filing by June 20, 2025. *See* Paper 7; *see also* Ex. 3001.

A. Background: The Underlying Litigation And IPR Proceedings

Vervain asserted U.S. Patent No. 10,950,300 (“the 300 Patent”) against both Kingston and Phison Electronics Corporation (“Phison”) in the United States District Court for the Western District of Texas. *See Vervain, LLC v. Kingston Technology Company, Inc., et al.*, No. 1:24-cv-254-ADA (W.D. Tex.) (“the Kingston Litigation”); *Vervain, LLC v. Phison Electronics Corporations*, No. 1:24-cv-259-ADA (W.D. Tex.) (“the Phison Litigation”). The Court has scheduled separate trials in these cases for December 8, 2025 (Kingston) and December 15, 2025 (Phison). *See* Exs. 2003, 2005.

On December 17, 2024, Phison petitioned for *inter partes* review of the 300 Patent in IPR2025-00215. *See Phison Electronics Corporation v. Vervain, LLC*, IPR2025-00215, Paper 2 (P.T.A.B. Dec. 17, 2025). Vervain subsequently requested that the Director exercise her discretion to deny institution. *See* IPR2025-00215,

Paper 10 (P.T.A.B. May 14, 2025). Among other arguments, Vervain noted that “[t]he Board would likely issue a final written decision [on IPR2025-00212] *eight months* after trial” is scheduled to begin in the Phison Litigation. *Id.* at 14.

As of the date of this filing, the Director has not ruled on whether to discretionarily deny institution of IPR2025-00215. Importantly, “Phison has not filed a *Sotera* stipulation or any other stipulation to mitigate concerns of duplicative efforts between the District Court and the Board.” *Id.* at 17.

On February 21, 2025, Kingston filed a substantively identical petition for *inter partes* review of the 300 Patent in IPR2025-00616. *See* Paper 1; Paper 3, 1-2 (“Kingston’s petition [in IPR2025-00616] and the petition in the Phison 300 IPR [IPR2025-00215] are substantively identical[.]”). Kingston now seeks to join IPR2025-00215 to benefit from Phison’s earlier filing date. Because Kingston’s Petition was filed two months later, the projected statutory deadline for a final written decision in IPR2025-00616—absent joinder—“would be September 20, 2026—nine months after the December 8, 2025, trial date” in the Kingston Litigation. Paper 8, 16 (citing Ex. 2003).

Like Phison, Kingston “has not filed a *Sotera* stipulation or any other stipulation to mitigate concerns of duplicative efforts between the District Court and the Board[.]” Paper 8, 19.

B. Joinder Should Be Conditioned On Entry Of Any Stipulation Entered By Phison

At present, neither Phison nor Kingston has entered any stipulation.

If Phison later enters a stipulation in an effort to avoid discretionary denial of IPR2025-00215, and the Director declines to discretionarily deny the petition and the Board institutes trial, Kingston should not be permitted to join unless it enters the same stipulation. Allowing Kingston to join without being bound by the same stipulation would unfairly prejudice Vervain. Kingston would gain the benefit of Phison’s earlier filing date while retaining the ability to assert duplicative invalidity grounds in the parallel district court litigation. *See* Paper 8, 19-20 (“If this Petition is instituted, Petitioner may rely on its Gavens ground [from IPR2025-00616] both before the Board and in the Parallel Litigation[.]”); *see also Shenzhen Waydoo Intel. Tech. Co., Ltd. v. Mhl Custom, Inc.*, No. IPR2024-00998, 2024 WL 5148063, at *2 (P.T.A.B. Dec. 17, 2024) (denying joinder motion, considering “the specific facts of th[e] case” regarding whether the “[p]atent [o]wner would suffer under prejudice”).

Moreover, as detailed in Vervain’s Request for Discretionary Denial of Institution (Paper 8), the *Fintiv* factors strongly favor discretionary denial. This is not a case where the presence or absence of stipulations would be immaterial to the *Fintiv* analysis. *Contra Amazon Web Servs., Inc. v. Zentian Ltd.*, No. IPR2023-01193, 2024 WL 116225, at *5 (P.T.A.B. Jan. 10, 2024) (finding that a subordinate petitioner requesting joinder should not be required to enter the same *Sotera*

stipulation as a parent petitioner when “the *Fintiv* factors as whole do not otherwise weigh in favor of discretionary denial”).

II. Conclusion

For the foregoing reasons, Vervain respectfully requests that, should Phison enter a stipulation to avoid discretionary denial and the Board permits institution of IPR2025-00215, Kingston’s motion for joinder be denied unless Kingston enters the same stipulation. Allowing otherwise would result in significant prejudice to Vervain.

Date: June 20, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify, in accordance with 37 C.F.R. § 42.205, that the foregoing
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