

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SANDISK TECHNOLOGIES, INC.,
Petitioner,

v.

LONGITUDE FLASH MEMORY SOLUTIONS LTD.,
Patent Owner.

Case No. IPR2025-01283
U.S. Patent No. 9,929,240

PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL OF INSTITUTION

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PATENT OWNER'S EXHIBIT LIST

<i>Exhibit</i>	<i>Description</i>
2001	Complaint, <i>Sandisk Corp. v. IPValue Management, Inc., et al.</i> , 5:25-cv-02389 (N.D. Cal.), March 7, 2025.
2002	Joint Stipulation and Proposed Order to Modify Case Management Order, as Modified, <i>Sandisk Corp. v. IPValue Management, Inc., et al.</i> , 5:25-cv-02389 (N.D. Cal.), Dec. 5, 2025.
2003	Invalidity Contentions, <i>Sandisk Corp. v. IPValue Management, Inc., et al.</i> , 5:25-cv-02389 (N.D. Cal.), Nov. 14, 2025.
2004	Order on Discovery Dispute, <i>Sandisk Corp. v. IPValue Management, Inc., et al.</i> , 5:25-cv-02389 (N.D. Cal.), Sept. 29, 2025.
2005	Order Denying Motion to Dismiss, <i>Sandisk Corp. v. IPValue Management, Inc., et al.</i> , 5:25-cv-02389 (N.D. Cal.), Oct. 7, 2025.
2006	Order, <i>Sandisk Corp. v. IPValue Management, Inc., et al.</i> , 5:25-cv-02389 (N.D. Cal.), Oct. 20, 2025.
2007	Plaintiff's Stipulation Regarding Invalidity Contentions, <i>Sandisk Corp. v. IPValue Management, Inc., et al.</i> , 5:25-cv-02389 (N.D. Cal.), Oct. 29, 2025.
2008	IPValue's and Longitude Flash Memory Solutions's Disclosure of Asserted Claims and Infringement Contentions, <i>Sandisk Corp. v. IPValue Management, Inc., et al.</i> , 5:25-cv-02389 (N.D. Cal.), Sept. 30, 2025.

I. INTRODUCTION

Petitioner’s IPR petition should be denied under the Director’s discretionary authority in 35 U.S.C. § 314(a). First, the ’240 patent issued nearly eight years ago, on March 27, 2018, and it therefore benefits from strong settled expectations. Second, in the N.D. Cal. litigation, Petitioner asserts that every challenged claim of the ’240 patent is indefinite—including the “multi-layer charge trapping layer” limitations that are central to its obviousness theories here—while in this IPR it ignores indefiniteness and treats those same terms as definite and readily mapped to the prior art. Under *Tesla* and *Revvo*, such unexplained, materially inconsistent claim-interpretation positions between district court and the Board are themselves a sufficient basis for discretionary denial.

The *Fintiv* and Process Memo considerations independently point the same way. The N.D. Cal. case, which Petitioner chose to file and in which it is now a counterclaim defendant, is ongoing and unstayed; by the time an institution decision is due, claim construction and discovery will be well underway, with trial expected around the time of any final written decision. That case will address the validity of the ’240 patent together with closely related 8,633,537 (the “’537 patent”) and 11,456,365 (the “’365 patent”) family mem-

bers based on the same Lee '255, Lee '961, and Fujiwara prior art combinations asserted here. Both the '537 and '240 patent benefit from strong settled expectations of validity, and no IPR has even been filed challenging the '537 patent. Sending only the challenge for the '240 patent—or even for both the '365 and '240 patents—to the Board while the district court resolves the same prior-art and motivation-to-combine issues for the rest of the family would be an inefficient use of Board resources and risks inconsistent outcomes. The Director should therefore exercise discretion and deny institution.

II. BACKGROUND

A. Background of the '240 Patent

The '240 patent was filed on October 26, 2016 and issued on March 27, 2018. It is one of a series of continuations and continuations-in-part of U.S. Patent No. 8,063,434, filed on May 13, 2008, which in turn claimed priority to provisional application 60/940,160, filed on May 25, 2007. Ex. 1001 at 2.

The patent is directed to NAND flash non-volatile memory transistors whose gate stacks include multiple charge-storing layers, and their manufacture. Such transistors are at the heart of flash memories used in solid state drives, hard drives, USB flash drives, and other non-volatile memory-based storage. In the embodiments described, a tunnel dielectric overlies a semiconductor channel, a blocking dielectric lies beneath the gate, and between them

is a multi-layer charge-trapping region that includes nitride layers of different oxygen content separated by an oxide anti-tunneling layer, all disposed under a gate electrode. Ex. 1001 at 2:34–50, 3:37–46, 4:32–44, 10:1–12, 12:22–43.

The specification explains that conventional charge-trap flash memories with Si-rich trapping layers provide a large initial program/erase window but experience rapid window collapse and limited data retention, while “high-quality” nitride layers offer only moderate improvement in retention and start from a smaller initial window, and that existing memory processes can be incompatible with CMOS logic processes used in embedded and system-on-chip designs. Ex. 1001 at 1:56–2:30. As described in the Background and Summary, the disclosed multi-layer charge-trapping architecture, combined with the high work-function gate, is presented as a solution intended to improve data retention and transistor lifetime while remaining compatible with standard logic process flows, thereby providing the advance over prior structures identified in the patent itself. *Id.*

B. Related Proceedings

The '240 patent, together with four other patents, is asserted in two pending district court cases (Petition at 103):

- *Sandisk Corp. v. IPValue Management, Inc., et al.*, 5:25-cv-02389 (N.D. Cal.) (the “N.D. Cal. Case”).

- *IPValue Management, Inc., et al. v. Western Digital Corp., et al.*, 8:25-cv-00119 (C.D. Cal.) (the “C.D. Cal. Case”).

The C.D. Cal. Case was filed by IPValue Management, Inc. and patent owner Longitude Flash Memory Solutions Ltd. on January 22, 2025, naming Western Digital Corporation as defendant. At that time, Petitioner Sandisk’s corporate parent Sandisk Corporation was a wholly owned subsidiary of Western Digital Corporation. Ex. 2001, ¶ 2. On February 24, 2025, a spin-off transaction was completed whereby Sandisk Corporation became separate from Western Digital Corporation. *Id.* On March 7, 2025, Sandisk Corporation filed the N.D. Cal. Case as a declaratory judgment action seeking *inter alia* a declaratory judgment that it does not infringe the ’240 patent. Ex. 2001.

Patent Owner subsequently amended its complaint in the C.D. Cal. Case to add Sandisk Corporation as a defendant, and it counterclaimed in the N.D. Cal. Case, alleging infringement of the ’240 patent by Sandisk Corporation and Petitioner Sandisk Technologies, Inc. *See* Ex. 2006. The C.D. Cal. Case has been stayed in favor of the N.D. Cal. Case. The N.D. Cal. Case is proceeding, with claim construction soon to begin and a Trial Setting Conference set for February 16, 2027. Ex. 2002 at 3–4.

Among the four other patents asserted in the C.D. Cal. Case and N.D. Cal. Case are the ’537 patent and the ’365 patent. *See* Ex. 2001, ¶ 1. Both

the '537 and '365 patents an ancestor and descendant respectively of the '240 patent by continuation. Petitioner filed an IPR petition challenging the '365 patent on September 3, 2025, which is pending as IPR2025-01281. To date, no IPR petition has been filed against the '537 patent.

C. This IPR Petition

Petitioner Sandisk Technologies, Inc. filed this Petition on October 14, 2025. Petitioner asserts two grounds, collectively challenging claims 1, 3–7, 9, and 11–18 of the '240 patent, for a total of 15 out of the 18 claims of the patent. The Petition relies on four references: Lee '255 (Ex. 1004), Lee '961 (Ex. 1005), Fujiwara (Ex. 1006), and Hwang (Ex. 1048).

The IPR2025-01281 petition challenging the related '365 patent likewise contains an obviousness ground based upon the combination of Lee '255, Lee '961, and Fujiwara. IPR2025-01281, Petition at 91.

These grounds largely overlap with invalidity theories Petitioner is asserting in district court. There Petitioner challenges claims 1, 3–5, 7, 9, 12, and 14–18, for an overlap of 12 challenged claims. Ex. 2003 at 1. The prior art asserted in district court includes the same Lee '255, Lee '961, Fujiwara, and Hwang references asserted in this IPR. Ex. 2003 at 46–47. The obviousness combinations asserted in district court against each of the '537, '240, and '365 patents include the combination of Lee '255 with Lee '961 and the

combination of Lee '255, Lee '961, and Fujiwara that make up the asserted grounds in this IPR and in IPR2025-01283. *Id.* at 40, 50, 60. Indeed both this IPR and IPR2025-01281 are incorporated by reference into the district court invalidity contentions as purportedly providing motivations to combine, for each of the '537, '240, and '365 patents. *Id.* at 39, 50, 59–60.

III. LEGAL STANDARD

The Director has discretion to deny institution under 35 U.S.C. § 314(a). *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 136 S. Ct. 2131, 2140 (2016). In determining whether to deny institution, *Fintiv* balances considerations such as “system efficiency, fairness, and patent quality.” *Apple Inc. v. Fintiv, Inc.*, Case No. IPR2020-00019, Paper 11 at 5 (P.T.A.B. May 13, 2020) (precedential) (hereinafter “*Fintiv*”). *Fintiv* set forth six factors for denying institution, which are addressed below. *Fintiv* at 5-6. The USPTO’s Process Memo¹ enumerated a number of additional considerations for discretionary denial, certain of which are also addressed below. Process Memo at 2-3.

The standard for claim construction is the same before the PTAB as in district court, and ordinarily the parties should take consistent positions on claim construction in the two forums. *Revvo Techs., Inc. v. Cerebrum Sensor*

¹ Interim Processes For PTAB Workload Management, Available at <https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf> (March 26, 2025).

Techs., Inc., Case No. IPR2025-00632, Paper 20 at 4–5 (P.T.A.B. Nov. 3, 2025) (precedential) (“although a petitioner is not necessarily precluded from arguing different claim construction positions before a district court and the Board, the petitioner should explain sufficiently why the different positions are warranted.”) In particular, a petitioner cannot ordinarily assert that a claim is indefinite in district court, but then argue that it is obvious by mapping that same claim to prior art before the PTAB. *Tesla, Inc. v. Intellectual Ventures II LLC*, Case No. IPR2025-00340, Paper 18 at 4 (P.T.A.B. Nov. 5, 2025) (informative) (“Allowing a petitioner to advance a claim construction before the Board when that petitioner has made inconsistent indefiniteness arguments in district court fails to further, but instead detracts from, the Office’s goal of ‘providing greater predictability and certainty in the patent system.’”)

IV. PETITIONER CONTENDS IN DISTRICT COURT THAT EVERY CLAIM OF THE ’240 PATENT IS INDEFINITE

In its district court invalidity contentions served on November 14, 2025, Petitioner asserts that every challenged claim of the ’240 patent is indefinite. Specifically, Petitioner contends that the term “multi-layer charge trapping layer” appearing in independent claims 1, 12, and 16, as well as in dependent claims 13 and 18 is indefinite. Ex. 2003 at 116. Petitioner also contends that additional terms appearing in dependent claims 3, 4, and 7 are indefinite. *Id.*

at 115–116. Yet in its petition, Petitioner never mentions the issue of indefiniteness and instead contends that each of these purportedly indefinite limitations is taught by the prior art.

Under the Director’s recent decisions in *Revvo* and in *Tesla*, this is grounds for denial of institution. As the Director noted in *Tesla*, “[a]llowing a petitioner to advance a claim construction before the Board when that petitioner has made inconsistent indefiniteness arguments in district court fails to further, but instead detracts from, the Office’s goal of ‘providing greater predictability and certainty in the patent system.’” *Tesla*, IPR2025-00340, Paper 18 at 4. Therefore, “when a petitioner advances different positions before the Board and a district court, that petitioner is *required* to explain why those different positions are warranted.” *Id.* at 3.

Here, Petitioner fails to provide an explanation and could not plausibly do so. First, Petitioner’s invalidity position was advanced in district court *after* it filed this IPR petition, and its district court invalidity contentions incorporate this petition by reference. Ex. 2003 at 4. In other words, Petitioner advanced its district court indefiniteness position with full knowledge that it was simultaneously—and inconsistently—arguing for obviousness of the same claims in this IPR. There was no judicial decision or other development in either forum over the month between the filing of the IPR petition and the

service of the invalidity contentions that would justify advancing a different position in district court from the position advanced at the PTAB. *See Revvo*, IPR2025-00632, Paper 20 at 5.

Second, the allegedly indefinite terms are not of the type that a POSITA could nevertheless apply to the prior art, because this is not merely a situation in which only the outer bounds of a numerical range are indefinite. *See Tesla*, IPR2025-00340, Paper 18 at 3–4. Rather, the purportedly indefinite terms are “multi-layer charge trapping layer,” “first and second diffusion regions are disposed above a semiconductor material structure,” and similarly binary terms. Ex. 2003 at 115–116. These are not terms that can be interpreted to have an unambiguous numerical range with indefinite outer bounds. Nothing in the petition acknowledges that there is an ambiguity in the scopes of these terms or explains how they are satisfied by the art in spite of the ambiguity. *E.g.*, Petition at 48–54 (simply stating that Lee ’961’s element 202A is a “multi-layer charge trapping layer” without in any way addressing ambiguity in the outer bounds of this term).

In its brief opposing discretionary denial in IPR2025-01281, petitioner sought to justify its inconsistent positions on indefiniteness on the similar “multi-layer charge storage region” claim term by pointing to positions purportedly taken by patent owner in its district court infringement contentions.

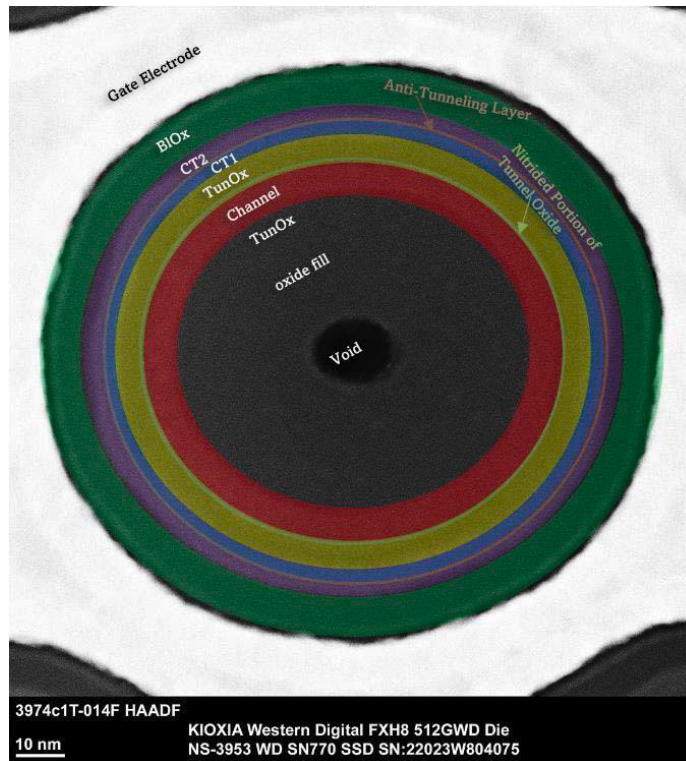
IPR2025-01281, Paper 11 at 15–17. To the extent that petitioner makes similar arguments in this IPR, they should be rejected. First, indefiniteness is a question of whether a patent’s “claims, read in light of the patent's specification and prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 898–99 (2014). Infringement contentions cannot render otherwise valid patent claims indefinite. Moreover, to the extent infringement contentions could render claims indefinite, the infringement contentions in question were served on September 30, 2025, two weeks before petitioner filed the instant IPR petition. Ex. 2008 at 12.

Second, petitioner’s arguments justifying its inconsistent positions on indefiniteness in IPR2025-01281 both misrepresent the infringement contentions in district court and contradict petitioner’s own confidential technical documents produced in the district court case. While the protective order in that case prevents the undersigned from disclosing the contents of that district court discovery, the misrepresentation of the infringement contentions is clear. In its brief opposing discretionary denial, petitioner argues:

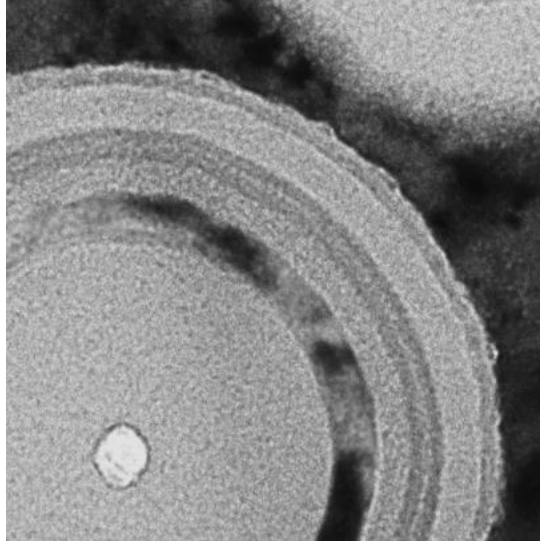
PO asserted that a single layer qualifies as a multi-layer region. *See* [IPR2025-01281, Ex. 1071] at 14 (adding colored annotations to a single layer with the labels “CT1,” “Anti-Tunneling Layer,” and “CT2”). PO’s position appears to be that variations

in chemical composition across a layer can transform a single layer into a “multi-layer” region.

IPR2025-01281, Paper 11 at 16. The colored annotations in question are the blue and purple layers in the image below:



IPR2025-01281, Ex. 1071 at 14. But unannotated images of the same structure in the same accused device clearly show two distinct layers, indicated by the fine lighter line separating two darker layers corresponding to the blue and purple layers in the figure above:



IPR2025-01281, Ex. 1071 at 7. Mapping this plainly multi-layer structure onto the claimed “multi-layer charge trapping layer” does not in any way suggest that this term is indefinite, even if infringement contentions could render otherwise definite claims indefinite. And petitioner should not be permitted to defeat discretionary denial based upon a misrepresentation of the infringement contentions and of the design and structure of its own products.

The Director should deny institution on the basis of this inconsistency in Petitioner’s positions on basic questions of claim interpretation across the two forums.

V. INSTITUTION OF THIS IPR WOULD NOT BE AN EFFICIENT USE OF THE PTAB’S RESOURCES

While *Fintiv* set forth a set of six factors that are relevant to discretionary denial, the ultimate question motivating the *Fintiv* decision was whether the existence and state of the parallel district court litigation rendered institution

“an inefficient use of Board resources.” *Fintiv*, IPR2020-00019, Paper 11 at

5. Here, institution would plainly not be an efficient use of resources.

**A. *Fintiv* Factor 1: Petitioner’s Prior Stay Request Has Expired
and There Is No Evidence a Further Stay Is Likely to Be
Granted**

Fintiv Factor 1 favors discretionary denial because the parallel district court litigation in N.D. Cal. is unstayed as to Petitioner, and there is no evidence that a further stay will be granted. Petitioner had previously moved for a stay of the N.D. Cal. case. This motion led to a brief stay of the case as to a different asserted patent (the ’505 patent), which went into effect on September 29, 2025 (Ex. 2004 at 1) and expired eight days later when the motion to dismiss that patent was denied (Ex. 2005). The parties then stipulated to stay the litigation as to Western Digital, but in the same stipulation agreed to add Petitioner Sandisk Technologies, Inc. as an infringement counterclaim defendant. Ex. 2006 at 3.

There is no pending motion to stay the N.D. Cal. case, and in particular no party has moved to stay that case pending this or any other IPR. Of the five patents at issue in that case, IPRs have only been filed on two, and the January 22, 2026 statutory bar to filing further IPRs is fast approaching. Any expectation that the N.D. Cal. Case would be stayed based upon the institution of one

IPR—or even of both this IPR and the -01281 IPR—is speculative and unsupported. Accordingly, this factor favors discretionary denial.

B. *Fintiv* Factor 2: The District Court’s Trial Date Is Near the Expected Date of Any Final Written Decision

Fintiv Factor 2 favors discretionary denial or is at worst neutral because the trial date is near the likely date of the final written decision. Specifically, the expected deadline for a final written decision in this case is April 22, 2027. The deadline for dispositive motions in the district court case is October 13, 2026, and the trial setting conference is set for February 16, 2027. Ex. 2002 at 4. Accordingly, the trial in the district court case is likely to occur at around the time of the final written decision or shortly thereafter. Certainly, substantial expense and effort will have been expended on fact discovery, expert discovery, and dispositive motions before a final written decision in this IPR. Accordingly, this factor favors denial, or is at the very least neutral.

C. *Fintiv* Factor 3: Significant Investment in the Parallel Litigation Will Have Occurred by the Time the Board’s Institution Decision is Due

Factor 3 relates to the “amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv* at 9. This factor favors discretionary denial. The institution decision for this IPR is due in April 2026. The parties will have expended substantial resources in the parallel district court litigation, e.g., for discovery

and claim construction briefing, as well as to develop their respective litigation positions, leading up to April 2026. Ex. 2002 at 3. Substantial completion of document production (May 7) will be mere weeks away, and the *Markman* hearing (on June 2) will be fast approaching. *Id.* Factor 3 thus also favors denial.

D. *Fintiv* Factor 4: There is Substantial Overlap Between the IPR Proceeding and the Parallel Litigation

Factor 4 looks at “whether all or some of the claims challenged in the petition are also at issue in district court” and whether the “petition includes the same or substantially the same claims, grounds, arguments, and evidence” as the parallel district court case. *Fintiv* at 12-13. As noted above, the overlap between the claims challenged in district court and in this IPR is 12 out of the 18 claims of the patent, including all of the claims asserted in district court. The obviousness grounds asserted in this IPR are also asserted in district court, not just against the ’240 patent but also against its ’537 and ’365 patent family members. Ex. 2003 at 39–40, 50, 59–60. The overlap is so complete that this IPR petition is incorporated by reference in the district court invalidity contentions to provide motivation to combine the references. *Id.*

The overlap is made more problematic by the Petitioner’s failure to offer more than a bare *Sotera* stipulation, Ex. 2007, falling short of the more fulsome stipulation that would make the IPR proceeding a “‘true alternative’ to

the district court proceeding.” *Sotera Wireless, Inc. v. Masimo Corp.*, Case No. IPR2020-01019, Paper 12 at 19 (P.T.A.B. Dec. 1, 2020); *see* Notice of Proposed Rulemaking, 90 F.R. 199 at 48341 (Oct. 17, 2025) (proposing to amend 37 C.F.R. § 42.108(d) to require stipulation by which the petitioner forgoes raising any grounds of invalidity under §§ 102 or 103 in other proceedings if IPR is instituted). Petitioner’s stipulation is limited to “any ground that could be raised under §§ 102 or 103 on the basis of prior art patents or printed publications.” Ex. 2007. The invalidity contentions, on the other hand, expressly assert the combination of the art in this IPR petition with “Cypress products,” an invalidity ground that would not appear to be covered by the narrow *Sotera* stipulation. Ex. 2003 at 50–53. *See Motorola Solutions, Inc. v. Stellar, LLC*, Case No. IPR2024-01205, Paper 19 at 3–4 (Mar. 28, 2025) (director review holding that *Sotera* stipulation entitled to less weight where petitioner still asserting combinations of IPR prior art with unpublished system art in district court). Any untimely broader stipulation that Petitioner might seek to enter after this request should not be accorded any weight. *See* Interim Director Discretionary Process,² § I.D (“If a petitioner chooses to file a stipulation, such as a *Sotera* stipulation, they should file it as soon as practicable,

² <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process>

so that the patent owner may address the impact of the stipulation in its discretionary denial brief.”).

Moreover, even a stipulation to completely forego §§ 102 and 103 invalidity defenses for the ’240 patent in district court would not eliminate the substantial overlap. As noted above, the same prior art combinations and motivations to combine them are also raised in the district court litigation to argue that the ’537 and ’365 patents are obvious. Ex. 2003 at 39–40, 50, 59–60. To date Petitioner has not even attempted to bring an IPR against the ’537 patent. Accordingly, the district court will need to decide the same issues concerning the scope of the prior art and motivation to combine references in addressing the claims of these closely related patents. This inevitably raises substantial “concerns of inefficiency and the possibility of conflicting decisions,” weighing against institution. *See Fintiv* at 12.

Under similar circumstances, where some but not all of a related set of challenged patents benefit from settled expectations of validity, the Director has denied institution. In *Amazon.com v. Audio Pod*, six related patents were challenged across six IPRs. *Amazon.com, Inc. v. Audio Pod IP, LLC*, Case No. IPR2025-00757, Paper 15 (P.T.A.B. Aug. 14, 2025). Five of those patents had been in force for 7–11 years; the sixth had been in force for only about four

years. *Id.* at 2–3. The Director held that the older patents created “strong settled expectations,” and then denied institution as to the four-year-old patent as well, explaining that although it had “not been in force as long as the other patents” (which would usually weigh against denial), the parallel district-court action would adjudicate validity of all six patents together, and sending only the young patent to the Board would be an “inefficient use of Board resources.” *Id.*

Similarly, in *Samsung v. iCashe* five of the challenged patents were between 8 and 12 years old, while the other two were 2 and 3 years old. *Samsung Elecs. Co., Ltd. v. iCashe, Inc.*, Case No. IPR2025-00639, Paper 11 at 2–3 (P.T.A.B. August 14, 2025). The Director still denied institution on the two younger patents, because the district court would adjudicate validity of all seven patents and referring only the younger ones to the Board would be an “inefficient use of Board resources.” *Id.*

Likewise, here it would be inefficient for the Board to adjudicate the validity of the ’240 patent while leaving the district court to adjudicate the similar issues of validity for the 11-year-old ’537 patent. For all of these reasons, Factor 4 weighs strongly in favor of denial.

E. *Fintiv* Factor 5: Petitioner is the Defendant in the Parallel Proceeding

Fintiv Factor 5 weighs in favor of discretionary denial because the parties are the same in both proceedings. *Fintiv*, Paper 11 at 13-14. Both the Petitioner and its real party-in-interest are counterclaim defendants in the N.D. Cal. Case. Petition at 95; Ex. 2006 at 3.

F. *Fintiv* Factor 6: The Petition Lacks Merit

Fintiv Factor 6 weighs in favor of denying institution if the Board deems analysis of this factor necessary. Petitioner has failed to show a reasonable likelihood of success on any challenged claims, as the Patent Owner expects to set forth in the Patent Owner Preliminary Response.

VI. NO SHOWING OF EXAMINER ERROR

To the extent that Petitioner argues that discretionary denial is inappropriate because of a purported material error by the examiner during prosecution, that argument should be rejected. As the Petition points out, Fujiwara was included among the references in an IDS filed during the prosecution of the '240 patent. Petition at 34. But the Petition does not attempt to show that Fujiwara, or any combination of this reference with any of the other references of record in prosecution should have led to the rejection of any of the challenged claims. Rather, the Petition relies on additional references that were not before the examiner. Accordingly, even if we assumed that every theory

of obviousness presented in the Petition was indisputably correct, that would not show that the examiner erred in analyzing the art that was before him during prosecution.

The Petition expressly argues that its obviousness grounds are based upon art that is different from that before the examiner and thus does not seek to show that the examiner overlooked teachings of the art before him or made errors in analyzing that art. Petition at 41 (“The combination of Lee ’255, Lee ’961, and Fujiwara differs from prior art considered during prosecution.”). Having argued in the Petition that the art making up its obviousness grounds is materially different from that before the examiner, Petitioner should not now be permitted to argue that the grounds of its petition show examiner error. Indeed, the Petition relies upon Lee ’255 and Lee ’961—which were not before the examiner—as teaching the “multi-layer charge trapping layer” and related limitations, Petition at 48–54, confirming that the examiner was correct to conclude that the prior art he considered failed to disclose that limitation.

VII. CONCLUSION

For each of the foregoing reasons, Patent Owner respectfully requests that the Director exercise discretion to deny institution of this IPR.

Case No. IPR2025-01283
U.S. Patent No. 9,929,240

Dated: November 17, 2025

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CERTIFICATE OF SERVICE

I hereby certify that “Patent Owner’s Request for Discretionary Denial of Institution” was served on November 17, 2025 by email sent to:

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Chris Ponder
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