

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICRON TECHNOLOGY, INC., and MICRON SEMICONDUCTOR
PRODUCTS, INC.,

Petitioners,

v.

PALISADE TECHNOLOGIES, LLP,

Patent Owner.

Case IPR2025-01559

Patent No. 9,524,974

**PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF
INSTITUTION**

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Exhibit No.	Description
2001	Plaintiff's Complaint for Patent Infringement, No. 7:24-cv-00262, Dkt. 1 (W.D. Tex. Oct. 16, 2024) in the District Court Litigation
2002	Scheduling Order (Dkt. No. 38) in the District Court Litigation
2003	Docket Entry List for the District Court Litigation
2004	Defendants' Final Invalidity Contentions for U.S. Patent Nos. 8,996,838; and 9,524,974 (highlighted by Patent Owner)
2005	Declaration of T. William Kennedy Jr.
2006	Affidavit of Service

I. INTRODUCTION

Under the Interim Director Discretionary Process, Patent Owner Palisade Technologies, LLP (“Patent Owner”) respectfully requests that the Director exercise his discretion to deny institution of *inter partes* review under 35 U.S.C. § 314(a).

Interim Director Stewart’s March 26, 2025, Memorandum titled “Interim Processes for PTAB Workload Management” (“Process Memo”), states that, in addition to the discretionary considerations set forth in existing Board precedent (e.g., *Fintiv*) and the Consolidated Trial Practice Guide (Nov. 2019), the Director will take into account “all relevant considerations,” including but not limited to the strength of the unpatentability challenge, the extent of the petitioner’s reliance on expert testimony, settled expectations of the parties, and the ability of the PTAB to comply with its statutory deadlines. Process Memo at 2-3. Given the circumstances outlined below, discretionary denial is warranted based on the *Fintiv* factors and those other relevant considerations.

First, settled expectations warrant denial. The patent-at-issue in this proceeding, U.S. Patent No. 9,524,974 (the “’974 patent”), issued on December 20, 2016, allowing expectations to settle for over eight years and nine months before Micron filed the Petition.

Second, Petitioners have not sought a stay. And even if Petitioners did so, the district court is unlikely to grant one.

Third, the timing of the trial (the “District Court Proceeding”) between Patent Owner and the Petitioners also warrants denial. The District Court Proceeding, which will decide the validity of the challenged patent, is scheduled to begin on October 5, 2026, over six months before the April 22, 2027, expected date of the Board’s final written decision.

Fourth, this proceeding is not a true alternative to the District Court Proceeding. The District Court Proceeding involves system prior art and many combinations of that system prior art with printed publications, none of which Petitioners have stipulated to forego in the District Court Proceeding. And only three of the five asserted patents in the District Court Proceeding currently stand challenged by IPR. For the other two Asserted Patents, the Board discretionarily denied their respective *inter partes* review petitions and the Director denied their requests for Director Review: IPR2025-01008 (’051 Patent); IPR2025-01009 (’314 Patent). Thus, the district court will, at minimum, proceed on two of the Asserted Patents.

Fifth, the validity challenges are weak. Petitioners frequently use expert testimony and the purported knowledge of a POSITA to fill gaps in the references themselves.

Sixth, the district court and the parties have already invested significant time and resources, and they will continue to do so until the expected institution date.

And seventh, the Petitioners are also Defendants in the District Court Proceeding.

II. BACKGROUND OF THE DISTRICT COURT PROCEEDING

On October 16, 2024, Patent Owner filed its complaint in the District Court Proceeding accusing Petitioners Micron Technology, Inc. and Micron Semiconductor Products, Inc. (collectively, “Petitioners” or “Micron”) of infringing the ’974 Patent.¹ Ex. 2001. The district court issued its schedule on April 4, 2025. Ex. 2002. Trial in the District Court Proceeding is scheduled to begin on October 5, 2026 (Ex. 2002 at 5), over six months before the projected deadline for the Board’s final written decision on April 22, 2027.

III. DISCRETIONARY DENIAL IS WARRANTED

A. The settled expectations favor discretionary denial.

The Director may consider the “[s]ettled expectations of the parties, such as

¹ That complaint also alleged infringement of four other United States Patents: Nos. 8,148,962 (“’962 patent”); 8,996,838 (“’838 patent”); 8,327,051 (“’051 patent”); and 9,281,314 (“’314 patent”) (collectively, with the patent in this proceeding, the “Asserted Patents”). Petitioners previously challenged two of the Asserted Patents in *inter partes* review petitions IPR2025-01008 (’051 Patent); IPR2025-01009 (’314 Patent). The Board discretionarily denied those petitions, and the Director denied Micron’s request for Director Review of those decisions.

the length of time the claims have been in force.” Process Memo at 2. The ’974 Patent issued on December 20, 2016, allowing expectations to settle for over eight years before the Petition was filed. That significantly exceeds other timeframes that the Board has found to create “strong settled expectations.”

The Board has found strong settled expectations for patents that have been in force for as little as six and seven years. *See, e.g., Apple Inc. v. Advanced Coding Technologies LLC*, IPR2025-00984, Paper 10 (PTAB Oct. 3, 2025) at 2 (“the challenged patents have been in force for seven, six, and thirteen years, creating settled expectations for Patent Owner”); *Be Smarter, LLC et al. v. Yonder, Inc.*, IPR2025-00970, Paper 14 (PTAB Sep. 26, 2025) at 2 (“the challenged patent has been in force for approximately eight years, creating settled expectations for Patent Owner”); *Smartsky Networks LLC v. Gogo Business Aviation LLC*, IPR2025-00672, Paper 10 (PTAB July 31, 2025) at 2 (“the challenged patent has been in force for seven years, creating strong settled expectations”) (emphasis added); *Tanklogix, LLC v. Sitepro, Inc.*, IPR2025-00647-653, Paper 10 (PTAB July 31, 2025) at 3 (“the challenged patents have been in force for seven, eleven, and nine years, respectively, creating strong settled expectations for Patent Owner”) (emphasis added).

B. *Fintiv* Factor 1 - Petitioners have not sought a stay, and a stay is unlikely to be granted.

This factor weighs against institution because the Petitioners waited until their last opportunity, i.e. three days before their 12-month deadline from service in the District Court Proceeding, to file their Petition. Ex. 2006 (affidavit of service

occurring on Oct. 18, 2024); Petition (filed Oct. 15, 2025). Petitioners have not requested a stay, presumably because the district court is unlikely to grant one. Petitioners know that unlikelihood firsthand, given that the same district court recently denied Petitioners' motion to stay in another case. *Sonrai Memory Ltd. v. Micron Tech., Inc.*, No. 1:23-CV-01407-ADA, 2024 U.S. Dist. LEXIS 231280 (W.D. Tex. May 29, 2024).

The Western District of Texas typically considers three factors when determining whether to grant a stay pending IPR of asserted patents: “(1) whether the stay will unduly prejudice the nonmoving party, (2) whether the proceedings before the court have reached an advanced stage, including whether discovery is complete and a trial date has been set, and (3) whether the stay will likely result in simplifying the case before the court.” *Id.* at *3-4. For the District Court Proceeding, the Western District of Texas is likely to find that each of those factors weighs against a stay.

For the first factor (prejudice to the non-moving party), the district court is likely to find prejudice to Patent Owner for several reasons, including (1) that a “stay risks the loss of testimonial and documentary evidence potentially valuable” to Patent Owner (*id.* at *4); (2) the length of the stay, which would likely “extend[] to the conclusion of any appeals from the Micron IPRs” (*id.*); (3) “because IPRs have limited scope—only patentability based on published prior art—and even more

limited discovery” (*id.* at 5); and (4) that Patent Owner “has an interest in the timely enforcement of its patent rights” (*id.*).

In addition, because the PTAB has not decided whether to institute this IPR, the district court is also likely to find that a stay would unduly prejudice Patent Owner under the first factor. *See, e.g., Datanet LLC v. Dropbox Inc.*, No. 6:22-CV-01142-OLG-DTG, 2023 U.S. Dist. LEXIS 230030, at *6-7 (W.D. Tex. Dec. 28, 2023) (distinguishing other cases where institution had already occurred from the case-at-issue, “where it is unknown whether an IPR will even be instituted,” and finding “that granting a stay motion on the current record would unduly prejudice” Patent Owner).

As the district court stated for the first factor: “[t]his Action is slated to resolve all the patent disputes separating the parties—either at the summary judgment stage or trial—before the PTAB adjudicates only invalidity based only on prior-art publications. The Court sees little sense in putting off trial in favor of a lagging, limited adjudication that may not ultimately obviate the need for a jury trial.” *Sonrai*, 2024 U.S. Dist. LEXIS 231280 at *6.

The district court is also likely to find that the second factor weighs against stay. “[I]f protracted and expansive discovery has already occurred, or the court has expended significant resources, then courts have found that this factor weighs against a stay.” *Id.* at *6-7 (quoting *CANVS Corp. v. United States*, 118 Fed. Cl. 587,

595 (2014)). Here, expansive discovery has already occurred, and the district court has expended significant resources deciding Petitioners' three motions, having a claim construction hearing, and issuing a claim construction order. Ex. 2003.

In addition, the second factor also involves whether a trial date has been set. *Sonrai*, 2024 U.S. Dist. LEXIS 231280 at *3-4. Trial is set to begin on October 5, 2026, over six months before the projected deadline for the Board's final written decision on April 22, 2027. For at least those reasons, the second factor also weighs against a stay.

The third factor (simplification of issues) also weighs against a stay. The district court considers the third factor the "most important factor" in the stay analysis and typically weighs two things for it: "(1) the scope of estoppel the movants are bound by and (2) the strength of the relevant IPR petitions in the context of the asserted claims." *Id.* at *7. Because the district court trial is scheduled before the PTAB is expected to issue its final written decision, the district court is likely to find that "the scope of estoppel has minimal impact, if any, on whether a stay will simplify the issues." *Id.* at *8. In addition, as discussed in the "true alternative" section below (Section III.D), "Micron can still challenge in this [district] Court the invalidity of the asserted claims on other grounds, especially those grounds that rely on system prior art, which could not be relied on during IPRs." *Id.* For those reasons, the district court is likely to find that "the potential for simplification of the issues is

low.” *Id.*

And the strength of the relevant IPR petitions in the context of the asserted claims also disfavors stay. For two of the five patents at issue in the District Court Proceeding, the Board has already denied institution of Micron’s IPRs. *See* IPR2025-01008, -01009. Thus, the strength of the IPR petitions in the context of the asserted claims is inherently weak. At least two patents and their asserted claims will survive even if the PTAB institutes all three remaining Micron IPRs and cancels all the challenged claims in those IPRs. And the bellwether of the strength of the IPRs, the institution decisions, has not occurred. *Cf. id.* at *10 (“Micron’s IPR petitions are relatively strong. The PTAB instituted IPR proceedings against every asserted claim ...”). Even so, Micron’s grounds are weak as discussed in Section III.E below and as will be further discussed in Patent Owner’s preliminary response.

For each of these reasons, a stay is unlikely. Accordingly, this factor favors discretionary denial.

C. *Fintiv* Factor 2 - The district court trial date is six months before the Board’s projected statutory deadline.

This factor weighs in favor of denying institution. “If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under *NHK*.” *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (“*Fintiv*”) at 9

(precedential, designated May 5, 2020). Here the district court trial is scheduled to commence on October 5, 2026 (Ex. 2002 at 5), over six months before the projected deadline for the Board's final written decision on April 22, 2027.

The Director has found even shorter gaps between the district court trial and the final written decision to favor discretionary denial. *See Linkplay Tech. Inc. v. Sonos, Inc.*, IPR2025-00509, 510, 511, Paper 10 (PTAB July 31, 2025) at 2 (granting discretionary denial based in part on the trial in the district court proceeding being scheduled two months before the projected final written decision date); *NVIDIA Corp. v. Neural AI, LLC*, IPR2025-00606, 608, Paper 18 (PTAB July 31, 2025) at 2 (granting discretionary denial based in part on the trial in the district court proceeding being scheduled shortly over one month before the projected final written decision date); *Zhuhai Cosmx Battery Co., Ltd. v. Ningde Amperex Tech. Ltd.*, IPR2025-00385, 389, 405, 431, 432, Paper 9 (PTAB July 2, 2025) at 2 (discretionary denial favored where the projected due date for the final written decision was August 2026, whereas trial in the parallel district court proceeding was scheduled for July 2026).

Even before the Process Memo, the Board found this factor favored denial in cases in which a trial date was scheduled one to two months before the final written decision. *See EClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10 (PTAB Apr. 13, 2022) at 9 (finding this factor weighed somewhat in favor of

discretionary denial and denying institution where “the beginning of the jury trial in the WDTX Cases is roughly one to two months before any final decision would have been due had *inter partes* review been instituted”); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 (PTAB May 13, 2020) at 13 (finding this factor weighed somewhat in favor of discretionary denial and denying institution where the district court trial was scheduled to occur approximately two months before the deadline for the Board to reach a final written decision).

Because trial in the District Court Proceeding is scheduled to begin over six months before the projected deadline for the Board’s final written decision if *inter partes* review is instituted, this factor weighs in favor of denial. *See Google LLC v. Cerence Operating Co.*, IPR2024-01465, Paper 15 (PTAB April 23, 2025) (“*Google-Cerence*”) at 9 (“Because the District Court Litigation will address the issues relating to the validity of the [challenged] patent in a trial scheduled to occur several months before we would issue a final written decision, we weigh the second *Fintiv* factor as favoring discretionary denial.”).

D. *Fintiv* Factor 4 – The IPR is not a “true alternative” to the District Court Proceeding.

This factor weighs in favor of discretionary denial because Petitioners have not filed a *Sotera* stipulation. Even if Petitioners later file a *Sotera* stipulation, it will not ensure that the IPR proceedings would be a “true alternative” to the District Court Proceeding. Petitioners only have live IPRs against three of the five patents in

the District Court Proceeding. And “Petitioner’s invalidity arguments in the district court are more expansive and include” system prior art and “combinations of the prior art asserted in these proceedings with unpublished system prior art, which Petitioner’s stipulation is not likely to moot.” *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 (PTAB March 28, 2025) (“*Motorola Solutions*”) at 4. In short, this IPR proceeding would not be a “true alternative” to the District Court Proceeding. *See id.* at 3-4.

All references relied upon in the Petition are also relied upon by Petitioners in the district court. *See* Ex. 2004 at 33 (table of “Prior Art Patents” to the ’974 Patent).

Invalidity Assertions in the Litigation (Ex. 2004 at 42-46)	Invalidity Assertions in the Petition
<u>Matsuno</u> alone or in combination with one or more of Lee; Hong; Haller; Pan; <u>Zhang</u> ; Kwak; Min; <u>Kao</u> ; Yang; Chandra Sekar; Goldman; SanDisk’s NAND; and Himeno.	<u>Ground 1</u> : Claims 1-2, 4, 12, and 15 is obvious over <u>Matsuno</u> (Ex-1005). <u>Ground 2</u> : Claims 6, 11, and 16 are obvious over Matsuno in view of <u>Zhang</u> (Ex-1006). <u>Ground 3</u> : Claims 13-14 and 17-18 are obvious over Matsuno in view of <u>Kao</u> (Ex-1007).
<u>Kwak</u> alone or in combination with one or more of Lee; Hong; Haller; Matsuno; <u>Zhang</u> ; Min; <u>Kao</u> ; Yang;	<u>Ground 4</u> : Claims 1-2, 4, 11-12, and 15 are obvious over <u>Kwak</u> (Ex-1008).

Chandra Sekar; Goldman; SanDisk's NAND; and Himeno.	<u>Ground 5</u> : Claims 6 and 16 are obvious over Kwak in view of <u>Zhang</u> . <u>Ground 6</u> : Claims 13-14 and 17 are obvious over Kwak in view of <u>Kao</u> .
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Even if Petitioners file their typical Sotera stipulation, that stipulation does not ensure that this proceeding would be a “true alternative” because the product and system art would remain at issue in the District Court Proceeding. Petitioners’ typical stipulation only states that, if the Petition is instituted and not later vacated, Petitioners “will not pursue as to the challenged claims any ground raised or that could have been reasonably raised in the IPR in the above-captioned district court case”. *See, e.g.*, IPR2025-01008, Petitioners’ *Sotera* Stipulation, Ex. 1034 at 0002. Yet Petitioners’ invalidity contentions assert a prior art system (i.e., “SanDisk’s NAND”) that it alleges to render obvious, in combination with other references, the asserted claims of the ’974 Patent. *See generally* Ex. 2004 at 34, 36-47 (showing SanDisk’s NAND as secondary references to Lee, Hong, Haller, Pan, Matsuno, Zhang, Kwak, Min).

The language of Petitioners’ typical stipulation is deliberately intended to leave those combinations of publications with prior systems at issue in the District Court Proceeding. As the Board has previously held, “[c]ritically, the district court invalidity contentions also assert combinations of product art with printed

publication prior art asserted in this proceeding.” *Samsung Electronics Co., Ltd. v. Sionyx, LLC*, IPR2025-00064, Paper 15 (“*Sionyx*”) (PTAB June 6, 2025) at 14. In that case, the Board held that “Petitioner’s Stipulation does not moot these district court invalidity contentions because these contentions could not have been asserted in the Petition (because these involve product art but *inter partes* review can only be based on ‘prior art consisting of patents or printed publications (35 U.S.C. § 311(b)).’” *Id.* at 14-15. Petitioners will undoubtedly argue in the District Court Proceeding that its combinations of publications and systems fall outside of any estoppel or its typical stipulation not to pursue “any ground raised or that could have been reasonably raised in the IPR.”

In addition, Petitioners only have live IPR petitions against three of the five patents asserted in the District Court Proceeding. Accordingly, even if the IPRs result in cancelling all of the claims of the ’974, ’838, and ’962 Patents (the presently challenged patents), the district court would still need to proceed on the other two asserted patents whose IPRs have been discretionarily denied.

The district court will address the same validity issues raised by the Petition (and more) before the Board is scheduled to reach a final decision if *inter partes* review is instituted. The Board should not use its resources to redo the work of another tribunal regarding the same issues. Accordingly, this factor weighs strongly in favor of denial. *See Sionyx* at 14-15.

E. *Fintiv* Factor 6 – The weakness of the validity challenges favors exercising discretion.

The Process Memo identifies “the strength of the unpatentability challenge” as a relevant consideration. Process Memo, 2. This consideration favors discretionary denial because Petitioners’ patentability challenges are weak. Patent Owner’s preliminary response will identify specific weaknesses in the Petition. But as a preview, Petitioners assert six grounds, none of which are anticipation grounds. *See, e.g.*, Petition at 9. Petitioners’ failure to identify any anticipatory art serves as an initial indication of the weaknesses of the Petition’s merits.

In addition, the Petition is particularly weak because it frequently resorts to filling holes in the disclosure of the references themselves with expert testimony about what a person of ordinary skill in the art “would have known” or “would have understood.” For example, for the Matsuno grounds for claim 1, the Petitioner argues that “[a]lthough silicon substrate 1 is not shown, a POSITA would have understood silicon oxide film 7 extends over silicon (semiconductor) substrate 1,” by relying on Petitioners’ expert declaration (citing “Ex-1002, ¶73”). Petition at 24 (emphasis added). As another example, for Matsuno Ground 2 (for claim 16), Petitioner makes the following conclusory statement: “[a] POSITA would have understood that after planarization, caps are formed from the metal layer that preserve the air gaps,” again citing Petitioners’ expert declaration (Ex-1002, ¶123). Petition at 52. These kinds of statements pervade the Petition. *See, e.g.* Petition at

57-58 (repeatedly relying on Petitioners' expert's characterizations of what a POSITA would have done or known in an attempt to meet claim 13); *id.* at 59 ("As explained previously, a POSITA would have known to use different materials for the sidewall spacer and the liner layer.") (citing Ex-1002, ¶¶132, 134); *id.* at 61 (repeatedly relying on Petitioners' expert's conclusory opinions about what a POSITA would have known or understood); *id.* at 64 (relying on Petitioners' expert's conclusory opinions about what a POSITA would have understood); *id.* at 35, 68-69, 71-73, 79, 87, 92, 94-96, 98.

In her July 31, 2025, Memorandum, Interim Director Stewart recognized the problem with using expert testimony and general declarations about what a person of ordinary skill purportedly would know. Specifically, doing such violates 37 C.F.R. § 42.104(b)(4), which requires that "[t]he petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon." Director Stewart explained that "enforcement of Rule 104(b)(4) means that applicant admitted prior art (AAPA), expert testimony, common sense, and other evidence that is not 'prior art consisting of patents or printed publications' (collectively, 'general knowledge') may not be used to supply a missing claim limitation." July 31 Memorandum at 1 (emphasis added).

Here, Petitioners rely extensively on such expert testimony and general knowledge, such that every ground for every challenged claim is affected, either

directly or because of claim dependency. “The extent of the petition’s reliance on expert testimony” is an enumerated consideration set forth in the Process Memo. Since that memorandum issued, the Office has further explained:

extensive reliance on expert testimony and/or reasonable disputes between experts on dispositive issues may suggest that the questions are better resolved in an Article III court.... As the judges have technical and legal expertise, it is not necessary for an expert to explain every aspect of the prior art. It is most helpful if an expert is providing focused testimony, for example to provide helpful context or to explain terms of art. The failure to provide focused expert testimony may weigh against institution.

FAQs for Interim Processes for PTAB Workload Management, at #22 (published Apr. 25, 2025), <https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management>. Petitioners’ heavy reliance on expert testimony thus presents questions that are better resolved in an Article III court.

F. *Fintiv* Factor 3 – The district court and the parties have heavily invested time and resources in the District Court Proceeding and will continue to do so before the anticipated institution date.

This factor asks the Director to “consider [] the amount and type of work that the court and the parties will have completed in the parallel litigation by the time of [an] institution decision.” *See Google-Cerence*, Paper 15 at 9. It “is related to the

trial date factor, in that more work completed by the parties and court in the parallel proceeding tends to support the arguments that the parallel proceeding is more advanced, a stay may be less likely, and instituting would lead to duplicative costs.” *Fintiv*, Paper 11 at 10. This factor weighs in favor of discretionary denial.

The district court and the parties have already invested significant time and resources into the District Court Proceeding. The parties have exchanged infringement contentions and invalidity contentions. Ex. 2002 at 1-2. This weighs in favor of denial. *See Motorola Solutions* at 3 (holding that this factor strongly favors denial because, among other things, “the parties had served extensive infringement and invalidity contentions”).

The magistrate judge in district court issued its claim construction order after the parties’ briefing and in-person hearing. Ex. 2003 at 17 (Dkt. Nos. 81, 87-90, 92, 93).

Discovery opened over two months ago, on October 2, 2025 (Ex. 2002 at 3), and substantial discovery has already taken place. Ex. 2005 at ¶ 3. Micron and Patent Owner each served initial disclosures on October 2, 2025. *Id.* at ¶ 4. Micron and Patent Owner collectively served 109 requests for production on October 2, 2025, and both parties served objections and responses to those requests on November 3, 2025. *Id.* at ¶ 5.

Micron served thirteen interrogatories on October 2, 2025, and Patent Owner

provided its responses on November 3, 2025. *Id.* at ¶ 6. Patent Owner served seventeen interrogatories on October 2, 2025, and Micron provided its responses on November 3, 2025. *Id.*

In addition, the parties served and answered nine venue interrogatories and nineteen requests for production on venue in May and June 2025. *Id.* at ¶ 7. And Micron presented four 30(b)(6) witnesses related to its venue motion in June and July 2025 (*Id.* at ¶ 7), which favors discretionary denial. *See Motorola Solutions* at 3 (holding this factor strongly favors denial because, among other things, the parties had “conducted several depositions.”).

Micron issued four third party subpoenas on November 5, 2025. *Id.* at ¶ 8. And the parties have produced over 21,639 pages of documents related to venue, prior art, and technical documentation. *Id.*

Patent Owner also has conducted substantial review of Micron’s source code, design files and related information, having sent two subject-matter experts to review materials Micron made available on a secure terminal at its headquarters on two different occasions. *Id.* at ¶ 9.

Micron has filed three motions in the District Court Proceeding: a motion to dismiss (Dkt. No. 24), motion to strike infringement contentions (*see* Dkt. No. 53 (order)) and a motion to transfer (Dkt. No. 41). Ex. 2003.

The magistrate judge issued a report and recommendation on the motion to

dismiss on July 24, 2025. *Id.* (Dkt. No. 55). The district court judge adopted that report and recommendation on August 15, 2025. *Id.* (Dkt. No. 79). The magistrate judge issued an order on the motion to strike infringement contentions on June 27, 2025. *Id.* (Dkt. No. 53). And the magistrate judge denied Micron’s motion to transfer on September 29, 2025. *Id.* (Dkt. No. 91).

By the anticipated time of an institution decision (April 22, 2026), the parties and court will have invested even more of their resources into the District Court Proceeding. Fact discovery will have been open for almost 6 months and will be one week from closing. Ex. 2002.

Given the substantial time and effort the parties and the district court have already invested in the District Court Proceeding, and the additional investment they will make before an institution decision is expected, this factor weighs in favor of denial.

G. *Fintiv* Factor 5 – The Petitioners are also defendants in the District Court Proceeding.

Petitioners Micron Technology, Inc. and Micron Semiconductor Products, Inc. are defendants the District Court Proceeding. Ex. 2001. Accordingly, this factor weighs in favor of denying institution. *See SAP America, Inc. v. Cyandia, Inc.*, IPR2024-01496, Paper 13 (PTAB April 7, 2025) at 9 (“The fact that Petitioner is also the defendant in the Litigation weighs in favor of discretionarily denying institution.”).

IV. CONCLUSION

For the reasons above, Patent Owner respectfully requests that the Director exercise discretion and deny institution of *inter partes* review.

Dated: December 22, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing was served on December 22, 2025, to Lead and Back-up Counsel for Petitioner at the service email addresses provided in the Petitioners: jkappos@omm.com; vzhou@omm.com; bhabber@omm.com; tfink@omm.com; preinbold@omm.com; OMMPALISADEMICRON@omm.com.

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CERTIFICATE OF COMPLIANCE

The undersigned certifies that this document complies with the type-volume limitations set forth in 37 C.F.R. § 42.24 *et seq.* This document contains no more than 20 pages excluding the caption page, tables of contents and authorities, exhibit list, signature, and certificates.

/s/ David T. DeZern
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