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9 *Micron Consumer Products Group, LLC*

10 UNITED STATES DISTRICT COURT  
11 NORTHERN DISTRICT OF CALIFORNIA  
12 SAN FRANCISCO DIVISION

13 YANGTZE MEMORY TECHNOLOGIES  
14 COMPANY, LTD.,

15 Plaintiff,

16 v.

17 MICRON TECHNOLOGY, INC., et al.,

18 Defendants.

19 MICRON TECHNOLOGY, INC.,

20 Counterclaim Plaintiff,

21 v.

22 YANGTZE MEMORY TECHNOLOGIES  
23 COMPANY, LTD., and YANGTZE  
24 MEMORY TECHNOLOGIES, INC.,

25 Counterclaim Defendants.

Case No. 3:23-cv-05792-RFL

**MTI'S UNOPPOSED MOTION TO  
MODIFY THE CASE SCHEDULE TO  
PERMIT MTI TO REASSERT  
COUNTERCLAIMS**

**REDACTED – PUBLIC VERSION**

**DEMAND FOR JURY TRIAL**

Date: March 11, 2025  
Time: 10:00 a.m. PT  
Judge: Hon. Rita F. Lin  
Courtroom: 15, 18<sup>th</sup> Floor

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**NOTICE OF MOTION AND MOTION**

PLEASE TAKE NOTICE that on March 11, 2025 at 10:00 am in the courtroom of the Honorable Rita F. Lin, 450 Golden Gate Avenue, Courtroom 15, 18th Floor, San Francisco, California, Defendant and Counterclaim plaintiff Micron Technology, Inc. (“MTI”) and defendant Micron Consumer Products Group, LLC (collectively, “Micron”) hereby move the Court under Fed. R. Civ. P. Rule 16(b)(4) to modify the case schedule to permit MTI to file Second Amended Counterclaims.

Plaintiff and Counterclaim defendant Yangtze Memory Technologies Company, Ltd. (“YMTC”) and Counterclaim defendant Yangtze Memory Technologies, Inc. (collectively, “YMTC Entities”) do not oppose this Motion and consent to MTI filing its Second Amended Counterclaims.

This Motion is based on this Notice of Motion and Motion, the Memorandum of Points and Authorities below, the Declaration of J. Jason Lang (“Lang Decl.”) filed concurrently herewith, the pleadings and papers on file in this case, and any other matters of which the Court may take judicial notice.

**MEMORANDUM OF POINTS AND AUTHORITIES**

**I. INTRODUCTION**

On February 16, 2024, MTI asserted patent infringement counterclaims against the YMTC Entities based on five MTI patents. Dkt. 35. On March 12, 2024, the YMTC Entities moved to dismiss those counterclaims based on MTI’s alleged failure to plead marking and post-complaint infringing activity. Dkt. 49. The YMTC Entities repeatedly represented to this Court that they were no longer committing infringing activity in the United States, *i.e.*, post-complaint activity. For example, the YMTC Entities stated that “Micron knows that YMTC/YMTI are not selling the accused 3D NAND products in the U.S. (or otherwise engaging in conduct that would infringe).” Dkt. 53 at 1. In short, the YMTC Entities represented to the Court that MTI had no basis to assert infringement theories that require post-complaint infringement.

While the motion was under submission, the YMTC Entities made their L.R. 3-4(d) production, which requires “[d]ocuments sufficient to show the sales, revenue, cost, and profits for

1 accused instrumentalities ... for any period of alleged infringement.” *See* N.D. Cal. Patent L.R. 3-  
2 4(d). Although this production [REDACTED]  
3 [REDACTED], it did not disclose any post-complaint sales or  
4 importations of the accused products in the United States. Nor did it disclose any sales or  
5 importations of a particular accused product type, namely, its 232-Layer 3D NAND memory  
6 products.

7 On July 16, 2024, the Court dismissed MTI’s counterclaims with leave to amend. Dkt. 78.  
8 On August 1, 2024—in reliance on the YMTC Entities’ representations to the Court and their Patent  
9 L.R. 3-4(d) production—MTI amended its counterclaims, dropping three patents and its allegation  
10 of willful infringement. Without the ability to show that YMTC engaged in infringing activity in  
11 2024, MTI could not allege infringement as to apparatus claims that it practiced or willfulness under  
12 the Court’s order of dismissal. And without documents showing that YMTC had imported 232-  
13 Layer 3D NAND memory products into the United States, MTI had to drop its infringement  
14 allegations against 232-Layer products as well.

15 [REDACTED]  
16 [REDACTED]  
17 [REDACTED]  
18 [REDACTED]  
19 [REDACTED]  
20 [REDACTED]

21 From December 2024 to the filing this Motion, MTI has acted diligently to request relief.  
22 [REDACTED] and then meeting and conferring with the  
23 YMTC Entities’ counsel, MTI timely brings this Motion seeking leave to modify the schedule to  
24 amend its counterclaims to reassert the three patents that it dropped and to reassert its willfulness  
25 claim in view of its reliance on the YMTC Entities’ misstatements about their infringing activity  
26 and their incomplete Patent L.R. 3-4(d) production. The YMTC Entities do not oppose this Motion.  
27 The parties agree that no other adjustment to Court’s schedule is necessary.

1           **II.           STATEMENT OF ISSUES TO BE DECIDED**

2           Given that (1) MTI was diligent in seeking leave to amend the case schedule after learning  
3 that YMTC’s representations that it was not currently engaging in infringing activity were incorrect  
4 and that YMTC withheld disclosure of such activity, (2) YMTC does not oppose MTI’s motion,  
5 and (3) MTI’s amendments will not impact the case schedule, should the Court modify the case  
6 schedule to allow MTI to amend its counterclaims to reassert the three patent infringement  
7 counterclaims and the willfulness claim that it dropped in reliance on YMTC’s statements and  
8 Patent Local Rule production?

9           **III.           STATEMENT OF FACTS**

10           On February 16, 2024, MTI asserted patent infringement counterclaims against the YMTC  
11 Entities for their infringement of U.S. Patent Nos. 10,475,737 (the “’737 patent”), 8,945,996 (the  
12 “’996 patent”), 8,803,214 (the “’214 patent”), 10,872,903 (the “’903 patent”), and 10,373,974 (the  
13 “’974 patent”) (collectively, the “Originally Asserted MTI Patents”). Dkt. 35. MTI based these  
14 counterclaims on information in public sources about the YMTC Entities’ infringing activities  
15 related to their 128-layer and 232-layer 3D NAND products (“128-Layer Products” and “232-Layer  
16 Products,” respectively). *Id.* ¶¶ 14-21. MTI alleged that the YMTC Entities, both individually and  
17 together as a joint enterprise: (1) directly infringed at least by importing the 128-Layer and 232-  
18 Layer Products into the United States, (2) infringed by making the 128-Layer and 232-Layer  
19 Products overseas and importing them into the United States, and (3) willfully infringed MTI’s  
20 patents. *Id.* ¶¶ 14-83.

21           On March 12, 2024, the YMTC Entities moved the Court to dismiss MTI’s counterclaims.  
22 Dkt. 49. Notably, the YMTC Entities repeatedly represented that they were no longer committing  
23 infringing activity in the United States. For example, the YMTC Entities stated that “Micron knows  
24 that YMTC/YMTI are not selling the accused 3D NAND products in the U.S. (or otherwise  
25 engaging in conduct that would infringe).” Dkt. 53 at 1. The YMTC Entities further argued that  
26 MTI “cannot plausibly support a claim for infringement in 2024—particularly given ... the ‘export  
27 bans’ imposed on YMTC in 2022 that have effectively prevented YMTC from undertaking U.S.-  
28 based commercial activity.” *Id.* at 2. And the YMTC Entities asserted that “as Micron knows,

1 YMTC’s 2022 addition to the Entity List effectively prevented [YMTC’s] ability to do business  
2 here.” *Id.* at 3 n.4.

3 While YMTC’s motion to dismiss was pending, on June 27, 2024, the YMTC Entities made  
4 their Patent L.R. 3-4(d) production. Patent L.R. 3-4(d) required that the YMTC Entities produce  
5 “[d]ocuments sufficient to show the sales, revenue, cost, and profits for accused instrumentalities  
6 ... for any period of alleged infringement.” Patent L.R. 3-4(d). [REDACTED]

7 [REDACTED]  
8 [REDACTED] See YMTC-MICRON\_0009683.  
9 [REDACTED]  
10 [REDACTED]

11 On the July 16, 2024, the Court dismissed all of MTI’s counterclaims. Dkt. 78. The Court  
12 based its decision on two grounds that are relevant here. First, the Court found that MTI’s “factual  
13 allegations do not provide a sufficient basis for the Court to plausibly infer that Yangtze Memory  
14 was selling, offering to sell, importing, or using the accused products in the United States, let alone  
15 that Yangtze Memory did so or was likely to do so after February 16, 2024.” Dkt. 78 at 3. Second,  
16 the Court found that MTI had not alleged that it marked its products, which meant that MTI had to  
17 plausibly allege post-complaint (post February 16, 2024) infringing acts. *Id.* at 2. The Court  
18 dismissed MTI’s counterclaims with leave to amend. *Id.* at 5.

19 In view of YMTC’s representations and its Patent L.R. 3-4(d) production, MTI could only  
20 assert: (1) apparatus patents that MTI did not practice (and thus no marking obligation would apply)  
21 and (2) patents that cover methods of making the accused products (and thus no marking obligation  
22 would apply). [REDACTED]  
23 [REDACTED]

24 On August 1, 2024—in reliance on the YMTC Entities’ representations to the Court and  
25 their Patent L.R. 3-4(d) production—MTI amended its counterclaims, dropping three Originally  
26 Asserted MTI Patents and all its allegations against YMTC’s 232-Layer products. Specifically,  
27 MTI amended its counterclaims to assert infringement against YMTC’s 128-Layer products (1)  
28 only under Section 271(g) for the ’996 patent (as there is no marking requirement), and (2) only

1 under Section 271(a) for the '903 patent (as MTI was able to allege compliance with any marking  
2 obligations for that patent). Dkt. 93; *see also* Dkt. 110 (answering, as opposed to moving to dismiss,  
3 MTI's First Amended Counterclaims). For the '737, '214, and '974 patents, however, MTI was  
4 unable to assert similar infringement theories. In short, without being able to allege current  
5 infringing activities, MTI had no choice but to drop these three patents as well as its allegations  
6 that YMTC willfully infringed.

7 Subsequently, MTI discovered evidence suggesting that the YMTC Entities' production of  
8 sales and importation information was incomplete. After much correspondence and meeting and  
9 conferring, on October 4, 2024, Micron moved to compel YMTC to produce information and  
10 documents related to its importation, sales, offers for sale, sampling, testing, qualification, and  
11 related activities in the U.S. *See* Dkt. 147. On October 18, 2024, the Court ordered YMTC to  
12 produce information and documents related to YMTC's manufacturing, worldwide sales,  
13 importation, intercompany transfers, prototyping, testing, qualification, marketing, and related  
14 activity. *See* Dkt. 163 at 1-7.

15 As demonstrated below, YMTC's belated Court-ordered productions reveal that YMTC's  
16 representations to the Court about its infringing activities were incorrect and that its earlier  
17 disclosures about its sales and importation activities were, at best, incomplete.

18 [REDACTED]

19 [REDACTED]

20 [REDACTED]

21 [REDACTED]

22 [REDACTED]

23 [REDACTED]

24 [REDACTED]

25 Ex. A.

26 [REDACTED]

27 [REDACTED]

28 [REDACTED]

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[REDACTED]

YMTC-MICRON\_0010167 (truncated). [REDACTED]  
[REDACTED] See YMTC-  
MICRON\_0010851 [REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]

<sup>1</sup> See YMTC-MICRON\_0010551, 10583-84; YMTC-MICRON\_0010851. For the products to be added to the NVMe Integrator’s List, YMTC needed to import the products into the United States for validation and testing.<sup>2</sup>

**IV. LEGAL STANDARD**

“[C]ircuits have consistently held that the requirements of both Rule 16 and Rule 15 must be met” when a party files a “motion seeking leave to amend filed after the scheduling order deadline has passed.” STEVEN S. GENSLER, FEDERAL RULES OF CIVIL PROCEDURE, RULES AND COMMENTARY at 539 (2024).

Under Federal Rule of Civil Procedure 16(b)(4), “[a] schedule may be modified only for good cause and with the judge’s consent.” Fed. R. Civ. P. 16(b)(4). “The good cause standard primarily considers the diligence of the party seeking the amendment.” *Kamal v. Eden Creamery*,

<sup>1</sup> <https://www.iol.unh.edu/registry/nvme>  
<sup>2</sup> <https://nvmexpress.org/education/faqs/>

1 *LLC*, 88 F.4th 1268, 1277 (9th Cir. 2023) (internal citation removed). “Though prejudice to the  
 2 opposing party is relevant, diligence is Rule 16(b)’s primary focus.” *Srigley v. Monterey Peninsula*  
 3 *Yacht Club, Inc.*, No. 22-CV-01589-PCP, 2024 WL 4143590, at \*1 (N.D. Cal. Sept. 11, 2024)  
 4 (citing *Johnson v. Mammoth Recreations, Inc.*, 975 F.2d 604, 609 (9th Cir. 1992)). For example,  
 5 a court in this District held that good cause to amend a scheduling order exists where a party  
 6 discovered new information and filed its motion to modify a month later. *See Synchronoss Techs.,*  
 7 *Inc. v. Dropbox Inc.*, No. 16-CV-00119-HSG, 2019 WL 95927, at \*1 (N.D. Cal. Jan. 3, 2019);<sup>3</sup>  
 8 *M.H. v. Cty. of Alameda*, No. 11-2868 CW, 2012 WL 5835732, at \*3 (N.D. Cal. Nov. 16, 2012)  
 9 (“Courts routinely allow parties to amend their pleadings after new information comes to light  
 10 during discovery.”); *see also Lyon v. U.S. Immigr. & Customs Enf’t*, 308 F.R.D. 203, 216 (N.D.  
 11 Cal. 2015) (“[C]ourts often find good cause when the motion to amend the scheduling order is  
 12 based upon new and pertinent information.”); *Ivy v. Mayet*, No. 14-CV-04879-HSG, 2015 WL  
 13 8641144, at \*2 (N.D. Cal. Dec. 14, 2015) (finding good cause exists when a party moves for leave  
 14 to file amended pleadings two months after learning of new information); *Fru-Con Constr. Corp.*  
 15 *v. Sacramento Mun. Util. Dist.*, No. CIV.S-05-583LKK/GGH, 2006 WL 3733815, at \*5 (E.D. Cal.  
 16 Dec. 15, 2006) (finding good cause where Defendant sought leave to amend pleading two months  
 17 after learning new information through discovery); *Fujitsu Ltd. v. Nanya Tech. Corp.*, No. C 06-  
 18 6613 CW, 2008 WL 962146, at \*2 (N.D. Cal. Apr. 8, 2008) (finding good cause to amend more  
 19 than one year after the amendment deadline because discovery revealed new information); *Finjan,*  
 20 *Inc. v. Blue Coat Sys. Inc.*, No. 13-cv-03999-BLF, 2014 WL 6626227, at \*1-2 (N.D. Cal. Nov. 20,  
 21 2014) (finding good cause to amend nine months after the amendment deadline because defendants  
 22 could not have uncovered new facts underlying their new asserted defenses before the deadline).

23 Under Federal Rule of Civil Procedure 15(a)(2), “a party may amend its pleading [] with  
 24 the opposing party’s written consent.” Fed. R. Civ. P. 15(a)(2). “Where the opposing party  
 25 consents to the filing of an amended pleading, the amendment should be allowed.” *Atlas v. Arnold,*  
 26

27 <sup>3</sup> Dropbox filed its motion on August 6, 2018, after Synchronoss disclosed new information that  
 28 formed the basis for the motion in a 10-K filing on July 2, 2018. Ex. C (*Synchronoss Techs.,*  
*Inc. v. Dropbox, Inc.*, Case No. 16-cv-00119-HSG-KAW, Dkt. 198 (Aug. 6, 2018)).

1 No. CV 15-01504 RSWL (RAO), 2016 WL 11521727, at \*3 (C.D. Cal. Oct. 31, 2016) (citing *Fern*  
 2 *v. U.S.*, 213 F.2d 674, 677 (9th Cir. 1954)).

3 **V. THE COURT SHOULD GRANT MTI LEAVE TO FILE SECOND AMENDED**  
 4 **COUNTERCLAIMS**

5 **A. There Is Good Cause To Amend The Scheduling Order Under Rule 16**

6 Good cause exists to amend the Scheduling Order (Dkt. 141) to permit MTI to file its  
 7 Second Amended Counterclaims (reasserting three Originally Asserted MTI Patents and its  
 8 willfulness claim) because (1) MTI only dropped those patents due YMTC's incorrect  
 9 representations and YMTC's incomplete production, and (2) MTI acted diligently in seeking leave  
 10 after discovering YMTC's misrepresentations. In addition, YMTC consents to MTI's amendment,  
 11 and the amendment will not otherwise affect the schedule. MTI is attaching a redline of the  
 12 proposed Second Amended Counterclaims to this motion. *See* Ex. B. The Second Amended  
 13 Counterclaims only reassert the three dropped patents, reassert MTI's claims for willful  
 14 infringement, and add factual pleadings as to the YMTC Entities' post-complaint sales. *Id.*

15 **First**, as Section III demonstrated in detail, MTI dropped the three patents from its  
 16 counterclaims based on the YMTC Entities' representations about its infringing activities and their  
 17 production pursuant to Patent L.R. 3-4(d). Specifically, MTI relied on YMTC's statements that it  
 18 had not sold or imported any 232-Layer products in the United States and that it had not sold or  
 19 imported any 128-Layer or 232-Layer products in the United States after MTI filed its  
 20 counterclaims in February 2024. For example, the YMTC Entities stated that "Micron knows that  
 21 YMTC/YMTI are not selling the accused 3D NAND products in the U.S. (or otherwise engaging  
 22 in conduct that would infringe)." Dkt. 53 at 1. Consistent with these statements, the YMTC  
 23 Entities' Patent L.R. 3-4(d) production did not include any recent infringing activity or any activity  
 24 relating to its 232-layer 3D products. Based on the YMTC Entities' statements and production,  
 25 MTI had no basis—at that time—to maintain three infringement counterclaims or its willful  
 26 infringement claim. Dkt. 93.

27 **Second**, as demonstrated in Section III, after a Court order compelling production from  
 28 YMTC, the YMTC Entities began to produce information and documents in late December 2024

1 [REDACTED]  
2 [REDACTED] MTI

3 has acted diligently since then, including investigating those productions, conferring with YMTC,  
4 and filing this Motion on January 29, 2025. Courts commonly find good cause exists under Rule  
5 16 to amend a pleading where a party learns of new supporting facts in discovery and diligently  
6 moves to make amendment accordingly. *See* § IV, *supra*.

7 **Third**, YMTC consents to MTI’s requested amendments, and both parties agree that no  
8 other adjustments to the Court’s case schedule are necessary (other than the modifying the date to  
9 allow MTI to amend its pleadings). This is because MTI has already provided infringement  
10 contentions on these patents, and the YMTC Entities have already provided invalidity contentions.  
11 The opening claim construction briefs are due on March 17, 2025. To the extent that YMTC selects  
12 a term for construction from these three patents, sufficient time exists for the parties to present that  
13 term to the Court in the opening briefs.

14 **B. MTI’s Proposed Amendment Is Permitted Under Rule 15 Because YMTC**  
15 **Provided Written Consent**

16 Under Rule 15, “[w]here the opposing party consents to the filing of an amended pleading,  
17 the amendment should be allowed.” *Atlas*, 2016 WL 11521727, at \*3 (citing *Fern*, 213 F.2d at  
18 677). Here, the YMTC Entities have provided written consent to MTI filing its Second Amended  
19 Counterclaims. Ex. B. Accordingly, Rule 15 permits MTI to file its Second Amended  
20 Counterclaims.

21 **VI. CONCLUSION**

22 For the foregoing reasons, MTI respectfully requests that the Court grant Micron’s motion  
23 and modify the case schedule to permit MTI to file its Second Amended Counterclaims.



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**PROOF OF SERVICE**

I am employed in the County of San Mateo, State of California. I am over the age of 18 years old and not a party to this action. My business address is Orrick, Herrington & Sutcliffe LLP, 1000 Marsh Road, Menlo Park, California 94025. On January 29, 2025, I served the **MTI'S UNOPPOSED MOTION TO MODIFY THE CASE SCHEDULE TO PERMIT MTI TO REASSERT COUNTERCLAIMS [FILED UNDER SEAL]** on all interested parties to this action in the manner described as follows:

- (VIA EMAIL)** On January 29, 2025, via electronic mail in Adobe PDF format the document(s) listed above to the electronic address(es) set forth below.
- (VIA OVERNIGHT-FED EX)** I caused the within document(s) to be delivered by overnight courier to the address(es) set forth below.

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***Counsel for Plaintiff and Counterclaim Defendants, Yangtze Memory Technologies Company, Ltd. and Yangtze Memory Technologies Company, Inc.***

I declare under penalty of perjury that the foregoing is true and correct. Executed on January 29, 2025, at San Jose, California.

/s/ Gabrielle Van Vleck  
 Gabrielle Van Vleck

# **Exhibit A**

**Filed Under Seal**

# **Exhibit B**

**Redacted - Public Version**

1 JARED BOBROW (STATE BAR NO. 133712)  
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 2 JASON LANG (STATE BAR NO. 255642)  
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 8 *Plaintiff Micron Technology, Inc., and Defendant*  
*Micron Consumer Products Group, LLC*

9  
 10 UNITED STATES DISTRICT COURT  
 11 NORTHERN DISTRICT OF CALIFORNIA  
 12 SAN FRANCISCO DIVISION

13 YANGTZE MEMORY TECHNOLOGIES  
 COMPANY, LTD.,

14 Plaintiff,

15 v.

16 MICRON TECHNOLOGY, INC., et al.,

17 Defendants.

Case No. 3:23-cv-05792- RFL

**MTI'S SECOND AMENDED  
 COUNTERCLAIMS**

**REDACTED – PUBLIC VERSION**

**DEMAND FOR JURY TRIAL**

Judge: Hon. Rita F. Lin

19 MICRON TECHNOLOGY, INC.,

20 Counterclaim Plaintiff,

21 v.

22  
 23 YANGTZE MEMORY TECHNOLOGIES  
 COMPANY, LTD., and YANGTZE  
 24 MEMORY TECHNOLOGIES, INC.,

25 Counterclaim Defendants.

1 **MTI'S SECOND AMENDED COUNTERCLAIMS**

2 In accordance with the Court's [DATE] Order (Dkt. No. [ ]), Defendant and Counterclaim  
3 Plaintiff Micron Technology, Inc. ("MTI") hereby submits its counterclaims against Plaintiff and  
4 Counterclaim Defendant Yangtze Memory Technologies Company, Ltd. ("YMTC"), and  
5 Counterclaim Defendant Yangtze Memory Technologies, Inc. ("YMTC Inc."), (collectively the  
6 "YMTC Entities") as follows:

7 **Nature of the Action**

8 1. MTI asserts these patent infringement claims against the YMTC Entities arising  
9 from their infringement of U.S. Patent Nos. 10,475,737 (the "737 patent"), 8,945,996 (the "996  
10 patent"), 8,803,214 (the "214 patent") ~~and~~, 10,872,903 (the "903 patent"), and 10,373,974 (the  
11 "974 patent") (collectively, the "MTI Asserted Patents"). On information and belief, each of the  
12 YMTC Entities has committed the acts of infringement described herein individually and together  
13 as one enterprise.

14 2. MTI also asserts a counterclaim for declaratory judgment of ownership of the U.S.  
15 Patent Nos. 10,879,254 (the "254 patent"), 11,581,322 (the "322 patent"), 10,658,378 (the "378  
16 patent"), 10,937,806 (the "806 patent"), 10,868,031 (the "031 patent"), and 11,468,957 (the "957  
17 patent") ~~patents~~.

18 **The Parties**

19 3. MTI is a Delaware corporation with its principal place of business at 8000 South  
20 Federal Way, Boise, Idaho 83716.

21 4. On information and belief, YMTC is a Chinese company with its principal place of  
22 business at No.88 Weilai 3<sup>rd</sup> Road, East Lake High-tech Development Zone, Wuhan, Hubei, China.

23 5. On information and belief, YMTC Inc. is a California corporation with its principal  
24 place of business at 2953 Bunker Hill Lane, Ste. 206, Santa Clara, California 95054.

25 **Jurisdiction and Venue**

26 6. MTI brings these counterclaims under the Patent Laws of the United States, 35  
27 U.S.C. §§ 1 et seq., and the Declaratory Judgment Act 28 U.S.C. § 2201, *et seq.*, against the YMTC  
28

1 Entities for their infringement of the MTI Asserted Patents and to obtain declaratory relief as to  
2 MTI's ownership of the '254, '322, '378, '806, '031, and '957 patents, respectively.

3 7. This Court has subject matter jurisdiction over MTI's counterclaims pursuant to 28  
4 U.S.C. §§ 1331, 1338(a), and 1367.

5 8. This Court has personal jurisdiction over YMTC, which is the plaintiff in this action.  
6 Further, YMTC has committed acts of infringement in this District through its business and sales  
7 activities in the Northern District of California, including directly and/or indirectly selling, offering  
8 for sale, importing, and/or using products that practice (or are made in a manner that practices) one  
9 or more claims of the MTI Asserted Patents.

10 9. This Court has personal jurisdiction over YMTC Inc., which has its principal place  
11 of business in Santa Clara, California, in this judicial District. Further, YMTC Inc. has committed  
12 acts of infringement in this District through its business and sales activities in the Northern District  
13 of California, including directly and/or indirectly selling, offering for sale, importing, and/or using  
14 products that practice (or are made in a manner that practices) one or more claims of the MTI  
15 Asserted Patents.

16 10. Venue over these counterclaims is proper in this District. YMTC is a foreign  
17 company and filed the underlying lawsuit in this District. ~~YMTC~~ YMTC Inc. resides in this District,  
18 has a regular and established place of business in the District, and has committed acts of  
19 infringement in this District.

20 11. YMTC claims to be the owner by assignment of the entire right, title, and interest  
21 in the '254, '322, '378, '806, '031, and '957 patents.

22 12. An immediate, real, and justiciable controversy exists between MTI and YMTC  
23 with respect to the ownership of the '254, '322, '378, '806, '031, and '957 patents by virtue of  
24 YMTC's claim that MTI infringes the '254, '322, '378, '806, '031, and '957 patents.

25 **MTI's Innovations and Patents**

26 13. MTI was founded in 1978 and is headquartered in Boise, Idaho. Since that time,  
27 MTI has become a world leader in innovative computer-memory and data-storage solutions,  
28

1 employing more than 43,000 employees worldwide with more than 5,000 employees in Idaho. Ex.  
2 1 at 2; Ex. 2 at 5.

3 14. MTI is the only U.S.-based manufacturer of semiconductor memory devices, and its  
4 presence in the U.S. is growing. MTI recently announced plans to invest approximately \$15 billion  
5 through the end of the decade to construct a new memory manufacturing plant in Boise, Idaho and  
6 up to \$100 billion over the next 20-plus years to build a fab near Syracuse, New York. Exs. 3-4.  
7 MTI's commitment to innovation is evident from its expansive patent portfolio that includes over  
8 54,000 patents. Ex 1 at 2.

9 15. For over a decade, MTI has been at the forefront of developing new and innovative  
10 3D NAND memory products. In March 2015, MTI launched its first 3D NAND product, a 32-  
11 layer high density memory chip. Ex. 5. Doing so required years of research and development  
12 before the product launch. These efforts led MTI to file dozens of patents on 3D NAND technology  
13 long before the product launch. Indeed, MTI described innovative 3D NAND arrays in patents it  
14 filed well before 2015. Exs. 6-7.

15 16. Since its initial 3D NAND product launch in 2015, MTI has continued to lead the  
16 world in 3D NAND innovation by developing and offering chips with greater memory capacity and  
17 capabilities. In early 2018, MTI doubled the number of layers in its 3D NAND products, releasing  
18 its 64-layer 3D NAND. Ex. 8. Thereafter, in 2019, MTI sampled its 128-layer 3D NAND (Ex. 9  
19 at 7) and, in 2020, MTI was the first company in the world to launch 176-layer 3D NAND. Ex. 10.  
20 In July 2022, MTI became the first company to scale its 3D NAND technology to 232-layers in  
21 production. Ex. 11. MTI has received numerous awards for and widespread recognition of its  
22 innovative 3D NAND technology. *See, e.g.*, Exs. 12-14.

### 23 **The Accused YMTC Products and the YMTC Entities' Infringing Activities**

24 17. YMTC is a global manufacturer and supplier of 3D NAND memory products.  
25 YMTC was founded in 2016 and is majority-owned by the Chinese government. Ex. 15. YMTC's  
26 founding followed the 2015 announcement of the Made in China 2025 initiative by Chinese  
27 President Xi Jinping. Ex. 16. The Made in China 2025 initiative positioned semiconductors as a  
28 critical growth industry for the Chinese economy. *Id.* The Chinese Government's investment

1 platform for funding the expansion of its semiconductor industry is the National Integrated Circuit  
2 Industry Investment Fund, more commonly known as the “Big Fund.” *Id.*

3 18. Latecomer YMTC has developed four generations of NAND storage devices since  
4 its founding in 2016: a first-generation 3D NAND storage technology incorporating a 32-layer 3D  
5 NAND memory array, a second-generation 3D NAND storage technology incorporating at least a  
6 64-layer 3D NAND memory array, a third-generation 3D NAND storage technology incorporating  
7 at least a 128-layer 3D NAND memory array, and a fourth generation 3D NAND storage  
8 technology incorporating at least a 232-layer 3D NAND memory array. Ex. 17.

9 19. Unsurprisingly, given MTI’s nearly decade long head start over YMTC into 3D  
10 NAND memory development, the YMTC Entities began to hire NAND engineers from MTI or its  
11 affiliates and has hired at least 20 such engineers to date. Indeed, at least eight of the named  
12 inventors on the YMTC Asserted Patents (*see* Dkt. No. 151) previously worked as engineers on 3D  
13 NAND R&D at ~~Micron-MTI~~ before they filed the YMTC Asserted Patents. Some of these named  
14 inventors are Hongbin Zhu, Qian Tao, Yushi Hu, Jun Liu and Changyun Lee.

15 20. On or around January 9, 2006, MTI hired Hongbin Zhu as an engineer to work at  
16 MTI’s headquarters in Boise, Idaho. In consideration of providing employment to Mr. Zhu, Mr.  
17 Zhu “assign[ed] and agree[d] to assign to [MTI], or its designee, all of [his] right, title and interest  
18 in and to all inventions, discoveries, ideas, processes, works of authorship, mask works, drawings,  
19 logos, developments, concepts, and improvements...whether or not patentable, copyrightable, or  
20 subject to other forms of protection, made, created, developed, written, reduced to practice, or  
21 conceived by [him], in whole or in part, either solely or jointly with others, during the period of  
22 time [he is] in the employ of or providing service to [MTI], whether during or outside of regular  
23 working hours.” Ex. 18 at 1 (Assignment Agreement between Hongbin Zhu and MTI).

24 21. During his 11 years of employment in Boise, Idaho at MTI, Mr. Zhu had access to  
25 information about the development of ~~Micron’s-MTI’s~~ 3D NAND technology, including on the  
26 designs for its 128-Layer and 176-Layer 3D NAND products. Mr. Zhu was also involved with,  
27 worked on, and jointly collaborated with other engineers at ~~Micron-MTI~~ on the development of the  
28 ~~Micron-MTI~~ Accused Products, including on the B27A, B37R and B47R products. Among other

1 things, Mr. Zhu knew about, worked on, and jointly collaborated with other engineers at ~~Micron~~  
2 ~~MTI~~ on alternating multiple-tier stack structures, the formation of channel structures through the  
3 stack, the formation of openings that extend through the stack, spacers on the sidewall of the  
4 openings, through array contacts that bury into the substrate, and slit structures that separate the  
5 memory stack (the slits being formed after through array contacts), at least under YMTC's  
6 construction of its patents. Consequently, per his Assignment Agreement, Mr. Zhu assigned, at  
7 least, any and all of the aforementioned individual and/or joint development work to ~~Micron~~~~MTI~~.  
8 This work is the subject matter of at least claim 1 of the '322 and '254 patents that were later filed  
9 by YMTC.

10 22. Then, on September 18, 2017, after 11 years at MTI, Mr. Zhu left the company. Mr.  
11 Zhu told ~~Micron~~~~MTI~~ on September 15, 2017, that he was leaving ~~Micron~~~~MTI~~ because he needed  
12 to move closer to his aging father. On the same date, he executed a "Separation Statement"  
13 reaffirming his obligations with respect to ~~Micron~~~~MTI~~ confidential information, which stated that  
14 he continued to agree not to use or disclose ~~Micron~~~~MTI~~ confidential information. Based on the  
15 foregoing, and following the closing of its employee termination process, MTI did not have reason  
16 to suspect that Mr. Zhu would utilize joint development work of MTI to apply for patents at a new  
17 employer, did not have reason to monitor Mr. Zhu's post-employment patent activities, and  
18 therefore did not do so.

19 23. After his departure from MTI, Mr. Zhu joined YMTC, where, based on information  
20 and belief, he has served as YMTC's vice president of research and development. On information  
21 and belief, while at YMTC, Mr. Zhu also worked on the development of alternating multiple-tier  
22 stack structures, the formation of channel structures through the stack, the formation of openings  
23 that extend through the stack, spacers on the sidewall of the openings, through array contacts that  
24 bury into the substrate, and slit structures that separate the memory stack (the slits being formed  
25 after the through array contacts), which is the subject matter of at least claim 1 of the '322 and '254  
26 patents that were filed by YMTC.

27 24. On November 21, 2020, YMTC filed Patent Application No. 17/100,847, which  
28 claims priority to PCT/CN2018/101482, filed on August 21, 2018, and issued as the '322 patent on

1 February 14, 2023. The '322 patent names Mr. Zhu as an inventor and claims technologies that  
2 Mr. Zhu learned of and worked on while at ~~Micron~~MTI.

3 25. On January 17, 2020, YMTC filed Patent Application No. 16/745,343, which claims  
4 priority to PCT/CN2018/101482, filed on August 21, 2018, and issued as the '254 patent on  
5 December 29, 2020. The '254 patent names Mr. Zhu as an inventor and claims technologies that  
6 Mr. Zhu learned of and worked on while at ~~Micron~~MTI.

7 26. Another former ~~Micron~~MTI employee who is now a named inventor on YMTC's  
8 Asserted Patents is Qian Tao. On or around June 6, 2011, MTI hired Qian Tao as an engineer to  
9 work at MTI's headquarters in Boise, Idaho. In consideration of providing employment to Mr.  
10 Tao, Mr. Tao "assign[ed] and agree[d] to assign to [MTI], or its designee, all of [his] right, title and  
11 interest in and to all inventions, discoveries, ideas, processes, works of authorship, mask works,  
12 drawings, logos, developments, concepts, and improvements...whether or not patentable,  
13 copyrightable, or subject to other forms of protection, made, created, developed, written, reduced  
14 to practice, or conceived by [him], in whole or in part, either solely or jointly with others, during  
15 the period of time [he is] in the employ of or providing service to [MTI], whether during or outside  
16 of regular working hours." Ex. ~~23-19~~ at 1 (Assignment Agreement between Qian Tao and MTI).

17 27. During his nearly 6 years of employment in Boise, Idaho at MTI, Mr. Tao had access  
18 to information about the development of ~~Micron's~~MTI's 3D NAND technology, including on the  
19 designs for its 64-Layer 3D NAND products. Among other things, Mr. Tao knew about, worked  
20 on, and jointly collaborated with other engineers at ~~Micron~~MTI on alternating multiple-tier stack  
21 and staircase structures, dielectric structures extending through the stack on isolation structures,  
22 through array contacts through the dielectric structure, channel structures, epitaxial layers, etch stop  
23 plugs, and slit structures, at least under YMTC's construction of its patents. Consequently, per his  
24 Assignment Agreement, Mr. Tao assigned at least any and all of the aforementioned individual  
25 and/or joint development work to ~~MTI~~Micron. This work is the subject matter of at least claim 1  
26 of the '378 patent and claim 8 of the '806 patent that were later filed by YMTC.

27 28. Then, on May 2, 2017, after nearly 6 years at MTI, Mr. Tao left the company. MTI  
28 did not have reason to suspect that Mr. Tao would utilize joint development work of MTI to apply

1 for patents at a new employer, did not have reason to monitor Mr. Tao’s post-employment patent  
2 activities, and therefore did not do so.

3 29. After his departure from MTI, Mr. Tao joined YMTC. On information and belief,  
4 while at YMTC, Mr. Tao worked on the development of alternating multiple-tier stack and staircase  
5 structures, dielectric structures extending through the stack on isolation structures, through array  
6 contacts through the dielectric structure, channel structures, epitaxial layers, etch stop plugs, and  
7 slit structures, which is the subject matter of at least claim 1 of the ’378 patent and claim 8 of the  
8 ’806 patent that were filed by YMTC.

9 30. On July 27, 2018, YMTC filed Patent Application No. 16/047,182, which claims  
10 priority to PCT/CN2018/085421, filed on May 3, 2018, and issued as the ’378 patent on May 19,  
11 2020. The ’378 patent names Mr. Tao as an inventor and claims technologies that Mr. Tao learned  
12 of, worked on, and jointly collaborated with other ~~MTIMicron~~ engineers on while at ~~MTIMicron~~.

13 31. On May 5, 2020, YMTC filed Patent Application No. 16/867,404, which claims  
14 priority to Patent Application No. 16/047,182, filed on July 27, 2018, now Patent No. 10,658,378,  
15 which is a continuation of Patent Application No. PCT/CN2018/085421, filed on May 3, 2018, and  
16 issued as the ’806 patent on March 2, 2021. The ’806 patent names Mr. Tao as an inventor and  
17 claims technologies that Mr. Tao learned of, worked on, and jointly collaborated with other  
18 ~~MTIMicron~~ engineers on while at ~~MTIMicron~~.

19 32. Another former ~~MTIMicron~~ employee who is now a named inventor on YMTC’s  
20 Asserted Patents is Yushi Hu. On or around June 27, 2011, MTI hired Yushi Hu as an engineer to  
21 work at MTI’s headquarters in Boise, Idaho. In consideration of providing employment to Mr. Hu,  
22 Mr. Hu “assign[ed] and agree[d] to assign to [MTI], or its designee, all of [his] right, title and  
23 interest in and to all inventions, discoveries, ideas, processes, works of authorship, mask works,  
24 drawings, logos, developments, concepts, and improvements...whether or not patentable,  
25 copyrightable, or subject to other forms of protection, made, created, developed, written, reduced  
26 to practice, or conceived by [him], in whole or in part, either solely or jointly with others, during  
27 the period of time [he is] in the employ of or providing service to [MTI], whether during or outside  
28 of regular working hours.” Ex. 24-20 at 1 (Assignment Agreement between Yushi Hu and MTI).

1           33. During his more than 5 years of employment in Boise, Idaho at MTI, Mr. Hu had  
2 access to information about the development of MTIMicron's 3D NAND technology, including on  
3 the designs for its 32 and 96-Layer 3D NAND products, as well as multi-deck developmental chips  
4 and replacement gate developmental technologies. Among other things, Mr. Hu knew about,  
5 worked on, and jointly collaborated with other engineers at MTIMicron on alternating multiple-tier  
6 staircase structures, insulating fill structures, dual deck structures, through-array contacts, aligned  
7 support pillars, unaligned channel structures, and replacement gate technologies, at least under  
8 YMTC's construction of its patents. Consequently, per his Assignment Agreement, Mr. Hu  
9 assigned at least any and all of the aforementioned individual and/or joint development work to  
10 MTIMicron. This work is the subject matter of at least claim 1 of the '031 patent that was filed by  
11 YMTC.

12           34. Then, on August 12, 2016, after more than 5 years at MTI, Mr. Hu left the company.  
13 MTI did not have reason to suspect that Mr. Hu would utilize joint development work of MTI to  
14 apply for patents at a new employer, did not have reason to monitor Mr. Hu's post-employment  
15 patent activities, and therefore did not do so.

16           35. After his departure from MTI, Mr. Hu joined YMTC. On information and belief,  
17 while at YMTC, Mr. Hu worked on the development of alternating multiple-tier staircase structures,  
18 insulating fill structures, dual deck structures, through-array contacts, aligned support pillars,  
19 unaligned channel structures, and replacement gate technologies, which is the subject matter of at  
20 least claim 1 of the '031 patent that was later filed by YMTC.

21           36. Another former MTIMicron employee who is now a named inventor on YMTC's  
22 Asserted Patents is Jun Liu. On or around September 3, 2002, MTI hired Jun Liu as an engineer to  
23 work at MTI's headquarters in Boise, Idaho. In consideration of providing employment to Mr. Liu,  
24 Mr. Liu "assign[ed] and agree[d] to assign to [MTI], or its designee, all of [his] right, title and  
25 interest in and to all inventions, discoveries, ideas, processes, works of authorship, mask works,  
26 drawings, logos, developments, concepts, and improvements...whether or not patentable,  
27 copyrightable, or subject to other forms of protection, made, created, developed, written, reduced  
28 to practice, or conceived by [him], in whole or in part, either solely or jointly with others, during

1 the period of time [he is] in the employ of or providing service to [MTI], whether during or outside  
2 of regular working hours.” Ex. ~~25-21~~ at 1 (Assignment Agreement between Jun Liu and MTI).

3 37. During his nearly 15 years of employment in Boise, Idaho at MTI, Mr. Liu had  
4 access to information about the development of ~~MTIMicron~~’s 3D NAND technology, including on  
5 the designs for its 96-Layer 3D NAND products. Among other things, Mr. Liu knew about, worked  
6 on, and jointly collaborated with other engineers at ~~MTIMicron~~ on alternating multiple-tier  
7 staircase structures with contacts and through array contacts, dual deck structures, and replacement  
8 gate technologies, at least under YMTC’s construction of its patents. Consequently, per his  
9 Assignment Agreement, Mr. Liu assigned, at least, any and all of the aforementioned individual  
10 and/or joint development work to ~~MTIMicron~~. This work is the subject matter of, at least, claim 1  
11 of the ’031 patent that was filed by YMTC.

12 38. Then, on June 9, 2017, after nearly 15 years at MTI, Mr. Liu left the company. MTI  
13 did not have reason to suspect that Mr. Liu would utilize joint development work of MTI to apply  
14 for patents at a new employer, did not have reason to monitor Mr. Liu’s post-employment patent  
15 activities, and therefore did not do so.

16 39. After his departure from MTI, Mr. Liu joined YMTC. On information and belief,  
17 while at YMTC, Mr. Liu worked on the development of alternating multiple-tier staircase structures  
18 with contacts and through array contacts, dual deck structures, and replacement gate technologies,  
19 which is the subject matter of at least claim 1 of the ’031 patent that was later filed by YMTC.

20 40. On September 10, 2018, YMTC filed Patent Application No. 16/126,919, which  
21 claims priority to PCT/CN2018/097432, filed on July 27, 2018, and issued as the ’031 patent on  
22 December 15, 2020. The ’031 patent names Mr. Hu and Mr. Liu as ~~an~~-inventors and claims  
23 technologies that Mr. Hu and Mr. Liu learned of, worked on, and jointly collaborated with other  
24 ~~MTIMicron~~ engineers on while at ~~MTIMicron~~.

25 41. Another former ~~MTIMicron~~ employee who is now a named inventor on YMTC’s  
26 Asserted Patents is Changhyun Lee. On or around September 14, 2015, MTI hired Changhyun Lee  
27 as an engineer to work at MTI’s headquarters in Boise, Idaho. In consideration of providing  
28 employment to Mr. Lee, Mr. Lee “agree[d] to and do hereby assign to [MTI], or its designee, all of

1 [his] existing and future right, title and interest in and to all Intellectual Property made, created,  
2 developed, written, reduced to practice, or conceived by [him], in whole or in part, either solely or  
3 jointly with others (i) while [he] [is] employed by ~~Micron~~[MTI], whether during or outside of  
4 regular working hours.” Ex. ~~26-22~~ at 3 (Assignment Agreement between Changhyun Lee and  
5 MTI).

6 42. During his more than 4 years of employment in Boise, Idaho at MTI, Mr. Lee had  
7 access to information about the development of ~~MTI~~~~Micron~~’s 3D NAND technology, including on  
8 the designs for its 32 and 64-Layer 3D NAND products, as well as ~~MTI~~~~Micron~~’s development of  
9 access algorithms. Among other things, Mr. Lee knew about, worked on, and jointly collaborated  
10 with other engineers at ~~MTI~~~~Micron~~ on pre-verify and verify stages, along with first and second bias  
11 voltages and first and second bias voltages, at least under YMTC’s construction of its patents.  
12 Consequently, per his Assignment Agreement, Mr. Lee assigned at least any and all of the  
13 aforementioned individual and/or joint development work to ~~MTI~~~~Micron~~. This work is the subject  
14 matter of at least claim 1 of the ’957 patent that was filed by YMTC.

15 43. Then, on October 23, 2019, after more than 4 years at MTI, Mr. Lee left the  
16 company. After his departure from MTI, Mr. Lee joined YMTC. On information and belief, while  
17 at YMTC, Mr. Lee worked on the development of alleged pre-verify and verify stages, along with  
18 first and second bias voltages and first and second bias voltages, which is the subject matter of at  
19 least claim 1 of the ’957 patent that was later filed by YMTC.

20 44. On March 4, 2021, YMTC filed Patent Application No. 17/191,768, which claims  
21 priority to PCT/CN2020/136482, filed on December 15, 2020, and issued as the ’957 patent on  
22 October 11, 2022. The ’957 patent names Mr. Lee as an inventor and claims technologies that Mr.  
23 Lee learned of, worked on, and jointly collaborated with other engineers on while at ~~MTI~~~~Micron~~.

24 45. The YMTC Entities have in the past and continue to directly ~~and/or indirectly used,~~  
25 ~~sell~~~~ed~~, offer~~ed~~ for sale, import~~ed~~, supply~~ied~~, or otherwise distributed~~d~~ into the United States, and  
26 provide~~d~~ support for, their 128-layer 3D NAND storage technology and products containing the  
27 same (collectively, the “YMTC 128L Accused Products”), including the X2-6070 and other  
28 memory chips (and memory products containing the same), such as the [REDACTED]

1 [REDACTED] and PE321 products, that have the same or similar structures, features,  
2 or functionalities, and/or are made by the same or similar Xtacking® 2.0 technology manufacturing  
3 processes, as the aforementioned exemplary product. YMTC makes the YMTC 128L Accused  
4 Products in China. E.g., YMTC-MICRON\_0010167 (listing YMTC products imported into the  
5 United States).

6 46. The YMTC Entities have in the past and continue to directly use, sell, offer for sale,  
7 import, supply, or otherwise distribute into the United States, and provide support for, their 232-  
8 layer 3D NAND storage technology and products containing the same (collectively, the “YMTC  
9 232L Accused Products”), including the X3-9060, X3-9070, X3-6070, X4-6080, and X4-9070 and  
10 other memory chips (and memory products containing the same), such as PC450, PC450\_2242,  
11 PC450\_2280, PC42Q\_2242, PC42Q\_2280, and [REDACTED] that have the same or  
12 similar structures, features, or functionalities, and/or are made by the same or similar Xtacking®  
13 3.0/4.0 technology manufacturing processes, as the aforementioned exemplary product. E.g.,  
14 YMTC-MICRON\_0010167 (listing YMTC products imported into the United States).

15 47. To the extent that a single part number has both a 128L and 232L version, that  
16 product is included under both the definition of YMTC 128L Accused Products and of YMTC  
17 232L Accused Products.

18 48. Upon information and belief, each of the YMTC 128L Accused Products, and  
19 YMTC 232L Accused Products have the same or similar structures, features, or functionalities,  
20 and/or are made by the same or similar manufacturing processes insofar as the structures, features,  
21 functionalities, and/or manufacturing processes of the Accused Products relate to the MTI Asserted  
22 Patents.

23 45-49. The YMTC 128L Accused Products and YMTC 232L Accused Products are  
24 collectively referred to as the “YMTC Accused Storage Products.”

25 46-50. For example, as set forth in YMTC’s Patent Local Rule 3-4 contentions and  
26 accompanying document production (YMTC-MICRON\_0009683), YMTC has imported into  
27 and/or sold in the United States YMTC 128L Accused Products, product numbers  
28 [REDACTED] within the last six years. On

1 information and belief, YMTC imported YMTC 128L Accused Products, including the at least  
2 PE321, after the filing on MTI’s original counterclaims (Dkt. No. 35) on February 16, 2024.<sup>1</sup> As  
3 another example, as set forth in YMTC’s document productions (YMTC-MICRON\_0010167, 551,  
4 583-84, 702, 851; YMTC-MICRON\_0011208-212, 219-223), YMTC has imported into and/or  
5 sold in the United States YMTC 232L Accused Products, including at least product numbers  
6 including X4-6080, X4-9070, PC450, PC450\_2242, PC450\_2280, PC42Q\_2242, PC42Q\_2280,  
7 and [REDACTED] within the last six years and/or after the filing of MTI’s original  
8 counterclaims (Dkt. No. 35) on February 16, 2024.

9 47. — On information and belief, YMTC controls and has controlled YMTC Inc.

10 51. —

11 — YMTC admits that it is “dedicated to the development of memory products for the  
12 global market” and that it “maintains ties to Silicon Valley through a wholly-owned subsidiary,  
13 Yangtze Memory Technologies, Inc.” Dkt. No. 29 ¶ 24.

14 52. —

15 **Counterclaim I**

16 **(Infringement of U.S. Patent No. 10,475,737)**

17 53. — MTI restates and incorporates by reference its allegations in Paragraphs 1 through  
18 52 of its Counterclaims.

19 54. — MTI, owns all right, title, and interest, including the right to recover damages for  
20 past, present, and future infringement, in and to U.S. Patent No. 10,475,737, entitled “Stack of  
21 horizontally extending and vertically overlapping features, methods of forming circuitry  
22 components, and methods of forming an array of memory cells.” A true and correct copy of the  
23 ’737 patent is attached as Ex. 23.

24 55. — The ’737 patent was duly and legally issued by the United States Patent and  
25 Trademark Office on Nov. 12, 2019.

26 56. — The YMTC Entities have infringed and are infringing at least claims 1-7, 9, 10-12,  
27 14, 15, 18, 20, 21, and 22 of the ’737 patent under 35 U.S.C. § 271(a), literally and/or under the

28 <sup>1</sup> <https://www.iol.unh.edu/registry/nvme>

1 doctrine of equivalents, by using, offering for sale, selling, and/or importing into the United States,  
2 without authorization, the YMTC Accused Storage Products.

3 57. The YMTC Accused Storage Products practice each and every limitation of at least  
4 claims 1-7, 9, 10-12, 14, 15, 18, 20, 21, and 22 of the '737 patent. Claim charts providing examples  
5 of how the YMTC Accused Storage Products practice the foregoing claims are attached as Exs. 24  
6 and 25 hereto and are incorporated by reference herein.

7 58. Since the filing of MTI's February 16, 2024, Answer to First Amended Complaint  
8 and Counterclaims (Dkt. No. 35), the YMTC Entities' infringement has been willful.


9 48-59. As a result of YMTC Entities' infringement of the '737 patent, MTI is entitled to  
10 monetary damages in an amount adequate to compensate for YMTC Entities' infringement, but in  
11 no event less than a reasonable royalty for the use made of the invention by the YMTC Entities,  
12 together with interest and costs as fixed by the Court.

13  
14 **Counterclaim II**  
15 **(Infringement of U.S. Patent No. 8,945,996)**

16 49-60. MTI restates and incorporates by reference its allegations in Paragraphs 1 through  
17 48-6059 of its Counterclaims.

18 50-61. MTI, owns all right, title, and interest, including the right to recover damages for  
19 past, present, and future infringement, in and to U.S. Patent No. 8,945,996, entitled "Methods of  
20 forming circuitry components and methods of forming an array of memory cells." A true and  
21 correct copy of the '996 patent is attached as Ex. ~~hibit~~ 264.

22 51-62. The '996 patent was duly and legally issued by the United States Patent and  
23 Trademark Office on Feb. 3, 2015.

24 52-63. The YMTC Entities have infringed and are infringing at least claims 1-4, 6-10, 12,  
25 13, 16-18, 23-26, 28, 30, and 32 of the '996 patent under 35 U.S.C. § 271(g), literally and/or under  
26 the doctrine of equivalents, by directly or indirectly importing into the United States at least the  
27 YMTC Accused Storage Products ~~YMTC 128L Accused Products, including at least product~~  
28 numbers  which are made outside the

1 United States using the patented processes of at least the foregoing claims, are not materially  
2 changed by subsequent processes, and are not a trivial and nonessential component of another  
3 product.

4 53-64. The YMTC Accused Storage Products~~YMTC 128L Accused Products~~ are made  
5 with, used to perform, and/or practice each and every limitation of at least claims 1-4, 6-10, 12, 13,  
6 16-18, 23-26, 28, 30, and 32 of the '996 patent. ~~A~~Claim charts providing examples of how the  
7 YMTC Accused Storage Products~~YMTC 128L Accused Products~~ practice the foregoing claims ~~is~~  
8 are attached as ~~Exs.~~Exhibits 20-27 and 28 hereto and ~~is~~are incorporated by reference herein.

9 54-65. YMTC makes the YMTC Accused Storage Products~~YMTC 128L Accused Products~~  
10 in China in accordance with the methods claimed in at least claims 1-4, 6-10, 12, 13, 16-18, 23-26,  
11 28, 30, and 32 of the '996 patent.

12 66. Since the filing of MTI's February 16, 2024, Answer to First Amended Complaint  
13 and Counterclaims (Dkt. No. 35), the YMTC Entities' infringement has been willful.

14 55-67. As a result of the YMTC Entities' infringement of the '996 patent, MTI is entitled  
15 to monetary damages in an amount adequate to compensate for the YMTC Entities' infringement,  
16 but in no event less than a reasonable royalty for the use made of the invention by the YMTC  
17 Entities, together with interest and costs as fixed by the Court.

18  
19 **Counterclaim III**

20 **(Infringement of U.S. Patent No. 8,803,214)**

21 68. MTI restates and incorporates by reference its allegations in Paragraphs 1 through  
22 67 of its Counterclaims.

23 69. MTI, owns all right, title, and interest, including the right to recover damages for  
24 past, present, and future infringement, in and to U.S. Patent No. 8,803,214, entitled "Three  
25 dimensional memory and methods of forming the same." A true and correct copy of the '214 patent  
26 is attached as Ex. 29.

27 70. The '214 patent was duly and legally issued by the United States Patent and  
28 Trademark Office on Aug. 12, 2014.



1 by using, offering for sale, selling, and/or importing into the United States, without authorization,  
2 the YMTC 128L Accused Products, ~~including at least product numbers YMN09TC1B1JC6C\_000~~  
3 ~~and YMN09TC1B1HC6C\_000.~~

4 ~~62-79.~~ The YMTC 128L Accused Products ~~are used to perform and/or~~ practice each and  
5 every limitation of at least claims 1-3, 5, 7-9, and 17-20- of the '903 patent. A claim chart providing  
6 examples of how the YMTC 128L Accused Products practice each limitation of at least the  
7 foregoing claims is attached as Ex. ~~hibit 22~~ 33 hereto and is incorporated by reference herein.

8 ~~63-80.~~ There are no marking requirements with which ~~MTIMicron~~ and its licensees have  
9 not complied for the period before February 2, 2024. ~~MTIMicron~~ has not made, used, sold, offered  
10 for sale, or imported into the United States any “patented articles” under the '903 patent. Moreover,  
11 on information and belief, prior to February 2, 2024, none of ~~MTIMicron~~'s licensees made, used,  
12 sold, offered for sale, or imported into the United States any “patented articles” under the '903  
13 patent.

14 81. The YMTC Entities had actual notice of their infringement of the '903 patent on  
15 February 16, 2024, the date ~~MTIMicron~~ filed its Answer to First Amended Complaint and  
16 Counterclaims (Dkt. No. 35).

17 ~~64-82.~~ Since the filing of MTI's February 16, 2024, Answer to First Amended Complaint  
18 and Counterclaims (id.), the YMTC Entities' infringement has been willful.

19 ~~65-83.~~ As a result of the YMTC Entities' infringement of the '903 patent, MTI is entitled  
20 to monetary damages in an amount adequate to compensate for the YMTC Entities' infringement,  
21 but in no event less than a reasonable royalty for the use made of the invention by the YMTC  
22 Entities, together with interest and costs as fixed by the Court.

23  
24 **Counterclaim V**

25 **(Infringement of U.S. Patent No. 10,373,974)**

26 **(Infringement of U.S. Patent No. 10,373,974)**

27 84. MTI restates and incorporates by reference its allegations in Paragraphs 1 through  
28 83 of its Counterclaims.

1           85. MTI, owns all right, title, and interest, including the right to recover damages for  
2 past, present, and future infringement, in and to U.S. Patent No. 10,373,974, entitled  
3 “Microelectronic devices and related methods.” A true and correct copy of the ’974 patent is  
4 attached as Ex. 34.

5           86. The ’974 patent was duly and legally issued by the United States Patent and  
6 Trademark Office on Aug. 6, 2019.

7           87. The YMTC Entities have infringed and are infringing at least claims 1, 4, and 5 of  
8 the ’974 patent under 35 U.S.C. § 271(a), literally and/or under the doctrine of equivalents, by  
9 using, offering for sale, selling, and/or importing into the United States, without authorization, the  
10 YMTC Accused Storage Products.

11           88. The YMTC Entities have infringed and are infringing at least claims 7, 9, and 11-  
12 19 of the ’974 patent under 35 U.S.C. § 271(g), literally and/or under the doctrine of equivalents,  
13 by directly or indirectly importing into the United States at least the YMTC Accused Storage  
14 Products, which are made outside the United States using the patented processes of at least the  
15 foregoing claims, are not materially changed by subsequent processes, and are not a trivial and  
16 nonessential component of another product.

17           89. YMTC makes the YMTC Accused Storage Products in China in accordance with  
18 the methods claimed in at least claims 7, 9, and 11-19 of the ’974 patent.

19           90. The YMTC Accused Storage Products are made with, used to perform, and/or  
20 practice each and every limitation of at least claims 7, 9, and 11-19 of the ’974 patent. Claim charts  
21 providing examples of how the YMTC Accused Storage Products practice the foregoing claims are  
22 attached as Ex. 35 and 36 hereto and are incorporated by reference herein.

23           66.—Since the filing of MTI’s February 16, 2024, Answer to First Amended Complaint  
24 and Counterclaims (Dkt. No. 35), the YMTC Entities’ infringement has been willful.

25           91.

26           —As a result of YMTC Entities’ infringement of the ’974 patent, MTI is entitled to  
27 monetary damages in an amount adequate to compensate for YMTC Entities’ infringement, but in  
28

1 no event less than a reasonable royalty for the use made of the invention by the YMTC Entities,  
2 together with interest and costs as fixed by the Court.

3 67-92.

4  
5 **Counterclaim ~~II~~VI**  
6 **(Declaratory Judgment of Ownership of the '322 patent)**

7 68-93. MTI restates and incorporates by reference its allegations in Paragraphs 1 through  
8 63-92 of its Counterclaims.

9 69-94. MTI is the true owner of the '322 patent by virtue of the assignment agreement  
10 entered into between Hongbin Zhu, one of the named inventors on the '322 patent, and MTI.  
11 Hongbin Zhu assigned all right, title and interest in the claimed invention that is the subject matter  
12 of at least claim 1 of the '322 patent to MTI during his employment at MTI. His assignment  
13 predates the priority date of the '322 patent. Ex. 18.

14 70-95. MTI holds equitable title to the '322 patent.

15 71-96. As such, MTI seeks declaratory relief that it is the sole and exclusive owner of the  
16 '322 patent or, in the alternative, that it owns a pro rata undivided interest in the '322 patent, and  
17 seeks transfer of legal title from YMTC to MTI.

18  
19 **Counterclaim ~~IV~~VII**  
20 **(Declaratory Judgment of Ownership of the '254 patent)**

21 72-97. MTI restates and incorporates by reference its allegations in Paragraphs 1 through  
22 67-96 of its Counterclaims.

23 73-98. MTI is the true owner of the '254 patent by virtue of the assignment agreement  
24 entered into between Hongbin Zhu, one of the named inventors on the '254 patent, and MTI.  
25 Hongbin Zhu assigned all right, title and interest in the claimed invention that is the subject matter  
26 of at least claim 1 of the '254 patent to MTI during his employment at MTI. His assignment  
27 predates the priority date of the '254 patent. Ex. 18.

28 74-99. MTI holds equitable title to the '254 patent.

1 ~~75-100.~~As such, MTI seeks declaratory relief that it is the sole and exclusive owner of the  
2 '254 patent or, in the alternative, that it owns a pro rata undivided interest in the '254 patent, seeks  
3 transfer of legal title from YMTC to MTI.

4 **Counterclaim VIII**  
5 **(Declaratory Judgment of Ownership of the '378 patent)**

6 ~~76-101.~~MTI restates and incorporates by reference its allegations in Paragraphs 1 through  
7 ~~71-100~~ of its Counterclaims.

8 ~~77-102.~~MTI is the true owner of the '378 patent by virtue of the assignment agreement  
9 entered into between Qian Tao, one of the named inventors on the '378 patent, and MTI. Qian Tao  
10 assigned all right, title and interest in the claimed invention that is the subject matter of at least  
11 claim 1 of the '378 patent to MTI during his employment at MTI. His assignment predates the  
12 priority date of the '378 patent. Ex. 19.

13 ~~78-103.~~MTI holds equitable title to the '378 patent.

14 ~~79-104.~~As such, MTI seeks declaratory relief that it is the sole and exclusive owner of the  
15 '378 patent or, in the alternative, that it owns a pro rata undivided interest in the '378 patent, seeks  
16 transfer of legal title from YMTC to MTI.

17  
18 **Counterclaim VIII**  
19 **(Declaratory Judgment of Ownership of the '806 patent)**

20 ~~80-105.~~MTI restates and incorporates by reference its allegations in Paragraphs 1 through  
21 ~~75-104~~ of its Counterclaims.

22 ~~81-106.~~MTI is the true owner of the '806 patent by virtue of the assignment agreement  
23 entered into between Qian Tao, one of the named inventors on the '806 patent, and MTI. Qian Tao  
24 assigned all right, title and interest in the claimed invention that is the subject matter of at least  
25 claim 8 of the '806 patent to MTI during his employment at MTI. His assignment predates the  
26 priority date of the '806 patent. Ex. 19.

27 ~~82-107.~~MTI holds equitable title to the '806 patent.  
28



1 ~~91.116.~~As such, MTI seeks declaratory relief that it is the sole and exclusive owner of the  
2 '957 patent or, in the alternative, that it owns a pro rata undivided interest in the '957 patent, seeks  
3 transfer of legal title from YMTC to MTI.

4 **DEMAND FOR A JURY TRIAL**

5 Defendants and counterclaim plaintiff request a jury trial on all issues related to YMTC's  
6 claims and MTI's counterclaims that are so triable.

7 **PRAYER FOR RELIEF**

8 WHEREFORE, ~~having fully answered,~~ Micron prays that the Court enter judgment as  
9 follows:

10 A. A judgment in favor of Micron and against YMTC on all of YMTC's claims,  
11 including a dismissal with prejudice of all of YMTC's claims;

12 B. A judgment declaring that Micron has not infringed, contributed to the infringement  
13 of, or induced others to infringe, either directly or indirectly, literally or under the doctrine of  
14 equivalents, any valid claims of the YMTC Asserted Patents (under 35 U.S.C. §§271 and 273);

15 C. A judgment declaring that the YMTC Asserted Patents are invalid;

16 D. A judgment declaring that this YMTC's case against Micron is exceptional and an  
17 award to Micron of its reasonable costs and expenses of litigation, including attorneys' fees and  
18 expert witness fees;

19 E. A judgment declaring that YMTC lacks standing to assert the '254, '322, '378, '806,  
20 '031, and '957 patents;

21 F. A judgment declaring that YMTC is estopped from asserting the '254, '322, '378,  
22 '806, '031, and '957 patents;

23 G. A judgment in favor of MTI and against the YMTC Entities on all of MTI's  
24 Counterclaims;

25 H. A judgment in favor of MTI that the YMTC Entities have infringed, either literally  
26 and/or under the doctrine of equivalents, one or more claims of each of the MTI Asserted Patents;

1 H.I. A judgment in favor of MTI that the YMTC Entities’ infringement has been willful  
2 since the filing of MTI’s February 16, 2024, Answer to First Amended Complaint and  
3 Counterclaims;

4 I.J. An order pursuant to 35 U.S.C. § 283 enjoining the YMTC Entities and their  
5 subsidiaries, parents, divisions, affiliates, successors, assigns, transferees, officers, directors,  
6 attorneys, agents, servants, employees, privies, and all other persons in active concert or  
7 participation with any of the foregoing, from continued acts of infringement of the claims of the  
8 MTI Asserted Patents;

9 J.K. A judgment and order requiring the YMTC Entities to pay MTI its damages, costs,  
10 expenses, and pre-judgment and post-judgment interest for the YMTC Entities’ infringement;

11 K.L. If a permanent injunction is not granted, then a judicial determination of the  
12 conditions for the YMTC Entities future infringement, such as an ongoing royalty;

13 L.M. A judgment declaring that MTI is the sole and exclusive owner of all right, title and  
14 interest in the ’254, ’322, ’378, ’806, ’031, and ’957 patents;

15 M.N. A judgment compelling YMTC to transfer legal title of the ’254, ’322, ’378, ’806,  
16 ’031, and ’957 patents to MTI;

17 N.O. A judgment declaring that MTI’s case against the YMTC Entities is exceptional and  
18 an award to MTI of its reasonable costs and expenses of litigation, including attorneys’ fees and  
19 expert witness fees;

20 O.P. All other relief that the Court deems just and proper.

21  
22 Dated: January 29, 2025

ORRICK, HERRINGTON & SUTCLIFFE LLP

23  
24 By: /s/ Jared Bobrow  
Jared Bobrow

25  
26 *Attorneys for Defendant and Counterclaim*  
27 *Plaintiff Micron Technology, Inc., and Defendant*  
28 *Micron Consumer Products Group LLC*

# **Exhibit C**

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DAVID M. KRINSKY (*pro hac vice*)  
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CHRISTOPHER J. MANDERNACH (*pro hac vice*)  
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17 Attorneys for Defendant DROPBOX, INC.

18 **IN THE UNITED STATES DISTRICT COURT**

19 **NORTHERN DISTRICT OF CALIFORNIA**

20 **OAKLAND DIVISION**

21 SYNCHRONOSS TECHNOLOGIES, INC.,

22 Plaintiff,

23 v.

24 DROPBOX, INC.,

25 Defendant.

No. 4:16-cv-00119-HSG-KAW

**DROPBOX, INC.'S NOTICE OF MOTION  
AND MOTION TO MODIFY THE  
SCHEDULING ORDER AND FOR  
LEAVE TO FILE A FIRST AMENDED  
ANSWER**

26 Date: September 27, 2018

27 Time: 2:00 PM

Place: Courtroom 2, 4th Floor (Oakland)

Judge: Hon. Haywood S. Gilliam, Jr.

28 **PUBLIC REDACTED VERSION**

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 2 308 F.R.D. 203 (N.D. Cal. 2015).....4, 5  
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 4 No. 11-2868 CW, 2012 WL 5835732 (N.D. Cal. Nov. 16, 2012).....5  
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 8 324 U.S. 806 (1945).....6, 7  
 9 *Thomas v. San Francisco Travel Ass'n,*  
 10 No. 14-CV-03043-YGR, 2016 WL 861239 (N.D. Cal. Mar. 7, 2016).....4  
 11 *Ultimax Cement Mfg. Corp. v. CTS Cement Mfg. Corp.,*  
 12 587 F.3d 1339 (Fed. Cir. 2009).....4  
 13 *United States v. Corinthian Colls.,*  
 14 655 F.3d 984 (9th Cir. 2011) .....4  
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17 **OTHER AUTHORITIES**

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1 orchestrated an effort to artificially inflate the value of its patents by entering into licenses that  
2 were not an “objective” measure of the value of the licensed rights.

3 On July 2, 2018, in its delayed 10-K filing for 2017, Synchronoss publicly admitted that  
4 its lump-sum licenses did not have economic substance independent of the acquisitions. Instead,  
5 each was executed as part of, and virtually simultaneously with, transactions in which  
6 Synchronoss *purchased the licensee or the licensee’s cloud-related assets*. Far from arms-length  
7 transactions, these were part of transactions in which Synchronoss bought the alleged “licensee”  
8 thereby rendering the allegedly independent licensing transaction moot. In a press release  
9 accompanying its 10-K filing, Synchronoss stated:

10 The company identified and corrected errors related to fees received under license  
11 agreements entered into with parties of certain historical acquisitions and a divestiture. In  
12 each case, we had originally treated the license agreement as a separate transaction and  
13 recorded the license fees as revenue. The company has determined to revise the  
14 accounting treatment of such license arrangements to record the license fees as part of the  
15 accounting for the acquisition or divestiture. Accordingly, this revenue has been reversed  
16 in the company’s restated financials and will not be recognized as revenue in subsequent  
17 periods.

18 Mandernach Decl., Ex. 2, at 6-7 (Synchronoss Press Release). Synchronoss further described in  
19 its 10-K filing specific licenses that are asserted in this litigation, as follows:

20 In connection with the acquisition of Openwave, the Company entered into \$10.0 million  
21 patent settlement agreement. The Company determined that the transaction was  
22 negotiated in the overall consideration paid for the purchase of Openwave, and as result,  
23 the proceeds were reflected as a reduction in the Company’s purchase price.

24 \* \* \*

25 On February 18, 2015, the Company entered into a patent license and settlement  
26 agreement for \$10.0 million, whereby the Company granted F-Secure a limited license to  
27 the Company’s patents. The Company concluded that since the settlement and the  
28 acquisition were contemplated and negotiated together, the Company determined to net  
the \$10.0 million settlement against the consideration transferred in connection with the  
purchase price, resulting in purchase price of \$49.5 million.

Mandernach Decl., Ex. 3, at 134, 137 (Excerpts from Synchronoss 2017 10-K Filing).

The license-then-buy scheme that Synchronoss disclosed in its 10-K filing appears to  
have been used with other licensees as well. For instance, documents recently produced by a

1 third party indicate that Synchronoss' [REDACTED] license, with Newbay Software Limited  
2 and Research in Motion Limited, was also procured using a similar license-then-buy approach.

3 [REDACTED]  
4 [REDACTED]  
5 [REDACTED]  
6 [REDACTED]  
7 [REDACTED]  
8 [REDACTED] The [REDACTED] was  
9 illusory; it yielded no net payment to Synchronoss, but appears to have been included for purely  
10 optical reasons. Indeed, [REDACTED]

11 [REDACTED]  
12 [REDACTED]  
13 [REDACTED]  
14 [REDACTED]  
15 Moreover, Synchronoss' royalty-based licenses also appear to be designed to create the  
16 illusion of value. For example, [REDACTED]

17 [REDACTED]  
18 [REDACTED]  
19 [REDACTED]  
20 [REDACTED]  
21 [REDACTED]  
22 [REDACTED] Again, Synchronoss appears to have orchestrated a licensing term to artificially inflate  
23 the value of the patents-in-suit.

24 On August 3, 2018, Synchronoss served its Supplemental Disclosure of Damages  
25 Contentions Under Patent Local Rule 3-8. In those supplemental contentions, Synchronoss

26 [REDACTED]  
27 [REDACTED]  
28 [REDACTED]

1 [REDACTED]

2 [REDACTED]

3 **II. LEGAL STANDARD**

4 Regional circuit law governs motions for leave to amend. *Ultimax Cement Mfg. Corp. v.*  
5 *CTS Cement Mfg. Corp.*, 587 F.3d 1339, 1354 (Fed. Cir. 2009). In the Ninth Circuit, if the  
6 scheduling order’s deadline to file for leave to amend pleadings has passed, the party seeking  
7 leave to amend must satisfy the requirements of Rule 16(b) and Rule 15(a) of the Federal Rules  
8 of Civil Procedure. *Ellis v. Advanta Bank*, No. 16-CV-06437-BLF, 2017 WL 4842069, at \*2  
9 (N.D. Cal. Oct. 26, 2017); *see also Johnson v. Mammoth Recreations, Inc.*, 975 F.2d 604, 608  
10 (9th Cir. 1992).

11 Under Rule 16(b), the party seeking leave “must show good cause for not having  
12 amended their [pleadings] before the time specified in the scheduling order expired.” *Coleman*  
13 *v. Quaker Oats Co.*, 232 F.3d 1271, 1294 (9th Cir. 2000). “The ‘good cause’ standard primarily  
14 considers the diligence of the party seeking the amendment.” *Lyon v. U.S. Immigration &*  
15 *Customs Enf’t*, 308 F.R.D. 203, 216 (N.D. Cal. 2015) (citing *Johnson*, 975 F.2d at 609). “[T]he  
16 focus of the inquiry is upon the moving party’s reasons for seeking modification.” *C.F. ex rel.*  
17 *Farnan v. Capistrano Unified Sch. Dist.*, 654 F.3d 975, 984 (9th Cir. 2011) (internal quotation  
18 marks omitted).

19 If good cause is found, “the Court may then consider whether leave to amend should be  
20 granted pursuant to Rule 15(a).” *Thomas v. San Francisco Travel Ass’n*, No. 14-CV-03043-  
21 YGR, 2016 WL 861239, at \*2 (N.D. Cal. Mar. 7, 2016). A party may amend under Rule 15(a) if  
22 it obtains the opposing party’s written consent or the court’s leave to amend. Fed. R. Civ. P.  
23 15(a)(2). “The court considers five factors in assessing the propriety of leave to amend—bad  
24 faith, undue delay, prejudice to the opposing party, futility of amendment, and whether the  
25 plaintiff has previously amended the [pleading].” *United States v. Corinthian Colls.*, 655 F.3d  
26 984, 995 (9th Cir. 2011). “Absent prejudice, or a strong showing of any of the remaining . . .  
27 factors, there exists a presumption under Rule 15(a) in favor of granting leave to amend.”  
28 *Eminence Capital, LLC v. Aspeon, Inc.*, 316 F.3d 1048, 1052 (9th Cir. 2003) (emphasis omitted).

1 Indeed, Rule 15 explicitly instructs courts to “freely give leave when justice so requires.” Fed.  
2 R. Civ. P. 15(a)(2). And under Ninth Circuit law, “Rule 15’s policy of favoring amendments to  
3 pleadings should be applied with extreme liberality.” *DCD Programs, Ltd. v. Leighton*, 833 F.2d  
4 183, 186 (9th Cir. 1987) (internal quotation marks omitted); *see also Griggs v. Pace Am. Grp.,*  
5 *Inc.*, 170 F.3d 877, 880 (9th Cir. 1999) (stating that the court must determine whether to grant  
6 leave with “all inferences in favor of granting the motion”).

### 7 **III. ARGUMENT**

#### 8 **A. Dropbox Has Good Cause to Allow for Amendment under Rule 16.**

9 Dropbox has “good cause” under Rule 16 to submit an Amended Answer that includes an  
10 unclean hands defense. Despite document requests pending for more than eighteen months,  
11 Synchronoss did not disclose the factual developments upon which Dropbox’s motion to amend  
12 is predicated—the orchestrated effort to artificially inflate the value of the Patents-in-Suit—until  
13 July 2, 2018 in its 10-K filing. And because Synchronoss did not produce any documents to  
14 Dropbox on this topic, Dropbox lacked sufficient basis to amend its Answer until after Dropbox  
15 learned of Synchronoss’ 10-K filing. Thus, Dropbox could not have moved to amend its  
16 complaint to include the unclean hands defense contained in its Proposed Amended Answer until  
17 well after the Court’s pleading deadline of January 19, 2018, had already passed. *See Johnson,*  
18 *975 F.2d at 609* (holding that a district court may permit amendment “if [the pretrial schedule]  
19 cannot reasonably be met despite the diligence of the party seeking the extension”). Dropbox  
20 filed this motion within weeks of learning of the factual predicate for its defense. *M.H. v. Cty. of*  
21 *Alameda*, No. 11-2868 CW, 2012 WL 5835732, at \*3 (N.D. Cal. Nov. 16, 2012) (“Courts  
22 routinely allow parties to amend their pleadings after new information comes to light during  
23 discovery.”); *see also Lyon*, 308 F.R.D. at 216 (“[C]ourts often find good cause when the motion  
24 to amend the scheduling order is based upon new and pertinent information.”). Dropbox thus  
25 has “good cause” to modify the Scheduling Order to allow for amendment.

#### 26 **B. Leave to Amend Is Appropriate under Rule 15.**

27 None of the Rule 15 factors weigh against granting leave to amend.  
28

1           *Bad faith:* The Ninth Circuit has explained that bad faith in the context of Rule 15 occurs  
2 when “the [party] merely is seeking to prolong the litigation by adding new but baseless legal  
3 theories.” *Griggs*, 170 F.3d at 881.

4           Dropbox seeks to add an unclean hands defense to its Answer. “[A] determination of  
5 unclean hands may be reached when ‘misconduct’ of a party seeking relief ‘has immediate and  
6 necessary relation to the equity that he seeks in respect of the matter in litigation,’ *i.e.*, ‘for such  
7 violations of conscience as in some measure affect the equitable relations between the parties in  
8 respect of something brought before the court.’” *Gilead Scis., Inc. v. Merck & Co.*, 888 F.3d  
9 1231, 1239 (Fed. Cir. 2018) (quoting *Keystone Driller Co. v. Gen. Excavator Co.*, 290 U.S. 240,  
10 245 (1933)). This doctrine “is not bound by formula or restrained by any limitation that tends to  
11 trammel the free and just exercise of discretion.” *Precision Instrument Mfg. Co. v. Auto. Maint.*  
12 *Mach. Co.*, 324 U.S. 806, 815 (1945).

13           Here, the facts indicate that Synchronoss entered into licenses that were not probative of  
14 the value of the patents, and in fact suggest an effort to artificially inflate their value. It then  
15 attempted to rely on those licenses to extract money from Dropbox in this litigation. In other  
16 words, the facts suggest that Synchronoss may not have “acted fairly and without fraud or deceit  
17 as to the controversy in issue.” *Precision Instrument*, 324 U.S. at 814-15. Thus, Dropbox has a  
18 legitimate basis to plead an unclean hands defense and seek discovery on the issue.

19           *Undue delay:* Under Rule 15, “delay alone no matter how lengthy is an insufficient  
20 ground for denial of leave to amend.” *United States v. Webb*, 655 F.2d 977, 980 (9th Cir. 1981).  
21 In any event, Dropbox has not unduly delayed in filing a motion to add these allegations. As  
22 discussed above, Dropbox moved to amend promptly after learning of the facts underlying its  
23 defense. *See p. 5, supra*. If there is any delay in this issue being presented, it is on the part of  
24 Synchronoss, which has not produced the relevant documents even though it has obviously been  
25 reckoning with the issue for some time in connection with its 2017 10-K filing.

26           *Prejudice to the opposing party:* “While all these factors are relevant, the crucial factor is  
27 the resulting prejudice to the opposing party.” *Howey v. United States*, 481 F.2d 1187, 1190 (9th  
28 Cir. 1973). “Unless undue prejudice to the opposing party will result, a trial judge should

1 ordinarily permit a party to amend its complaint.” *Id.* Here, Synchronoss would not suffer any  
2 undue prejudice if the Court allows Dropbox to file its Amended Answer.

3 *Futility of amendment:* Amendment is futile when “no set of facts can be proved under  
4 the amendment to the pleadings that would constitute a valid and sufficient claim or defense.”  
5 *Miller v. Rykoff-Sexton Inc.*, 845 F.2d 209, 214 (9th Cir. 1988). As discussed, the unclean hands  
6 doctrine “is not bound by formula or restrained by any limitation that tends to trammel the free  
7 and just exercise of discretion.” *Precision Instrument*, 324 U.S. at 815. There are a number of  
8 facts that could, and do, support Dropbox’s asserted defense. Accordingly, the proposed  
9 amendment is not futile.

10 *Whether the party has previously amended the pleading:* Dropbox has not previously  
11 amended its Answer.

#### 12 **IV. CONCLUSION**

13 For the foregoing reasons, Dropbox respectfully requests that the Court permit Dropbox  
14 to file an Amended Answer.

15  
16 Dated: August 6, 2018

Respectfully submitted,

17 By: /s/ Christopher J. Mandernach

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7 *Micron Consumer Products Group, LLC*

8 UNITED STATES DISTRICT COURT  
9 NORTHERN DISTRICT OF CALIFORNIA,  
10 SAN FRANCISCO DIVISION

12 YANGTZE MEMORY TECHNOLOGIES  
13 COMPANY, LTD.,

14 Plaintiff,

15 v.

16 MICRON TECHNOLOGY, INC., et al.,

17 Defendants.

18 MICRON TECHNOLOGY, INC.,

19 Counterclaim Plaintiff,

20 v.

21 YANGTZE MEMORY TECHNOLOGIES  
22 COMPANY, LTD., and YANGTZE  
23 MEMORY TECHNOLOGIES, INC.,

24 Counterclaim Defendants.

Case No. 3:23-cv-05792-RFL

**[PROPOSED] ORDER GRANTING  
MTI'S UNOPPOSED MOTION TO  
MODIFY THE CASE SCHEDULE TO  
PERMIT MTI TO REASSERT  
COUNTERCLAIMS**

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Before the Court is the Unopposed Motion of Micron Technology, Inc. (“MTI”) and defendant Micron Consumer Products Group, LLC (collectively, “Micron”) to Modify the Case Schedule to Permit MTI to Reassert Counterclaims.

After considering the Motion and relief requested therein, and good cause having been shown, **IT IS HEREBY ORDERED** that MTI’s Motion to Modify the Case Schedule to Permit MTI to Reassert Counterclaims is **GRANTED**.

Dated: \_\_\_\_\_

\_\_\_\_\_  
Hon. Rita F. Lin  
United States District Judge

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10 UNITED STATES DISTRICT COURT  
11 NORTHERN DISTRICT OF CALIFORNIA  
12 SAN FRANCISCO DIVISION

13 YANGTZE MEMORY TECHNOLOGIES  
14 COMPANY, LTD.,

15 Plaintiff,

16 v.

17 MICRON TECHNOLOGY, INC., et al.,

18 Defendants.

Case No. 3:23-cv-05792-RFL

**DECLARATION OF JASON LANG  
IN SUPPORT OF MTI'S UNOPPOSED  
MOTION TO MODIFY THE CASE  
SCHEDULE TO PERMIT MTI TO  
REASSERT COUNTERCLAIMS**

19  
20 MICRON TECHNOLOGY, INC.,

21 Counterclaim Plaintiff,

22 v.

23 YANGTZE MEMORY TECHNOLOGIES  
24 COMPANY, LTD., and YANGTZE  
25 MEMORY TECHNOLOGIES, INC.,

26 Counterclaim Defendants.

1 I, Jason Lang, declare as follows:

2 1. I am an attorney with the law firm of Orrick, Herrington & Sutcliffe LLP, counsel  
3 of record to Defendant and Counterclaim Plaintiff, Micron Technology, Inc. and Defendant Micron  
4 Consumer Products Group, LLC (“Micron”) in the above-captioned matter. I am a member in good  
5 standing of the Bar of the State of California. I make this declaration based on my personal  
6 knowledge, unless otherwise noted. If called as a witness, I could and would testify competently  
7 to the matters set forth herein.

8 2. I make this declaration in support of MTI’s Unopposed Motion to Modify the Case  
9 Schedule to Permit MTI to Reassert Counterclaims.

10 3. Exhibit A is a true and correct copy of a document YMTC served on MTI on  
11 December 20, 2024, as Attachment A to its Second Supplemental Responses to First Set of  
12 Interrogatories (Nos. 12-14).

13 4. Exhibit B is a true and correct redlined copy of MTI’s Second Amended  
14 Counterclaims that MTI seeks to file.

15 5. Exhibit C is a true and correct copy of DI 198 filed in *Synchronoss Techs., Inc. v.*  
16 *Dropbox, Inc.*, Case No. 16-cv-00119-HSG-KAW (N.D. Cal.) on Aug. 6, 2018.

17 I declare under penalty of perjury that the foregoing is true and correct to the best of my  
18 knowledge. Executed this 29<sup>th</sup> day of January, 2025, in Menlo Park, CA.

19  
20 /s/ Jason Lang  
Jason Lang