

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

YANGTZE MEMORY TECHNOLOGIES COMPANY, LTD.

Petitioner

v.

MICRON TECHNOLOGY, INC.

Patent Owner

IPR2025-00500

U.S. PATENT 10,475,737

**PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL**

TABLE OF CONTENTS

I. INTRODUCTION 1

II. **DISCRETIONARY DENIAL IS INAPPROPRIATE GIVEN THE STRONG MERITS OF THE UNPATENTABILITY CHALLENGE**..... 3

 A. The Petition Presents Particularly Strong Merits as the Board Has Already Instituted an IPR on a Related Ancestor Patent with Similar Claims 4

 B. The Petition Presents Strong Merits on Grounds Based on Anticipation and Single-Reference Obviousness..... 6

 C. Discretionary Denial is Not Warranted Because Material Errors Were Committed During Patent Examination 9

III. **DISCRETIONARY DENIAL UNDER FINTIV IS INAPPROPRIATE BECAUSE THE '737 PATENT IS NOT CURRENTLY INVOLVED IN ANY PARALLEL PROCEEDING** 15

 A. The '737 Patent is Not Currently Asserted in any Pending Civil Action 15

 B. The '737 Patent Remains an Imminent Obstacle for Petitioner as Patent Owner is Highly Likely to Reassert it Once the Stay is Lifted 16

 C. Discretionary Denial under *Fintiv* Would Still be Inappropriate Even If the Potential Reassertion of the '737 Patent Warrants a *Fintiv* Analysis 17

IV. **PATENT OWNER HAS NOT DEVELOPED SETTLED EXPECTATIONS THAT FAVOR DISCRETIONARY DENIAL**..... 19

V. **PATENT OWNER'S ARGUMENTS FOR DISCRETIONARY DENIAL SHOULD BE REJECTED** 20

A.	Patent Owner’s Allegations Are Unsupported and Irrelevant	21
B.	Patent Owner’s Arguments Are Contrary to Law.....	25
1.	Petitioner is a “person” entitled to file an IPR.....	25
2.	The Chinese government is not an RPI	29
3.	The Director should not exercise discretion to deny the Petition	34
VI.	CONCLUSION.....	36

LIST OF EXHIBITS

Exhibit	Description
EX1001	U.S. Patent No. 10,475,737 to Tang <i>et al.</i>
EX1002	Prosecution History of U.S. Patent No. 10,475,737
EX1003	Declaration of Dr. Kelin Kuhn
EX1004	U.S. Patent Application Publication No. 2010/0133598 in the Name of Chae <i>et al.</i>
EX1005	U.S. Patent Application Publication No. 2011/0156132 in the Name of Kiyotoshi <i>et al.</i>
EX1006	U.S. Patent Application Publication No. 2017/0352674 in the Name of Jeong <i>et al.</i>
EX1007	U.S. Patent Application Publication No. 2011/0151667 in the Name of Hwang <i>et al.</i>
EX1008	U.S. Patent No. 9,929,175 to Tang <i>et al.</i>
EX1009	U.S. Patent No. 9,564,471 to Tang <i>et al.</i>
EX1010	U.S. Patent No. 9,318,430 to Tang <i>et al.</i>
EX1011	U.S. Patent No. 8,945,996 to Tang <i>et al.</i>
EX1012	Joint Claim Construction and Prehearing Statement (Patent Local Rule 4-3), <i>Yangtze Memory Technologies Co. Ltd. v. Micron Technology, Inc. and Micron Consumer Products Group, LLC.</i> , No. 3:23-cv-05792-RFL, D.I. 105 (N.D. Cal. August 19, 2024)
EX1013	“Solid” – Merriam-Webster Online Dictionary 2010, Retrieved February 20, 2010, from https://web.archive.org/web/20100218235823/http://www.merriam-webster.com/dictionary/solid
EX1014	Bill Arnold, “Shrinking Possibilities,” <i>IEEE Spectrum</i> , vol. 46, no. 4, April 2009, pp. 26-28, 50-56
EX1015	U.S. Patent Application Publication No. 2007/0066004 in the Name of Nakagawa
EX1016	Y. Fukuzumi <i>et al.</i> , “Optimal Integration and Characteristics of Vertical Array Devices for Ultra-High Density, Bit-Cost Scalable Flash Memory,” <i>Proceedings of the 2007 IEEE International Electron Devices Meeting</i> , Washington, DC, USA, December 10-12, 2007, pp. 449–452
EX1017	S. Bangsaruntip <i>et al.</i> , “Universality of Short-Channel Effects in Undoped-Body Silicon Nanowire MOSFETs,” <i>IEEE Electron Device</i>

Exhibit	Description
	Letters, vol. 31, no. 9, Sept. 2010, pp. 903-905
EX1018	U.S. Patent Application Publication No. 2010/0327252 in the Name of Lee
EX1019	Prosecution History of U.S. Patent No. 9,929,175
EX1020	J. Jang <i>et al.</i> , “Vertical cell array using TCAT (Terabit Cell Array Transistor) Technology for Ultra High Density NAND Flash Memory,” 2009 Symposium on VLSI Technology, Kyoto, Japan, 2009, pp. 192-193
EX1021	K. Joo <i>et al.</i> , “Novel Transition Layer Engineered Si Nanocrystal Flash Memory with MHSOS Structure Featuring Large V_{th} Window and Fast P/E Speed,” IEEE International Electron Devices Meeting, 2005. IEDM Technical Digest., Washington, DC, USA, 2005, pp. 865-868
EX1022	S. Park <i>et al.</i> , “A New Operating Scheme by Switching the Polarity of Program/Erase Bias for Partially Oxidized Amorphous-Si-Based Charge-Trap Memory,” IEEE Transactions on Electron Devices, vol. 53, no. 11, Nov. 2006, pp. 2847-2849
EX1023	M. Rosmeulen <i>et al.</i> , “Silicon Rich Oxides as an Alternative Charge Trapping Medium in Fowler-Nordheim and Hot Carrier Type Non-Volatile-Memory Cells,” Digest. International Electron Devices Meeting, San Francisco, CA, USA, 2002, pp. 189-192
EX1024	Defendant’s Answer To First Amended Complaint And Counterclaims, <i>Yangtze Memory Technologies Co. Ltd. v. Micron Technology, Inc. and Micron Consumer Products Group, LLC.</i> , No. 3:23-cv-05792-RFL, D.I. 35 (N.D. Cal. February 16, 2024)
EX1025	Order Granting Motion To Dismiss Counterclaims, <i>Yangtze Memory Technologies Co. Ltd. v. Micron Technology, Inc. and Micron Consumer Products Group, LLC.</i> , No. 3:23-cv-05792-RFL, D.I. 78 (N.D. Cal. July 16, 2024)
EX1026	Defendant’s First Amended Counterclaims, <i>Yangtze Memory Technologies Co. Ltd. v. Micron Technology, Inc. and Micron Consumer Products Group, LLC.</i> , No. 3:23-cv-05792-RFL, D.I. 93 (N.D. Cal. August 1, 2024)
EX1027	Defendant’s Unopposed Motion To Modify The Case Schedule To Permit Defendant To Reassert Counterclaims, <i>Yangtze Memory Technologies Co. Ltd. v. Micron Technology, Inc. and Micron Consumer Products Group, LLC.</i> , No. 3:23-cv-05792-RFL, D.I. 213

Exhibit	Description
	(N.D. Cal. January 29, 2025)
EX1028	Order Granting Motion To Stay Case Pending <i>Inter Partes</i> Review, <i>Yangtze Memory Technologies Co. Ltd. v. Micron Technology, Inc. and Micron Consumer Products Group, LLC.</i> , No. 3:23-cv-05792-RFL, D.I. 243 (N.D. Cal. March 14, 2025)
EX1029	Press Release, U.S. Department of Commerce, Department of Commerce Awards CHIPS Incentives to Micron for Idaho and New York Projects and Announces Preliminary Memorandum of Terms for Virginia DRAM Project to Secure Domestic Supply of Legacy Memory Chips (Dec. 10, 2024) available at: https://www.commerce.gov/news/press-releases/2024/12/departments-commerce-awards-chips-incentives-micron-idaho-and-new-york (last accessed Apr. 9, 2025)
EX1030	IPR2025-00245 (<i>Micron Technology, Inc., v. Yangtze Memory Technologies Company, Ltd.</i>), Paper 1 (excerpt)
EX1031	IPR2024-00370 (<i>Micron Technology v. Netlist Inc.</i>), Paper 1 (excerpt)
EX1032	Printout, Bureau of Industry and Security, Entity List FAQs (2024) available at: https://www.bis.doc.gov/index.php/component/fsj_faqs/cat/33-entity-list-faqs (last accessed Apr. 9, 2025)
EX1033	87 Fed. Reg. 77505 (December 19, 2022), Additions and Revisions to the Entity List and Conforming Removal From the Unverified List
EX1034	Printout, Yahoo Finance, Micron Technology Inc. (MU), available at https://finance.yahoo.com/quote/MU/holders/ (last accessed Apr. 9, 2025)
EX1035	Printout, Slashgear, The Real Owners Behind the World’s Biggest Tech Companies, available at: https://www.slashgear.com/1669177/biggest-tech-companies-who-really-owns/ (last accessed Apr. 11, 2025)

All emphases in quotations are added unless otherwise noted.

Direct quotations of claim language are italicized.

This paper includes color illustrations and should be viewed in color.

I. INTRODUCTION

Discretionary denial of the instant Petition for *Inter Partes* Review (“IPR”) of U.S. Patent No. 10,475,737 (the “’737 patent”) is wholly unwarranted. Petitioner has presented grounds of unpatentability that are strong on the merits. In a related IPR, the Board has already determined that claims from an ancestor patent of the ’737 patent—U.S. Patent No. 8,945,996 (“the ’996 patent”)—with similar limitations are likely unpatentable based on U.S. Patent Application Publication No. 2010/0133598 to Chae *et al.* (“Chae,” EX1004), which is also applied in this Petition. The institution of that related IPR is strong evidence that claims of the ’737 patent are also likely to be unpatentable.

Moreover, the Petition presents meritorious grounds based on multiple anticipation and single-reference obviousness challenges. As explained below and in the Petition, the claims of the ’737 patent are anticipated and rendered obvious by Chae and U.S. Patent Application Publication No. 2017/0352674 in the name of Jeong *et al.* (“Jeong,” EX1006). Both references independently, expressly, and undisputedly disclose every limitation of certain challenged claims.

In addition, during prosecution, the examiner materially erred by overlooking relevant prior art—for example, the teachings of Jeong. As a result, the claims were allowed without recognition that the purportedly patentable subject matter was already disclosed in Jeong. It is therefore appropriate for the Office to use its

resources to correct this error through this IPR.

Discretionary denial is also inappropriate because no district court litigation currently involves the '737 patent. While Patent Owner attempted to assert the '737 patent in a pending litigation case, the motion to reassert counterclaims based on the '737 patent was dismissed after the litigation was stayed. Nonetheless, the '737 patent remains a live threat, as it is likely to be reasserted once the stay is lifted. The PTAB review now—when there is no parallel litigation—serves the core purpose of IPR: to provide an efficient, non-duplicative alternative to district court litigation. In these circumstances, no *Fintiv* analysis is required. But even if considered, as discussed below, the *Fintiv* factors weigh against discretionary denial.

Patent Owner also has not established settled expectations that would justify discretionary denial. As detailed below, consistent with recent Director decisions, the '737 patent has not been in force for any significant period since its grant at the end of 2019 to create settled expectations.

Finally, arguments raised by Patent Owner's Request for Discretionary Denial ("DD Request") are unsupported, irrelevant, and contrary to law. Petitioner is a statutorily authorized "person" under 35 U.S.C. § 311(a) entitled to file an IPR. Patent Owner's allegations regarding real party-in-interest ("RPI") status are baseless. There is no credible and reliable evidence that the "Chinese government" is the RPI or has control of any of Petitioner's actions in this proceeding. Accepting

Patent Owner’s theory would improperly extend RPI status to virtually every investor in any corporate petitioner. Further, there is no credible evidence that Petitioner’s parent company—Yangtze Memory Technologies Holding Co., Ltd. (“YMTH”)—should have been identified as an RPI. Patent Owner offers no evidence that YMTH directed or controlled this proceeding. Even assuming, *arguendo*, that the Chinese government or YMTH could be considered an unnamed RPI, Patent Owner has not shown that any such omission warrants discretionary denial. In fact, as detailed below, the law says otherwise.

II. DISCRETIONARY DENIAL IS INAPPROPRIATE GIVEN THE STRONG MERITS OF THE UNPATENTABILITY CHALLENGE

Discretionary denial is unwarranted considering the strong merits of the unpatentability grounds set forth in the Petition, consistent with the Acting Director’s *Interim Processes for PTAB Workload Management* (“Director Memo”). Noably, Patent Owner did *not* dispute the underlying merits of the Petition in its DD Request. *See generally* DD Req. As discussed in detail below, the Petition presents particularly strong merits based on: (i) a previously instituted IPR against a similar claim of an ancestor patent of the ‘737 patent, relying on the same prior art, (ii) multiple straightforward anticipation and single-reference obviousness grounds presented in the Petition, and (iii) material errors made by the Office during prosecution of the ‘737 patent.

A. The Petition Presents Particularly Strong Merits as the Board Has Already Instituted an IPR on a Related Ancestor Patent with Similar Claims

Although the validity of the '737 patent has not been adjudicated, the PTAB has already found a reasonable likelihood that the similar claim in its ancestor '996 patent was unpatentable in a related IPR proceeding, IPR2025-00098 (“the '098 IPR”). *See* Pet. 2–3 (identifying the '098 IPR as a related matter); IPR2025-00098, Paper 15 at 12–15 (PTAB June 10, 2025).

This prior institution of a related patent with similar claims is strong evidence that the merits of the instant Petition are strong. *See Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9 at 2 (Director June 13, 2025) (“*Tesla*”). In *Tesla*, the Director reasoned that “[t]he merits are strong because the Board previously determined there was a reasonable likelihood that similar claims of an ancestor patent were unpatentable in three separate proceedings.” *Id.* That rationale applies with equal force here.

In its Institution Decision of the '098 IPR, the Board determined that the petitioner had sufficiently shown that Chae discloses or suggests claim limitations in claim 1 of the '996 patent, including “*a stack of horizontally extending and vertically overlapping features,*” “*a primary portion and an end portion,*” and “*operative structures.*” *See* IPR2025-00098, Paper 15 at 12–15 (determining that “Petitioner has sufficiently shown that Chae discloses or suggests each of these

limitations, and thus shows a reasonable likelihood that it would prevail in showing that claim 1 is unpatentable over Chae”). The Board also adopted the petitioner’s proposed claim constructions, including the construction of “*dummy structure*,” which are the same as those applied in the instant Petition. *Id.* at 11–12; Pet. 11-12.

There is significant overlap in claimed subject matter between the challenged claims here and claim 1 of the ’996 patent. For example, at least independent claims 1, 11, and 21 of the ’737 patent include limitations corresponding to those in the ’996 patent.¹ The present Petition relies on the same Chae reference, applies the same claim constructions, and advances substantially the same analysis that the Board previously found reasonably likely to anticipate or render obvious claim 1 of the ’996 patent. *See* Pet. 11–12, 15–23, 30–34, 39-45.

Moreover, because the Board has already instituted the ’098 IPR, both Petitioner and the public have a reasonable expectation that the similarly challenged claims of the ’737 patent are likewise likely unpatentable. That expectation weighs heavily against discretionary denial.

¹ Claim 1 of the ’996 patent recites additional limitations (*e.g., removing at least some sacrificial materials*) that are not required by claims 1, 11, and 21 of the ’737 patent. Conversely, any additional limitations recited in claims 1, 11, and 21 of the ’737 patent but not present in claim 1 of the ’996 patent (*e.g., semiconductive material, vertical contacts*) are also disclosed and rendered obvious by Chae. *See* Pet. 15–23, 30–34, 39-45.

B. The Petition Presents Strong Merits on Grounds Based on Anticipation and Single-Reference Obviousness

The challenged claims recite stack structures in three-dimensional (3D) NAND memory devices, which had been well-known in the semiconductor industry prior to the earliest possible priority date of the '737 patent. For instance, the components of the claimed stack structures in challenged independent claims, including the horizontally extending and vertically overlapping “*features/gate lines*,” as well as the “*operative structures*,” “*dummy structures*,” and “*contacts*” that extend vertically through the “*features/gate lines*” in different regions of the stack structures, are clearly and extensively disclosed in each of Chae, Jeong, U.S. Patent Application Publication No. 2011/0156132 in the name of Kiyotoshi *et al.* (“Kiyotoshi,” EX1005), and U.S. Patent Application Publication No. 2011/0151667 in the name of Hwang *et al.* (“Hwang,” EX1007). The remaining claim limitations amount to routine design variations or industry-standard techniques that were well known or at least obvious in view of the cited prior art.

The Petition accordingly presents particularly strong unpatentability arguments on grounds based on anticipation and single-reference obviousness. Specifically, the Petition establishes that (i) claims 1–12, 14, 15, 21, and 22 are anticipated and rendered obvious by Chae (Grounds 1 and 2), and (ii) claims 18 and 20 are anticipated and rendered obvious by Jeong (Grounds 4 and 5). *See* Pet. 4–5.

These straightforward and well-supported challenges further demonstrate that discretionary denial is inappropriate, and that institution should be granted.

For example, FIG. A below presents a side-by-side comparison of FIG. 13 of the '737 patent—which illustrates the claimed invention—with FIG. 15E of Chae. Pet. 6-7, 15 (citing EX1003 – FIGs. C and F with additional annotations). Similarly, FIG. B below provides a side-by-side comparison between FIG. 13 of the '737 patent and FIG. 3 of Jeong, and FIG. C provides a side-by-side comparison between FIG. 13 of the '737 patent and FIG. 8 of Hwang. Pet. 6-7, 57, 68 (citing EX1003 – FIGs. C, J, and K with additional annotations).

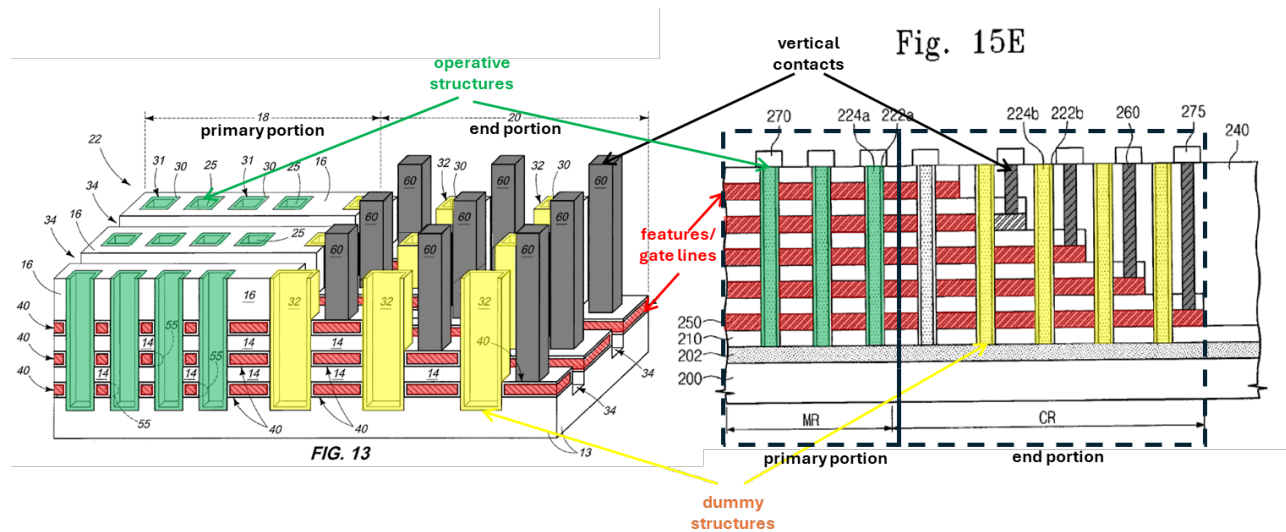


FIG. A: Side-by-side Comparison of Annotated FIG. 13 of the '737 Patent and Annotated FIG. 15E of Chae

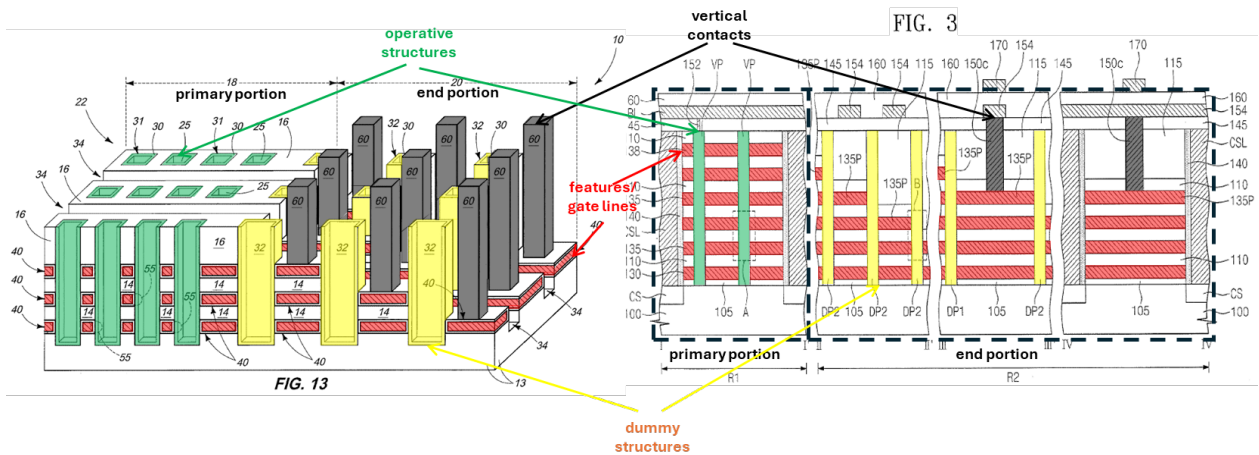


FIG. B: Side-by-side Comparison of Annotated FIG. 13 of the '737 Patent and Annotated FIG. 3 of Jeong

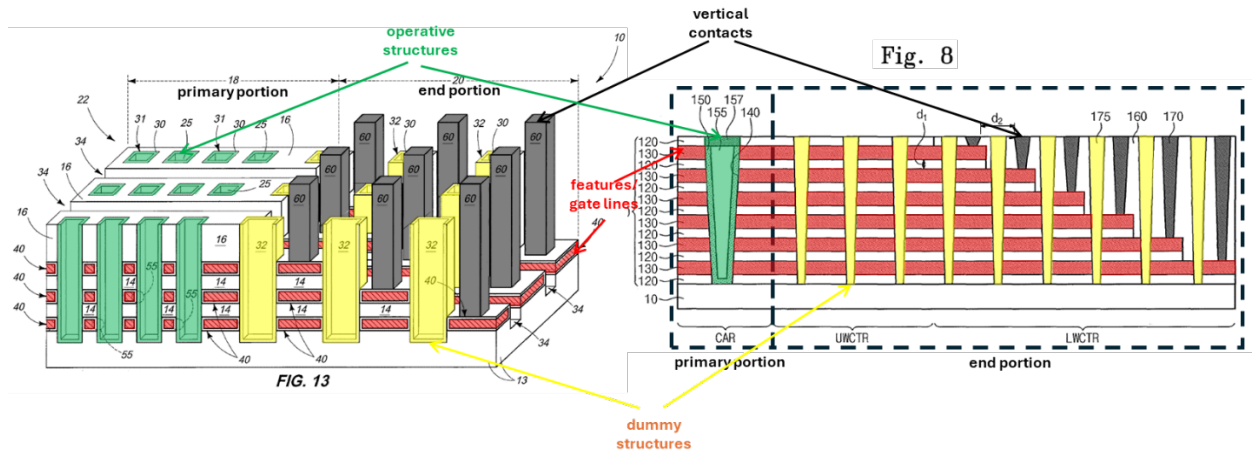


FIG. C: Side-by-side Comparison of Annotated FIG. 13 of the '737 Patent and Annotated FIG. 8 of Hwang

As illustrated in FIGs. A–C above, it is clear that each of Chae, Jeong, and Hwang discloses a stack structure including “a primary portion and an end portion,” which is substantially identical to the one recited in the challenged claims. In particular, the components of the stack—namely, the “features/gate lines” (highlighted in red), “operative structures” (in green), “dummy structures” (in

yellow), and “*vertical contacts*” (in black)—are consistently and expressly disclosed across these prior art references. *See* Pet. 6-7, 13-15, 55-57, 68-69.

C. Discretionary Denial is Not Warranted Because Material Errors Were Committed During Patent Examination

Discretionary denial is inappropriate because the Petition establishes that the Office committed a material error during examination of the '737 patent. As a result, it would be appropriate for the Office to use its resources to review that material error. *See Microsoft Corporation v. Partec Cluster Competence Center GMBH*, IPR2025-00318, Paper 9 at 3 (Director June 12, 2025) (“*Microsoft*”) (finding that “discretionary denial of institution is not warranted because of Petitioner’s showing of material error during patent examination” and that “it is an appropriate use of Office resources to review the potential error”); *Eunsung Global Corp. v. HydraFacial LLC*, IPR2025-00445, Paper 14 at 3 (Director July 10, 2025) (finding that “discretionary denial is not appropriate” because “Petitioner persuasively demonstrates that the patent examiner overlooked certain teachings in Karasiuk that appear to disclose the allowable features of the claims”); *Anthony Inc. v. Controltec LLC*, IPR2025-00559, Paper 9 at 2 (Director July 16, 2025) (finding that “[a]lthough the challenged patents have been in force for approximately eighteen and seventeen years, Petitioner appears to show a material error by the Office, and it is an appropriate use of Office resources to review the potential error”).

During prosecution of the '737 patent, the examiner allowed claims 18-22 because the prior art on the record did not teach the claim limitations related to “*vertical contacts.*” Pet. 8 (citing EX1002, 48-49). However, the examiner overlooked relevant prior art, as Jeong clearly discloses the purportedly patentable subject matter in claims 18 and 20. *See Microsoft*, IPR2025-00318, Paper 9 at 2-3 (finding that the examiner overlooked pertinent prior art references that were not previously before the examiner); *Anthony Inc.*, IPR2025-00559, Paper 9 at 2 (same); *Tesla, Inc. v. Charge Fusion Technologies, LLC*, IPR2025-00152, Paper 11 at 2-3 (Director June 12, 2025) (finding Office erred by overlooking prior art teachings that disclosed the purportedly allowable feature); *Microsoft Corporation v. XI Discovery, Inc.*, IPR2025-00253, Paper 13 at 2 (Director June 25, 2025) (same).

At the outset, neither the '737 patent nor its parent patents provide written disclosure support for the limitation in independent claim 18 requiring “*the **contacts** and dummy structures having different horizontal cross-sections relative one another*” and that “*different horizontal cross-sections have different values of total horizontal area relative one another*” in dependent claim 20. The specifications of these patents do not describe the horizontal cross-section of **contacts** at all, let alone provide any comparison with the horizontal cross-section of dummy structures. The only mention of any “cross-section” or “cross section” in the specifications pertains to openings 25 and 27, in which **operative structures** 31 and dummy structures 32

are formed, respectively. *See* Pet. 9. However, openings 25 (operative structures 31) do not correspond to the claimed “*contacts*” (*e.g.*, contacts 60), and the horizontal cross-section of openings 25 (operative structures 31) is not even associated with the horizontal cross-section of the contacts. *Id.* 10.

FIG. 13 also cannot demonstrate possession of the claimed limitation regarding horizontal cross-sections of contacts and dummy structures. The patents do not disclose that FIG. 13 (which is explicitly described as a “**diagrammatical**” illustration) is drawn to scale, nor do they disclose any dimensions or shapes. *Id.* Further, because the schematic illustration of FIG. 13 does not depict a **complete** horizontal cross-section of any dummy structure 32, a person of ordinary skill in the art (POSITA) would not be able to compare the horizontal cross-sections of dummy structures 32 and contacts 60 based on FIG. 13. *Id.* 11. Accordingly, the examiner’s failure to identify this clear deficiency in written description constitutes a material error directly bearing on the patentability of claims 18 and 20.

Moreover, claims 18 and 20 are not entitled to the benefit of any parent application, because the subject matter of those claims is not disclosed in the manner required under 35 U.S.C. § 112. By overlooking the written description issue, the Office applied an incorrect search period during examination, necessarily omitting prior art that could have been used to reject claims 18 and 20. *See Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12 at 3-4 (Director July 16, 2025) (finding

the examiner erred regarding the priority issue). Jeong, for example, is just one such reference that qualifies as prior art against those claims but was overlooked due to this material examination error. See Pet. 5, 8–11.

Jeong expressly and undisputedly discloses the purported patentable subject matter related to “vertical contacts” in claims 18 and 20. Specifically, as shown in FIG. D (annotated FIG. 3 of Jeong) below, Jeong clearly teaches contact plugs 150 (in black, “vertical contacts”) in second/connection region R2 (“end portion”), each connecting with a respective electrode 130, 135, or 138 (in red, “individual of the control gate lines”). Pet. 65-66 (citing EX1003 — FIG. AE with additional annotations).

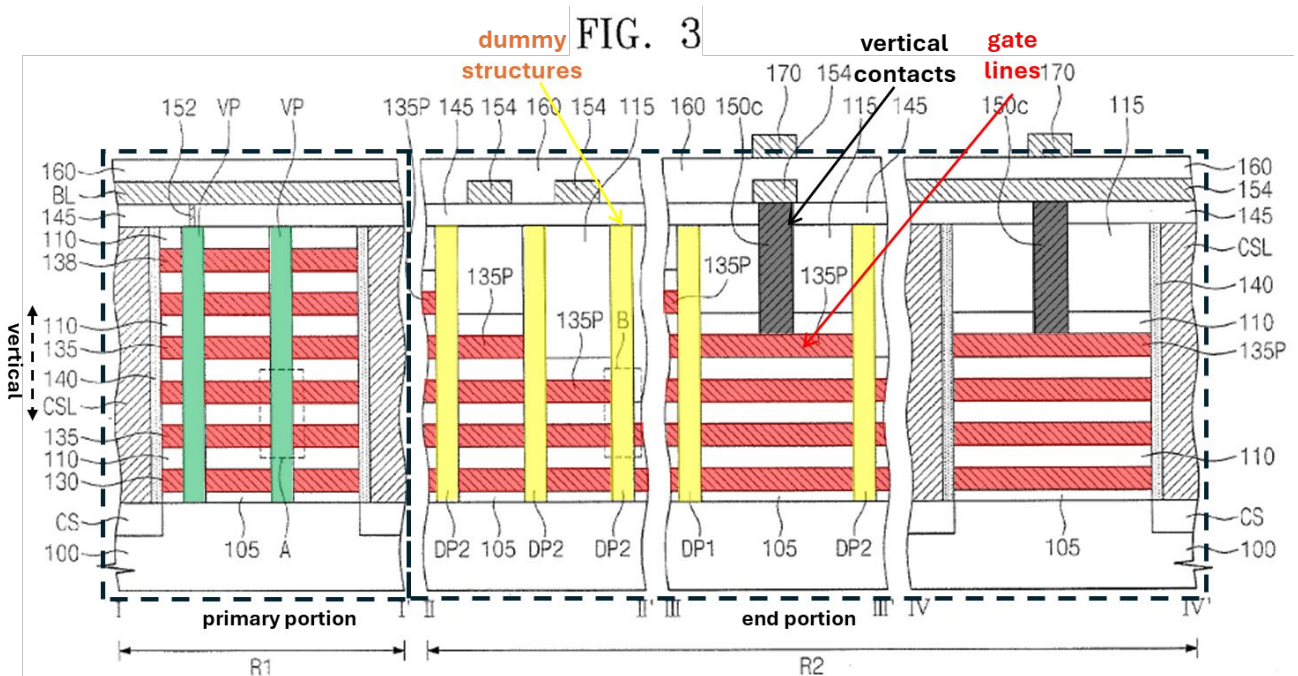


FIG. D: Annotated FIG. 3 of Jeong (EX1003 — FIG. AE)

Jeong further teaches that dummy pillars DP1 and DP2 (in yellow, “dummy

structures”) and contact plugs 150 (in black, “*vertical contacts*”) have different sizes, *e.g.*, diameters, from the plan view (“*horizontal cross-sections relative one another*”). Pet. 66 (citing EX1006, claims 25, 34, and 39). For example, Jeong expressly states: “a size of each of the dummy pillars is smaller than that of each of the contact plugs, when viewed from a plan view” (EX1006, claims 25 and 39), and “a diameter of each of the dummy pillars is less than that of the contact plug, when viewed from a plan view” (EX1006, claim 34). Pet. 66.

Therefore, the examiner overlooked relevant prior art by not having considered Jeong’s teachings, demonstrating that the Office erred in a manner material to the patentability of at least claims 18 and 20.

As to Kiyotoshi, it was cited in an information disclosure statement (IDS) submitted during the prosecution of the ’737 patent.² Pet. 82 (citing EX1002, 56, 60). Kiyotoshi was also cited in the Notice of Allowance in the file history of the parent U.S. Patent No. 9,929,175 (the “’175 patent,” EX1019) as one of the three closest prior art references of the allowed claims. *Id.* (citing EX1019, 22-25). However, Kiyotoshi was not a basis for rejection in the ’737 patent examination; there was no substantive discussion regarding any of the challenged claims of the ’737 patent with

² Notably, Petitioner has provided detailed and specific arguments in the Petition explaining why discretionary denial under 35 U.S.C. § 325(d) does not apply to Kiyotoshi. *See* Pet. 82–83. Patent Owner does not dispute these arguments or raise any arguments under § 325(d) in the DD Request.

respect to Kiyotoshi.

To the extent Kiyotoshi was previously presented to the Office, the Office erred in a manner material to the patentability of at least claims 5-8, 10-12, 14, and 15 by overlooking Kiyotoshi's teachings related to "*control gate lines*," "*dummy structures*," and "*a contact*." See Pet. 46-48. Kiyotoshi includes specific teachings that "impact patentability of the challenged claims." *Ecto World, LLC et al. v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 at 5-6 (PTAB May 19, 2025) (precedential). Specifically, the examiner overlooked the disclosures of Kiyotoshi, as demonstrated in Ground 3 of the Petition, that clearly show various purported patentable subject matters of the parent '175 patent, which are similar to claim limitations recited in claims 5-8, 10-12, 14, and 15 of the '737 patent, including those related to "*control gate lines*," "*dummy structures*," and "*a contact*." Pet. 46-48, 82 (citing EX1019, 22-23). Thus, the examiner materially erred by overlooking Kiyotoshi's teachings despite Kiyotoshi being disclosed in an IDS and by not considering Kiyotoshi in combination with Chae. See *Eunsung*, IPR2025-00445, Paper 14 at 3. Moreover, the discussion of Kiyotoshi with respect to the challenged claims of the '737 patent was underdeveloped because Kiyotoshi was merely discussed in relation to the claims of the parent '175 patent, which are distinct from the challenged claims of the '737 patent, and was not extensively evaluated for the same purposes upon which Petitioner relies in this Petition. See *Ecto World*,

IPR2024-01280, Paper 13 at 5.

In sum, the examiner erred materially in failing to raise a written description rejection regarding claims 18 and 20, overlooking Jeong’s express disclosure of the purported patentable subject matter of claims 18 and 20, and Kiyotoshi’s teachings related to “*control gate lines*,” “*dummy structures*,” and “*a contact*” in claims 5-8, 10-12, 14, and 15. In light of these material errors, discretionary denial is not warranted. *See, e.g., Microsoft*, IPR2025-00318, Paper 9 at 3.

III. DISCRETIONARY DENIAL UNDER FINTIV IS INAPPROPRIATE BECAUSE THE ’737 PATENT IS NOT CURRENTLY INVOLVED IN ANY PARALLEL PROCEEDING

A. The ’737 Patent is Not Currently Asserted in any Pending Civil Action

As pointed out in the Petition, the ’737 patent was initially asserted as counterclaims in Patent Owner’s February 16, 2024 Answer and Counterclaim in *Yangtze Memory Technologies Co. Ltd. v. Micron Technology, Inc. et al.*, No. 3:23-cv-05792-RFL (N.D. Cal.) (“NDCA case”), but the district court dismissed it under Federal Rule of Civil Procedure 12(b)(6), with leave to amend. *See* Pet. 2, n. 1 (citing EX1024-EX1025).

Subsequently, on January 29, 2025, Patent Owner filed an unopposed motion for leave to amend its counterclaims to reassert the ’737 patent. *Id.* (citing EX1027). This Petition was filed on February 12, 2025, about two weeks after the motion was

filed. That motion was later denied as moot on March 14, 2025, in view of the current stay of the NDCA case. EX1028, 2–3.

Accordingly, the '737 patent is *not* presently asserted in the NDCA case or in any other pending civil action. As a result, there is no parallel proceeding involving the '737 patent that would justify discretionary denial under *Fintiv* or related guidance. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (PTAB March 20, 2020) (precedential).

B. The '737 Patent Remains an Imminent Obstacle for Petitioner as Patent Owner is Highly Likely to Reassert it Once the Stay is Lifted

Although the '737 patent is not currently asserted in any pending civil action, it continues to pose an imminent threat to Petitioner as the '737 patent was not dismissed with prejudice. Patent Owner previously sought leave to amend its counterclaims to reassert the '737 patent in the NDCA case, and that motion was unopposed. Given the procedural history and the posture of the case, it is highly likely that Patent Owner will renew its efforts to assert the '737 patent against Petitioner after the stay is lifted (*e.g.*, through a renewed motion).

This case is readily distinguishable from prior decisions in which the Director found that dismissal of a patent from parallel district court litigation weighed in favor of discretionary denial. In each of those cases, the patent at issue *no longer posed a threat* to the petitioner—either because it was dismissed *with prejudice* (*see*

IPR2024-01453 (Paper 15 at 2), IPR2025-00415, -00417, and -00418 (Paper 10 at 2-3)), dismissed pursuant to a *joint motion* by the parties (*see* IPR2025-00290, -00291, and -00317 (Paper 18 at 4)), or subject to a *stipulation* by the patent owner *not* to assert the challenged claims against the petitioner (*see* IPR2025-00227 (Paper 13 at 4, DD Req. 10), IPR2025-00313 and -00314 (Paper 18 at 2, DD Opp. 1)).

By contrast, here, the '737 patent remains at the center of a live and unresolved dispute between the parties. Petitioner faces a real and ongoing risk of future litigation involving the '737 patent, which strongly supports institution and weighs against discretionary denial. Having the PTAB resolve the patentability issues without any overlap with the litigation—especially given that the litigation is stayed—would serve the very purpose for which IPR was created: to provide an efficient alternative to district court litigation.

C. Discretionary Denial under *Fintiv* Would Still be Inappropriate Even If the Potential Reassertion of the '737 Patent Warrants a *Fintiv* Analysis

As stated in Section III.A, the '737 patent is not asserted in the currently stayed NDCA case, and there is no other pending parallel district court litigation involving the '737 patent. To the extent the potential reassertion of the '737 patent is later allowed to be reasserted in the NDCA case, discretionary denial would still be inappropriate under *Fintiv* analysis.

The NDCA case is presently stayed pending resolution of other IPR

proceedings, and no trial date has been set (*Fintiv* Factor 1). *See generally* EX1028. As the court noted in its stay order, “the litigation is in an early stage.” *Id.* 1. If new patents, including the ’737 patent, are asserted after the stay is lifted, the case schedule will likely be further extended to accommodate those additional claims. Therefore, even after the stay is lifted, it is highly unlikely that a trial would occur before a Final Written Decision (FWD) is issued in this IPR (*Fintiv* Factor 2).

Furthermore, the parties have made minimal investment with respect to the ’737 patent in the NDCA case before the ’737 patent was dismissed (*Fintiv* Factor 3). Patent Owner’s original counterclaims concerning the ’737 patent were dismissed under Rule 12(b)(6) for failure to adequately plead infringement. EX1025, 1. Invalidity contentions for the ’737 patent have not yet been served. Petitioner was diligent in filing the Petition just about two weeks after Patent Owner’s motion for leave to amend its counterclaims to reassert the ’737 patent was filed.

In addition, Petitioner has stipulated that if this IPR is instituted and the ’737 patent is reasserted in the NDCA case, Petitioner will *not* pursue the same grounds of invalidity in the district court litigation (*Fintiv* Factor 4). Pet. 84, n. 14 (citing *Sand Revolution II, LLC v. Continental Intermodal Group – Trucking LLC*, IPR2019-01393, Paper 24 at 11-12 (PTAB June 16, 2020) (informative)).

Finally, as discussed above in Section II, the Petition presents strong unpatentability grounds and compelling merits (*Fintiv* Factor 6). It is also worth

noting that the same PTAB merits panel has already been assigned to a number of IPR proceedings between the parties, all of which involve similar 3D NAND memory technologies as those at issue in the '737 patent. *See, e.g.*, IPR2025-00098, -00099, -00189, -00117, -00118, -00034, IPR2024-00911, -00909, -00791, -00788, -00792, -00790, -00789, -00794, -00795. Given the complexity of the technologies underlying the '737 patent, as well as the panel's technical background and its familiarity with the subject matter through these related proceedings, it would be far more efficient for the PTAB—particularly the same merits panel—to adjudicate the validity of the '737 patent. Moreover, PTAB adjudication will help ensure consistent and predictable invalidity determinations across these related proceedings involving similar technologies.

Accordingly, even if a *Fintiv* analysis were deemed appropriate, almost all *Fintiv* factors weigh against discretionary denial.

IV. PATENT OWNER HAS NOT DEVELOPED SETTLED EXPECTATIONS THAT FAVOR DISCRETIONARY DENIAL

The '737 patent issued at the end of 2019 (November 12, 2019) and thus, has *not* been in force for a significant period of time to create settled expectations. *See Cambridge Industries USA Inc., v. Applied Optoelectronics, Inc.* IPR2025-00434 Paper 11 at 2-3 (Director June 26, 2025) (finding Patent Owner has not developed strong settled expectations that favor discretionary denial for patents issued in 2020

and 2019); *Berkshire Hathaway Energy Company et al. v. Birchtech Corp.*, IPR2025-00274, Paper 23 at 3 (Director July 2, 2025) (same).

Consistent with those findings in *Cambridge* and *Berkshire*, Patent Owner has not established settled expectations with respect to the '737 patent that would support discretionary denial here.

V. PATENT OWNER'S ARGUMENTS FOR DISCRETIONARY DENIAL SHOULD BE REJECTED

Patent Owner in its DD Request raises three arguments about whether Petitioner can file a petition and whether the Director should discretionarily deny the Petition due to alleged Chinese government investment in Petitioner.³ These arguments should be rejected.

First, Petitioner is a “person” that can file an IPR consistent with binding precedent. Second, Petitioner is a private company, not a state-owned enterprise, and mere investment by certain Chinese government entities does not render Chinese government an RPI. Indeed, the U.S. government has invested in Patent Owner, but was not identified as an RPI in any of Patent Owner's own IPRs. Third, the U.S. government has not alleged that Petitioner operates on behalf of the Chinese

³ As noted by Patent Owner, the arguments for discretionary denial in its DD Req. are “substantially identical” to those in its Preliminary Responses and Sur-replies in the '098 IPR. DD Req. 1, n. 1. Those arguments, however, have been rejected by the Board of the '098 IPR in the Institution Decision. *See* IPR2025-00098, Paper 15 at 16-23 (PTAB June 10, 2025).

government. Petitioner’s 2022 inclusion on the U.S. Commerce Department’s “Entity List” was exclusively based on the U.S. government’s perceived risk that Petitioner’s products could be “diver[ted]” to another entity on the list, not on any allegation of Chinese government ownership or control. In sum, Patent Owner’s arguments are specious and unsupported by its alleged evidence and adopting them would require the Director to make drastic holdings that are contrary to law and precedent.

A. Patent Owner’s Allegations Are Unsupported and Irrelevant

Patent Owner’s allegation that the Chinese government controls Petitioner is unsupported by its alleged evidence, which is unreliable and inaccurate. Petitioner is a private company with independent control over its actions, including this Petition. No other party played a role in Petitioner’s decision to pursue this IPR, or exercised control over the arguments. None of Patent Owner’s alleged evidence shows otherwise.

The sum total of the alleged evidence provided in Patent Owner’s DD Request is that: (1) the Chinese government has a fund that invests in the integrated circuit field (DD Req. 3-7); (2) Petitioner’s parent company YMTH has a series of minority investors, and Patent Owner alleges that these investors have taken investment from a diverse range of interests that includes local government branches in China and the integrated circuit investment fund (DD Req. 7-10); and (3) Petitioner has been added

to the U.S. Bureau of Industry and Security's ("BIS") Entity List and to the U.S. Department of Defense's ("DOD") Chinese Military Company List ("CMC List") (DD Req. 10-12). Even if true, Patent Owner never explains how any of these allegations supports its conclusory argument that the Chinese government is an RPI.

Patent Owner cannot support its argument because it is wrong. That Petitioner's parent company allegedly has a series of minority investors, including various government entities, does not imply control, nor is such an investment structure unusual for private Chinese companies. Patent Owner does not purport to explain how this set of entities exercises any level of control over Petitioner's actions. Indeed, Patent Owner's briefing cites no case in which the Director or Board has held that a passive investor in any company (let alone one three levels removed) should prevent a party from being able to file an IPR petition, and Petitioner knows of no such case. Moreover, in the NDCA case, Patent Owner chose to sue Petitioner—not the Chinese government or any alleged investors that it argues are state-owned entities. Assuming *arguendo* that Patent Owner truly believes that Petitioner is "an entity created, owned, and controlled by the Chinese government" and is therefore "not a statutorily authorized 'person,'" it should have named the Chinese government, not Petitioner, in the NDCA case. DD Req. 1. Petitioner similarly identified RPIs at the NDCA case, and Patent Owner never challenged the fact that Petitioner did not name the Chinese government in that forum. EX2021.

Following Patent Owner’s own argument, the U.S. government would be an RPI when Patent Owner files IPR petitions, at least because Patent Owner took a \$6.165 billion U.S. government investment as part of the 2022 CHIPS Act. EX1029. Like the Chinese integrated circuit fund, the CHIPS Act constitutes state investment in Patent Owner and was intended to “help the U.S. grow its share of advanced memory manufacturing” and to “strengthen U.S. economic resiliency by bolstering a reliable domestic supply of leading-edge DRAM chips.” *Id.* If taking passive investment from a government source makes the government an RPI, then Patent Owner’s direct investment from the U.S. government would mean that it should identify the U.S. government as an RPI when it files or defends against IPRs—something that it has never done in its 30+ IPRs filed since the CHIPS Act passed. *See, e.g.*, Paper 3; *see also* EX1030; EX1031.

Patent Owner’s Entity List and CMC List allegations (both of which Petitioner disagrees with and is currently disputing through the entities tasked with those determinations) are similarly misleading. The Entity List identifies entities “subject to specific license requirements for the export, reexport and/or transfer (in-country) of specified items.” EX1032. Petitioner’s inclusion on the Entity List does not state or suggest that it is owned or controlled by the Chinese government—rather, BIS explained that the reason for Petitioner’s inclusion is exclusively the alleged “risk of diversion to [other] parties on the Entity List.” EX1033, 77506. Neither ownership

nor control are a reason for inclusion on the Entity List. *See* 15 C.F.R. § 744.11 (listing criteria). With respect to the CMC List, Patent Owner inaccurately argues that inclusion means that a company is an alleged “entity that is owned and/or controlled by the Chinese government.” DD Req. 12. Patent Owner strategically omits that there is an alternative reason for inclusion on the list that is unrelated to ownership or control. *See* H.R. 6395, 116th Cong. § 1260H(d)(1)(B)(II) (2021). For example, a company may be added to the CMC List on a finding that it is “affiliated with the Chinese Ministry of Industry and Information Technology, including research partnerships and projects.” *Id.* § 1260H(d)(2)(B). The DOD has not specified the reason for Petitioner’s inclusion on the CMC List, which may be wholly unrelated to any alleged ownership/control by the Chinese government, and thus irrelevant to this IPR.

In aggregate, Patent Owner’s allegations are not only unsupported, but irrelevant. Patent Owner’s evidence does not suggest that the Chinese government has control over Petitioner or that it has any involvement at all except as a passive investor in the investors in Petitioner’s parent. Because Petitioner functions as an independent, private company, with sole control over how it conducts itself in this proceeding, and there is no evidence to the contrary, Patent Owner’s arguments should be rejected.

B. Patent Owner’s Arguments Are Contrary to Law

1. Petitioner is a “person” entitled to file an IPR

Patent Owner asserts that Petitioner is not a statutorily authorized “person” under 35 U.S.C. § 311(a) entitled to file an IPR petition under the Supreme Court’s holding in *Return Mail, Inc. v. U.S. Postal Service*, 587 U.S. 618 (2019). DD Req. 16-20. Notably, the Board in the related ’098 IPR expressly rejected this same argument, finding that “it does not disprove that YMTC is a company, and therefore a ‘person’ under § 311 regardless of whether it is also a government entity.” IPR2025-00098, Paper 15 at 16. Patent Owner does not dispute that YMTC is a company. *See, e.g.*, DD Req. 7 (stating that “YMTC is China’s State-Owned NAND Memory *Company*”). Thus, as a company, YMTC constitutes a “person” under the express language of the Dictionary Act, which is eligible under 35 U.S.C. § 311(a) to file a petition for IPR. 1 U.S.C. § 1. Patent Owner has not provided any binding precedent, nor any persuasive argument, that the holding of *Return Mail* should be extended to exclude a “company”—even if such company were under the control of a foreign government—from the express definition of a “person” under 1 U.S.C. § 1. *See* IPR2025-00098, Paper 15 at 17.

Moreover, Patent Owner’s argument that Petitioner is not a “person,” based on *Return Mail*, is misguided. *Return Mail* was largely based on statutory restrictions against suing the U.S. government for infringement that do not apply to

Petitioner, and Patent Owner’s argument was rejected by the Federal Circuit in analogous circumstances.

In *Return Mail*, the Supreme Court held a U.S. government agency (the U.S. Postal Service) was not a “person” and thus could not file an IPR because “federal agencies face lower risks [so] it is reasonable for Congress to have treated them differently” than an individual or a private party. 587 U.S. 618, 625, 635-636 (2019). Non-government actors “face greater and more uncertain risks if they misjudge their right to use technology” including because 28 U.S.C. § 1498 places several restrictions on patent owners suing the Government, which are not applicable to shield non-government actors from patent infringement claims. *Id.* (listing restrictions). None of these restrictions applies to Patent Owner’s infringement counterclaim against Petitioner, which faces all of the same potential liability as any other private company, particularly given Patent Owner’s decision to bring its allegations of Chinese control at the PTAB but not at the NDCA case.

Patent Owner improperly equates YMTC—a private company with multiple shareholders—with the U.S. Postal Service—a federal agency. The Supreme Court held that the USPS is a federal agency. *See Return Mail*, 587 U.S. at 637 (“a federal agency is not a ‘person’ who may petition for post-issuance review under the AIA”); *Id.* at 627 (statutory definition of person includes “companies” but not the Federal Government). Patent Owner does not contest that the U.S. Postal Service is a federal

agency and that YMTC is a company.

Beyond this textual analysis (which is itself dispositive), Patent Owner's arguments also fail to address the U.S. government-specific analysis set forth in *Return Mail*. As the Board in the '098 IPR explained, *Return Mail* was based on factors specific to the U.S. government (such as limitations on patent owners' rights when bringing claims against the U.S. and on problems with inter-agency proceedings), which do not apply to YMTC. IPR2025-00098, Paper 15 at 18-19. As noted in *Tik Tok Inc. v. Cellspin Soft, Inc.*, the "overarching notion underlying *Return Mail*'s analysis is that the U.S. Government is treated differently than private parties in adversarial, adjudicatory patent proceedings." IPR2024-00757, Paper 33 at 12-13 (PTAB June 2, 2025) (internal citations omitted, emphasis added), Director review granted, Paper 34 (PTAB June 5, 2025);⁴ *see also, e.g., Return Mail*, 587 U.S. at 634–636 (stating how the U.S. government is "in a unique position among alleged infringers given that 28 U.S.C. § 1498 limits patent owners to bench trials before the Court of Federal Claims"), 636 n.10 (discussing estoppel procedures that may not

⁴ Director Review was granted in the *TikTok* proceedings due to "novel issues presented." IPR2024-00757, Paper 34 at 3. This matter is distinguishable from *TikTok* at least because it involves different parties, a different procedural posture, and a different record. Additionally, unlike in *TikTok*, Patent Owner has filed its own IPRs against Petitioner relating to the NDCA case such that denying Petitioner the same opportunity would be inequitable. *See, e.g.,* IPR2024-00788 to -00795, -00909 to -00912; IPR2025-00034 to -00035, -00117 to -00119, -00189-00191, -00228 to -00229, -00244 to -00245, and -00294.

be applicable to the U.S. government), 636 (discussing the “awkward situation” that might arise as a result from a civilian patent owner defending their patent in “an adversarial proceeding initiated by one federal agency (such as the Postal Service) and overseen by a different federal agency (the Patent Office).” Patent Owner does not address that these same considerations apply to a foreign government or foreign government entity, such that we should extend *Return Mail’s* holding to foreign governments or foreign government entities. See IPR2025-00098, Paper 15 at 18-19.

A more apt comparison is *Bozeman Fin. LLC v. Fed. Rsrv. Bank of Atlanta*, in which the Federal Circuit determined that Federal Reserve banks were “persons” under the AIA in the aftermath of the *Return Mail* decision:

It is significant that the Banks are subject to suit for patent infringement in any court. The Supreme Court recognized that federal agencies face less risk for patent infringement than do private entities, and recognized that lessened risk as a reason for Congress to treat federal agencies differently. A patent owner's remedy is limited when it sues the government rather than private entities. Patent owners’ ability to sue the Banks in any district court, and to seek remedies they would be prohibited from in a suit against the government, favors a finding that the Banks are separate from the government and Congress intended the Banks have access to post-issuance proceedings.

955 F.3d 971, 975-76 (Fed. Cir. 2020) (citations omitted). *Bozeman* thus counsels that Petitioner, a private entity subject to suit in district court (as shown by the

lawsuit that Patent Owner filed against Petitioner), is a “person” entitled to file an IPR petition.

The Federal Circuit’s reasoning is even more applicable to Petitioner than it was to the banks in *Bozeman*. There plaintiff argued that the banks were “operating members of the nation’s Federal Reserve System, which is a federal agency, meaning they are government entities” and that they “implement the monetary and fiscal policies of the United States, conduct important governmental functions, and any profit generated by the Banks is transferred to the United States Treasury.” *Id.* at 975. Petitioner is not a government entity and does not have any of the advantages that the U.S. government enjoys defending itself in court.

Because *Return Mail* is distinguishable and *Bozeman* counsels that Petitioner is a statutory “person,” Patent Owner’s argument is legally flawed and should be rejected.

2. The Chinese government is not an RPI

Patent Owner never explains how the Chinese government⁵ controlled or could have controlled this proceeding, or how this petition was “filed at another

⁵ Patent Owner refers to the “Chinese government” as an unnamed RPI but does not identify what the “Chinese government” is. *See, e.g.*, DD Req. 3–5 (referring to “China’s State Council”), 7 (municipal governments), 7–9 (identifying the seven shareholders of YMTC Holding as “state-owned enterprises”), 9 (stating the actual controller of the Yangtze River Industrial Investment Group is the “administration of Wuhan East Lake High-tech Development Zone”), 9 (stating the actual controller

party's behest." *Uniloc 2017 LLC v. Facebook Inc.*, 989 F.3d 1018, 1027–28 (Fed. Cir. 2021). To identify RPIs, "[r]elevant considerations may include, whether a party exercises [or could exercise] control over a petitioner's participation in a proceeding, or whether a party is funding the proceeding or directing the proceeding." *Id.* (cleaned up).

Patent Owner's bare allegations that Petitioner's parent company has investors that took investment from the Chinese government do not suggest that the government specifically funded this proceeding or that it had an opportunity to control Petitioner's filing of these IPR petitions against Patent Owner. At most, Patent Owner argues that the Chinese government gets a benefit from this proceeding because it has investors in the company. DD Req. 20-24. But having investors has never been the standard for identifying RPIs. Accepting this argument would mean that every investor (or at least every major investor) in a company is an RPI, and therefore that the estoppel from a one-year bar or final written decision would infect dozens of companies that had nothing to do with the lawsuit or the IPR. For example, Patent Owner would be an RPI with its investors, which in turn would be RPIs with many of the biggest public technology companies in the U.S. EX1034;

of the Yangtze River Industrial Group is the "Hubei Provincial State-owned Assets Supervision and Administration Commission"). *See* IPR2025-00098, Paper 15 at 19, n. 7.

EX1035 (Patent Owner’s biggest investors also invest in many other tech companies). Worse yet, under Patent Owner’s argument, when a state invests in a company, every company that the state has invested in would have the same estoppel profile as the state—impacting hundreds of other companies.

Because the Chinese government is not an RPI, and because Patent Owner’s argument would drastically expand the definition of RPI and the corresponding requirement to identify RPIs, the Director should reject that argument.

Patent Owner’s alternative argument that Petitioner should have identified YMTH as an RPI lacks merit because Patent Owner never argues nor provides evidence that YMTH controlled or could control this proceeding. *See VirnetX Inc. v. Mangrove Partners Master Fund, Ltd.*, 778 F. App’x 897, 903 (Fed. Cir. 2019) (investment manager of petitioner was not an RPI, even after transmitting money to finance the proceedings).

Even assuming, *arguendo*, that the “Chinese government” or YMTH could be considered an unnamed RPI, Patent Owner has not shown that any such omission warrants discretionary denial. As the Board already held in the related ’098 IPR, Patent Owner “does not sufficiently show that the failure to identify the RPI is a reason to decline to institute this proceeding.” IPR2025-00098, Paper 15 at 19. Patent Owner has not asserted that a statutory bar or other estoppel would apply to either the Chinese government or YMTH in this proceeding. *Id.* at 20 (citing 35

U.S.C. § 315(b)). Precedential PTAB decisions hold that Petitioner could add an RPI without necessitating a new filing date. *See SharkNinja Operating LLC v. iRobot Corp.*, IPR2020-00734, Paper 11, 18 (PTAB October 6, 2020) (precedential); *Lumentum Holdings, Inc. v. Capella Photonics, Inc.*, IPR2015-00739, Paper 38 at 6 (PTAB March 4, 2016) (precedential) (stating that a petition may be corrected, including adding a real party in interest, without assigning a new filing date).

Indeed, in *Unified Patents, LLC v. MemoryWeb, LLC*, the Director reaffirmed the *SharkNinja* precedent, emphasizing that it “best serves the Office’s interests in cost and efficiency to not resolve an RPI issue when it would not create a time bar or estoppel under 35 U.S.C. § 315 in that proceeding.” *Unified Patents, LLC v. MemoryWeb, LLC*, IPR2021-01413, Paper 76 at 4 (PTAB May 22, 2023) (vacating the Board’s RPI determination in the Final Written Decision as not necessary to resolve the proceeding, such as a time bar under § 315(b) or estoppel under 35 U.S.C. § 315(e)). Here, Patent Owner has not alleged—and cannot show—that either the Chinese government or YMTH has been sued for patent infringement. Accordingly, Patent Owner has not demonstrated that any determination as to whether the Chinese government or YMTH is an RPI, or in privity with Petitioner, would impact this proceeding or give rise to a time bar or estoppel. IPR2025-00098, Paper 15 at 20.

Nonetheless, to the extent that the Director determines that YMTH should be identified, Petitioner is willing to amend its identification of RPIs to include YMTH.

Such an amendment should not change the filing date afforded to the petition. *See Wi-Fi One v. Broadcom Corp*, 878 F.3d 1364, 1374, n.9 (Fed. Cir. 2018) (*en banc*) (“[I]f a petition fails to identify all real parties in interest under § 312(a)(2), the Director can, and does, allow the petitioner to add a real party in interest.”); *Adello Biologics LLC v. Amgen Inc*, PGR2019-00001, Paper 11 (precedential). Patent Owner has long been on notice of YMTH’s interest, at least from Petitioner’s November 2023 disclosure in the NDCA case. EX2021; *see Mayne Pharma Int’l Pty. Ltd. v. Merck Sharp & Dohme Corp.*, 927 F.3d 1232, 1239 (Fed. Cir. 2019) (allowing amendment of RPIs to include a party identified in parallel district court litigation).

As to Patent Owner’s contention that the Chinese government may file additional IPR proceedings through other Chinese semiconductor companies if this Petition is denied or unsuccessful and that RPI provisions seek to protect patent owners from harassment via “successive petitions by the same or related parties” (DD Req. 30-31)—such concerns are unfounded and speculative. The PTAB has already established mechanisms to prevent abusive or duplicative proceedings if they arise. *See* IPR2025-00098, Paper 15 at 20-21 (citing Patent Trial and Appeal Board Consolidated Trial Practice Guide (November 2019) (“Consolidated TPG”), 55–63; *General Plastic Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 15–18 (PTAB September 6, 2017) (precedential) (recognizing the “potential

for abuse of the review process by repeated attacks on patents” and setting forth factors to consider in exercising discretion on instituting inter partes review as to “follow-on” petitions challenging the same patent previously challenged in an *inter partes* review proceeding).

3. The Director should not exercise discretion to deny the Petition

Patent Owner (DD Req. 32-34) relies on *Microsoft Corp. v. Science Applications Int’l Corp.* to argue that the Director should discretionally deny this Petition, but that case is inapposite. IPR2019-01311, Paper 35 (PTAB January 27, 2020). There, the patent owner initially sued the U.S. government (not a private company) at the Court of Federal Claims. *Id.* at 3. Microsoft had a contract with the government to produce the allegedly infringing technology, and therefore filed IPR petitions, but these petitions were not filed until more than one year after the lawsuit against the government was filed. *Id.* at 7-8. The Board concluded that Microsoft would have “no interest” in “seeking invalidity of the challenged claims but for the Contract” and that “the Petition and the infringement claims against the government are intertwined.” *Id.* at 9. The Board also pointed to “evidence of at least some pre-filing communication” and of the relationship between the parties. *Id.* at 1.

In contrast, here the related district court litigation is not a suit against the Chinese government (but directly against Petitioner), there is no similar estoppel

issue, and there are no allegations, let alone evidence, of any coordination between the Chinese government and Petitioner as to this IPR. *See* IPR2025-00098, Paper 15 at 23 (finding that “[u]nlike in *Microsoft*, in which the statutory bar under 35 U.S.C. § 315(b) applied because the U.S. government had been sued more than one year prior, there is no argument in the present proceeding that the Chinese government has been sued for patent infringement or is otherwise subject to a statutory bar under § 315(b)”). Instead, Petitioner has a clear interest in the district court lawsuit by virtue of being accused there of patent infringement.

Patent Owner’s additional arguments for discretionary denial (DD Req. 34-37) rely again on its conclusory allegation that the Chinese government owns and controls Petitioner, which is unsupported by its alleged evidence, and which is contrary to the position that Patent Owner took at the NDCA case. Appealing to xenophobic fears, Patent Owner further urges the Director to make a political decision—discretionarily denying any IPR petition that is filed by a company that has Chinese (or any other state) investment, no matter how far removed from its day-to-day operations. DD Req. 35-36. The Director should reject Patent Owner’s attempt to inject its political biases into this IPR.

VI. CONCLUSION

For the above reasons, Petitioner respectfully requests that the Director refrain from exercising discretion to deny this Petition, and instead pass it to a merits panel for consideration.

Respectfully submitted,

BAYES PLLC

/Zhiwei Zou/

Zhiwei (Wayne) Zou

Registration No. 66,041

Lead Counsel for Petitioner

Date: July 17, 2025
8260 Greensboro Drive, Suite 625
McLean, VA 22102
(703) 995-9887

CERTIFICATION UNDER 37 C.F.R. § 42.24

This Petitioner's Opposition to Patent Owner's Request for Discretionary Denial complies with the requirements of 37 C.F.R. § 42.24. As calculated by the word count feature of Microsoft Word, it contains 8,086 words, excluding the parts exempted by § 42.24.

/Zhiwei Zou/
Zhiwei (Wayne) Zou
Registration No. 66,041
Lead Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing **Petitioner's Opposition to Patent Owner's Request for Discretionary Denial and Exhibits 1028-1035** were served on July 17, 2025, via email, as agreed to by counsel of record for the Patent Owner, at the following.

PTABDocketJL2@orrick.com

PTABDocketJ3B3@orrick.com

T61PTABDocket@orrick.com

micron-ymtc_ohs@orrick.com

ORRICK, HERRINGTON & SUTCLIFFE LLP

Dated: July 17, 2025

/Zhiwei Zou/
Zhiwei (Wayne) Zou
Lead Counsel for Petitioner