

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

VERVAIN, LLC,
Patent Owner.

IPR2025-00614
U.S. Patent No. 8,891,298

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

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EXHIBIT LIST

Exhibit No.	Description
2001	Declaration of Dr. Sunil Khatri from <i>Phison Electronics Corporation v. Vervain, LLC</i> , IPR2025-00212, Ex. 2001 (P.T.A.B. Mar. 26, 2025) (expert report filed with Patent Owner’s Preliminary Response)
2002	<i>Vervain, LLC v. Western Digital Corp. et al.</i> , No. 6:21-cv-488-ADA, Dkt. 41 (W.D. Tex. Jan. 24, 2022) (Claim Construction Order)
2003	<i>Vervain, LLC v. Kingston Technology Company, Inc., et al.</i> , No. 1:24-cv-254-ADA, Dkt. 19 (W.D. Tex. Jul. 15, 2024) (agreed scheduling order)
2004	<i>Vervain, LLC v. Kingston Technology Company, Inc., et al.</i> , No. 1:24-cv-254-ADA, Dkt. 56 (W.D. Tex. Jan. 28, 2025) (order denying motion to transfer venue)
2005	<i>Vervain, LLC v. Phison Electronics Corporation</i> , No. 1:24-cv-259-ADA, Dkt. 16 (W.D. Tex. Jul. 15, 2024) (agreed scheduling order)
2006	“Judge Albright Patent FAQ,” https://www.txwd.uscourts.gov/for-attorneys/judge-albright-courtroom-faq/ . Accessed December 18, 2024.
2007	Judge Albright’s Standing Order Governing Proceedings (OGP) 4.4—Patent Cases, Filed January 23, 2024.
2008	Preliminary Claim Constructions for <i>Vervain, LLC v. Phison Electronics Corporation</i> , No. 1:24-cv-259-ADA and <i>Vervain, LLC v. Kingston Technology Company, et al.</i> , No. 1:24-cv-254-ADA – email from Mr. Brown received on February 5, 2025.
2009	Markman Hearing Transcript dated February 6, 2025, for <i>Vervain, LLC v. Phison Electronics Corporation</i> , No. 1:24-cv-259-ADA and <i>Vervain, LLC v. Kingston Technology Company, et al.</i> , No. 1:24-cv-254-ADA.

Exhibit No.	Description
2010	<i>Vervain, LLC v. Western Digital Corp. et al.</i> , No. 6:21-cv-00488-ADA, Dkt. 180 (W.D. Tex. Jul. 26, 2023) (Redacted Copy of Order on the Pending Motions and Motions <i>In Limine</i>).
2011	<i>Phison Electronics Corp. v. Vervain, LLC</i> , PGR2024-00047, Paper 9 (P.T.A.B. Mar. 17, 2024) (Decision Denying Institution of Post-Grant Review of U.S. Patent No. 11,830,546)
2012	<i>Phison Electronics Corp. v. Vervain, LLC</i> , PGR2024-00048, Paper 9 (P.T.A.B. April 28, 2025) (Decision Denying Institution of Post-Grant Review of U.S. Patent No. 11,854,612)
2013	Docket Sheet for <i>Vervain, LLC v. Kingston Technology Company, Inc., et al.</i> , No. 1:24-cv-254-ADA (W.D. Tex.). Accessed May 19, 2025.
2014	Excerpts from Kingston’s Final Invalidation Contentions served on February 28, 2025 in <i>Vervain, LLC v. Kingston Technology Company, Inc., et al.</i> , No. 1:24-cv-254-ADA (W.D. Tex.)
2015	“Interim Processes for PTAB Workload Management Memorandum,” issued March 26, 2025, https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf . Accessed May 13, 2025.
2016	Docket Sheet for <i>Vervain, LLC v. Phison Electronics Corporation</i> , No. 1:24-cv-259-ADA (W.D. Tex.). Accessed May 19, 2025.

I. INTRODUCTION

Pursuant to the “Interim Processes for PTAB Workload Management Memorandum” issued March 26, 2025 (“the *PTAB Memorandum*”), Patent Owner Vervain, LLC (“PO” or “Vervain”) respectfully submits this brief requesting that the Director exercise her discretion to deny institution of the Petition for *Inter Partes* Review (IPR) (Paper 1) of U.S. Patent No. 8,891,298 (“298 Patent” or “the Challenged Patent”) filed by Kingston Technology Company, Inc., Kingston Technology Corporation, and Kingston Digital, Inc. (“Kingston” or “Petitioners”).

The Director should exercise her discretion and deny institution under 35 U.S.C. § 314(a)—instituting this Petition would require a considerable and inefficient use of the Board’s resources. The parties are already litigating a parallel case in district court, which involves the Challenged Patent and seven others. The parallel case is well past its infancy. Before the institution decision is due in this IPR proceeding, the district court will have already held the *Markman* hearing, and the parties will have completed fact discovery and submitted expert reports. And trial in the district court case is scheduled for *nine months before* the final written decision deadline here. Furthermore, Petitioner advances overlapping invalidity grounds in district court but *has not stipulated to any estoppel* in the event this Petition is instituted. The advanced parallel proceeding should proceed, and this Petition should be denied.

Further, the Petition is weak on the merits. The Petition includes *three* cursory single-reference obviousness grounds challenging claims 1-11 (“Challenged Claims”). Petitioner’s grounds rely on theories based on U.S. Patent No. 8,634,240 (“Gavens”) (Ex. 1045), U.S. Patent Appl. Pub. No. 2009/0327591 (“Moshayedi”) (Ex. 1043), and U.S. Patent Appl. Pub. No. 2008/0140918 (“Sutardja”) (Ex. 1042), respectively. Each of these grounds, however, is inadequately explained. Petitioner omits certain limitations from its analysis entirely, and where limitations are addressed, the Petition fails to reconcile critical differences between the Challenged Claims and the prior art.

Accordingly, PO respectfully requests that the Director exercise her discretion to deny institution of the Petition.

II. BACKGROUND

A. The 298 Patent And The Vervain Patent Family

U.S. Patent No. 8,891,298 (the “Challenged Patent”) belongs to a family of patents including U.S. Patent Nos. 8,891,298; 9,196,385; 9,997,240; 10,950,300; 11,830,546; 11,854,612; 11,967,369; and 11,967,370 (the “Vervain Patents”). These patents share the same specification and are continuations stemming from U.S. Patent No. 8,891,298.

The Vervain Patents, each entitled “Lifetime Mixed Level Non-Volatile Memory System,” have effective filing dates of July 19, 2011. Ex. 1001, Cover. Dr. G. R. Mohan Rao is the sole named inventor of the Vervain Patents.

At a high level, the Vervain Patents describe a reliable flash memory storage system combining both single-level cell (SLC) and multi-level cell (MLC) non-volatile memories.¹ Ex. 1001, Abstract; Ex. 2001, ¶38.² SLC memory stores 1 bit per cell, and MLC memory stores more than 1 bit per cell. Ex. 1001, 1:64-67; Ex. 2001, ¶¶32-34. In general, SLC is faster and less prone to errors, but requires more space and power to store a given amount of data. Ex. 1001, 1:38-43.

¹ Non-volatile memories can store information even after the system is powered off. Flash memory is a specific type of non-volatile memory, where data is stored in “blocks” of “pages.” Ex. 1001, 2:31-48; Ex. 2001, ¶27.

² This Brief cites to the expert opinions of Dr. Sunil Khatri originally filed with the patent owner preliminary response in *Phison Electronics Corp. v. Vervain, LLC*, IPR2025-00212, Paper 8 (P.T.A.B. Mar. 26, 2025). Kingston moved for joinder to Phison’s IPR2025-00212 (*see* Paper 3) and has confirmed that “[t]his Petition neither adds to nor alters any arguments already raised before the Board [in Phison’s IPR2025-00212 petition].” Petition, 1.

The Vervain Patents describe a particular way of writing data to MLC and performing a data integrity test. The data integrity test checks the integrity of the data (*i.e.*, whether errors have occurred). The Vervain Patents explain that, if the data integrity test reveals a problem such as corrupt data, the data can be remapped to SLC (which is less error-prone) or other MLC blocks. Ex. 1001, 2:59-3:13, 4:4-10; Ex. 2001, ¶36.

The Vervain Patents further explain that one can distinguish between “hot” blocks (which receive more frequent writes), and “cold” blocks (which receive less frequent writes). Ex. 1001, 6:24-35. Because SLC has greater endurance, “hot” blocks can be allocated to SLC to increase the lifetime of the system. *Id.* “Cold” blocks, on the other hand, can be allocated to MLC to take advantage of its higher density storage. Ex. 2001, ¶37.

1. The Challenged Claims

The Challenged Patent includes one independent claim, Claim 1. Claim 1 is representative for purposes of this brief. Claim 1 requires:

Claim 1	
[1Pre]	A system for storing data comprising:
[1a]	at least one MLC non-volatile memory module comprising a plurality of individually erasable blocks;

[1b]	at least one SLC non-volatile memory module comprising a plurality of individually erasable blocks; and
[1c]	a controller coupled to the at least one MLC non-volatile memory module and the at least one SLC non-volatile memory module wherein the controller is adapted to:
[1d]	a) maintain an address map of at least one of the MLC and SLC non-volatile memory modules, the address map comprising a list of logical address ranges accessible by a computer system, the list of logical address ranges having a minimum quanta of addresses, wherein each entry in the list of logical address ranges maps to a similar range of physical addresses within either the at least one SLC non-volatile memory module or within the at least one MLC non-volatile memory module;
[1e]	b) determine if a range of addresses listed by an entry and mapped to a similar range of physical addresses within the at least one MLC non-volatile memory module, fails a data integrity test, and, in the event of such a failure, the controller remaps the entry to the next available equivalent range of physical addresses within the at least one SLC non-volatile memory module;
[1f]	c) determine which of the blocks of the plurality of the blocks in the MLC and SLC non-volatile memory modules are accessed most frequently by maintaining a count of the number of times each one of the blocks is accessed; and

[1g]	d) allocate those blocks that receive the most frequent writes by transferring the respective contents of those blocks to the at least one SLC non-volatile memory module.
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B. Litigation Involving The Vervain Patents

On March 7, 2024, Patent Owner (“PO”) filed a complaint against Kingston asserting infringement of the Challenged Patent, along with five additional Vervain Patents, in *Vervain, LLC v. Kingston Technology Company, Inc., et al.*, No. 1:24-cv-254-ADA (W.D. Tex.) (“the Parallel Litigation”). *See* Ex. 2013 (docket sheet showing the original Complaint, filed March 7, 2024, which asserted infringement of the first six Vervain Patents); *see also* Ex. 1082 (First Amended Complaint, filed May 10, 2024, which added infringement assertions for two more Vervain Patents—U.S. Patent Nos. 11,967,369 and 11,967,370).

On March 8, 2024, Patent Owner (“PO”) filed another complaint, also asserting infringement of the Challenged Patent among other Vervain Patents, against Phison Electronics Corporation (“Phison”) in *Vervain, LLC v. Phison Electronics Corporations*, No. 1:24-cv-259-ADA (W.D. Tex.) (“the Phison Litigation”). *See* Ex. 2016 (docket sheet also showing a first amended complaint, filed May 13, 2024).

1. IPR And PGR Filings Against The Vervain Patents

Once the Phison Litigation was ongoing, Phison filed requests for *inter partes* review and post grant review challenging each of the Vervain Patents—U.S. Patent Nos. 8,891,298 (IPR2025-00212); 9,196,385 (IPR2025-00213); 9,997,240 (IPR2025-00214); 10,950,300 (IPR2025-00215); 11,830,546 (PGR2024-00047); 11,854,612 (PGR2024-00048); 11,967,369 (PGR2025-00010); and 11,967,370 (PGR2025-00011). These requests were filed between August and December 2024.

Kingston then filed two requests for *inter partes* review on February 21, 2025: IPR2025-00614, challenging U.S. Patent No. 8,891,298, and IPR2025-00616, challenging U.S. Patent No. 10,950,300. Kingston represented that its two Petitions include arguments identical to those included in Phison’s IPR2025-00212 and IPR2025-00215, respectively, and filed corresponding motions for joinder. *See, e.g.*, Paper 3 (Motion for Joinder to Phison’s IPR2025-00212 to assume an “understudy” role).

The Board has already denied institution of two of Phison’s petitions on the merits—PGR2024-00047 and PGR2024-00048 (“the Denied PGRs”). *See Exs.* 2011-2012. The Board issued detailed decisions denying institution, substantively rejecting each of Petitioner’s grounds. *See generally id.*

The Board is expected to issue a decision on whether to institute IPR2025-00212 by June 26, 2025.

The Director is expected to decide by July 14, 2025, whether to exercise her discretion to deny institution of the five remaining Phison petitions—IPR2025-00213, IPR2025-00214, IPR2025-00215, PGR2025-00010, and PGR2025-00011. If the Director does not exercise her discretion, the Board is expected to decide whether to deny institution on the merits by August 14, 2025.

The Director is expected to decide by July 20, 2025, whether to exercise her discretion to deny institution of the two Kingston petitions—IPR2025-00614 (the present Petition) and IPR2025-00616. If the Director does not exercise her discretion, the Board is expected to decide by September 20, 2025, whether to deny institution on the merits and whether to deny Kingston’s joinder motions.

2. The Parallel District Court Litigation

The Parallel Litigation is well underway. The parties completed jurisdictional discovery—including multiple depositions—before the Court denied Kingston’s motions to transfer and to dismiss for improper venue. *See* Exs. 2004, 2013 (including at Dkt. No. 59 the sealed Order denying the motion to dismiss). The parties completed claim construction briefing, and the Court (with Judge Albright presiding) provided constructions for the disputed terms—all in PO’s favor—at a *Markman* hearing on February 6, 2025. *See* Exs. 2008-2009. Fact discovery opened on December 9, 2024, and the parties exchanged final invalidity and infringement contentions on February 28, 2025. *See* Ex. 2003.

Further, the Parallel Litigation is rapidly approaching trial. Fact discovery closes on July 7, 2025, necessitating that the parties begin depositions in June. *See* Ex. 2003. Opening expert reports are due July 11, 2025, followed by summary judgment and *Daubert* motions on September 12. *See* Ex. 2003. ***Trial is scheduled to begin on December 8, 2025.*** *See id.*

3. Prior Litigation Involving The Vervain Patents

Vervain previously asserted four of the Vervain Patents—U.S. Patent Nos. 8,891,298; 9,196,385; 9,997,240; and 10,950,300—against Western Digital and Micron in *Vervain, LLC v. Micron Technology, Inc. et al.*, No. 6:21-cv-487-ADA (W.D. Tex) and *Vervain, LLC v. Western Digital Corp. et al.*, No. 6:21-cv-488-ADA (W.D. Tex.) (“the Prior Litigation”). In these cases, the Court held a *Markman* hearing and ruled on summary judgment motions, maintaining the validity of the Vervain Patents. *See, e.g.*, Exs. 2002 (Claim Construction Order, issued January 24, 2022), 2010 (Summary Judgment Order).

Further, in these cases, Micron filed IPRs against U.S. Patent Nos. 8,891,298; 9,196,385; 9,997,240; and 10,950,300 (*see* IPR2021-01547, -01548, -01549,

and -01550). These IPRs were terminated prior to Final Written Decisions, following the parties' joint motions to terminate after reaching a settlement.

III. THE DIRECTOR SHOULD EXERCISE HER DISCRETION AND DENY INSTITUTION UNDER 35 U.S.C. § 314(a)

The Director should exercise her discretion and deny institution on all grounds because of the significant overlap with the Parallel Litigation, which is scheduled for trial well before a Final Written Decision would be expected here.

As shown below, the *Fintiv* factors all weigh in favor of denying institution under 35 U.S.C. § 314(a). See *NXP USA, Inc. v. Impinj, Inc.*, PGR2022-00005, Paper 18 at 7 (P.T.A.B. May 2, 2022) (weighing *Fintiv* factors and denying institution); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) ("*Fintiv*").

A. Factor 1: The Parallel Litigation Has Not Been Stayed And Is Unlikely To Be Stayed Even If This Petition Is Instituted

This factor weighs against institution because a stay of the Parallel Litigation is highly unlikely. Petitioner has not sought a stay, and the Board's decisions on institution and joinder are not expected until September 20, 2025.³ Given the timing

³ Phison's IPR2025-00212—which Kingston seeks to join in IPR2025-00614—is expected to receive an institution decision by June 26, 2025.

and complexity of the Parallel Litigation, it is improbable that Judge Albright would grant a stay even if the Petition is instituted.

Particularly, September 20, 2025, is after the *close* of fact discovery (July 7, 2025), and after the parties serve opening (July 11, 2025) and rebuttal (August 8, 2025) expert reports. *See* Ex. 2003. Accordingly, the Court will have “expended significant resources,” and would be unlikely to grant a stay. *See, e.g., Sonrai Memory Ltd. v. LG Elecs. Inc.*, No. 6:21-cv-00168-ADA, 2022 WL 2307475, at *3 (W.D. Tex. June 27, 2022) (denying stay when fact discovery opened two weeks before the institution decision).

Further, in the Parallel Litigation, PO asserted *eight patents* against Petitioner Kingston. *See* Ex. 1082, ¶2. Kingston filed IPR petitions against only two of these patents. Further, Phison filed IPR or PGR petitions against all eight Vervain Patents, but the Board has already denied institution in two of these proceedings—PGR2024-00047 and PGR2024-00048. *See* Exs. 2011-2012. In circumstances such as these, it is even more unlikely that the Court would grant a stay. *See Smart Mobile Techs. LLC v. Apple Inc.*, No. 6:21-cv-00603-ADA, 2023 WL 5051374, at *6 (W.D. Tex. Aug. 8, 2023) (denying stay based on instituted IPRs when institution was not granted on all asserted patents).

Thus, Factor 1 weighs against institution.

B. Factor 2: The Board Would Likely Issue A Final Written Decision Nine Months After Trial

This factor weighs against institution because trial is scheduled to begin nine months before the projected final written decision. Should the Director not exercise her discretion to deny institution, the Board is expected to decide whether to institute by September 20, 2025. Accordingly, the projected statutory deadline for a final written decision would be September 20, 2026—*nine months after the December 8, 2025, trial date*. See Ex. 2003.

Furthermore, should Phison's IPR2025-00212 be instituted and Kingston's joinder motion granted, the projected statutory deadline for a final written decision in the joined proceeding would be June 26, 2026—*six months after* the trial date.

Judge Albright is highly unlikely to move this trial date, as he has a practice of “not mov[ing] the trial date except in extreme situations.” Ex. 2006; *see also NXP USA*, PGR2022-00005, Paper 18 at 9 (weighing factor 2 in favor of discretionary denial when “the currently scheduled trial in the parallel proceeding is scheduled to begin over two months before our deadline to reach a final decision”); *Google LLC v. Cerence Operating Co.*, IPR2024-01465, 2025 WL 1182608, at *4 (P.T.A.B. Apr. 23, 2025) (weighing factor 2 in favor of discretionary denial when “the district court has set a trial date of October 6, 2025, which is almost seven months before the final written decision in this proceeding would be due in late April 2026” and “nothing in

the...record indicates a trial in the District Court Litigation would not take place months before our deadline to reach a final decision”).

C. Factor 3: The Court And Parties Have Invested Heavily In The Parallel Litigation

This factor weighs against institution because the parties and the Court have invested and will continue to invest significant resources in the Parallel Litigation. The Board weighs “the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv*, IPR2020-00019, Paper 11 at 9.

By the time the Board decides whether to institute this IPR in September 2025, the parties will have completed *Markman* briefing (Nov. 22, 2024); briefed a motion to transfer venue and a motion to dismiss (which the Court resolved on Jan 29, 2025, and Feb. 5, 2025, respectively); exchanged final infringement and invalidity contentions (Feb. 28, 2025); completed fact discovery (closes July 7, 2025); exchanged opening expert reports (July 11, 2025); and exchanged rebuttal expert reports (Aug. 8, 2025). *See* Exs. 2003, 2004, 2009. In addition, the parties will have completed extensive document production, as well as numerous fact and expert witness depositions.

Furthermore, the Court will have held a hearing regarding Kingston’s motions to dismiss and to transfer venue (Dec. 5, 2024), thereafter denying those motions. *See* Ex. 2013. The Court will also have held the *Markman* hearing and issued its

constructions (Feb. 6, 2025), and ruled on numerous discovery disputes. *See* Exs. 2008 (Court’s preliminary claim constructions), 2009 (transcript for the February 6 *Markman* hearing, during which the Court adopted its preliminary constructions); *see also Fintiv*, Paper 11 at 10 (“[D]istrict court claim construction orders may indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial.”).

Thus, the Court and the parties have invested and will continue to invest significant resources in the Parallel Litigation and, accordingly, this factor weighs against institution. *See NXP USA*, PGR2022-00005, Paper 18 at 9-10 (weighing factor 3 in favor of discretionary denial where the *Markman* hearing and the service of final infringement and invalidity contentions occurred before the Board’s institution decision deadline); *Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, 2025 WL 947070, at *1 (P.T.A.B. Mar. 28, 2025) (Order Granting Director Review, Vacating the Decision Granting Institution, and Denying Institution of *Inter Partes* Review) (finding “factor 3 strongly favors discretionary denial” when “the parties had served extensive infringement and invalidity contentions, served opening and rebuttal expert reports, filed claim construction briefs, and conducted several depositions” and “[t]he court also had held a claim construction hearing and construed the disputed claim terms”).

D. Factor 4: There Is Significant Overlap Between Issues Raised In This Petition And In The Parallel Litigation

This factor weighs against institution given the significant overlap between the Petition and the Parallel Litigation. The Parallel Litigation involves the same 298 Patent as this proceeding, along with seven additional patents. *See* Ex. 1082, ¶2.

Further, the Parallel Litigation already involves the three grounds raised in the Petition. Specifically, the Parallel Litigation involves U.S. Patent Pub. Appl. No. 2011/0096601, which is the patent application publication leading to the Gavens patent (U.S. Patent No. 8,634,240, Ex. 1045) that Petitioner relies on in its first single-reference obviousness ground. The Parallel Litigation also involves the same Moshayedi (Ex. 1043) and Sutardja (Ex. 1042) references that Petitioner relies on in its second and third single-reference obviousness grounds. Petitioner Kingston identified and charted these references as primary references for the 298 Patent in its Invalidity Contentions. *See* Ex. 2014, 78-79 (referencing charts included in “Exhibit A – 101” (relying on Moshayedi), “Exhibit A – 107” (relying on Sutardja), and “Exhibit A – 109” (relying on “Gavens ’601”)).

Despite this significant overlap, ***Petitioner has not filed a Sotera stipulation or any other stipulation*** to mitigate concerns of duplicative efforts between the District Court and the Board, as well as any concerns regarding potentially conflicting decisions. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (P.T.A.B. Dec. 1, 2020). If this Petition is instituted, Petitioner may

rely on the same grounds both before the Board and in the Parallel Litigation, including in its expert report and at trial.

Thus, this factor weighs heavily against institution. *See NXP USA*, PGR2022-00005, Paper 18 at 11-12 (weighing factor 4 in favor of discretionary denial when the petitioner “d[id] not offer a stipulation” and “assert[ed] the same prior art in both proceedings”).

E. Factor 5: The Parties Are The Same In Both Proceedings

The Petitioner and the defendant in the Parallel Litigation “are the same party,” so “this factor weighs in favor of discretionary denial.” *NXP USA*, PGR2022-00005, Paper 18 at 12.

F. Factor 6: Other Circumstances Weigh Against Institution

1. The Merits Of The Petition Are Weak

Each of Petitioner’s single-reference obviousness grounds are weak on the merits. As outlined below, clear flaws in Petitioner’s cursory presentation of each of its grounds underscore the Petition’s weak merits.⁴

⁴ Patent Owner expects to file a “Preliminary Response On The Merits And Other Non-Discretionary Considerations” by June 20, 2025, which will provide a more detailed and technical explanation of the Petition’s numerous substantive weaknesses. Patent Owner’s arguments here focus on threshold deficiencies in

Ground 1, Gavens (Petition, 21-38): Petitioner’s Gavens ground fails to provide a coherent analysis for limitation [1f]. *See* Petition, 29-30.

Specifically, limitation [1f] requires a “*maintaining a count* of the number of times each...block[] is accessed.” Petitioner fails to identify with particularity which prior art disclosure it is mapping to this limitation, particularly with respect to “maintaining a count.” Petition, 29-30. Instead, Petitioner takes a scattershot approach, ambiguously referencing multiple unrelated disclosures that mention a “count,” without explaining how they are mapped—individually or in combination—to the claims. *See* Ex. 2001, ¶¶98-99.

Petitioner first cites Gavens’s “hot count” but then also relies on Lee (Ex. 1050) and Gorobets (Ex. 1049), which Gavens allegedly incorporates by reference, citing their unrelated teachings on maintaining “counts” for memories. Petition, 30. However, Petitioner provides no explanation of how Lee and/or Gorobets—which do not describe the same embodiments as Gavens—apply to or combine with Gavens’s disclosure. Petitioner cannot simply cherry-pick distinct teachings from different references without articulating how they are mapped to the claims. *See Captioncall, LLC v. Ultratec, Inc.*, No. IPR2020-01215, 2021 WL 278381, at *7

Petitioner’s grounds that are alone dispositive—Petitioner’s failure to explain its grounds with particularity, and failure to clearly map the cited prior art to the claims.

(P.T.A.B. Jan. 27, 2021) (denying institution when petitioner relied on “distinct” embodiments from a reference and another reference that was incorporated by reference, explaining that “[a]nticipation requires all elements arranged as in the claim without the need to pick and choose elements from different disclosures”); *Nearmap US, Inc. v. Eagle View Technologies, Inc.*, IPR2024-00716, Paper 9 at 18 (P.T.A.B. Oct. 9, 2024) (denying institution of *inter partes* review, explaining that “[t]he question before us is not whether we could come up with a way to understand how the asserted prior art could render the challenge claims unpatentable, but rather did Petitioner provide the arguments and evidence to show that the challenged claims are unpatentable.”).

Further, for limitation [1f], the Petitions offers only an anticipation analysis, asserting that “Gavens and incorporated references *disclose* the determining [the count].” Petition, 30 (emphasis added). The Petition includes no obviousness analysis for this limitation—failing to explain, for example, why a person of ordinary skill would have combined the unrelated teachings of Gavens, Lee, and Gorobets. *Id.*; see also *In re Stepan Co.*, 868 F.3d 1342, 1346 n.1 (Fed. Cir. 2017) (“Whether a rejection is based on combining disclosures from multiple references, combining multiple embodiments from a single reference, or selecting from large lists of elements in a single reference, there must be a motivation to make the combination

and a reasonable expectation that such a combination would be successful, otherwise a skilled artisan would not arrive at the claimed combination.”).

Thus, “[i]t is the petitioner’s burden to present a clear argument,” and it has failed to do so. *Netflix, Inc. v. DivX, LLC*, 84 F.4th 1371, 1377 (Fed. Cir. 2023). “It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’” *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (quoting 35 U.S.C. § 312(a)(3)).

Therefore, Petitioner’s cursory Gavens ground, including its inadequate and deficient explanation for limitation [1f], is weak on the merits.

Ground 2, Moshayedi (Petition, 39-51): Petitioner’s Moshayedi ground similarly lacks adequate explanation, and is weak on the merits.

First, limitation [1b] requires “at least one SLC non-volatile memory module *comprising a plurality of individually erasable blocks.*” Petitioner provides only a cursory, single-sentence analysis for this limitation, entirely omitting any discussion of the claimed “individually erasable blocks.” Petition, 40. Thus, the Petition’s deficient Ground 2 analysis should be rejected for this reason alone. *See Nearmap*, IPR2024-00716, Paper 9 at 18.

Notwithstanding, for this limitation, Petitioner supports its Ground with a single citation to Moshayedi. Petition, 40. However, even that citation cannot save Petitioner's ground. Petitioner cites "Fig. 1(112)," but this figure says nothing about "individually erasable blocks" and, instead, depicts only SLC. Ex. 1043, Fig. 1; Ex. 2001, ¶109.

Finally, Petitioner cites two paragraphs of its expert declaration but fails to provide any analysis from those paragraphs in the Petition itself. Petition, 40 ("See [Sechen ¶¶ 167-68]"). Petitioner cannot simply cite its expert declaration while omitting arguments/analysis from the Petition regarding Petitioner's mapping of prior art to claim language. 37 C.F.R. § 42.6(a)(3); *Acon Inc. v. Amo Dev., LLC*, IPR2021-00858, 2022 WL 17585777, at *16 (P.T.A.B. Dec. 12, 2022) ("arguments may not be incorporated from an expert's declaration wholesale into the [p]etition").

Second, Petitioner's analysis for limitation [1d] is similarly deficient. Here, Petitioner fails to identify how Moshayedi discloses a "list of logical address ranges having a *minimum quanta of addresses*." Petition, 41; Ex. 2001, ¶¶110-111.

Petitioner references several paragraphs from Moshayedi that generically relate to "a logical block address...mapped to a location within a physical block" (Petition, 41) but fails to correlate these teachings with the claim language, including the "minimum quanta of addresses." Petition, 41 (citing Ex. 1043, ¶¶6, 36-39, 44).

Petitioner cannot simply cite Moshayedi without explaining how it discloses what is claimed. *See DeSilva v. DiLeonardi*, 181 F.3d 865 (7th Cir. 1999) at 866-67.

Still, even when considered individually, these citations do not show that Moshayedi discloses or suggests the “minimum quanta of addresses.” Paragraphs 6 and 44 disclose logical-to-physical mapping but do not describe a minimum quanta of addresses. *See* Ex. 1043, ¶¶6 (“logical block address (‘LBA’)”), 44 (“assigning LBA to physical address”). Similarly, paragraphs 36-39 disclose a “controller architecture” and “virtual-to-physical mapping” but do not describe a minimum quanta of addresses. *See id.*, ¶¶36-39; *see also Amazon.com, Inc., et al. v. Avago Technologies General IP (Singapore) PTE. LTD.*, IPR2017-01112, Paper 11 at 13 (P.T.A.B. Aug. 23, 2017) (“Petitioner is inviting us to assume the role of archeologist of the record, which invitation we decline.”); *Netflix, Inc. v. DivX, LLC*, 84 F.4th 1371, 1379 (Fed. Cir. 2023) (“While the Board should review a petition holistically, it is not obligated to cobble together assertions from different sections of a petition or citations of various exhibits in order to infer every possible permutation of a petitioner’s argument.” (cleaned up)).

Accordingly, Petitioner did not meet its burden to map limitations [1b] and [1d] with particularity, and Petitioner’s ambiguous challenges are weak on the merits. *See* 35 U.S.C. § 312(a)(3).

Ground 3, Sutardja (Petition, 52-66): Petitioner’s Sutardja ground is similarly deficient.

For example, for limitation [1g], Petitioner ambiguously references multiple embodiments from Sutardja without clarifying how these embodiments map to limitation [1g]. Petition, 58 (citing *Fig. 7A* and ¶146, as describing the “transfer to SLC...of the most frequently written LBAs”), 58-59 (citing *Fig. 7C* and ¶149, describing mapping based on “the number of write operations to [a] first physical block...during a predetermined time”), 59 (citing *Fig. 7E* and ¶153, describing mapping based on whether “the wear level of...MLC...is greater than a predetermined threshold”).

The Petition ambiguously references the disclosure of each of these embodiments but does not clearly state how it is mapping them to the claims, including whether it is presenting these embodiments in the alternative or relying on some kind of combination of all three (for which Petitioner did not provide the required obviousness analysis). *See* Petition, 58-59. This ground is plainly deficient on this basis alone. *See also GN Resound A/S v. Oticon A/S*, IPR2015-00103, Paper 13 at 6 (P.T.A.B. Jun. 18, 2015) (denying institution on certain grounds, explaining that “[e]ssentially, Petitioner requires the Board to search through the cited portions of [the prior art] to map prior art disclosure with claim elements. It is a requirement of a Petition to align the evidence and arguments with the various limitations of the

challenged claims”); *A.C. Dispensing Equip. Inc. v. Prince Castle LLC*, IPR2014-00511, Paper 6 at 5-6 (P.T.A.B. Sept. 10, 2014) (“Petitioner should not expect the Board to search the record and piece together the evidence necessary to support Petitioner’s arguments.”); *Masimo Corp. v. Apple Inc.*, IPR2023-00745, Paper 44 (final written decision) at 36 (P.T.A.B. Oct. 15, 2024) (determining that the challenged claim is not unpatentable, explaining: “In essence, Petitioner invites the Board to piece together a single theory that meets all claim elements from these disparate theories that each require distinct structures....”) (citing *Amazon.com, Inc., et al. v. Avago Technologies General IP (Singapore) PTE. LTD.*, IPR2017-01112, Paper 11 at 13 (P.T.A.B. Aug. 23, 2017)).⁵

Accordingly, the Petition’s weak merits weigh heavily against institution. *See also* Ex. 2015, 2 (stating that “The strength of the unpatentability challenge” should be considered in determining whether to discretionarily deny a petition).

⁵ In Dr. Khatri’s concurrently filed declaration—previously filed with the patent owner preliminary response in IPR2025-00212—Dr. Khatri further explains how, even when considered individually, each embodiment of Sutardja that Petitioner cites does not disclose the requirements of limitation [1g]. *See* Ex. 2001, ¶¶139-146.

2. The Petition Relies Heavily On Expert Testimony

“The extent of the petition’s reliance on expert testimony” should also be considered in assessing whether to exercise discretion to deny institution. Ex. 2015, 2. This Petition is heavily reliant on expert testimony. Petitioner’s obviousness grounds—based on Gavens, Moshayedi, and Sutardja, respectively, “*in view of a POSITA’s knowledge of NAND flash technology*” (Petition, 16-17)—relies on expert testimony to establish what they contend would have been the relevant knowledge of a POSA, including how a POSA would have artificially reconstructed these references to fit the language of the Challenged Claims. For example, Petitioner relies on what they contend—based on expert testimony—was “well-known to the POSITA[.]” See Petition, 53, 60. Petitioner’s substantial reliance on expert testimony underscores that these arguments are more appropriately resolved in the Parallel Litigation—further supporting discretionary denial.

3. The Challenged Patent Belongs To A Family Of Patents With Settled Expectations

The “[s]ettled expectations of the parties, such as the length of time the claims have been in force” should also be considered in assessing whether to exercise discretion to deny institution. Ex. 2015, 2. Here, the first four Vervain Patents—including the 298 Patent challenged here—were successfully litigated in the Prior Litigation. See *supra* Sections II.A and II.B.3. This family of patents, which claims priority to 2011, embodies the inventions of a single inventor, Dr. G. R. Mohan Rao.

The longstanding nature of these patents and the settled expectations surrounding Dr. Rao's inventions further support discretionary denial.

4. Instituting This Petition Would Be An Inefficient Use Of The Board's Resources

Rather than presenting a limited number of well-supported grounds, the Petition asserts three cursory grounds of questionable merit. If instituted, the Board would be obligated to evaluate and issue a final written decision on each of these deficient grounds, requiring an unnecessary expenditure of resources. The Petition's presentation of three weak, single-reference obviousness challenges thus further supports discretionary denial under 35 U.S.C. §314(a). *See Chevron Oronite Co. v. Infineum USA L.P.*, IPR2018-00923, Paper 9 at 10–11 (P.T.A.B. Nov. 7, 2018) (informative); *Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7 at 41–43 (P.T.A.B. Jan. 24, 2019) (informative).

5. Instituting This Petition Would Unnecessarily Burden The Board's Resources

Finally, Petitioner filed separate petitions challenging only two of the eight patents asserted in the Parallel Litigation. The purpose of discretionary denial is to “allay[] concerns about inefficiency and duplication of efforts.” *Fintiv*, Paper 11 at 6. Instituting two separate IPRs to address only some of the issues currently being addressed in the single, mature district court case would be inefficient and an unnecessary expenditure of the Board's resources.

This inefficiency is further illustrated by the mismatch in scope: while Petitioner challenged 11 claims in this Petition, PO is currently asserting only 5 claims from the Challenged Patent in the Parallel Litigation. And the number of asserted claims may decrease when the parties “meet and confer...to discuss significantly narrowing the number of claims asserted” by June 6, 2025. Ex. 2003,2-3. Requiring the Board to adjudicate at least six additional claims not asserted in the Parallel Litigation would impose an unnecessary burden—especially given that the validity of the asserted claims will already be resolved at trial, as explained above.

Thus, all *Fintiv* factors—including multiple additional circumstances—weigh against institution, and the Director should exercise her discretion to deny institution under 35 U.S.C. § 314(a).

IV. CONCLUSION

For the foregoing reasons, the Director should exercise her discretion to deny institution.

Date: May 20, 2025

Respectfully submitted,

/Alan Whitehurst/

Alan Whitehurst
Reg. No. 43,263
awhitehurst@mckoolsmith.com
Arvind Jairam
Reg. No. 62,759
ajairam@mckoolsmith.com
Christopher McNett
Reg. No. 64,489
cmcnett@mckoolsmith.com
Christian Dorman
Reg. No. 79,118
cdorman@mckoolsmith.com
McKool Smith, P.C.
1717 K St. NW, Suite 1000
Washington, DC 20006
Telephone: (202) 370-8300
Facsimile: (202) 370-8344

Counsel for Patent Owner

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. §42.24(d), Patent Owner hereby certifies that the word count for the foregoing **PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION** is 5,391 words, which is within the limit set in 37 C.F.R. §42.24(b)(1). This word count does not include the table of contents, table of authorities, exhibit list, certificate of word count, and certificate of service. This word count was prepared using Microsoft Word.

Date: May 20, 2025

By: */Alan Whitehurst/*
Alan Whitehurst, Reg. No. 43,263

CERTIFICATE OF SERVICE

I hereby certify, in accordance with 37 C.F.R. § 42.205, that the foregoing **PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION** was served via electronic mail on May 20, 2025 on the following counsel of record for Petitioner:

Cono A. Carrano
ccarrano@akingump.com
Ryan S. Stronczer
rstronczer@akingump.com
Brock F. Wilson
bfwilson@akingump.com
Akin Gump Strauss Hauer & Feld LLP
2001 K St. NW
Washington, DC 20006
Telephone: (202) 887-4000
Facsimile: (202) 887-4288

George Andrew Lever Rosbrook
arosbrook@akingump.com
Akin Gump Strauss Hauer & Feld LLP
112 E. Pecan Street, Suite 1010
San Antonio, TX 78205
Telephone: (210) 781-7026

AG-KINGSTON-VERVAIN@akingump.com

Dated: May 20, 2025

By: /Alan Whitehurst/
Alan Whitehurst, Reg. No. 43,263