

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

**PETITIONERS' MOTION FOR JOINDER
TO *INTER PARTES* REVIEW IPR2025-00212**

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Kingston Technology Company, Inc., Kingston Technology Corporation, and Kingston Digital, Inc. (collectively, “Kingston” or “Petitioners”) respectfully submit this Motion for Joinder, concurrently with their Petition for *inter partes* review of U.S. Patent No 8,891,298 (“the ’298 Patent”), pursuant to 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22 and 42.122(b). This request is being submitted within the time set forth in 37 C.F.R. § 42.122(b).

On November 25, 2024, Phison Electronics Corp. (“Phison”) filed its Petition for IPR in *Phison Electronics Corporation v. Vervain, LLC*, Case No. IPR2025-00212 (“the Phison 298 IPR”). Kingston’s petition challenges the same claims (1-11) and presents the same prior art and invalidity grounds at issue in the Phison 298 IPR.

Kingston’s request for joinder is timely because the Board has not yet issued an institution decision in Phison 298 IPR. Further, Kingston’s request is consistent with the policy surrounding *inter partes* reviews, as it is the most expedient way “to secure the just, speedy, and inexpensive resolution of every proceeding.” *See* 37 C.F.R. § 42.1(b); *see also HTC v. Parthenon Unified Memory Architecture LLC*, IPR2017-00512, Paper No. 12 at 5-6 (June 1, 2017). Kingston’s petition and the petition in the Phison 298 IPR are substantively identical with respect to the asserted grounds, based on the same prior art combination and supporting evidence, and challenge the same claims (*i.e.*, Kingston’s Petition is a “copycat” petition). Upon

joining the Phison 298 IPR, Kingston will act as an “understudy” and will not assume an active role unless Phison settles with Patent Owner (or otherwise ceases to participate in the IPR).

Accordingly, the proposed joinder will neither unduly complicate the Phison 298 IPR nor delay its schedule. As such, the joinder will promote judicial efficiency in determining the patentability of the '298 Patent without prejudice to Patent Owner.

Kingston has met and conferred with Phison's counsel of record in the Phison 298 IPR. Phison does not oppose Kingston's motion for joinder.

II. RELATED MATTERS

The '298 Patent is asserted against Kingston in *Vervain, LLC v. Kingston Technology Company, Inc. et al*, C.A. No. 1:24-cv-00254 (W.D.T.X.) (“Kingston WDTX Action”).

The '298 Patent is also at issue in the following pending actions:

- *Vervain, LLC v. Phison Electronics Corp.*, C.A. No. 1:24-cv-00259 (W.D.T.X.) (“Phison WDTX Action”); and
- *Phison Electronics Corporation v. Vervain, LLC*, IPR2025-00212 (PTAB) (“Phison 298 IPR”).

The '298 Patent was formerly at issue in the following terminated actions:

- *Vervain, LLC v. Micron Technology, Inc. et al*, C.A. No. 6-21-cv-00487 (W.D.T.X.) (“Micron WDTX Action”);

- *Vervain, LLC v. Western Digital Corp. et al*, C.A. No. 6-21-cv-00488 (W.D.T.X.) (“Western Digital WDTX Action”); and
- *Micron Technology, Inc. v. Vervain, LLC*, IPR2021-01547 (PTAB) (“Micron 298 IPR”).

III. STATEMENT OF MATERIAL FACTS

1. On May 10, 2021 Vervain filed its Complaint in the Micron WDTX Action asserting, *inter alia*, the '300 Patent.
2. On May 10, 2021 Vervain filed its Complaint in the Western Digital WDTX Action asserting, *inter alia*, the '300 Patent.
3. On September 21, 2021, Micron Technology, Inc. (“Micron”) filed its petition in the Micron 298 IPR requesting cancellation of claims 1-12 of the '298 Patent.
4. On April 8, 2022, the Board instituted the Micron 298 IPR as to all claims and all grounds.
5. On April 4, 2023, the Board granted the parties' joint motion to terminate the Micron 298 IPR pursuant to a settlement agreement.
6. On April 21, 2023, Vervain voluntarily dismissed the Micron WDTX Action.
7. On August 8, 2023, Vervain voluntarily dismissed the Western Digital WDTX Action.

8. On March 7, 2024, Vervain filed its Original Complaint in the Kingston WDTX Action asserting, *inter alia*, the '300 Patent. Kingston was served with the Original Complaint on March 11, 2024.
9. On March 8, 2024, Vervain filed its Original Complaint in the Phison WDTX Action asserting, *inter alia*, the '300 Patent.
10. On November 25, 2025, Phison filed its petition in the Phison 298 IPR. The Phison 298 IPR challenges the same claims and presents the same prior art and grounds as the Micron 298 IPR.
11. Kingston's petition and Phison's petition in the Phison 298 IPR are substantively identical. Both petitions contain the same grounds (based on the same prior art combinations and supporting evidence) against the same claims, using the same evidence and arguments.

IV. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

The Board may grant a motion for joining an *inter partes* review petition with another *inter partes* review proceeding. *See* 35 U.S.C. § 315(c). A petitioner may request joinder up to one month after the institution date of the proceeding to which joinder is requested, without prior authorization. 37 C.F.R. § 42.122(b). The Board, in determining whether to exercise its discretion to grant a motion for joinder, considers: (1) Petitioner's explanation why joinder is appropriate, (2) whether any

new grounds of unpatentability are asserted in the second petition, (3) what impact, if any, joinder would have on the cost and schedule for the existing proceeding, and (4) whether granting joinder will add to the complexity of briefing and/or discovery. *Samsung Elecs. Co. Ltd., v. Demaray LLC*, IPR2021-01091, Paper 8 at 9-10 (PTAB Dec. 20, 2021) (citing Consolidated Trial Practice Guide, 76 (Nov. 2019) (<https://www.uspto.gov/TrialPracticeGuideConsolidated>) (citing *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013))).

B. Kingston's Motion is Timely

Kingston's Motion for Joinder is timely. A petitioner may request joinder "no later than one month after the institution date" of the original IPR. 37 C.F.R. § 42.122(b). Motions for joinder that are filed before institution of the related IPR comply with this rule. *Id.* at 8; *see also, e.g., ZyXEL Communications Corp. v. Unm Rainforest Innovations*, IPR2021-00739, Paper 17 at 15 (PTAB Oct. 1, 2021) (motion for joinder not premature when filed before institution decision); *Dell Inc. v. Neodron Ltd.*, IPR2020-00731, Paper 9 at 5 (PTAB July 31, 2020); *Pfizer, Inc. v. Genentech, Inc.*, IPR2017-02063, Paper 25 at 3-4 (PTAB Feb. 21, 2018).

As noted above, the Phison 298 IPR was filed on November 25, 2024 and the Board has not issued an institution decision as of this Motion's filing. Thus, Kingston is filing this motion for joinder within the time limit enumerated in 37 C.F.R. § 42.122(b).

Kingston requests that action on this Motion be held in abeyance until, and granted only if, the Board institutes the Phison 300 IPR. Central Security Group — Nationwide, Inc. v. Ubiquitous Connectivity, LP, IPR2019-01609, Paper 11 at 9 (PTAB Feb. 26, 2020). If Phison terminates its involvement prior to an institution decision, or if the Board denies institution of the Phison 300 IPR, Kingston requests that this Motion be withdrawn as moot and that Kingston's Petition be considered on the merits under Kingston's full control, as Kingston is not estopped from requesting IPR of the '300 Patent at the time of this filing.

Further, Kingston's Petition and this Motion are timely under 35 U.S.C. § 315. As set forth in Kingston's Petition, the '298 Patent is one of eight patents asserted by Patent Owner in the Kingston WDTX Action. Kingston was served with the Original Complaint asserting, *inter alia*, the '298 Patent in the Kingston WDTX Action on March 11, 2024. Accordingly, the Kingston's Petition and this Motion are timely under 35 U.S.C. § 315.

C. All Four Joinder Factors Weighs in Favor of Kingston

Kingston's petition is substantively identical to the petition in the Phison 298 IPR. Further, Kingston does not present any new grounds of unpatentability. Additionally, as Kingston will act as an "understudy" with respect to Phison, joinder will have minimal or no impact on the pending schedule of the Phison 298 IPR. *See Sony Corp. et al. v. Memory Integrity, LLC.*, IPR2015-01353, Paper No. 11 at 6

(PTAB Oct. 15, 2015) (granting motion for joinder where petitioners requested an “understudy” role). Moreover, the briefing and discovery will be simplified by resolving all issues in a single proceeding. Accordingly, joinder is appropriate.

1. Joinder with the Phison 298 IPR Is Appropriate

The Board “routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding.” *Samsung Elecs. Co., Ltd. v. Raytheon Co.*, IPR2016-00962, Paper No. 12 at 9 (PTAB Aug. 24, 2016) (internal quotations and citations omitted).

Here, joinder with the Phison 298 IPR is appropriate because Kingston's petition presents identical arguments and the same grounds raised in the Phison 298 IPR. Kingston challenges the same claims of the same patent, relies on the same expert declaration, and is based on the same grounds and combinations of prior art submitted in the Phison 298 IPR.

Kingston's Petition is substantively identical to the Phison 300 IPR petition, containing only minor differences related to the formalities of a different party filing the petition and discretionary denial analysis specific to Kingston.¹ Because these proceedings are substantively identical, good cause exists for joinder with the Phison 298 IPR, consistent with 37 C.F.R. § 42.1(b), so that the Board can efficiently

¹ For example, Kingston's Petition contains a brief discussion of *Advanced Bionics* with respect to discretionary denial under 35 U.S.C. § 325(d) as it pertains to Kingston. *See* Kingston's Petition at 66.

“secure the just, speedy, and inexpensive resolution” of Kingston’s and Phison’s petitions in a single proceeding.

2. Kingston’s Petition Does Not Propose New Grounds

As noted above, Kingston’s petition is substantively identical to the petition in the Phison 298 IPR. It challenges the same claims of the ’298 Patent, presents the same grounds and combinations of prior art, and relies on the same expert declaration submitted in the Phison 298 IPR. *See Sony*, IPR2015-01353, Paper No. 11 at 5 (granting institution of IPR and motion for joinder where petitioners relied “on the same prior art, same arguments, and same evidence, including the same expert and a substantively identical declaration”); *see also Par Pharm., Inc. v. Novartis AG*, IPR2016-01023, Paper No. 20 at 14 (PTAB Oct. 27, 2016) (granting motion for joinder where petitioners “do not assert any new ground of unpatentability that is not already being considered in [an instituted IPR proceeding], rely on the same arguments and evidence, and do not require any modification to the existing schedule”).

3. Joinder Will Not Negatively Impact the Phison 298 IPR Trial Schedule

Joinder will have minimal impact, if any, on the Phison 298 IPR’s trial schedule. Because Kingston’s petition presents no new issues or grounds of unpatentability, there are no new issues for Patent Owner to address. *See Sony*, IPR2015-01353, Paper No. 11 at 6 (granting IPR and motion for joinder where

“joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR]”). Further, Kingston expressly agrees that it will consent to the Phison 298 IPR trial schedule should the Board institute the Phison 298 IPR. Thus, there are no new issues for the Board to address, and Patent Owner will not be required to present any additional responses or arguments.

The Patent Owner's Response will also not be negatively impacted because the issues presented in Kingston's petition are identical to the issues presented in the Phison 298 IPR. Patent Owner will not be required to provide any additional analysis or arguments beyond what it will already provide in responding to the petition in the Phison 298 IPR. As Kingston's petition relies on the same expert declaration as Phison, only a single deposition is needed for the proposed joined proceeding.

Accordingly, joinder with the Phison 298 IPR will not unduly burden or negatively impact the existing trial schedule.

4. Procedures to Simplify Briefing and Discovery

Kingston explicitly agrees to take an “understudy” role, which will simplify briefing and discovery. Kingston only contemplates that it would assume the role of primary petitioner in the Phison 298 IPR if: (1) Phison is terminated as a party to the proceeding or (2) Phison ceases participating in the proceeding such that the proceeding is no longer “meaningfully adversarial,” contrary to the public interest.

See ZTE (USA), Inc. v. CyWee Grp. Ltd., IPR2019-00143, Paper 50 at 7-9 (PTAB July 17, 2020) (allowing a joinder petitioner to assume the role of primary petitioner with respect to a motion to amend because the “trial no longer appears to be meaningfully adversarial” where the primary petitioner did not oppose revised amended claims).

As an understudy, Kingston agrees, upon joining the Phison 298 IPR, that the following conditions shall apply so long as Phison remains an active party in the Phison 298 IPR:

- a) All filings by Kingston in the joined proceeding be consolidated with Phison's, unless a filing solely concerns issues that do not involve Phison;²
- b) Kingston shall not raise any new grounds not already instituted by the Board in the Phison 298 IPR, or introduce any argument or discovery not already introduced by Phison without first seeking leave from the Board;
- c) Kingston shall be bound by any agreement between Patent Owner and Phison concerning discovery and/or depositions; and

² Circumstances may require Kingston to request and file separate papers with respect to its individual status as petitioner in the proceeding—*e.g.*, a motion to terminate.

- d) Kingston at deposition shall not, without first seeking leave from the Board, receive any direct, cross examination or redirect time beyond that permitted for Phison in this proceeding alone under either 37 C.F.R. § 42.53 or any agreement between the Patent Owner and Phison.

See, e.g., Mylan Pharms. Inc. v. Novartis AG, IPR2015-00268, Paper 17 at 5 (PTAB April 10, 2015) (granting motion for joinder subject to identical conditions).

Thus, Kingston's acceptance of an understudy role will allow the Phison 298 IPR to proceed without any delay or needing any duplicative efforts by the Board or the Patent Owner. *See Sony*, IPR2015-01353, Paper No. 11 at 6-7 (granting IPR and motion for joinder because "joinder would increase efficiency by eliminating duplicative filings and discovery and would reduce costs and burdens on the parties as well as the Board" where petitioners agreed to an "understudy" role). Kingston is further willing to agree to any other reasonable conditions the Board deems necessary.

V. GENERAL PLASTIC IS INAPPLICABLE

As explained in Kingston's petition, application of the *General Plastic* analysis is not appropriate here as it relates to the Phison 298 IPR. *See Kingston Petition*, Paper No. 1 at §XII.C.

In *General Plastic*, the Board set forth a series of factors that may be analyzed with respect to "follow-on" petitions to help conserve the finite resources of the

Board and prevent a subsequent petitioner from gaining a strategic advantage from filing a later petition. *See General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, slip op. at 16 (PTAB Sept. 6, 2017) (Paper 19) (precedential as to § II.B.4.i).

Kingston submits that *General Plastic* does not apply in this circumstance. Kingston's petition is not a "follow-on," at least because: (1) Kingston has not previously filed an IPR against any claim of the '298 Patent, (2) Kingston's petition is substantively identical to the petition in the Phison 298 IPR, and (3) Kingston seeks to join the Phison 298 IPR as an understudy. As such, this is not the type of "serial" petition to which *General Plastic* applies.

However, in the event the Board does analyze the *General Plastic* factors, those factors heavily weigh in favor of instituting the present IPR, as discussed in detail in §XII.C of Kingston's Petition.

VI. CONCLUSION

For the reasons discussed above, Kingston respectfully requests that the Board grant Kingston's petition and grant joinder with IPR2025-00212.

Date: February 21, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§42.6(e), 42.8(b)(4), and 42.105, the undersigned certifies that that a copy of the foregoing Motion for Joinder was served by filing this document through the P-TACTS System on February 21, 2025, as well as delivering a copy via overnight mail on the correspondence address of record for the subject patent:

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