

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioner

v.

**VERVAIN, LLC,**

Patent Owner

**PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR  
DISCRETIONARY DENIAL UNDER 35 U.S.C. § 314(a)**

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1001	U.S. Patent No. 8,891,298, titled “LIFETIME MIXED LEVEL NON-VOLATILE MEMORY SYSTEM,” to Rao
1002	Declaration of Carl Sechen, Ph.D.
1003	U.S. Provisional Application No. 61/509,257, titled “IMPROVED LIFETIME MIXED LEVEL NAND FLASH SYSTEM” by Rao
1004	U.S. Patent No. 7,855,916, titled “NONVOLATILE MEMORY SYSTEMS WITH EMBEDDED FAST READ AND WRITE MEMORIES,” to Rao
1005	Original Complaint, ECF No. 1, Vervain, LLC v. Kingston Technology Company, Inc. et al, No. 1:24-cv-00254 (W.D. Tex.)
1006	Excerpts from prosecution history of ’298 patent
1007-24	<i>Intentionally omitted</i>
1025	Excerpts from Rino Micheloni, et al., INSIDE NAND FLASH MEMORIES (Springer 2010)
1026	Excerpts from NONVOLATILE MEMORY TECHNOLOGIES WITH EMPHASIS ON FLASH: A COMPREHENSIVE GUIDE TO UNDERSTANDING AND USING NVM DEVICES (Joe E. Brewer & Manzur Gill eds. Wiley-IEEE Press 2008)
1027	Excerpts from MICROSOFT COMPUTER DICTIONARY (5 <sup>th</sup> ed. 2002)
1028-29	<i>Intentionally omitted</i>
1030	Yu Cai et al., <i>Program Interference in MLC NAND Flash Memory: Characterization, Modeling and Mitigation</i> (IEEE 2013)
1031	Kang-Deog Suh et al., <i>A 3.3 V 32 Mb NAND Flash Memory with Incremental Step Pulse Programming Scheme</i> , 30 IEEE J. Solid State Circuits 1149 (Nov. 1995)

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1032	Eitan Yaakobi et al., <i>Error Characterization and Coding Schemes for Flash Memories</i> (2010 IEEE Globecom Workshops, Miami, FL at 1856-60)
1033	Evans, Chris, “Enterprise MLC: How flash vendors are boosting MLC write endurance” (June 3, 2011)
1034	Nelson Duann, SLC & MLC Hybrid (Silicon Motion Flash Memory Summit, Santa Clara, CA, Aug. 12, 2008)
1035	Ashish Jagmohan et. al., <i>Adaptive Endurance Coding for NAND Flash</i> (2010 IEEE Globecom Workshops, Miami, FL at 1841-45)
1036	Sungjin Lee et al., <i>FlexFS: A Flexible Flash File System for MLC NAND Flash Memory</i> (2009 USENIX Annual Technical Conference, San Diego, CA, June 14-19, 2009)
1037	Minyoung Sung & Kanghee Kim, <i>Asymmetric Flash Volume Management</i> , 58 <i>IEEE Transactions on Consumer Electronics</i> 455 (May 2012)
1038	Greg Atwood et al., <i>Intel StrataFlash™ Memory Technology Overview</i> at 4, <i>Intel Technology J.</i> (Q4 1997)
1039	Taehee Cho et al., “A 3.3 V 1 Gb multi-level NAND flash memory with non-uniform threshold voltage distribution,” <i>2001 IEEE International Solid-State Circuits Conference. Digest of Technical Papers</i> , ISSCC (Cat. No. 01CH37177) (2001)
1040	U.S. Patent No. 6,456,528, titled for “SELECTIVE OPERATION OF A MULTI-STATE NON-VOLATILE MEMORY SYSTEM IN A BINARY MODE” to Chen
1041	U.S. Patent No. 8,078,794, titled “HYBRID SSD USING A COMBINATION OF SLC AND MLC FLASH MEMORY ARRAYS,” to Lee et al.
1042	U.S. Patent Appl. Pub. No. 2008/0140918, titled “HYBRID NON-VOLATILE SOLID STATE MEMORY SYSTEM” by Sutardja

<b>Exhibit</b>	<b>Description</b>
1043	U.S. Patent Appl. Pub. No. 2009/0327591, titled “SLC-MLC COMBINATION FLASH STORAGE DEVICE,” by Moshayedi
1044	U.S. Patent Appl. Pub. No. 2010/0172179, titled “SPARE BLOCK MANAGEMENT OF NON-VOLATILE MEMORIES,” by Gorobets et al.
1045	U.S. Patent No. 8,634,240, titled “NON-VOLATILE MEMORY AND METHOD WITH ACCELERATED POST-WRITE READ TO MANAGE ERRORS,” to Gavens et al.
1046	U.S. Patent No. 8,806,301, titled “DATA WRITING METHOD FOR A FLASH MEMORY, AND CONTROLLER AND STORAGE SYSTEM USING THE SAME,” to Yu et al.
1047	U.S. Patent Appl. Pub. No. 2010/0115192, titled “WEAR LEVELING METHOD FOR NON-VOLATILE MEMORY DEVICE HAVING SINGLE AND MULTI LEVEL MEMORY CELL BLOCKS,” by Lee
1048	U.S. Patent Appl. Pub. No. 2011/0271043, titled “SYSTEM AND METHOD FOR ALLOCATING AND USING SPARE BLOCKS IN A FLASH MEMORY,” to Segal et al.
1049	U.S. Patent Appl. Pub. No. 2011/0153912, titled “MAINTAINING UPDATES OF MULTI-LEVEL NON-VOLATILE MEMORY IN BINARY NON-VOLATILE MEMORY,” by Gorobets et al.
1050	U.S. Patent No. 5,930,167, titled “MULTI-STATE NON-VOLATILE FLASH MEMORY CAPABLE OF BEING ITS OWN TWO STATE WRITE CACHE,” to Lee et al.
1051	U.S. Patent Appl. Pub. No. 2010/0172180, titled “NON-VOLATILE MEMORY AND METHOD WITH WRITE CACHE PARTITIONING,” by Paley et al.
1052	<i>Intentionally omitted</i>

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1053	U.S. Patent Appl. Pub. No. 2009/0268513, titled “MEMORY DEVICE WITH DIFFERENT TYPES OF PHASE CHANGE MEMORY,” by De Ambroggi et al.
1054	U.S. Patent Appl. Pub. No. 2009/0307418, titled “MULTI-CHANNEL HYBRID DENSITY MEMORY STORAGE DEVICE AND CONTROL METHOD THEREFOR,” by Chen et al.
1055	U.S. Patent Appl. Pub. No. 2010/0058018, “MEMORY SCHEDULER FOR MANAGING INTERNAL MEMORY OPERATIONS,” by Kund et al.
1056-60	<i>Intentionally omitted</i>
1061	Duane H. Oto et al., <i>High-Voltage Regulation and Process Considerations for High-Density 5 V-Only E<sup>2</sup>PROM’s</i> , SC-18 IEEE J. Solid State Circuits 532 (Oct. 1983)
1062	Gheorghe Samachisa et al., <i>A 128K Flash EEPROM Using Double-Polysilicon Technology</i> , SC-22 IEEE J. Solid State Circuits 676 (Oct. 1987)
1063	Masaki Momodomi et al., <i>An Experimental 4-Mbit CMOS EEPROM with a NAND-Structured Cell</i> , 24 IEEE J. Solid State Circuits 1238 (Oct. 1989)
1064	Tae-Sun Chung et al., <i>A survey of Flash Translation Layer</i> , 55 J. Systems Architecture 332-43 (2009)
1065	Yoshiba Iwata et al., <i>A High-Density NAND EEPROM with Block-Page Programming for Microcomputer Applications</i> , 25 IEEE J. Solid-State Circuits 417 (Apr. 1990)
1066	Simona Boboila and Peter Desmoyers, <i>Write Endurance in Flash Drives: Measurements and Analysis</i> , Usenix Conference (Feb. 2010)
1067	SiliconSystems, <i>Increasing Flash SSD Reliability</i> , StorageSearch.com (April 2005)

<b>Exhibit</b>	<b>Description</b>
1068	Taehee Cho et al., <i>A Dual-Mode NAND Flash Memory: 1-Gb Multilevel and High-Performance 512-Mb Single Level Modes</i> , 36 IEEE J. Solid State Circuits 1700 (Nov. 2001)
1069	Ken Takeuchi, <i>A Multipage Cell Architecture for High-Speed Programming Multilevel NAND Flash Memories</i> , 33 IEEE J. Solid-State Circuits 1228 (Aug. 1998)
1070-77	<i>Intentionally omitted</i>
1078	Joint Claim Construction Statement, ECF No. 43, <i>Vervain, LLC v. Kingston Technology Company, Inc. et al</i> , No. 1:24-cv-00254 (W.D. Tex.)
1079	<i>Phison Electronics Corporation v. Vervain, LLC</i> , IPR2025-00212, Paper No. 2 (PTAB Nov. 25, 2024)
1080	Preliminary Claim Construction Order, <i>Vervain, LLC v. Kingston Technology Company, Inc. et al</i> , No. 1:24-cv-00254 (W.D. Tex.)
1081	Docket list for <i>Vervain, LLC v. Kingston Technology Company, Inc.</i> , No. 1:24-cv-00254 (W.D. Tex. filed March 7, 2024)
1082	First Amended Complaint, ECF No. 10 in <i>Vervain, LLC v. Kingston Technology Company, Inc. et al</i> , No. 1:24-cv-00254 (W.D. Tex.)
1083	Signed Agreed Scheduling Order, ECF No. 19 in <i>Vervain, LLC v. Kingston Technology Company, Inc. et al</i> , No. 1:24-cv-00254 (W.D. Tex.)
1084	“Interim Processes for PTAB Workload Management,” issued March 26, 2025
1085	Active Cases Before Judge Alan D. Albright as of June 2, 2025
1086	Statistics on Median Time-to-Trial between June 2, 2024 and June 2, 2025

<b>Exhibit</b>	<b>Description</b>
1087	“Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,” issued March 24, 2025
1088	Western District of Texas Calendar Year 2024 Statistical Public Report
1089	Amended Order Assigning the Business of The Court (January 31, 2025)
1090	Consolidated Trial Practice Guide (Nov. 2019)
1091	Email from PO’s Counsel re: Reduction to No More Than Five Asserted Claims Per Patent and Sixteen Total Across the Eight Patents-in-Suit (June 9, 2025)
1092	Docket list for <i>Vervain, LLC v. Micron Technology Inc., et al.</i> , No. 6:21-cv-00487 (W.D. Tex. filed May 10, 2021)
1093	Docket list for <i>Vervain, LLC v. Western Digital Corp. et al.</i> , No. 6:21-cv-00488 (W.D. Tex. filed May 10, 2021)
1094	First Amended Complaint, ECF No. 9 in <i>Vervain, LLC v. Phison Electronics Corp., No. 1:24-cv-00259</i> (W.D. Tex.)

## I. INTRODUCTION

Kingston Technology Company, Inc., Kingston Technology Corporation, And Kingston Digital, Inc., (“Kingston” or “Petitioner”) respectfully requests the Board deny Vervain, LLC’s (“Vervain’s” or “Patent Owner’s”) Request for Discretionary Denial of *inter partes* review (“IPR”) of U.S. Patent No. 10,950,300 (“the ’300 patent”) (Paper 8, “PO’s Request”), because the *Fintiv*<sup>1</sup> and other factors set forth in the Acting Director’s “Interim Processes for PTAB Workload Management” issued March 26, 2025 (“Director Memo”) do not warrant such a denial. The PTAB’s previous institution of proceedings in IPR2021-01550 further demonstrate that the “efficiency and integrity of the system are best served by . . . instituting review.” *Fintiv* at 6.

There is no evidence that the district court would deny a stay if one were requested (*Fintiv* Factor 1). In addition, as of June 2, 2025, Judge Albright has 273 active cases pending before him, and the scheduled trial date significantly deviates from the median time-to-trial and is subject to change (Factor 2).

Regarding Factor 3, discovery is still pending, no dispositive motions have been filed, a written claim construction order has not yet issued, and there has been

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<sup>1</sup> *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (precedential).

no meaningful investment by the court on the merits of invalidity. All of these conditions weigh against discretionary denial.

Regarding Factor 4, the majority of the Challenged Claims in this IPR will likely not be adjudicated in the parallel litigation, and the number of invalidating prior art references will likely be reduced before trial. Ex. 1091. Thus, there will be minimal overlap between the issues raised in the Petition and the district court proceeding. Petitioner has a clear interest in obtaining a determination on the validity of all Challenged Claims in this forum.

While Petitioner is also a defendant in the related district court action, that is true in the vast majority of IPR proceedings. Moreover, as stated above regarding Factor 4, there will be minimal overlap between the issues raised in the Petition and the district court proceeding, and thus substantially different issues are raised in the Petition than will likely be raised at trial in the district court proceedings. The identity of the parties should therefore be considered neutral to preserve the Board's role as an efficient and accessible forum for resolving patentability disputes (Factor 5).

Finally, the merits of the Petition are strong (Factor 6). The Board previously instituted IPR2021-01547 (the "Micron '298 IPR"), which was filed by Micron Technology, Inc., and challenged claims 1-5, 8-9, and 11 of the '298 Patent based on substantially the same foundational prior art, further reinforcing the strength of

the invalidity grounds presented here. The fact that the Micron '298 IPR was dismissed pursuant to a settlement agreement before a final written decision does not bear any weight on the fact at the Board found that the merits of this petition had a “reasonable likelihood” of success when instituting trial. *See* 35 U.S.C. § 314.

There are also no settled expectations to weigh against institution. To the contrary, Patent Owner has filed—and is likely to continue filing—parallel actions following the same enforcement pattern against Kingston and other industry members, including Kingston’s suppliers (*e.g.*, Phison). *See* Ex. 1094. Instituting this IPR would allow the Board to conclusively address the validity of all Challenged Claims in a single proceeding, thereby avoiding duplicative litigation and administrative actions, and conserving both judicial and party resources.

Taken together, these factors confirm that institution will promote procedural efficiency, reduce litigation burdens, and further the public interest in ensuring that only valid patent claims remain in force. Accordingly, the Director should decline to exercise her discretion to deny institution.

## **II. *FINTIV* DOES NOT SUPPORT DISCRETIONARY DENIAL**

### **A. Factor 1 Is Neutral: The Absence of a Stay Request Does Not Support Discretionary Denial**

Patent Owner’s argument that a stay is unlikely is speculative and should be given no weight. PO’s Request at 10-11. The Board has consistently held that it “will not attempt to predict how the district court ... will proceed” on the question of a

stay because “the court may determine whether or not to stay any individual case ... based on a variety of circumstances and facts.” *Sand Revolution II, LLC v. Continental Intermodal Group–Trucking LLC*, IPR2019-01393, Paper 24 at 7 (P.T.A.B. June 16, 2020) (informative); *see also Hulu, LLC v. SITO Mobile, Ltd.*, IPR2021-00298, Paper 11 at 10–11 (P.T.A.B. May 19, 2021).

While Petitioner has not yet sought a stay, courts frequently consider stay requests after institution. Notably, in *Sonrai Memory Ltd. v. Western Digital Technologies, Inc.*, the district court currently presiding over the parallel proceeding granted a stay pending the outcome of *inter partes* review even though the litigation had already reached an advanced stage. There, the court conducted a *Markman* hearing and opened fact discovery at a time when two of the three IPRs had not yet been instituted, and the PTAB’s final written decision for the last-filed IPR was expected to issue approximately four months after the scheduled trial date. Nonetheless, the Court determined that the potential for simplifying the issues through IPR outweighed the advanced procedural posture of the case and the fact that the expected date trial preceded the Board’s final written decision by several months. *See Sonrai Memory Ltd. v. Western Digital Technologies, Inc.*, 2022 WL 3108818 (W.D. Tex. Aug. 4, 2022).

Patent Owner also contends that a stay is unlikely because the Board has denied institution in two other proceedings to which Kingston is not a party—

PGR2024-00047 and PGR2024-00048—and, therefore, even if institution is granted in this IPR, not all asserted patents will be subject to the Board’s review. PO’s Request at 11. However, this argument is misplaced and misconstrues the relevance of those non-instituted proceedings to the question of whether a stay would ultimately be granted. Courts have consistently held that a stay may be appropriate even when only a subset of asserted patents is subject to IPR, particularly where, as here, the patents share overlapping claim terms, specifications, or technical disclosures. In *Acqis, LLC v. EMC Corp.*, 109 F. Supp. 3d 352 (D. Mass. 2015), the court granted a stay even though only two of the eleven asserted patents were under IPR. The court rejected the argument that a stay would be ineffective simply because most asserted patents were not subject to review. Instead, it emphasized the “similarity of inventive disclosure” and shared specifications among the patents in holding that that the instituted IPRs were likely to simplify the litigation as a whole. *Id.*

Moreover, as in *Acqis*, a stay is appropriate even at an advanced stage of litigation where there is no undue prejudice to the patent owner. There, the court observed that while “substantial document and written discovery” had taken place and “a claim construction opinion had been issued,” significant work remained for both the court and the parties. *Id.* The plaintiff’s claim of prejudice was unavailing,

particularly where the plaintiff was a non-practicing entity, had no competing products, and had not sought preliminary injunctive relief. *Id.*

The same is true here. Vervain is not a competitor of Kingston, does not manufacture or sell products, and has not alleged irreparable harm. Its interests in this litigation are purely monetary. Like the plaintiff in *Acqis*, Vervain did not seek a preliminary injunction, further undermining any claim of undue prejudice from delay. These facts would support a stay and weigh against discretionary denial.

In sum, the Board should not credit Patent Owner's unsupported speculation about the likelihood of a stay. Courts can and do grant stays post-institution. This factor does not support discretionary denial and, if anything, should be weighed as neutral in the *Fintiv* analysis.

**B. Factor 2 Supports Institution: The District Court's Scheduled Trial Date Significantly Deviates from the Median Time-to-Trial and Is Subject to Change**

Patent Owner contends that the district court's scheduled trial date of December 8, 2025, weighs against institution because it precedes the Board's projected statutory deadline for a final written decision on September 20, 2026 (June 26, 2026 if the Board grants Petitioner's motion for joinder with IPR2025-00212), and is "highly unlikely" to move. PO's Request at 12. This argument, however, disregards the actual litigation landscape in the Western District of Texas.

Although Judge Albright has indicated that he does not generally move trial dates, the current scheduled trial date of December 8, 2025, which sets trial only 21 months after the March 7, 2024 Complaint, significantly deviates from the statistical norms in his courtroom. Ex. 1083. As of June 2, 2025, Judge Albright had 273 active cases pending before him. Ex. 1085. Over the past 365 days, the median time-to-trial for cases before Judge Albright has been approximately 32 months, placing the more realistic trial date around November 2026—well after the Board’s projected statutory deadline for a final written decision. *See* Ex. 1086. This substantial gap between the scheduled and statistically expected trial dates strongly suggests that trial will likely occur after the Board’s decision, weighing against discretionary denial.

The Board and the Acting Director have recognized that median time-to-trial statistics are a more reliable benchmark than scheduled trial dates. *See Amazon.com, Inc. v. NL Giken Inc.*, IPR2025-00250, Paper 14 at 2 (P.T.A.B. May 16, 2025) (Acting Director found discretionary denial inappropriate where the median time-to-trial statistics suggested trial would occur after the projected final written decision—even though the scheduled date was earlier); *see also* Ex. 1087 (instructing panels to consider time-to-trial data when assessing Factor 2)

This statistical discrepancy can be explained by the recent reassignment of Judge Albright from the Waco Division—which received 809 filings in 2024—to

the significantly busier Austin Division, which had 1,765 filings during the same period. Ex. 1088 at 3. As part of this transition, Judge Albright retains responsibility for his entire Waco docket (excluding patent cases) while also absorbing 40% of the Austin Division's caseload. Ex. 1089 at 3. Given this substantial expansion of Judge Albright's caseload, it is increasingly likely that the currently scheduled trial will be delayed—potentially placing it closer to, or even beyond, the Board's projected Final Written Decision deadline in this IPR, which weighs against discretionary denial. See *Ericsson Inc. v. XR Commc'ns LLC*, IPR2024-00868, Paper 8 at 29 (P.T.A.B. Dec. 13, 2024) (trial scheduled less than five months before FWD did not support discretionary denial).

In sum, the December 2025 trial date is speculative and likely to shift given recent statistical trends and judicial resource constraints. Factor 2 does not support discretionary denial and, at a minimum, is neutral in this case.

**C. Factor 3 Supports Institution: Limited Investment in the Merits of Invalidity Weighs Against Discretionary Denial**

Patent Owner argues that the parties and court have invested significantly in the parallel litigation, but this is incorrect. PO's Request at 13-14. The Board has made clear that the *Fintiv* Factor 3 inquiry focuses not on overall litigation progress, but on how much investment has occurred in the specific validity issues raised in the Petition. See *Sand Revolution II*, IPR2019-01393, Paper 24 at 10–11. In *Sand*

*Revolution II*, despite claim construction proceedings, scheduling orders, and other procedural developments, the Board found that the district court’s and the parties’ investment in the substance of the invalidity case was minimal, noting that “much of the district court’s investment relates to ancillary matters untethered to the validity issue itself” and that “the district court’s two-page *Markman* Order in this case does not demonstrate the same high level of investment of time and resources as the detailed *Markman* Order in *Fintiv*.” *Id.*

The same reasoning applies here. Although discovery likely will have closed by the time the Board issues its institution decision (due by September 20, 2025), the district court has yet to issue a written *Markman* order and the Court is not likely to have ruled on any dispositive or *Daubert* motions (due September 12, 2025). *See* Ex. 1083. These facts show that the parties and the district court have not yet meaningfully engaged with the invalidity issues raised in this Petition. Accordingly, Factor 3 does not support exercising discretion to deny institution.

**D. Factor 4 Supports Institution: The Majority of Challenged Claims Will Not Be Adjudicated in the Parallel Litigation**

Patent Owner asserts that there is “significant overlap” between the issues raised in this Petition and those being litigated in district court. PO’s Request at 15-16. This is incorrect. This Petition challenges 12 claims, whereas Patent Owner has proposed to reduce the number of asserted claims to no more than five per patent

and sixteen total across the eight patents-in-suit by the time it serves its Final Election of Asserted Claims in the parallel litigation. Ex. 1091. Accordingly, the majority of the challenged claims will likely not be adjudicated in the parallel litigation.

The Board has found Factor 4 weighs in favor of institution where only a subset of challenged claims is being litigated. See *Hanwha Sols. Corp. v. Maxeon Solar PTE. LTD.*, IPR2024-01203, Paper 17, 18-19 (Feb. 26, 2025) (“While some overlap of issues may exist, complete overlap does not exist and resolution of the companion trial will not address the non-overlapping claims... Accordingly, we determine that *Fintiv* factor 4 weighs slightly against exercising our authority to deny institution.”) Thus, Factor 4 does not support exercising discretion to deny institution.

**E. Factor 5 Is Neutral: Party Identity Should Not Justify Discretionary Denial**

Petitioner is also the defendant in the parallel district court litigation—a fact that is true in the vast majority of IPR proceedings. Moreover, as stated above regarding Factor 4, there will likely be minimal overlap between the issues raised in the Petition and the district court proceeding. Thus, substantially different issues are raised in the Petition than will be adjudicated in the district court proceedings. See *Fintiv* at 14 (noting that the issue of whether a Petitioner is related to a defendant in

a parallel proceeding is ultimately about whether “the issues are the same as, or substantially similar to, those already or about to be litigated, or other circumstances weigh against redoing the work of another tribunal”). As such, this overlap does not meaningfully support discretionary denial. Holding otherwise would undermine the very purpose of the IPR framework, which was designed to provide an alternative forum for resolving patentability issues raised in infringement actions. *See, e.g.*, H.R. Rep. No. 112-98, at 164 (2011) (describing Congress’s goal of expanding “opportunities for low-cost, efficient alternatives to litigation as a way of resolving disputes about the validity of issued patents.”).

**F. Factor 6 Supports Institution: The Petition Is Compelling and Consistent with Prior Board Institutions Based on Similar Prior Art**

**1. The Merits of the Petition Are Strong**

This factor considers other circumstances, including the petition’s merits, that may affect discretionary denial. *Fintiv* at 14. Here, the merits of the Petition are compelling.<sup>2</sup>

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<sup>2</sup> Patent Owner’s Request contains several pages of substantive arguments regarding the merits of the instant Petition (*see* PO Request at 17-23) that are improper in a discretionary denial brief. *See* FAQs for Interim Processes for PTAB Workload Management (<https://www.uspto.gov/patents/ptab/faqs/interim-processes->

The Board has previously instituted the Micron '298 IPR challenging claims 1-5, 8-9, and 11 of the '298 Patent. *See* IPR2021-01547, Paper No. 13 (PTAB April 8, 2022). The scope of challenged claims and the prior art in this Petition are substantially the same as those that the Board previously instituted in the Micron IPR. *Moshayedi* and *Sutardja* were before the Board in the Micron '298 IPR. The *Gavens* reference relied upon in the instant Petition is a continuation-in-part in the same family as *Dusija*, which was relied upon in the Micron '298 IPR. *Gavens* thus contains everything disclosed in *Dusija* and more, further reinforcing the strength of the present Petition. Although the Micron '298 IPR was terminated due to settlement, the Board's decision to institute based on *Moshayedi*, *Sutardja*, and *Dusija* demonstrates that it found grounds based on the same foundational prior art presented a "reasonable likelihood" of success.

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workload-management) at FAQ 25 ("The parties should not treat a discretionary denial brief or opposition as an additional opportunity for merits briefing."). To the extent that Patent Owner intends to raise these substantive issues in its Patent Owner's Preliminary Response, Petitioner will respond in its Reply, per the Office's current guidance. *Id.*

**2. Petitioner’s Expert Testimony Is Consistent with Binding Precedent and The Director’s March 26, 2025 Memorandum**

Patent Owner’s criticism of Petitioner’s reliance on expert testimony is contrary to binding precedent. PO’s Request at 24. The Federal Circuit has made clear that both claim construction and obviousness must be construed from the standpoint of a person of ordinary skill in the art (POSITA). The Federal Circuit’s *en banc* decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) expressly recognized that “the ordinary and customary meaning of a claim term is the meaning it would have had to person of ordinary skill in the art in question at the time of the invention.” Similarly, in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), the Supreme Court held that the obviousness inquiry requires assessing whether a POSITA would have recognized that combining prior art elements yields predictable results, and whether such a combination would have been within the ordinary skill in the field.

The Board acknowledges the probative value of expert testimony, as clearly articulated in *Consolidated Trial Practice Guide* (Nov. 2019):

Expert testimony may be presented to establish the scope and content of the prior art for determining obviousness and anticipation. Such testimony may be helpful in evaluating, for example, the ‘prior art as viewed with the knowledge of one of skill in the art at the time of invention.’ *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1297 (Fed. Cir. 2002).

Ex. 1090 at 42. The Director Memo further confirms that the contents of the Consolidated *Trial Practice Guide* are among the factors to be considered in the exercise of discretion. Ex. 1084 at 2.

Here, Petitioner submits the declaration of Dr. Carl Sechen, whose testimony is based on technical analysis and supporting references, consistent with the requirements of 37 C.F.R. § 42.65 and the Director Memo. His declaration provides the legally required POSITA perspective and directly supports the Petition's claim construction and obviousness grounds. Rather than being a weakness, the Petitioner's expert testimony is a critical strength of the Petition.

### **3. The Absence of Settled Expectations Weighs in Favor of Institution**

Patent Owner's assertion of settled expectations is unfounded. PO's Request at 24-25. The previous litigation Patent Owner refers to was dismissed by stipulation of the parties, preventing any final disposition of issues on the merits. *See* Ex. 1092, 1093. This proceeding arises within the context of a broader litigation campaign targeting multiple defendants. In addition to the prior litigation against Micron and Western Digital, Patent Owner has also brought suit against Phison Electronics Corp., whose products are incorporated into a number of Petitioner's accused products. *See* Ex. 1079, 1094.

As noted above, the Board previously found a substantially similar challenge to the Challenged Claims of '300 Patent to have a "reasonable likelihood of success." As these invalidity challenges were never fully adjudicated (before either the Board or the District Court) due a settlement, the logical expectation would be that these grounds remain equally as strong today. Petitioner thus has a compelling interest in securing invalidation of all Challenged Claims to eliminate ongoing exposure to baseless infringement allegations and to protect both its business operations and its customers' interests.

**4. Instituting This Petition Would Be An Efficient Use of The Board's Resources**

Institution is warranted because the Challenged Claims include both method and apparatus claims that are not asserted in the parallel district court litigation (*i.e.*, claims 2 and 6-10). Petition at 66.

Moreover, Patent Owner has filed parallel suits following the same enforcement template against both Kingston and Phison, creating substantial overlap in the accused products and asserted claims. *See* Ex. 1079, 1094. This multi-defendant litigation strategy heightens the risk of inconsistent claim construction, duplicative validity assessments, and confidentiality challenges among co-defendants. *Id.* A Board determination would promote consistency and judicial

efficiency across forums by addressing the common invalidity issues in a centralized, expert-driven proceeding.

Additionally, compared to the 11 claims challenged in this Petition, Patent Owner will likely assert no more than 5 claims by the time it serves its Final Election of Asserted Claims in the parallel litigation, and possibly none by the time dispositive motions are filed. Ex. 1091. Even if Petitioner successfully invalidates a subset of claims at trial, Patent Owner may still assert the remaining, unadjudicated claims against Petitioner, its customers, or other users in future litigation. Institution of this IPR would enable the Board to conclusively resolve the validity of all Challenged Claims, thereby avoiding repeated lawsuits and IPRs, and conserving judicial and party resources.

#### **5. Instituting This Petition Would Not Burden the Board's Resources**

The America Invents Act (AIA) was enacted to provide a cost-effective and technically rigorous forum to weed out unpatentable claims early, before years of expensive district court discovery and trial. PGR and IPR proceedings serve an essential public function in ensuring that only valid patent rights survive.

Here, the Petition presents a strong challenge to claims of questionable validity. Meanwhile, Patent Owner is pursuing multiple overlapping lawsuits against Petitioner, asserting related claims from the same patent family. This strategy not

only increases the risk of inconsistent outcomes, but also imposes duplicative burdens on the Board, district courts, and the parties, all of whom must repeatedly address the same invalidity and infringement issues in parallel or successive proceedings. Without institution, there is a substantial risk of repeated litigation and serial IPRs over the same subject matter.

A single, comprehensive IPR that addresses all challenged claims would promote efficiency, conserve judicial and agency resources, and avoid duplicative proceedings of the same disputes. Far from straining the Board's resources, institution in this case would fulfill the AIA's core objectives. Accordingly, Factor 6 weighs strongly against discretionary denial.

### **III. CONCLUSION**

For the reasons set forth above, Petitioner respectfully request that the Director deny Patent Owner's request for discretionary denial and that the Petition be forwarded to a merits panel for consideration.

Date: June 20, 2025

Respectfully submitted,  
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**CERTIFICATION OF WORD COUNT (37 C.F.R. § 42.6(e))**

The undersigned hereby certifies that the attached Petitioner's Opposition to Patent Owner's Request for Discretionary Denial of Institution, including footnotes, but not the cover page, exhibit list, table of contents, table of authorities, mandatory notices, and certifications, contains 3,704 words, as measured by the Word Count function of Microsoft Word. This is less than the limit of 14,000 words as specified by 37 C.F.R. § 42.24(a)(i).

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**CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))**

The undersigned hereby certifies pursuant to 37 C.F.R. §§ 42.6(e) that the above-captioned Petitioner's Opposition to Patent Owner's Request for Discretionary Denial of Institution (and any new exhibits), was served in its entirety on June 20, 2025, via electronic mail upon the following counsel of record for Patent Owner:

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