

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner

v.

NETLIST, INC.,
Patent Owner

Case IPR2025-00001
U.S. Patent No. 11,386,024

**PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW
OF DECISION GRANTING INSTITUTION**

Mail Stop "PATENT BOARD"
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	LEGAL STANDARD.....	1
III.	ARGUMENT.....	1
	1. Reviewing Samsung’s voluminous record is a waste of Board resources.....	1
	2. Reviewing Samsung’s six grounds, which lack the requisite particularity, is a waste of Board resources.	4
IV.	CONCLUSION	7

I. INTRODUCTION

Netlist respectfully requests that the Director review and reverse the panel's Decision on Institution (Paper 17, "DI"). The decision is inconsistent with important policy considerations directed to the efficient use of PTAB resources. Moving forward with trial would expend undue resources sifting through voluminous exhibits and case histories to adjudicate unclear and redundant grounds. The panel did not even decide whether four of the six grounds meet the threshold for institution, suggesting that the PTAB lacks the resources (or they are better expended elsewhere) to resolve the fact-intensive issues in dispute and that an Article III court is the appropriate forum for adjudication.

The Director should *deny* institution.

II. LEGAL STANDARD

A party may request Director Review of a panel's decision on institution on the grounds of (a) an abuse of discretion, (b) important issues of law or policy, (c) erroneous findings of material fact, or (d) erroneous conclusions of law.

III. ARGUMENT

The Director should reverse the panel's decision because the decision is inconsistent with the following important policy considerations.

1. **Reviewing Samsung's voluminous record is a waste of Board resources.**

When deciding whether to exercise discretion to deny institution, the Board

should consider “the efficient administration of the Office [and] the ability of the Office to timely complete proceedings,” 35 U.S.C. § 316(b), as well as the requirement to “secure the just, speedy, and inexpensive resolution of every proceeding,” 37 C.F.R. § 42.1(b). Here, Samsung developed an expansive record (including voluminous expert testimony, fact witness testimony, prior case histories, and extraneous exhibits) seeking to resolve numerous fact-intensive issues, but failed to advance focused and meritorious arguments for all grounds. In such cases, the Board should deny institution to conserve resources.

Even before trial was instituted, Samsung filed 116 exhibits. It filed a 346-page expert declaration (EX1003). It filed case histories of multiple related patents (EX1005, EX1006, EX1007, EX1038, EX1096) and petitions, expert declarations, deposition transcripts, and Board decisions from *six* prior IPRs (EX1021, EX1032-EX1035, EX1058-EX1060, EX1062, EX1091-EX1093, EX1098-EX1106, EX1108, EX1109). It submitted briefing and orders from prior district court cases involving multiple parties. EX1061; EX1064-EX1068. And it relies on this prior litigation throughout the Petition as the basis for its grounds.

With such an unusually large record, instituting trial would require the Board to dedicate a disproportionate amount of resources to this case. The Board’s limited resources are better spent elsewhere—namely, cases in which petitioners present streamlined arguments and evidence demonstrating that all asserted

grounds meet the threshold for institution.

Many of Samsung's exhibits and prior testimony, moreover, are proffered here to re-litigate a highly fact-intensive inquiry of whether the draft JEDEC proposal (EX1015)—a reference in grounds 1 and 4—qualifies as prior art. Pet., 36-43. In addition to the draft JEDEC proposal itself, Samsung relies on 24 other JEDEC references in its efforts to establish, among other things, public availability of the proposal (EX1024-EX1026, EX1029, EX1036, EX1037, EX1046, EX1048, EX1049, EX1051-EX1053, EX1056, EX1071-EX1075, EX1083-EX1088). Samsung also submitted three fact-witness declarations (EX1050, EX1054, EX1055), Pet., 36-43, filed over three years ago in IPR2022-00064, which reviewed a related patent. The public availability of the JEDEC proposal was fully litigated there, yet the Board did not decide the issue. EX1103, 9 n.4.

As Netlist has explained multiple times, the reference was not publicly available. POPR, 18-42. It was presented confidentially as a proposal to a JEDEC standard and voted on by the authoring committee during an invite-only conference in Maui. *See, e.g.*, POPR, 40-41. After reviewing the parties' arguments and evidence, the panel declined to rule on whether Samsung made its threshold showing that the JEDEC proposal is prior art because "factual issues remain as to how 'accessible' the draft proposal in Exhibit 1015 would have been to an interested person who was not a member of JEDEC." DI, 41.

Litigating this fact-intensive dispute (again) will require third-party testimony and in-depth fact analysis. Such a dispute is better suited for district courts, which have broader subpoena powers and discovery procedures. *Compare* Fed. R. Civ. P. 45 (broad third-party subpoena powers), *with* 35 U.S.C. § 24 (the Board needs a district court to issue a subpoena). Parsing the relevant expert testimony is also better suited for an Article III court: “extensive reliance on expert testimony and/or reasonable disputes between experts on dispositive issues may suggest that the questions are better resolved in an Article III court.” *See* FAQ 21 for Interim Processes for PTAB Workload Management.

At bottom, a district court is better suited to resolve the issues-in-dispute. Accordingly, the Director should deny institution to conserve PTAB resources.

2. Reviewing Samsung’s six grounds, which lack the requisite particularity, is a waste of Board resources.

The Director should also reverse because Samsung failed to present its six grounds with sufficient particularity. POPR, 4-6. “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)). A corollary to this requirement is that petitioners are prohibited from incorporating by reference arguments from other documents into the petition. 37 C.F.R.

§ 42.6(a)(3); *Cisco Sys., Inc. v. C-Cation Techs., LLC*, IPR2014-00454, Paper 12 at 7-10 (P.T.A.B. Aug. 29, 2014) (informative).

But that is exactly what Samsung did. It excessively incorporated by reference from other documents, enabling it to pack collateral-estoppel arguments, lengthy public-accessibility allegations, and six invalidity grounds into a single petition. POPR, 4-6, 8. Samsung's incorporation by reference was particularly egregious in its collateral-estoppel arguments. It presented lengthy claim listings of related patents before the substance of the Petition (not included in the word count), which the panel relied on. DI, 20-22 (citing, for example, Pet. xvii–xlii). Samsung also incorporated-by-reference more than 50 pages of claim charts from its expert's declaration. Pet., 6 (citing EX1003, ¶¶152-155); POPR, 8. Permitting these violations, the panel attempted to cure Samsung's deficient showing by cobbling together the various pieces. DI, 17-22.

Further demonstrating the lack of particularity, Samsung grouped its grounds together and bounced between their different secondary references at will. For example, it analyzed grounds 1-3 together under the single heading “Combinations for Grounds 1-3: Hazelzet (EX1014) and either JEDEC (EX1015), Buchmann (EX1016), or Wang (EX1090).” Pet., 43. At times, Samsung cited the secondary references collectively. *E.g., id.* at 48. But at other times, it referred to them separately. *E.g., id.* at 43-44, 74-76. In other words, Samsung picked and

chose when it was convenient to cite which secondary reference and made it nearly impossible to disentangle its web of grounds.

Worse yet, Samsung haphazardly threw in many documents outside its grounds—Ellsberry, Pet., 46; Hein, Pet., 48; Micron, Pet., 48; Stone, Pet., 51-52; Talbot, Pet., 54; and various JEDEC references, which may have the same public availability issues as the JEDEC proposal itself, Pet., 66-71. Samsung’s excessive reliance on extraneous documents confirms that the Petition lacks the particularity needed to understand the grounds.

Adaptics is instructive. *Adaptics Ltd. v. Perfect Company*, IPR2018-01596, Paper 20 (P.T.A.B. Mar. 6, 2019) (informative). There, the petitioner relied on additional documents beyond the four corners of the references named in the grounds. *Id.* at 22. The Board denied institution, reasoning that the petition’s reliance on “these additional documents ... to fill gaps in the asserted references with respect to the claimed subject matter increases our concern that the Petition lacks the required particularity, and, instead, turns the Petition into an empty invitation for the Board and Patent Owner to search the record for evidence that might support the full breadth of Petitioner’s contentions.” *Id.* at 22-23. Similarly here, Samsung’s citation to many additional documents throughout the grounds further demonstrates that the Petition fails to satisfy the particularity requirement.

In sum, the Director should not allow the panel to continue down the path of

considering Petitioner's ambiguous challenges. The Director should grant review and *deny* institution, consistent with the PTAB's rules and case law.

IV. CONCLUSION

For the foregoing reasons, Netlist respectfully requests that the Director grant this request for Director Review and reverse the panel's decision to institute review of the '024 patent.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/Richard M. Bemben/

Richard M. Bemben
Registration No. 68,658
Lead Attorney for Patent Owner

Date: May 29, 2025

1101 K Street, NW, 10th Floor
Washington, DC 20005
(202) 371-2600

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

I certify that the above-captioned **PATENT OWNER'S REQUEST FOR
DIRECTOR REVIEW OF DECISION GRANTING INSTITUTION** was
served in its entirety on May 29, 2025, upon the following parties via electronic
mail:

Eliot D. Williams (Lead Counsel)
Theodore W. Chandler (Back-up Counsel)
Ferenc Pazmandi (Back-up Counsel)
Brianna L. Potter (Back-up Counsel)
BAKER BOTTS L.L.P.
DLSamsungNetlistIPRs@bakerbotts.com

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/Richard M. Bemben/

Richard M. Bemben
Registration No. 68,658
Lead Attorney for Patent Owner

Date: May 29, 2025

1101 K Street, NW, 10th Floor
Washington, DC 20005
(202) 371-2600

24866992