

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,

Petitioner,

v.

NETLIST, INC.,

Patent Owner

IPR2026-00017

Patent 9,824,035

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

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1001	U.S. Patent No. 9,824,035 (“’035 Patent”)
1002	File History of U.S. Patent No. 9,824,035
1003	Declaration of Dr. Robert Wedig
1004	Curriculum Vitae of Dr. Robert Wedig
1005	U.S. Patent Pub. No. 2010/0312925 to Osanai (“ <u>Osanai</u> ”) (Exhibit 1005 in IPR2022-00236, and Exhibit 2004 in IPR2023-00847)
1006	U.S. Patent No. 8,020,022 to Tokuhira (“ <u>Tokuhira</u> ”)
1007	U.S. Patent Pub. No. 2006/0277355 by Ellsberry (“ <u>Ellsberry</u> ”)
1008	U.S. Patent No. 6,184,701 to Kim (“ <u>Kim</u> ”)
1009	U.S. Patent No. 8,566,516 to Schakel
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1012	<i>SK Hynix Inc. et al. v. Netlist, Inc.</i> , IPR2017-00730, Paper No. 1 (PTAB January 20, 2017) (632 Petition)
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1014	<i>SK Hynix Inc. et al. v. Netlist, Inc.</i> , IPR2017-00730, Paper No. 8 (PTAB July 21, 2017) (632 Decision Denying Institution)
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1016	<i>Netlist, Inc. v. Micron Tech., Inc., et al.</i> , No. 6:21-cv-00431 (W.D. Tex. Apr. 28, 2021) (Netlist Complaint)
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1018	JEDEC Standard 21-C, DDR SDRAM Registered DIMM Design Specification (January 2002)
1019	Declaration of Julie Carlson for JESD79-3C
1020	JEDEC DDR3 SDRAM Standard, JESD79-3C (April 2008)
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1024	U.S. Patent No. 9,263,103 to Giovannini
1025	U.S. App. No. 61/676,883 (provisional application to '632 Patent)
1026	U.S. Patent No. 8,565,033 to Manohararajah
1027	U.S. Patent No. 7,808,849 to Swain
1028	U.S. Patent No. 9,536,579 to Iijima
1029	U.S. Patent Pub. No. 2007/0008791 to Butt (“ <u>Butt</u> ”)
1030	U.S. Patent Pub. No. 2010/0309706 to Saito (“ <u>Saito</u> ”)
1031	Final Written Decision, <i>Samsung Electronics Co., Ltd. v. Netlist, Inc.</i> , IPR2022-00639, Paper 45 (PTAB Oct. 18, 2023)
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1033	Final Written Decision, <i>Samsung Electronics Co., Ltd. v. Netlist, Inc.</i> , IPR2022-00615, Paper 96 (PTAB Apr. 17, 2024)
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1043	[omitted]
1044	[omitted]
1045	Declaration of Dr. Robert Wedig Regarding U.S. Patent No. 10,860,506 (Exhibit 1003 in IPR2022-00711)

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1046	U.S. Patent No. 10,860,506
1047	[omitted]
1048	Joint 4-3 Claim Construction and Prehearing Statement, <i>Netlist, Inc. v. Samsung Electronics Co., Ltd. et al.</i> , No. 2:21-cv-00463 (E.D. Tex. Aug. 19, 2022 and Aug. 23, 2022)
1049	Joint Claim Construction Chart Pursuant to P.R. 4-5(d), <i>Netlist, Inc. v. Samsung Electronics Co., Ltd. et al.</i> , No. 2:21-cv-00463 (E.D. Tex. Sept. 30, 2022)
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1056	U.S. Patent Pub. No. 2010/0312956 to Hiraishi (“ <u>Hiraishi</u> ”) (Exhibit 1005 in IPR2023-00847)
1057	U.S. Pat No. 10,268,608
1058	Declaration of Dr. Robert Wedig Regarding U.S. Patent No. 10,268,608 (Exhibit 1003 in IPR2023-00847)
1059	Petitioner's demonstratives for U.S. Patent No. 10,268,608 (Exhibit 1089 in IPR2023-00847)
1060	Final Written Decision, <i>Samsung Electronics Co., Ltd. v. Netlist, Inc.</i> , IPR2023-00847, Paper 42 (PTAB Dec. 10, 2024) (U.S. Patent No. 10,268,608)
1061	Notice of Docketing, <i>Samsung Electronics Co., Ltd. v Netlist, Inc.</i> , No. 2025-1378 (Fed. Cir. Jan. 21, 2025) (U.S. Patent No. 10,268,608)
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1063	Netlist’s Response Brief, <i>Samsung Electronics Co., Ltd. v Netlist, Inc.</i> , No. 2025-1378 (Fed. Cir. July 28, 2025) (U.S. Patent No. 10,268,608)
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1065	[omitted]
1066	Final Written Decision, <i>Micron Technology, Inc. et al. v. Netlist, Inc.</i> , IPR2022-00236, Paper 34 (PTAB June 20, 2023) (U.S. Patent No. 9,824,035)
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1076	[omitted]
1077	Netlist’s Technology Tutorial (Exhibit 1047 in IPR2022-00711 and Exhibit 1077 in IPR2023-00847)
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1084	U.S. Patent No. 7,215,584 to Butt et al. (incorporated by reference in [0047] of Exhibit 1029)
1085	Presentation on read leveling and write leveling for DDR3 memory modules (2008)
1086	Complaint, <i>In the Matter of Certain Dynamic Random Access Memory (DRAM) Devices, Products Containing the Same, and Components Thereof</i> , Inv. No. 337-TA-3854 (USITC filed Sept. 30, 2025) (U.S. Patent Nos. 9,824,035 and 10,268,608)
1087	Netlist Form 10-K (Annual Report) for 2023, available at https://investors.netlist.com/filings-financials/sec-filings .
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1091	Final Written Decision, <i>Samsung Electronics Co., Ltd. v. Netlist, Inc.</i> , IPR2022-00996, Paper 49 (PTAB Dec. 6, 2023) (U.S. Patent No. 11,016,918)
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1093	Final Written Decision, <i>Samsung Electronics Co., Ltd. v. Netlist, Inc.</i> , IPR2022-01428, Paper 48 (PTAB Apr. 1, 2024) (U.S. Patent No. 8,787,060)

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1095	Order Denying Director Review, <i>Samsung Electronics Co., Ltd. v. Netlist, Inc.</i> , IPR2022-01427 and -01428, Paper 52 (PTAB June 17, 2024)
1096	Final Written Decision, <i>Samsung Electronics Co., Ltd. v. Netlist, Inc.</i> , IPR2023-00454, Paper 45 (PTAB July 30, 2024) (U.S. Patent No. 11,093,417)
1097	Order Denying Director Review, <i>Samsung Electronics Co., Ltd. v. Netlist, Inc.</i> , IPR2023-00454, Paper 47 (PTAB Oct. 8, 2024) (U.S. Patent No. 11,093,417)
1098	Order Granting Motion to Stay, <i>Samsung Electronics Co., Ltd. et al. v. Netlist, Inc.</i> , No. 1:21-cv-01453 (D. Del. Dec. 1, 2023) (U.S. Patent No. 10,217,523)
1099	Order Granting Request for <i>Ex Parte</i> Reexamination, No. 90/015,449 (Nov. 21, 2025) (U.S. Patent No. 10,268,608)
1100	Complaint, <i>Netlist, Inc. v. Samsung Electronics Co., Ltd. et al.</i> , No. 2:21-cv-00463 (E.D. Tex. filed Dec. 20, 2021)
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1102	Notice of Institution of Investigation No. 337-TA-1472, 91 Fed. Reg. 155 (Jan. 2, 2026), available at https://www.federalregister.gov/documents/2026/01/02/2025-24146/certain-dynamic-random-access-memory-dram-devices-products-containing-the-same-and-components
1103	Order No. 11: Initial Determination Amending the Target Date, <i>In the Matter of Certain Dynamic Random Access Memory (DRAM) Devices, Products Containing the Same, and Components Thereof</i> , Inv. No. 337-TA-1472 (USITC Jan. 27, 2026), available at https://edis.usitc.gov/external/search/advanced.html?invId=8817
1104	Memorandum re: Director Institution of AIA Trial Proceedings (Oct. 17, 2025), available at https://www.uspto.gov/subscription-center/2025/director-institution-aia-trial-proceedings

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1105	Memorandum re: Interim Processes for PTAB Workload Management (Mar. 26, 2025), <i>available at</i> < https://www.uspto.gov/subscription-center/2025/uspto-issues-new-interim-process-concerning-institution-aia-proceedings >
1106	Memorandum re: Final Written Decision Procedures for AIA Trial Proceedings (July 29, 2025), <i>available at</i> < https://www.uspto.gov/subscription-center/2025/ptab-issued-memorandum-aia-trials >
1107	Memorandum re: Guidance on USPTO’s recission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” (Mar. 24, 2025), <i>available at</i> < https://www.uspto.gov/patents/ptab/resources >
1108	Declaration of James Kiczek (SEA), <i>Netlist, Inc. v. Samsung Electronics Co., Ltd. et al.</i> , No. 2:25-cv-00557 (E.D. Tex. Sept. 11, 2025)
1109	Declaration of Danny Kim (SSI), <i>Netlist, Inc. v. Samsung Electronics Co., Ltd. et al.</i> , No. 2:25-cv-00557 (E.D. Tex. Sept. 11, 2025)
1110	Order determining Google is not a Real Party-in-Interest or Privy of Samsung, <i>Samsung Electronics Co., Ltd. v. Netlist, Inc.</i> , IPR2022-00615, Paper 64 (PTAB July 13, 2023)
1111	Complaint for Declaratory Judgment, <i>Samsung Electronics Co., Ltd. and Samsung Semiconductor, Inc. v. Netlist, Inc.</i> , No. 1:25-cv-01453 (D. Del. filed Oct. 15, 2021)
1112	Samsung Semiconductor, About Us, <i>available at</i> < https://semiconductor.samsung.com/about-us/locations/us/ >
1113	Samsung Semiconductor, Inc., Articles of Incorporation in California (July 13, 1992), <i>available at</i> < https://bizfileonline.sos.ca.gov/search/business >
1114	Samsung Semiconductor, Inc., California Statement of Information (Apr. 15, 2025), <i>available at</i> < https://bizfileonline.sos.ca.gov/search/business >
1115	Samsung investments in the United States, <i>available at</i> < https://semiconductor.samsung.com/sas/company/taylor/ >
1116	U.S. Patent No. 10,025,731

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1117	Samsung Electronics America, Inc. (“SEA”)’s Motion to Dismiss for Improper Venue, <i>Netlist, Inc. v. Samsung Electronics Co., Ltd. et al.</i> , No. 2:25-cv-00557 (E.D. Tex. Nov. 24, 2025)
2001	Joint Development and License Agreement, November 12, 2015
2002	Stock Purchase Warrant, November 18, 2015
2003	Senior Secured Convertible Promissory Note, November 18, 2015
2004	Security Agreement by and between Netlist, Inc. and SVIC No. 28 New Technology Business Investment L.L.P., November 18, 2025
2005	Samsung Venture Investment Corporation website, available at https://www.samsungventure.co.kr/english/jsp/company/company.jsp (last accessed October 12, 2025)
2006	Recorded Assignment and IP Security Agreement, Reel No. 037150, Frame No. 0897, November 20, 2015
2007	Release of Assignment, Reel No. 065629, Frame No. 0330, November 20, 2023
2008	Redacted First Amended Complaint for Breach of Contract and Declaratory Relief, <i>Netlist Inc. v. Samsung Electronics Co., Ltd.</i> , Case No. 8:20-cv-00993-JAK (C.D. Cal.), August 31, 2020
2009	Judgment, <i>Netlist Inc. v. Samsung Electronics Co., Ltd.</i> , Case No. 8:20-cv-00993-JAK (C.D. Cal.), April 7, 2025
2010	Median time to trial statistics for the International Trade Commission, Docket Navigator report generated October 6, 2025
2011–13	[intentionally omitted]
2014	Verdict Form, <i>Netlist, Inc. v. Samsung Electronics Co. et al.</i> , Case No. 2:21-cv-00463-JRG (E.D. Tex.), April 21, 2023
2015	Complaint, <i>In the Matter of Certain Dynamic Random Access Memory (DRAM) Devices, Products Containing the Same, and Components Thereof</i> , Investigation No. 337-TA-3854 (I.T.C.), September 29, 2025
2016	[intentionally omitted]
2017	Verdict Form, <i>Netlist, Inc. v. Samsung Electronics Co. et al.</i> , Case No. 2:22-cv-00293-JRG (E.D. Tex.), November 22, 2024

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2018	List of Patent Trial and Appeal Board proceedings filed by Samsung Electronics Co., Ltd. against Netlist, Inc.’s Patents, Docket Navigator, generated November 10, 2025
2019	Notice of Proposed Rulemaking, 90 Fed. Reg. 48,335 (Oct. 17, 2025)
2020	Excerpts from PTAB 2025 Intelligence Report, Patexia, Inc.
2021	Ramkumar, A., “Trump Takes Aim at Chip Makers With New Plan to Throttle Imports,” <i>The Wall Street Journal</i> , September 26, 2025, accessible at https://www.wsj.com/economy/trade/trump-chip-tariffs-exemptions-90fa2ab3 (last accessed September 26, 2025)
2022	[intentionally omitted]
2023	“Netlist and SK hynix Enter into Strategic Agreements for Patents, Technology and Product Supply,” Netlist Press Release, April 5, 2021
2024	“Precedential designation of <i>Corning Optical Communications RF, LLC v. PPC Broadband Inc.</i> , IPR2014-00440, Paper 68 (PTAB Aug. 18, 2015) (except for § II.E.1),” Memorandum from Under Secretary of Commerce for Intellectual Property and Acting Director of the United States Patent Trademark Office John A. Squires, October 28, 2025
2025–26	[intentionally omitted]
2027	Plaintiff’s Corporate Disclosure Statement, <i>Samsung Electronics Co., Ltd. et al. v. Netlist, Inc.</i> , Case No. 1:25-cv-00626-JLH (D. Del.), May 20, 2025
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2029–39	[intentionally omitted]
2040	Judgment under Federal Circuit Rule 36, <i>Samsung Elecs. Co., Ltd. v. Netlist, Inc.</i> , Appeal No. 23-2133 (Fed. Cir.), March 5, 2025
2041	Judgment under Federal Circuit Rule 36, <i>Samsung Electronics Co., Ltd. v. Netlist, Inc.</i> , Appeal No. 25-1378 (Fed. Cir.), December 9, 2025
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2045–48	[intentionally omitted]
2049	Final Written Decision, <i>Micron Technology, Inc. v. Netlist, Inc.</i> , IPR2022-00236 (P.T.A.B. June 20, 2023)
2050	Decision Granting Petitioner’s Request on Rehearing of Final Written Decision, <i>Micron Technology, Inc. v. Netlist, Inc.</i> , IPR2022-00236 (P.T.A.B. Aug. 16, 2023)
2051	Record of Oral Hearing, <i>Samsung Elecs. Co., Ltd.</i> , IPR2023-00847 (P.T.A.B. Nov. 21, 2024)
2052	Appellant’s Principal Brief, <i>Samsung Elecs. Co., Ltd. v. Netlist, Inc.</i> , Appeal No. 25-1378 (Fed. Cir.), April 18, 2025
2053	Order Initiating <i>Sua Sponte</i> Director Review and Staying Proceeding, IPR2025-00145 (P.T.A.B. Dec. 22, 2025)
2054	Notice of Institution of Investigation, Inv. No. 337-TA-1472 (I.T.C. Dec. 29, 2025)

I. INTRODUCTION

Netlist’s request for discretionary denial (“DD Req.”) should be denied for many reasons, including the Final Written Decisions invalidating substantially identical claims, and the fact this proceeding is far ahead of Netlist’s ITC action:

II. ARGUMENT

A. **The Board’s Final Written Decisions in IPR2022-00236 and IPR2022-00711 invalidating substantially identical claims defeats any “settled expectations” and confirms that the Examiner materially erred during prosecution**

The Board’s Final Written Decisions in IPR2022-00236 and IPR2022-00711 invalidating substantially identical claims defeats any “settled expectations” and confirms that the Examiner materially erred, which strongly weighs against discretionary denial here. *See Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12, at 3 (PTAB July 16, 2025) (informative) (“[T]he patent examiner’s conclusion directly contradicts the Board’s determination and raises concerns of material error such that review of the challenged patents is an appropriate use of Office resources.”); *POSCO Co. v. ArcelorMittal*, IPR2025-00370, Paper 10, at 2–3 (PTAB June 25, 2025) (Acting Director) (“It is an appropriate use of Office resources to...ensure that a patent applicant or owner does not take action inconsistent with the judgment in a prior Office proceeding. *See* 37 C.F.R. § 42.73(d)(3)...”); *Nintendo Co. v. Resonant Sys., Inc.*, IPR2025-00680, Paper 18, at 3 (PTAB Aug. 14, 2025) (Acting Director) (“[T]he Board has determined claims

that are substantially similar to the challenged claims to be unpatentable....

Although the challenged patent has been in force for more than ten years, creating strong settled expectations for Patent Owner, this does not overcome the aforementioned considerations that counsel against discretionary denial.”).

The following three sections address this issue in more detail.

- 1. The Examiner materially erred during prosecution of challenged claims 9, 14 and 17–20 of the '035 patent, as confirmed by IPR2022-00236 invalidating substantially identical claims 10–13 of the '035 patent, and by IPR2022-00711 invalidating substantially identical claims 7–8 of the related '506 patent**

This section focuses on challenged claims 9, 14, and 17–20 of the '035 patent, while the next two sections address the remaining challenged claims.

The prosecution of the '035 patent was perfunctory: the Examiner issued a double-patenting rejection, EX1002, 87–95, and then immediately allowed all the claims (with some “minor” amendments) upon the filing of a terminal disclaimer, *id.* 105–11, 114–15, 118, 123–30, 142–47, 156–58.

The Examiner’s “reasons for allowance” for all of the claims was merely a recitation of the limitations found in claim 1. *See* EX1002, 128–29. But later, in IPR2022-00236 (filed by Micron), the Board found claim 1 obvious (along with claims 10–13 and 21–22) in light of Osanai and Tokuhiro, *see* EX1001, 41; EX1066–67, meaning the Examiner materially erred during prosecution by relying on claim 1 to allow all claims of the '035 patent. Netlist is now estopped from

challenging those findings. *See* Pet. 21–22 (citing 37 C.F.R. § 42.73(d)(3)).

Netlist is further estopped by IPR2022-00711 (filed by Samsung), which invalidated *all* claims of the related '506 patent, primarily in light of Hiraishi (which is materially identical to Osanai above, *see* EX1003, ¶¶64–65), Tokuhiro (same as above), and a third reference, Butt, which was not considered in IPR2022-00236 (above). *See* Pet. 18–19, 21–22; EX1068–69, EX1101.

As shown below, challenged claims 9, 14, and 17–20 are substantially identical to claims 10–13 of the '035 patent found invalid in IPR2022-00236, and claims 7–8 of the related '506 patent found invalid in IPR2022-00711. Thus, the Examiner's allowance of claims 9, 14, and 17–20 of the '035 patent “contradicts the Board's determination [in IPR2022-00236 and IPR2022-00711] and raises concerns of material error such that review of the challenged patents is an appropriate use of Office resources.” *Padagis*, IPR2025-00464, Paper 12, at 3; *POSCO*, IPR2025-00370, Paper 10, at 2–3; *Nintendo*, IPR2025-00680, Paper 18, at 3; Pet. 21–22 (citing 37 C.F.R. § 42.73(d)(3)).

The table below shows that challenged claims 9 and 14 of the '035 patent (on the right) are substantially identical to claims 7–8 of the '506 patent found invalid in IPR2022-00711 (on the left):

<u>'506 claims 7–8 found invalid in IPR2022-00711 (EX1068, 22-24, 26-30)</u>	<u>'035 claims 9 and 14 challenged here that are substantially identical</u>
<p>8 [<i>found invalid in IPR2022-00711 (EX1068, 26–30, 7–19)</i>]. The memory module of claim 1 . . . wherein the first data <i>buffer</i> further includes <i>receiver circuits corresponding to respective ones of the module control signals</i>, a respective receiver circuit for a respective module control signal including a <i>metastability detection circuit</i> configurable to generate one or more metastability indicators indicating a <i>metastability condition in the respective module control signals with respect to the module clock signal</i>.</p>	<p>9. The memory module of claim 1 [<i>found invalid in IPR2022-00236 (EX1066, 15–43)</i>], wherein the each respective <i>buffer</i> circuit is further configured to receive a module clock signal from the module control device and further includes a <i>receiver circuit for each of the module control signals</i>, the receiver circuit including a <i>metastability detection circuit</i> configured to determine a <i>metastability condition in the each of the module control signals with respect to the module clock signal</i>.</p>
<p>7 [<i>found invalid in IPR2022-00711 (EX1068, 22–24, 7–19)</i>]. The memory module of claim 1 . . . wherein the first data <i>buffer</i> is further configurable to: <i>receive the module clock signal; generate a local clock signal having a programmable phase relationship with the module clock signal; and output the local clock signal; wherein the first memory device is configurable to receive the local clock signal</i> and to</p>	<p>14. The memory module of claim 1 [<i>found invalid in IPR2022-00236 (EX1066, 15–43)</i>], wherein the each respective <i>buffer</i> circuit is further configured to <i>receives a module clock signal</i> and further includes a clock regeneration circuit configured to <i>generate a local clock signal having a programmable phase relationship with the module clock signal</i>, wherein the each respective</p>

<u>'506 claims 7–8 found invalid in IPR2022-00711 (EX1068, 22-24, 26-30)</u>	<u>'035 claims 9 and 14 challenged here that are substantially identical</u>
output the first section of the read data and first read strobe in accordance with the local clock signal.	buffer circuit is configured to <i>output the local clock signal to the respective set of memory devices.</i>

The table below shows that challenged claims 17–20 of the '035 patent (on the right) are substantially identical to claims 10–13 of the '035 patent found invalid in IPR2022-00236 (on the left):

<u>'035 claims 10–13 found invalid in IPR2022-00236 [EX1066, 46–51]</u>	<u>'035 claims 17–20 challenged here that are substantially identical</u>
10 [<i>found invalid in IPR2022-00236 (EX1066, 46–47, 15–43)</i>]. The memory module of claim 1, wherein each of the plurality of <i>buffer circuits has a data width of 1 byte</i> , and wherein each of the <i>memory devices has a data width of 1 byte</i> .	17. The memory module of claim 14 [<i>see chart above for claim 14</i>], wherein each of the plurality of <i>buffer circuits has a data width of 1 byte</i> , and wherein each of the <i>memory devices has a data width of 1 byte</i> .
11 [<i>found invalid in IPR2022-00236 (EX1066, 47–48)</i>]. The memory module of claim 10, wherein the <i>memory devices are arranged in a plurality of ranks</i> and the respective set of memory devices include <i>one memory device from each of the plurality of ranks</i> , and	18. The memory module of claim 17, wherein the <i>memory devices are arranged in a plurality of ranks</i> and the respective set of memory devices include <i>one memory device from each of the plurality of ranks</i> , and wherein the <i>module command signals include chip select signals</i> that select

<u>'035 claims 10–13 found invalid in IPR2022-00236 [EX1066, 46–51]</u>	<u>'035 claims 17–20 challenged here that are substantially identical</u>
<p>wherein the <i>module command signals include chip select signals</i> that select one memory device in the respective set of memory devices <i>to receive or output the respective data and strobe signals</i>.</p>	<p>one memory device in the respective set of memory devices <i>to output or receive the respective data and strobe signals</i> in accordance with the local clock signal [from claim 14].</p>
<p>12 [found invalid in IPR2022-00236 (EX1066, 48–50, 15–43)]. The memory module of claim 1, wherein each of the plurality of <i>buffer circuits has a data width of 1 byte</i>, and wherein each of the <i>memory devices has a data width of 4 bits</i>.</p>	<p>19. The memory module of claim 14, wherein each of the plurality of <i>buffer circuits has a data width of 1 byte</i>, and wherein each of the <i>memory devices has a data width of 4 bits</i>.</p>
<p>13 [found invalid in IPR2022-00236 (EX1066, 51)]. The memory module of claim 12, wherein the <i>memory devices are arranged in a plurality of ranks</i> and the respective set of memory devices include <i>two memory devices from each of the plurality of ranks</i>, and wherein the module command signals include <i>chip select signals that select two memory devices</i> in the respective set of memory devices <i>to</i></p>	<p>20. The memory module of claim 19, wherein the <i>memory devices are arranged in a plurality of ranks</i> and the respective set of memory devices include <i>two memory devices from each of the plurality of ranks</i>, and wherein the module command signals include <i>chip select signals that select two memory devices</i> in the respective set of memory devices <i>to output or receive the respective data and strobe</i></p>

<u>'035 claims 10–13 found invalid in IPR2022-00236 [EX1066, 46–51]</u>	<u>'035 claims 17–20 challenged here that are substantially identical</u>
<i>receive or output the respective data and strobe signals, the two memory devices being in a same rank.</i>	<i>signals in accordance with the local clock signal [from claim 14], the two memory devices being in a same rank.</i>

The tables above confirm the material errors made by the Examiner with respect to claims 9, 14, and 17–20 of the '035 patent. But there is more, below.

2. The Examiner materially erred with respect to challenged dependent claims 15–16 by completely failing to search the prior art for a “sampler”

The Examiner also materially erred during prosecution with respect to challenged claims 15–16, which depend from claim 14 (discussed above) which in turn depends from claim 1 (found invalid in IPR2022-00236 as discussed above).

Challenged claims 15–16 add the requirement of a “sampler that samples.” EX1001, 20:63, 21:1. But the Examiner *never* searched the prior art for “sampler” or any similar phrase. *See* EX1002, 101–03, 132–35. Instead the Examiner allowed *all* the claims solely on the basis of the limitations in claim 1. *See* EX1002, 128–29. That was error, as confirmed by IPR2022-00236 which found claim 1 invalid. *See* EX1001, 41; EX1066–67. Netlist does not dispute this error, and does not dispute that claims 15–16 were obvious, *see* Pet. 100–06.

3. The Examiner materially erred with respect to challenged claims 2–8 of the '035 patent, and § 325(d) does not apply, in light of the Butt reference that Samsung previously presented in IPR2022-00711 against the related '506 patent

Netlist ignores the material errors above, and instead focuses on claim 2 (and dependent 6), which survived IPR2022-00236 (filed by Micron) based on a *sua sponte* narrow claim construction for “*memory write operation*” in claim 2. *See* Pet. 19–20, 23; DD Req. 11; EX1066, 33 n.5, 43–46.

But as explained in the Petition, the Butt reference — which was not considered in IPR2022-00236 or during prosecution — expressly teaches the claimed “*memory write operation*” found in claims 2–8. *See* Pet. 84–85 (citing Pet. 54–55); EX1029, ¶[0044] (“writes to...DDR memory”); *see also* Pet. 31 (“Butt further teaches using normal read/write operations during initialization.”).

Samsung’s reliance on Butt here is *not* a case of “roadmapping” based on Micron’s failure in IPR2022-00236. To the contrary, Samsung relied on Butt in IPR2022-00711 *before* the decision in IPR2022-00236 (which did not involve Samsung). *See* Pet. 20 (“Ground 1 here (involving Butt)...[was] previously filed with the Board [in IPR2022-00711]”); EX1045, 187, 232; EX1068, 32.

Netlist is therefore incorrect that “Samsung’s Petition does not pass muster under Section 325(d).” DD Req. 10–11. Neither the Examiner nor the Board in IPR2022-00236 considered Butt (or “substantially the same prior art or argument”), meaning part one of *Advanced Bionics* is not satisfied. *See Ecto*

World, LLC v. RAI Strategic Holdings, Inc., IPR2024-01280, Paper 13, at 3 (PTAB May 19, 2025) (precedential). And Butt shows the Examiner materially erred.

* * * * *

The material errors discussed above with respect to challenged claims 2–9 and 14–20 of the '035 patent weigh strongly against discretionary denial. *See, e.g., Microsoft Corp. v. ParTec Cluster Competence Ctr. GmbH*, IPR2025-00318, Paper 9, at 2–3 (PTAB June 12, 2025) (Acting Director) (“Petitioner provides persuasive evidence that the Office erred in a manner material to the patentability of the challenged claims by overlooking the teachings of [the prior art]”); *Eunsung Global Corp. v. HydraFacial LLC*, IPR2025-00445, Paper 14, at 2–3 (PTAB July 10, 2025) (Acting Director) (similar for patent “issued in 2017”); *Xencor, Inc. v. Merus N.V.*, IPR2025-00604, Paper 12, at 2–3 (PTAB July 17, 2025) (Acting Director) (similar for patent “issued in 2016”); *Anthony Inc v. ControlTec LLC*, IPR2025-00559, Paper 12, at 2 (PTAB July 16, 2025) (Acting Director) (similar for patents “in force for approximately eighteen and seventeen years”).

B. Netlist cannot rely on the 2015 JDLA agreement between Samsung and Netlist to show “settled expectations” because Netlist deliberately placed the '035 patent “in a drawer” from its issuance in 2017 until 2025, and instead chose to assert the related '506 patent in 2021, which Samsung invalidated in IPR2022-00711, creating “settled expectations” for Samsung

As explained above, the Board’s Final Written Decisions in IPR2022-00236 and IPR2022-00711 defeat Netlist’s claims of “settled expectations,” *see* DD Req.

7–12 (alleging “settled expectations” based on the age of the ’035 patent, the 2015 JDLA agreement with Samsung that Netlist asserts it “terminated...on July 15, 2020,” and claim 2 in IPR2022-00236).

Netlist also cannot show “settled expectations” because it deliberately placed the ’035 patent “in a drawer” from its issuance in 2017 until 2025 and instead asserted other patents, including the related ’506 patent against Samsung in 2021, *see* EX1100, which Samsung completely invalidated in IPR2022-00711, *see* EX1068–69. The Federal Circuit affirmed. EX1101. As a result, the only party with “settled expectations” is Samsung, not Netlist. *See, e.g., Celgene Corp. v. Peter*, 931 F.3d 1342, 1362–63 (Fed. Cir. 2019) (“For forty years, patent owners have . . . had the expectation that the PTO could reconsider the validity of issued patents . . . applying a preponderance of the evidence standard.”).

Netlist asserts that “Samsung has no settled expectations in the ’035 patent” because Samsung lost IPR2023-00847 against another patent Netlist asserted in 2023, called the ’608 patent, while the ’035 patent sat in a drawer. DD Req. 12. Netlist misleadingly argues that “Samsung’s attorney argu[ed] the claims [of the ’608 and ’035] are ‘materially identical.’” *Id.* That is misleading because Netlist argued to the contrary, and the Board agreed with Netlist, as explained in the Petition: “[T]he Board found the challenged claims of the ’608 Patent not invalid based on a narrow construction for ‘data path,’ which the Board found differed

from ‘data paths’ (plural) in the ’035 Patent.” Pet. 20–21 (citing EX1060, 20–21). The Federal Circuit affirmed. EX2041. Given this narrow claim construction, the decision in IPR2023-00847 about the ’608 patent does not undercut any of Samsung’s “settled expectations” with respect to the ’035 patent in light of the Final Written Decisions in IPR2022-00236 and IPR2022-00711 discussed above.

C. The ITC is not the best forum to resolve the parties’ dispute, given that this proceeding is far ahead of the ITC, only two of the 15 challenged claims (i.e., 13%) are at issue in the ITC, and given the large number and wide scope of patents asserted in the ITC

Netlist is incorrect that “[t]he ITC is the best forum to resolves the parties’ dispute,” DD Req. 13–14, for at least three reasons:

First, this proceeding is far ahead of the ITC, as discussed below (pp.12–15).

Second, only two of the 15 challenged claims (i.e., 13%) are at issue in the ITC, *see* EX2015, 12 (¶ 7), meaning “the additional claims at issue here, but not in the ITC proceeding, weigh against exercising our discretion to deny institution,” *Volkswagen Grp. of Am., Inc. v. Arigna Tech. Ltd.*, IPR2021-01321, Paper 10, at 8 (PTAB Feb. 15, 2022) (ITC case involved only 44% of the challenged claims).

Third, “[t]he large number and vast scope of the patents asserted in the district court [and ITC] litigation[s] weighs against discretionary denial, as the Board is better suited to review a large number of patents involving diverse subject matter,” especially here where the Board has already invalidated related patents in all 5 patent families in the ITC. *Tesla, Inc. v. Intellectual Ventures II LLC*,

IPR2025-00217, Paper 9, at 3 (PTAB June 13, 2025) (informative) (citation omitted); *Samsung Elecs. Co. v. Wilus Inst. of Standards & Tech. Inc.*, IPR2025-00933, Paper 11, at 3 (PTAB Oct. 10, 2025) (similar); *Am. Airlines, Inc. v. Intellectual Ventures I LLC*, IPR2025-00785, Paper 11, at 3 (PTAB Aug. 29, 2025) (Acting Director) (similar). The 5 patent families in the ITC are: (1) the '035 patent (at issue here) on “data buffers,” EX2015, 26, ¶ 90; *id.* 23, ¶ 70, which is related to the '506 patent where the Board invalidated 20 claims, EX1068–69, EX1101; (2) the '087 patent on “high bandwidth” memory, EX2015, 27, ¶ 100, which is at issue in PGR2025-00071 and IPR2025-01402, and is related to two patents where the Board invalidated 54 claims, EX1093–94; (3) the '731 patent on “impedance mismatch,” EX2015, 22, ¶ 59, which is at issue in IPR2025-01431 and related to three patents where the Board invalidated 99 claims, *see* EX1116, 1:28–:44; EX1015; EX1031–34; (4) the '366 patent on “power management,” EX2015, 21, ¶ 49, which is at issue in PGR2026-00001 and IPR2026-00018, and is related to two patents where the Board invalidated 60 claims, EX1090–92; and (5) the '523 patent on “testing,” EX2015, 24, ¶ 80, which was stayed for years, EX1098.

D. The *Fintiv* factors favor institution, given that this proceeding is far ahead of Netlist’s belated ITC action

The *Fintiv* factors favor institution given that this proceeding is far ahead of Netlist’s belated ITC action. Netlist’s arguments (DD Req. 14–17) are incorrect.

Factors 1–4: Factors 1–4 favor institution because the Final Written

Decision here will easily beat the ITC's Final Determination: The projected statutory deadline here is "April 29, 2027." DD Req. 15. Netlist's belated ITC action, in contrast, was only instituted a few weeks ago, EX1102, and has a target date for a Final Determination on "September 3, 2027," EX1103, 2, which is *over four months after* the statutory deadline here.

Given that this proceeding is far ahead of Netlist's belated ITC action, the ITC will defer to "the PTO's role as the lead agency in assessing the patentability, or validity, of . . . issued claims," thus avoiding inconsistency and promoting efficiency. *Certain Unmanned Aerial Vehicles and Components Thereof*, Inv. No. 337-TA-1133, Comm'n Op., 2020 WL 5407477, at *21 (Sept. 8, 2020). Netlist's arguments for Factors 1 and 4 about the lack of a "stay," "inefficiency," and "overlap[]" are thus incorrect. DD Req. 14, 16–17. Netlist argues that "Samsung has not submitted *any stipulation* that it will forgo overlapping validity challenges at the ITC," DD Req. 16–17, but that is because this proceeding is so far ahead of the ITC that Samsung has not yet served any invalidity contentions in the ITC, and the statutory estoppel under 35 U.S.C. § 315(e)(2) moots the need for a stipulation: everyone (including the ITC) will know as soon as this proceeding is instituted that Samsung will be estopped under § 315(e)(2) *months* before the target date for the ITC to decide validity, thus obviating any reason for the ITC to ever consider those invalidity arguments (either before or after the estoppel) or for Samsung to ever

pursue invalidity arguments that will be estopped.

Factor 2 strongly favors institution as shown above. Netlist incorrectly focuses on the ITC's *initial* determination and hearing dates, DD Req. 15, contrary to the Board's policy that it is "less likely to deny institution under *Fintiv* where the ITC *projected final determination* date is *after* the Board's deadline to issue a final written decision," EX1107, 2 (emphasis added), as is true here, as explained above. *See also RingConn LLC v. Ouraring, Inc.*, IPR2025-00412, Paper 11, at 2–3 (PTAB June 25, 2025) (Acting Director) (focusing on the date for "*conclusion* of the ITC investigation" (emphasis added)). In any event, the projected statutory deadline here of "April 29, 2027," DD Req. 15, will *also* beat the ITC's *initial* determination on "May 3, 2027," EX1103, 2. Finally, as explained above, in light of *Certain Unmanned Aerial Vehicles* and the estoppel under § 315(e)(2), there is no risk of inconsistent decisions or duplication of effort in the ITC.

Factor 3 also favors institution because Netlist's belated ITC action was only instituted a few weeks ago, EX1102, making it highly likely that "at the time of the [PTAB's] institution decision, the [ITC will] not [have] issued orders related to the patent at issue in the petition, [which] weighs against exercising discretion to deny institution," *Fintiv* at 10 (Factor 3).

Netlist is therefore incorrect that the ITC is "a *faster* forum to determine validity." DD Req. 14. The PTAB is, as explained above. And the same is true

with respect to 4 of the other 5 patents in the ITC (all but the '523 patent): The '087, '731, and '366 patents are subject to petitions with an expected Final Written Decision months ahead of the ITC's target date of September 3, 2027, *see* EX1103, 2, meaning the ITC will defer to the PTAB as explained above. *See* PGR2025-00071 and IPR2025-01402 ('087 patent, March 4, 2027); IPR2025-01431 ('731 patent, March 9, 2027); PGR2026-00001 and IPR2026-00018 ('366 patent, May 20, 2027). The '608 patent is the subject of an *ex parte* reexam, *see* EX1099, which was filed before Netlist's ITC action and "will be conducted with special dispatch," 37 C.F.R. § 1.550(a), meaning it should also beat the ITC. Only the '523 patent is not subject to a pending USPTO proceeding, but that patent has been stayed in district court *for over two years* (without Netlist filing an ITC action until now), EX1098, showing its lack of importance to the parties' dispute.

Factors 5 and 6: Although Samsung is a defendant/respondent in the parallel ITC proceeding (Factor 5), the merits of the Petition are strong given the material errors by the Examiner as shown by the Board's Final Written Decisions discussed above (pp.1–9), which favors institution (Factor 6).

E. The Petition correctly named the Real Parties in Interest

Netlist is incorrect that the Petition "fails to name [SEA] as an RPI." DD Req. 17. This is the same argument Netlist raised in IPR2025-01402, PGR2025-00071, and IPR2025-01431, and it is incorrect for the same reasons provided in

those proceedings, which are summarized here:

The Petition correctly identified the real parties in interest as SEC (Korea) — the Petitioner, “responsible for manufacturing the Accused [Products]” — and SSI (California), the subsidiary of SEC (Korea) “responsible for marketing and facilitating sales of [the Accused Products] in the United States.” EX1117, 3–4; *see also* Paper 1, 1 (“The real parties in interest are the Petitioner, [SEC (Korea)], and [SSI (California)]”); Paper 2 (power of attorney by SEC (Korea)); EX2015, 11–12 (¶¶6–7), 22 (¶60) (accusing MRDIMM of infringing the ’035 patent).

SEA, in contrast, is a different subsidiary of SEC (Korea) that is *not* responsible for the accused products and instead “focuses on commercializing Samsung end-user products, such as consumer electronics products and mobile devices,” EX1117, 4, which are *not* accused of infringing the ’035 patent. Netlist has repeatedly named SEA as a token defendant to try to establish venue in the Eastern District of Texas, which Samsung disputes is proper, *see* EX1117, and is why SEA has joined in mirror-image declaratory judgment actions asserting venue is proper in Delaware, *see* EX2044. In the original lawsuit, before any disputes about venue in Texas, only SEC (Korea) and SSI (California) were named in Delaware, *see* EX1111, given they are the only *real* parties in interest.

Netlist has had in its possession for months — but failed to disclose to the Board — declarations confirming the facts above, including the following:

- “SSI [California] is responsible for marketing and facilitating sales of Samsung HBM and dual in-line memory module (‘DIMM’) products in the United States....SEC [Korea] is responsible for manufacturing the Accused Products, and it does so only outside the United States.” EX1109, ¶¶ 5–6.
- “SEA focuses on end-user products. HBM and dual in-line memory modules (‘DIMMS’) are stand-alone DRAM components and are not end-user products. SEA has not designed, manufactured, marketed, offered for sale, or sold stand-alone DRAM products or imported them into the United States since at least 2019.” EX1108, ¶ 7.

Unsurprisingly, given these facts, Petitioner has consistently named only SEC (Korea) and SSI (California) as the real parties in interest, and never SEA, in over 15 petitions against Netlist over the past four years in cases involving HBM and DIMMs. *See, e.g.*, IPR2022-00062 to -64; IPR2022-00615; IPR2022-00639; IPR2022-00711; IPR2022-00996; IPR2022-00999; IPR2022-01427 to -28; IPR2023-00454 to -55; IPR2023-00847; IPR2025-00001 to -02. Netlist points to other petitions naming SEA, *see* DD Req. 19, but they involved different patents and accused products. Netlist has never argued, in any of the previous 15 petitions over the past four years, that SEA is a real party in interest under *AIT* or *RPX* (despite Netlist repeatedly naming SEA as a token defendant in the related litigation). And the Board has specifically rejected Netlist’s argument under *AIT* and *RPX* that a *customer* (such as SEA) becomes a real party in interest or privy

simply because Netlist has named that customer as a defendant in related litigation:

Petitioner [SEC (Korea)] contends that it is the real party-in-interest in this proceeding and that the relationship between [its customer] Google and Petitioner is nothing more than a ‘standard customer-manufacturer relationship for the [accused] product’ Petitioner’s and Google’s interests are aligned insofar as they have been accused of infringing the same patent, but the evidence shows that they are acting independently, and that Petitioner did not file the Petition at the behest of or on behalf of Google. . . . Petitioner provides compelling authority that a manufacturer-customer relationship alone does not establish privity, even with indemnity provisions.

EX1110, 13, 14, 23; EX1033, 3.

There is no basis to permit Netlist to relitigate “real party in interest” and privity under *AIT* and *RPX* now, after so many years and petitions, and after losing on these issues in the past as shown above. 37 C.F.R. § 42.73(d)(3). Netlist now argues that SEA is an RPI because “SSI is a wholly-owned subsidiary of SEA,” DD Req. 18, but that is incorrect: “The traditional rule is that mere status as a corporate parent is insufficient to render an entity an RPI (or even a privy).” *Syngenta Crop Protection AG v. FMC Corp.*, PGR2020-00028, Paper 8, at 15 (PTAB Sept. 15, 2020). Nor is it sufficient that SEA is named as a token defendant in litigation or is a customer, as explained above. The relevant factors here are the *opposite* of *AIT/RPX*, given “[m]ost critically” that SEA did not “pa[y]” Petitioner to “reduce” its “exposure” and given that Petitioner has the

“apparent risk of infringement liability” while SEA has little to none in comparison. *RPX*, IPR2015-01750, Paper 128, at 31; EX1110, 18–19. In sum, Petitioner correctly named its RPIs, unlike Netlist, as explained below.

F. Netlist’s history of spending over \$100 million to harass Samsung with meritless litigation weighs strongly against discretionary denial here, and raises national security concerns about the source of Netlist’s funding

Netlist’s history of harassing Samsung with invalid patents weighs strongly against discretionary denial here. Over the past four years, Netlist has spent over \$100 million to harass Samsung with meritless litigation, as confirmed by Final Written Decisions in favor of Samsung invalidating all asserted claims in 7 of the 8 patents in the “multiple jury verdicts” cited by Netlist, *see* DD Req. 5 (citing EX2014, EX2017). *See* EX1031–32 (’339 patent), EX1090–92 (’918 and ’054 patents), EX1093–95 (’060 and ’160 patents), EX1033–34 (’912 patent), EX1096–97 (’417 patent). The 8th patent (the ’608 patent) is the subject of an ongoing *ex parte* reexam. *See* EX1099. And with respect to the alleged breach of the JDLA agreement, *see* DD Req. 4–5, the court awarded Netlist only \$1, *see* EX2009.

Netlist’s lavish spending on litigation, despite being a “small company,” DD Req. 2, raises significant questions about Netlist’s representation that it is the *only* real party in interest in this proceeding. *See* Paper 5; 37 C.F.R. § 42.8(a)(2), (b)(1). Over the past four years, Netlist has spent far more on “legal fees” — over \$100 million — than its “[g]ross profit” of \$21.7 million. *See* EX1087, 53; EX1088, 59;

EX1089, 6. Clearly someone other than Netlist is funding the repeated assertion of invalid patents against Samsung, but Netlist has not identified who it really is. That raises national security concerns, given Samsung's critical contributions to this country's dominance in computing technology. EX2024, 2 ("Opaque investment structures...by foreign adversaries"). Netlist concedes there are "important national security and economic interests" in this area. DD Req. 19–20.

Netlist asserts that its licensee SK hynix "will invest \$3.87 billion in a chip packaging facility in Indiana," DD Req. 20, but there is no evidence that SK hynix's planned facility in Indiana has any relevance to the '035 patent or to the products that allegedly practice that patent. In any event, that is peanuts compared to Samsung's \$47 billion invested in the United States. EX1115; EX1112–14. And Netlist itself has not made meaningful contributions to the economy or national security and instead operates at a significant loss as discussed above.

G. Netlist's arguments improperly circumvent the Board

All of Netlist's arguments to the Director improperly circumvent the "Board [which] institutes the trial on behalf of the Director." 37 C.F.R. § 42.4(a); 77 Fed. Reg. 48,612, 48,616 (Aug. 14, 2012). This is especially true given the Board's prior Final Written Decisions above (pp.1–9) invalidating similar claims.

III. CONCLUSION

Netlist's discretionary denial request lacks merit. Trial should be instituted.

Dated: January 29, 2026

/Eliot D. Williams/
Eliot D. Williams, Reg. #50,822
BAKER BOTTS L.L.P.
700 K Street, N.W.
Washington, D.C. 20001
T: (202) 639-1334
F: (202) 639-1167

Theodore W. Chandler
Reg. No. 50,319
BAKER BOTTS L.L.P.
1801 Century Park East
Suite 2400
Los Angeles, CA 90067
T: (213) 202-5702
F: (213) 202-5732

Ferenc Pazmandi
Reg. No. 66,216
BAKER BOTTS L.L.P.
101 California Street
Suite 3200
San Francisco, CA 94111
T: (415) 291-6255
F: (415) 291-6355

Mark A. Speegle
Reg. No. 77,512
BAKER BOTTS L.L.P.
401 South First Street, Suite 1300
Austin, Texas 78704
T: (512) 322-2536
F: (512) 322-3636

*Counsel for Petitioner
Samsung Electronics Co., Ltd.*

CERTIFICATE OF COMPLIANCE

I hereby certify that this **Petitioner’s Opposition to Patent Owner’s Discretionary Denial Request**, excluding the parts of the brief exempted by 37 C.F.R. § 42.24, complies with the page limits provided by § III.C.iii of the Interim Director Discretionary Process, <<https://www.uspto.gov/patents/ptab/interim-director-discretionary-process>>, which states: “Effective for patent owners’ discretionary denial requests due on or after September 1, 2025, a petitioner’s opposition to the patent owner’s discretionary denial brief is limited to 20 pages, regardless of when a patent owner files its brief.”

Dated: January 29, 2026

/Eliot D. Williams/
Eliot D. Williams, Reg. #50,822
BAKER BOTTS L.L.P.
700 K Street, N.W.
Washington, D.C. 20001
T: (202) 639-1334
F: (202) 639-1167

*Counsel for Petitioner Samsung
Electronics Co., Ltd.*

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 29th day of January, 2026, **Petitioner’s Opposition to Patent Owner’s Discretionary Denial Request** was served by email on the following counsel for Patent Owner:

Richard M. Bemben (Reg. No. 68,658) STERNE, KESSLER, GOLDSTEIN & FOX PLLC 1101 K Street NW, 10th Floor Washington, DC 20005 Phone: (202) 772-8549 Fax: (202) 371-2540 Email: PTAB@sternekessler.com rbemben-PTAB@sternekessler.com	Jennifer Meyer Chagnon (Reg. No. 55,440) STERNE, KESSLER, GOLDSTEIN & FOX PLLC 1101 K Street NW, 10th Floor Washington, DC 20005 Phone: (202) 772-8890 Fax: (202) 371-2540 Email: PTAB@sternekessler.com jchagnon-PTAB@sternekessler.com
Richard C. Kim (Reg. No. 40,046) NETLIST, INC. 111 Academy Way, Suite 100 Irvine, California 92617 Phone: (949) 679-0124 Email: PTAB@sternekessler.com rkim@netlist.com	Raymond K. Chan (Reg. No. 66,164) NETLIST, INC. 111 Academy Way, Suite 100 Irvine, California 92617 Phone: (949) 679-0101 Email: PTAB@sternekessler.com rchan@netlist.com
Francisco A. Rubio-Campos (Reg. No. 45,358) NETLIST, INC. 111 Academy Way, Suite 100 Irvine, California 92617 Phone: (949) 377-0296 Email: PTAB@sternekessler.com frubio@netlist.com	

Dated: January 29, 2026

/Eliot D. Williams/
Eliot D. Williams, Reg. #50,822
BAKER BOTTS L.L.P.
700 K Street, N.W.
Washington, D.C. 20001
T: (202) 639-1334
F: (202) 639-1167

*Counsel for Petitioner Samsung
Electronics Co., Ltd.*