

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner

v.

NETLIST, INC.,
Patent Owner

Case IPR2026-00017
U.S. Patent No. 9,824,035

**PATENT OWNER PRELIMINARY RESPONSE
UNDER 37 C.F.R. § 42.107(a)**

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.	THE '035 PATENT	3
	A. Summary	3
	B. IPR2022-00236: The PTAB previously determined that claims 2 and 6 were not obvious over Osanai and Tokuhiro.	3
	C. Claim Construction.....	4
III.	THE DIRECTOR SHOULD DENY INSTITUTION.....	4
	A. The Petition fails to name all real parties in interest.....	4
	1. Relevant Litigation History.....	6
	2. SEA is an unnamed RPI.....	7
	3. The Director should deny the Petition.	9
	B. Samsung advances inconsistent claim constructions in its Petition and in its Delaware DJ complaint.	12
	C. The Petition fails to demonstrate a reasonable likelihood the claims would have been obvious.	15
	1. Samsung fails to demonstrate claims 2-8 would have been obvious.	15
	2. Samsung fails to demonstrate that claims 4 and 14-20 would have been obvious.....	18
	3. Samsung fails to address known secondary considerations of non-obviousness, including its own licensing activities.....	20
	a. Samsung licensed Netlist’s portfolio in 2015.....	22
	b. SK hynix licensed Netlist’s portfolio in 2021.	24
	D. The Petition fails to present its Grounds “with particularity.”.....	25
	E. <i>Chevron</i> and <i>Deeper</i> favor denying institution.....	26
IV.	CONCLUSION.....	27

PATENT OWNER'S UPDATED EXHIBIT LIST

Exhibit No.	Description
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
2011-2013	<i>Intentionally Left Blank</i>
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

Exhibit No.	Description
2016	<i>Intentionally Left Blank</i>
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
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	<i>Intentionally Left Blank</i>
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> , IPR2024-00440, 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
2025-2026	<i>Intentionally Left Blank</i>
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

Exhibit No.	Description
2028	List of Patent Trial and Appeal Board proceedings listing Samsung Electronics America, Inc. as Petitioner, Docket Navigator, generated December 3, 2025
2029-2039	<i>Intentionally Left Blank</i>
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 Elecs. Co., Ltd. v. Netlist, Inc.</i> , Appeal No. 25-1378 (Fed. Cir.), December 9, 2025
2042-2043	<i>Intentionally Left Blank</i>
2044	Complaint, <i>Samsung Elecs. Co., Ltd. et al. v. Netlist, Inc.</i> , Case No. 1:25-cv-01371-JLH (D. Del.), November 11, 2025
2045-2048	<i>Intentionally Left Blank</i>
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. v. Netlist, Inc.</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)
2055	Disclaimer filed in U.S. Patent No. 9,824,035, January 29, 2026

Exhibit No.	Description
2056	Amended Proposed Procedural Schedule, Inv. No. 337-TA-1472 (I.T.C. Jan. 27, 2026)
2057	“Enforcement and Non-Waiver of 37 C.F.R § 42.104(B)(4) and Permissible Uses of General Knowledge in <i>Inter Partes</i> Reviews,” United States Patent & Trademark Office Memorandum, July 31, 2025
2058	Docket, <i>Samsung Elecs. Co., Ltd. et al. v. Netlist, Inc.</i> , Case No. 1:25-cv-01371-JLH (D. Del.), November 11, 2025

I. INTRODUCTION

The Director should deny institution of *inter partes* review of claims 2-9¹ and 14-20 of U.S. Patent No. 9,824,035 (“the ’035 patent”) because: (1) the Petition fails to name a real party in interest (RPI), (ii) Samsung advances inconsistent claim constructions in its Petition and in its complaint for declaratory judgment (DJ) in the District of Delaware (DDE), (iii) the Petition fails to demonstrate a reasonable likelihood of success on the merits, and (iv) the Petition is procedurally deficient. Each of these reasons independently supports denying institution.

First, despite being a clear beneficiary of this challenge to the validity of the ’035 patent, and having a preexisting, established relationship with Petitioner, Samsung Electronics America, Inc. (“SEA”) is not listed as an RPI to this IPR. Not only is SEA a named defendant in the ITC investigation in which Netlist has asserted infringement of the ’035 patent, but SEA is also a named *plaintiff* in Samsung’s declaratory judgment action in Delaware. That Samsung *itself* chose to list SEA as co-plaintiff in the Delaware DJ action forecloses any argument that SEA is not an RPI here. The PTAB’s precedential decision in *Corning Optical* mandates that the Petition cannot be considered given this failure to name all RPIs.

¹ Netlist disclaimed claim 9 to streamline the Director’s review.

Second, Samsung presents inconsistent claim construction positions in this IPR and in the Delaware DJ action. In its Petition, Samsung acknowledges and adopts the PTAB's prior determination of "memory operation." But in its DJ complaint, Samsung argues its products do not infringe based on a narrower construction of "memory operation" that plainly conflicts with the Board's prior construction. Samsung provides *no explanation* for its different claim construction positions, which it advanced around the same time. *Revvo* mandates denial.

Third, Samsung fails to demonstrate a reasonable likelihood of success on the merits. To start, Samsung presents a convoluted obviousness theory for claim 2 (and claims 3-8 by virtue of their dependency from claim 2) that requires at least ten modifications that are virtually impossible to follow and clearly motivated by hindsight. As another example, Samsung fails to carry its burden to show claims 4 and 14-20 are unpatentable because it does not show Osanai (the relied upon reference) teaches a "programmable" phase relationship. Samsung also fails to address known secondary considerations of non-obviousness, including its *own* prior licensing activities related to the '035 patent. At bottom, Samsung's obviousness theories are flawed and incomplete, and thus fail to satisfy the threshold for institution.

Samsung's Petition also violates the Director's guidance and basic procedural rules. The asserted grounds are not presented with particularity as

required, but rather rely on conclusory statements followed by cross-citations to lengthy passages that provide little to no explanation on how the cited evidence supports the assertion. This allows for gamesmanship and shifting theories of the very sort Samsung has advanced in prior proceedings.

Independently, each of these reasons supports denying institution. In combination, they overwhelmingly show that the Director should not institute trial.

II. THE '035 PATENT

A. Summary

The '035 patent describes a memory module that includes buffer circuits, each buffer circuit including logic configured to obtain timing information based on signals received during a second memory operation prior to a first memory operation. *See* EX1001, 15:18-21. The logic is further configured to control timing of respective data and strobe signals on the data paths in accordance with the timing information. *See* EX1001, 15:46-64. The claimed invention overcomes deficiencies in conventional read/write leveling techniques for managing read/write data timing. EX1001, 15:16-18.

B. IPR2022-00236: The PTAB previously determined that claims 2 and 6 were not obvious over Osanai and Tokuhira.

The '035 patent was the subject of a prior challenge in IPR2022-00236 brought by Micron (the "'236 IPR"). In the '236 IPR, the PTAB upheld the validity of claims 2 and 6 and determined these claims were *not* obvious over

Osanai and Tokuhiro. EX2050, 6. Samsung uses the Micron decision as a roadmap to advance substantially the same art and arguments here.

C. Claim Construction

Samsung carries the burden to explain “how the challenged claim is to be construed” and “how the construed claim is unpatentable.” 37 C.F.R.

§§ 42.104(b)(3)-(4). Samsung alleges no terms need to be construed. Pet., 22.

Nevertheless, as explained below, Samsung advances inconsistent claim interpretations in this IPR and in Samsung’s co-pending DJ action involving the ’035 patent, Section III.B, and fails to explain how it interprets the term “programmable” that is recited in claims 4 and 14, Section III.C.2. The Petition is deficient because it fails to satisfy Rules 104(b)(3)-(4), and thus should be denied.

III. THE DIRECTOR SHOULD DENY INSTITUTION

A. The Petition fails to name all real parties in interest.

The Director should deny the Petition because it fails to name Samsung Electronics America, Inc. (“SEA”) as a real party in interest (RPI). “A petition filed under section 311 may be considered *only if* ... the petition identifies all real parties in interest.” 35 U.S.C. § 312(a)(2) (emphasis added); *see also* 37 C.F.R. §§ 42.8(b)(1), 42.104. It is “Petitioner’s burden to bring forth evidence or arguments that it named all RPIs.” *Yangtze Memory Techs. Co., Ltd. v. Micron Tech., Inc.*, IPR2025-00098, Paper 38 (PTAB Jan 15, 2026) (informative) (citing *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242 (Fed. Cir. 2018)). A petition that

fails to name all RPIs cannot be considered, *Corning Optical Commc 'ns RF, LLC v. PPC Broadband, Inc.*, IPR2014-00440, Paper 68 at 23-24 (PTAB Aug. 18, 2015) (precedential except § II.E.1); EX2024, 1, and thus should be denied.

“Determining whether a non-party is a ‘real party in interest’ ... takes into account both equitable and practical considerations, with an eye toward determining whether the non-party is a clear beneficiary that has a preexisting, established relationship with the petitioner.” *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1351 (Fed. Cir. 2018) (“*AIT*”). Factors relevant for evaluating whether a party is an unnamed RPI include: (i) the relationship between the petitioner and the unnamed party; (ii) the unnamed party’s “interest in” and “benefit from” the IPR; (iii) whether petitioner can be said to be representing that interest; and (iv) whether the unnamed party desired review of the patent. *See RPX Corp. v. Applications in Internet Time, LLC*, IPR2015-01750, Paper 128 at 10-11 (PTAB Oct. 2, 2020) (precedential) (“*RPX*”) (listing factors).

“AIA proceedings should not be used by foreign adversaries,” like Samsung, “to harass American patentees,” like Netlist. EX2024, 4. Samsung, who has twice been found to willfully infringe Netlist patents, has repeatedly used the PTAB to attempt to avoid paying a fair price for its unauthorized use of Netlist’s patented technology. *See* Netlist Discretionary Denial Brief (“DD Br.”), Paper 8, at 5-6. Here, Samsung again attempts to avail itself of review before the PTAB but

violates its statutory and regulatory obligation to name all RPIs in its Petition. The Director should apply *Corning* and deny institution.

1. Relevant Litigation History

On September 29, 2025, Netlist filed an ITC complaint against Samsung Electronics Co., Ltd (“SEC”); Samsung Electronics America, Inc. (“SEA”), Samsung Semiconductor, Inc. (“SSI”), and certain of Samsung customers, asserting six patents: the ’035 patent and U.S. Patent Nos. 10,025,731; 10,217,523; 10,268,608; 12,308,087; and 12,373,366. EX2015. Of the six asserted patents, the PTAB has already reviewed and upheld the validity of relevant claims in three of the patents:

- In IPR2022-00236, filed by Micron, the PTAB upheld claims 2 and 6 of the ’035 patent over the combination of Osanai and Tokuhiko (two of the same references that Samsung advances here). EX1066, 62-63.
- In IPR2023-00847, filed by Samsung, the PTAB upheld claims 1-5 of the related ’608 patent, a decision the Federal Circuit affirmed. *Samsung Elecs. Co. v. Netlist, Inc.*, IPR2023-00847, Paper 42 at 73 (PTAB Dec. 10, 2024), *aff’d*, No. 25-1378, Dkt. No. 33 (Fed. Cir. Dec. 9, 2025).
- In IPR2022-00063, filed by Samsung, the PTAB upheld claims 1-34 of the ’523 patent, a decision the Federal Circuit affirmed. *Samsung Elecs. Co. v. Netlist, Inc.*, IPR2022-00063, Paper 53 at 58 (PTAB May 3, 2023),

aff'd, No. 23-2133, Dkt. No. 44 (Fed. Cir. Mar. 5, 2025).

On October 27, 2025, Samsung filed the Petition in this IPR listing SEC as the Petitioner and SSI as an RPI. Pet., xvii. About two weeks later, on November 11, 2025, the three Samsung entities SEC, SEA, and SSI filed a complaint in the District of Delaware (DDE) for declaratory judgment of non-infringement of the '035 patent. EX2044.

On December 29, 2025, following a delay due to the government shutdown, the ITC instituted the investigation (337-TA-1472). EX2054.

2. SEA is an unnamed RPI.

SEA is an unnamed RPI: it “is a clear beneficiary that has a preexisting, established relationship with the petitioner” SEC and with real party in interest SSI. *AIT*, 897 F.3d at 1351. Taking those requirements in reverse order, SEA indisputably has a preexisting, established relationship with both SEC and SSI. According to Samsung, “SSI is a wholly-owned subsidiary of SEA, which itself is a wholly-owned subsidiary of SEC.” EX2027, 1. Netlist alleges that, collectively, the three Samsung entities import and/or sell within the United States after importation certain products that infringe the '035 patent (and the other patents asserted in the ITC). EX2005, 7 (¶24).

SEA would also plainly benefit from review and potential invalidation of the '035 patent in this proceeding. EX2015, 2. As a respondent in the ITC

investigation, SEA would benefit from the expedited review afforded by an IPR, which applies a more favorable burden of proof for invalidity than an ITC investigation (preponderance vs. clear and convincing) and (if successful) could allow Samsung to avoid an ITC import ban of the accused memory products. SEA's voluntary participation as co-plaintiff in the Delaware DJ action, which was filed shortly after Samsung filed its Petition in this proceeding, is particularly telling because (i) Samsung had control over which parties to name and chose to include SEA and (ii) in doing so, Samsung represented to the DDE court that "[a]n immediate, real, and justiciable controversy exists between Samsung [including SEA] and Netlist as to whether Samsung has infringed the '035 patent." EX2044, 3 (¶12). SEA has a significant stake in the outcome of this IPR and would clearly benefit if the PTAB were to invalidate the claims of the '035 patent.

The relevant *RPX* factors also show that SEA is an unnamed RPI. As to factor (i), SEA is a subsidiary of SEC and parent of SSI, and therefore clearly has a relationship with both Samsung entities. As to (ii), SEA's involvement in two co-pending litigations demonstrates it has a significant stake and would benefit from a favorable outcome in this IPR. As to (iii) and (iv), SEC (as parent) and SSI (as subsidiary) are plainly representing the interests of SEA—in particular, its interest in avoiding liability for infringement by attempting to invalidate the asserted patent. *See RPX*, IPR2015-01750, Paper 128 at 27.

Finally, Samsung is the leading petitioner in AIA challenges and has named SEA as an RPI on close to 800 petitions. EX2020, 48; EX2028. Samsung knew it failed to fulfill the requirement for naming all RPIs because Netlist has raised this issue in its discretionary denial brief and in multiple related proceedings. *See, e.g.*, Paper 8, 17-19. Yet Samsung has made no attempt to meet its burden to demonstrate it named all RPIs, nor can it with the clear-cut evidence that SEA is an RPI. *See Yangtzee*, IPR2025-00098, Paper 38 at 8 (when the identification of RPIs is in dispute, Petitioner has the burden to demonstrate it named all RPIs).

3. The Director should deny the Petition.

The Director should not consider the Petition because it fails to name all RPIs. *Corning*, IPR2014-00440, Paper 68 at 23-25; *Yangtzee*, IPR2025-00098, Paper 38 at 8. In this case, the correct remedy is to terminate the proceeding.

PTAB precedent from prior administrations has allowed petitioners to correct petitions that fail to name an RPI without any consequence, such as without altering the filing date. *See Adello Biologics LLC v. Amgen Inc.*, PGR2019-00001, Paper 11 (PTAB Feb. 14, 2019) (precedential) (allowing correction while maintaining filing date); *Proppant Express Inv., LLC v. Oren Techs., LLC*, IPR2017-01917, Paper 86 (PTAB Feb. 13, 2019) (precedential) (same). *Corning* says otherwise, listing a host of cases that were terminated for failure to name all RPIs and rejecting the petitioner's request to correct without altering the filing

date. IPR2014-00440, Paper 68 at 23-25. To the extent *Adello* and *Proppant* are inconsistent with *Corning*, they should be de-designated and put to pasture.

Second, Samsung should not be permitted to correct its Petition at this stage. First, no good cause exists. Samsung clearly knew that it would name SEA as a co-plaintiff in the Delaware DJ action, which it filed about two weeks after filing the Petition in this proceeding. Samsung simply (and incorrectly) chose not to list SEA here, despite the statutory and regulatory obligation to do so. There is no excuse for this omission.

Second, Samsung has made no effort to correct its Petition, and, at this point, any request for correction would not be timely. Netlist put Samsung on notice that Samsung failed to meet its RPI obligations in related IPRs in early December 2025, *see* IPR2025-01402, Paper 12 at 8-17, and that Samsung failed to meet its RPI obligation in this IPR in mid-December 2025, *see* IPR2025-01402, Paper 17 at 2-3. Samsung has thus been on notice for almost two months. Despite the evidence to the contrary, Samsung merely alleges that SEA is not an RPI to these proceedings. *See* IPR2025-01402, Paper 16 at 1-4.

Third, it is bad policy to allow a petitioner to correct its petition, which would circumvent the statute and invite gamesmanship. Congress plainly stated that a petition may only be considered if the petition identifies all real parties in interest, and that requirement is echoed in the PTAB regulations. 35 U.S.C.

§ 312(a)(2); 37 C.F.R. § 42.104. Allowing a petitioner to correct a petition by adding an unnamed RPI would impart no real consequence for failure to follow these requirements.

Worse yet would be to change the filing date and restart the proceeding, if even possible. This would be grossly unfair to the patent owner, as it would allow the petitioner to see all of the patent owner's arguments (including discretionary briefing) before the proceeding was restarted. That is, it would permit the petitioner a second bite at the apple and open the door to road mapping based on all the arguments that a patent owner included in its discretionary denial briefing and preliminary response. Further, it would drive up costs to the patent owner because the patent owner would have to expend resources to defend itself again. Because circumstances that may affect the analysis (particularly on discretionary issues) will have changed based on any new later filing date, simply relying on the already-filed briefing would not be sufficient.

Finally, in this case, it would be futile to accord a new filing date and restart this proceeding because of the state of the co-pending ITC investigation. Again, the ITC instituted the investigation on December 29, 2025. EX2054. On January 27, 2026, ALJ McNamara issued an amended proposed procedural schedule setting the date for the evidentiary hearing (trial) in late November / early December 2026, the final initial determination on May 3, 2027, and the target date on September 3,

2027. EX2056. The Director’s decision on institution (DI) here is due April 29, 2026. According a new filing date and restarting this proceeding would push the DI due date out for another six months, to the end of October 2026. In that case, the FWD would be due at the end of October 2027, which is well past all the key milestones in the ITC investigation. *Fintiv* and other discretionary considerations would favor denial even more strongly than they do now, *see* Paper 8 (“DD Brief”),² and thus restarting this proceeding would unnecessarily expend the PTAB’s and the parties’ limited resources to redo the pre-institution phase of a proceeding that plainly should be denied under *Fintiv*. Therefore, the Director should deny the Petition.

B. Samsung advances inconsistent claim constructions in its Petition and in its Delaware DJ complaint.

The Director should deny institution because Samsung takes inconsistent claim construction positions in its Petition (filed October 27, 2025) and in its DJ complaint in Delaware (filed November 11, 2025). Claim 1 recites “memory operation,” such as the claimed first and second memory operations. EX1001, 19:42-43 (“a second memory operation prior to the first memory operation”). In its

² Netlist maintains that the discretionary considerations overwhelmingly favor denying the Petition without even reaching the merits/non-discretionary considerations. *See generally* Paper 8.

Petition, Samsung acknowledges that the Board in IPR2022-00236 interpreted “memory operation” broadly to include training operations, such as write leveling operations: “the Board interpreted ‘*memory operation*’ to encompass write operations and write leveling operations” Pet., 23 (citing EX1066, ’236 Final Written Decision, 31-33). In its DJ complaint, Samsung alleges that its “Memory Modules do not satisfy the requirements for claim 1 for at least the reason that the alleged ‘timing information’ is not obtained during a ‘second memory operation’ because the timing information is set based on *trainings* that are not a ‘memory operation.’” EX2044, 27 (§106) (emphasis added). That is, Samsung embraces the Board’s prior, broader interpretation of “memory operation” in the Petition when seeking to invalidate the claims but advances a narrower construction in its DJ complaint to try to avoid infringement.

Samsung provides no explanation for its inconsistent positions, which it advanced only two weeks apart. Nor did Samsung seek leave to explain these inconsistencies after the Director designated *Revvo I* precedential and *Tesla* informative in early November 2025, shortly after Samsung filed its IPR petition but before Samsung filed its DJ complaint. *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 (PTAB Nov. 3, 2025) (precedential) (“*Revvo I*”); *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18 (PTAB Nov. 5, 2025) (informative). Samsung’s attempt to adopt a broader

construction before the PTAB when challenging validity but a narrower construction in district court when trying to avoid liability is the type of gamesmanship *Revvo I* and *Tesla* prohibit.

To be sure, the Director in *Revvo II* reemphasized “that the Board’s claim construction rules discourage petitioners from seeking broader constructions at the Board to support unpatentability while seeking narrower constructions in litigation to avoid infringement liability.” *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 36, 2 (PTAB Jan. 26, 2026) (“*Revvo II*”); *see id.* (“Simply put, you can’t have it both ways and certainly not without a sufficient explanation.”). He explained that a petitioner “may proffer a different, broader construction before the Board” only in the “rare instance[]” when “the district court *already has rejected* petitioner’s narrower construction.” *Id.* at 4; *see id.* (“My precedential [*Revvo I*] decision does not provide for conditional future outcomes”).

Here, the district court handling Samsung’s DJ action has *not* already rejected Samsung’s narrower construction of “memory operation”; nor will address claim construction any time soon as Samsung’s DJ action is still in its early stages. EX2058. Samsung’s inconsistent claim construction positions are directed to a term in claim 1, which is likewise required by all the dependent claims that Samsung challenges here. Because this deficiency applies to all challenged claims,

the Director should deny review. *Revvo II*, IPR2025-00632, Paper 36 at 4 (“The appropriate course of action under these circumstances is to deny institution.”).

C. The Petition fails to demonstrate a reasonable likelihood the claims would have been obvious.

In addition to the deficiencies identified above, the Petition’s obviousness Grounds fail to demonstrate a reasonable likelihood the challenged claims are unpatentable.

1. Samsung fails to demonstrate claims 2-8 would have been obvious.

Claim 2 depends on claim 1 and recites that “the first memory operation is a memory read operation and the second memory operation is a memory write operation.” Because claims 3-8 depend on claim 2, Samsung’s challenges to claims 3-8 rise or fall with claim 2.

Samsung presents three Grounds and alleges that each of the Grounds renders claim 2 obvious. Pet., 1, 83. But Samsung relies only on the references in Ground 1 to address claim 2. Pet., 83. Thus, as best understood, Samsung’s challenge to claim 2 is limited to the combination of Osanai, Butt, and Tokuhira.³

³ The lack of clarity in Samsung’s Petition is not limited to claim 2. In each of its three Grounds, Samsung alleges that all challenged claims are unpatentable without explaining the role (if any) that each reference has in its obviousness

Samsung fails to demonstrate that this combination renders claim 2 obvious.

To start, none of the references teaches the limitation recited in claim 2. Nor does Samsung allege otherwise. Instead, Samsung presents a sprawling and convoluted obviousness theory that requires no less than 10 modifications to Osanai, Butt, and Tokuhiko to arrive at the feature recited in claim 2. Pet., 35-57 (attempting to explain the Ground 1 combination). As best understood, Samsung's challenge to claim 2 requires at least the following modifications:

1. Implementing Tokuhiko's DR delay elements in Osanai's data buffers.
Pet., 49-50.
2. Adding Tokuhiko's read delay elements to Osanai's data buffer
"immediately after the DQ data signal from the memory is latched ...
using the DQS strobe that has been centered using Butt's technique."
Pet., 51.
3. Modifying Osanai's module controller to "measure[] the impact of the
fly-by delays at each data buffer during a write operation." Pet., 53.
4. Further modifying Osanai's module controller to "program[] Tokuhiko's

theories. A petition is required to identify the grounds "with particularity." 35
U.S.C. § 312(a)(4); *see also* 37 C.F.R. § 42.104(b)(3)-(4). Samsung's failure to do
so is a fatal defect that runs throughout the Petition and warrants denying review.

- DR delay elements in the data buffers to remove those fly-by delays in subsequent read operations” Pet., 53.
5. Using Butt’s “write operations during initialization to measure the fly-by delays.” Pet., 54.
 6. Applying “Osanai’s time measuring techniques to determine the fly-by delays.” Pet., 55.
 7. Using Osanai’s feedback channel DRF “to communicate the measured time intervals from each of the data buffer circuits back to the module controller” Pet., 55.
 8. Further modifying the module controller to “program Tokuhiko’s DR delay elements in the data buffers to remove those fly-by delays in subsequent read operations.” Pet., 55.
 9. “[I]mplement[ing] Tokuhiko’s write delay elements DW in Osanai’s data buffers *and* ... program[ming] them to compensate for fly-by delays in the write direction.” Pet., 55-56 (emphasis added).
 10. Finally, performing the process of removing fly-by delays in the middle of Osanai’s calibration procedure of Figure 13; more specifically, right *in between* Osanai’s S4 and S5 read leveling procedures. Pet., 56-57.

Even if all these modifications were technologically feasible (which Netlist does not concede) and one could follow Samsung’s Ikea-like assembly

instructions, no POSITA would have attempted such a complex undertaking unless motivated by hindsight. Samsung plainly fails victim to impermissible hindsight, seeking to use Netlist’s invention as a roadmap to combine and modify so many aspects of the three references. Using hindsight in this manner is improper and should be rejected. *Ruiz v. AB Chance Company*, 357 F.3d 1270, 1275 (Fed. Cir. 2004) (“This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result — often the very definition of invention.”). Indeed, the lack of clarity and sheer complexity of Samsung’s theory confirms that claim 2 would not have been obvious over Osanai, Butt, and Tokuhiko, similar to what the PTAB previously held.⁴

2. Samsung fails to demonstrate that claims 4 and 14-20 would have been obvious.

Dependent claims 4 and 14 recite, “wherein the each respective buffer circuit is further configured to receive a module clock signal and further includes a clock regeneration circuit configure to generate a local clock signal having a *programmable* phase relationship with the module clock signal, wherein the each respective buffer circuit is further configured to output the local clock signal to the

⁴ Again, the PTAB in IPR2022-00236 already upheld claim 2 over the combination of Osanai and Tokuhiko.

respective set of memory devices.” Claims 15-20 depend from claim 14. Samsung alleges that Osanai teaches the elements of claims 4 and 14. Pet., 86-88 (addressing claim 4), 99 (addressing claim 14 by reference to claim 4).

Samsung fails to show that Osanai teaches the required “programmable” phase relationship. Samsung carries the burden to explain “how the challenged claim is to be construed” and “how the construed claim is unpatentable.” 37 C.F.R. §§ 42.104(b)(3)-(4). Samsung does not explain how the term “programmable” in claims 4 and 14 should be construed. Pet., 22 (adopting the position that no terms require construction). Instead, it merely cites to paragraphs 80, 93, 151, and 169 of Osanai as allegedly teaching a clock regeneration circuit that generates a local clock signal that has “a programmable” phase relationship with the module clock signal. Pet., 86-87. But none of these paragraphs use the term “program” or “programmable,” or state that a local clock signal is generated that has a “programmable” phase relationship with a module clock signal.

Paragraph 80 of Osanai describes a DLL circuit 212 in memory chip 200 that “generate[s] an internal clock LCLK,” which is “phase-controlled with respect to the clock signal CK.” EX1005, ¶80. Paragraph 169 similarly explains that the DLL circuit “generates an internal clock signal of which a phase is controlled with respect to an external clock signal” EX1005, ¶169. But neither Samsung nor its expert explains how the term “programmable” should be interpreted or why

controlling a phase satisfies the claimed “programmable” phase relationship. *See* EX1003, ¶¶229-230 (expert repeating Petition’s arguments).

Paragraphs 93 and 151 of Osanai are even further afield. Paragraph 93 explains that the DLL circuit 310 in data register buffer 300 may have the same configuration and function as the DLL circuit 212 in memory chip 200. EX1005, ¶93. And paragraph 151 explains that an internal clock signal is displaced during a write leveling procedure. EX1005, ¶151. But again, neither paragraph mentions a phase relationship that is “programmable.” Nor does Samsung provide any explanation to support its theory. Accordingly, Samsung fails to demonstrate a reasonable likelihood that Osanai teaches the “programmable” phase relationship required by claims 4 and 14-20.

3. Samsung fails to address known secondary considerations of non-obviousness, including its own licensing activities.

Compounding the case for denial on the merits, Samsung’s obviousness challenges are incomplete because Samsung fails to address known secondary considerations of non-obviousness, including its own licensing activities related to the ’035 patent. Secondary considerations “may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art was not.” *Apple Inc. v. Samsung Elecs. Co., Ltd.*, 839 F.3d 1034, 1052-53 (Fed. Cir. 2016) (en banc) (quoting *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538-39 (Fed. Cir. 1983)). Evidence of

secondary considerations “must be considered in every case where present,” *Apple*, 839 F.3d at 1048, and may be “crucial in avoiding the trap of hindsight ...,” *Leo Pharm. Prods., Ltd. v. Rea.*, 726 F.3d 1346, 1358 (Fed. Cir. 2013).

Licensing is one such secondary consideration that must be considered, where present, when evaluating obviousness. *See Ancora Techs., Inc. v. Roku, Inc.*, 140 F.4th 1351, 1362 (Fed. Cir. 2025) (quoting *LaserDynamics, Inc. v. Quanta Comput., Inc.*, 694 F.3d 51, 79 (Fed. Cir. 2012) for the proposition that “[a]ctual licenses to the patented technology are highly probative ... because such actual licenses most clearly reflect the economic value of the patented technology in the marketplace.”). Unlike products, “[l]icenses to the challenged patent ... do not require a nexus with respect to the specific claims at issue, nor does our nexus law require that a particular patent be the only patent being licensed or the sole motivation for entering into a license.” *Ancora Techs.*, 140 F.4th at 1362.

The Board has “cautioned petitioners in prior proceedings that petitions may be denied if they do not address known evidence of secondary considerations.” *Stryker Corp. v. KFX Medical, LLC*, IPR2019-00817, Paper 10 at 28-29 (PTAB Sept. 16, 2019); *see id.*, 29 (collecting Board decisions issued between 2013-2017); *see also Gilead Sciences, Inc. v. The United States of America, Represented by the Secretary of the Department of Health & Human Services*, IPR2019-01453, Paper 14 at 26-30 (PTAB Feb. 20, 2020) (finding that “Petitioner’s failure to

persuasively address the [unexpected results presented during prosecution] in its Petition means Petitioner falls short of its burden to establish a reasonable likelihood of success in prevailing on its challenge”).

Samsung knew of but failed to address in its obviousness Grounds the licensing activities between (1) itself and Netlist and (2) Netlist and SK hynix. This licensing activity demonstrates the economic value and non-obviousness of the technology that is recited in the challenged claims of the '035 patent. Indeed, that Samsung itself licensed the '035 patent is particularly probative of the non-obvious nature of the challenged claims.

a. Samsung licensed Netlist's portfolio in 2015.⁵

Samsung acknowledges its license to Netlist's portfolio included the '035 patent. EX2044, 2 ¶2. Specifically, on November 12, 2015, Netlist and Samsung entered into a Joint Development and License Agreement (“JDLA”) under which Netlist granted Samsung a license to its intellectual property, including Netlist's patents (including the '035 patent), continuations, and pending applications.

EX2001, 1-2, 8.

The parties entered into this agreement to jointly develop certain DRAM

⁵ Netlist's Brief on Discretionary Denial Brief (Paper 8) provides additional details of the history between Samsung and Netlist.

technologies. Indeed, the JDLA enabled Samsung to use Netlist's technology to develop DRAM memory products that are critical to current high-performance computing and AI applications, such as double data rate, 5th generation (DDR5) memory and high bandwidth memory (HBM). EX2015, 7.

As the JDLA indicates, Netlist and Samsung concurrently entered into collateral agreements, including an "Intellectual Property Security Agreement." EX2006, 5-16. Under the Intellectual Property Security Agreement, Netlist granted Samsung a security interest in Netlist's patents and patent applications, including divisions, continuations, and continuations-in-part. EX2006, 5. Thus, Samsung recognized the importance and value of Netlist's patents (and relied on their validity) by requiring them as loan collateral. EX2004. The agreement required that Netlist "[p]rotect, defend, and maintain the validity and enforceability" of the assets. EX2004, 8.

Under the JDLA, Samsung was obligated to supply Netlist certain memory products at competitive prices. However, in 2018, Samsung began to deliberately restrict Netlist's access to products and repeatedly failed to fulfill Netlist's orders, forcing Netlist to forgo business opportunities. EX2008, 4. Accordingly, Netlist terminated the JDLA on July 15, 2020, and filed suit in the Central District of California ("CDCA"). EX2008; EX2015, 7. Samsung did not record the release of its security interest to Netlist's patent assets until October 27, 2023. *See* EX2007.

Following trial in the CDCA, a jury agreed with Netlist that Samsung breached the JDLA and that Netlist's termination was valid. On April 7, 2025, the district court entered judgement against Samsung pursuant to the jury verdict.⁶ EX2009.

b. SK hynix licensed Netlist's portfolio in 2021.

In 2021, SK hynix licensed Netlist's patent portfolio (including the '035 patent), further demonstrating the industry's desire for access to Netlist's superior technology. EX2023. SK hynix is a leading provider of next generation DIMMs and HBM. In the first three months of FY2025, SK hynix reported \$9.1 billion in revenue in the United States. EX2015, 28. A significant portion of this revenue is attributable to products that include Netlist's patented technology.

* * *

Samsung plainly knew of its own licensing activities with Netlist. It also knew that SK hynix took a license to Netlist's portfolio. EX2030, 689:10-24 (testimony on April 18, 2023, in prior litigation between Netlist and Samsung). Because such known secondary-considerations evidence must be considered when evaluating obviousness, Samsung's failure to address this evidence is fatal to its obviousness challenges. Moreover, this real-world evidence demonstrates that

⁶ That decision is on appeal to the Ninth Circuit (case number 25-5531). The district court ruling is *res judicata* unless and until overturned on appeal.

Samsung and SK hynix, two of the largest memory manufactures, considered the claims valuable and non-obvious. Accordingly, the Director should deny institution.

D. The Petition fails to present its Grounds “with particularity.”

As mentioned above, Samsung fails to identify its obviousness challenges “with particularity.” 35 U.S.C. § 312(a)(3). First, the Petition presents Grounds 1-3 as one jumbled section, with no attempt to distinguish its arguments. *See* Pet., 60-106. Samsung leaves it to the Board and Netlist to puzzle out the differences between the challenges, including why Samsung added the additional references in Grounds 2 and 3. This strategy is not new: Samsung has a longstanding practice of inappropriately shifting invalidity theories midstream. *See, e.g.*, EX1049, 45-68 (discussing the numerous new arguments made by Samsung in its Reply in its challenge of the ’608 patent). The Director should deny the Petition for its lack of clarity and failure to provide the required notice of the specific challenges of unpatentability.

Next, the Petition often presents conclusory statements with little to no explanation on how the cited evidence supports the assertion. For example, as explained above with respect to claim 4, the Petition alleges that Osanai teaches a DLL circuit that generates a local clock signal having the required “programmable” phase relationship but fails to explain how any of the cited

portions of Osanai purportedly satisfy the claimed feature. Pet., 86-87. As another example, in its challenge of claim 9, the Petition again makes a conclusory assertion—citing only expert testimony as support—that the Data Register Control Circuit 320 implements the DLL circuit 310 to avoid a potential metastability by adjusting the phase of the internal clock signal used to capture the DRC signal.⁷ Pet., 98.

The Director should reject these arguments because they are insufficient to satisfy Petitioner’s burden of persuasion. *See* 37 C.F.R. § 42.104(b)(4) (a petition “must specify where each element of the claim is found in the prior art patents or printed publications relied upon.”). Such cursory and conclusory analysis falls well short of Petitioner’s obligation to perform reasoned analysis—based on the references asserted in its challenges and run afoul of the Office guidance that compliance with Rule 104(b)(4) precludes reliance on expert testimony for claim limitations. EX2057. Because this deficiency is replete throughout the entire Petition, the Director should deny institution.

E. *Chevron and Deeper* favor denying institution.

The merits consideration phase includes determining whether the petition

⁷ Despite these deficiencies in Samsung’s analysis, as noted above, Netlist disclaimed claim 9 to streamline the Director’s review.

presents a sufficient number of grounds/challenges that meet the reasonable likelihood standard. Interim Process, § I.F. When “a petition meets the standards for institution in relation to fewer than all the challenges presented, or where deficiencies in the petition ... affect only a portion of the challenges presented, the [Board] will evaluate all the challenges and determine whether, in the interests of efficient administration of the Office and integrity of the patent system, the entire petition should be denied.” Trial Practice Guide, § II.D.3 (citing 35 U.S.C. §§ 316(b), 326(b); *accord Chevron Oronite Co., LLC v. Infineum USA L.P.*, IPR2018-00923, Paper 9 (PTAB Nov. 7, 2018) (informative); *Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7 (PTAB Jan. 24, 2019) (informative)).

As discussed throughout this Preliminary Response, the Petition suffers from numerous fatal deficiencies. Given these defects, institution of review should be denied even if some of the claims or grounds meet the standard for institution (which they do not). It would not be an efficient use of the Board’s valuable time and resources to institute review when resolution of this proceeding would be costly and time-consuming to address challenges that are flawed from the outset. *See* Interim Processes Memo, 3; 35 U.S.C. § 316(b).

IV. CONCLUSION

Because the Petition suffers fatal procedural and substantive defects, the Director should deny institution.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/Richard M. Bemben/

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

Date: January 29, 2026

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

CERTIFICATE OF WORD COUNT (37 C.F.R. § 42.24(d))

1. This Patent Owner Preliminary Response complies with the type-volume limitation of 14,000 words, comprising 6,024 words, excluding the parts exempted by 37 C.F.R. § 42.24(a)(1).

2. This Patent Owner Preliminary Response complies with the general format requirements of 37 C.F.R. § 42.6(a) and has been prepared using Microsoft® Word in 14-point Times New Roman font.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/Richard M. Bemben/

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

Date: January 29, 2026

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 PRELIMINARY RESPONSE UNDER 37 C.F.R. § 42.107(a)** and associated Exhibits 2055-2058 were served in their entireties on January 29, 2026, upon the following parties via electronic mail:

Eliot D. Williams (Lead Counsel)
Theodore W. Chandler (Back-up Counsel)
Ferenc Pazmandi (Back-up Counsel)
Mark A. Speegle (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: January 29, 2026

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