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To:	Director_PTABDecision_Review
Cc:	Trials; DL Samsung Netlist IPRs; Winston-IPR-Netlist@winston.com; #NetlistIPR [Int]; ~Heim, Michael; Chris Limbacher
Subject:	IPR2023-00454 Patent Owner"s Request for Director Review
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Attachments:	IPR2023-00454 PO"s Request for Director Review.pdf

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Dear Director Vidal,

Pursuant to the Revised Interim Director Review Process, Patent Owner Netlist, Inc. respectfully notifies the parties and the USPTO of its filing of the attached Request for Director Review (Paper 46, "Request") of the Final Written Decision by the Board (Paper 45) in IPR2023-00454, in which the Board wrongly determined that claims 1-15 of U.S. Patent No. 11,093,417 are unpatentable as obvious over the disclosures of at least three references. These references included one (JESD21-C) that Petitioners did not include in any proposed ground. The Board expressly relied on JESD21-C to satisfy claim limitations despite Petitioners having argued that they cited that reference solely to demonstrate a motivation to combine the other two references with each other.

The Request presents the following issue for which Patent Owner seeks review:

> Whether the Board relied on an erroneous conclusion of law in determining that the challenged claims are unpatentable by expressly finding claim limitations satisfied by a reference that the Petition did not include in any proposed ground and that Petitioners disclaimed in connection with teaching those limitations, in conflict with at least Supreme Court precedent that "petitioner's contentions, not the Director's discretion, define the scope of the litigation all the way from institution through to conclusion," *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1357 (2018), as well as Federal Circuit precedent that the Board lacks "authority … to raise, address, and decide unpatentability theories never presented by the petitioner." *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016).

This error implicates important issues of law and policy regarding the Board's authority to deviate from grounds actually proposed and arguments actually made in petitions and throughout *inter partes* review proceedings. Director Review provides an opportunity to clarify the importance to adhering to those grounds and arguments and not crafting new grounds inconsistent with the Petition and Petitioners' arguments. These and other issues highlighted in the Request warrant the Director's intervention.

Patent Owner Netlist, Inc. is concurrently filing a Request for Director Review in IPR2023-00455 (Paper 46), which raises the same substantive issue.

Respectfully submitted,

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