

From: [Trials](#)
To: [Williams, Eliot D.](#); [Trials](#)
Cc: [Zhong, Annita](#); [Lindsay, Jonathan](#); [Sheasby, Jason](#); [#NetlistIPR \[Int\]](#); [Chandler, Ted](#); [DL Samsung Netlist IPRs](#)
Subject: RE: Request for Preliminary Reply IPR2023-00454 & -00455
Date: Thursday, June 8, 2023 2:48:57 PM

Counsel,

From the Board –

In each proceeding, Petitioner may file by June 16, 2023, a four-page reply limited to addressing issues 1 and 4. Patent Owner may respond by June 26, 2023, with a four-page sur-reply.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Williams, Eliot D. <Eliot.Williams@BakerBotts.com>
Sent: Thursday, June 8, 2023 9:07 AM
To: Trials <Trials@USPTO.GOV>
Cc: Zhong, Annita <HZhong@irell.com>; Lindsay, Jonathan <jlindsay@irell.com>; Sheasby, Jason <JSheasby@irell.com>; #NetlistIPR [Int] <NetlistIPR@irell.com>; Chandler, Ted <ted.chandler@bakerbotts.com>; DL Samsung Netlist IPRs <dlamsungnetlistiprs@BakerBotts.com>
Subject: Request for Preliminary Reply IPR2023-00454 & -00455

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Dear Board:

Petitioner in the above-referenced IPRs requests a teleconference to seek authorization to file limited pre-institution Replies to the Patent Owner's Preliminary Responses (POPRs). Patent Owner has indicated they do not object to part of this request, but object to some of this request, and in any event would request a sur-reply of equal length if Petitioner's request is granted. The parties are available at the following times for a teleconference to discuss:

Thu 6/8: 12pm ET-3:30pm ET,
Fri 6/9: 12pm ET-1pm ET, after 2pm ET
Mon 6/12: 3-4 p.m. ET
Tue 6/13: 3-4 p.m. ET

A summary of the request is set forth below.

IPR2023-00454 (417 patent) and -00455 (215 patent)

The two POPRs filed in these two IPRs are similar, so any reply by Petitioner would also be similar in both IPRs.

In each IPR, Petitioner requests a reply of up to 8 pages due 8 business days after Board authorization to address the following issues:

1. Discretionary denial under *Fintiv* (454 POPR 62–65, 455 POPR 53–56)
2. Patent Owner’s claim construction for “rank” (454 POPR 6; 455 POPR 6–11)
3. Whether, as a matter of statutory interpretation of 35 U.S.C. § 311(b), a published patent application like Ellsberry is a “printed publication” as of its filing date as the Board found in the institution decision for 2022-00615 (454 POPR 46–48; 455 POPR 34–36)
4. Discretionary denial under § 325(d) (454 POPR 59–62; 455 POPR 49–53), including whether under the proper claim construction for “rank” the Examiner erred under Part 2 of *Advanced Bionics* with respect to whether specific limitations are obvious in light of:
 1. Perego (454 POPR 13–25, 33–46; 455 POPR 19–33)
 2. JESD79-2 (454 POPR 25–33; 455 POPR 15, 44)
 3. Ellsberry (454 POPR 48–54; 455 POPR 36–44)
 4. Halbert (454 POPR 55–59; 455 POPR 45–49)

Good cause exists for a reply in each IPR on the issues above in light of the lengthy, unexpected, and incomplete arguments made by Patent Owner in its POPRs on the issues above. The short replies proposed above would enable the Board to identify and resolve the disputed issues more quickly and efficiently than if required to sort through all of Patent Owner’s papers and exhibits without hearing from Petitioner on those issues.

As for #2 (claim construction for “rank”), good cause exists for a reply in IPR2023-00454 because the claim term and prior art are the same in both IPRs, and thus the claim construction positions should be the same in both IPRs.

Patent Owner’s position:

Netlist does not oppose a reply that addresses #1 and #3 below for a total of 4 pages. As to # 2, for IPR2023-00454, the POPR spent less than 4 lines on claim construction: it merely voiced its disagreement with a specific portion of Samsung’s proposed construction and noted “the arguments made herein are independent of that dispute.” POPR 6. As a result, there is no good cause for Samsung to seek to address #2 and #4. As to IPR2023-00455, while Netlist has explained the dispute in more detail, the arguments in the POPR are independent of the dispute. There is therefore also no good cause for Samsung to seek to address #2 and #4.

Netlist also requests that if the Board grants a pre-institution reply, Netlist should be granted a sur-reply of equal lengths.

Respectfully,

Eliot D. Williams

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