

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

NETLIST, INC.,
Patent Owner.

Case No. IPR2023-00847
Patent No. 10,268,608

PATENT OWNER PRE-INSTITUTION SUR-REPLY

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Petitioner contends that “Part 1 of *Advanced Bionics* favor Petitioner, because Petitioner does not present the same *anticipation* argument rejected in IPR2022-00237, but instead presents ‘the same or substantially the same prior art or arguments’ that were *accepted* by the Board in IPR2022-00236 and -00711” Paper 9 (“Reply”), 2 (internal citation omitted) (original emphasis included). That argument is unsupported by the record because those other proceedings did not involve substantially the same issues. But, in any event, Petitioner’s argument tries to turn § 325(d) on its head. § 325(d) is a tool to conserve Board resources and prevent patent owner harassment, not a mechanism for a petitioner to piggyback off of other proceedings involving different patents.

For Ground 1, Samsung presents essentially four arguments. *First*, as argued in the POPR, Samsung’s inclusion of Butt in Ground 1 creates the appearance of a different ground than in Micron -0237, but does not change the substance of the challenge because none of Butt’s teachings are relied on to satisfy an actual claim limitation. POPR, 5-11. This is confirmed by the fact that **Samsung’s reply (like the Petition) does not (and cannot) point to a single claim element that is satisfied by Butt’s teachings.** Claim 10 is no different as the Petition does not even mention Butt for claim 10, let alone rely on it. Pet., 67-71. In any event, claim 10 has been disclaimed and therefore is to be treated as if it “never existed in the patent.” *Guinn v. Kopf*, 96 F.3d 1419, 1422 (Fed. Cir. 1996).

Second, Samsung attempts to distance itself from IPR2022-00237 (“Micron -0237”) by misdirecting the Board’s attention instead to IPR2022-00236 (“Micron -0236”). But while Micron -0237 also involved the ’608 patent, Micron -0236 involved a parent patent (the ’035) with materially different claims. Notably, the claims in Micron -0236 do not include a “delay circuit” of any kind, least of all one which “delay[s] a signal through the data path by an amount determined by the command processing circuit in response to at least one of the module control signals.” The significance of this distinction cannot be overstated because it was those “delay circuit” limitations which formed the basis for the Board’s decision to deny institution. EX2006, (“The claim requires the *data path* include the delay circuit. Based on our review of Petitioner’s contentions it appears Petitioner does not demonstrate this to be the case.”) (original emphasis included); POPR, 4. Thus, because Butt is not relied on for disclosing a delay circuit, or a data path that includes a delay circuit (or any other limitation), the challenge here is substantially the same as what the Board considered and rejected in Micron -0237. Moreover, that institution occurred in Micron -0236 actually reinforces the fact that the claims here, which include the “delay circuit” and related delay limitations, are in fact patentably distinct from the claims in Micron -0236, which did not include those limitations.

Even if the Board were to consider the reasoning applied in Micron -0236, which again pertains to materially different claims, the result should still be denial

under §325(d). This is because the Board in Micron -0236 relied on Micron’s argument that Osanai’s “input buffers (INB) act as a gate allowing data and strobe signals to either pass through or not pass through” in finding “that these disclosures of Osanai are sufficient to teach controlling the timing of the data and strobe signals on the data paths on which those signals travel.” EX1066, 36. But unlike the ’035 patent at issue in Micron -0236, the claims here also distinctly recite “a tristate buffer,” which Samsung has alleged is satisfied by those same INB and OUTB buffers from Hiraishi. *See* Pet., 42 (“Hiraishi discloses that the ‘data register control circuit 320’ controls several tristate buffers in the data path, including, e.g., buffers OUTB and INB shown in Figure 5, thus teaching that these buffers are ‘controlled by the command processing circuit’”); *see also id.*, 39. Because Samsung is already relying on Hiraishi’s INB and OUTB buffers to satisfy the distinctly-recited “tristate buffer” limitation, it cannot (and does not) rely on those buffers as being the “delay circuit” that performs the signal delay in the claimed manner.

Third, Samsung’s reply confirms that it is attempting to use the Board’s decision in Micron -0237 as a road map by contending that the deficiencies identified by the Board in its rehearing denial are allegedly being addressed here. Reply, 4. But preventing such abuse of process is one of main reasons for the Board to use its discretionary authority. In any event, it is of no import under § 325(d) if the arguments in Micron -0237 were different because § 325(d) applies where the same

or substantially the same art or arguments have previously been considered. And here, the Office has already considered the same prior art, as detailed in the POPR.

Fourth, Samsung suggests for the first time that there was Examiner error under Part 2 of *Advanced Bionics* based on the reasoning that the record allegedly was not well developed. Reply, 4. That, however, is contrary to the record. For example, Micron -0237 forms part of the record previously considered by the Office and clearly shows a thorough and careful consideration of the same or substantially the same prior art and arguments, culminating in a detailed 20-page institution decision. Moreover, the '608 patent is part of a family of patents, each of which was examined by the same examiner who issued prior art rejections in related applications, as Samsung's own expert acknowledges. EX1003, ¶¶ 46, 59. Thus, in addition to the Board's consideration of substantially the same prior art and arguments in Micron -0237, Samsung has not shown the Examiner erred by allowing the claims "without any substantive rejection" because the examiner did in fact issue substantive rejections in related applications.

For Ground 2, Samsung argues that "in IPR2022-00237 the Board never considered Tokuhiro" essentially because Micron's arguments about what was disclosed were different. Paper 9, 1-2. But that alone is insufficient to overcome § 325(d) which requires either the same prior art or arguments be satisfied, not both.

Dated: October 5, 2023

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

I hereby certify that this Patent Owner's Pre-Institution Sur-Reply complies with the page limit provided by the Board in Exhibit 3001 (Sept. 25, 2023), which stated: "The reply shall not exceed 4 pages and is limited to addressing Patent Owner's arguments in the Preliminary Response concerning discretionary denial under § 325(d). The sur-reply shall not exceed 4 pages and is limited to responding to Petitioner's arguments in the reply. The reply is due 7 business days from the date of this grant, with the sur-reply due 7 business days after the filing of the reply."

/s/ Jonathan Lindsay
Jonathan M. Lindsay

CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. section 42.6, that on October 5, 2023, a complete copy of the foregoing document **PATENT OWNER'S PRE-INSTITUTION SUR-REPLY** was served by electronic mail, as agreed to by the parties, upon the following:

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