

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’S MOTION TO STRIKE

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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EXHIBIT LIST

Exhibit No.	Document
EX2001	Statutory Disclaimer for 15/820,076
EX2002	Power of Attorney and Filing Receipt for 15/820,076
EX2003	IPR2022-00237 IPR Petition
EX2004	U.S. Publication No. 2010/0312925 (Osanai)
EX2005	IPR2022-00711 Record of Oral Hearing
EX2006	IPR2022-00237 DECISION Denying Institution of IPR
EX2007	IPR2022-0711 IPR Petition
EX2008	U.S. Patent No. 8,713,379 (Takeman)
EX2009	IPR2022-00237 Petitioner's Request for Rehearing
EX2010	IPR2022-00237 DECISION Denying Petitioner's Request for Rehearing
EX2011	IPR2022-00237 Declaration of Donald Alpert, Ph.D.
EX2012	Deposition Transcript of Robert Wedig
EX2013	Declaration of Dr. William Mangione-Smith
EX2014	JEDEC STANDARD, DDR2 SDRAM SPECIFICATION (JESD79-2F) (November 2009)
EX2015	JEDEC STANDARD, DDR3 SDRAM Standard (JESD79-3F) (Revision of JESD79-3E, July 2010) (July 2012)
EX2016	Deposition of Robert Wedig in IPR2022-00711 (506 IPR)
EX2017	Electronics Cooling, Challenges In Thermal Management Of Memory Modules
EX2018	JEDEC STANDARD, Double Data Rate (DDR) SDRAM Specification (JES79) (June 2000)
EX2019	JEDEC STANDARD, DDR3 SDRAM Specification (JESD79-3A) (Revision of JESD79-3) (September 2007)

EX2020	Petition for Inter Partes Review of U.S. Patent No. 10,860,506 (IPR2022-00711)
EX2021	Final Written Decision (IPR2022-00711)
EX2022	DECISION Denying Patent Owner's Request on Rehearing of Final Written Decision (IPR2022-00711)
EX2023	Final Written Decision (IPR2022-00236)

Pursuant to the Board's order dated July 1, 2024 (EX3002), Patent Owner hereby moves to strike the blocks of text from the figures appearing on the following pages of the Reply: **Pages 5, 10, 22, 27 (top figure), 28 (bottom figure), 30 (top figure), 39, 40, 42.** To the extent it is not feasible to strike the text itself, then the entire figures should be struck.

I. ARGUMENT

37 C.F.R. § 42.24(c)(1) limits replies to patent owner responses to 5,600 words. The rule is clear that this limit applies to the entire reply brief except for “a table of contents; a table of authorities; a listing of facts that are admitted, denied, or cannot be admitted or denied; a certificate of service or word count; or an appendix of exhibits.” *Id.* Thus, the rule does not exclude any text in the body of the brief from the word count. Indeed, the Board has cautioned that though “a party need not go beyond the routine word count supplied by their word processing program...parties should be careful not to abuse the process. *Excessive words in figures, drawings or images*... in order to circumvent the rules on word count, may lead to dismissal of a party's brief.” *Roland Corp. v. Inmusic Brands Inc.*, IPR2018-00332, Paper 12 at 16-17 (PTAB July 2, 2018) (citing *Pi-Net Int'l, Inc. v. JPMorgan Chase & Co.*, 600 Fed. App'x. 774 (Fed. Cir. 2015) (per curiam); *see also Patent Trial and Appeal Board Consolidated Trial Practice Guide*, November 2019 at 40 (same); *Google, Inc., v. Ji-Lee*, Case No. IPR2016-00022, Paper 25 (PTAB Nov. 23, 2016)

(expunging Reply Brief for exceeding word count where briefs “include numerous block quotations of textual material from the record that were inserted into the Reply Briefs as images rather than text, and that were not included in the word count certifications submitted”). Petitioner’s Reply does exactly this, and the text exceeding the word count should be stricken. Below is a representative example of an objectionable annotation in the Reply (Paper 23 at 22):

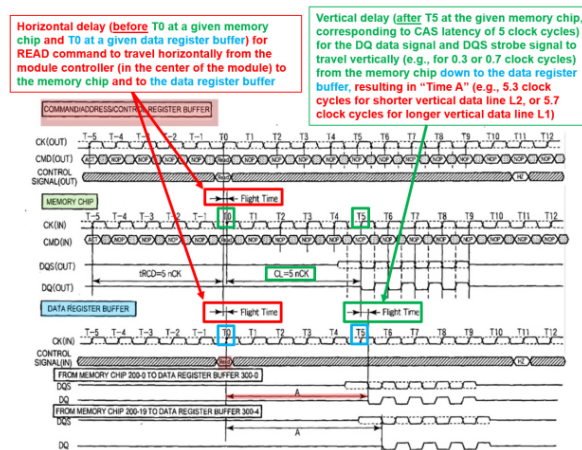


FIG.15

Pet. 75 (annotated with admissions by Netlist's expert, EX1074, 218:8-224:4);⁵ *see*

The Certificate of Compliance submitted with Petitioner's Reply states that it contains 5,596 words. Paper 23 at 49. However, including the block text in the identified figures brings the total to about 6,453 words, 853 words over the limit (not including labels).

Annotations and limited text added to figures may be permissible when “helpful to the reader,” as in *Gen. Elec. Co. v. Pratt & Whitney Canada Corp.*, IPR2020-00083, Paper 11, at 5-6 (PTAB Apr. 20, 2020). Netlist thus does not object

to every instance where annotations were added to the figures, such as the figures on pages 2, 26, 27 (bottom), 28 (top), 30 (bottom), 32, 41, 43, 45. But as the Board previously observed, “blocks of text pasted in as an image must be included in the word count” and “that *words* present in, or, at a minimum, ***added to, Figures that are pasted in as images should also be included in the word count.***” *Artic Cat, Inc. v. Polaris Indus. Inc.*, IPR2017-00433, Paper 15 at 2-4 (PTAB June 22, 2017).¹

Here, Petitioner’s use of blocks of text embedded in the identified figures is even more offensive than instances where the Board found violation of the rule on word count. In *Comcast Cable Comms. LLC v. Rovi Guides, Inc.*, the annotations caused the brief to exceed the word count by only 286 words, and the Board ordered the Petitioner to conform their brief to the word limit by removing content. IPR2019-01413, Paper 10 at 2-3 (PTAB Dec. 17, 2019). Here, the significant amount of words (and arguments) included in the Reply figures (which would have been counted by a word processor had they not been added in image form) are clearly argumentative text that should have been included in the text, as demonstrated by the example provided above.

¹ Due to the impending sur-reply deadline, ordering Petitioner to submit a revised brief as in *Artic Cat* is not viable. The fair and just remedy is simply ordering Petitioner to redact the offending text, as in *Comcast*.

Petitioner attempts to justify its transgression by stating that the blocks of text in the figures simply mirror language already in the brief. That argument is unavailing. The words in the figures are framed differently and enable Petitioner to make additional arguments and elaborations using color coding and symbols like arrows, and then referring to those arguments and elaborations in the text of the brief with only the latter contributing to the word count. *See e.g.*, Reply, 10 (briefly stating that “Netlist has argued that the DQ/DQS signals must remain aligned with each other,” and then including the actual relied-on statements in a figure below); 38-39 (arguing that fly-by topology “result[ed] in a skew of the data that needed to be corrected with read/write leveling, as illustrated below,” followed by a figure which contains an additional 217 words of descriptive text). And if the extra text truly mirrors that already in the body of the text, then Petitioner would suffer no inconvenience or prejudice by removing it. Nor does the fact that the text was present in deposition exhibits created by Petitioner justify their exclusion from the word count: if word limits cannot be evaded by improper incorporation by reference of the exhibits, pasting the text from the exhibits as images does not make it proper.

Patent Owner is prejudiced by the block text in the above-identified figures. The figures include block quote/text alleged to support Petitioner’s arguments, and in some cases include the argument itself (e.g., p. 22), all of which Patent Owner would be charged with responding to in the limited space allotted for sur-replies.

Moreover, this is not the first time this same Petitioner (and counsel) has attempted to evade the word limit in IPR proceedings. The panel in IPR2022-00615, -00639, and -00711 noted “the presence of gamesmanship” in its petitions in those cases, noting further that the “failure to comply with an applicable rule or order in a proceeding is *grounds for sanctions*.” Paper 6, at 3. Petitioner and its counsel did not take those warnings seriously.

As such, the Board should strike the text from the above-identified figures, or if that is not feasible, the entire figures, to prevent Petitioner from engaging in its continued gamesmanship and disregard of the rules. Such tactics undermine the Board’s regulations and prejudice opposing parties who lack the ability to fully respond to the arguments and alleged support covertly included in this manner.

II. CONCLUSION

The Board should strike the block text identified above, or alternative the figures themselves, for violation of the word limit in 37 C.F.R. § 42.24(c)(1).

Dated: July 10, 2024

Respectfully submitted,

By: /Jonathan M. Lindsay/

Case No. IPR2023-00847

Patent No. 10,268,608

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CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. sections 42.6, that on July 10, 2024, a complete copy of **PATENT OWNER'S MOTION TO STRIKE** was served upon the following, by ELECTRONIC MAIL:

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