

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 SUBMIT SUPPLEMENTAL
INFORMATION PURSUANT TO 37 C.F.R. §42.123(b)**

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Netlist moves to submit the attached deposition testimony and one-page deposition exhibit as supplemental information under 37 C.F.R. §42.123(b).

I. Nature of Supplemental Information Sought to be Submitted

The supplemental information consists of testimony given by Samsung's district court expert for the '608 patent, Mr. Joseph McAlexander on July 19, 2024 in the parallel litigation between Netlist and Samsung in which the '608 patent is at issue. *See* Attachment A, 1. Mr. McAlexander is Samsung's infringement and validity expert for the '608 patent and submitted reports on these topics. *See id.*, Attachment A, 2 (8:16-24). He was deposed in connection with his expert reports, and his testimony is reflected, in part, in the attached excerpt and deposition exhibit.

The testimony and exhibit are not hearsay under Rule 801(d)(2)(B)-(D). First, Mr. McAlexander's statements are offered against Samsung, the petitioner in this proceeding. Second, by retaining Mr. McAlexander as its expert and having him submit expert reports on issues relating to infringement and validity in the district court, and by relying on his opinions to support its interpretation of the claims of the '608 patent, including relying on his testimony at trial next month, Samsung has manifested its adoption of Mr. McAlexander's statements. Fed. R. Evid. 801(d)(2)(B). Samsung authorized Mr. McAlexander to make the statements that he made during his deposition in connection with Samsung's invalidity and non-infringement arguments. Fed. R. Evid. 801(d)(2)(C). Mr. McAlexander's testimony

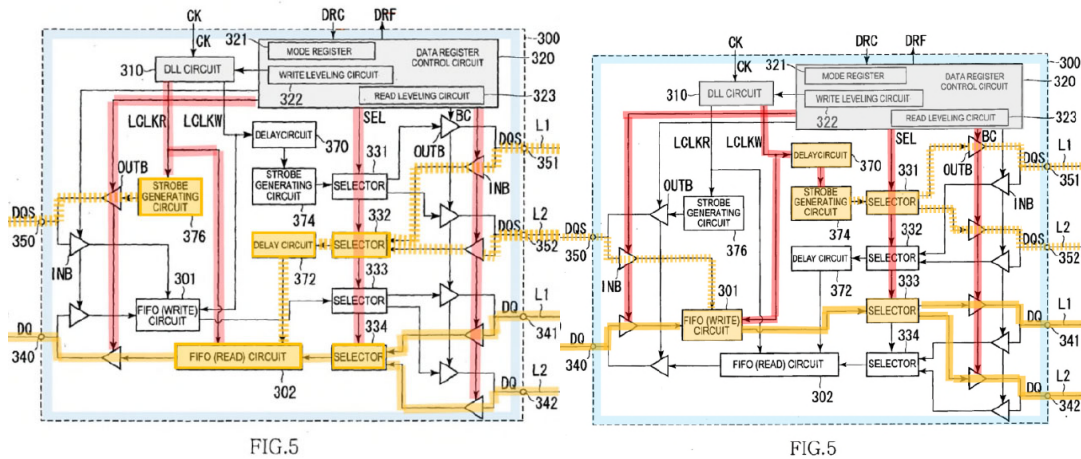
was made by on a matter (*i.e.*, his understanding of the '608 patent's "data path") within the scope of his engagement as Samsung's technical expert for the '608 patent, and while that relationship lasted. Fed. R. Evid. 801(d)(2)(D).

Furthermore, the testimony was given without objections by Samsung. *See generally*, Attachment A. As such, the testimony became binding on Samsung. *Fox v. Taylor Diving & Salvage Co.*, 694 F.2d 1349, 1355-56 (where a party allowed its expert to testify without objection in a prior trial, the trial testimony became binding on the party); *see also Abstrax, Inc. v. Dell, Inc.*, Civ. No. 2:07-cv-221-DF, 2009 WL 10677355 (E.D. Tex., Oct. 9, 2009)(in response to Dell's motion to exclude its own expert from a prior litigation, the court ruled those testimony "are admissions" and "are (1) statements of which Dell has manifested an adoption or belief in their truth; (2) statements by a person authorized by the party to make a statement concerning the subject; or (3) statements by the party's agent concerning a matter within the scope of the agency or employment" under FRE 801(d)(2)(B)-(D)).

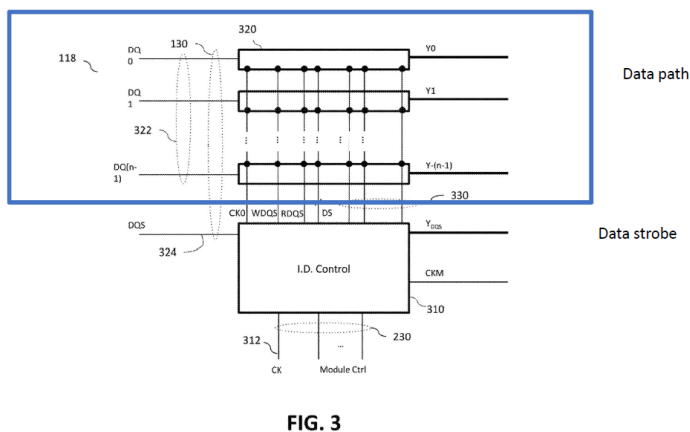
II. Relevance of the Supplemental Information

The '608 patent recites that each data buffer includes "a data path corresponding to each data signal line in the respective set of data/strobe signal lines." *See e.g.*, EX1001, Cl. 1. Samsung has made clear its position that the claimed "data path" encompasses both data signal lines and strobe signal lines. *See Reply*, 4-12. The Petition's unpatentability theory is based on this incorrect claim

interpretation. *See* Pet., 40-41 (annotating FIG. 5 of Hiraishi “showing data paths, orange, for read and write operations,” which includes both strobe signal lines (DQS) and data signal lines (DQ)); EX1002, page 98 (§142) (below); EX2012 (Wedig), 40:11-16, 40:21-41:1.



Mr. McAlexander’s testimony contradicts that claim interpretation, confirming instead Netlist’s position that the “data path” of the ’608 patent does **not** include the strobe signal line. *See* POR, § VI.A; Sur-Reply, § I.



1 Q. Okay. Give me one second. Just,
2 I'm not good with this. I'm just trying to --
3 A. You're pretty good.
4 Q. Have I accurately described the data
5 path in the '608 patent based on what you just
6 testified in the document I'm showing you?
7 A. Yes, sir.
8 Q. So I'll mark this as Exhibit
9 Tab 101.
10 (Exhibit 101 was marked.)

Attachment A, 5-6. Specifically, Mr. McAlexander testified with respect to FIG. 3 of the ’608 patent that “[t]he data path is shown as Y0, Y1 through 320, going to

DQ0, DQ1, and up through Y minus, N minus 1, to DQ, N minus 1.” *Id.*, 4 (92:11-13). Mr. McAlexander then testified that in Figure 3, “the top three circuits that are shown ... is [sic] your path of data” and the strobe is “down in the I.D. control blocks.” *Id.*, 4 (92:15-25). The questioning attorney then annotated FIG. 3 in the above manner by adding the blue box and labeling it as “Data path” and adding the label “Data strobe” next to the YDQS line provided to the ID Control block 310 which goes to the DQS signal line 324; Mr. McAlexander then confirmed that the annotation in the exhibit was accurate. *Id.*, 5 (93:1-9). Thus, testimony by Samsung’s technical expert for the ’608 patent discredits Samsung’s IPR position that the claimed “data path” can be satisfied by Hiraishi’s various strobe signal lines. Moreover, Samsung itself has submitted and relied on over 20 exhibits from parallel district court proceedings and earlier IPR proceeds, and so it cannot claim that information from other proceedings is irrelevant. *See, e.g.*, EX1012-EX1015, EX1035-EX1045, EX1047-EX1051, EX1053-EX1057.

III. The Supplemental Information Could Not Be Obtained Earlier

Mr. McAlexander’s deposition did not occur until July 19, 2024. The final transcript and importantly Exhibit 101, were not available until July 26, 2024. Moreover, the transcript was designated as confidential and the excerpt at issue was de-designated only on August 9 after Netlist’s repeated prodding. Therefore, the testimony could not have been obtained earlier, but once the testimony was given,

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Netlist acted diligently in expediently raising this issue with the Board. To the extent Samsung argues that Mr. McAlexander could have been deposed earlier, that presupposes that Netlist could have known that Mr. McAlexander would give inconsistent testimony. In any event, Mr. McAlexander became unavailable on the originally agreed-to deposition date, February 16. The dates that Samsung subsequently offered conflicted with the questioning attorney's pre-existing obligations (3 jury trials since March, and numerous scheduled court hearings). Thus, the evidence could not have reasonably been provided earlier.

IV. Admission of the Supplemental Information is in Interest-of-Justice

Evidence that a party has taken inconsistent positions on the same issue in an IPR proceeding and in related district court litigation is relevant to the Board's determination and should be considered in the interests-of-justice. *See, e.g., Kingston Tech. Co., Inc. v. Spex Techs., Inc.*, No. IPR2017-01021, Paper 31, at 2, 4-5 (PTAB May 29, 2018). Here, the supplemental information is sworn testimony from Samsung's own district court expert for the same patent on a case dispositive issue. Without this evidence, which may be before a jury in next month's trial, the IPR record would be incomplete and could result in Patent Owner's due process rights being severely impaired.

Dated: August 21, 2024

Respectfully submitted,

By: /Jonathan M. Lindsay/

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CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. section 42.6, that on August 21, 2024, a complete copy of the foregoing document **PATENT OWNER'S MOTION TO SUBMIT SUPPLEMENTAL INFORMATION PURSUANT TO 37 C.F.R. §42.123(b) and Attachment A** were served by electronic mail, as agreed to by the parties, upon the following:

BAKER BOTTS L.L.P.

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ATTACHMENT A

UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

NETLIST, INC.,)
Plaintiff,)
vs.) CASE NO. 2:22cv293JRG
SAMSUNG ELECTRONICS CO.,)
LTD.,)
Defendant.)
_____)

CONFIDENTIAL - ATTORNEYS' EYES ONLY

CORRECTED TRANSCRIPT OF
REMOTE VIDEOTAPED DEPOSITION UPON ORAL
EXAMINATION OF JOSEPH McALEXANDER

FRIDAY, JULY 19, 2024

9:08 A.M. (Central Standard Time)

(All participants appeared remotely)

TAKEN AT THE INSTANCE OF THE PLAINTIFF

REPORTED BY:

MONNA J. NICKESON, RPR, CRR, CCR, CSR CA 14430

JOB: 6792757

1 Netlist.

2 MR. DRYER: This is Christopher
3 Dryer on behalf of the Samsung defendants
4 and the witness. And with me today is
5 James Cowan, both from Fish & Richardson.

6 THE VIDEOGRAPHER: Thank you. The
7 court reporter may now swear in the witness
8 and we will proceed.

9
10 JOSEPH McALEXANDER
11 having been first duly sworn to tell the truth, the
12 whole truth, and nothing but the truth,
13 testified as follows:

14 EXAMINATION

15 BY MR. SHEASBY:

16 Q. Good morning, sir. Can you state
17 your full name for the record.

18 A. Joseph Colby McAlexander, III.

19 Q. Sir, you've been retained on behalf
20 of the Samsung defendants; is that correct?

21 A. Yes, that is correct.

22 Q. That's to provide expert opinions in
23 this matter with Netlist; is that correct?

24 A. Yes, that's correct.

25 Q. Did you interview any Samsung

Page 8

1

[REDACTED]

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[REDACTED]

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[REDACTED]

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[REDACTED]

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[REDACTED]

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[REDACTED]

19

[REDACTED]

20

[REDACTED]

21

[REDACTED]

BY MR. SHEASBY:

22

Q. Okay. And you looked at the patent

23

in preparation for your report, correct?

24

A. Yes.

25

Q. And the strobe signal line is part

1 of the data path, correct?

2 MR. DRYER: Objection. Form.

3 THE WITNESS: Well, the strobe
4 signal line is to -- it's part of the read
5 operation. It'll basically signal to the
6 particular buffer that it's located in when
7 it can then time the read.

8 BY MR. SHEASBY:

9 Q. Right. I'm asking, where is the
10 data path on Figure 3?

11 A. The data path is shown as Y0, Y1
12 through 320, going to DQ0, DQ1, and up through
13 Y minus, N minus 1, to DQ, N minus 1.

14 Q. Let me do it this way.

15 A. So if you look at the top three
16 circuits that are shown, from right to left, Y0
17 to DQ, Y1 to DQ1, Y, paren, N minus one, paren,
18 to DQ, paren, N minus one, paren, those three
19 upper blocks is your read path, is your path of
20 data. And down in the I.D. control block you
21 will see a YDQS input to a DQS output. That's
22 the strobe.

23 So you've got the lines at the top
24 are for your data and the strobe is line 324,
25 which is DQS line.

