

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD,

Petitioner.

v.

NETLIST, INC.,
Patent Owner.

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

**PATENT OWNER'S OPPOSITION TO
PETITIONER'S MOTION TO EXCLUDE**

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I. EX2016 is Admissible

Samsung hired Dr. Wedig for this proceeding to opine on the Hiraishi, Butt, Tokuhiro, Ellsberry, and Kim references. *See e.g.*, EX1003, ¶¶89-111. Samsung did this knowing that it had previously hired Dr. Wedig for IPR2022-00711 to opine on those same references in connection with the '506 patent, a direct continuation of the '608 patent. During Dr. Wedig's deposition in IPR2022-00711, Netlist questioned him on his understanding of the operation of Hiraishi, Butt, and Tokuhiro and submitted his prior testimony (EX2016) when his understanding turned out to be inconsistent with the theories advanced by Petitioner in this proceeding.

Petitioner redirected Dr. Wedig after his cross examination in IPR2022-00711 on topics of relevance here, and therefore had the motivation and full opportunity to develop Dr. Wedig's testimony. EX2016, 217:15-222:3. Moreover, Petitioner submitted in this IPR alleged errata to that same deposition testimony. EX1073. In fact, Petitioner itself has submitted in this IPR testimony from IPR2022-00711 given by Dr. Mangione-Smith in the form of both his deposition transcript and declaration, and cited to both in the Petitioner Reply. *See* Reply, 45 (citing EX1075 (Transcript of Deposition of Dr. William Mangione-Smith on May 4, 2023 (Exhibit 1046 in IPR2022-00711))); *see also id.*, 6 (citing EX1076 (Declaration of Dr. William Mangione-Smith on January 31, 2023 (Exhibit 2006 in IPR2022-00711))).

Finally, in his deposition for *this IPR*, Dr. Wedig was asked whether his

opinions about Hiraishi, Butt and Tokuhiko given in the '506 IPR (IPR2022-00711) had changed. EX2012, 14:2-15:2. Dr. Wedig confirmed that his “understanding of those -- of those pieces of art are the same, in that I believe when I understood them last year when we worked on '506, that my understanding of how that art works has not changed. So I have the same -- same understanding of the technology that's being taught by those references as I did when I reviewed – reviewed them for the '506 patent.” *Id.*, 15:5-12. Even more, Dr. Wedig reaffirmed his testimony from IPR2022-00711 regarding the prior art.

Q. “... And do you also stand by your testimony about the prior art references that are in common between the '506 and the '608 IPRs?

THE WITNESS: I thought I answered that, that I still understand those references, and I believe that I have the same understanding of those reference as I did when I worked on the '506 patent.

Id., 16:7-14 (objection omitted).

A. EX2016 is not hearsay

In IPR2022-00711, Netlist asked Dr. Wedig (1) for his understanding of what Hiraishi’s read leveling does (POR, 53), (2) if he had ever seen a reference that didn’t use the memory controller to adjust for fly-by delays seen by the memory controller (POR, 60, 78), (3) whether the memory controller, being on the motherboard, is less space-constrained than the memory module (POR, 76), (4) whether in the

combination of Hiraishi and Tokuhiro, Hiraishi's memory controller has to still adjust the incoming data (POR, 79), (5) whether additional, unstated modifications would be needed to implement the combination of Hiraishi and Tokuhiro (POR, 81), and (6) whether sampling data and clocking out data are different (Sur-Reply, 21). Petitioner appears to agree as to the purpose of Patent Owner's citations to the prior testimony. Reply, 1-2. Thus, when Samsung took positions in this IPR which are contrary to Dr. Wedig's prior testimony, Netlist cited to Dr. Wedig's prior testimony, not for the truth of the matter asserted, but to show Samsung's arguments are inconsistent with its own expert's opinions. Thus, the testimony is not hearsay.

1. The Prior Testimony Comprises a Declarant-Witness's Prior Inconsistent Statements under FRE 801(d)(1).

The prior statements were all made under penalty of perjury in a deposition. Moreover, the prior statements are inconsistent with positions Dr. Wedig takes in his declaration in this proceeding, and therefore are excluded from hearsay under FRE 801(d)(1)(A). For example, in IPR2022-00771 Dr. Wedig testified about Hiraishi's read leveling: "So the read leveling, what it does, it's used in an adjustment of the activation timing from the input buffer circuit INB and the like. That's the purpose of S4 leveling." EX2016 at 59:4-18. But in the declaration he submitted in this proceeding, he testified that "[r]ead leveling determines delays ('Re-Timing') for the read data (DQ) and strobe (DQS) signals received at different

times A” EX1003, ¶162. As another example, in IPR2022-00771 Dr. Wedig testified that he has never seen “any reference that adjusts fly-by delays being received by a memory controller that doesn’t rely on the memory controller.” EX2016, 177:14-19, 171:15-21. However, in the declaration he submitted in this proceeding, Dr. Wedig testified that a “Skilled Artisan would have also understood that *implementing such a fly-by delay compensation in the memory module* would simplify the read leveling in the memory controller of Hiraishi and make the system’s operation more reliable since the large fly-by delays of read data would be removed at an early stage so that the rest of the system does not have to manage such large fly-by delays.” EX1003, ¶250. As a further example, in IPR2022-00771, Dr. Wedig testified that, in the combination of Hiraishi and Tokuhiro, “Hiraishi’s memory controller is still adjusting the incoming data so that it is being captured in the valid data eye.” EX2016, 181:9-15. Yet, in the declaration he submitted in this proceeding, Dr. Wedig testified that “the result of this [Hiraishi-Tokuhiro] combination is that the read data arrives to the memory controller without substantial fly-by delays, thus simplifying the memory controller’s job and circuitry for properly capturing the read data.” EX1003, ¶273.

Moreover, Samsung’s argument that Netlist did not “cross-examin[e] [the witness] about [the] prior statement” is incorrect. Motion at 3. Dr. Wedig was specifically asked about his prior testimony, which he confirmed, stating: “I believe

when I understood them last year when we worked on '506, that my understanding of how that art works has not changed. So I have the same -- same understanding of the technology that's being taught by those references as I did when I reviewed -- reviewed them for the '506 patent." EX2016, 15:5-12; see also 16:7-14 ("I still understand those references, and I believe that I have the same understanding of those reference as I did when I worked on the '506 patent.").

Therefore, the statements are admissible.

2. The Prior Testimony is an Opposing Party Statement under FRE 801(d)(2).

The testimony should also be properly regarded as an opposing party statement under FRE 801(d)(2). First, because Dr. Wedig is Samsung's expert in the IPR2022-00711 where he relied on the same prior art references as here, Dr. Wedig's statements regarding the operation and disclosures of the prior art were made with the authorization of Samsung on the subject matter regarding the specific prior art references. FRE 801(d)(2)(C). As such, EX2016 is not hearsay and therefore is admissible.

Second, Dr. Wedig reaffirmed his prior testimony in this IPR, confirming his understanding to the prior art had not changed from "when I worked on the '506 patent." EX2012, 14:2-15:12, 16:7-14. Samsung did not object to Dr. Wedig's affirmation of his prior testimony. As such, Samsung "manifested that it [had]

adopted [the testimony] or believed [it] to be true,” an independent ground under FRE 801(d)(2)(B) for finding that the testimony is non-hearsay. And once those portions of testimony are admitted, for completeness, it is only fair that the remaining testimony—whether consistent or inconsistent with those adopted positions—be admitted. *See* FRE 106 (“If a party introduces all or part of a writing or recorded statement, an adverse party may require the introduction, at that time, of any other part — or any other writing or recorded statement — that in fairness ought to be considered at the same time.”).

Third, Petitioner did not object to the questions for some of the cited testimony and objected only as to form instead of relevance or scope as to the others. *See* EX2016, 59:4–18 (cited at POR, 53); 123:14-18, 124:6-13 (cited at Sur-Reply, 12); 142:15–24, 143:5–144:2 (cited at POR, 76); 151:2–13, 152:17–23, 174:7–11 (cited at POR, 80-81); 171:15–21, 177:14–19, 181:9–15 (cited at POR, 60, 78, 79; Sur-reply, 20-21); 181:9–15 (cited at POR, 79); 194:18–21 (POR, at 60). In *Fox v. Taylor Diving & Salvage Co.*, 694 F.2d 1349, 1355-56 (5th Cir. 1983), the Court found that where a party allowed its expert to testify without objection in a prior trial, the trial testimony became binding on the party. Here, Petitioner at most objected to the form of the questions, and in many cases, did not object at all. Thus, the testimony should be treated as a party statement. *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)). At the very least, by not objecting or moving to exclude either the prior statements or Dr. Wedig’s confirmation of those prior statements, Samsung “manifested that it adopted [those statement] or believed [them] to be true,” per FRE 801(d)(2)(B)).

Finally, Samsung’s argument that it does not “control” Dr. Wedig is misplaced and does not change the fact that, as detailed above, (i) the statements were made with the authorization of Samsung on the subject matter regarding the specific prior art references (FRE 801(d)(2)(C)), and (ii) Samsung manifested that it adopted or believed the testimony to be true (FRE 801(d)(2)(B)), each of which are independent hearsay exceptions.

B. EX2016 is highly relevant and non-prejudicial

Because the prior art at issue in IPR2022-00711 and in this IPR is the same, Dr. Wedig’s testimony in IPR2022-00711 is *ipso facto* highly relevant to the issues in this proceeding. For example, in his IPR2022-00711 deposition, Netlist asked Dr. Wedig (1) about his understanding of what Hiraishi’s read leveling does (POR, 53),

(2) if he had ever seen a reference that didn't use the memory controller to adjust for fly-by delays seen by the memory controller (POR, 60, 78), (3) whether the memory controller, being on the motherboard, is less space-constrained than the memory module (POR, 76), (4) whether in the combination of Hiraishi and Tokuhiro, Hiraishi's memory controller has to still adjust the incoming data (POR, 79), (5) whether additional, unstated modification would be needed to implement the combination of Hiraishi and Tokuhiro (POR, 81), and (6) whether sampling data and clocking out data are different (Sur-Reply, 21). Because Samsung has taken contrary positions in this proceeding, Dr. Wedig's prior testimony is highly relevant to the Board's assessment of those positions. Moreover, because obviousness must be examined in light of, among other things, "the scope and content of the prior art" and "differences between the prior art and the claims at issue," (*Graham v. John Deer Co. of Kansas City*, 383 U.S. 1, 17 (1966)), Dr. Wedig's testimony that reflects a POSITA's understanding of the same prior art at issue here is therefore highly relevant.

Regarding Samsung's argument that the prior statements are irrelevant because Netlist had a full opportunity to examine the witness in this proceeding, it is non-sequitur. Motion at 6. Dr. Wedig's declaration is his direct testimony and the existence of prior inconsistent statements cannot be shielded by the mere fact that he was made available to be deposed again. *See Ultratec, Inc. v. CaptionCall, LLC*,

872 F.3d 1267, 1269-70, 1273 (2017) (finding that conflicting testimony on cross-examination from a different proceeding involving the same expert and prior art references “would be highly relevant to both the Board's analysis of the specific issues on which he gave inconsistent testimony and to the Board's overall view of his credibility.”); *see also id.*, 1273 (where the Board’s fact finding repeatedly relied on the expert’s opinions, “no reasonable fact finder would refuse to consider evidence of inconsistent sworn testimony. Moreover, any such inconsistencies would likely bear on the overall credibility of the expert.”).

And while Samsung attempts to distinguish or re-characterize Dr. Wedig’s prior testimony (Motion at 4-8), it is the Board that is best suited to evaluate relevance, and it should not be precluded from doing so as Samsung now attempts to do. Nonetheless, responses to Samsung’s arguments are included below for completeness.

1. Exhibit 2016, 104:24–106:4 (Motion, 4-6)

Samsung’s argument about the relevance of these statements is misplaced. As stated in the Sur-Reply, the prior statements support the fact that sampling and clocking out data are two different operations. Sur-Reply at 21; EX2016, 105:10-16 (describing clocking out as sending data out “to the next point”); 104:24-105:17-106:4 (describing sampling as indicating when the data is valid). This is inconsistent with Dr. Wedig’s opinion that a POSA would regard the combination as having a

reasonable expectation of success. EX1003, ¶¶ 261, 275. Moreover, the notion that Dr. Wedig uses the terms “sampling” and “clocking” out data interchangeably is disingenuous. Motion at 6. While he seemingly changed his testimony on re-direct to suggest that clocking out data is a type of sampling, this is evidence of additional inconsistent testimony, not that he uses these terms interchangeably. His direct testimony was unequivocal on this point. *See* EX2016 at 104:24–106:4. And there is no indication in his declaration that he regards the terms as being interchangeable. Compare EX1003, ¶ 224 (discussing sampling) to ¶ 262 (discussing clocking out data from FIFO 302). Moreover, nothing in the prior art suggests the terms can be used interchangeably.

2. Exhibit 2016 at 59:4–18 (Motion, 6-7)

Regarding Dr. Wedig’s clear testimony about the purpose of Hiraishi’s read leveling operation in IPR2022-00711 (i.e., to adjust activation timing of the input buffers), Samsung suggests that his testimony was more than just about the INB because of the inclusion of the phrase “and the like.” Motion at 7. But Dr. Wedig couldn’t say what “and the like” means, just unhelpfully stating that “it does a lot of things.” EX2016, 60:8-9. Importantly, Dr. Wedig further took the position that whatever “and the like” means, “it’s not given in any more detail than that, but that’s within the knowledge of one of ordinary skill.” EX2016, 60:8-61:4. That testimony is inconsistent with Samsung’s suggestion that Hiraishi would be understood to

disclose that its read leveling extends beyond what is explicitly stated, i.e., adjusting the activation timing of the input buffers. Thus, there is nothing “unfair and confusing” about Dr. Wedig’s testimony, as Samsung suggests. In any event, Samsung could have resolved any alleged confusion by asking for clarification on re-direct, which it did not do.

3. Exhibit 2016 at 123:14–18 and 124:6–13 (Motion, 7-8)

Samsung argues that this testimony is irrelevant because the claimed “module control signals” are mapped to “DRC” in Hiraishi, while the testimony relates to the local clock signals provided to Hiraishi’s FIFOs. Motion, 7. As such, Samsung appears to agree that Hiraishi’s FIFO does not operate in response to module control signals, and therefore cannot be the claimed “delay circuit.” POR, 36, 39; Sur-Reply, 9-12. However, to the extent that Samsung attempts to maintain its new Reply argument that the Read FIFO 302 satisfies the claimed “delay circuit” (Reply, 15), then the testimony is directly relevant to showing that is incorrect.

4. Exhibit 2016 at 142:15–:24, 143:5–144:2, 151:2–13, 152:17–23, and 174:7–1 (Motion, 8)

Dr. Wedig’s broad unsupported assertions about additional unstated modification being “nothing significant,” and other unspecified comments, are insufficient to render irrelevant otherwise clear testimony on specific issues. POR, 76 (citing to EX2016 at 142:15–:24, 143:5–144:2); 80-81 (citing to 151:2–13,

152:17–23, and 174:7–1).

5. EX2016 at 171:15–21, 177:14–19, 181:9–15, 194:18–21

Samsung has no argument for why these statements should be excluded under Fed. R. Evid. 403.

C. The evidence should be admitted under 37 C.F.R. § 42.51(b)(1)(iii)

EX2016 should also be admitted in light of the requirements under Rule 42.51(b)(1)(iii) and the duty of candor, which both require a party before the Board to bring to the Board’s attention facts that are inconsistent with the party’s position advanced during the proceeding. Here, as noted above and in the POR, Dr. Wedig’s testimony in several instances is not consistent with what Petitioner argues. As such, Samsung would have had an obligation to present this testimony to the Board and have it made part of the record. The testimony does not become inadmissible when Netlist, instead of Samsung, made the submission. Otherwise, a party could simply hire different experts in different proceedings, and hide their inconsistent testimony from the Board. Such an outcome is not in the interests of justice or consistent with the duty of candor imposed on those practicing before the Board.

D. Exhibit 2016 is not Deficient under 37 C.F.R. § 42.53(f)(5)–(6)

First, there is no requirement to submit errata in an IPR, and 37 C.F.R. § 42.53(f)(5)–(6) does not say otherwise. Boards have held that errata sheets are not part of the “transcript” contemplated in 37 C.F.R. § 42.53(f)(7). IPR2021-00145,

Paper 54, at 3. Moreover, a requirement of submitting errata sheets was considered and expressly rejected. *See* Rules of Practice for Trials Before the Patent Trial and Appeal Board, 77 Fed. Reg. 48612, 48642 (Aug. 14, 2012) (“The Board’s experience with errata sheets is that parties tend to disagree on what is and is not considered an errata sheet. For example, there have been instances where a party has attempted to change a deponent’s answer from “yes” to “no” over the objection of the opponent. Accordingly, *the final rules do not provide for the submission of errata sheets*, however, where a party believes that the submission of an errata sheet is necessary to the proceeding, the party may arrange for a conference call with the Board to discuss the matter.”).

Second, the errata was submitted by Samsung and is part of the record. EX1072. Netlist did not object.

Third, none of the errata affects the cited statements, and Samsung does not suggest otherwise.

II. Conclusion

For the foregoing reasons, the Board should decline to exclude EX2016, including at 59:4–18, 104:24–106:4, 123:14–18, 124:6–13, 142:15–24, 143:5–144:2, 151:2–13, 152:17–23, 171:15–21, 174:7–11, 177:14–19, 181:9–15, and 194:18–21.

Dated: August 23, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. sections 42.6, that on August 23, 2024, a complete copy of **PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO EXCLUDE** was served upon the following, by ELECTRONIC MAIL:

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