

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,

Petitioner,

v.

NETLIST, INC.,

Patent Owner

Case IPR2025-00001

Patent 11,386,024

**PETITIONER'S AUTHORIZED RESPONSE TO
PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW OF
DECISION GRANTING INSTITUTION**

Netlist's Request for Director Review (Paper 19) should be denied:

1. Netlist waived its “waste of Board resources” argument (DR Req. 1–4):

Netlist has waived the argument that institution would be a “waste of Board resources” given the supposedly “voluminous record.” DR Req. 1–4. Tellingly, Netlist never “specifically identif[ies] [what Netlist] believes the Board misapprehended or overlooked,” 37 C.F.R. § 42.71(d), because Netlist never presented this argument to the Board in the first place, which is fatal: “The Director will not consider . . . new arguments not part of the official record.” See <<https://www.uspto.gov/patents/ptab/decisions/director-review-process>> (§ 3.E).

Netlist's argument is also incorrect. First, Netlist fails to identify any “Article III court” that will address these issues (DR Req. 1, 4), because currently there is no parallel district court litigation addressing unpatentability (Pet. 113), which is why Netlist never raised any *Fintiv* arguments. Second, there is no need for “third-party subpoena powers” (DR Req. 4), because both Netlist and Samsung are members of JEDEC and their employees were personally involved in the events in question (EX1046, 1; EX1037, 21), and JEDEC has voluntarily provided Netlist and Samsung with requested information (EX2007; EX1050; EX1092). Third, the public accessibility of the proposal to JEDEC (EX1015, EX1039) is not an issue on which Samsung has submitted “expert testimony” (DR Req. 4), because it is a legal issue based on simple, non-technical fact questions. Fourth,

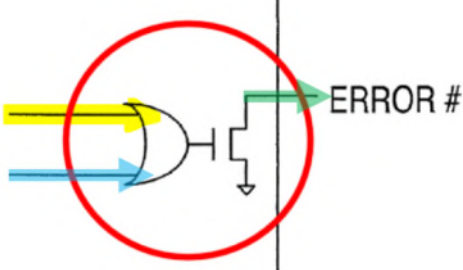
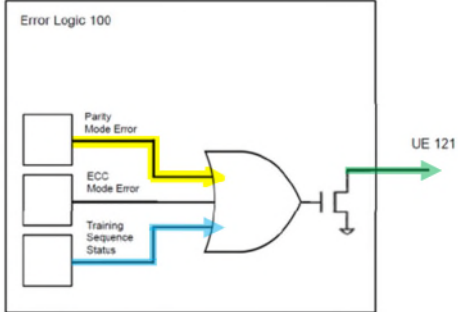
public accessibility is not a complicated issue: Netlist’s provisional patent expressly references the “proposal in JEDEC” (EX1008, 22), and Netlist concedes that the relevant public would have “known” about this proposal (EX1105, 18; EX1003, 145–46), so the Institution Decision directed the parties to focus on narrow issues related to accessibility, such as who could “join JEDEC” (ID 33–34), which is hardly a complicated issue.

Furthermore, the question of whether the JEDEC proposal qualifies as a prior-art “printed publication” is an issue of unique importance to the Board, not a waste of resources. Netlist’s provisional patent application specifically refers to the JEDEC proposal (EX1008, 22), which raises the important question of whether a patent applicant like Netlist can have it both ways, and rely on the JEDEC proposal to show written description in the provisional (EX1105, 14, ¶ 31; *id.*, 17–20, ¶¶ 39–41), while at the same time insisting that the JEDEC proposal is not a prior-art “printed publication” that can be used as a Ground in an IPR because supposedly it “was not publicly available” (DR Req. 3). Resolving that question would not be a “waste of Board resources” as Netlist self-servingly suggests. And it is a question that is likely to come up repeatedly until it is resolved by the Board, given that many patent applicants in this field are a member of JEDEC. *See, e.g.*, EX1074 (listing members of JEDEC, including AMD, Broadcom, Canon, Dell, Ericsson, Google, HP, IBM, Intel, Micron, Microsoft, Motorola, Netlist, NVIDIA,

Panasonic, Qualcomm, Samsung, SanDisk, Seagate, Sony, Texas Instruments, Toshiba, the U.S. Army, and dozens of others).

Finally, Netlist’s argument fails to acknowledge that the **same** issues, factual record, Grounds, and substantially the same expert declaration are presented in both this IPR and the parallel IPR2025-00002, which shares the same panel of judges—two of whom are already familiar with substantially the same record from two recent related IPRs (ID 17)—so there are obvious efficiencies to having the Board decide both IPRs together.

2. The Board correctly rejected Netlist’s argument that “six grounds . . . is a waste of Board resources” (ID 17; DR Req. 4–7): The Board correctly concluded that “instituting a trial is an efficient use of the Board’s time and resources” (ID 17), rejecting Netlist’s argument that a trial on six grounds would be inefficient. Netlist now seeks Director Review on the purported basis of “important policy considerations” (DR Req. 1), but Netlist never identifies any policy considerations and instead simply disagrees with the Board’s decision to institute trial. But the Board did not err in finding that trial will be efficient, because in both this IPR and the parallel IPR2025-00002, all six grounds rely on Hazelzet as the primary reference, and all six grounds challenge all claims using the same structure shown below with an open-drain output (green), which directly corresponds to Figure 3 of the patent, see Pet. 23:

Grounds 1–3 (Pet. 16–17, highlighting added)	Grounds 4–6 (Pet. 109–10, highlighting added)
	

Prelim. Reply (Paper 11) at 1. Two of the three judges on the panel are already familiar with this structure and the relevant record from two related IPRs successfully challenging substantially identical claims. ID 17–22; EX1102, 6–8, 51–53, 66–67, 71–75; EX1103, 6–9, 50–52, 71–73, 78–82.

Netlist is wrong to compare this IPR to *Adaptics* (DR Req. 6), “which involved potentially hundreds of distinct grounds.” *FreeWheel Media, Inc. v. Intent IQ, LLC*, IPR2024-00422, Paper 10, at 18 (PTAB Oct. 2, 2024). Here, all six grounds are simple and straightforward, and all share the same basic structure as shown above. Netlist tacitly concedes this when it admits that the Petition “analyzed grounds 1-3” (corresponding to the structure shown above left) “together under [a] single heading” of the Petition. DR Req. 5 (citing Pet. 43); *see also* Pet. 16–17. Similarly, the Petition analyzed Grounds 4–6 (corresponding to the structure shown above right) under a single heading. Pet. 107–12. Again, that is because all six grounds rely on Hazelzet as the primary reference, and the secondary references are all compatible with the basic structure shown above.

Furthermore, the Board correctly rejected Netlist’s argument that the Petition improperly “incorporated by reference from other documents.” DR Req. 5. As found by the Board when rejecting Netlist’s argument, Petitioner provided “particularity and specificity” and “sufficient explanation and evidence.” ID 24–25. Netlist complains that Petitioner “presented lengthy *claim listings* of related patents before the substance of the Petition (not included in the word count), which the panel relied on.” DR Req. 5 (emphasis added). But the rules specifically provide that “claim listings” are not included in the word count. 37 C.F.R. § 42.24(a)(1). Thus, as found by the Board, it was permissible for the Petition to refer to claim elements by their label (e.g., [1.e.2]). *See* ID 20–21. By analogy, petitions commonly cite to the prior art using citations to column and line numbers, instead of reprinting the entire text of the prior art, and that is not “incorporation by reference” as suggested by Netlist (DR Req. 5). The rules expressly permit “specific *citations* to the portions of the record that support [a] fact,” 37 C.F.R. § 42.22(c) (emphasis added), and only prohibit “[*a*]rguments [from being] incorporated by reference from one document into another document,” 37 C.F.R. § 42.6(a)(3) (emphasis added).

Dated: June 5, 2025

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CERTIFICATE OF COMPLIANCE

I hereby certify that this **Petitioner's Authorized Response to Patent Owner's Request for Director Review of Decision Granting Institution**, excluding the parts of the brief exempted by 37 C.F.R. § 42.24, complies with the page limits provided by the Director's email on May 29, 2025, which stated: "Petitioner is authorized to submit a response limited to the issues raised in the Director Review requests, of no more than five pages, to be filed within five business days of this email. Any such responses must be filed in P-TACTS, i.e., by selecting the 'Other: Other' paper type and the paper must be titled 'Authorized Response to Director Review Request' or it may not be considered. No new evidence is permitted. No further briefings are authorized at this time." EX3100.

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 5th day of June, 2025,

Petitioner's Authorized Response to Patent Owner's Request for Director

Review of Decision Granting Institution was served by email on the following counsel for Patent Owner:

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