

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,

Petitioner,

v.

NETLIST, INC.,

Patent Owner

Case IPR2025-01402

Patent 12,308,087

PETITIONER'S NOTICE RANKING PETITIONS

Petitioner has filed two petitions today — a PGR and an IPR — challenging all claims of U.S. Patent No. 12,308,087. Petitioner ranks the petitions as follows:

<u>Rank</u>	<u>Petition</u>	<u>Asserted Grounds</u>			
		1	2	3	4
1	PGR2025-00071	§ 112 written description All claims	§ 112 indefiniteness Claims 24-28	§ 103 <u>Keeth + Shaeffer</u> All claims	§ 103 Ground 3 + <u>Riho2</u> All claims
2	IPR2025-01402	—	—		

The Board has recognized “that there may be circumstances in which more than one petition may be necessary.” *PTAB Consolidated Trial Practice Guide* at 59 (Nov. 2019). One of the examples provided by the Board is a “dispute about priority.” *Id.* This is such a situation.

As shown in the table above, Grounds 3 and 4 in the two petitions are identical and challenge all claims on the basis of obviousness under § 103. Grounds 1 and 2, however, are only included in the PGR petition because they raise § 112 issues that cannot be raised in an IPR petition and that concern the priority date of the challenged claims and thus whether the patent is eligible for a PGR. *Compare* 35 U.S.C. § 321(b) (“A petitioner in a post-grant review may request to cancel as unpatentable 1 or more claims of a patent on any ground that could be raised under paragraph (2) or (3) of section 282(b) (relating to invalidity of the patent or any claim).”), *with id.* § 311(b) (“A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on

a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.”).

In particular, as discussed in the PGR petition, the challenged patent issued very recently, on May 20, 2025, and facially claims priority to pre-AIA applications filed in 2011 and 2010. But the PGR petition contends that at least one of the claims in the challenged patent lacks written description under § 112 in any application filed before March 16, 2013. If the PGR petition is correct, then the challenged patent is eligible for a PGR because “a patent claiming the benefit of a priority application filed before March 16, 2013 must have written description support in . . . the earlier-filed application to avoid PGR-eligibility.” *CSIRO v. BASF Plant Sci. GmbH*, PGR2020-00033, Paper 11, at 9 (PTAB Sept. 10, 2020).

As shown by the table above, Petitioner ranks the PGR petition first, and the IPR petition second. If the Board institutes the PGR, then in similar situations the Board has denied institution of the IPR. *See, e.g., Samsung Elecs. Co. v. MemoryWeb, LLC*, PGR2022-00034, Paper 11, at 11–16 (PTAB Nov. 17, 2022) (granting institution of PGR); *Samsung Elecs. Co. v. MemoryWeb, LLC*, IPR2022-00885, Paper 11, at 7 (PTAB Nov. 17, 2022) (denying institution of IPR).

But if the PGR petition is wrong — and all of the challenged claims are entitled to priority to a pre-AIA application filed before March 16, 2013, meaning the patent cannot be challenged in a PGR — then the challenged patent may be

challenged by an IPR now, without waiting nine months after the date of the grant of the patent. *See* 37 C.F.R. § 42.102(a)(2). In that situation, Petitioner's IPR petition — ranked second here — would become the only petition for institution.

Dated: August 25, 2025

/Eliot D. Williams/
Eliot D. Williams, Reg. #50,822
BAKER BOTTS L.L.P.
700 K Street, N.W.
Washington, D.C. 20001
T: (202) 639-1334
F: (202) 639-1167

Theodore W. Chandler
Reg. No. 50,319
BAKER BOTTS L.L.P.
1801 Century Park East
Suite 2400
Los Angeles, CA 90067
T: (213) 202-5702
F: (213) 202-5732

Ferenc Pazmandi
Reg. No. 66,216
BAKER BOTTS L.L.P.
101 California Street
Suite 3200
San Francisco, CA 94111
T: (415) 291-6255
F: (415) 291-6355

Mark A. Speegle
Reg. No. 77,512
BAKER BOTTS L.L.P.
401 South First Street, Suite 1300
Austin, Texas 78704
T: (512) 322-2536

F: (512) 322-3636

*Counsel for Petitioner
Samsung Electronics Co., Ltd.*

CERTIFICATE OF COMPLIANCE

I hereby certify that this **Petitioner’s Notice Ranking Petitions**, excluding the parts of the brief exempted by 37 C.F.R. § 42.24, complies with the page limits provided by page 60, note 3, of the Consolidated Trial Practice Guide (Nov. 2019), which states, “A separate paper filed with the petitions . . . shall be no more than 5 pages where the same paper is filed with each petition.”

Dated: August 25, 2025

/Eliot D. Williams/
Eliot D. Williams, Reg. #50,822
BAKER BOTTS L.L.P.
700 K Street, N.W.
Washington, D.C. 20001
T: (202) 639-1334
F: (202) 639-1167

*Counsel for Petitioner Samsung
Electronics Co., Ltd.*

CERTIFICATE OF SERVICE

I hereby certify that on this 25th day of August, 2025, a copy of this
Petitioner's Notice Ranking Petitions has been served in its entirety by FedEx
Express on the following counsel of record for Patent Owner:

Jamie J. Zheng, Ph.D., Esq.
Netlist, Inc.
111 Academy Way, Suite 100
Irvine, CA 92617-3046
(650) 521-4828

Dated: August 25, 2025

/Eliot D. Williams/
Eliot D. Williams, Reg. #50,822
BAKER BOTTS L.L.P.
700 K Street, N.W.
Washington, D.C. 20001
T: (202) 639-1334
F: (202) 639-1167

*Counsel for Petitioner Samsung
Electronics Co., Ltd.*