

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAMSUNG ELECTRONICS CO., LTD.,  
Petitioner

v.

NETLIST, INC.,  
Patent Owner

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Case IPR2025-01402  
U.S. Patent No. 12,308,087

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**PATENT OWNER NETLIST, INC.'S BRIEF ON  
DISCRETIONARY DENIAL**

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Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

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**PATENT OWNER'S EXHIBIT LIST**

| <b>Exhibit No.</b> | <b>Description</b>                                                                                                                                                                                                                            |
|--------------------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 2001               | Joint Development and License Agreement, November 12, 2015                                                                                                                                                                                    |
| 2002               | Stock Purchase Warrant, November 18, 2015                                                                                                                                                                                                     |
| 2003               | Senior Secured Convertible Promissory Note, November 18, 2015                                                                                                                                                                                 |
| 2004               | Security Agreement by and between Netlist, Inc. and SVIC No. 28 New Technology Business Investment L.L.P., November 18, 2025                                                                                                                  |
| 2005               | Samsung Venture Investment Corporation website, available at <a href="https://www.samsungventure.co.kr/english/jsp/company/company.jsp">https://www.samsungventure.co.kr/english/jsp/company/company.jsp</a> (last accessed October 12, 2025) |
| 2006               | Recorded Assignment and IP Security Agreement, Reel No. 037150, Frame No. 0897, November 20, 2015                                                                                                                                             |
| 2007               | Release of Assignment, Reel No. 065629, Frame No. 0330, November 20, 2023                                                                                                                                                                     |
| 2008               | Redacted First Amended Complaint for Breach of Contract and Declaratory Relief, <i>Netlist Inc. v. Samsung Electronics Co., Ltd.</i> , Case No. 8:20-cv-00993-JAK (C.D. Cal.), August 31, 2020                                                |
| 2009               | Judgment, <i>Netlist Inc. v. Samsung Electronics Co., Ltd.</i> , Case No. 8:20-cv-00993-JAK (C.D. Cal.), April 7, 2025                                                                                                                        |
| 2010               | Median time to trial statistics for the International Trade Commission, Docket Navigator report generated October 6, 2025)                                                                                                                    |
| 2011               | Consolidation Order, <i>Netlist Inc. v. Samsung Electronics Co., Ltd.</i> , Case No. 2:25-cv-00557 (E.D. Tex.), June 26, 2025                                                                                                                 |
| 2012               | Docket Control Order, <i>Netlist Inc. v. Samsung Electronics Co., Ltd.</i> , Case No. 2:25-cv-00557 (E.D. Tex.), July 25, 2025                                                                                                                |
| 2013               | First Amended Complaint, <i>Netlist Inc. v. Samsung Electronics Co., Ltd.</i> , Case No. 2:25-cv-00557 (E.D. Tex.), July 8, 2025                                                                                                              |

| Exhibit No. | Description                                                                                                                                                                                                                                                                                                                                             |
|-------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 2014        | Verdict Form, <i>Netlist, Inc. v. Samsung Electronics Co. et al.</i> , Case No. 2:21-cv-00463-JRG (E.D. Tex.), April 21, 2023                                                                                                                                                                                                                           |
| 2015        | Complaint, <i>In the Matter of Certain Dynamic Random Access Memory (DRAM) Devices, Products Containing the Same, and Components Thereof</i> , Investigation No. 337-TA-3854 (I.T.C.), September 29, 2025                                                                                                                                               |
| 2016        | Samsung Defendants' P.R. 3-3 Invalidity Contentions, <i>Netlist Inc. v. Samsung Electronics Co., Ltd.</i> , Case No. 2:25-cv-00557 (E.D. Tex.), September 24, 2025                                                                                                                                                                                      |
| 2017        | Verdict Form, <i>Netlist, Inc. v. Samsung Electronics Co. et al.</i> , Case No. 2:22-cv-00293-JRG (E.D. Tex.), November 22, 2024                                                                                                                                                                                                                        |
| 2018        | List of Patent Trial and Appeal Board proceedings filed by Samsung Electronics Co., Ltd. against Netlist, Inc.'s Patents, Docket Navigator, generated November 3, 2025                                                                                                                                                                                  |
| 2019        | Notice of Proposed Rulemaking, 90 Fed. Reg. 48,335 (Oct. 17, 2025)                                                                                                                                                                                                                                                                                      |
| 2020        | Excerpts from PTAB 2025 Intelligence Report, Patexia, Inc.                                                                                                                                                                                                                                                                                              |
| 2021        | Ramkumar, A., "Trump Takes Aim at Chip Makers With New Plan to Throttle Imports," <i>The Wall Street Journal</i> , September 26, 2025, accessible at <a href="https://www.wsj.com/economy/trade/trump-chip-tariffs-exemptions-90fa2ab3">https://www.wsj.com/economy/trade/trump-chip-tariffs-exemptions-90fa2ab3</a> (last accessed September 26, 2025) |
| 2022        | Netlist, Inc. Form 8-K, United States Securities and Exchange Commission, November 12, 2015                                                                                                                                                                                                                                                             |
| 2023        | "Netlist and SK hynix Enter into Strategic Agreements for Patents, Technology and Product Supply," Netlist Press Release, April 5, 2021                                                                                                                                                                                                                 |
| 2024        | Comparison of Claim 1 of U.S. Patent No. 12,308,087 with Claim 1 of U.S. Patent No. 8,787,060 and Claim 1 of U.S. Patent No. 9,318,160                                                                                                                                                                                                                  |
| 2025        | Written Decision on Registration, Korean Patent Application No. 10-2017-0113355, mailed March 24, 2022                                                                                                                                                                                                                                                  |

| Exhibit No. | Description                                                                                                                                                                                                                                                                                                                                                                     |
|-------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 2026        | U.S. Patent No. 10,026,724 to Kim et al., issued July 17, 2018                                                                                                                                                                                                                                                                                                                  |
| 2027        | Opening Brief for Appellant Netlist, Inc., <i>Netlist, Inc. v. Samsung Electronics Co., Ltd.</i> , Case No. 24-2240 (Fed. Cir.), February 4, 2025                                                                                                                                                                                                                               |
| 2028        | Joint Appendix Volume II of II, <i>Netlist, Inc. v. Samsung Electronics Co., Ltd.</i> , Case No. 24-2240 (Fed. Cir.), May 28, 2025                                                                                                                                                                                                                                              |
| 2029        | Morris, A., “IPBC Global 2025: Acting USPTO Director says IPR use needs to change,” <i>IAM</i> , June 10, 2025, accessible at <a href="https://www.iam-media.com/article/ipbc-global-2025-acting-uspto-director-says-ipr-use-needs-change">https://www.iam-media.com/article/ipbc-global-2025-acting-uspto-director-says-ipr-use-needs-change</a> (last accessed June 16, 2025) |

## **I. INTRODUCTION**

Discretionary considerations overwhelmingly favor denial of this IPR for the following reasons:

1. It would not be an appropriate use of PTAB resources to permit Samsung to challenge the '087 patent due to Samsung's prior technology partnership with Netlist, which involved patents in the '087 family. As early as April 2015, Netlist gave Samsung a presentation on the stacked-die technology at the heart of the '087 family. And, in November 2015, Netlist and Samsung executed an agreement that granted Samsung a license to and a security interest in Netlist's IP portfolio (including patents in the '087 family), as well as an ownership stake in Netlist itself. The agreement required Netlist to maintain and defend the validity of the patents. After Samsung breached their agreement, it has repeatedly used the PTAB to attack the very patents it once (i) licensed, (ii) accepted as collateral for a loan (thus implicitly recognizing the patents as valid), and (iii) required Netlist to maintain for its benefit. Notably, Samsung did not record the release of its security interest until 2023—after the '087 patent application was filed. Additionally, SK hynix has taken a license to the '087 patent, creating some settled expectations for Netlist.
2. The '087 patent is before both U.S. district courts and the U.S. ITC in litigation between the parties. Because the ITC matter involves other patents related to DRAM memory that Samsung cannot challenge at the PTAB, the ITC is a better

forum to resolve the parties' dispute.

3. The ITC is projected to conduct its hearing (trial) and reach an initial determination well before the Board's projected deadline for issuing a FWD. Samsung has not stipulated not to pursue duplicative obviousness arguments at district court, before the ITC, and in this IPR. Litigating the same issues in all three fora would waste resources and risk inconsistent results.
4. The Office did not commit any material errors during prosecution. The examination included consideration of two of the three references used in Samsung's challenges and the '087 claims are patentably distinct and more detailed than its parent applications that were previously before the PTAB.
5. Denying institution would further the Administration's goal of promoting a strong domestic chip manufacturing industry.
6. Samsung improperly filed both an IPR and a PGR on the same patent. This lack of respect for Board procedures and limited resources is reason alone to deny this IPR (as the second ranked petition).

## **II. BACKGROUND**

### **A. Netlist and Samsung were technology partners under a 2015 Joint Development and License Agreement ("JDLA").**

Netlist is a small company based in Irvine, California that has made a name for itself as a market disrupter with its cutting-edge computer memory solutions. Over the past 25 years, Netlist has developed and sold high-performance memory

products to some of the world's largest computing companies. A key component of Netlist's success has been its significant investment in R&D and patent protection.

On November 12, 2015, Netlist and Samsung entered into a JDLA under which Netlist granted Samsung a license to its intellectual property, including patents (e.g., U.S. 8,787,060 ("060 patent"), which is the earliest non-provisional in the '087 family), continuations, and pending applications (e.g., Appl. 14/337,168, which issued as U.S. 9,318,160 ("160 patent") in the '087 family). EX2001, 1-2, 8. The JDLA enabled Samsung to use Netlist's technology to develop DRAM memory products that are critical to current high-performance computing and AI applications, such as double data rate, 5<sup>th</sup> generation (DDR5) memory and high bandwidth memory (HBM). EX2015, 7.

As the JDLA indicates, Netlist and Samsung concurrently entered into an agreement for convertible note financing ("Purchase Agreement"), EX2001, 1, which was executed by Samsung's "venture investment arm": Samsung Venture Investment Corporation (SVIC). EX2005; EX2022, 2. The Purchase Agreement included a number of sub-agreements, including: (1) a Stock Purchase Warrant ("Stock Warrant"); (2) a Senior Secured Convertible Promissory Note ("Promissory Note"); (3) a Security Agreement; and (4) an "Intellectual Property Security Agreement." EX2002; EX2003; EX2004; EX2006, 5-16.

Under the Stock Warrant, Samsung purchased 2 million shares of Netlist at

30 cents per share, representing a 3.25% ownership interest of the 61.5 million shares issued at the time of the agreement. EX2002. The Promissory Note further provided Samsung an additional option to convert a \$15 million collateralized loan to shares of Netlist's Common Stock—translating to 12 million shares, which represented an approximate 19.5% ownership interest in Netlist. EX2003, 2. Thus, Samsung had the ability to acquire a significant equity stake in Netlist.

Under the Intellectual Property Security Agreement, Netlist also granted Samsung a security interest in Netlist's patents and patent applications, including divisions, continuations, and continuations-in-part. EX2006, 5. Thus, Samsung recognized the importance and value of Netlist's patents (and relied on their validity) by requiring them as loan collateral. EX2004. The identified assets included two parents of the '087 patent: the '060 patent and 14/337,168 (issued as the '160 patent). EX2006, 15-16. The agreement required that Netlist "[p]rotect, defend, and maintain the validity and enforceability" of the assets. EX2004, 8. And the application that issued as the '087 patent was filed before Samsung recorded the release of its security interest in 2023. EX2007.

In short, as a result of the November 2015 technology partnership, Samsung acquired a license to and a security interest in Netlist's IP portfolio (including patents in the '087 family), as well as an ownership interest in Netlist itself.

**B. Samsung breached the JDLA**

Under the JDLA, Samsung was obligated to supply Netlist certain memory products at competitive prices. However, in 2018, Samsung began to deliberately restrict Netlist's access to products and repeatedly failed to fulfill Netlist's orders, forcing Netlist to forgo business opportunities. EX2008, 4. Accordingly, Netlist terminated the JDLA on July 15, 2020, and filed suit in the Central District of California ("CDCA"). EX2008; EX2015, 7. Samsung did not record the release of its security interest to Netlist's patent assets until October 27, 2023 (after the '087 patent application was filed). *See* EX2007.

Following trial in the CDCA, a jury agreed with Netlist that Samsung breached the JDLA and that Netlist's termination was valid. On April 7, 2025, the district court entered judgement against Samsung pursuant to the jury verdict. EX2009. That decision is on appeal to the Ninth Circuit (case number 25-5531). The district court ruling is res judicata unless and until overturned on appeal.

**C. Juries have found Samsung liable for willful infringement of Netlist patents and awarded Netlist hundreds of millions of dollars in damages.**

Netlist has secured multiple jury verdicts confirming the commercial success of its inventions, including two against Samsung. In 2023, a jury in the Eastern District of Texas (EDTX) found that Samsung willfully infringed five Netlist patents and that the patents were not invalid and awarded Netlist \$303.15 million

in damages. *See* EX2014. In 2024, a jury found that Samsung willfully infringed three Netlist patents and that the patents were not invalid and awarded Netlist \$118 million in damages. *See* EX2017. Yet Samsung has continued its infringing conduct, enabled by the ability to repeatedly challenge Netlist’s patents—patents it once licensed and required Netlist to defend the validity of—before the PTAB.

**D. Samsung has repeatedly attacked the validity of Netlist patents it once licensed in IPR proceedings.**

In the past five years, 18 of Netlist’s patents have been attacked at the Patent Office, with 13 of those patents subject to multiple attacks. Samsung has filed 18 IPRs and one PGR against Netlist patents, many of which Samsung previously licensed and had a security interest in. EX2018. This petition continues a pattern of serial IPR filings by Samsung. Indeed, Samsung is, by far, the most frequent petitioner in IPR proceedings, having filed over 600 IPR petitions in the last five years. EX2020, 48; *see* EX2019, 48,337 (“By far, the most frequent users of IPR proceedings are large technology companies.”).

**E. Netlist seeks to prevent Samsung’s ongoing infringement.**

In May 2025, Netlist filed suits against Samsung (25-cv-00557) and Micron (25-cv-00558) in EDTX, and amended its complaint in July 2025, to prevent ongoing infringement of the ’087 patent (and others). EX2013. The cases were consolidated for pretrial purposes. EX2011. Trial is set for March 15, 2027. EX2012, 1.

In September 2025, Netlist filed an ITC complaint against Samsung and certain of its customers asserting six patents, including the '087 patent. EX2015. Of the six asserted patents, the PTAB has confirmed the validity of three of the patents; Samsung was the petitioner in two of those proceedings. EX2015, 5-6. *Samsung Elecs. Co. v. Netlist, Inc.*, IPR2022-00063, Paper 53 at 58 (PTAB May 3, 2023) (confirming the validity of all claims of the '523 patent), *aff'd*, No. 23-2133, Dkt. No. 44 (Fed. Cir. Mar. 5, 2025); *Samsung Elecs. Co. v. Netlist, Inc.*, IPR2023-00847, Paper 42 at 73 (PTAB Dec. 10, 2024) (confirming the validity of claims 1–5 of the '608 patent), *appeal docketed*, No. 25-1378, Dkt. No. 1 (Fed. Cir. Jan. 21, 2025). Due to the lapse in federal appropriations, the ITC investigation has not yet been instituted, but Netlist expects that institution will occur promptly once the Government shutdown ends. Netlist will update the PTAB upon institution.

**F. SK hynix licensed Netlist's portfolio in 2021.**

In 2021, SK hynix licensed Netlist's patent portfolio (including the '087 patent), further demonstrating the industry's desire for access to Netlist's superior technology. EX2023. SK hynix is a leading provider of next generation DIMMs and HBM. In the first three months of FY2025, SK hynix reported \$9.1 billion in revenue in the United States. EX2015, 28. A significant portion of this revenue is attributable to products that include Netlist's patented technology. *Id.*

### III. MULTIPLE INDEPENDENT REASONS WARRANT DENIAL.

#### A. Samsung's prior technology partnership with Netlist, including its prior license to Netlist's patents, should foreclose review.

Prior technology partnerships, licenses, and ownership interests in a challenged patent weigh heavily in favor of denying an AIA challenge filed by a party who previously had an interest in the patent. *See L'Oreal USA, Inc. v. Brightex Bio-Photonics, LLC*, IPR2025-00971, Paper 13 at 2 (PTAB Sept. 26, 2025) (that parties were “technology partners” for many years and developed products together favored denial); *Microsoft Corp. v. TS-Optics Corp.*, IPR2025-00767, Paper 13 at 2 (PTAB Aug. 14, 2025) (“Absent exceptional circumstances, it is not an efficient use of Board resources where a party licensed the challenged patent, and then, as is the case here, now advocates for the unpatentability of that same patent.”); *RegenX Science, Inc. v. NextGen Biologics, Inc.*, IPR2025-00620, Paper 13 (PTAB July 31, 2025) (same).

Samsung's prior business relationship with Netlist and its interest in the parent applications (and continuations) that led to the '087 patent should foreclose this IPR. Netlist presented its stacked-die technology to Samsung in April 2015. EX2027, 14; EX2028, 67-68, 74-79. Shortly thereafter, Samsung and Netlist entered into the JDLA and were “technology partners,” lasting from November 2015 until July 2020. EX2001; EX2008, 1. During this period, Samsung took a license to Netlist's patents, which, by the terms of their agreement, Netlist was required to

“[p]rotect, defend, and maintain the validity and enforceability” of. EX2004, 8. In the event of breach by Netlist, Samsung had the right—without Netlist’s consent—to defend and institute any action with respect to the patent collateral (including parents of the ’087 patent); to grant or issue exclusive or non-exclusive licenses; and to assign or otherwise transfer title in the patent collateral. EX2004, 10. Samsung also acquired a 3.25% stake in Netlist itself, with an option to acquire nearly 20% of the company.

Netlist thus granted Samsung important interests in its company and in the stacked-die technology of the ’087 patent family—interests that, in turn, gave Samsung strong incentives to have Netlist maintain and develop valid patents covering this technology (as the agreements themselves indicate). This IPR should be denied because it is not an appropriate or efficient use of PTAB resources to review a patent challenge brought by a party that previously acquired rights to technology covered by the patent through an agreement that it subsequently breached.

Further, because of Samsung’s lengthy history with and interest in the ’087 patent family, Samsung should have known that the application leading to the ’087 patent was filed in March 2022, and published in June 2022. Had Samsung questioned the validity of the ’087 patent or the caliber of examination, it should have made third-party submissions to the Office during prosecution. *See* EX2029, 2 (“Among other tools, the [AIA] gives an opportunity for third parties to send prior

art to the USPTO when patents are under examination.”).

Finally, that SK hynix took a license to Netlist’s portfolio creates at least some settled expectations in the ’087 patent. *Alliance Laundry Sys., LLC v. PayRange LLC*, IPR2025-00950, Paper 11 at 3 (PTAB Sept. 19, 2025) (evidence that challenged patent is licensed creates settled expectations for Patentee).

**B. The ITC is the best forum to resolve the parties’ dispute.**

The ITC is the fastest and most efficient forum to resolve the dispute between Netlist and Samsung. *See Samsung Elecs. Co. Ltd. v. VB Assets, LLC*, IPR2025-00870, Paper 11 at 3 (PTAB Oct. 10, 2025) (where there were six patents at issue in district court and PTAB would review, at most, two of the patents, denying institution because the district court would be “fastest and most efficient” forum in which to resolve the overall dispute).

Netlist’s ITC complaint asserts six patents related to DRAM memory against Samsung (and others): U.S. Patent Nos. 9,824,035; 10,025,731; 10,217,523; 10,268,608; 12,308,087; and 12,373,366. Samsung is estopped under § 315(e) from challenging the ’608 and ’523 patents because it was a petitioner in two prior IPRs where the PTAB confirmed their validity. EX2015, 5-6. Samsung has not challenged the ’366 patent at the PTAB. And the schedule for Samsung’s challenge to the ’035 patent in IPR2026-00017 (and any later challenge to the ’366 patent) will be far behind the ITC schedule. Further, the PTAB should not review the

validity of the '035 patent *again* because it was the subject of IPR2022-00236 brought by Micron in which the asserted claims were upheld. *See Intel Corp. v. Advanced Cluster Sys., Inc.*, IPR2025-00794, Paper 13 at 2-3 (PTAB Aug. 14, 2025) (repeated prior challenges weigh against institution); EX2019, 48,338. The PTAB has thus already upheld the validity of three of the asserted patents. And Samsung previously had a license to and/or an ownership interest in the asserted patents or their parents.

Under these circumstances, it is not an appropriate or efficient use of PTAB resources to review the patents Netlist asserted in the ITC, including the '087 patent. The PTAB cannot fully resolve the parties' dispute because Samsung cannot challenge two of the other patents at PTAB. So the ITC is plainly the better forum. And, as discussed below, the ITC will also be a *faster* forum to determine validity.

**C. The *Fintiv* factors strongly favor discretionary denial.**

All of the *Fintiv* factors favor or strongly favor denying institution.

**1. Factor 1 strongly favors denial because the ITC will not grant a stay.**

Factor 1 strongly favors denial because the ITC is virtually certain not to stay its proceedings pending conclusion of an IPR. *See Milwaukee Electric Tool Corp v. Klein Tools, Inc.*, IPR2025-00724, Paper 14 at 2-3 (PTAB Sept. 12, 2025). The ITC has a statutory mandate to complete its investigation “at the earliest practical time” and its standing practice is to deny such requests. *See* 19 U.S.C. §

1337(b)(1); *Certain Automated Storage and Retrieval Systems, Robots, and Components Thereof*, Inv. No. 337-TA-1228, Order No. 6 (ITC Mar. 9, 2021); *see also Klein Tools, Inc. v. Milwaukee Electric Tool Corp.*, IPR2024-01400, Paper 22 at 2 (Stewart June 9, 2025) (determining on Director Review that “[t]he Board did not give enough weight to the lack of a stay, or the fact that a stay was unlikely, in the parallel [ITC] investigation”). There is no indication that the ITC would depart from its standing practice here. So factor 1 strongly counsels in favor of denial.

**2. Factor 2 strongly favors denial because the projected ITC initial determination will occur months before the projected FWD and the ITC trial will occur even sooner; DCT trial is scheduled for the same month as the FWD.**

Factor 2 strongly favors denial. The projected statutory deadline for the FWD in this IPR would be March 4, 2027. In the consolidated EDTX cases, trial is scheduled for March 15, 2027. Even if Samsung moves for a stay of its case due to the ITC investigation, Micron’s case will proceed (because Micron is not a party to that investigation). The validity of the ’087 patent is thus likely to be adjudicated at trial in EDTX around the same time as the PTAB’s deadline for issuing an FWD.

As for the ITC, Netlist filed its complaint on September 29, 2025. Due to the shutdown, the ITC investigation has yet to be instituted, but Netlist expects institution to occur promptly once federal appropriations resume. The median time for the ITC to issue its initial determination is 14.8 months. EX2010. So the ITC initial determination would likely issue by mid-December 2026 or early 2027—months

before any final written decision in this IPR. *See* EX2019, 48,341 (October 17, 2025 proposed rules consider the timing of the ITC’s “initial or final determination” in evaluating whether to institute an IPR).

Even more relevant to the factor two inquiry is that the hearing—which is analogous to the trial date in district court—is highly likely to occur months sooner. *Fintiv* instructs that “an earlier ITC *trial* date may favor exercising authority to deny institution ... if the ITC is going to decide the same or substantially similar issues.” *Fintiv*, 8 (emphasis added). And, under the Interim Process, the hearing date alone has been used to evaluate factor two based on a co-pending “ITC trial.” *See Taiwan Semiconductor Manufacturing Co. Ltd. v. Marlin Semiconductor Ltd.*, IPR2025-00848, Paper 11 at 2 (PTAB Sept. 3, 2025) (comparing the ITC *hearing* date to the final written decision due date and determining it is unlikely the FWD would issue “*before the ITC trial occurs.*”) (emphasis added). Institution of an IPR under these circumstances—when the ITC trial is highly probable to occur *at least four months prior* the issuance of a decision by the Board—would not be consistent with the AIA’s objective to provide an effective and efficient alternative to litigation. *Accord NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (precedential).

**3. Factor 3 favors denial because ITC discovery will begin promptly upon ITC institution.**

Factor 3 favors denial. The relevant consideration is the “amount and type of work already completed in the parallel litigation by the court and the parties *at the time of the institution decision.*” *Fintiv*, 9 (emphasis added). The deadline for issuing a Decision on Institution (DI) in this IPR is March 4, 2026. ITC discovery will begin promptly upon ITC institution. *See* 19 C.F.R. §§ 210.29(b)(1), 210.30(b)(1). Given the ITC’s statutory mandate to complete investigations at the earliest practical time—and because the hearing will occur months before the ITC’s projected initial determination date of December 2026 or early 2027—it is highly likely that, by the time a DI in this proceeding issues, the parties will have already invested enormous resources into discovery at the ITC.

**4. Factor 4 strongly favors denial because Samsung has not offered a stipulation.**

Factor 4, which considers the overlap between the issues raised in the IPR petition and in the parallel proceeding(s) in order to evaluate “concerns of inefficiency and the possibility of conflicting decisions,” *Fintiv*, 12, also strongly favors denial. In the parallel district court proceeding, Samsung submitted invalidity contentions that significantly overlap with its IPR challenges. *Compare* EX2016, 33-35 (asserting the claims of the ’087 patent are obvious over Keeth, Shaeffer, and Riho2), *with* Pet., 4 (challenging the claims based on Keeth, Shaeffer, and Riho2).

Samsung further challenged the claims on numerous additional anticipation and obviousness grounds and asserts the claims are invalid under § 112. EX2016, 31-179, 263-294. These contentions are likely a preview of what Samsung will allege in the ITC investigation as well.

More importantly, Samsung has not submitted *any stipulation* and, therefore, has done nothing to mitigate concerns of inefficiency or duplication of effort such that “th[is] IPR proceeding[] would be a ‘true alternative’ to the district court proceeding” or to the ITC investigation. *See Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3-4 (PTAB Mar. 28, 2025) (on Director Review vacating panel’s institution decision and denying under *Fintiv*); *see also Phison Electronics Corp., v. Vervain, LLC*, PGR2025-00010, Paper 14 at 3 (PTAB July 10, 2025) (lack of stipulation tips the balance in favor of discretionary denial). The significant overlap and Samsung’s failure to stipulate strongly favors denial. And Samsung should not be permitted to enter a stipulation at this late date. *See Interim Process* § I.D (petitioners should file stipulations “as soon as practicable”).

**5. Factors 5 and 6 favor denial because the parties in the IPR overlap with the parties in the district court and ITC litigations and the merits are weak.**

Factor 5 favors denial because the parties in the parallel litigation overlap. *See Pet.*, 1. Factor 6 also favors denial because, as will be explained in the POPR, the Petition fails to establish that the challenged claims are invalid over the

Grounds asserted therein. Netlist asks the Director to consider the full briefing presented in its POPR. *See* Interim Process, § II.C.i (stating a patent owner may direct attention to an anticipated POPR and evidence for a discussion of the merits).

**D. The Office committed no material errors during prosecution and the '087 claims are materially different than those of its parents.**

The Office committed no material errors during prosecution that require correction by the PTAB. Rather, examination of the '087 patent was very thorough, involving: (1) *four Worldwide prior art searches by the Office* on: September 28, 2022 (EX1002, 120-22); July 6-7, 2023 (EX1002, 192-95); September 18, 2023 (EX1002, 246-49); and January 13, 2024 (EX1002, 326-29); (2) *six Office Actions on the merits* (EX1002, 103-16, 201-06, 258-63, 334-40, 425-29, 830-86 (including examiner's amendment)); (3) *seven rounds of claim amendments and/or remarks* (EX1002, 144-52, 208-17, 269-80, 304-13, 341-52, 746-76, 778-96); and (4) *nine information disclosure statements* (EX1002, 69-91, 167-75, 233-39, 303-17, 360-67, 392-98, 400-05, 716-24, 731-34 (listing Keeth)).

Samsung concedes that two of the three references asserted in its obviousness Grounds, including primary reference Keeth, were considered during prosecution, Pet., 3-5 (Grounds), 11, 14, and thus cannot credibly allege that the Office's prior art searches or Netlist's disclosures were inadequate. Moreover, Samsung knew of all three asserted references (Keeth, Shaeffer, and Riho2) at the time that the '087 patent was being examined at the Office. EX2026 (Samsung

patent citing Keeth); EX2025 (March 2022 KIPO communication in Samsung application listing publication of Shaeffer as reference 4, *see* EX1048, (65)); EX1072, 3 (Samsung asserted Riho2 in IPR2022-01428, filed in August 2022). Had Samsung believed that the Examiner's evaluation of Keeth and Riho2 was inadequate (because the Examiner considered both), it should have submitted third-party submissions explaining the combination of references it asserts here. *See* EX2029, 2.

Nor can Samsung credibly allege that the prior IPRs of the parents of the '087 patent (i.e., the '160 and '060 patents) demonstrate a history of invalidity with the *claimed* subject matter. First, the PTAB decisions regarding the '060 and '160 patents are currently on appeal, and thus validity has not been finally adjudicated (Appeal No. 24-2203). Second, the claims of the '087 patent are more detailed than those of the '060 and '160 patents. EX2024. Indeed, Samsung's Grounds challenging the '087 patent demonstrate that the validity issues and theories are different, requiring Samsung to present different art and combinations than it asserted against the '060 and '160 patents. *Compare* EX1072, 2-3 (Grounds against '060) and EX1073, 2-3 (Grounds against '160), *with* Pet., 4-5. Specifically, in the IPRs against the '060 and '160 patents, Samsung asserted various combinations of Kim (U.S. 2011/0103156) and Rajan (U.S. 8,041,881), EX1072, 2-3; EX1073, 2-3, and asserted Riho2 only in Grounds that the PTAB did not

evaluate, EX1072, 74; EX1073, 67. Here, Samsung relies on entirely different primary and secondary references (Keeth and Shaeffer), disingenuously implying there should be an estoppel effect from the prior IPRs. *See* Pet., 8-9. But the claims and asserted art are plainly different, and thus the outcomes of Samsung's prior IPRs (challenging Netlist patents that Samsung once licensed) do not demonstrate error in examination or a history of invalidity with respect to the claimed subject matter of the '087 patent.

**E. Institution of this proceeding would be contrary to important national security and economic interests.**

Considerations of “[c]ompelling economic ... or national security interests” are highly relevant to the discretionary denial analysis. Memo, 2. These important domestic policy and security interests are a further reason supporting denial.

The current presidential administration has made clear that domestic production of semiconductors is needed for “economic security.” EX2021, 2. The administration is appropriately concerned that U.S. technology companies are overly dependent on semiconductor chips made overseas and vulnerable to crippling disruption to its supply chains. *Id.* Netlist (a U.S. company) and its licensee SK hynix (a company that will manufacture in the U.S.) support these important policy goals by their ongoing significant investment in establishing a domestic semiconductor manufacturing industry based on products that incorporate the '087 patent's claimed technology. *See* EX2015, 26-29. And Netlist's ITC

complaint seeks to block memory devices that infringe its patents and are manufactured abroad from being imported into this country. Enforcement of Netlist's IP rights will thus encourage domestic manufacturing of semiconductors, such as through the substantial domestic manufacturing performed by Netlist licensee SK hynix. EX2015, 28-29. Notably, institution of this proceeding would risk frustrating that goal.

Indeed, SK hynix announced in 2024 that it will invest *\$3.87 billion* in a chip packaging facility in Indiana. EX2015, 28. Given the importance of the '087 patent technology to supporting a domestic semiconductor industry, it would not be an appropriate use of PTAB resources to institute this proceeding and undermine the critical efforts of this administration to encourage domestic manufacturing of semiconductors in furtherance of national economic and security interests.

**F. Samsung's gamesmanship of filing parallel petitions that challenge the same claim sets should not be tolerated.**

"[T]he practice of the same party filing multiple petitions challenging the same patent ... is disfavored." *Comcast Cable Commc'ns, LLC v. Entropic Commc'ns, LLC*, IPR2025-00183, Paper 11 at 2 (PTAB June 25, 2025). Instead of analyzing the written description support of the claims and choosing and standing behind a position, Samsung shifts the burden to the PTAB to fully analyze the issue—all the while hoping for no negative consequence if their written description

contentions are determined to be incorrect. Samsung admits as much, indicating the IPR petition was filed as a back-up “if the PGR petition is wrong.” Paper 3, 2. Samsung’s strategy of filing two petitions unnecessarily burdens the PTAB and should not be rewarded. Discretionary denial of Samsung’s second ranked IPR petition is appropriate, even if the PGR is denied. *See FreightCar America, Inc. v. National Steel Car Ltd.*, IPR2025-01048, Paper 20 at 4 (PTAB Oct. 10, 2025) (discretionarily denying second ranked petition before first ranked petition considered on the merits); *see* Paper 3 (ranking the PGR first).

#### **IV. CONCLUSION**

The parties’ prior business relationship, the co-pending litigation, the Office’s high-quality original examination, Samsung’s gamesmanship of filing multiple petitions against the ’087 patent, and the Administration’s goal of incentivizing domestic chip manufacturing overwhelmingly favor discretionary denial. The Director should deny institution, and Samsung should pursue its invalidity arguments in district court and before the ITC.

Respectfully submitted,

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**CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))**

I certify that the above-captioned **NETLIST, INC.'S BRIEF ON  
DISCRETIONARY DENIAL** and associated Exhibits 2001-2029 were served in  
their entireties on November 4, 2025, upon the following parties via electronic  
mail:

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