

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
U.S. Patent No. 12,308,087

**PATENT OWNER'S SUR-REPLY IN SUPPORT OF
PATENT OWNER'S PRELIMINARY RESPONSE**

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Patent Trial and Appeal Board
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PATENT OWNER'S UPDATED EXHIBIT LIST

Exhibit No.	Description
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 https://www.samsungventure.co.kr/english/jsp/company/company.jsp (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 https://www.wsj.com/economy/trade/trump-chip-tariffs-exemptions-90fa2ab3 (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

Exhibit No.	Description
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
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 https://www.iam-media.com/article/ipbc-global-2025-acting-uspto-director-says-ipr-use-needs-change (last accessed June 16, 2025)
2030	“Precedential designation of <i>Corning Optical Communications RF, LLC v. PPC Broadband Inc.</i> , IPR2014-00440, Paper 68 (PTAB Aug. 18, 2015) (except for § II.E.1),” United States Patent and Trademark Office Memorandum, October 28, 2025
2031	Public Redated Version of Complaint for Declaratory Judgment of Non-Infringement, <i>Samsung Electronics Co., Ltd. et al. v. Netlist, Inc.</i> , Case No. 1:25-cv-00626-JLH (D. Del.), May 20, 2025
2032	Public Redated Version of Proposed First Amended Complaint for Declaratory Judgment of Non-Infringement, <i>Samsung Electronics Co., Ltd. et al. v. Netlist, Inc.</i> , Case No. 1:25-cv-00626-JLH (D. Del.), July 29, 2025

Exhibit No.	Description
2033	Defendants Samsung Semiconductor, Inc. and Samsung Electronics America, Inc.'s Motion to Dismiss for Improper Venue, <i>Netlist, Inc. v. Samsung Electronics Co., Ltd. et al.</i> , Case No. 2:25-cv-00557-JRG (E.D. Tex.), November 24, 2025
2034	Plaintiff's Corporate Disclosure Statement, <i>Samsung Electronics Co., Ltd. et al. v. Netlist, Inc.</i> , Case No. 1:25-cv-00626-JLH (D. Del.), May 20, 2025
2035	List of Patent Trial and Appeal Board proceedings listing Samsung Electronics America, Inc. as Petitioner, Docket Navigator, generated December 3, 2025
2036	Redline Comparison of Independent Claim 1 and Independent Claims 9, 13, 20, 23, and 24 of U.S. Patent No. 12,308,087
2037	Word Counts of Petitions in IPR2025-01402 and PGR2025-00071, including image annotations
2038	Final Judgment, <i>Netlist, Inc. v. Samsung Electronics Co., Ltd. et al.</i> , Case No. 2:21-cv-00463-JRG (E.D. Tex.), August 11, 2023
2039	Trial Transcript, Volume 3, <i>Netlist, Inc. v. Samsung Electronics Co., Ltd. et al.</i> , Case No. 2:21-cv-00463-JRG (E.D. Tex.), April 18, 2023
2040	Judgment under Federal Circuit Rule 36, <i>Samsung Elecs. Co., Ltd. v. Netlist, Inc.</i> , Appeal No. 23-2133 (Fed. Cir.), March 5, 2025
2041	Judgment under Federal Circuit Rule 36, <i>Samsung Electronics Co., Ltd. v. Netlist, Inc.</i> , Appeal No. 25-1378 (Fed. Cir.), December 9, 2025
2042	Netlist's Petition for the Director to Suspend the Rules and Deny the Request for Reexamination Under 35 U.S.C. §§ 303(a) and 325(d), <i>Ex Parte</i> Reexamination Control No. 90/015,449, filed October 17, 2025

Exhibit No.	Description
2043	Complaint, <i>Netlist, Inc. v. Samsung Elecs. Co., Ltd. et al.</i> , Case No. 2:25-cv-00748-JRG (E.D. Tex.), July 28, 2025
2044	Complaint, <i>Samsung Elecs. Co., Ltd. et al. v. Netlist, Inc.</i> , Case No. 1:25-cv-01371-JLH (D. Del.), November 11, 2025
2045	Commission Determination, <i>In the Matter of Certain Unmanned Aerial Vehicles and Components Thereof</i> , Investigation No. 337-TA-1133 (I.T.C.), September 8, 2020
2046	Samsung's Certificate of Interest, <i>Netlist, Inc. v. Samsung Electronics Co., Ltd.</i> , Appeal No. 24-2203 (Fed. Cir.), August 27, 2024
2047	Company Profile, Avnet, Inc., accessible at https://s23.q4cdn.com/291570380/files/doc_downloads/fact-sheet/2020/Avnet-Fact-Sheet.pdf (last accessed December 22, 2025)
2048	"Samsung Authorized Distributor Avnet Americas," Avnet, Inc., accessible at https://www.avnet.com/americas/manufacturers/m/samsung/ (last accessed December 22, 2025)

I. THE DIRECTOR SHOULD DENY INSTITUTION

A. The Petition fails to name two RPIs: Samsung Electronics America, Inc. (“SEA”) and Avnet, Inc. (“Avnet”).

Samsung’s Reply (Paper 16) confirms that the Director should deny institution under Section 312(a)(2) and *Corning Optical* because the Petition fails to name SEA and Avnet as RPIs. Paper 12, POPR, 8-17; EX2030 (*Corning* memo). RPI has an “expansive formulation” that is satisfied by showing that the party under consideration “is a clear beneficiary that has a preexisting, established relationship with the petitioner.” *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1351 (Fed. Cir. 2018). Samsung does not even mention—let alone apply—this test, which both SEA and Avnet easily satisfy. POPR, 8-17. While both entities are RPIs, the Director need only find that one is an RPI to deny institution.

According to *Samsung*, SEA is a subsidiary of Petitioner Samsung Electronics Co., Ltd. (“SEC”) and the parent of RPI Samsung Semiconductor, Inc. (“SSI”). EX2034, 1. Along with SEC and SSI, SEA is a respondent at the ITC, EX2015, 2 (¶5); a co-defendant in related EDTX litigation, EX2013, 1; and a co-plaintiff in a Delaware DJ action that Samsung filed on the *same* day that the ’087 patent issued. EX2031, 1; EX2032, 1 (Samsung’s proposed first amended DJ complaint (FAC) continuing to name SEA as co-plaintiff). In the DJ complaint, Samsung represents that “[a] substantial, immediate, and real controversy exists between Samsung [including SEA] and Netlist regarding whether Samsung or its customers or end users

infringe the '087 patent” EX2031, 25 (¶79); *see also* EX2032, 41 (¶137).

If that is not enough, SEA (along with SEC and SSI) once held a license to the '087 patent's parent patents (the '060 and '160 patents), Paper 8, DD Br., 2-4; EX2031, 8 (¶¶28-29); was found to willfully infringe those patents, EX2038, 1-2; and is a co-appellant in Samsung's appeal of that judgment, EX2046, 2. SEA undisputably has a preexisting, established relationship with SEC and SSI, and would clearly benefit from this PGR (e.g., potentially avoiding liability); it is an RPI.

So is Avnet. All agree that Samsung and Avnet have a preexisting, established relationship: according to Samsung, Avnet is Samsung's customer. EX2032, 2 (¶2). But more than that, Avnet is a distributor of Samsung's memory products, EX2047, EX2048, and, as such, is a co-defendant in the EDTX litigation, EX2013, 1. Critically, Avnet is also a co-plaintiff in the Delaware DJ action, and has represented to that court that there exists “substantial, immediate, and real controversy” with Netlist as to infringement of the '087 patent. EX2032, 41 (¶137). Given its involvement in these cases, Avnet would clearly benefit from this proceeding.

Faced with these damning facts, Samsung presents a series of misleading arguments. It starts by quoting *Nintendo* to allege that Avnet (but not SEA) is not a “true defendant in the dispute.” Reply, 1 (cleaned up, quoting *In re Nintendo of Am., Inc.*, 756 F.3d 1363, 1365 (Fed. Cir. 2014)). But *Nintendo* was about whether venue was proper, not whether an unnamed party was an RPI to a PTAB case. 756

F.3d at 1366-67. And Avnet *chose* to be a plaintiff in the Delaware DJ action, certifying there is an “immediate ... controversy.” EX2032, 5 (¶16), 41 (¶137).

Samsung next cites Exhibit 1129 to assert that the “original” DJ action in Delaware named only SEC and SSI. Reply, 2. But the complaint filed as Exhibit 1129 is for a different DJ action that did not involve the ’087 patent. Again, SEA is a plaintiff in the original DJ complaint in Delaware against the ’087 patent, and both SEA and Avnet are plaintiffs in the proposed FAC. EX2031; EX2032.

Samsung then accuses Netlist of concealing declarations Samsung used to support its EDTX venue motion. Reply, 2. But Netlist submitted the motion *itself* (EX2033). The motion contains the same alleged facts, *see* EX2033, 3-4, which are irrelevant here because venue and RPI turn on different legal tests, POPR, 12-14.

Next, Samsung argues that it “has consistently named only SEC ... and SSI” as RPIs, “and never SEA or any customers” in its many past petitions against Netlist’s patents (many of which it previously licensed). Reply, 2. But Samsung’s admission that it may have skirted its statutory obligation in previous cases does not relieve Samsung of satisfying that obligation in this proceeding.

Taking a different tack, Samsung next attempts to shift the burden to Netlist, complaining that Netlist has never argued in past IPRs that SEA is an RPI. Reply, 3. That is irrelevant. As Petitioner, it is Samsung’s burden under Section 312(a)(2) to name all RPIs in its Petition. It failed to do so and should be held to account.

Samsung then accuses Netlist of attempting to “relitigate” the RPI issue in IPR2022-00615. But the issue there was whether Google was an RPI to a petition challenging a different patent; it had nothing to do with SEA or Avnet. EX1128, 2. Samsung goes as far as characterizing SEA as a mere customer: “a *customer* (such as Avnet or SEA),” Reply, 3, which is plainly untrue and inconsistent with Samsung’s disclosures in Delaware and to the Federal Circuit. EX2034; EX2046, 2. Worse, Samsung’s Reply presents a misleading block quote that cobbles together text *spanning 10 pages* of that decision. Reply, 3 (citing pp. 13, 14, 23 of EX1128).

Finally, Samsung argues that the most critical *AIT/RPX* factor demonstrating that SEA and Avnet are not RPIs is that they did not pay Petitioner to reduce their potential exposure to infringement liability. Reply, 4. But that factor is inapplicable here because none of the parties have a business model like RPX.

The facts bely Samsung’s conclusion it “has clean hands, unlike Netlist.” Reply, 4. Samsung breached the parties’ 2015 agreement, willfully infringed Netlist’s patents, and seeks PTAB review to escape paying a fair price for its unauthorized use of Netlist’s technology. DD Br., 2-6. It should not be allowed to do so.

B. The Director should deny institution under *Revvo* and *Tesla*.

Samsung’s cursory argument that withdrawing its inconsistent claim constructions in EDTX moots the issue is incorrect. Reply, 4. Samsung has not made *any* stipulation here, including agreeing to forgo those constructions at the ITC.

Respectfully submitted,

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Date: December 22, 2025

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

I certify that the above-captioned **PATENT OWNER'S SUR-REPLY IN
SUPPORT OF PATENT OWNER'S PRELIMINARY RESPONSE** and associated Exhibits 2046-2048 were served in their entireties on December 22, 2025, upon the following parties via electronic mail:

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