

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner

v.

NETLIST, INC.,
Patent Owner

Case IPR2025-01431
U.S. Patent No. 10,025,731

**PATENT OWNER PRELIMINARY RESPONSE
UNDER 37 C.F.R. § 42.107(a)**

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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
2024	“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

Exhibit No.	Description
2025	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
2026	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
2027	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
2028	List of Patent Trial and Appeal Board proceedings listing Samsung Electronics America, Inc. as Petitioner, Docket Navigator, generated December 3, 2025
2029	Word Count of Petition in IPR2025-01431, including image annotations
2030	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

I. INTRODUCTION

The Director should deny institution of *inter partes* review of claims 1-18 of U.S. Patent No. 10,025,731 (“the ’731 patent”) because: (1) the Petition fails to name two real parties in interest (RPIs), (ii) Samsung advances inconsistent claim constructions across proceedings at the Board and in district court, (iii) the Petition fails to demonstrate a reasonable likelihood of success on the merits, (iv) the Petition is procedurally deficient, and (v) considerations under the Board’s *Chevron/Deeper* precedent favor denial. Each of these reasons independently supports denying institution.

First, despite being clear beneficiaries of Petitioners’ challenges to the validity of the ’731 patent, and having preexisting, established relationships with Petitioners, neither Samsung Electronics America, Inc. (“SEA”) nor Avnet, Inc. (“Avnet”) is listed as an RPI to this IPR. Not only are SEA and Avnet both named defendants in both the EDTX and ITC cases in which Netlist has asserted infringement of the ’731 patent, but they also are named *plaintiffs* in Samsung’s declaratory judgment action in Delaware. That Samsung *itself* chose to list SEA and Avnet as co-plaintiffs in this Delaware DJ action forecloses any argument they are not RPIs here. The Board’s precedential decision in *Corning Optical* mandates that the Petition cannot be considered, and thus the Director should deny institution.

Second, Samsung presents inconsistent claim construction positions in this IPR and the EDTX proceeding. In EDTX, Samsung contends most of the claims are indefinite. But in this IPR, Samsung argues that the Board should apply the plain and ordinary meaning to the claims. Contrary to the Board's precedent in *Revvo* (precedential) and *Tesla* (informative), Samsung provides *no explanation* for its different claim construction positions. Under these circumstances, *Revvo* mandates denial.

Third, Samsung fails to demonstrate a reasonable likelihood of success on the merits for a number of reasons, each of which independently supports denial. To start, Samsung's contentions for many claims/claim elements are unsupported by expert testimony because Dr. Wolfe's declaration addresses only a subset of the claim elements. Exhibit 1093, which is a claim chart that Dr. Wolfe references only one time, is not in the form of an affidavit or declaration—i.e., it is unsigned and lacks the required perjury statement—and should not be given any weight. Samsung also fails to address known secondary considerations of non-obviousness, including its *own* prior licensing activities related to the '731 patent. Accordingly, Samsung's obviousness theories are incomplete and fail to satisfy the threshold for institution.

Fourth, Samsung's Petition violates even the most basic of the Board's procedural rules. The asserted grounds are not presented with particularity, often

resorting to conclusory statements that are followed by lengthy string citations with little to no explanation on how the cited evidence supports the assertion. Again, this allows for gamesmanship and shifting theories. And, despite repeated reminders from the Board in numerous other proceedings, Samsung continues its disregard of the Board's rule on word count limits and prohibition of incorporation by reference.

Finally, even if the Director finds that the Petition has presented a reasonable likelihood of success as to one or even a handful of claims (which it does not), it would not be an efficient use of the Board's valuable time and resources to institute review when resolution of this proceeding would be costly and time-consuming to address challenges that are flawed from the outset.

Independently, each of these reasons supports denying institution. In combination, they overwhelmingly show that the Board should not institute trial.

II. THE '731 PATENT

A. Summary

The '731 patent discloses and claims a memory module that includes signal correction circuits, each including at least one programmable impedance mismatch circuit, to correct signals transmitted to and from the module's memory devices. *See* EX1001, 9:55-62. The claimed correction circuitry can reduce signal noise due to impedance mismatch in the system, enabling the claimed memory modules to

provide stable, reliable signals at high data rates. *See* EX1001, 4:30-67.

B. Level of Skill in the Art

At this stage of the proceeding, solely for the purpose of this preliminary response, Netlist adopts Samsung’s proposed level of skill in the art. Netlist reserves the right to present a different level of skill in the art, if necessary.

C. Claim Construction

None of the arguments below turn on the construction of any specific claim term. The Board thus need not construe any terms to resolve the dispute and deny the Petition. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (the Board “need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy.’”).

Contrary to Samsung’s inconsistent claim construction positions in the co-pending Eastern District of Texas (EDTX) litigation, *see* Section IV, all claims satisfy the definiteness requirement of 35 U.S.C. § 112, ¶2.

III. THE PETITION FAILS TO NAME TWO REAL PARTIES IN INTEREST: SEA AND AVENT.

The Director should deny the Petition because it fails to name two real parties in interest (RPIs): Samsung Electronics America, Inc. (“SEA”) and Avnet, Inc. (“Avnet”). “A petition filed under section 311 may be considered *only if* ... the petition identifies all real parties in interest.” 35 U.S.C. § 312(a)(2) (emphasis added); *see also* 37 C.F.R. §§ 42.8(b)(1), 42.104. A petition that fails to name all

RPIs cannot be considered, *Corning Optical Commc'ns RF, LLC v. PPC*

Broadband, Inc., IPR2014-00440, Paper 68 at 23-24 (PTAB Aug. 18. 2015)

(precedential except § II.E.1); EX2024, 1, and thus should be denied.

“Determining whether a non-party is a ‘real party in interest’ ... takes into account both equitable and practical considerations, with an eye toward determining whether the non-party 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) (“*AIT*”). Factors relevant for evaluating whether a party is an unnamed RPI include: (i) the relationship between the petitioner and the unnamed party; (ii) the unnamed party’s “interest in” and “benefit from” the IPR; (iii) whether petitioner can be said to be representing that interest; and (iv) whether the unnamed party desired review of the patent. *See RPX Corp. v. Applications in Internet Time, LLC*, IPR2015-01750, Paper 128 at 10-11 (PTAB Oct. 2, 2020) (precedential) (“*RPX*”) (listing factors).

“AIA proceedings should not be used by foreign adversaries,” like Samsung, “to harass American patentees,” like Netlist. EX2024, 4. Samsung, who has twice been found to willfully infringe Netlist patents, has repeatedly used the PTAB to attempt to avoid paying a fair price for its unauthorized use of Netlist’s patented technology. *See* Netlist Discretionary Denial Brief (“DD Br.”), Paper 6, at 5-6. Here, Samsung again attempts to avail itself of review before the PTAB, but

violates its statutory and regulatory obligation to name all RPIs in its Petition; namely, its subsidiary and DJ co-plaintiff SEA and its customer and DJ co-plaintiff Avnet. The Director should apply *Corning* and deny institution.

A. Relevant Litigation History

In May 2025, Netlist filed suits against Samsung Electronics Co., Ltd (“SEC”); Samsung Electronics America, Inc. (“SEA”), and Samsung Semiconductor, Inc (“SSI”) (25-cv-00557) and Micron (25-cv-00558) in EDTX. In July 2025, Netlist amended its complaint to assert the ’731 patent and add Samsung’s customer Avnet as a defendant. EX2013. The -557 and -558 cases were consolidated for pretrial purposes. EX2011; EX2013. Trial is set for March 15, 2027. EX2012, 1. In July 2025, the same three Samsung entities (SEC, SEA, and SSI) filed a proposed amended complaint in the District of Delaware (DDE) for declaratory judgment of non-infringement of the ’731 patent and added Avnet as a fourth DJ plaintiff.¹ EX2025.

In September 2025, Netlist filed an ITC complaint against the three Samsung entities (SEC, SEA, and SSI) and certain of its customers asserting six patents, including the ’731 patent. EX2015. Of the six asserted patents, the PTAB has upheld the validity of three of the patents; Samsung was the petitioner in two

¹ Samsung filed the Petition in this IPR on August 29, 2025.

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).

B. SEA is an unnamed RPI.

SEA is an unnamed RPI: it “is a clear beneficiary that has a preexisting, established relationship with the petitioner[s]” SEC and SSI. *AIT*, 897 F.3d at 1351. Taking those requirements in reverse order, SEA indisputably has a preexisting, established relationship with both SEC and SSI. According to Samsung, “SSI is a wholly-owned subsidiary of SEA, which itself is a wholly-owned subsidiary of SEC.” EX2027, 1. Netlist alleges that SEA and SSI, “collectively with SEC, operate[] the Device Solutions division, which is involved in the design, manufacture, use, offering for sale and/or sales of” products that infringe the '731 patent. EX2013, 2-3 (¶¶4-5).

SEA would also plainly benefit from review and invalidation of the '731 patent. SEA is a co-defendant in both the EDTX and ITC cases in which Netlist has asserted infringement of the '731 patent. EX2013, 2; EX2015, 2. SEA is also a co-plaintiff in the Delaware DJ action, which is particularly telling because

(i) Samsung had control over which parties to name and chose to include SEA and

(ii) in doing so, Samsung represented to the DDE court that “[a]n immediate, real, and justiciable controversy exists between Samsung [including SEA] and Netlist as to whether Samsung has infringed the ’731 patent.” EX2025, 5 (¶17). Given SEA’s involvement in the EDTX and ITC cases, SEA would clearly benefit from the expedited review afforded by the IPR process, which applies a more favorable standard of review than district court litigation (preponderance vs. clear and convincing) and could allow Samsung to avoid damages and injunctive relief in other fora. And SEA’s *voluntary* involvement in the Delaware DJ action confirms that it has a significant stake in the outcome of this IPR.

The relevant *RPX* factors also show that SEA is an unnamed RPI. As to (i), SEA is a subsidiary of SEC and parent of SSI, and therefore clearly has a relationship with both Samsung entities. As to (ii), SEA’s involvement in *three* co-pending litigations demonstrates it has a significant stake and would benefit from a favorable outcome in this IPR. As to (iii) and (iv), SEC (as parent) and SSI (as subsidiary) are plainly representing the interests of SEA—in particular, its interest in avoiding liability for infringement by attempting to invalidate the asserted patent. *See RPX*, IPR2015-01750, Paper 128 at 27.

That Samsung has moved to dismiss SSI and SEA from the EDTX case for alleged improper venue does not change the RPI analysis. *See* EX2026. The issues

of whether venue is proper in EDTX and whether SEA is an RPI to this proceeding are different legal and factual analyses. Venue is governed by 28 U.S.C. § 1400(b), which asks “where the defendant resides, or where the defendant has committed acts of infringement and has a regular and established place of business.” RPI, by contrast, “takes into account both equitable and practical considerations, with an eye toward determining whether the non-party is a clear beneficiary that has a preexisting, established relationship with the petitioner.” *AIT*, 897 F.3d at 1351. The RPI analysis is not limited to a specific district court venue, such as EDTX. And thus even if venue is not properly sited for a given defendant, it does not follow that the defendant fails to qualify as an RPI.

SEA is a perfect example. In its motion to dismiss, Samsung raises three arguments: (1) neither SSI nor SEA resides in Texas, (2) SSI has no regular and established place of business in EDTX, and (3) Netlist fails to plausibly allege an act of infringement by SEA in EDTX. EX2026, 6-11. Even if Samsung were to prevail on *all* three arguments, which it should not, SEA is still an RPI to this proceeding. Samsung’s first two arguments are geographically limited to Texas and thus have no bearing on the RPI inquiry. Its third argument is limited to *SEA*’s alleged non-infringement. Even if SEA does not infringe in EDTX, which Netlist does not concede, Samsung’s argument does not extend to SEC and SSI. Because SEA has preexisting, established relationships with both, the RPI inquiry is still at

issue in light of the EDTX case against SEC and SSI. And, if there were any doubt, the Delaware DJ action and the ITC case confirm that SEA is an unnamed RPI.

Finally, Samsung is the leading petitioner in AIA challenges and has named SEA as an RPI on close to 800 petitions. EX2020, 48; EX2028. Samsung knew or should have known the requirement for naming all RPIs and has no excuse for failing to do so here.

C. Avnet is an unnamed RPI.

Avnet is also an unnamed RPI: it “is a clear beneficiary that has a preexisting, established relationship with the petitioner[s]” SEC and SSI. *AIT*, 897 F.3d at 1351. Netlist’s complaint in the related EDTX litigation lists Avnet as a defendant. EX2013, 1. And in the Delaware DJ action—again, where the plaintiffs had control over the parties to name—they chose to file a proposed amended complaint to add Avnet as a plaintiff. EX2025. In that complaint, the plaintiffs (including SEC, SEA, SSI, and Avnet), acknowledge that Avnet is a Samsung customer. EX2025, 2.

Similar to the analysis for SEA, the *RPX* factors demonstrate Avnet is an unnamed RPI. It has an established relationship to Petitioners (customer). It has a clear “interest in” and “benefit from” this IPR (avoiding liability for alleged infringement). Petitioners, as Avnet’s supplier, are representing Avnet’s interest. And Avnet clearly desires review of the ’731 patent, as evidenced by the

declaratory judgment action in which Avnet is a named plaintiff. This last fact is particularly damning: Avnet, as a named plaintiff to the declaratory judgment, certified *collectively* with Samsung that it has an “immediate, real, and justiciable controversy” as to whether it infringes the ’731 patent and made no attempt to establish its own, separate reasons for standing. EX2025, 5. Avnet is thus plainly coordinating with Samsung on its attempt to invalidate the claims. Therefore, Petitioners violated the statute and rules by failing to name Avnet as an RPI.

D. The Director should deny the Petition.

The Petition is defective because it fails to name all RPIs. *Corning*, IPR2014-00440, Paper 68 at 23-25. The correct remedy in this case is to terminate the proceeding.

Board precedent from prior administrations has allowed petitioners to correct petitions that fail to name an RPI without any consequence, such as without altering the filing date. *See Adello Biologics LLC v. Amgen Inc.*, PGR2019-00001, Paper 11 (PTAB Feb. 14, 2019) (precedential) (allowing correction while maintain filing date); *Proppant Express Inv., LLC v. Oren Techs., LLC*, IPR2017-01917, Paper 86 (PTAB Feb. 13, 2019) (precedential) (same). *Corning* says otherwise, listing a host of cases that were terminated for failure to name all RPIs and rejecting the petitioner’s request to correct without altering the filing date. IPR2014-00440, Paper 68 at 23-25. To the extent *Adello* and *Proppant* are

inconsistent with *Corning*, they should be de-designated and put to pasture.

Samsung should not be permitted to correct its Petition at this stage. First, no good cause exists. Samsung knew that SEA was co-defendant in the EDTX litigation and a co-plaintiff in the Delaware DJ action in July 2025—long before it filed the Petition at the end of August 2025. It simply chose not to list SEA here, despite the statutory and regulatory obligation to do so. Samsung also did not seek leave to correct its Petition when the Director designated *Corning* precedential, despite filing petitions as recently as November 20, 2025, that list SEA as an RPI. *See* IPR2026-00116, -00117. There is no excuse.

Second, it is bad policy to allow a petitioner to correct its petition, which would circumvent the statute and invite gamesmanship. Congress clearly stated a petition may only be considered if the petition identifies all real parties in interest, which is echoed in the PTAB regulations. 35 U.S.C. § 312(a)(2); 37 C.F.R. 42.104. Allowing a petitioner to correct a petition by adding an unnamed RPI would impart no real consequence for failure to follow these requirements.

Worse yet would be to change the filing date and restart the proceeding, if even possible. This would be grossly unfair to a patent owner, such as Netlist, because it would allow the petitioner to see all of the patent owner's arguments (including discretionary briefing) before the proceeding was restarted. That is, it would permit the petitioner a second bite at the apple and open the door to road

mapping based on all the arguments that a patent owner included in its discretionary denial briefing and preliminary response. Further, it would drive up costs to the patent owner because the patent owner would have to expend resources to defend itself again. Because circumstances that may affect the analysis (particularly on discretionary issues) will have changed based on any new later filing date, simply relying on the already-filed briefing would not be sufficient.

Moreover, in this case, the ITC is already projected to complete its initial determination *months* before the Board's *original* final written decision. DD Br., 13-14. A clock reset would significantly increase this time and clearly be contrary to the purpose of the AIA's objective to provide an effective and efficient alternative to litigation. *Accord NHK Spring Co., Ltd. v. Intrix-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (precedential).

In sum, the Director should deny the Petition because it fails to name all RPIs.

IV. SAMSUNG ADVANCES INCONSISTENT CLAIM CONSTRUCTIONS AT THE BOARD AND THE DISTRICT COURT.

The Director should deny institution because Samsung presents different claim construction positions between its Petition before the Board and its invalidity contentions in the EDTX case. Specifically, Samsung argues in its IPR Petition that the Board should apply the plain and ordinary meaning to the claims, while it argues in its EDTX invalidity contentions that the sole independent claim, and

several dependent claims, are indefinite. Samsung did not explain why it took inconsistent positions in the different cases.

Nor did Samsung seek leave to explain the inconsistencies after the Director designated *Revvo* precedential and *Tesla* informative about a month ago. *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 (PTAB Nov. 3, 2025) (precedential); *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18 (PTAB Nov. 5, 2025) (informative). Both of these decisions are highly relevant. *Tesla*, in particular, presents a similar situation as here, where a petitioner asserted the plain and ordinary meaning of challenged claims in an IPR proceeding after asserting the same claims were indefinite in district court. As in both *Revvo* and *Tesla*, the Petition should be denied.

Rules 104(b)(3) and 104(b)(4) require a petitioner to explain “how the challenged claim is to be construed” and “how the construed claim is unpatentable.” 37 C.F.R. §§ 42.104(b)(3)-(4). “The Board’s claim construction rules are designed to ensure that the Board correctly construes claim terms and to minimize inconsistency in claim construction between forums.” *Revvo*, IPR2025-00632, Paper 20 at 4. A petitioner that advances different claim construction positions in different fora needs to explain why those different positions are warranted. *Id.* at 3-5. That a petitioner “cannot raise indefiniteness challenges in an *inter partes* review is not a sufficient explanation” because such a statement

amounts to an assertion that a petitioner should be permitted to raise inconsistent invalidity challenges. *Tesla*, IPR2025-00340, Paper 18 at 3-4.

Samsung advances different claim construction positions in its IPR and in district court. In EDTX, Samsung contends independent claim 1 and three dependent claims are indefinite. EX2016, 321-324. Specifically, Samsung asserts the following claim terms listed in the table below are indefinite in whole, in part, or in combination.

Relevant Claim(s)	Term
1[e][1]	“each circuit of the at least one circuit further comprising a set of correction circuits, each correction circuit of the set of correction circuits being configured to make corrections in one or more signals transmitted between a respective port connection of the first set of port connections and a corresponding port connection in the second set of port connections”
14	“at least one circuit is configured to improve signal integrity in signals transmitted between the at least one connector and the plurality of memory devices”
15	“at least one circuit is configured to improve timing of signals transmitted between the at least one connector and the plurality of memory devices”
16	“at least one circuit is configured to improve power consumption by signals transmitted between the at least one connector and the plurality of memory devices”

EX2016, 322.

Samsung asserts in EDTX that these claims “fail to inform those skilled in the art about the scope of the invention.” EX2016, 322. Yet, Samsung apparently has had no trouble understanding the scope of these claims for purposes of

mapping them to the prior art in this proceeding. Samsung makes no attempt to reconcile the differences in its claim construction positions or otherwise explain its inconsistencies, contrary to holdings in *Revvo* and *Tesla*. Indeed, its constructions are irreconcilable.

Moreover, Samsung's attempt to argue different claim constructions undermines the integrity of the patent system. "Allowing a petitioner to advance a claim construction before the Board when that petitioner has made inconsistent indefiniteness arguments in district court fails to further, but instead detracts from, the Office's goal of 'providing greater predictability and certainty in the patent system.'" *Tesla*, IPR2025-00340, Paper 18 at 4 (citations omitted). The impact on the Board when a petitioner takes inconsistent positions cannot be understated. As one panel recently asked, "[i]f, according to Petitioner many limitations in [the claims] are indefinite then how does Petitioner propose that the Board construe such limitations to assess Petitioner's invalidity challenges?" *Am. Airlines, Inc. v. Intellectual Ventures I LLC*, IPR2025-01055, Paper 11 at 13 (PTAB Nov. 21, 2025). To that question, Samsung provides only silence in its Petition, rather than fulfilling its obligation to clearly explain how the challenged claims are to be construed. *See* 37 C.F.R. § 42.104(b)(3). And Samsung should not have left it to Netlist to inform the Board of Samsung's different claim constructions. *Accord Am. Airlines*, IPR2025-01055, Paper 11 at 13 (citing 37 C.F.R. § 42.11).

In sum, the Director should deny the Petition because Samsung advances inconsistent claim constructions in its IPR and district court contentions.

V. THE PETITION FAILS TO DEMONSTRATE A REASONABLE LIKELIHOOD THE CLAIMS WOULD HAVE BEEN OBVIOUS.

In addition to the deficiencies identified above, the Petition's obviousness Grounds fail to demonstrate a reasonable likelihood the claims are unpatentable. As a threshold matter, Samsung argues that prior Board decisions directed to other Netlist patents demonstrate that the claims of the '731 patent are invalid. Pet., 21-26. This argument has no merit because none of the prior Board decisions were directed to patents in the '731 patent family—the claims at issue in those IPRs were materially different than the claims of the '731 patent and Samsung has not shown otherwise.

A. Samsung's challenge to certain claim elements is based solely on unsupported attorney argument because Exhibit 1093 is not sworn testimony that complies with Rule 42.53(a).

Samsung's expert, Dr. Wolfe, addresses only a subset of the claim elements in his Declaration. *See* EX1003, ¶125 ("In the paragraphs below, I focus on providing context and technical explanations related to specific limitations."). Instead of addressing all elements, he appears to refer to Exhibit 1093,² which is a

² The declaration cites to Exhibit 1095, but that exhibit does not exist. Exhibit 1093 appears to be the correct exhibit number as it is the only exhibit with such a

53-page, unsigned “claim chart” for both Grounds presented in the Petition. *Id.* Dr. Wolfe mentions the chart only once (in ¶125) and does not even attempt to incorporate it by reference into his Declaration.³

The Director and the Board should give no weight to Exhibit 1093. Rule 42.53(a) requires that “[u]ncompelled direct testimony must be submitted in the form of an affidavit.” 37 C.F.R. § 42.53(a). Exhibit 1093 is not in the form of an affidavit or declaration. More critically, it lacks a perjury statement and is unsigned. Therefore, it is not evidence in the form of sworn testimony that could support Samsung’s obviousness challenges.

As a result, Samsung’s challenge to certain claim elements is based solely on attorney argument—which “is not evidence.” *Icon Health & Fitness, Inc. v. Strava, Inc.*, 849 F.3d 1034, 1043 (Fed. Cir. 2017). Addressing claim 1, for example, Samsung alleges that Ellsberry *renders obvious* elements 1.b, 1.d, and 1.f.1. Pet., 60-61, 64-65, 73-74. But Dr. Wolfe does not address claim elements 1.b, 1.d, and 1.f.1 in his Declaration, even though the challenge relies on an obviousness analysis for these limitations. Nor does he address dependent claims 5, 8-9, 11-13,

claim chart.

³ To the extent Dr. Wolfe’s statement in ¶125 is read to incorporate Exhibit 1093 into his Declaration, that would violate Rule 42.6(a)(3).

and 17. Accordingly, Samsung's arguments with respect to these elements and claims amount to nothing more than attorney argument, which is insufficient to satisfy the threshold for institution.

B. Samsung fails to address known secondary considerations of non-obviousness, including its own licensing activities.

Samsung's obviousness challenges are incomplete, and thus should be denied, because Samsung fails to address known secondary considerations of non-obvious, including its own licensing activities related to the '731 patent. Secondary considerations "may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art was not." *Apple Inc. v. Samsung Elecs. Co., Ltd.*, 839 F.3d 1034, 1052-53 (Fed. Cir. 2016) (en banc) (quoting *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538-59 (Fed. Cir. 1983)). Evidence of secondary considerations "must be considered in every case where present," *Apple*, 839 F.3d at 1048, and may be "crucial in avoiding the trap of hindsight ...," *Leo Pharm. Prods., Ltd. v. Rea.*, 726 F.3d 1346, 1358 (Fed. Cir. 2013).

Licensing is one such secondary consideration that must be considered, where present, when evaluating obviousness. *See Ancora Techs., Inc. v. Roku, Inc.*, 140 F.4th 1351, 1362 (Fed. Cir. 2025) (quoting *LaserDynamics, Inc. v. Quanta Comput., Inc.*, 694 F.3d 51, 79 (Fed. Cir. 2012) for the proposition that "[a]ctual licenses to the patented technology are highly probative ... because such actual

licenses most clearly reflect the economic value of the patented technology in the marketplace.”). Unlike products, “[l]icenses to the challenged patent ... do not require a nexus with respect to the specific claims at issue, nor does our nexus law require that a particular patent be the only patent being licensed or the sole motivation for entering into a license.” *Ancora Techs.*, 140 F.4th at 1362.

The Board has “cautioned petitioners in prior proceedings that petitions may be denied if they do not address known evidence of secondary considerations.” *Stryker Corp. v. KFX Medical, LLC*, IPR2019-00817, Paper 10 at 28-29 (PTAB Sept. 16, 2019); *see id.*, 29 (collecting Board decisions issued between 2013-2017); *see also Gilead Sciences, Inc. v. The United States of America, Represented by the Secretary of the Department of Health & Human Services*, IPR2019-01453, Paper 14 at 26-30 (PTAB Feb. 20, 2020) (finding that “Petitioner’s failure to persuasively address the [unexpected results presented during prosecution] in its Petition means Petitioner falls short of its burden to establish a reasonable likelihood of success in prevailing on its challenge”).

Samsung knew of but failed to address in its obviousness Grounds the licensing activities between (1) itself and Netlist and (2) Netlist and SK hynix.

1. Samsung licensed Netlist's portfolio in 2015.⁴

Samsung licensed Netlist's portfolio, including the '731 patent, until July 2020. Specifically, on November 12, 2015, Netlist and Samsung entered into a Joint Development and License Agreement ("JDLA") under which Netlist granted Samsung a license to its intellectual property, including Netlist's patents (including the parent patents of the '731 patent), continuations, and pending applications (such as Patent No. Application No. 14/715,491, which issued as the '731 patent on July 17, 2018). EX2001, 1-2, 8.

The parties entered into this agreement to jointly develop certain DRAM technologies. Indeed, 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, 5th generation (DDR5) memory and high bandwidth memory (HBM). EX2015, 7.

As the JDLA indicates, Netlist and Samsung concurrently entered into collateral agreements, including an "Intellectual Property Security Agreement." EX2006, 5-16. Under the Intellectual Property Security Agreement, Netlist granted Samsung a security interest in Netlist's patents and patent applications, including

⁴ Netlist's Brief on Discretionary Denial Brief (Paper 6) provides additional details of the history between Samsung and Netlist.

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 application 14/715,491—the application that issued as the ’731 patent. EX2006, 15. The agreement required that Netlist “[p]rotect, defend, and maintain the validity and enforceability” of the assets. EX2004, 8.

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. *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.⁵ EX2009.

⁵ 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.

2. SK hynix licensed Netlist's portfolio in 2021.

In 2021, SK hynix licensed Netlist's patent portfolio (including the '731 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.

* * *

Samsung plainly knew of its own licensing activities with Netlist. It also knew that SK hynix took a license to Netlist's portfolio. EX2030, 689:10-24 (testimony on April 18, 2023, in prior litigation between Netlist and Samsung). Because such known secondary-consideration evidence must be considered when evaluating obviousness, Samsung's fail to address this evidence is fatal to its obviousness challenges. Accordingly, the Director should deny institution.

VI. THE PETITION VIOLATES THE BOARD'S RULES AND IS FACIALLY DEFICIENT.

Samsung takes a number of shortcuts in its Petition that violate the Board's rules and expose fatal substantive deficiencies that warrant denying institution.

A. The Petition does not identify the evidence relied upon in its challenges with particularity, as required.

Samsung fails to identify its obviousness challenges "with particularity." 35 U.S.C. § 312(a)(3). First, the Petition presents Grounds 1 and 2 as one jumbled

section, with no attempt to distinguish its arguments. *See Pet.*, 58-105. Rather, it leaves to the Board and Netlist to puzzle out the differences between the challenges and why Samsung added the additional reference to Ground 2.

Next, the Petition often presents conclusory statements with little to no explanation on how the cited evidence supports the assertion. For example, in the analysis of limitation 1.e.1, the Petition makes a number of conclusory assertions that Ellsberry teaches its signal drivers correct read and write data signals but provides no support in Ellsberry for these purported teachings. *See Pet.*, 67. As another example, the Petition makes a conclusory assertion, without support in Ellsberry, that Ellsberry recognizes “impedance control should be handled at the Switch ASIC level rather than passing the memory controller’s impedance matching instructions to the memory device.” *See Pet.*, 69-70. These are just a few examples; there are many others.

The Director should reject these arguments because they are insufficient to satisfy Petitioner’s burden of persuasion. *See Parus Holdings, Inc. v. Google LLC*, 70 F.4th 1365, 1371 (Fed. Cir. 2023) (noting that a party’s burden “cannot be met simply by throwing mountains of evidence at the Board without explanation or identification of the relevant portions of that evidence”); *see also* 37 C.F.R. § 42.104(b)(4) (a petition “must specify where each element of the claim is found in the prior art patents or printed publications relied upon.”). Such cursory and

conclusory analysis falls well short of Petitioner’s obligation to perform reasoned analysis—based on the references asserted in its challenges. Because this deficiency is replete throughout the entire Petition, the Director should deny institution.

B. Samsung improperly relies on incorporation by reference from prior Board decisions to support its challenges.

The Petition’s use of incorporation by reference violates the Board’s Rules and fails to provide Patent Owner and the Board with adequate notice of Petitioner’s patentability challenges. “[T]he expedited nature of IPRs bring with it an obligation for petitioners to make their case *in their petition* to institute.”

Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd., 821 F.3d 1359, 1369 (Fed. Cir. 2016) (emphasis added). To do so, the petition must identify, “in writing and *with particularity*, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3) (emphasis added); *see also DeSilva v.*

DiLeonardi, 181 F.3d 865, 866-67 (7th Cir. 1999) (incorporation “by reference amounts to a self-help increase in the length of the [] brief” and “is a pointless imposition on the court’s time. A brief must make all arguments accessible to the judges, rather than ask them to play archeologist with the record.”). The Board should not consider any arguments that are not presented in the petition. *Cisco Sys., Inc. v. C-Cation Techs., LLC*, IPR2014-00454, Paper 12 at 10 (PTAB Aug.

29, 2014) (“[W]e will not consider arguments that are not made in the Petition, but are instead incorporated by reference”).

In its challenges, Samsung relies heavily on incorporating by reference from prior Board decisions on Netlist patents that are not in the '731 patent family (and other evidence in the record) instead of providing fulsome explanations of how the combinations of (i) Ellsberry and Dour and (ii) Elssberry, Dour, and Abadeer allegedly render the challenged claims obvious. *See, e.g.*, Pet., 60-61 (addressing element 1.b), 62-64 (addressing element 1.c), 83-91 (addressing claims 6-8). At bottom, Samsung’s use of incorporation by reference and string citations to documents in other records skirts its obligation to perform reasoned analysis. Samsung’s reliance on prior decisions related to different claims and its failure to make the required necessary evidentiary showings in its Petition are fatal to its challenges. *See Canadian Solar Inc. v. Maxeon Solar Pte., Ltd.*, IPR2024-01039, Paper 13 at 26-28 (PTAB Jan. 14, 2025) (“Petitioner does not direct us to any authority establishing that it may rely on findings of ... a Board decision involving different claims from a different patent application to satisfy its evidentiary burdens in this proceeding.”). Thus, the Director should deny institution.

C. The Petition violates the Board’s word count limit.

Trying to pack in too much, Samsung’s Petitions unsurprisingly violate the Board’s rules on word count limits. An IPR petition is limited to 14,000 words. 37

C.F.R. § 42.24(a)(1)(i).

In this proceeding, Samsung's certification of compliance indicates that the Petition contains 13,958 words and complies with the Board's rule. Pet., 108. However, the actual word count of the Petition is 14,315 words, including 318 words in annotations. EX2029. Samsung similarly violated the word count in its recent IPR and PGR Petitions against Netlist's 12,308,087 patent. *See Samsung Elecs. Co., v. Netlist, Inc.*, IPR2025-01402, Paper 12 at 40 (noting actual word count of IPR Petition is 14,214 words; actual word count of PGR Petition, which has a limit of 18,700 words, is 19,592 words, including 669 words in annotations).

Samsung has a history of disregarding this forum's rules. For example, in the final written decision in a prior IPR, the Board required Samsung to file a revised Reply because of its attempted circumvention of the word count rules. *Samsung Elecs. Co., Ltd. v. Netlist, Inc.*, IPR2023-00847, Paper 42 at 70-71 (PTAB Dec. 10, 2024). The Board has also warned Samsung against impermissible incorporation by reference, which is another way of violating the word limit. *Samsung Elecs. Co., Ltd. v. Netlist, Inc.*, IPR2025-00001, Paper 17 at 25 ("Petitioner should be mindful going forward that we will not 'play archeologist with the record.'"). And the Board has also found Samsung engaged in "gamesmanship by using non-standard cites without spaces in an attempt to circumvent the word count requirement." *Samsung Elecs. Co., Ltd. v. Netlist, Inc.*,

IPR2022-00615, Paper 6 at 3 (PTAB July 6, 2022) (also finding the same gamesmanship in IPR2022-00639 and IPR2022-00711). The Board's rules clearly set forth that a petition will not be accorded a filing date until the petition complies with § 42.104 (which includes compliance with the word count limits set forth in § 42.24). 37 C.F.R. § 42.106. Rather than permitting Samsung to correct its petition when it repeatedly disregarded the Board's rule, institution should be denied.

VII. *CHEVRON* AND *DEEPER* FAVOR DENYING INSTITUTION.

The merits consideration phase includes determining whether the petition presents a sufficient number of grounds/challenges that meet the reasonable likelihood standard. Interim Process, § I.F. When “a petition meets the standards for institution in relation to fewer than all the challenges presented, or where deficiencies in the petition ... affect only a portion of the challenges presented, the [Board] will evaluate all the challenges and determine whether, in the interests of efficient administration of the Office and integrity of the patent system, the entire petition should be denied.” Trial Practice Guide, § II.D.3 (citing 35 U.S.C. §§ 316(b), 326(b); *accord Chevron Oronite Co., LLC v. Infineum USA L.P.*, IPR2018-00923, Paper 9 (PTAB Nov. 7, 2018) (informative); *Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7 (PTAB Jan. 24, 2019) (informative)).

As discussed throughout this Preliminary Response, the Petition suffers from numerous fatal deficiencies. Given these defects, institution of review should be denied even if some of the claims or grounds meet the standard for institution (which they do not). It would not be an efficient use of the Board’s valuable time and resources to institute review when resolution of this proceeding would be costly and time-consuming to address challenges that are flawed from the outset. *See* Interim Processes Memo, 3; 35 U.S.C. § 316(b).

VIII. CONCLUSION

Because the Petition suffers fatal procedural and substantive defects, the Director should deny institution.

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CERTIFICATE OF WORD COUNT (37 C.F.R. § 42.24(d))

1. This Patent Owner Preliminary Response complies with the type-volume limitation of 14,000 words, comprising 6,405 words, excluding the parts exempted by 37 C.F.R. § 42.24(a)(1).

2. This Patent Owner Preliminary Response complies with the general format requirements of 37 C.F.R. § 42.6(a) and has been prepared using Microsoft® Word in 14-point Times New Roman font.

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

I certify that the above-captioned **PATENT OWNER PRELIMINARY
RESPONSE UNDER 37 C.F.R. § 42.107(a)** and associated Exhibits 2024-2030
were served in their entireties on December 9, 2025, upon the following parties via
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