

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,

Petitioner,

v.

NETLIST, INC.,

Patent Owner

IPR2025-01431
Patent 10,025,731

**PETITIONER'S OPPOSITION
TO PATENT OWNER'S DISCRETIONARY DENIAL REQUEST**

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1002	File History of U.S. Patent No. 10,025,731 (Application No. 14/715,491), <i>available at</i> https://patentcenter.uspto.gov/applications/14715491/ifw/docs?application= >
1003	Declaration of Dr. Andrew Wolfe
1004	Curriculum Vitae of Dr. Andrew Wolfe
1005	U.S. Patent App. Publication No. 2006/0277355 by <u>Ellsberry</u> et al.
1006	U.S. Patent No. 7,024,518 to <u>Halbert</u> et al.
1007	U.S. Patent Application Publication No. 2006/0117152 to <u>Amidi</u> et al.
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1009	JEDEC Standard Double Data Rate (DDR) SDRAM Specification, <u>JESD79</u> (June 2000)
1010	JEDEC Standard 21-C, DDR SDRAM Registered DIMM Design Specification (January 2002)
1011	JEDEC Standard DDR2 SDRAM Specification, <u>JESD79-2B</u> (January 2005)
1012	Declaration of John J. Kelly Regarding Records of Joint Electron Device Engineering Council (JEDEC)
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1014	U.S. Patent No. 7,532,537 to Solomon et al.
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1033	U.S. Patent No. 7,945,793 to <u>Wilcox</u>
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1038	Applications Note: Understanding DRAM Operation, IBM (1996), downloaded from https://web.archive.org/web/20150619221528/https://compas.cs.stonybrook.edu/~nhonarmand/courses/sp15/cse502/res/dramop.pdf [EX2010 in IPR2022-00639]
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1044	First Amended Complaint, <i>Netlist, Inc. v. Samsung Electronics Co., Ltd. et al.</i> , No. 2:25-cv-00557 (E.D. Tex. filed July 8, 2025) (U.S. Patent No. 10,025,731)
1045	First Amended Complaint, <i>Netlist, Inc. v. Micron Technology, Inc.</i> , No. 2:25-cv-00558 (E.D. Tex. filed July 8, 2025) (U.S. Patent No. 10,025,731)
1046	Netlist’s infringement contentions against Samsung (Redacted Exhibit B-1) in <i>Netlist, Inc. v. Samsung Electronics Co., Ltd. et al.</i> , No. 2:25-cv-00557 (E.D. Tex. July 16, 2025) (U.S. Patent No. 10,025,731)
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1049	Declaration of Julie Carlson re: JEDEC Standard Double Data Rate (DDR) SDRAM Specification, <u>JESD79</u> (June 2000)
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1066	Final Written Decision, <i>Samsung Electronics Co., Ltd. et al. v. Netlist, Inc.</i> , IPR2022-00639, Paper 45 (PTAB Oct. 18, 2023) ('339 patent)

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1067	Decision Denying Patent Owner’s Request on Rehearing of Final Written Decision, <i>Samsung Electronics Co., Ltd. et al. v. Netlist, Inc.</i> , IPR2022-00639, Paper 48 (PTAB Feb. 9, 2024) (’339 patent)
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1081	U.S. Patent No. 8,756,364 (’364 patent)
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1083	U.S. Patent No. 8,250,295 to <u>Amidi et al.</u>
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1085	Netlist’s Technology Tutorial
1086	JEDEC Standard, FBDIMM: Advanced Memory Buffer (AMB), JESD82-20 (March 2007) (“JESD82-20”)
1087	DDR2 SDRAM datasheet (2006), <i>available at</i> https://web.archive.org/web/20060324202631/http://www.micron.com/products/dram/ddr2sdram/part.aspx?part=MT47H128M8BT-3 , https://web.archive.org/web/20060324085459/http://download.micron.com/pdf/datasheets/dram/ddr2/1GbDDR2.pdf

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1088	Declaration of Julie Carlson for JESD82-20
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1093	Invalidity claim chart by Dr. Andrew Wolfe
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1095	Netlist Form 10-K (Annual Report) for 2024, <i>available at</i> < https://investors.netlist.com/filings-financials/sec-filings >.
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1102	Final Written Decision, <i>Samsung Electronics Co., Ltd. v. Netlist, Inc.</i> , IPR2023-00454, Paper 45 (PTAB July 30, 2024) (U.S. Patent No. 11,093,417)

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1104	Notice of Oral Argument on December 5, 2025, <i>Samsung Electronics Co., Ltd. v. Netlist, Inc.</i> , No. 2025-1378 (Fed. Cir. Oct. 21, 2025) (IPR2023-00847 of U.S. Patent No. 10,268,608)
1105	Order Granting Motion to Stay, <i>Samsung Electronics Co., Ltd. et al. v. Netlist, Inc.</i> , No. 1:21-cv-01453 (D. Del. Dec. 1, 2023) (U.S. Patent No. 10,217,523)
1106	Samsung’s Motion to Dismiss for Improper Venue, <i>Netlist, Inc. v. Samsung Electronics Co., Ltd. et al.</i> , No. 2:25-cv-00557 (E.D. Tex. Nov. 24, 2025) (U.S. Patent No. 10,025,731)
1107	Micron’s Motion to Dismiss for Improper Venue, <i>Netlist, Inc. v. Micron Technology, Inc. et al.</i> , No. 2:25-cv-00558 (E.D. Tex. July 22, 2025) (U.S. Patent No. 10,025,731)
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1109	ITC, Notice of Receipt of Complaint, 90 Fed. Reg. 51,406 (Nov. 17, 2025), <i>available at</i> < https://www.federalregister.gov/documents/2025/11/17/2025-19973/notice-of-receipt-of-complaint-solicitation-of-comments-relating-to-the-public-interest >
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1112	Memorandum re: Director Institution of AIA Trial Proceedings (Oct. 17, 2025), <i>available at</i> < https://www.uspto.gov/subscription-center/2025/director-institution-aia-trial-proceedings >

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1115	Samsung Semiconductor, About Us, <i>available at</i> < https://semiconductor.samsung.com/about-us/locations/us/ >
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1117	Samsung Semiconductor, Inc., California Statement of Information (Apr. 15, 2025), <i>available at</i> < https://bizfileonline.sos.ca.gov/search/business >
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1122	Complaint, <i>Netlist, Inc. v. Samsung Electronics Co., Ltd. et al.</i> , No. 2:21-cv-00463 (E.D. Tex. filed Dec. 20, 2021) (accusing DDR5 RDIMMs, DDR5 SODIMMs, and DDR5 UDIMMs of infringement)

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1123	CPC Classification G06F (Electrical Digital Data Processing), <i>available at</i> https://www.uspto.gov/web/patents/classification/cpc/html/cpc-G06F.html >
1124	CPC Classification G11C (Static Stores), <i>available at</i> https://www.uspto.gov/web/patents/classification/cpc/html/cpc-G11C.html >
1125	Class 326 (Electronic Digital Logic Circuitry), <i>available at</i> https://www.uspto.gov/web/patents/classification/uspc326/sched326.htm >
1126	Samsung investments in the United States, <i>available at</i> https://semiconductor.samsung.com/sas/company/taylor/ >
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, <i>available at</i> 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

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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
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

I. INTRODUCTION

Netlist's request for discretionary denial ("DD Req.") should be denied.

The Examiner's egregious material errors during prosecution weigh strongly against discretionary denial. The Examiner ***completely failed*** to search the prior art for the key limitation in the '731 patent — an "impedance matching" circuit in limitations [1.e.2] and [1.f.2] — because he repeatedly only searched for the misspelled word "impedence," and he never searched the classes specifically devoted to "impedance matching" circuits. The Examiner also erred by searching only for "ranks" without also searching for "banks," which was another term under the relevant JEDEC standards used to refer to the same thing as "ranks." As a result of these searching errors, the Examiner never found the key references in the Petition that clearly invalidate all claims (Dour and Ellsberry), and instead he allowed the claims without a single rejection. Netlist is therefore completely wrong that this was a "high quality" examination. DD Req. 16–17.

Samsung's extensive "settled expectations" also weigh against discretionary denial. Four years ago, after the '731 patent issued, Netlist accused Samsung's products of infringing a different patent (the '918 patent), which Samsung invalidated with a Final Written Decision in IPR2022-00996. Now Netlist is asserting the '731 patent against the ***same*** products that were at issue in Netlist's lawsuit four years ago, upsetting Samsung's "settled expectations" with respect to

its products. Furthermore, Samsung’s successful challenge to the related ’339 patent — resulting in extensive factual findings estopping Netlist with respect to virtually every claim limitation in the ’731 patent — also created “settled expectations” for Samsung and weighs against discretionary denial here. *See POSCO Co. v. ArcelorMittal*, IPR2025-00370, Paper 10, at 2–3 (PTAB June 25, 2025) (Acting Director) (“settled expectations” for petitioner given “the Board previously determined related claims to be unpatentable”).

Netlist relies extensively on the “JDLA” agreement with Samsung in 2015 to try to show “settled expectations” in the ’731 patent, but the fact is that Netlist put the ’731 patent “in a drawer” soon after it issued in 2018. The reason why is clear: the Board repeatedly found related patents invalid in 2018, 2019, 2023, and 2024, creating an expectation that the ’731 patent would also be invalidated if it were ever asserted. So Netlist never did, until now, despite years and years of litigation against Samsung involving many other patents.

Netlist points to parallel proceedings in district court and the ITC, but this proceeding will beat those proceedings: The district court action will be stayed. 28 U.S.C. § 1659(a) (“shall stay”). The ITC action trails this proceeding because it was filed by Netlist in retaliation to this proceeding. Therefore, the ITC will defer to “the PTO’s role as the lead agency in assessing the patentability, or validity, of . . . issued claims,” thus avoiding inconsistency and promoting efficiency, *Certain*

Unmanned Aerial Vehicles and Components Thereof, Inv. No. 337-TA-1133, Comm’n Op., 2020 WL 5407477, at *21 (Sept. 8, 2020).

For these and many other reasons discussed below, trial should be instituted.

II. ARGUMENT

A. During prosecution of the ’731 patent, the Examiner materially erred during his search of the prior art — by misspelling “impedance,” by not searching the class specifically devoted to “impedance matching,” and by searching for “ranks” but not “banks” — and thus he never found the Dour and Ellsberry references in the Petition that clearly invalidate all claims

The Examiner’s egregious material errors during prosecution weigh strongly against discretionary denial. As explained below, the Examiner used the wrong keywords to search the prior art, so he never found the key references in the Petition that clearly invalidate all claims (Dour and Ellsberry), and instead he allowed the claims to issue without a single rejection.

Every claim of the ’731 patent requires an “impedance matching” circuit, which is found in limitations [1.e.2] and [1.f.2]. EX1001, 17:21, 17:27. During prosecution, the Examiner relied on those limitations to distinguish the prior art and to allow the claims without a single rejection. *See* EX1002, 105–09.

Incredibly, however, the Examiner ***completely failed*** to search the prior art for an “impedance matching” circuit because he repeatedly only searched for the misspelled word “impedence” (which unsurprisingly did not generate many hits):

EAST Search History (Prior Art)

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
L1	0	slect\$3 with rank and impedance with match\$3	US-PGPUB; USPAT	OR	OFF	2017/06/09 10:54
L2	0	select\$3 with rank and impedance with match\$3	US-PGPUB; USPAT	OR	OFF	2017/06/09 10:54

EX1002, 125 (annotated); *see also id.* 127–28, 132, 134–35, 230–32. If the Examiner had correctly spelled “impedance” there would have been hundreds of hits. *See* <<https://ppubs.uspto.gov/pubwebapp/>>.

The Examiner’s misspelled searches were material error. So too was failing to search the classes specifically devoted to “impedance matching”: G06F 13/4086 (“Bus ***impedance matching***, e.g. termination”) and 326/20 (“Bus or line termination (e.g., clamping, ***impedance matching***, etc.”)). *See* EX1123, 26; EX1125, 1. If the Examiner had searched those classes (or searched for “impedance”), he would have found the Dour reference (EX1018) that renders obvious all the claim limitations requiring “impedance matching.” *See* Pet. 32–36, 68–72 (limitation [1.e.2]), 74–77 (limitation [1.f.2]). Instead, the Examiner searched other classes and did not find the relevant prior art. *See* EX1001, 1 (G06F 12/1684, G06F 13/4027, G11C 5/02, G11C 5/06, G11C 8/18).

The Examiner also materially erred by only searching for the term “rank” without also searching for “bank,” the term used extensively by the primary reference in the Petition called Ellsberry (EX1005). *See* EX1002, 125, 127, 132,

134, 228–31. As the Board has repeatedly found in Final Written Decisions involving related patents, a POSITA would have been familiar with the JEDEC standards, *see* Pet. 27–28, which at the time used **both** the term “bank” (in the DDR1 standard) **and** the term “rank” (in the DDR2 and later standards) to refer to the same thing. *Compare* EX1009, 7 (“bank”), *with* EX1051, 6 (“Rank”), *and* EX1011, 6 (“Rank”); *see also* EX1041, 413 (explaining the relationship between “bank” and “rank”). Both the DDR1 and DDR2 standards were in force at the relevant time, so the Examiner missed material prior art, including Ellsberry, by not including the term “bank” in his search. *See* Pet. 3, 21–27, 29–32 (discussing Ellsberry). And the Board has repeatedly found that Ellsberry teaches “ranks” (despite using the word “banks”). *See* Pet. 64; EX1078, 38–39; EX1066, 33.

Netlist is therefore completely wrong that “[t]he Office committed no material errors during prosecution” and that this was a “high quality” examination. DD Req. 16–17. To the contrary, there were multiple material errors, as explained above. Those material errors weigh strongly against discretionary denial. *See, e.g., Microsoft Corp. v. ParTec Cluster Competence Ctr. GmbH*, IPR2025-00318, Paper 9, at 2–3 (PTAB June 12, 2025) (Acting Director) (“Petitioner provides persuasive evidence that the Office erred in a manner material to the patentability of the challenged claims by overlooking the teachings of [the prior art]”); *Eunsung Global Corp. v. HydraFacial LLC*, IPR2025-00445, Paper 14, at 2–3 (PTAB July

10, 2025) (Acting Director) (denying discretionary denial for a patent “issued in 2017” given that the “examiner overlooked certain teachings in [the prior art] that appear to disclose the allowable features of the claims”); *Xencor, Inc. v. Merus N.V.*, IPR2025-00604, Paper 12, at 2–3 (PTAB July 17, 2025) (Acting Director) (similar for patent “issued in 2016”); *Anthony Inc v. ControlTec LLC*, IPR2025-00559, Paper 12, at 2 (PTAB July 16, 2025) (Acting Director) (similar for patents “in force for approximately eighteen and seventeen years”).

In *Anthony*, for example, similar to here, “[t]he patent examiner issued a notice of allowance . . . as the first office action. Petitioner persuasively explains that the patent examiner erred by overlooking the teachings of [the prior art]. Although the challenged patents have been in force for approximately eighteen and seventeen years, Petitioner appears to show a material error by the Office, and it is an appropriate use of Office resources to review the potential error.” *Id.* (citation and footnote omitted).

B. Netlist’s second bite at the apple by asserting the ’731 patent against the *same* DDR5 products that Netlist accused of infringement *four years ago* upsets Samsung’s “settled expectations,” and weighs against discretionary denial, given that Samsung invalidated the previous Netlist patent asserted against those DDR5 products

By asserting the ’731 patent, Netlist is trying to take a second bite at the apple, upsetting Samsung’s “settled expectations,” which also weighs against discretionary denial here. ***Four years ago***, in December 2021, Netlist asserted a

different patent (the '918 patent) against Samsung's DDR5 products, specifically "DDR5 RDIMMs, DDR5 SODIMMs, DDR5 UDIMMs." EX1122, 39, ¶ 68.

Netlist did not assert the '731 patent (either against DDR5 or any other products).

In response, Samsung filed an IPR against the '918 patent, resulting in a Final Written Decision in IPR2022-00996 invalidating *all* claims, EX1098–99, thus creating "settled expectations" for Samsung with respect to its DDR5 products. *See* EX1113, 2 (identifying "[s]ettled expectations of the parties" as relevant).

Netlist is now upsetting Samsung's "settled expectations" by asserting the '731 patent against the *same* DDR5 products that were at issue in Netlist's lawsuit four years ago. *See* EX1046, 1; EX1044, 25, ¶ 53. Netlist's attempt to take a second bite at the apple, in violation of Samsung's "settled expectations," weighs against discretionary denial here.

C. Samsung's successful challenge against a related patent also created "settled expectations" for Samsung and weighs against discretionary denial here

Samsung's successful challenge to the related '339 patent also created "settled expectations" for Samsung and weighs against discretionary denial here. *See POSCO*, IPR2025-00370, Paper 10, at 2–3 ("Petitioner's arguments regarding settled expectations . . . tip the balance It is an appropriate use of Office resources to provide consistency and predictability to the public, and to ensure that

a patent applicant or owner does not take action inconsistent with the judgment in a prior Office proceeding. *See* 37 C.F.R. § 42.73(d)(3)”); *Nintendo Co. v. Resonant Sys., Inc.*, IPR2025-00680, Paper 18, at 3 (PTAB Aug. 14, 2025) (Acting Director) (“[I]n an inter partes review of a continuation patent of the challenged patent, the Board has determined claims that are substantially similar to the challenged claims to be unpatentable. . . . Although the challenged patent has been in force for more than ten years, creating strong settled expectations for Patent Owner, this does not overcome the aforementioned considerations that counsel against discretionary denial.”).

As explained in the Petition, the ’731 patent identifies the ’339 patent family as “related.” *See* Pet. 21 (citing EX1001, 1:29, 1:39-40); EX1065 (’339 patent, which is grandchild of ’185 patent). Over **three years** ago, Samsung filed an IPR against the related ’339 patent, resulting in a Final Written Decision invalidating **all** claims, based primarily on the Ellsberry reference, EX1066–67, which is the same primary reference here, *see* Pet. 3, 29 (citing Ellsberry, EX1005).

As explained in the Petition, Netlist is now estopped with respect to virtually every claim limitation in the ’731 patent in light of the Board’s previous factual findings about the Ellsberry prior-art reference. *See* Pet. 21–27. Given the ’339 Final Written Decision, Netlist is “precluded from taking action inconsistent with the adverse judgment.” 37 C.F.R. §42.73(d)(3); *SoftView LLC v. Apple Inc.*, 108

F.4th 1366, 1373 (Fed. Cir. 2024) (“[S]ection 42.73(d)(3) . . . ensur[es] the integrity of the proceedings before the PTO by preventing actions that would undermine the outcomes of those proceedings.”). Furthermore, Netlist is also “bound...by any subsidiary factual determinations that were actually litigated and essential to the judgment” in the prior proceedings. *Mobile Tech, Inc. v. InVue Security Prods. Inc.*, IPR2018-00481, Paper 29, at 18 (PTAB July 16, 2019); *see also B & B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 148 (2015) (following the Restatement); Restatement (Second) of Judgments §§13, 27.

These “settled expectations” for Samsung weigh against discretionary denial here. Netlist is trying to circumvent the Board’s Final Written Decision invalidating the ’339 patent by now asserting the related ’731 patent, contrary to Samsung’s “settled expectations.”

D. Netlist’s history of spending over \$100 million to harass Samsung with meritless litigation weighs strongly against discretionary denial here, and raises national security concerns about the source of Netlist’s funding

Netlist’s history of harassing Samsung with invalid patents weighs strongly against discretionary denial here. Over the past four years, Netlist has spent over \$100 million to harass Samsung with meritless litigation, as confirmed by Final Written Decisions in favor of Samsung invalidating all asserted claims in 7 of the 8 patents in the “multiple jury verdicts” cited by Netlist, *see* DD Req. 5 (citing EX2014, EX2017). *See* EX1066–67 (’339 patent), EX1097–99 (’918 and ’054

patents), EX1118–20 (’060 and ’160 patents), EX1078 (’912 patent), EX1102–03 (’417 patent). The 8th patent (the ’608 patent) is the subject of an ongoing *ex parte* reexam. See No. 90/015,449. And with respect to the alleged breach of the JDLA agreement, see DD Req. 4–5, the court awarded Netlist only \$1 in nominal damages, see EX2009.

Netlist’s lavish spending on patent litigation against Samsung, despite being a “small company,” DD Req. 2, raises significant questions about Netlist’s representation that it is the **only** real party in interest in this proceeding. See Paper 4; 37 C.F.R. § 42.8(a)(2), (b)(1). Over the past four years, Netlist has spent far more on litigation — over \$100 million — than its gross profits of \$21.7 million:

	<u>Netlist’s Finances</u>			
	<u>Gross Profit</u>	<u>R&D</u>	<u>IP Legal Fees</u>	<u>Net Loss</u>
2022:	\$11.9M	-\$10.6M	-\$20.4M	-\$33.4M
2023:	\$2.4M	-\$9.2M	-\$42.6M	-\$60.4M
2024:	\$2.9M	-\$8.1M	-\$38.0M	-\$53.9M
2025 (through Q3):	\$4.5M	-\$2.5M	-\$15.5M	-\$22.6M
Total:	\$21.7M	-\$30.4M	-\$116.5M	-\$170.3M

See EX1094, 53; EX1095, 59; EX1096, 6. Given Netlist’s lack of money, as shown above, clearly someone other than Netlist is funding the repeated assertion of invalid patents against Samsung, but Netlist has not identified who it really is. That raises national security concerns. The source of Netlist’s funding could have nefarious motives, including trying to hobble Samsung’s critical contributions to

this country's dominance in computing technology. Netlist concedes there are "important national security and economic interests," DD Req. 17–18, but ignores that Samsung's real party-in-interest includes a California corporation that has contributed billions to the U.S. economy over more than 30 years, *see* Pet. 1; EX1115–17, unlike Netlist which operates at a significant loss as shown above.

Netlist asserts that its licensee "SK hynix announced in 2024 that it will invest \$3.87 billion in a chip packaging facility in Indiana," DD Req. 18, but there is no evidence that SK hynix's planned facility in Indiana has any relevance to the '731 patent or to the DDR5 products that allegedly practice that patent. In any event, to the extent such investments are relevant, SK hynix's \$3.87 billion investment in Indiana is peanuts compared to Samsung's \$47 billion invested in the United States, with a \$17 billion minimum investment in advanced chip production in Texas that will create 1,800 jobs. *See* EX1126 ("Everything's Bigger in Texas").

The national security and economic interests favor Samsung, not Netlist, and weigh against discretionary denial.

- E. Netlist cannot show "settled expectations" given that Netlist deliberately placed the '731 patent "in a drawer" from its issuance in 2018 until July 2025 given Final Written Decisions invalidating the related '364 patent in 2018, the related '185 patent in 2018, the related '907 patent in 2019, the related '339 patent in 2023, and the related '912 patent in 2024**

Netlist incorrectly asserts that it has "settled expectations" because the '731

patent “has been in force for over seven years” (i.e., since 2018), *see* DD Req. 7, and because of Netlist’s portfolio license with SK hynix in 2021 and its “JDLA” agreement with Samsung in 2015, *see id.* 7–9.

To the contrary, Netlist deliberately placed the ’731 patent “in a drawer” shortly after it issued in 2018 because patents related to the ’731 patent were repeatedly invalidated in response to IPRs filed by SK hynix and Samsung, *see* Pet. 21–22 (citing EX1001, 1:19–:44), including:

- U.S. Patent No. 8,756,364 in 2018 (EX1080, by SK hynix)
- U.S. Patent No. 8,516,185 in 2018 (EX1053, by SK hynix)
- U.S. Patent No. 9,606,907 in 2019 (EX1062, by SK hynix), based on Ellsberry
- U.S. Patent No. 10,949,339 in 2023 (EX1066, by Samsung), based on Ellsberry
- U.S. Patent No. 7,6519,912 in 2024 (EX1078, by Samsung), based on Ellsberry

Given this lengthy history finding related patents invalid, and given the extensive factual findings about Ellsberry estopping Netlist with respect to virtually every claim limitation in the ’731 patent, *see* Pet. 21–27, the only party with “settled expectations” is Samsung, not Netlist, as discussed above (pp.7–9). *See, e.g., Celgene Corp. v. Peter*, 931 F.3d 1342, 1362–63 (Fed. Cir. 2019) (“For

forty years, patent owners have . . . had the expectation that the PTO could reconsider the validity of issued patents . . . applying a preponderance of the evidence standard.”).

Netlist relies extensively on the “JDLA” agreement with Samsung to try to show “settled expectations,” *see* DD Req. 2–4, 8–10, but Netlist asserts it “terminated the JDLA on July 15, 2020,” DD Req. 4, after which Netlist never accused Samsung of infringing the ’731 patent until now (no doubt given the glaring invalidity problems as confirmed by the Final Written Decisions against related patents discussed directly above). Instead Netlist asserted a different patent (the ’918 patent), and lost, creating “settled expectations” for Samsung, as discussed above (pp.6–7).

Finally, the egregious material errors by the Examiner during prosecution outweigh any alleged “settled expectations” by Netlist, as shown by the cases discussed above (pp.5–6).

F. The *Fintiv* factors favor institution, given that this proceeding is far ahead of Netlist’s retaliatory ITC action

The *Fintiv* factors favor institution, contrary to Netlist’s arguments for discretionary denial in favor of the retaliatory ITC action it filed *after* Samsung filed this Petition, *see* DD Req. 10–16.

Factors 1–4: This proceeding is far ahead of Netlist’s retaliatory ITC action, so the ITC will defer to “the PTO’s role as the lead agency in assessing the

patentability, or validity, of . . . issued claims,” thus avoiding inconsistency and promoting efficiency. *Certain Unmanned Aerial Vehicles*, 2020 WL 5407477, at *21. Netlist’s arguments for Factors 1 and 4 about the lack of a “stay,” “inefficiency,” and “overlap” are thus incorrect. DD Req. 12–14, 14–16. Netlist incorrectly focuses on the ITC’s **initial** determination date, *id.* 13, contrary to the Board’s policy that it is “less likely to deny institution under *Fintiv* where the ITC **projected final determination** date is **after** the Board’s deadline to issue a final written decision,” EX1121, 2 (emphasis added), as is true here, as explained below. *See also RingConn LLC v. Ouraring, Inc.*, IPR2025-00412, Paper 11, at 2–3 (PTAB June 25, 2025) (Acting Director) (focusing on the date for “**conclusion** of the ITC investigation” (emphasis added)).

Factor 2 favors institution because the Final Written Decision here will easily beat the ITC and district court: The projected statutory deadline here is “March 9, 2027,” DD Req. 12, and likely much earlier given the new streamlined “summary notice to the parties granting institution,” EX1112, 2. Netlist’s retaliatory ITC action, in contrast, was only received three weeks ago, *see* EX1109–10, and has not been instituted (which normally takes 30 days, *see* 19 C.F.R. § 210.10(a)(1)), and thus is not expected to reach a Final Determination until at least May 21, 2027, *see* EX1111, 2 (18.2 months), and likely even later given the backlog from the government shutdown. The district court action will be

stayed, *see* 28 U.S.C. § 1659(a) (“shall stay”), and in any event has both a scheduled trial date of “March 15, 2027,” DD Req. 12, and an expected trial date of July 16, 2027, *see* EX1108, 35 (25.9 months); EX1083, that are ***after*** the statutory deadline here.

Netlist is therefore incorrect that “[t]he ITC is the fastest and most efficient forum.” DD Req. 10. The PTAB is, as explained above. And the same is true with respect to 4 of the other 5 patents in the ITC (all but the ’523 patent): The ’087, ’035, and ’366 patents are subject to petitions with an expected Final Written Decision date ahead of the ITC, meaning the ITC will defer to the PTAB as explained above. *See* PGR2025-00071 and IPR2025-01402 (’087 patent, March 4, 2027); IPR2026-00017 (’035 patent, April 29, 2027); PGR2026-00001 and IPR2026-00018 (’366 patent, May 20, 2027). The ’608 patent is the subject of an *ex parte* reexam, *see* No. 90/015,449, which was filed months before Netlist’s ITC action and “will be conducted with special dispatch,” 37 C.F.R. § 1.550(a), meaning it should also beat the ITC. Only the ’523 patent is not subject to a pending PTAB proceeding, but that patent has been stayed in district court ***for over two years*** (without Netlist filing an ITC action until now), EX1105, showing its lack of importance to the parties’ dispute.

Factor 3 also favor institution because the ITC action has not been instituted, and the district court actions are subject to pending motions to dismiss and will not

have a “Claim Construction Hearing” until at least September 25, 2026, *see* EX1106–07; EX2012, 3, making it highly likely that “at the time of the [PTAB’s] institution decision, the district court [and ITC will] not [have] issued orders related to the patent at issue in the petition, [which] weighs against exercising discretion to deny institution,” *Fintiv* at 10 (Factor 3).

Factors 5 and 6: Although Samsung is a defendant/respondent in the parallel proceeding (Factor 5), the merits of the Petition are strong given the egregious material errors by the Examiner discussed above (pp.3–6), which favors institution (Factor 6).

Furthermore, “[t]he large number and wide scope of the patents asserted in the district court [and ITC] litigation weighs against discretionary denial, as the Board is better suited to review a large number of patents involving diverse subject matter,” especially here where the Board has already invalidated related patents in all 5 patent families in the ITC. *Samsung Elecs. Co. v. Wilus Inst. of Standards & Tech. Inc.*, IPR2025-00933, Paper 11, at 3 (PTAB Oct. 10, 2025); *Am. Airlines, Inc. v. Intellectual Ventures I LLC*, IPR2025-00785, Paper 11, at 3 (PTAB Aug. 29, 2025) (Acting Director) (similar). The 5 patent families in the ITC, with diverse subject matter, are:

- The ’731 Patent: Netlist describes this patent as concerning a “programmable impedance mismatch circuit, to correct signals

transmitted to and from the module’s memory devices.” EX2015, 22, ¶ 59. The Board has already invalidated claims in five related patents, as discussed above (pp.11–13).

- U.S. Patent No. 12,308,087: Netlist describes this patent as concerning “stacked dies and interconnects that allows the memory to operate at high bandwidth while mitigating load issues.” EX2015, 27, ¶ 100. The Board has already invalidated 54 claims across two patents in this same family. *See* EX1118–20 (’060 and ’160 patents).
- U.S. Patent No. 12,373,366: Netlist describes this patent as concerning “circuitry that allows for power management on the memory modules themselves (as opposed to on the motherboard on which the memory modules are mounted).” EX2015, 21, ¶ 49. The Board has already invalidated 60 claims across two patents in this same family. *See* EX1097–99 (’918 and ’054 patents).
- U.S. Patent Nos. 10,268,608 and 9,824,035: Netlist describes these patents as concerning “memory modules that include ‘isolation devices’ (also called ‘data buffers’ or ‘buffer circuits’).” EX2015, 23, ¶ 70; *id.* 26, ¶ 90. The ’608 patent is the subject of an ongoing *ex parte* reexam, *see* No. 90/015,449, and the Board has already invalidated 20 claims in a patent in this same family, *see* IPR2022-

00711.

- U.S. Patent No. 10,217,523: Netlist describes this patent as concerning “memory modules that support two modes of operation (e.g., a testing mode and a normal operation mode).” EX2015, 24, ¶ 80. The Board has already invalidated 20 claims across three patents in this same family. *See* IPR2014-00970; IPR2017-00560; IPR2017-00562.

G. Netlist’s arguments improperly circumvent the Board

All of Netlist’s arguments to the Director improperly circumvent the “Board [which] institutes the trial on behalf of the Director.” 37 C.F.R. § 42.4(a); 77 Fed. Reg. 48,612, 48,616 (Aug. 14, 2012). This is especially true given Netlist’s improper attempt to circumvent the Board’s prior Final Written Decisions by asserting the ’731 patent despite being estopped with respect to virtually every claim limitation, as discussed above (pp.7–9).

III. CONCLUSION

Netlist’s discretionary denial request lacks merit. Trial should be instituted.

Dated: December 9, 2025

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CERTIFICATE OF COMPLIANCE

I hereby certify that this **Petitioner's Opposition to Patent Owner's Discretionary Denial Request**, excluding the parts of the brief exempted by 37 C.F.R. § 42.24, complies with the page limits provided by § III.C.iii of the Interim Director Discretionary Process, <<https://www.uspto.gov/patents/ptab/interim-director-discretionary-process>>, which states: "Effective for patent owners' discretionary denial requests due on or after September 1, 2025, a petitioner's opposition to the patent owner's discretionary denial brief is limited to 20 pages, regardless of when a patent owner files its brief."

Dated: December 9, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 9th day of December, 2025, **Petitioner's Opposition to Patent Owner's Discretionary Denial Request** was served by email on the following counsel for Patent Owner:

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