

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner

v.

NETLIST, INC.,
Patent Owner

Case IPR2026-00018
U.S. Patent No. 12,373,366

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

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Patent Trial and Appeal Board
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PATENT OWNER'S 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, 2015
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
2010-2013	<i>Intentionally Left Blank</i>
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	<i>Intentionally Left Blank</i>

Exhibit No.	Description
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 10, 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	<i>Intentionally Left Blank</i>
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> , IPR2024-00440, Paper 68 (PTAB Aug. 18, 2015) (except for § II.E.1),” Memorandum from Under Secretary of Commerce for Intellectual Property and Acting Director of the United States Patent Trademark Office John A. Squires, October 28, 2025
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	<i>Intentionally Left Blank</i>

Exhibit No.	Description
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	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)
2030-2039	<i>Intentionally Left Blank</i>
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 Elecs. Co., Ltd. v. Netlist, Inc.</i> , Appeal No. 25-1378 (Fed. Cir.), December 9, 2025
2042	<i>Intentionally Left Blank</i>
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
2044-2046	<i>Intentionally Left Blank</i>
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)
2049-2052	<i>Intentionally Left Blank</i>

Exhibit No.	Description
2053	Order Initiating <i>Sua Sponte</i> Director Review and Staying Proceeding, IPR2025-00145 (P.T.A.B. Dec. 22, 2025)
2054	Notice of Institution of Investigation, Inv. No. 337-TA-1472 (I.T.C. Dec. 29, 2025)
2055	Comparison of Claim 1 of U.S. Patent No. 12,373,366 with Claim 1 of U.S. Patent No. 11,232,054, Claim 1 of U.S. Patent No. 11,016,918, Claim 1 of U.S. Patent No. 8,874,831, and Claim 1 of U.S. Patent No. 8,301,833
2056	Petition for <i>Inter Partes</i> Review of U.S. Patent No. 11,232,054, IPR2022-00999 (P.T.A.B. May 17, 2022)
2057	Petition for <i>Inter Partes</i> Review of U.S. Patent No. 7,619,912, IPR2022-00615 (P.T.A.B. Feb. 17, 2022)
2058	Decision Granting Petitioner's Request on Rehearing of Final Written Decision, IPR2022-00236 (P.T.A.B. Aug. 16, 2023)
2059	Initial Determination Setting the Target Date, Inv. No. 337-TA-1472 (I.T.C. Jan. 14, 2026)
2060	Proposed Procedural Schedule, Inv. No. 337-TA-1472 (I.T.C. Jan. 14, 2026)

I. INTRODUCTION

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

1. Despite the patent's age, Netlist has developed settled expectations in the '366 patent, particularly with respect to Samsung. *First*, Netlist and Samsung entered into a Joint Development and License Agreement (JDLA) in November 2015 to jointly develop non-volatile dual inline memory module (NVDIMM) technology that is described in the '366 patent. Among other rights, the parties' agreement granted Samsung a license to and a security interest in Netlist's portfolio (including patents and applications in the '366 family) and an ownership stake in Netlist itself. *Second*, SK hynix licensed the '366 patent, which enhances Netlist's settled expectations. *Third*, Samsung monitored the application that issued as the '366 patent and knew of the art that it asserts in the Petition while the '366 patent was being examined. Samsung thus could have but chose not to make a third party submission during prosecution to present its obviousness theory to the Office. Instituting this IPR would disincentivize early submission of prior art to the Office during prosecution.

2. Netlist asserted the '366 patent against Samsung at the ITC (and in EDTX). Because the litigation involves other DRAM patents that Samsung cannot challenge at the PTAB, the ITC is a better forum to resolve the parties' dispute.

3. The ITC is scheduled to conduct its hearing (trial) and reach an initial determination (ID) before the Board's projected deadline for issuing a FWD.

Samsung has *not* stipulated not to pursue duplicative obviousness arguments before the ITC (or the district court) and in this IPR. Litigating the same issues in both fora would waste resources and risk inconsistent results.

4. Samsung's Petition fails to name all real parties in interest.

5. Section 325(d) favors denial because both parts of *Advanced Bionics* are satisfied: (1) the art was before the Office and (2) the Examiner did not commit any material errors.

6. The PTAB's evaluation of other patents in the '366 family does not demonstrate invalidity of the *claimed* subject matter because the '366 claims are patentably distinct and more detailed than its parent applications.

7. Denying institution would further the Administration's goal of promoting a strong domestic chip manufacturing industry.

8. Samsung improperly filed both an IPR and a PGR on the same patent. This lack of respect for Board procedures and limited resources is reason alone to deny this IPR (as the second ranked petition).

II. BACKGROUND

A. Netlist and Samsung were technology partners under a 2015 Joint Development and License Agreement (“JDLA”) to develop technology described in the ’366 patent.

Netlist is a small U.S. company based in Irvine, California that has made a name for itself as a market disrupter with its cutting-edge computer memory solutions. The ’366 patent, which traces its roots to a provisional application filed in June 2007, describes and claims such solutions: memory modules with *on-module* power management, which enables the precise voltage control and increased energy efficiency that is critical in modern DRAM memory modules. *See, e.g.*, EX1001, 25:23-26:57, FIG. 16. While having broad applicability, this power-management solution was used in Netlist’s NVDIMM product that is discussed in the ’366 patent. EX1001, 11:25-54; FIG. 3B, 306’.

On November 12, 2015, Netlist and Samsung entered into a JDLA under which the parties agreed (among other things) to jointly develop the NVDIMM product. EX2001, 6 (clauses 5.1- 5.2), 16-19. Samsung acknowledges it entered into the JDLA to develop NVDIMM technology. PGR2025-00071, Paper 11, 4.

Under the JDLA, Netlist also granted Samsung a license to its intellectual property, including patents, continuations, and pending patent applications. EX2001, 1-2, 8. Samsung alleges that the license included the ’366 patent. EX2025, 2 ¶2. In addition to NVDIMM, 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 an agreement for convertible note financing ("Purchase Agreement"), EX2001, 1, which was executed by Samsung's "venture investment arm": Samsung Venture Investment Corporation (SVIC). EX2005. The Purchase Agreement included sub-agreements, including: (1) a Stock Purchase Warrant ("Stock Warrant"); (2) a Senior Secured Convertible Promissory Note ("Promissory Note"); (3) a Security Agreement; and (4) an "Intellectual Property Security Agreement." EX2002; EX2003; EX2004; EX2006, 5-16.

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

Under the Intellectual Property Security Agreement, Netlist also granted Samsung a security interest in Netlist's patent assets. 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 agreement required that Netlist "[p]rotect, defend, and maintain the validity and enforceability" of the assets (including the '366 patent). EX2004, 8.

In short, via the November 2015 technology partnership, Samsung acquired a license to and a security interest in Netlist's IP portfolio (including the '366 patent that it now challenges), as well as an ownership interest in Netlist itself.

B. Samsung breached the JDLA.

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

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

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

Netlist has secured multiple jury verdicts confirming the commercial success of its inventions, including two against Samsung. In 2023, a jury in the Eastern District of Texas (EDTX) found that Samsung willfully infringed five Netlist patents and that the patents were not invalid and awarded Netlist \$303.15 million in damages. EX2014. In 2024, a jury found that Samsung willfully infringed three Netlist patents and that the patents were not invalid and awarded Netlist \$118 million in damages. EX2017. Yet Samsung has continued its infringing conduct, enabled by the ability to repeatedly challenge Netlist's patents—patents it once licensed and required Netlist to defend the validity of—before the PTAB.

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

In the past five years, 21 of Netlist's patents have been attacked at the Patent Office, with 15 of those patents subject to multiple attacks. Samsung has filed 19 IPRs and two PGRs against Netlist patents, many of which Samsung previously licensed and had a security interest in. EX2018. This Petition continues a pattern of serial IPR filings by Samsung. Indeed, Samsung is, by far, the most frequent petitioner in IPR proceedings, having filed over 600 IPR petitions in the last five years. EX2020, 48; *see* EX2019, 48,337 (“By far, the most frequent users of IPR proceedings are large technology companies.”).

E. Netlist continues to try to prevent Samsung's ongoing infringement.

In July 2025, Netlist filed suits against Samsung and Avnet (25-cv-00748), and Micron (25-cv-00749) in EDTX to prevent ongoing infringement of the '366 patent. EX2043. In September 2025, Netlist filed an ITC complaint against Samsung and certain of its customers asserting six patents, including the '366 patent. EX2015. Of the six asserted patents, the PTAB has confirmed the validity of three of the patents; Samsung was the petitioner in two of those proceedings. EX2015, 5-6. *Samsung Elecs. Co. v. Netlist, Inc.*, IPR2022-00063, Paper 53 at 58 (PTAB May 3, 2023) (confirming the validity of all claims of the '523 patent), *aff'd*, No. 23-2133, Dkt. No. 44 (Fed. Cir. Mar. 5, 2025); *Samsung Elecs. Co. v. Netlist, Inc.*, IPR2023-00847, Paper 42 at 73 (PTAB Dec. 10, 2024) (confirming the validity of claims 1–5 of the '608 patent), *aff'd*, No. 25-1378 (Fed. Cir. Dec. 9, 2025). The ITC investigation was instituted December 29, 2025. EX2054.

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

In 2021, SK hynix licensed Netlist's patent portfolio (including the '366 patent), further demonstrating the industry's desire for access to Netlist's superior technology. EX2023. SK hynix is a leading provider of next generation DIMMs and HBM. In the first three months of FY2025, SK hynix reported \$9.1 billion in revenue in the United States. EX2015, 28. A significant portion of this revenue is attributable to products that include Netlist's patented technology. *Id.*

III. MULTIPLE INDEPENDENT REASONS WARRANT DENIAL

A. Netlist's settled expectations favor denial.

1. Samsung's prior technology partnership with Netlist and interest in the '366 patent should foreclose review.

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

Samsung's past business relationship with Netlist and its interest in the '366 patent should foreclose review. Samsung and Netlist entered into the JDLA to develop technology (NVDIMM) described in the '366 patent and were "technology partners" for nearly five years. EX2001; EX2008, 1. During this period, Samsung took a license to Netlist's patents, which, by the terms of their agreement, Netlist was required to "[p]rotect, defend, and maintain the validity and enforceability" of. EX2004, 8. In the event of breach by Netlist, Samsung had the

right—without Netlist’s consent—to defend and institute any action with respect to the patent collateral (including parents of the ’366 patent); to grant or issue exclusive or non-exclusive licenses; and to assign or otherwise transfer title in the patent collateral. EX2004, 10. Samsung also acquired a 3.25% stake in Netlist itself, with an option to acquire nearly 20% of Netlist.

Netlist thus granted Samsung important interests in its company and in the NVDIMM technology of the ’366 patent family—interests that, in turn, gave Samsung strong incentives to have Netlist protect the ’366 patent’s technology. Review should be denied because it is not an appropriate or efficient use of PTAB resources to review a patent challenge brought by a party that previously had acquired rights in the patent through an agreement that it subsequently breached.

2. SK hynix’s license enhances Netlist’s settled expectations.

That SK hynix took a license to Netlist’s portfolio enhances Netlist’s settled expectations in the ’366 patent. *Alliance Laundry Sys., LLC v. PayRange LLC*, IPR2025-00950, Paper 11 at 3 (PTAB Sept. 19, 2025) (informative) (evidence that challenged patent is licensed creates settled expectations for Patentee).

3. Samsung knew of the application that issued as the ’366 patent but did not make a third party submission.

Finally, Samsung’s notice but failure to act favors denial. Specifically, Samsung knew of the application that issued as the ’366 patent and the art that it asserts in the Petition (Perego, Harris, and Amidi), but chose not to make a third

party submission during prosecution. *See* EX2029, 2 (“Among other tools, the [AIA] gives an opportunity for third parties to send prior art to the USPTO when patents are under examination.”). Samsung knew of application 17/582,797 (issued as the ’366 patent) and Harris and Amidi by at least May 2022. EX2056, 1, 3. Samsung knew of Perego by at least February 2022. EX2057, 4. Had Samsung questioned the validity of the claims, it should have made a third-party submission to allow earlier consideration by the Office prior to the issuance of the patent.

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

To stop Samsung’s rampant, ongoing infringement, Netlist asserted six patents against Samsung at the ITC: 9,824,035; 10,025,731; 10,217,523; 10,268,608; 12,308,087; and 12,373,366. EX2015. The ITC is the best forum for resolving this dispute because Samsung cannot challenge all the asserted patents at the PTAB, and each of Samsung’s Petitions against the patents it *can* challenge suffers fatal defects. *See Samsung Elecs. Co. Ltd. v. VB Assets, LLC*, IPR2025-00870, Paper 11 at 3 (PTAB Oct. 10, 2025).

Samsung is estopped under Section 315(e) from challenging the ’523 and ’608 patents at the PTAB. For each patent, Samsung petitioned for IPR, the PTAB upheld the claims, and the Federal Circuit affirmed. EX2040; EX2041.

Samsung filed a bevy of IPR and PGR petitions against the other four patents: IPR2025-01402 (’087), PGR2025-00071 (’087), IPR2025-01431 (’731),

IPR2026-00017 ('035), IPR2026-00018 ('366), and PGR2026-00001 ('366). The PTAB should not consider any of these petitions. The PTAB has already reviewed and upheld the validity of the relevant claims of the '035 patent. EX2058. And all Samsung's petitions suffer the same fatal and incurable defect: they fail to name all RPIs. *See, e.g.*, Section III.D below; IPR2025-01402, Paper 17 at 2.

Samsung's failure to name all RPIs is fatal to its Petitions against four of the patents. And it cannot challenge the other two at the PTAB. Institution should thus be denied because the PTAB cannot resolve any—much less all—of this dispute. And, as discussed below, the ITC will also be a *faster* forum to determine validity.

C. The *Fintiv* analysis strongly favors discretionary denial.

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

Factor 1 strongly favors denial because the ITC will not defer to the PTAB and is virtually certain not to stay its proceedings pending conclusion of an IPR. *See Milwaukee Elec. Tool Corp. v. Klein Tools, Inc.*, IPR2025-00724, Paper 14 at 2-3 (PTAB Sept. 12, 2025). The ITC has a statutory mandate to complete its investigation “at the earliest practical time” and its standing practice is to deny such requests. *See* 19 U.S.C. § 1337(b)(1); *Certain Automated Storage and Retrieval Systems, Robots, and Components Thereof*, Inv. No. 337-TA-1228, Order No. 6 (ITC Mar. 9, 2021); *see also Klein Tools, Inc. v. Milwaukee Elec. Tool Corp.*, IPR2024-01400, Paper 22 at 2 (PTAB June 9, 2025) (determining on

Director Review that “[t]he Board did not give enough weight to the lack of a stay, or the fact that a stay was unlikely, in the parallel [ITC] investigation”). There is no indication that the ITC would depart from its standing practice here.

2. Factor 2 strongly favors denial because the projected ITC initial determination will occur before the projected FWD and the ITC trial will occur even sooner.

Factor 2 strongly favors denial. The projected statutory deadline for the FWD is May 20, 2027. Netlist filed its ITC complaint September 29, 2025, and the investigation was instituted December 29, 2025 (delayed due to the shutdown). EX2054. The ITC has set the target date for its initial determination (ID) as April 2, 2027—about 7 weeks before any final written decision in this IPR. EX2059. That the ITC ID will precede the FWD favors denial. *See* EX2053 (Order initiating Director Review to determine whether IPR should be terminated based on ITC ID).

Even more relevant than the ID, the ITC hearing—which is analogous to the district court trial—is scheduled to begin October 28, 2026. EX2060, 3. *Fintiv* instructs that “an earlier ITC *trial* date may favor exercising authority to deny institution ... if the ITC is going to decide the same or substantially similar issues.” *Fintiv*, 8 (emphasis added). And, under the Interim Process, the hearing date alone has been used to evaluate factor two based on a co-pending “ITC trial.” *See Taiwan Semiconductor Mfg. Co. Ltd. v. Marlin Semiconductor Ltd.*, IPR2025-00848, Paper 11 at 2 (PTAB Sept. 3, 2025) (comparing the ITC *hearing* date to the

final written decision due date and determining it is unlikely the FWD would issue “*before the ITC trial occurs*”) (emphasis added). Institution here—when the ITC trial scheduled several *months* before the PTAB issues a FWD—would not be consistent with the AIA’s objective to provide an effective and efficient alternative to litigation. *Accord NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (precedential).

3. Factor 3 favors denial because the parties have already invested significant resources at the ITC.

Factor 3 favors denial. The relevant consideration is the “amount and type of work already completed in the parallel litigation by the court and the parties *at the time of the institution decision*.” *Fintiv*, 9 (emphasis added). Discovery at the ITC is already underway. EX2054. The parties have served initial discovery requests, with responses due January 22. Discovery will be ongoing until the institution deadline. By the time a DI issues in this proceeding, the parties will have already invested enormous resources into discovery at the ITC.

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

Factor 4 strongly favors denial because Samsung has not submitted *any stipulation* that it will forgo overlapping validity challenges at the ITC or in the EDTX proceeding. Therefore, it has done nothing to mitigate concerns of inefficiency or duplication of effort such that “th[is] IPR proceeding[] would be a

‘true alternative’ to” the ITC litigation or the district court. *See Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3-4 (PTAB Mar. 28, 2025) (on Director Review, vacating institution decision and denying under *Fintiv*); *see also Phison Elecs. Corp., v. Vervain, LLC*, PGR2025-00010, Paper 14 at 3 (PTAB July 10, 2025) (lack of stipulation tips the balance in favor of discretionary denial).

5. Factors 5 and 6 favor denial because the parties in the IPR overlap with the parties in the ITC litigation and the merits are weak.

Factor 5 favors denial because the parties in the parallel litigations overlap. *See Pet.*, 1. Factor 6 also favors denial because, as will be explained in the POPR, the Petition fails to establish that the challenged claims are invalid over the Grounds asserted therein. *See Interim Process*, § II.C.i (patent owner may direct attention to an anticipated POPR and evidence for a discussion of the merits).

D. Samsung’s Petition fails to name all RPIs.

The Petition suffers a fatal and incurable defect: it fails to name Samsung Electronics America, Inc (“SEA”) and Avnet, Inc. (“Avnet”) as RPIs. This violates Samsung’s statutory and regulatory obligations and is an independent reason for denial. 35 U.S.C. § 312(a)(2); 37 C.F.R. § 42.8(b)(1); *Corning Optical Commc’ns RF, LLC v. PPC Broadband, Inc.*, IPR2014-00440, Paper 68 (PTAB Aug. 18, 2015) (precedential except § II.E.1); *Yangtze Memory Techs. Co., Ltd. v. Micron Tech., Inc.*, IPR2025-00098, Paper 38 (PTAB Jan. 15, 2026) (informative).

Netlist's ITC complaint named as defendants Samsung Electronics Co., Ltd ("SEC"), SEA, and Samsung Semiconductor, Inc ("SSI"). EX2015, 1. Along with SEC and SSI, SEA and Avnet are co-defendants in the related EDTX litigation. EX2043, 1. And, in August 2025, these Samsung entities (SEC, SEA, SSI) and Avnet filed a proposed amended complaint in the District of Delaware for declaratory judgment of non-infringement of the '366 patent. EX2025.

SEA is an RPI: it is a "clear beneficiary" that has a "preexisting, established relationship with" both Petitioner SEC and RPI SSI, and will benefit from this IPR. *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1351 (Fed. Cir. 2018). According to Samsung, "SSI is a wholly-owned subsidiary of SEA, which itself is a wholly-owned subsidiary of SEC." EX2027. Netlist asserts in the ITC that these entities import and sell products and components that infringe the '366 patent. EX2015, 7. As a defendant at the ITC and in EDTX and plaintiff in DE, SEA has an "interest in" and would "benefit[] from" a favorable outcome here by potentially avoiding liability for its ongoing infringement of Netlist's patents.

Avnet is also an RPI. All agree that Samsung and Avnet have a preexisting, established relationship: according to Samsung, Avnet is Samsung's customer. EX2025, 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 EDTX, EX2043, 1. Like SEA, Avnet would benefit from this IPR by potentially avoiding liability.

Particularly telling, in the Delaware DJ action, the plaintiffs had control over the parties to name and chose to include SEA and Avnet. In doing so, Samsung and Avnet represented to the court that a “substantial, immediate, and real controversy exists between Plaintiffs and Netlist regarding whether Plaintiffs or their customers or end users infringe the ’366 patent.” EX2025, 48 (¶156).

There is simply no excuse for Samsung’s failure to name SEA and Avnet as RPIs when it filed this IPR in November 2025, which was *after* Corning was designated precedential in October 2025. Indeed, Samsung is the leading petitioner at the PTAB and has named SEA as an RPI on close to 800 petitions. EX2020, 48; EX2028. It knew or should have known of its statutory obligation to name RPIs.

Because the Petition fails to name all RPIs, the Director should not consider the Petition and should deny review. *Yangtze Memory*, 8.

E. Samsung’s Petition should be denied under 325(d).

1. *Advanced Bionics* Part 1: The Petition presents the same art that was before the Examiner during prosecution.

The Petition’s sole obviousness Ground relies on Perego, Harris, and Amidi. Pet., 4. During prosecution, Netlist submitted an IDS identifying IPR2022-00615 in which Samsung challenged another Netlist patent using the Perego reference. EX1002, 392; EX2057, 4. And Samsung admits the Examiner applied Harris and Amidi to reject the claims and that Netlist presented arguments to distinguish over these references. Pet., 17. Thus, the art in the Petition was before the Examiner.

2. *Advanced Bionics* Part 2: There were no material errors.

The Examiner committed no material errors that require correction at the PTAB. Examination of the '366 patent was very thorough, involving: (1) *six Worldwide prior art searches by the Office* on: July 7, 2023 (EX1002, 320-28); October 31, 2023 (EX1002, 476-78); February 22, 2024 (EX1002, 519-21); August 5, 2024 (EX1002, 623-27, 1242-46); April 19, 2025 (EX1002, 1527-28); June 7, 2025 (EX1002, 1612-14); (2) four Office Actions on the merits (EX1002, 168-75, 345-51, 645-62, 1261-74); (3) five rounds of claim amendments and/or remarks (EX1002, 298-304, 425-432, 491-503, 1122-1236, 1398-1496; and (4) *six information disclosure statements* (EX1002, 209-17 (listing Harris, Amidi), 240-45, 269-74, 379-86, 392-99, 506-07, 544-46, 572-579, 582-86, 1101-08, 1118-19).

Samsung thus cannot credibly allege that Netlist's disclosures or the Examiner's prior art searches were inadequate. Again, Netlist directed the Examiner to an IPR involving Perego, and Samsung concedes that Harris and Amidi were used and thoroughly vetted by the Examiner. Pet., 16-18. Samsung knew of all three asserted references at the time the '366 patent was being examined. *See* Section III.A.3. Had Samsung believed that Netlist's disclosures or the Examiner's searches and evaluation of the art were inadequate, it should have made a third-party submission explaining the references that it asserts here. *See* EX2029, 2.

F. The '366 patent's family history does not favor institution because the '366 claims are materially different than those of its parents.

The prior IPRs of the parents of the '366 patent (i.e., the '054, '918, '831, and '833 patents) do not show a history of invalidity with the *claimed* subject matter. First, the PTAB decisions regarding the '054 and '918 patents are currently on appeal, and thus validity has not been finally adjudicated (Appeal No. 24-1859). Second, the claims of the '366 patent are significantly more detailed than those of the '054, '918, '831, and '833 patents. EX2055. Tellingly, the Examiner did not require terminal disclaimers with respect to any of the '054, '918, '831, and '833 patent claims before allowance. Further, the Examiner considered *all* of these FWDs during prosecution of the '366 patent, even basing a rejection on the grounds in the '918 FWD, and yet determined the '366 patent claims were allowable after further amendments and arguments by Netlist. EX1002, 523 (marking '918 and '054 FWDs as considered), 638 (marking '831 and '833 FWDs as considered), 648-62 (discussing '918 and '054 FWDs in Office Action and basing rejection thereon).

Indeed, Samsung's Perego-Harris-Amidi Ground demonstrates that the validity issues are different here because Samsung presents an entirely different primary reference and combination than it asserted against the '054 and '918 patents. *Compare* EX1070, 90 (Grounds against '918) *and* EX1071, 79 (Grounds against '054), *with* Pet., 4. Specifically, in the IPRs against the '054 and '918 patents, Samsung did not rely on Perego. EX1070, 90; EX1071, 79. Likewise, there is no

overlap in references used in the IPRs against the '831 and '833 patents. EX1018, 3: EX1020, 3. Here, Samsung relies on an entirely different primary reference (Perego), while disingenuously implying there should be an estoppel effect from the prior IPRs. *See* Pet., 18-19. But the claims and asserted art are plainly different, and thus Samsung's prior IPRs do not show error in examination or a history of invalidity with respect to the claimed subject matter of the '366 patent.

G. Institution of this IPR would be contrary to important national security and economic interests.

Domestic production of semiconductors is needed for “economic security.” EX2021, 2. Netlist's ITC complaint seeks to block infringing memory devices manufactured abroad from being imported into the U.S. Enforcing Netlist's IP rights will encourage domestic semiconductor manufacturing, such as through the substantial domestic manufacturing by SK hynix, who plans to invest \$3.87 billion in Indiana. EX2015, 28. Given the importance of the '366 patent technology to supporting a domestic semiconductor industry, it would not be an appropriate use of PTAB resources to institute review and undermine the critical efforts of this administration to encourage domestic manufacturing of semiconductors in furtherance of national economic and security interests.

In the related IPRs/PGRs, Samsung advances the baseless accusation that Netlist is not the RPI and is funded by nefarious sources—an accusation that Netlist has thoroughly refuted. *See, e.g.*, IPR2025-01402: Paper 11, 12-13

(Samsung's accusation), Paper 17, 4 (Netlist's reply). Samsung's accusation is nothing more than a transparent attempt at misdirection to cover for its own failure to list all RPIs in its petitions. IPR2025-01402, Paper 17, 1-3.

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

“[T]he practice of the same party filing multiple petitions challenging the same patent ... is disfavored.” *Comcast Cable Commc'ns, LLC v. Entropic Commc'ns, LLC*, IPR2025-00183, Paper 11 at 2 (PTAB June 25, 2025). Instead of analyzing the written description support of the claims and choosing and standing behind a position, Samsung shifts the burden to the PTAB to fully analyze the issue—all the while hoping for no negative consequence if its written description contentions are determined to be incorrect. Samsung admits as much, indicating the IPR petition was filed as a back-up “if the PGR petition is wrong.” Paper 3, 2-3. Samsung's strategy of filing two petitions unnecessarily burdens the PTAB and should not be rewarded. Discretionary denial of Samsung's second ranked IPR petition is appropriate, even if the PGR is denied. *See FreightCar America, Inc. v. National Steel Car Ltd.*, IPR2025-01048, Paper 20 at 4 (PTAB Oct. 10, 2025) (discretionarily denying second ranked petition before first ranked petition considered on the merits); *see* Paper 3 (ranking the PGR first).

IV. CONCLUSION

The Director should exercise his discretion to deny institution.

Respectfully submitted,

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

I certify that the above-captioned **PATENT OWNER NETLIST, INC.’S BRIEF ON DISCRETIONARY DENIAL** and associated Exhibits 2001-2009, 2014-2015, 2017-2021, 2023-2025, 2027-2029, 2040-2041, 2043, 2047-2048, 2053-2060 were served in their entireties on January 20, 2026, upon the following parties via electronic mail:

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