

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,

Petitioner,

v.

NETLIST, INC.,

Patent Owner

PGR2025-00071

Patent 12,308,087

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

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1123	Memorandum re: Guidance on USPTO's rescission of "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation" (Mar. 24, 2025), <i>available at</i> https://www.uspto.gov/patents/ptab/resources >
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

Exhibit #	Description
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
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

Exhibit #	Description
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	Comparison of Claim 1 of U.S. Patent No. 12,308,087 with Claim 1 of U.S. Patent No. 8,787,060 and Claim 1 of U.S. Patent No. 9,318,160
2025	Written Decision on Registration, Korean Patent Application No. 10-2017-0113355, mailed March 24, 2022
2026	U.S. Patent No. 10,026,724 to Kim et al., issued July 17, 2018
2027	Opening Brief for Appellant Netlist, Inc., <i>Netlist, Inc. v. Samsung Electronics Co., Ltd.</i> , Case No. 24-2240 (Fed. Cir.), February 4, 2025
2028	Joint Appendix Volume II of II, <i>Netlist, Inc. v. Samsung Electronics Co., Ltd.</i> , Case No. 24-2240 (Fed. Cir.), May 28, 2025
2029	Morris, A., “IPBC Global 2025: Acting USPTO Director says IPR use needs to change,” <i>IAM</i> , June 10, 2025, accessible at https://www.iam-media.com/article/ipbc-global-2025-acting-uspto-director-says-ipr-use-needs-change (last accessed June 16, 2025)

I. INTRODUCTION

Netlist’s request for discretionary denial (“DD Req.”) should be denied. Samsung filed its petition only **three months** after the ’087 patent issued —**before** Netlist’s retaliatory ITC action — consistent with the policy that early challenges favor robust, predictable patent rights and weigh against discretionary denial.

Netlist focuses extensively on a 2015 agreement between Samsung and Netlist called the “JDLA,” but Netlist asserts it “terminated the JDLA on July 15, 2020,” DD Req. 5, long **before** the ’087 patent application was filed in 2022, *see* EX1001, thus defeating all of Netlist’s arguments premised on the JDLA.

Furthermore, during prosecution of the ’087 patent, the Board issued Final Written Decisions **invalidating all 54 claims** of the related ’060 and ’160 patents in response to Samsung’s IPRs, *see* EX1072–74, yet neither Netlist nor the Examiner discussed these Final Written Decisions or cited references, *see* Pet. 9 (citing EX1003, ¶ 83), even though Netlist asserts that the ’087 patent covers the exact same HBM products by Samsung that Netlist previously asserted were covered by the now-invalid ’060 and ’160 patents, *see, e.g.*, EX1083, 9, ¶¶ 21–23 (“HBM”); EX1089, 14 (“HBM”). That was material error, and contrary to Samsung’s “settled expectations” with respect to its HBM memory products critical to this country’s AI technology, *see, e.g.*, EX1118, 2 (“indispensable to . . . AI”); *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”).

The Examiner also materially erred by allowing claims that clearly lack written description, as confirmed by the Federal Circuit’s recent decision reversing a jury verdict and invalidating claims like those here that require one very specific combination where the written description merely provides a “laundry list” of millions of different possible combinations. *Compare* Pet. 12–23 (“laundry list”), *with Duke Univ. v. Sandoz Inc.*, No. 24-1078, 2025 WL 3210322, at *7 (Fed. Cir. Nov. 18, 2025) (“laundry list”). Netlist impermissibly drafted the claims of the ’087 patent to try to cover HBM technology for AI without any written description in the patent for the claimed combination. *See* Pet. 12–38; EX1089, 14 (“HBM”).

Netlist points to parallel proceedings in district court and the ITC, but the district court action will be stayed, 28 U.S.C. § 1659(a) (“shall stay”), and this proceeding is far ahead of Netlist’s retaliatory ITC action, meaning 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. Early challenges to patentability, like here, are favored and weigh against discretionary denial

Samsung filed its PGR petition quickly — only three months after the '087 patent issued in 2025, and months *before* Netlist's retaliatory ITC action — which weighs against discretionary denial: “Early challenges favor robust, predictable patent rights and weigh against discretionary denial. Further, petitions for post-grant review are favored because they must be filed no later than nine months from the grant of the patent (35 U.S.C. § 321(c)), are close in time to examination, and occur before expectations in the patent rights are strongly settled.” *Straumann USA, LLC v. Smart Denture Conversions, LLC*, PGR2025-00054, Paper 11, at 2 (PTAB Oct. 17, 2025) (Acting Director); *accord Geotab Inc. v. Fractus, S.A.*, IPR2025-01026, Paper 14, at 2 (PTAB Oct. 17, 2025) (Acting Director).

B. Netlist cannot rely on the 2015 JDLA agreement between Samsung and Netlist to show “settled expectations,” because Netlist asserts it terminated the JDLA long before the '087 patent application was filed

Netlist focuses extensively on a 2015 agreement between Samsung and Netlist called the “JDLA,” and argues that it “should foreclose review.” DD Req. 2–5, 8–10. But Netlist asserts it “terminated the JDLA on July 15, 2020,” DD Req. 5, long before the '087 patent application was filed in 2022, *see* EX1001, thus defeating all of Netlist's arguments premised on the JDLA. Furthermore, the '087 patent is asserted against “HBM” products for Artificial Intelligence (AI), *see*

EX1083, 9, ¶¶ 21–23 (“HBM”); EX1089, 14 (“HBM”); EX1118, 2 (“HBM”), which differ significantly from the products discussed 10 years ago in the JDLA, called “NVDIMM-P,” which used “non-volatile” (NV) memory that was much “slower,” EX2001 at SEC000003 (“NVDIMM-P Product”), SEC000006, § 5.1 (“The Parties will work together to standardize NVDIMM-P”).

The cases cited by Netlist are thus clearly distinguishable, because they involved patents issued long ago that the petitioner had licensed or knew about for a long time, arguably creating “settled expectations” for the patent owner, unlike here where the ’087 patent application was filed very recently, after Netlist asserts it terminated the JDLA. See DD Req. 8 (citing *L’Oreal USA, Inc. v. Brightex Bio-Photonics, LLC*, IPR2025-00971, Paper 13, at 2 (PTAB Sept. 26, 2025) (Acting Director) (“Petitioner . . . had notice of the challenged patent for a significant period of time.”); *Microsoft Corp. v. TS-Optics Corp.*, IPR2025-00767, Paper 13, at 2 (PTAB Aug. 14, 2025) (Acting Director) (“[T]he challenged patent has been in force for more than seventeen years, creating strong settled expectations for Patent Owner. Additionally, Petitioner was aware of the challenged patent, having taken a license to it from 2011 to 2018.”)).

Netlist argues that the JDLA covered “parent applications (and continuations) that led to the ’087 patent,” DD Req. 8, but Netlist omits that Samsung filed IPRs against those parent patents (the ’060 and ’160 patents, see

EX1001, 2), which resulted in Final Written Decisions **invalidating all 54 claims** of the '060 and '160 patents, see EX1072–74, thus creating “settled expectations” for Samsung, not for Netlist, as explained below. Given that Samsung successfully challenged the '060 and '160 patents, Netlist certainly could not have had “settled expectations” with respect to the related '087 patent that recently issued. 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.”).

C. Samsung’s successful challenges to the related '060 and '160 patents created “settled expectations” for Samsung and weigh against discretionary denial

Samsung’s successful challenges to the related '060 and '160 patents — prior to issuance of the '087 patent — created “settled expectations” for Samsung with respect to its HBM products and weigh against discretionary denial here. See, e.g., EX1113, 2 (identifying “[s]ettled expectations of the parties” as relevant); *POSCO*, IPR2025-00370, Paper 10, at 2–3 (“Petitioner’s arguments regarding settled expectations . . . tip the balance The fact that the Board previously determined related claims to be unpatentable—prior to the issuance of the challenged claims in this proceeding—tips the balance against discretionary denial. 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) (similar).

Netlist sued Samsung almost **four years** ago asserting that Samsung’s HBM memory products infringed Netlist’s ’060 and ’160 patents. *See* EX1044, 63–69. In response, Samsung filed IPRs, resulting in Final Written Decisions **invalidating all 54 claims** of the ’060 and ’160 patents. *See* EX1072–74. Netlist is upsetting Samsung’s settled expectations and taking a third bite at the apple by asserting the recently issued ’087 patent against those **same** HBM products. *See, e.g.*, EX1083, 9, ¶¶ 21–23 (“HBM”); EX1089, 14 (“HBM”).

D. Netlist should not be rewarded for circumventing the Board by refusing to amend the claims during the ’060 and ’160 IPRs and instead presenting new claims to the Examiner in the ’087 prosecution that try to cover the same HBM products that Netlist had tried to cover with the ’060 and ’160 claims

Samsung’s “settled expectations” are especially strong given that Netlist could have — but did not — try to amend the claims of the ’060 and ’160 patents during those IPRs to reflect the claim language now found in the ’087 patent. *See* 37 C.F.R. § 42.121 (permitting motion to amend during IPR). Netlist should not be rewarded for circumventing the Board by refusing to amend the claims during the ’060 and ’160 IPRs and instead presenting new claims to the Examiner in the ’087 prosecution that try to cover the same HBM products that Netlist had tried to

cover with the '060 and '160 claims.

Netlist is treating the Patent Office like a casino, where a patent owner can keep pulling the slot machine in the hopes of eventually getting lucky. But that not only violates Samsung's "settled expectations," it also violates the "efficient administration of the Office," 35 U.S.C. § 316(b), and "the just, speedy, and inexpensive resolution of every proceeding," 37 C.F.R. § 42.1(b). Netlist's gamesmanship weighs strongly against discretionary denial here.

E. The Examiner materially erred during prosecution

The Examiner materially erred during prosecution, both with respect to written description under § 112, and obviousness under § 103, and it is an appropriate use of Office resources to correct those material errors:

- 1. The Examiner materially erred by allowing extraordinarily detailed claims that lacked written description under § 112, as confirmed by the recent Federal Circuit decision invalidating similar claims where the written description merely provided a "laundry list" of millions of possible combinations**

The Examiner materially erred by allowing claims that clearly lack written description, as confirmed by the Federal Circuit's recent decision reversing a jury verdict and invalidating claims like those here that require one very specific combination where the written description merely provides a "laundry list" of millions of different possible combinations. *Compare* Pet. 12–23 ("laundry list"), *with Duke Univ.*, 2025 WL 3210322, at *7 ("laundry list").

The written description of the '087 patent says over 250 times that certain features “may” or “can” be included in “some” embodiments (without ever identifying any particular embodiment), *see, e.g.*, EX1001, 10:48, and then the '087 patent emphasizes that “such conditional language is ***not generally intended to imply that features, elements and/or states are in any way required*** for one or more embodiments,” EX1001, 23:18–:26. In short, the written description merely provides a “laundry list” of possible features resulting in millions of possible combinations. *See* Pet. 19–23.

The claims allowed by the Examiner, in contrast, state directly the opposite: they ***require*** an extraordinarily specific combination of limitations, as reflected by the extraordinary length of each independent claim (several of which exceed 1,000 words). *See* Pet. 15–17. That specificity is found nowhere in the '087 patent.

During prosecution, Netlist and the Examiner purported to identify written description support for a few isolated limitations, *see* Pet. 9 (citing EX1003, ¶¶ 85–89); DD Req. 18 (citing EX1002, 769–76), but that analysis was materially erroneous: the test for written description is not whether, “[w]orking ***backward*** from a knowledge of [the claims],” it is possible ***in hindsight*** to try to show “support by picking and choosing claim elements from different embodiments that are never linked together in the specification.” Pet. 13 (quoting *Novozymes A/S v. DuPont Nutrition Biosciences APS*, 723 F.3d 1336, 1349 (Fed. Cir. 2013), and

Flash-Control, LLC v. Intel Corp., No. 20-2141, 2021 WL 2944592, at *4 (Fed. Cir. July 14, 2021) (nonprecedential)); *see also* Pet. 33–36 (discussing EX1002, 769–76). Instead, the test for written description requires starting with “the four corners of the specification” — with no foreknowledge of the specific combination in the claim language — to see if it shows that the inventors had “possession” of the specific combination found in the claim language. Pet. 12 (quoting *Rivera v. ITC*, 857 F.3d 1315, 1322 (Fed. Cir. 2017)). The Examiner materially erred by failing to do that.

By analogy, if a patent filed in 2011 disclosed a piano, that patent would not provide written description for this year’s hit song — “Golden” by KPop Demon Hunters, <<https://www.youtube.com/watch?v=yebNIHKAC4A&t=65s>> — simply because, in hindsight, every note of the song can be played using the keys of the piano in a specific combination. That has it backwards. A patent must disclose the claimed combination to provide written description. The combination cannot be pieced together in hindsight. Yet that is precisely what Netlist is trying to do with the ’087 patent: Netlist impermissibly drafted the claims of the ’087 patent in hindsight to try to cover HBM technology “indispensable” to Artificial Intelligence without any written description in the patent for the claimed combination. EX1118, 2 (“indispensable to . . . AI”); EX1089, 14 (“HBM”); Pet. 12–38. Tellingly, Netlist has never made a single HBM product.

Netlist asserts institution should be discretionarily denied under 35 U.S.C. § 325(d) and *Advanced Bionics* because “[t]he Office should not waste resources in reconsidering the examiner’s thorough and correct determination there is written description support for the claims.” DD Req. 17–19. But the Examiner’s analysis for written description was backwards, as explained above, and there is no evidence that the Examiner found written description for the specific limitations discussed in the Petition, *see* Pet. 23–36 (unidirectional interconnects/conduits for conducting signals down the stack; unidirectional first/second/fourth/sixth/eighth signals; fifth/sixth/eighth signals; multiple types of interconnects with selective electrical communication; C/A signals that do not include any chip select signals) — let alone **all** the limitations in combination, *see* Pet. 14–23.

Accordingly, there is no basis for discretionary denial and institution should be granted. *See, e.g., Adello Biologics LLC v. Amgen Inc.*, PGR2019-00001, Paper 13, at 10–11 & n.8 (PTAB Apr. 19, 2019) (“[I]t is not clear from the prosecution history that the examiner sufficiently considered whether the broader language of the issued claims also satisfies the written description requirement. . . . Under the circumstances, we decline to deny institution under §325(d) based on the written-description and enablement arguments presented in the Petition.”); *Lifescan Global Corp. v. Ikeda Food Research, Ltd.*, PGR2019-00032, Paper 11, at 11–15 (PTAB Aug. 15, 2019) (“[T]he mere absence of a rejection does not reflect that the

Examiner already considered the specific arguments presented in the Petition. . . .

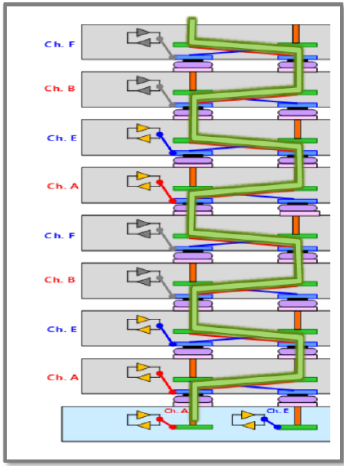
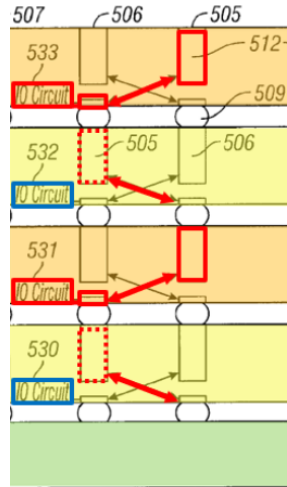
[W]e find that the circumstances favor institution because the arguments presented in the Petition were not specifically considered by the Examiner.”).

2. The Examiner materially erred with respect to obviousness under § 103 by searching the wrong classes and by focusing on keywords rather than figures showing the same HBM structure Netlist was trying to claim

The Examiner also materially erred with respect to obviousness under § 103, because the Examiner searched the wrong classes, and the Examiner apparently focused on keywords (in the wrong classes), rather than figures (in the correct classes) showing the same HBM structure Netlist was trying to claim.

By way of background, the Examiner for the ’087 patent is the same Examiner that allowed the 54 claims in the related ’060 and ’160 patents, all of which the Board unanimously found to be invalid in response to Samsung’s IPRs. *See* EX1072–74; EX1070, 474; EX1006, 171; EX1002, 826. The Examiner is regarded as “an extremely easy examiner and in the 4th percentile across all examiners (with 100th percentile most difficult).” EX1122, 2.

During prosecution of the ’087 patent, the Examiner failed to reject the claims — which purport to cover the structure for HBM memory (as shown below left) — despite a prior-art reference called “Keeth” disclosing a nearly identical structure (as shown by the Petition, below right):

<u>HBM memory allegedly covered by the claims of the '087 patent</u>	<u>Prior art (“Keeth,” EX1047)</u>
Twist (HBM2 and HBM2E)  See EX1089, 14.	 See Pet. 87–88.

The Examiner materially erred by searching the wrong classes (below left), rather than the correct classes containing the Keeth reference (below right):

<u>Classes searched by the '087 Examiner</u>	<u>Classes for the primary reference in the Petition (EX1047)</u>
(51) Int. Cl. <i>G11C 5/06</i> (2006.01) <i>G11C 7/10</i> (2006.01) <i>G11C 7/12</i> (2006.01) (52) U.S. Cl. CPC <i>G11C 5/066</i> (2013.01); <i>G11C 5/06</i> (2013.01); <i>G11C 7/1057</i> (2013.01); <i>G11C 7/1084</i> (2013.01); <i>G11C 7/12</i> (2013.01) (58) Field of Classification Search CPC <i>G11C 5/066</i>; <i>G11C 5/06</i>; <i>G11C 7/1057</i>; <i>G11C 7/1084</i>; <i>G11C 7/12</i> USPC 365/63 See application file for complete search history. See EX1001, 1–2.	(51) Int. Cl. <i>G06F 13/14</i> (2006.01) <i>H01L 25/065</i> (2006.01) <i>G11C 5/02</i> (2006.01) <i>G06F 13/38</i> (2006.01) <i>H01L 23/31</i> (2006.01) <i>H01L 23/48</i> (2006.01) <i>H01L 25/18</i> (2006.01) (52) U.S. Cl. CPC <i>H01L 25/0652</i> (2013.01); <i>G06F 13/385</i> (2013.01); <i>G11C 5/02</i> (2013.01); <i>H01L 23/3128</i> (2013.01); <i>H01L 23/481</i> (2013.01); <i>H01L 25/18</i> (2013.01); <i>H01L 2224/16145</i> (2013.01); <i>H01L 2225/06513</i> (2013.01); <i>H01L 2225/06544</i> (2013.01) USPC 710/305 (58) Field of Classification Search USPC 710/305–309, 315–317; 257/678, 257/684–685, 701–703, 777 See application file for complete search history. See EX1047, 1.

The Examiner searched certain subclasses within G11C, which concerns the internal “storage of digital . . . information” and “does not cover elements not

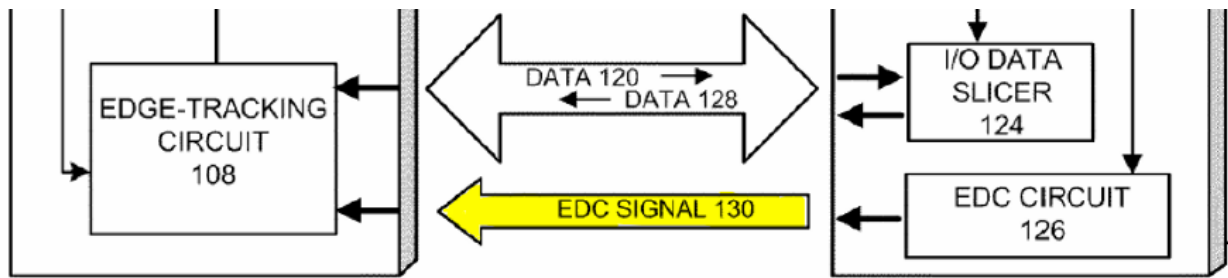
adapted for storage.” EX1120, 1. The claims of the ’087 patent, in contrast, as shown by the images above (p.12), concern the three-dimensional interconnections for memory devices, not simply the internal “storage of digital . . . information” (which the Examiner focused on). *Id.* Thus, the Examiner overlooked relevant classes containing the Keeth reference, such as H01L 25/0652 (“Assemblies consisting of a **plurality** of semiconductor or other solid state devices...{the devices being arranged next and **on each other**, i.e. mixed assemblies}”). EX1121, 26–27 (emphasis added).

Furthermore, given that the claims of the ’087 patent try to cover a specific three-dimensional structure, as shown by the images above (p.12), it is easiest to find relevant prior art by looking at figures (in the correct classes), not by running keyword searches. The Examiner looked in the wrong classes, though, and thus apparently never saw the relevant figures in the Keeth reference.

Although the Examiner performed some keyword searches unrestricted by class, the Examiner did not use synonyms found in the Keeth reference. For example, the Examiner searched for “interconnect,” EX1002, 121, while Keeth repeatedly uses the phrase “conductive path[s]” to disclose the same thing, *see, e.g.*, EX1047, Abstract, 1:34–35, 1:41. The Examiner’s search was deficient.

Netlist argues the “Office committed no material errors during prosecution” because there were “four Worldwide prior art searches by . . . January 2024.” DD

Req. 15. But as explained above, the searches were in the wrong classes and used the wrong keywords. Furthermore, Netlist rewrote virtually every word of the claim **after** those four searches, EX1002, 746–50, but the Examiner never searched for the newly added limitations, such as “unidirectional,” despite later identifying that limitation in the reasons for allowance, *id.* 853–62. That was error. In any event, a unidirectional interconnect is another example of a simple concept easier to find in a figure (e.g., an arrow pointing in one direction) than with keywords:



Pet. 95–96.

Netlist also argues “two of the three references asserted in [the Petition’s] obviousness Grounds, including primary reference Keeth, were **considered** during prosecution.” DD Req. 16 (emphasis added). That is misleading. The primary reference, Keeth, was never **discussed**, see Pet. 39 (citing EX1003, ¶ 155), and instead was merely **cited** in an IDS containing hundreds of other references, see EX1002, 125, and the secondary reference, Shaeffer (shown directly above), was neither cited nor discussed, see Pet. 40 (citing EX1003, ¶ 161). Thus, the Examiner never considered the combination of Keeth and Shaeffer presented in the

Petition, see Pet. 5, 42–52 (Grounds 3–4), and even with respect to Keeth (which was merely cited in an IDS with an unusually large “volume of . . . references”), “the Examiner did not issue any prior art rejections during examination, so the Examiner materially erred by overlooking certain teachings,” such as the fact that Keeth discloses a structure nearly identical to what Netlist was trying to claim, as shown above (p.12). *Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13, at 5–7 & n.3 (PTAB May 19, 2025) (precedential).

Accordingly, there is no basis for discretionary denial and institution should be granted. 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]”); *Xencor, Inc. v. Merus N.V.*, IPR2025-00604, Paper 12, at 2–3 (PTAB July 17, 2025) (Acting Director) (similar); *Anthony Inc v. ControlTec LLC*, IPR2025-00559, Paper 12, at 2 (PTAB July 16, 2025) (Acting Director) (similar).

F. 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

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. 5–6 (citing EX2014, EX2017). *See* EX1065 (’339 patent), EX1097–99 (’918 and ’054 patents), EX1072–74 (’060 and ’160 patents), EX1100–01 (’912 patent), EX1102–03 (’417 patent). The 8th patent (the ’608 patent) survived Samsung’s IPR based on an extremely narrow claim construction that Netlist proposed in the PTAB — but not to the jury, which awarded \$12 million, *see* EX2017, 7 — resulting in an appeal of that IPR to the Federal Circuit that will be heard tomorrow, *see* EX1104. And with respect to the alleged breach of the JDLA agreement, *see* DD Req. 5, the court awarded Netlist only \$1 in nominal damages, *see* EX2009.

Netlist’s history of harassing Samsung with invalid patents weighs strongly against discretionary denial here. It also raises significant questions about Netlist’s representation that it is the ***only*** real party in interest in this proceeding. *See* Paper 5; 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 AI technology. *See, e.g.*, EX1118, 2 (“indispensable to...AI”), 5. Netlist concedes there are “important national security and economic interests,” DD Req. 19–20, 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 does not make any HBM products and operates at a significant loss as shown above.

G. 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 its retaliatory ITC action, *see* DD Req. 10–15.

Factors 1, 2, and 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. 11–12, 14–15. Netlist incorrectly focuses on the ITC’s **initial** determination date, *id.* 12, 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,” EX1123, 2 (emphasis added), as is true here, as explained below. Furthermore, only 11 of the 28 challenged claims (i.e., 39%) are at issue in the ITC, *see* EX2015 at 3 (¶ 7), meaning “the additional claims at issue here, but not in the ITC proceeding, weigh against exercising our discretion to deny institution,” *Volkswagen Grp. of Am., Inc. v. Arigna Tech. Ltd.*, IPR2021-01321, Paper 10, at 8 (PTAB Feb. 15, 2022) (ITC case involved only 44% of the challenged claims).

Factor 2 favors institution because the Final Written Decision here will beat the ITC and district court: The projected statutory deadline here is “March 4, 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 two 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 ’731, ’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* IPR2025-01431 (’731 patent, March 9, 2027); IPR2026-00017 (’035 patent, April 29, 2027); PGR2026-00001 and IPR2026-00018 (’366 patent, May 20, 2027). The appeal of the ’608 patent will be heard tomorrow, EX1104, meaning the Final Written Decision on remand should be completed in 2026, *see* SOP 3 (“within six months”), well ahead of 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.

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).

Factors 3, 5, and 6: The ITC action has not been instituted, and the district

court actions are still subject to motions to dismiss, *see* EX1106–07, 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). Although Samsung is a defendant/respondent in the parallel proceeding (Factor 5), the merits of the Petition are strong given the material errors by the Examiner discussed above (pp.7–15), which favors institution (Factor 6).

H. The parallel IPR petition (ranked second) is merely a subset of the Grounds in this PGR petition, creating no extra work

Given the “dispute about priority,” the Board has specifically recognized that “more than one petition may be necessary,” Paper 3, at 1, contrary to Netlist’s argument, *see* DD Req. 20. And the parallel IPR proceeding (ranked second) is a subset of the Grounds here, creating no extra work. Paper 3, at 1; EX1114.

I. 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 the Board’s familiarity with the related ’060 and ’160 patents and Netlist’s previous actions improperly circumventing the Board, as discussed above (pp.5–7).

III. CONCLUSION

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

Dated: December 4, 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."

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 4th 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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