UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner

v.

NETLIST, INC.,
Patent Owner

Case PGR2025-00071
U.S. Patent No. 12,308,087

PATENT OWNER'S REPLY TO PETITIONER'S OPPOSITION TO DISCRETIONARY DENIAL

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PATENT OWNER'S UPDATED EXHIBIT LIST

Exhibit No.	Description
2001	Joint Development and License Agreement, November 12, 2015
2002	Stock Purchase Warrant, November 18, 2015
2003	Senior Secured Convertible Promissory Note, November 18, 2015
2004	Security Agreement by and between Netlist, Inc. and SVIC No. 28 New Technology Business Investment L.L.P., November 18, 2025
2005	Samsung Venture Investment Corporation website, available at https://www.samsungventure.co.kr/english/jsp/company/company.jsp (last accessed October 12, 2025)
2006	Recorded Assignment and IP Security Agreement, Reel No. 037150, Frame No. 0897, November 20, 2015
2007	Release of Assignment, Reel No. 065629, Frame No. 0330, November 20, 2023
2008	Redacted First Amended Complaint for Breach of Contract and Declaratory Relief, *Netlist Inc. v. Samsung Electronics Co., Ltd.*, Case No. 8:20-cv-00993-JAK (C.D. Cal.), August 31, 2020
2009	Judgment, *Netlist Inc. v. Samsung Electronics Co., Ltd.*, 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, *Netlist Inc. v. Samsung Electronics Co., Ltd.*, Case No. 2:25-cv-00557 (E.D. Tex.), June 26, 2025
2012	Docket Control Order, *Netlist Inc. v. Samsung Electronics Co., Ltd.*, Case No. 2:25-cv-00557 (E.D. Tex.), July 25, 2025

Exhibit No.	Description
2013	First Amended Complaint, *Netlist Inc. v. Samsung Electronics Co., Ltd.*, Case No. 2:25-cv-00557 (E.D. Tex.), July 8, 2025
2014	Verdict Form, *Netlist, Inc. v. Samsung Electronics Co. et al.*, Case No. 2:21-cv-00463-JRG (E.D. Tex.), April 21, 2023
2015	Complaint, *In the Matter of Certain Dynamic Random Access Memory (DRAM) Devices, Products Containing the Same, and Components Thereof*, Investigation No. 337-TA-3854 (I.T.C.), September 29, 2025
2016	Samsung Defendants' P.R. 3-3 Invalidity Contentions, *Netlist Inc. v. Samsung Electronics Co., Ltd.*, Case No. 2:25-cv-00557 (E.D. Tex.), September 24, 2025
2017	Verdict Form, *Netlist, Inc. v. Samsung Electronics Co. et al.*, 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," *The Wall Street Journal*, September 26, 2025, accessible at https://www.wsj.com/economy/trade/trump-chip-tariffs-exemptions-90fa2ab3 (last accessed September 26, 2025)
2022	Netlist, Inc. Form 8-K, United States Securities and Exchange Commission, November 12, 2015
2023	"Netlist and SK hynix Enter into Strategic Agreements for Patents, Technology and Product Supply," Netlist Press Release, April 5, 2021

Exhibit No.	Description
2024	Comparison of Claim 1 of U.S. Patent No. 12,308,087 with Claim 1 of U.S. Patent No. 8,787,060 and Claim 1 of U.S. Patent No. 9,318,160
2025	Written Decision on Registration, Korean Patent Application No. 10-2017-0113355, mailed March 24, 2022
2026	U.S. Patent No. 10,026,724 to Kim et al., issued July 17, 2018
2027	Opening Brief for Appellant Netlist, Inc., *Netlist, Inc. v. Samsung Electronics Co., Ltd.*, Case No. 24-2240 (Fed. Cir.), February 4, 2025
2028	Joint Appendix Volume II of II, *Netlist, Inc. v. Samsung Electronics Co., Ltd.*, Case No. 24-2240 (Fed. Cir.), May 28, 2025
2029	Morris, A., "IPBC Global 2025: Acting USPTO Director says IPR use needs to change," *IAM*, June 10, 2025, accessible at https://www.iam-media.com/article/ipbc-global-2025-acting-uspto-director-says-ipr-use-needs-change (last accessed June 16, 2025)
2030	"Precedential designation of *Corning Optical Communications RF, LLC v. PPC Broadband Inc.*, IPR2014-00440, Paper 68 (PTAB Aug. 18, 2015) (except for § II.E.1)," United States Patent and Trademark Office Memorandum, October 28, 2025
2031	Public Redated Version of Complaint for Declaratory Judgment of Non-Infringement, *Samsung Electronics Co., Ltd. et al. v. Netlist, Inc.*, Case No. 1:25-cv-00626-JLH (D. Del.), May 20, 2025
2032	Public Redated Version of Proposed First Amended Complaint for Declaratory Judgment of Non-Infringement, *Samsung Electronics Co., Ltd. et al. v. Netlist, Inc.*, Case No. 1:25-cv-00626-JLH (D. Del.), July 29, 2025

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

Exhibit No.	Description
2043	Complaint, *Netlist, Inc. v. Samsung Elecs. Co., Ltd. et al.*, Case No. 2:25-cv-00748-JRG (E.D. Tex.), July 28, 2025
2044	Complaint, *Samsung Elecs. Co., Ltd. et al. v. Netlist, Inc.*, Case No. 1:25-cv-01371-JLH (D. Del.), November 11, 2025
2045	Commission Determination, *In the Matter of Certain Unmanned Aerial Vehicles and Components Thereof*, Investigation No. 337-TA-1133 (I.T.C.), September 8, 2020

I. THE ITC IS THE BEST FORUM TO RESOLVE THE DISPUTE.

To stop Samsung's rampant, ongoing infringement, Netlist asserted six patents against Samsung at the ITC: Patent Nos. 9,824,035; 10,025,731; 10,217,523; 10,268,608; 12,308,087; and 12,373,366. EX2015; Paper 8 ("DD Br."), 5-7. Samsung's prior license to Netlist's portfolio should foreclose PTAB review. DD Br., 8-11. Nevertheless, per its typical playbook, Samsung filed a bevy of IPR and PGR petitions against four of the patents: IPR2025-01402 ('087), PGR2025-00071 ('087), IPR2025-01431 ('731), IPR2026-00017 ('035), IPR2026-00018 ('366), and PGR2026-00001 ('366). Samsung is estopped from challenging the '523 and '608 patents. DD Br., 10-11. 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.

A. Samsung is estopped from challenging two of the six ITC patents.

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. Regarding the '608 patent, Samsung argued in its Opposition that the Federal Circuit would remand the '608 appeal. Opp., 19. That proved incorrect; the Federal Circuit affirmed. And Samsung made no attempt to update the PTAB after it lost the appeal.

Samsung touts that the '608 patent was targeted again in *ex parte* reexam

No. 90/015,449, which was filed anonymously. IPR2025-01431, Paper 11, 15. This reexam should also be terminated as an improper serial challenge. EX2042. And because Samsung is intent on invaliding the '608 patent, the Director should order Samsung to confirm that it did not play *any role* in requesting this reexam.

B. Samsung's Petitions fail to name all real parties in interest (RPIs).

All Samsung's Petitions against the other four asserted patents suffer the same fatal and incurable defect: they fail to name all RPIs. Samsung's Petitions against the '087 and '731 patent fail to name Samsung Electronics America, Inc. ("SEA") and Avnet, Inc. ("Avnet") as RPIs. IPR2025-01402, POPR, 8-17; PGR2025-00071, POPR, 8-17; IPR2025-01431, POPR, 4-13. SEA is a subsidiary of Petitioner Samsung Electronics Co., Ltd. ("SEC") and parent of RPI Samsung Semiconductor, Inc. ("SSI"). EX2034, 1. Along with SEC and SSI, SEA is a respondent at the ITC, a co-defendant in related EDTX litigation, and a co-plaintiff in a DJ action in Delaware. POPR, 11-12. Avnet, Samsung's customer, is also a co-defendant in EDTX and a co-plaintiff in the Delaware DJ action. POPR, 14-15.

Samsung's Petitions against the '366 and '035 patents are similarly defective. In its '366 Petition, Samsung fails to name SEA and Avnet as RPIs. IPR2026-00018, Pet., 1 (naming SEC and SSI); PGR2026-00001, Pet., 1 (same). Both are co-defendants in EDTX litigation and DJ co-plaintiffs. EX2043, 1; EX2032, 2. And SEA is a respondent at the ITC. EX2015, 3. In its '035 Petition, Samsung fails

to name SEA. IPR2026-00017, Pet., xvii (SEC and SSI). SEA is a respondent at the ITC and a co-plaintiff in a DJ action against the '035 patent. EX2044, 1.

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.

C. The ITC is the fastest forum for resolving the parties' dispute.

Fintiv factors 1-4 show that the ITC is not only the best but also the fastest forum for resolving the dispute. **Factor 1:** Samsung misrepresents *Certain Unmanned Aerial Vehicles*. There, the ITC did not stay an investigation pending PTAB review. Opp., 17-18. Rather, after *completing* the investigation, the ITC delayed enforcing the remedial orders. EX2045, *21. The ITC case here will proceed regardless of the outcome of these IPRs. And even if the co-pending district court case with Samsung is stayed because of the ITC case, the suit with Micron will move forward. Trial is scheduled in March 2027. DD Br., 12.

Factor 2: The Government shutdown delayed institution at the ITC, which should occur December 29, 2025. Paper 14. Samsung argues that ITC's Final Determination will issue in 18.2 months, after the FWD deadline. Opp., 18. But Samsung ignores that—even under its estimated schedule—the ITC hearing and initial determination should occur before the FWD deadline. Opp., 17-18. The Director should deny institution based on the hearing and initial determination. DD Br., 13.

Factors 3-4: The investment and overlap factors favor denial. Samsung has not made *any* stipulation to forgo overlapping invalidity challenges. DD Br., 15. And while Samsung withdrew its inconsistent claim constructions in EDTX, Samsung has not agreed to forgo those theories at the ITC. POPR, 17-22; EX1125.

D. There are no material errors for the PTAB to correct.

Samsung's attempts to show material error fail. The specification provides written description support for the '087 claims. *See* POPR, 22-49. And Samsung's KPop analogy is off pitch because Netlist (who understands the difference between patent and copyright) did not try to patent a song. *See* Opp., 9. Finally, Samsung's argument that the examiner's search was inadequate (it wasn't) is irrelevant; all agree that two of the three references—including the primary reference Keeth—were before the examiner. Pet., 11, 14. No search was required to find them.

E. The PTAB is not the best forum for Samsung to pursue its frivolous allegation that Netlist receives funding from "nefarious" sources.

Samsung's baseless accusation that Netlist receives funding from "nefarious" sources is entirely without merit. Netlist is a U.S. publicly traded company that routinely files SEC disclosures, which Samsung knows. Opp., 16-17 (EX1094-EX1096). This desperate attempt to cast Netlist as a bad actor—an attempted distraction from Samsung's contract breaches and willful infringement, DD Br., 5-6 (multiple jury verdicts)—should be flatly rejected. In any event, the PTAB affords limited discovery and is not the right forum to pursue this frivolous accusation.

Respectfully submitted,

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

I certify that the above-captioned **PATENT OWNER'S REPLY TO PETITIONER'S OPPOSITION TO DISCRETIONARY DENIAL** and associated Exhibits 2040-2045 were served in their entireties on December 18, 2025, upon the following parties via electronic mail:

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