

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,

Petitioner,

v.

NETLIST, INC.,

Patent Owner

PGR2026-00001

Patent 12,373,366

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

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. ARGUMENT	1
A. Early challenges to patentability, like here, are favored and weigh against discretionary denial	1
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 ’366 patent application was filed.....	1
C. Samsung’s successful challenges to the related ’918 and ’054 patents created “settled expectations” for Samsung and weigh against discretionary denial	3
D. Netlist should not be rewarded for circumventing the Board by refusing to amend the claims during the ’918 and ’054 IPRs and instead presenting new claims to the Examiner in the ’366 prosecution that try to cover the same DDR5 DIMM products that Netlist had tried to cover with the ’918 and ’054 claims	4
E. The Examiner materially erred during prosecution	5
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 possible combinations	5
2. The Examiner materially erred with respect to obviousness under § 103 by overlooking the <u>Perego</u> reference disclosing the same DDR5 DIMM structure Netlist was trying to claim....	8
F. The ITC is <u>not</u> the best forum to resolve the parties’ dispute, given that this proceeding is far ahead of the ITC, only 7 of the 38 challenged claims (i.e., 18%) are at issue in the ITC, and given the large number and wide scope of patents asserted in the ITC.....	10

G.	The <i>Fintiv</i> factors favor institution, given that this proceeding is far ahead of Netlist’s belated ITC action	12
H.	The Petition correctly named the Real Parties in Interest.....	15
I.	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.....	19
J.	Netlist’s arguments improperly circumvent the Board	20
III.	CONCLUSION.....	20

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<i>Celgene Corp. v. Peter</i> , 931 F.3d 1342 (Fed. Cir. 2019)	3
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Statutes

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35 U.S.C. § 103.....	5, 8
35 U.S.C. § 112.....	5
35 U.S.C. § 316(b)	5
35 U.S.C. § 325(d)	7
35 U.S.C. § 325(e)(2).....	13

Regulations

37 C.F.R. § 1.550(a).....	14
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37 C.F.R. § 42.73(d)(3).....	4, 18
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1128	Final Written Decision, <i>Samsung Electronics Co., Ltd. et al. v. Netlist, Inc.</i> , IPR2022-00711, Paper 42 (PTAB Oct. 17, 2023) (U.S. Patent No. 10,860,506)
1129	Denying Patent Owner's Request on Rehearing of Final Written Decision, <i>Samsung Electronics Co., Ltd. et al. v. Netlist, Inc.</i> , IPR2022-00711, Paper 44 (PTAB Dec. 20, 2023) (U.S. Patent No. 10,860,506)
1130	Judgment Affirming Final Written Decision in IPR2022-00711, <i>Netlist, Inc. v. Samsung Electronics Co., Ltd. et al.</i> , No. 2024-1521 (Fed. Cir. Dec. 9, 2025) (U.S. Patent No. 10,860,506)
1131	Notice of Institution of Investigation No. 337-TA-1472, 91 Fed. Reg. 155 (Jan. 2, 2026), <i>available at</i> https://www.federalregister.gov/documents/2026/01/02/2025-24146/certain-dynamic-random-access-memory-dram-devices-products-containing-the-same-and-components >
1132	Order No. 11: Initial Determination Amending the Target Date, <i>In the Matter of Certain Dynamic Random Access Memory (DRAM) Devices, Products Containing the Same, and Components Thereof</i> , Inv. No. 337-TA-1472 (USITC Jan. 27, 2026), <i>available at</i> https://edis.usitc.gov/external/search/advanced.html?invId=8817 >
1133	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 >

Exhibit #	Description
1134	Memorandum re: Interim Processes for PTAB Workload Management (Mar. 26, 2025), <i>available at</i> https://www.uspto.gov/subscription-center/2025/uspto-issues-new-interim-process-concerning-institution-aia-proceedings
1135	Memorandum re: Final Written Decision Procedures for AIA Trial Proceedings (July 29, 2025), <i>available at</i> https://www.uspto.gov/subscription-center/2025/ptab-issued-memorandum-aia-trials
1136	Memorandum re: Guidance on USPTO’s recission 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
1137	Samsung Electronics America, Inc. (“SEA”)’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)
1138	Declaration of James Kiczek (SEA), <i>Netlist, Inc. v. Samsung Electronics Co., Ltd. et al.</i> , No. 2:25-cv-00557 (E.D. Tex. Sept. 11, 2025)
1139	Declaration of Danny Kim (SSI), <i>Netlist, Inc. v. Samsung Electronics Co., Ltd. et al.</i> , No. 2:25-cv-00557 (E.D. Tex. Sept. 11, 2025)
1140	Order determining Google is not a Real Party-in-Interest or Privy of Samsung, <i>Samsung Electronics Co., Ltd. v. Netlist, Inc.</i> , IPR2022-00615, Paper 64 (PTAB July 13, 2023)
1141	Complaint for Declaratory Judgment, <i>Samsung Electronics Co., Ltd. and Samsung Semiconductor, Inc. v. Netlist, Inc.</i> , No. 1:25-cv-01453 (D. Del. filed Oct. 15, 2021)
1142	Samsung Semiconductor, About Us, <i>available at</i> https://semiconductor.samsung.com/about-us/locations/us/
1143	Samsung Semiconductor, Inc., Articles of Incorporation in California (July 13, 1992), <i>available at</i> https://bizfileonline.sos.ca.gov/search/business
1144	Samsung Semiconductor, Inc., California Statement of Information (Apr. 15, 2025), <i>available at</i> https://bizfileonline.sos.ca.gov/search/business

Exhibit #	Description
1145	Samsung investments in the United States, <i>available at</i> <https://semiconductor.samsung.com/sas/company/taylor/>
1146	U.S. Patent No. 10,025,731
1147	Netlist’s Notice of Patent Priority Dates, <i>In the Matter of Certain Dynamic Random Access Memory (DRAM) Devices, Products Containing the Same, and Components Thereof</i> , Inv. No. 337-TA-1472 (USITC Feb. 4, 2026), <i>available at</i> <https://edis.usitc.gov/external/search/advanced.html?invId=8817>
1148	Amended Complaint, <i>Netlist, Inc. v. Samsung Electronics Co., Ltd. et al.</i> , No. 2:21-cv-00463 (E.D. Tex. filed May 3, 2022)
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
2010–13	[intentionally omitted]
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

Exhibit #	Description
2016	[intentionally omitted]
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	[intentionally omitted]
2023	“Netlist and SK hynix Enter into Strategic Agreements for Patents, Technology and Product Supply,” Netlist Press Release, April 5, 2021
2024	“Precedential designation of <i>Corning Optical Communications RF, LLC v. PPC Broadband Inc.</i> , IPR2014-00440, Paper 68 (PTAB Aug. 18, 2015) (except for § II.E.1),” 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	[intentionally omitted]
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

Exhibit #	Description
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)
2030–39	[intentionally omitted]
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 Electronics Co., Ltd. v. Netlist, Inc.</i> , Appeal No. 25-1378 (Fed. Cir.), December 9, 2025
2042	[intentionally omitted]
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
2044–46	[intentionally omitted]
2047	Company Profile, Avnet, Inc., accessible at https://s23.q4cdn.com/291570380/files/doc_downloads/factsheet/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)
2049–52	[intentionally omitted]
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)

Exhibit #	Description
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

Netlist’s request for discretionary denial (“DD Req.”) should be denied for many reasons, including the Final Written Decisions invalidating the related ’918 and ’054 patents, and the fact this proceeding is far ahead of Netlist’s ITC action.

II. ARGUMENT

A. Early challenges to patentability, like here, are favored and weigh against discretionary denial

Samsung filed this PGR petition quickly — less than four months after the ’366 patent issued, and *before* Netlist’s retaliatory ITC action was instituted — which weighs against discretionary denial: “Petitions for post-grant review are favored because they must be filed no later than nine months from the grant of the patent . . . , are close in time to examination, and occur before expectations in the patent rights are strongly settled.” *Multi-Color Corp. v. Brook & Whittle Ltd.*, PGR2025-00025, Paper 10, at 2–3 (PTAB July 16, 2025) (precedential); *see also Straumann USA, LLC v. Smart Denture Conversions, LLC*, PGR2025-00054, Paper 11, at 2 (PTAB Oct. 17, 2025) (Acting Director); *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 ’366 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, 7–10. But Netlist asserts it “terminated the JDLA on July 15, 2020,” DD Req. 5, long before the ’366 patent application was filed in 2022, see EX1001, thus defeating all of Netlist’s arguments premised on the JDLA. Furthermore, the ’366 patent is asserted against “high-speed” “DDR5 generation DIMMs,” see EX2015, 20 (¶ 49), 11–12 (¶¶6–7), 19 (¶39), 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 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 ’366 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 “parents of the ’366 patent,” DD Req. 8, but Netlist omits that Samsung filed IPRs against those parent patents (the ’054 and ’918 patents, *see* EX1001, 2), which resulted in Final Written Decisions ***invalidating all 60 claims*** of the ’918 and ’054 patents, *see* EX1070–72, thus creating “settled expectations” for Samsung, not for Netlist, as explained below. Given that Samsung successfully challenged the ’918 and ’054 patents, Netlist certainly could not have had “settled expectations” with respect to the related ’366 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.”).

For similar reasons, Netlist’s license with SK hynix in 2021 did not create settled expectations, *see* DD Req. 7, 9, because the ’366 patent did not exist in 2021, and the patents that did exist (the ’918 and ’054 patents) were found invalid.

C. Samsung’s successful challenges to the related ’918 and ’054 patents created “settled expectations” for Samsung and weigh against discretionary denial

Samsung’s successful challenges to the related ’918 and ’054 patents — prior to issuance of the ’366 patent — created “settled expectations” for Samsung with respect to its DDR5 DIMM products and weigh against discretionary denial

here. *See, e.g.*, EX1134, 2 (identifying “[s]ettled expectations of the parties” as relevant); *POSCO Co. v. ArcelorMittal*, IPR2025-00370, Paper 10, at 2–3 (PTAB June 25, 2025) (Acting Director) (“It is an appropriate use of Office resources 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)...”); *Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12, at 3 (PTAB July 16, 2025) (informative) (similar).

Netlist sued Samsung almost ***four years*** ago asserting that Samsung’s DDR5 DIMM products infringed Netlist’s ’918 and ’054 patents. *See* EX1148, 46–48, 55–57. In response, Samsung filed IPRs, resulting in Final Written Decisions ***invalidating all 60 claims*** of the ’918 and ’054 patents. *See* EX1070–72. Netlist is upsetting Samsung’s settled expectations and taking a third bite at the apple by asserting the recently issued ’366 patent against those ***same*** DDR5 DIMM products. *See* EX1100, 13 (¶34); EX2015, 11–12 (¶¶6–7), 19 (¶39).

D. Netlist should not be rewarded for circumventing the Board by refusing to amend the claims during the ’918 and ’054 IPRs and instead presenting new claims to the Examiner in the ’366 prosecution that try to cover the same DDR5 DIMM products that Netlist had tried to cover with the ’918 and ’054 claims

Samsung’s “settled expectations” are especially strong given that Netlist could have — but did not — try to amend the claims of the ’918 and ’054 patents during those IPRs to reflect the claim language now found in the ’366 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 '918 and '054 IPRs and instead presenting new claims to the Examiner in the '366 prosecution that try to cover the same DDR5 DIMM products that Netlist had tried to cover with the '918 and '054 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 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 possible combinations. *Compare* Pet. 24–28 (“laundry list”), *with Duke Univ. v. Sandoz Inc.*, 160 F.4th 1305, 1316 (Fed. Cir. 2025) (“laundry list”).

The written description of the ’366 patent says over 100 times that certain features “may” (or may not) be included in “certain” embodiments (without ever identifying any particular embodiment). *See generally* EX1001. The claims allowed by the Examiner, in contrast, state directly the opposite: they **require** an extraordinarily specific combination, as reflected by the extraordinary length of each independent claim (over 900 words). *See* Pet. 26–27. That specificity is found nowhere in the ’366 patent. Netlist impermissibly drafted the claims of the ’366 patent in hindsight to try to cover the DDR5 DIMM standard released in 2020, without any written description in the patent for the claimed combination as of 2008. Pet. 22–23, 27–43; EX1147, 2 (claiming priority to “June 2, 2008”).

During prosecution, Netlist and the Examiner purported to identify written description support for limitations ***in isolation***, *see* Pet. 31–33, 38 (citing EX1003, ¶¶ 122–23, 127; EX1002, 1441–42, 1437–38); DD Req. 16–17, 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. 25 (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)). 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. 24 (quoting *Rivera v. ITC*, 857 F.3d 1315, 1322 (Fed. Cir. 2017)). The Examiner materially erred by failing to do that.

Netlist asserts institution should be discretionarily denied under 35 U.S.C. § 325(d) and *Advanced Bionics* because “substantially the same arguments regarding the claims’ written description support were considered by the Examiner.” DD Req. 16. But the Examiner’s analysis for written description was backwards, as explained above, and the claims were significantly amended afterwards, see EX1003, ¶¶103–11, and there is no evidence the Examiner found written description for the **combination** of the specific limitations discussed in the Petition, see Pet. 27–46 (“at least,” enabling groups of SDRAM “independently,” receiving power “only” via regulated voltage lines, and an “additional trigger condition”) — let alone **all** the limitations in the issued claims, see Pet. 26–27.

Accordingly, there is no basis for discretionary denial. See, e.g., *Adello*

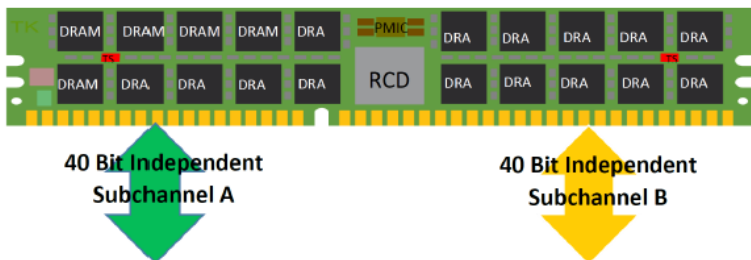
Biologics LLC v. Amgen Inc., PGR2019-00001, Paper 13, at 10–11 & n.8 (PTAB Apr. 19, 2019); *Lifescan Global Corp. v. Ikeda Food Research, Ltd.*, PGR2019-00032, Paper 11, at 11–15 (PTAB Aug. 15, 2019).

2. The Examiner materially erred with respect to obviousness under § 103 by overlooking the Perego reference disclosing the same DDR5 DIMM structure Netlist was trying to claim

The Examiner also materially erred with respect to obviousness under § 103.

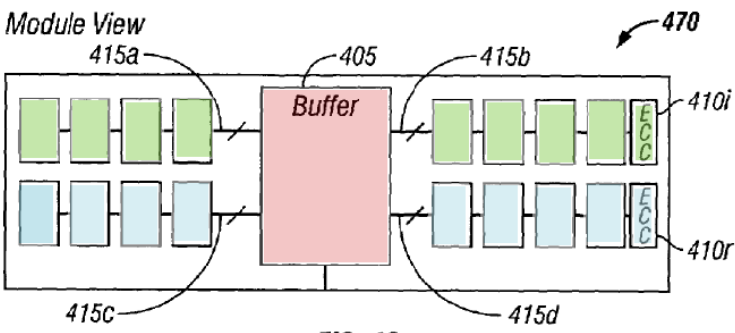
During prosecution of the '366 patent, the Examiner failed to reject the claims — which purport to cover the structure for a DDR5 DIMM with *two* “[s]ubchannel[s]” (shown below) — despite a prior-art reference called “Perego” disclosing a nearly identical structure, also with *two* “channels” (further below):

DDR5 DIMM allegedly covered by the claims of the '366 patent



See Pet. 23; EX2015, 11–12 (¶¶6–7), 19 (¶39).

Prior art (“Perego,” EX1035)



See Pet. 47, 113–16; EX1035, 21:16-20 (“two channels 415c and 415d”).

Netlist argues “the art in the Petition was before the Examiner.” DD Req. 16. To the contrary, the Examiner never considered the Perego reference shown above (or “substantially the same prior art or argument”), *see* Pet. 47, meaning part one of *Advanced Bionics* is not satisfied. *See Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13, at 3 (PTAB May 19, 2025) (precedential). And Perego above shows the Examiner materially erred, especially since the Examiner relied on the structure shown above as the reasons for allowance. EX1002, 1623–24; EX1003, ¶109. Netlist argues it “submitted an IDS identifying IPR2022-00615 in which Samsung challenged another Netlist patent using the Perego reference,” DD Req. 16 (citing EX1002, 392), but the Examiner specifically did **not** consider IPR2022-00615, *see* EX1002, 463 (“EXCEPT WHERE LINED THROUGH”), and Netlist **never** submitted Perego to the Examiner, so there is no evidence the Examiner ever considered Perego. Furthermore, the unusually large “volume of . . . references” submitted by Netlist during prosecution without any “assistance regarding the relevance of references” (*see, e.g.*, EX1002, 209–16, 240–45, 269–74, 379–86, 392–99, 507, 544–46) made it highly unlikely the Examiner would be able to pick out the citation to Perego in **another document** that Netlist now relies upon. *Ecto World*, IPR2024-01280, Paper 13, at 6–7 & n.3.

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. The ITC is not the best forum to resolve the parties’ dispute, given that this proceeding is far ahead of the ITC, only 7 of the 38 challenged claims (i.e., 18%) are at issue in the ITC, and given the large number and wide scope of patents asserted in the ITC

Netlist is incorrect that “[t]he ITC is the best forum to resolves the parties’ dispute,” DD Req. 10–11, for at least three reasons:

First, this proceeding is far ahead of the ITC, as discussed below (pp.12–15).

Second, only 7 of the 38 challenged claims (i.e., 18%) are at issue in the ITC, *see* EX2015, 12 (¶ 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).

Third, “[t]he large number and vast scope of the patents asserted in the district court [and ITC] litigation[s] 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. *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9, at 3 (PTAB June 13, 2025) (informative) (citation omitted); *Samsung Elecs. Co. v. Wilus Inst. of Standards & Tech. Inc.*, IPR2025-00933, Paper 11, at 3 (PTAB Oct. 10, 2025) (similar); *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 are: (1) the ’366 patent (at issue here) on “power management,” EX2015, 21, ¶ 49, which is related to two patents where the Board invalidated 60 claims, EX1070–72; (2) the ’087 patent on “high bandwidth” memory, EX2015, 27, ¶ 100, which is at issue in PGR2025-00071 (instituted on February 18th), and is related to two patents where the Board invalidated 54 claims, EX1122–24; (3) the ’731 patent on “impedance mismatch,” EX2015, 22, ¶ 59, which is at issue in IPR2025-01431 (instituted on February 18th) and related to three patents where the Board invalidated 99 claims, see EX1146, 1:28–:44; EX1117–21; (4) the ’035 patent on “data buffers,” EX2015, 26, ¶ 90; see also *id.* 23, ¶ 70, which is at issue in IPR2026-00017 and related to the ’506 patent where the Board invalidated 20 claims, EX1128–30; and (5) the ’523 patent on “testing,” EX2015, 24, ¶ 80, which was stayed for years, EX1125.

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

The *Fintiv* factors favor institution given that this proceeding is far ahead of Netlist’s belated ITC action. Netlist’s arguments (DD Req. 11–14) are incorrect.

Factors 1–4: Factors 1–4 favor institution because the Final Written Decision here will easily beat the ITC’s Final Determination: The projected statutory deadline here is “May 20, 2027.” DD Req. 12. Netlist’s belated ITC action, in contrast, was only instituted several weeks ago, EX1131, and has a target date for a Final Determination on “September 3, 2027,” EX1132, 2, which is ***3.5 months after*** the statutory deadline here.

Given that this proceeding is far ahead of Netlist’s belated ITC action, 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). Netlist’s arguments for Factors 1 and 4 about the lack of a “stay,” “inefficiency,” and “overlap[]” are thus incorrect. DD Req. 11, 13–14. Netlist argues that “Samsung has not submitted *any stipulation* that it will forgo overlapping validity challenges at the ITC or in the EDTX proceeding,” DD Req. 13, but that is because the EDTX case will soon be stayed, *see* 28 U.S.C. § 1659(a) (“shall stay”), and this proceeding is so far ahead of the ITC that Samsung has not yet served any

invalidity contentions in the ITC and the statutory estoppel under 35 U.S.C. § 325(e)(2) moots the need for a stipulation: everyone (including the ITC) will know as soon as this proceeding is instituted that Samsung will be estopped under § 325(e)(2) **months** before the target date for the ITC to decide validity, thus obviating any reason for the ITC to ever consider those invalidity arguments (either before or after the estoppel) or for Samsung to ever pursue invalidity arguments that will be estopped.

Factor 2 strongly favors institution as shown above. Netlist incorrectly focuses on the ITC’s **initial** determination and hearing dates, DD Req. 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,” EX1136, 2 (emphasis added), as is true here, as explained above. *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)). In any event, given the new streamlined “summary notice to the parties granting institution,” EX1133, 2 — which allows for faster institution decisions — it is reasonably likely that the Final Written Decision here would also beat the ITC’s **initial** determination on “May 3, 2027,” EX1132, 2. Finally, as explained in the previous paragraph, in light of *Certain Unmanned Aerial Vehicles* and the estoppel under § 325(e)(2), there is no risk of

inconsistent decisions or duplication of effort in the ITC. Indeed, as discussed above (p.10), only 18% of the challenged claims are at issue in the ITC.

Factor 3 also favors institution because Netlist's belated ITC action was only instituted several weeks ago, EX1131, making it highly likely that "at the time of the [PTAB's] institution decision, the [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).

Netlist is therefore incorrect that the ITC is "a *faster* forum to determine validity." DD Req. 11. 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, '731, and '035 patents are subject to petitions with an expected Final Written Decision months ahead of the ITC's target date of September 3, 2027, *see* EX1132, 2, meaning the ITC will defer to the PTAB as explained above. *See* PGR2025-00071 ('087 patent, February 18, 2027); IPR2025-01431 ('731 patent, February 18, 2027); IPR2026-00017 ('035 patent, no later than April 29, 2027). The '608 patent is the subject of an *ex parte* reexam, *see* EX1126, which was filed 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 USPTO proceeding, but that patent has been stayed in district court ***for over two years*** (without Netlist filing an ITC action until now), EX1125,

showing its lack of importance to the parties' dispute.

Factors 5 and 6: Although Samsung is a defendant/respondent in the parallel ITC proceeding (Factor 5), the merits of the Petition are strong given the material errors by the Examiner as discussed above (pp.5–10), which favors institution (Factor 6).

H. The Petition correctly named the Real Parties in Interest

Netlist is incorrect that the Petition “fails to name [SEA] and [Avnet] as RPIs.” DD Req. 14–16. This is the same argument Netlist raised in IPR2025-01431 (which was instituted), PGR2025-00071 (which was instituted), and IPR2025-01402 (which was ranked second to PGR2025-00071), and it is incorrect for the same reasons provided in those proceedings, which are summarized here:

SEA and Avnet are merely alleged purchasers or users of the accused products, and not the *real* parties in interest, which the Petition correctly identifies as SEC (Korea) — the Petitioner, “responsible for manufacturing the Accused [Products]” — and SSI (California), the subsidiary of SEC (Korea) “responsible for marketing and facilitating sales of [the Accused Products] in the United States.” EX1137, 3–4; *see also* Paper 1, 1 (“The real parties in interest are the Petitioner, [SEC (Korea)]; and [SSI (California)]”); Paper 2 (power of attorney by SEC (Korea)); EX2015, 11–12 (¶¶6–7), 19 (¶39) (accusing DDR5 DIMMs of infringing the ’366 patent).

SEA, in contrast, is a different subsidiary of SEC (Korea) that is **not** responsible for the Accused Products and instead “focuses on commercializing Samsung end-user products, such as consumer electronics products and mobile devices,” which are **not** accused of infringing the ’366 patent. EX1137, 4. And Avnet, as Netlist admits, is merely an alleged “customer” of the Accused Products, DD Req. 15; EX2025, 2, and thus not a “‘true defendant’ in the dispute,” *In re Nintendo of Am., Inc.*, 756 F.3d 1363, 1365 (Fed. Cir. 2014). Netlist has repeatedly named SEA and Avnet as token defendants to try to establish venue in the Eastern District of Texas, EX1100, ¶¶ 11, 13, which Samsung disputes is proper, *see* EX1137, and is why SEA and Avnet have joined in mirror-image declaratory judgment actions asserting venue is proper in Delaware, *see* EX2025. In the original lawsuit, before any disputes about venue in Texas, only SEC (Korea) and SSI (California) were named in Delaware, *see* EX1141, given they are the only **real** parties in interest.

Netlist has had in its possession for months — but failed to disclose to the Board — declarations confirming the facts above, including the following:

- “SSI [California] is responsible for marketing and facilitating sales of Samsung HBM and dual in-line memory module (‘DIMM’) products in the United States....SEC [Korea] is responsible for manufacturing the Accused Products, and it does so only outside the United States.” EX1139, ¶¶ 5–6.

- “SEA focuses on end-user products. HBM and dual in-line memory modules (‘DIMMS’) are stand-alone DRAM components and are not end-user products. SEA has not designed, manufactured, marketed, offered for sale, or sold stand-alone DRAM products or imported them into the United States since at least 2019.” EX1138, ¶ 7.

Unsurprisingly, given these facts, Petitioner has consistently named only SEC (Korea) and SSI (California) as the real parties in interest, and never SEA or any customers, in over 15 petitions against Netlist over the past four years in cases involving HBM and DIMMs. *See, e.g.*, IPR2022-00062 to -64; IPR2022-00615; IPR2022-00639; IPR2022-00711; IPR2022-00996; IPR2022-00999; IPR2022-01427 to -28; IPR2023-00454 to -55; IPR2023-00847; IPR2025-00001 to -02. Netlist points to other petitions naming SEA, *see* DD Req. 16, but they involved different patents and accused products.

Netlist has never argued, in any of the previous 15 petitions over the past four years, that SEA is a real party in interest under *AIT* or *RPX* (despite Netlist repeatedly naming SEA as a token defendant in the related litigation). And the Board has specifically rejected Netlist’s argument under *AIT* and *RPX* that a **customer** (such as Avnet or SEA) becomes a real party in interest or privy simply because Netlist has named that customer as a defendant in related litigation:

Petitioner [SEC (Korea)] contends that it is the real party-in-interest in this proceeding and that the relationship between [its customer] Google and Petitioner is nothing more than a ‘standard customer-

manufacturer relationship for the [accused] product’ Petitioner’s and Google’s interests are aligned insofar as they have been accused of infringing the same patent, but the evidence shows that they are acting independently, and that Petitioner did not file the Petition at the behest of or on behalf of Google. . . . Petitioner provides compelling authority that a manufacturer-customer relationship alone does not establish privity, even with indemnity provisions.

EX1140, 13, 14, 23; EX1120, 3.

There is no basis to permit Netlist to relitigate “real party in interest” and privity under *AIT* and *RPX* now, after so many years and petitions, and after losing on these issues in the past as shown above. 37 C.F.R. § 42.73(d)(3). Netlist now argues that SEA is an RPI because “SSI is a wholly-owned subsidiary of SEA,” DD Req. 15, but that is incorrect: “The traditional rule is that mere status as a corporate parent is insufficient to render an entity an RPI (or even a privy).” *Syngenta Crop Protection AG v. FMC Corp.*, PGR2020-00028, Paper 8, at 15 (PTAB Sept. 15, 2020). Nor is it sufficient that SEA and Avnet are named as token defendants in litigation or are customers, as explained above. The relevant factors here are the **opposite** of *AIT*/*RPX*, given “[m]ost critically” that SEA and Avnet did not “pa[y]” Petitioner to “reduce” their “exposure” and given that Petitioner has the “apparent risk of infringement liability” while they have little to none in comparison. *RPX*, IPR2015-01750, Paper 128, at 31; EX1140, 18–19. In sum, Petitioner correctly named its RPIs, unlike Netlist, as explained below.

I. 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, DD Req. 5–6 (citing EX2014, EX2017). *See* EX1118–19 (’339 patent), EX1070–72 (’918 and ’054 patents), EX1122–24 (’060 and ’160 patents), EX1120–21 (’912 patent), EX1090–92 (’417 patent). The 8th patent (the ’608 patent) is the subject of an ongoing *ex parte* reexam. *See* EX1126. 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 lavish spending on litigation, despite being a “small U.S. company,” DD Req. 2, raises significant questions about Netlist’s representation that it is the **only** real party in interest. *See* Paper 6; 37 C.F.R. § 42.8(a)(2), (b)(1). Over the past four years, Netlist has spent far more on “legal fees” — over \$100 million — than its “[g]ross profit” of \$21.7 million. *See* EX1114, 53; EX1115, 59; EX1116, 6. 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, given Samsung’s critical contributions to this country’s dominance in computing technology. *See* EX2024, 2 (“Opaque

investment structures...by foreign adversaries”). Netlist concedes there are “important national security and economic interests” in this area. DD Req. 20.

Netlist asserts that its licensee SK hynix “plans to invest \$3.87 billion in Indiana,” DD Req. 20, but there is no evidence that SK hynix’s planned facility in Indiana has any relevance to the ’366 patent or to the products that allegedly practice that patent. In any event, that is peanuts compared to Samsung’s \$47 billion invested in the United States. EX1145; EX1142–44. And Netlist itself has not made meaningful contributions to the economy or national security and instead operates at a significant loss as discussed above.

J. 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 ’918 and ’054 patents and Netlist’s previous actions improperly circumventing the Board, as discussed above (pp.3–5).

III. CONCLUSION

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

Dated: February 20, 2026

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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 20th day of February, 2026, **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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