Director_Discretionary_Decision@uspto.gov
571-272-7822

Paper 20
Date: April 28, 2026

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

NETLIST, INC.,
Patent Owner.

IPR2026-00018 (Patent 12,373,366 B2)
PGR2026-00001 (Patent 12,373,366 B2)

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office*.

DECISION
Denying Institution of *Inter Partes* Review and Post-Grant Review

Netlist, Inc. ("Patent Owner") filed a request for discretionary denial (Paper 8, "DD Req.") in each of the above-captioned cases, and Samsung Electronics Co., Ltd. and Samsung Semiconductor, Inc. (collectively, "Petitioner") filed an opposition (Paper 11, "DD Opp.").[1] With authorization, Patent Owner filed a Reply (Paper 15, "PO Reply") and Petitioner filed a Sur-reply (Paper 18, "Pet. Sur-reply"). On March 23, 2026, after considering the parties' arguments and the record, and in view of all relevant considerations, I issued a Notice indicating that the Petitions are denied in the above-captioned cases. Paper 19.

The final written decisions in the above-captioned proceedings would be due by May 20, 2027. *See* DD Req. 12. The challenged patent is the subject of a co-pending investigation at the International Trade Commission ("ITC") against Petitioner, Google, and Super Micro. *Id.* at 11–14; PO Reply 1. The hearing in the parallel ITC investigation is set to begin on November 23, 2026, and the final initial determination is set for May 3, 2027. PO Reply 1–2; Ex. 2062. As such, it is unlikely that the final written decisions in the above-captioned proceedings will issue before a final determination in the ITC investigation, resulting in significant duplication of effort, additional expense for the parties, and a risk of inconsistent decisions.

Despite contending that "statutory estoppel under 35 U.S.C. § 325(e)(2) moots the need for a stipulation," Petitioner filed a stipulation in the ITC that it will not pursue invalidity defenses based on grounds that reasonably could have been raised in the Petitions, or any ground based on a

[1] Citations are to papers in PGR2026-00001. The parties filed similar papers in IPR2026-00018.

combination of system prior art and the references asserted in the Petitions, contingent on institution. DD Opp. 12–13; Ex. 1149.

Patent Owner argues both that Petitioner's stipulation is ineffective because it: (1) is untimely and (2) does not bind the other ITC respondents who adopted Petitioner's invalidity grounds presented in the Petitions. *See* PO Reply 1–2. I agree.

First, the stipulation is untimely. Petitioner did not file its stipulation until two weeks after it filed its opposition to Patent Owner's Request for Discretionary Denial. The Interim Director Discretionary Process Guidelines explain that "[i]f a petitioner chooses to file a stipulation, such as a *Sotera* stipulation, they should file it as soon as practicable, so that the patent owner may address the impact of the stipulation in its discretionary denial brief." *See* Interim Director Discretionary Process Guidelines §I.D.[2] Petitioner failed to meet these guidelines.

Second, the stipulation is ineffective because it does not bind Petitioner's co-respondents. Petitioner acknowledges that it "does not control Google or Super Micro," but asserts that these co-respondents will not pursue in the ITC "any invalidity defense that overlaps with the instituted grounds." Pet. Reply 2. Petitioner does not support this argument with any written statement or stipulation from Google or Super Micro. Attorney argument is insufficient to bind these entities who, as noted above, have adopted Petitioner's invalidity grounds presented in the Petitions as defenses in the ITC investigation.

[2] Available at: https://www.uspto.gov/patents/ptab/interim-director-discretionary-process.

While certain arguments are highlighted above, the determination not to exercise discretion to deny institution is based on the complete record and a holistic assessment of all of the evidence in light of the arguments presented.

In consideration of the foregoing, it is:

ORDERED that the Petitions are *denied*, and no trial is instituted.

FOR PETITIONER:

Eliot Williams
Theodore Chandler
Ferenc Pazmandi
Mark Speegle
BAKER BOTTS L.L.P.
eliot.williams@bakerbotts.com
ted.chandler@bakerbotts.com
ferenc.pazmandi@bakerbotts.com
mark.speegle@bakerbotts.com

FOR PATENT OWNER:

Richard M. Bemben
Jennifer Meyer Chagnon
STERNE, KESSLER, GOLDSTEIN & FOX PLLC
rbemben-PTAB@sternekessler.com
jchagnon-PTAB@sternekessler.com

Raymond K. Chan
Francisco A. Rubio-Campos
NETLIST, INC.
rchan@netlist.com
frubio@netlist.com