UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner

v.

NETLIST, INC.,
Patent Owner

Case IPR2025-01431
U.S. Patent No. 10,025,731

PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW OF DECISION GRANTING INSTITUTION

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-	ITC Inv. No. 337-TA-1472, Super Micro Computer, Inc.'s Response, Dkt 871441	Super Micro ITC Resp.	February 3, 2026

I. INTRODUCTION

Netlist respectfully requests that the Director review and reverse the decision granting institution (Paper 21) for the following reasons:

1. Samsung's Petition fails to name Samsung Electronics America, Inc. ("SEA") as a real party in interest. Among other things, SEA is a *co-plaintiff* in Samsung's DJ action in Delaware against the '731 patent. Given SEA's relationship to Samsung and its representations to the Delaware court that it has DJ standing, SEA necessarily qualifies as an RPI. Yet Samsung has not sought to correct its Petition to add SEA.

2. There will be significant duplication of effort by the ITC and risk of inconsistencies because the ITC will hold its hearing *months* before the projected Final Written Decision (FWD) for this IPR. Indeed, the two other co-respondents (Google and Super Micro) are raising arguments that substantially overlap with this IPR. And Samsung's late filed stipulation—submitted *after* institution—should not be considered.

3. Netlist has strong settled expectations. The '731 patent issued more than seven and a half years ago, and Samsung *itself* previously held a license. SK hynix currently licenses the patent. The patent's age and licensing history demonstrates its value and establishes strong settled expectations for Netlist that warrant de-instituting review.

II. ARGUMENTS

Discretionary and non-discretionary considerations overwhelmingly support de-instituting review.

A. Samsung's Petition fails to name SEA as an RPI.

The Director should de-institute review because Samsung's Petition fails to name SEA as an RPI. "A petition filed under section 311 may be considered *only if* … the petition identifies all real parties in interest." 35 U.S.C. § 312(a)(2) (emphasis added). A party is an RPI when it "is a clear beneficiary that has a preexisting, established relationship with the petitioner." *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1351 (Fed. Cir. 2018). "[A] patent owner must produce some evidence that tends to show that a particular third party should be named a real party in interest." *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1244 (Fed. Cir. 2018). But after the RPI issue is placed in dispute, the petitioner has the burden "to bring forth evidence or arguments demonstrating that it named all RPIs." *Yangtze Memory Techs. Co., Ltd. v. Micron Tech., Inc.*, IPR2025-00098, Paper 38 at 8 (PTAB Jan. 15, 2026) (informative) (citing *Worlds*, 903 F.3d at 1242).

Netlist provided substantial evidence that SEA is an RPI. Paper 9 ("POPR"), 4-14; Paper 16 ("DD Reply"), 2-3; Paper 18 ("POPR Sur-Reply"), 1-4. The burden

then shifted to Samsung to show otherwise. Because Samsung failed to carry its burden (and because SEA is an RPI), this IPR should be de-instituted.

1. SEA is an unnamed RPI.

Netlist demonstrated that SEA is an unnamed RPI. POPR, 7-10; POPR Sur-Reply, 1-4. Specifically, SEA admittedly has a preexisting, established relationship with both Petitioner SEC and named RPI SSI. SSI is a wholly-owned subsidiary of SEA, which is a wholly-owned subsidiary of SEC (SEC→SEA→SSI). EX2027, 1.

SEA is also a clear beneficiary of this proceeding. SEA is:

- a respondent in the ITC investigation, EX2015, 2 (¶5);
- a co-defendant in EDTX litigation, EX2013, 1; and
- a co-plaintiff in Samsung's DJ action against the '731 patent, EX2025, 1.

As a named defendant in the EDTX litigation and in the ITC investigation asserting the '731 patent, SEA faces the same infringement exposure as SEC and SSI. Invalidating the '731 patent through this IPR would immediately benefit SEA by eliminating liability and foreclosing injunctive relief in the parallel fora.

Critically, Samsung *itself* confirmed SEA's concrete interest in the '731 patent by naming SEA as a plaintiff in its DJ action. In that complaint, Samsung affirmatively alleged that a "substantial, immediate, and real controversy" exists between Netlist and SEA regarding infringement of the '731 patent. EX2025, 44 (¶146); *see id*., 5 (¶17). Having represented to an Article III court that SEA has

standing and a present stake in the '731 patent dispute, Samsung cannot now credibly claim that SEA is only a peripheral entity with no RPI status in this IPR.

And SEA's relationship with SEC and interest and participation in the litigation with Netlist is far greater than that of the party who the Board found to be unnamed RPI in *Aylo Freesites Ltd. v. Dish Techs. LLC*, IPR2024-00940, Paper 75 (PTAB Feb. 3, 2026) ("*Aylo*"). There, the Director de-instituted review because the petition failed to name a mere "services affiliate of Petitioner and co-defendant in parallel district court litigation." *Aylo*, 2. SEA, by contrast, is a corporate entity in the middle of petitioner SEC and RPI SSI (SEC→SEA→SSI) and has affirmatively invoked standing in Delaware to participate in Samsung's DJ action. If the affiliate in *Aylo* was an RPI, SEA necessarily is as well.

In the face of this overwhelming evidence, it was Samsung's burden to show it had, in fact, named all RPIs. Samsung fell far short of meeting this burden. Samsung's attempt to dismiss SEA as focused on "commercializing Samsung's end-user products"[1] or as a venue placeholder fails as a matter of law. *See* POPR Reply, 1-2. The RPI inquiry is not limited to which entity physically manufactures

[1] The ITC investigation involves memory modules, e.g., SODIMM and UDIMM, that may be used in end-user products, e.g., desktops and laptops. EX2015, 6; *see* https://semiconductor.samsung.com/dram/module/.

an accused product, nor does it turn on venue doctrine under 28 U.S.C. § 1400(b). *See* POPR, 8-10. Nor can Samsung avoid SEA's RPI status by marginalizing SEA's role here after having invoked SEA's interests to establish standing elsewhere. Indeed, Samsung's decision to name SEA as a co-plaintiff in its DJ action demonstrates that Samsung (as the parent company) is representing SEA's interest in challenging the validity of the '731 patent in this IPR.

Significantly, nowhere in its argument does Samsung provide evidence, or even a clear statement, that it is not representing SEA's interest in avoiding liability for infringement by challenging the validity of the '731 patent in this IPR. SEA is an RPI and Samsung has not demonstrated otherwise.

2. Denial of institution is mandated by *Corning* because Samsung has made no attempt to correct its Petition.

A petition that fails to name all RPIs cannot be considered. *Corning Optical Commc'ns RF, LLC v. PPC Broadband, Inc.*, IPR2014-00440, Paper 68 at 23-24 (PTAB Aug. 18. 2015) (precedential except § II.E.1). The appropriate remedy is to terminate this proceeding.

This IPR presents different circumstances than *Curium*, where the Director allowed a petitioner to submit updated mandatory notices to correctly identify all RPIs and then restarted the proceeding by according the petition a new filing date. *Curium US LLC v. Universitat Heidelberg*, IPR2025-01582, Paper 11 (PTAB Feb. 25, 2025) (informative). Here, Samsung has been on notice for months that it failed

to name all RPIs. At no point did Samsung seek to correct its Petition. Nor should it be permitted to at this late stage. No good cause exists to justify any late attempt to correct the Petition when Samsung deliberately chose not to correct its failure.

Because Samsung's Petition fails to identify all RPIs, including SEA, the Director should reverse the institution decision. Allowing Samsung to proceed despite this omission would undermine the statutory RPI requirement, invite gamesmanship, and conflict with the Director's express guidance emphasizing transparency and the integrity of PTAB proceedings.

B. Samsung's stipulation does not mitigate the concerns undergirding *Fintiv* because it does not bind Google and Super Micro.

Earlier today (March 4, 2026), Samsung filed a stipulation regarding this proceeding to forego presenting certain invalidity defenses in other forums so long as the Director maintains institution. PGR2026-00001, EX1149. The Director should give no weight to Samsung's stipulation. First, the stipulation is illusory because it covers only the Samsung entities involved in the dispute with Netlist (i.e., SEC, SEA, and SSI) but does not bind the other respondents at the ITC, Google and Super Micro. Second, the stipulation is untimely and should not be considered.

Samsung's stipulation does not bind Google and Super Micro, and thus does not mitigate the concerns (e.g., duplication of efforts and inconsistent results) that undergird the policy behind *Fintiv*. Trial in the ITC case is scheduled to begin at

the end of November 2026—months before the projected FWD date of February 18, 2027. ITC Schedule, 9. Because neither Google nor Super Micro submitted a stipulation, each will have the full arsenal of invalidity challenges to present at the ITC hearing, including the obviousness theories presented here. And, in fact, both Super Micro and Google asserted that the claims of the '731 patent are invalid for failure to meet all statutory requirements, including 35 U.S.C. §§ 103, 112. Super Micro ITC Resp., 76; Google ITC Resp., 41 (¶4).[2] Google and Super Micro both even asserted the '731 patent is invalid based on the *same* references presented in this IPR (Ellsberry, Dour, Abadeer). *See* Google ITC Resp., 41 (¶5), App'x B, 10, 23, 25; Super Micro ITC Resp., 76, Ex. B. There is significant risk that this IPR and the ITC proceeding will substantially overlap, resulting in duplicative effort and the potential for inconsistent results. *See* DD Brief, 11-15.

Additionally, Samsung's stipulation is untimely. At the time of institution, Samsung had not submitted *any* stipulation to minimize inefficiencies and duplication of effort. DD Brief, 15. Nor should its late notification to Netlist of a stipulation, filed the *same day* as the deadline for this Director review request, be considered. *See* Interim Process § I.D (petitioners should file stipulations "as soon

[2] If requested, Netlist can provide public versions of the cited briefing from the ITC proceeding.

as practicable, so that the patent owner may address the impact of the stipulation in its discretionary denial brief"). Further, none of the respondents, including Samsung, have agreed not to raise inconsistent claim constructions to "minimize inconsistency in claim construction between forums." *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 at 4 (PTAB Nov. 3, 2025) (precedential).

To avoid the issues that will be caused by this IPR not being a "true alternative" to the ITC proceeding, the Director should de-institute and allow the ITC to resolve the parties' dispute. DD Brief, 10-15.

C. Netlist has strong settled expectations in the '731 patent.

The '731 patent issued on July 17, 2018, and has been in force for over seven and a half years, which creates strong settled expectations. *Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 (PTAB June 18, 2025) (informative). Samsung admittedly held a license to the '731 patent. EX2025, 12 (¶¶41-42). And SK hynix took a license in 2021. EX2023. This licensing activity—particularly by the party who is now challenging the patent—strengthens Netlist's settled expectations. Paper 6 ("DD Brief"), 7-8 (citing e.g., *Alliance Laundry Sys., LLC v. PayRange LLC*, IPR2025-00950, Paper 11 at 3 (PTAB Sept. 19, 2025) (informative); EX2006, 12-16; EX2023.

Samsung attempted to undermine Netlist's strong settled expectations by alleging the Office materially erred during prosecution. Paper 11 ("DD Opp."), 3-6, 11-13; Paper 17 ("DD Sur-Reply"), 4. But Samsung's allegations do not hold up under close examination.

First, there is no history of invalidity in the '731 patent family. *See* DD Brief, 17. In a blatant attempt at misdirection, Samsung recites the history of prior challenges for patents that are *not* part of the '731 patent family. DD Opp., 12. The chart below lists all the patents in the priority chain of the '731 patent family.

Patent	**Prior challenge**
8,154,901	None
8,782,250	None
9,037,809	None

A comparison of the patents discussed in Samsung's brief (7,619,912; 8,756,364; 8,516,185; 9,606,907; 10,949,339) with those above demonstrates that the recited history is irrelevant to establishing material error in the examination of the '731 patent.

Second, that the Examiner misspelled "impedance" during prosecution was not material to patentability. Samsung argues "impedance matching" is recited "in limitations [1.e.2] and [1.f.2]," and because the examiner misspelled impedance and failed to search certain classes, he failed to identify the Ellsberry and Dour references. DD Opp., 3-6. But that is irrelevant because Samsung does not allege

that either reference teaches [1.e.2] and [1.f.2]. Rather, Samsung's obviousness theory relies on combinations of the references, expert testimony, and standards to address them. Pet., 68-77. Failing to (i) identify references that do *not* teach the limitations and (ii) combine them in the way that Samsung proposes is not material error.

Because Netlist has strong settled expectations and the Office did not commit a material error, the Director should de-institute review.

III. CONCLUSION

Because the decision to institute this IPR appears to have overlooked or misapprehended facts and arguments made by Netlist that establish that this IPR should be denied, Netlist respectfully requests that the Director grant this request for Director Review and reverse the Institution Decision.

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 REQUEST FOR DIRECTOR REVIEW OF DECISION GRANTING INSTITUTION** was served in its entirety on March 4, 2026, upon the following parties via electronic mail:

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