

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 REQUEST FOR DIRECTOR REVIEW OF
DECISION GRANTING INSTITUTION**

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Patent Trial and Appeal Board
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GLOSSARY OF BRIEFING AND ABBREVIATIONS

Paper No.	Brief Name	Abbreviation	Filing Date
1	Petition for <i>Inter Partes</i> Review of U.S. Patent No. 10,025,731	Pet.	August 25, 2025
8	Patent Owner Netlist, Inc.'s Brief on Discretionary Denial	DD Brief	November 4, 2025
12	Patent Owner Preliminary Response Under 37 C.F.R. § 42.107(a)	POPR	December 4, 2025
11	Petitioner's Opposition to Patent Owner's Discretionary Denial Request	DD Opp.	December 4, 2025
16	Petitioner's Authorized Reply to Patent Owner's Preliminary Response	POPR Reply	December 18, 2025
17	Patent Owner's Reply to Petitioner's Opposition to Discretionary Denial	DD Reply	December 18, 2025
18	Petitioner's Authorized Sur-Reply to Patent Owner's Discretionary Denial Request	DD Sur-Reply	December 22, 2025
19	Patent Owner's Sur-Reply in Support of Patent Owner's Preliminary Response	POPR Sur-Reply	December 22, 2025
-	ITC Inv. No. 337-TA-1472, Joint Proposed Procedural Schedule, Dkt 871408	ITC Schedule	February 6, 2026
-	ITC Inv. No. 337-TA-1472, Response of Google LLC, Dkt 871433	Google ITC Resp.	February 3, 2026

Paper No.	Brief Name	Abbreviation	Filing Date
-	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 22) 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 '087 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. SEA was also found to *willfully infringe* two patents in the '087 family and is a party to Samsung's subsequent appeal at the Federal Circuit. Yet Samsung has not sought to correct its Petition to add SEA as an RPI here.

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 PGR. Indeed, the two other co-respondents (Google and Super Micro) are raising arguments that substantially overlap with this PGR. And Samsung's late filed stipulation—submitted *after* institution—should not be considered.

The Director should de-institute 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 12 ("POPR"), 8-17; Paper 17 ("DD Reply"), 2-3; Paper 19 ("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 PGR should be de-instituted.

1. SEA is an unnamed RPI.

Netlist demonstrated that SEA is an unnamed RPI. POPR, 11-14; 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). EX2034, 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 '087 patent, EX2032, 1.

As a named defendant in the EDTX litigation and in the ITC investigation asserting the '087 patent, SEA faces the same infringement exposure as SEC and SSI. Invalidating the '087 patent through this PGR 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 '087 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 '087 patent. EX2032, 41

(¶137); *see id.*, 5 (¶16). Having represented to an Article III court that SEA has standing and a present stake in the '087 patent dispute, Samsung cannot now credibly claim that SEA is only a peripheral entity with no RPI status in this PGR.

What is more, SEA (along with SEC and SSI) also:

- once held a license to parent patents of the '087 patent (U.S. 8,787,060 and U.S. 9,318,160), DD Brief, 2-4; EX2031, 8 (¶¶28-29);
- was found to *willfully infringe* those parent patents, EX2038, 1-2; and
- is a co-appellant in Samsung's appeal of that judgment, EX2046, 2.

SEA's extensive history with the '087 patent family further confirms its status as an RPI in this PGR.

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" 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 an accused product, nor does it turn on venue doctrine under 28 U.S.C. § 1400(b). *See* POPR, 12-14. 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 '087 patent in this PGR.

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 '087 patent in this PGR. 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 PGR 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. Yet 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 '087 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¶4.¹ Google and SuperMicro both even asserted the '087 patent is invalid based on the *same* references presented in this PGR (Keeth, Shaeffer, Riho2). *See* Google ITC Resp., 41 (¶5), Appx B, 18, 19, 28; Super Micro ITC Resp., 76, Ex. B. There is significant risk that this PGR and the

¹ If requested, Netlist can provide public versions of the cited briefing from the ITC proceeding.

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 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 PGR 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.

III. CONCLUSION

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

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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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