
From: Trials <Trials@USPTO.GOV>
Sent: Wednesday, November 29, 2023 10:29 AM
To: Yaquian, Juan C.; Williams, Eliot D.; Lindsay, Jonathan; Trials
Cc: Winston-IPR-NetList; #NetlistIPR [Int]; DL Samsung Netlist IPRs; Chandler, Ted
Subject: RE: IPR2022-00996, IPR2022-00999 (918/054) - Request to Supplement

Follow Up Flag: Follow up
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Counsel,

From the Board –

Patent Owner’s requests to supplement the records of these proceedings with testimony from another case are denied. These requests come too late in these proceedings to be considered and in any case would not be helpful to resolving the issues presented in these cases.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Yaquian, Juan C. <JYaquian@winston.com>
Sent: Tuesday, November 28, 2023 12:01 PM
To: Williams, Eliot D. <Eliot.Williams@BakerBotts.com>; Lindsay, Jonathan <jlindsay@irell.com>; Trials <Trials@USPTO.GOV>
Cc: Winston-IPR-NetList <Winston-IPR-NetList@winston.com>; #NetlistIPR [Int] <NetlistIPR@irell.com>; DL Samsung Netlist IPRs <dlsamsungnetlistiprs@BakerBotts.com>; Chandler, Ted <ted.chandler@bakerbotts.com>
Subject: RE: IPR2022-00996, IPR2022-00999 (918/054) - Request to Supplement

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Dear Honorable Board,

In response to Patent Owner’s email below, Petitioner Micron submits its position for the Board’s consideration:

Micron opposes the request and opposes Netlist’s improper arguments in the joint email. 1) Netlist is attempting to circumvent the Board’s rules by taking untimely depositions in unrelated proceedings in order to try and develop additional arguments in the IPR without properly seeking discovery in the IPR. 2) The request improperly attempts to circumvent the Protective Order for the litigation which states “Documents, information or material produced pursuant to any discovery request in this Action, including but not limited to Protected Material designated as DESIGNATED MATERIAL, shall be used by the Parties only in the litigation of

involve the '918 and '054 patents. 4) Netlist has no excuse for its late request: The discovery period in the litigation opened on November 2022 (over a year ago) but Netlist waited until October 11, 2023 to serve a deposition notice on Scott Cyr. Further, Netlist had the opportunity to depose Mr. Cyr much earlier in the prior EDTX Case No. Case No. 6:21-cv-203 between Netlist and Micron, which Netlist has already used to improperly attempt to develop testimony to support its IPR positions with respect to the irrelevant testimony of Mr. Holbrook. 5) The cited testimony is irrelevant and mischaracterized. Further, the witness is a Micron engineer who is not a witness on Netlist's patents, has not read any of the IPR papers, and not a testifying expert as to how terms in the patent should be interpreted. Netlist is improperly and unfairly using litigation depositions of fact witnesses who are not aware of the issues in the IPR proceedings in a last ditched effort attempt to obtain soundbites to somehow improve its IPR record and the Board should deny this blatant and improper gamesmanship.

For at least these reasons, Petitioner Micron does not believe that a call with the Board is necessary or appropriate.

Regards,

Juan C. Yaquian
Lead Counsel for Petitioner Micron

Juan C. Yaquian

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From: Williams, Eliot D. <Eliot.Williams@BakerBotts.com>
Sent: Monday, November 27, 2023 9:59 AM
To: Lindsay, Jonathan <jlindsay@irell.com>; Trials <Trials@USPTO.GOV>
Cc: Winston-IPR-NetList <Winston-IPR-NetList@winston.com>; #NetlistIPR [Int] <NetlistIPR@irell.com>; DL Samsung Netlist IPRs <dlsamsungnetlistiprs@BakerBotts.com>; Chandler, Ted <ted.chandler@bakerbotts.com>
Subject: RE: IPR2022-00996, IPR2022-00999 (918/054) - Request to Supplement

Dear Honorable Board:

In response to Patent Owner's email below, Petitioner Samsung submits its position for the Board's consideration:

Petitioner Samsung's position: Petitioner Samsung's position is that a call is not necessary or appropriate for several reasons:

First, the testimony in question by Micron’s engineer is in a case that does not involve the 918/054 patents challenged in these IPRs and instead involves the 912 patent which is from a different patent family. See *Netlist, Inc. v. Micron Tech., Inc.*, No. 2:22-cv-00293 (E.D. Tex. filed Aug. 1, 2022). Neither party’s mandatory notices has ever identified the 912 patent (or cases involving the 912 patent) as being relevant to these IPRs.

Second, Micron is joined only as an “understudy” in these IPRs, see IPR2022-00996, Paper 26, at 4; IPR2022-00999, Paper 27, at 4, and Samsung has never seen or heard the testimony in question by Micron’s engineer, which apparently is still under seal pursuant to the Protective Order in the case. That Protective Order apparently prohibits Netlist from using any evidence from the district court action in this proceeding without first obtaining approval from the judge (which Netlist has not indicated that it has received). See *Netlist, Inc. v. Micron Tech., Inc.*, No. 2:22-cv-00293, ECF No. 60, at 3, ¶ 5 (E.D. Tex. Dec. 12, 2022).

Third, Netlist made little effort to “meet and confer to resolve any disputes.” Netlist emailed the Board less than 24 hours after raising this issue with Samsung for the first time. Samsung knows nothing about the testimony and thus it is unfair to ask Samsung to take a position or participate in a call with the Board now.

Fourth, Netlist’s last motion to submit supplemental information is still pending (IPR2022-00996, Papers 42–43; IPR2022-00999, Papers 44–45), and it appears that many of Samsung’s reasons for opposing that motion would apply here (IPR2022-00996, Paper 45; IPR2022-00999, Paper 47), such as: fact testimony by a lay witness in 2023 is not relevant to claim construction of a patent filed over 15 years ago; it does not appear that Micron designated the witness to testify about claim construction; the testimony is inadmissible hearsay since Samsung was not at the deposition; and the evidence is too late — Netlist made no effort to depose Micron in this IPR and the time for discovery is now over and Final Written Decisions are due in less than two weeks. In short, as Samsung previously predicted, “To permit Netlist to submit this extrinsic evidence from a fact witness in another proceeding at this late date would invite every party to bombard the Board with endless motions to submit random evidence from outside the IPR.” IPR2022-00996, Paper 45 at 5.

For at least these reasons, Petitioner Samsung does not believe that a call with the Board is necessary or appropriate.

Respectfully,

Eliot D. Williams

BAKER BOTTS LLP 

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From: Lindsay, Jonathan <jlindsay@irell.com>
Sent: Wednesday, November 22, 2023 9:43 AM
To: Trials <Trials@USPTO.GOV>
Cc: winston-ipr-netlist@winston.com; #NetlistIPR [Int] <NetlistIPR@irell.com>; Williams, Eliot D. <Eliot.Williams@BakerBotts.com>; DL Samsung Netlist IPRs <dlsamsungnetlistiprs@BakerBotts.com>
Subject: IPR2022-00996, IPR2022-00999 (918/054) - Request to Supplement

[EXTERNAL EMAIL]

Dear Honorable Board,

The Board previously granted leave for Patent Owner to file a motion for leave to supplement the record to include testimony by a Micron corporate representative on technical infringement issues, Mr. Boe Holbrook. This briefing is complete. Micron has recently replaced Mr. Holbrook on technical infringement matters with a different representative, Mr. Scott Cyr. On November 20, a deposition of Mr. Cyr occurred. Mr. Cyr has designed memory modules at Micron for over 24 years, and has been responsible for modules from DDR1 through the present. This deposition did not occur until November 20. The next day Netlist requested that Micron and Samsung agree to the submission of this testimony. The Netlist patents that Mr. Cyr addressed share important common claim terms with the '054 and '918 patents. These Netlist patents are also asserted against Samsung. The Samsung and Micron litigations are occurring in parallel before the same Court. And Micron and Samsung are operating under a common interest agreement. Mr. Cyr provided highly material testimony on the following subject

(a) The meaning of the term “power, data, address and control signals between the memory module and the host systems.” Micron’s corporate representative testified that using address and control signals sent from the host system to the memory module is a “different technology” from using packetized information delivered from a host system to an AMB on a FBDIMM. This is inconsistent with the position of the Petitioner’s before the PTAB.

(b) The meaning of the term “memory module.” Micron’s corporate representative testified that a memory module is defined by the presence of an off-module memory controller and testified that a PCIE card with an on-board memory controller is not a memory module. This is inconsistent with the position of the Petitioner’s before the PTAB.

Patent Owner is acutely aware that the tolerance of the PTAB for post-hearing submissions is limited. But the nature of the structure Congress has set up creates the potential for binding testimony elicited in one forum (a district court) to be highly material in another (PTAB) and vice versa.

Patent Owner seeks leave to submit this additional testimony without any argument or explanation.

Yesterday morning, Patent Owner requested Petitioner's position and availability for a call with the Board, but did not hear back as of the sending of this email.

Due to the importance of this matter, Patent Owner can be available at any time, if the Board deems a call necessary or helpful.

Jonathan M. Lindsay

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