

**From:** Williams, Eliot D. <Eliot.Williams@BakerBotts.com>  
**Sent:** Tuesday, September 5, 2023 5:07 PM  
**To:** Lindsay, Jonathan <jlindsay@irell.com>; Trials <Trials@USPTO.GOV>  
**Cc:** DL Samsung Netlist IPRs <dlamsungnetlistiprs@BakerBotts.com>; winston-ipr-netlist@winston.com;  
#NetlistIPR [Int] <NetlistIPR@irell.com>  
**Subject:** RE: IPR2022-00996, IPR2022-00999 - Request for Conference Call

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Dear Honorable Board:

In response to Patent Owner's email, 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, because Netlist's apparent dispute (which counsel for Samsung in this IPR knows nothing about) is only with Micron, who was joined to each of these three IPRs as an "understudy," meaning Micron has had no active involvement in these IPRs. If and when Samsung is terminated from these proceedings, and Micron becomes an active petitioner, then Netlist can renew its request for a call with the Board about Micron, but until then, Netlist has not provided an appropriate basis for a call with the Board. See IPR2022-00615, Paper 58, at 14 ("[Micron]'s role in IPR2022-00615 shall be limited as stated by [Micron] in the Motion for Joinder (Paper 1 at 6–9) unless and until Samsung is terminated from that proceeding"); IPR2022-00996, Paper 26, at 4 (similar); IPR2022-00999, Paper 27, at 4 (similar).

Furthermore, it appears that Netlist's dispute with Micron must be resolved by the judge in the district court action, not the Board. Netlist has made reference to "a deposition transcript of Micron's corporate representative, but Micron has improperly designated the transcript as confidential under the district court's protective order." Again, counsel for Samsung in this IPR knows nothing about the transcript that Netlist is referring to or what Netlist's apparent dispute concerns, but the public docket for the district court action between Netlist and Micron shows that a stipulated Protective Order was entered which 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): "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 this Action and shall not be used for any other purpose***. Any person or entity who obtains access to DESIGNATED MATERIAL or the contents thereof pursuant to this Order shall not make any copies, duplicates, extracts, summaries or descriptions of such DESIGNATED MATERIAL or any portion thereof except as may be reasonably necessary in the litigation of this Action." *Netlist, Inc. v. Micron Tech., Inc.*, No. 2:22-cv-00203, ECF No. 46, at 3, ¶ 5 (E.D. Tex. Nov. 1, 2022). Indeed, in a similar situation, the Board specifically admonished Netlist on this issue: "Any dispute regarding the scope or alleged violation of stipulations proffered by a party ***should be addressed in the district court proceedings*** in which such stipulations are to have effect." IPR2022-00996, Paper 14, at 2 (PTAB Jan. 18, 2023).

Samsung is also concerned about the timing of Netlist's request for a call with the Board. Netlist sent an email, out of the blue, over Labor Day Weekend, on Saturday, September 2, 2023, unilaterally stating that it was going to email the Board about an issue that it had never raised before and which counsel for Samsung in this IPR knows nothing about. Netlist made no effort to "meet and confer to resolve any disputes." Furthermore, the deadline for Netlist to submit evidence in these three IPRs has already passed: Netlist filed its Patent Owner Response in IPR2022-00615 on August 10, 2023 (after a five-month delay, see Paper 63), and Netlist filed its sur-replies in IPR2022-00996 and -00999 on August 4, 2023 (after an extension of 30 days and an email from the Board on July 27, 2023, stating, "No new evidence may be entered. See 37 C.F.R. § 42.23(b)). Any such future requests from Patent Owner are likely to be denied."). In light of the schedules for these three IPRs — which have already been delayed at Netlist's request — it appears that Netlist's request to submit additional evidence is untimely.

Finally, it is unclear how testimony by "Micron's corporate representative" in 2023 could be relevant to these three IPRs (where the alleged date of invention was over 10 years ago), and why (if such evidence could be relevant) Netlist did not seek authorization for such discovery in these IPRs within the time limits established by the Board's scheduling orders. In general, fact testimony by corporate representatives is not normally considered relevant for issues like claim construction and invalidity, because those issues are "in the clear purview of **experts**[,] and lay witness testimony on such issues does not comply with the Federal Rules of Evidence or Civil Procedure." *HVLPO2, LLC v. Oxygen Frog, LLC*, 949 F.3d 685, 689 (Fed. Cir. 2020) (emphasis added); see also Fed. R. Evid. 701–02.

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

Respectfully,

Eliot D. Williams

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**From:** Lindsay, Jonathan <[jlindsay@irell.com](mailto:jlindsay@irell.com)>

**Sent:** Tuesday, September 5, 2023 4:16 PM

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**Subject:** IPR2022-00996, IPR2022-00999 - Request for Conference Call

[EXTERNAL EMAIL]

Dear Board,

Patent Owner requests a conference call with the Board to disclose positions Micron has taken in the parallel district court proceeding which are inconsistent with positions it has taken in the above IPR proceedings which directly impact the merits of the IPR challenge. This information is contained in a deposition transcript of Micron's corporate representative on technical matters relating to the 918/054 patents, and who discussed the difference between AMB packets and signals. This deposition did not occur until August 30. The next day Netlist asked for the relevant testimony be designated so that it

can be used. Micron has improperly designated the transcript as confidential under the district court's protective order, and therefore Patent Owner is unable to submit the information itself as supplemental information. Moreover, failure on Micron's part to disclose this information is a direct non-compliance with its obligation to disclose inconsistent information under 36 CFR 42.51(b)(1). Netlist has made Micron aware of its concerns regarding compliance with 36 CFR 42.51(b)(1).

Patent Owner respectfully requests a conference call with the Board to seek guidance on how to proceed including, if necessary, seeking leave to file a motion to compel discovery.

The parties are available at the following time:

- Wednesday, September 6, between 11:00am and 3:30pm Eastern
- Thursday, September 7, between 11:00am and 3:30pm Eastern

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