

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD., MICRON TECHNOLOGY, INC.,
MICRON SEMICONDUCTOR PRODUCTS, INC., and
MICRON TECHNOLOGY TEXAS LLC,
Petitioner,

v.

NETLIST, INC.,
Patent Owner.

IPR2022-00615 (Patent 7,619,912 B2)
IPR2022-00996 (Patent 11,016,918 B2)
IPR2022-00999 (Patent 11,232,054 B2)¹

Before PATRICK M. BOUCHER, JON M. JURGOVAN,
DANIEL J. GALLIGAN, and KARA L. SZPONDOWSKI,
*Administrative Patent Judges.*²

JURGOVAN, *Administrative Patent Judge.*

¹ Micron Technology, Inc., Micron Semiconductor Products, Inc., and Micron Technology Texas LLC filed motions for joinder and petitions in IPR2023-00203, IPR2023-00405, and IPR2023-00406, and have been joined as petitioners in each of the captioned proceedings.

² This Order addresses issues that apply in each of the captioned proceedings. We therefore exercise our discretion to issue one Order to be filed in each proceeding. This is not an expanded panel, the proceedings have not been consolidated, and the parties are not authorized to use this heading style without prior Board approval.

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ORDER
Conduct of the Proceedings
37 C.F.R. § 42.5

On September 15, 2023, a conference call was held between Samsung Electronics Co., Ltd., Micron Technology, Inc., Micron Semiconductor Products, Inc., and Micron Technology Texas LLC (collectively “Petitioner”), Netlist, Inc. (“Patent Owner”), and Judges Jurgovan, Galligan, and Boucher. During the call, we discussed Patent Owner’s request for authorization to file a Motion to Submit Supplemental Information under 37 C.F.R. § 42.123(b). Patent Owner’s request for authorization to file the Motion is *granted*.

In an e-mail dated September 5, 2023, Patent Owner requested authorization to file the Motion, asserting that, in a concurrently pending district court litigation, a deposition transcript of Micron’s corporate representative on technical matters related to the ’912, ’918, and ’054 patents shows Petitioner is taking positions that are inconsistent with those advanced in these proceedings. IPR2022-00615, Ex. 3017; IPR2022-00996, Ex. 3002; IPR2022-00999, Ex. 3002. According to Patent Owner, “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).”³ IPR2022-00615, Ex. 3017; IPR2022-00996, Ex. 3002; IPR2022-00999, Ex. 3002.

³ Patent Owner also asserted that Micron improperly designated the deposition transcript as confidential under the district court’s protective order (IPR2022-00615, Ex. 3017; IPR2022-00996, Ex. 3002;

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In an e-mail dated September 5, 2023, Petitioner Micron opposed Patent Owner’s request, arguing that (1) Micron is merely an understudy in the captioned proceedings, (2) Patent Owner did not properly seek leave from the Board to conduct discovery in the relevant *inter partes review* proceedings, (3) the deposition occurred after the deadline for submitting new evidence in the captioned proceedings, and (4) Patent Owner misrepresents the referenced testimony as being from a Micron “corporate representative.” IPR2022-00615, Ex. 3018; IPR2022-00996, Ex. 3003; IPR2022-00999, Ex. 3003.

In an e-mail dated September 5, 2023, Petitioner Samsung opposed Patent Owner’s request as well, arguing that (1) “a call is not necessary because Netlist’s apparent dispute . . . is only with Micron, who was joined to each of these three IPRs as an ‘understudy,’” (2) the request is untimely because “Netlist made no effort to ‘meet and confer to resolve any disputes’” on this matter, and “the deadline for Netlist to submit evidence in these three IPRs has already passed,” (3) “it is unclear how testimony by ‘Micron’s corporate representative’ in 2023”—which “is not normally considered relevant for issues like claim construction and invalidity”—“could be relevant to these three IPRs (where the alleged date of invention was over 10 years ago),” and (4) “it is unclear . . . why . . . Netlist did not

IPR2022-00999, Ex. 3002), to which Micron and Samsung offered rebuttals (IPR2022-00615, Exs. 3018–3019; IPR2022-00996, Exs. 3003–3004; IPR2022-00999, Exs. 3003–3004). In a subsequent e-mail dated September 11, 2023, however, Patent Owner stated that “the deposition transcript in question has now been unsealed.” IPR2022-00996, Ex. 3005; IPR2022-00999, Ex. 3005. So, the confidentiality of the deposition transcript does not appear to be at issue.

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seek authorization for such discovery in these IPRs within the time limits established by the Board's scheduling orders." IPR2022-00615, Ex. 3019; IPR2022-00996, Ex. 3004; IPR2022-00999, Ex. 3004.

During the conference call, the parties discussed their positions with Judges Jurgovan, Galligan, and Boucher. Having considered each party's arguments, we grant Patent Owner's request for authorization to file a Motion to Submit Supplemental Information under 37 C.F.R. § 42.123(b).

Within seven calendar days from the date of this Order, Patent Owner may file a Motion to Submit Supplemental Information under 37 C.F.R. § 42.123(b), not to exceed five (5) pages. The Motion should address (1) the subject and scope of the supplemental information Patent Owner seeks to submit; (2) why the supplemental information is relevant to the claims in each of these proceedings and how the supplemental information indicates Petitioner is taking an inconsistent position in each of these proceedings, with citations to the record; (3) why Micron's deponent was speaking as a "corporate representative" within the scope of what the deponent was designated to testify, and in relation to the claim language of the involved patents; (4) why the supplemental information reasonably could not have been obtained earlier; and (5) why consideration of the supplemental information would be in the interests-of-justice.

In addition, we request that Patent Owner file the supplemental information for which submission is sought as an *attachment* to the Motion, not as an *exhibit*.

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If desired, Petitioner, within seven calendar days of the filing date of Patent Owner's Motion to Submit Supplemental Information, may file an Opposition to the Motion, not to exceed five (5) pages.

If desired, within seven days of Petitioner's Opposition to the Motion, Patent Owner may file a Reply to the Opposition, not to exceed two (2) pages.

In view of the foregoing, it is

ORDERED that Patent Owner may file a Motion to Submit Supplemental Information under 37 C.F.R. § 42.123(b), limited to five pages, within seven calendar days from the date of this Order;

FURTHER ORDERED that the Motion shall have as attachment(s) the supplemental information for which submission is sought, but the supplemental information at issue shall not be filed as exhibits;

FURTHER ORDERED that Petitioner may file an Opposition to Patent Owner's Motion, limited to five pages, within seven calendar days of the filing date of Patent Owner's Motion.

FURTHER ORDERED that Patent Owner may file a Reply, limited to two pages, within seven calendar days of Petitioner's Opposition.

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