

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

SANDISK CORPORATION,  
Petitioner,

v.

NETLIST, INC.,  
Patent Owner.

---

Case IPR2014-00994  
Patent 8,301,833 B1

---

Before: LINDA M. GAUDETTE, BRYAN F. MOORE, and  
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION  
Denying Institution of *Inter Partes* Review  
*37 C.F.R. § 42.108*

I. INTRODUCTION

Sandisk Corporation, Inc. (“Petitioner”) filed a Petition, on June 20, 2014, requesting an *inter partes* review of claims 1–30 of US Patent No. 8,301,833 B1 (Ex. 1001, “the ’833 patent”). Paper 1 (“Pet.”). Netlist, Inc.

(“Patent Owner”) filed a Preliminary Response on October 2, 2014. Paper 7 (“Prelim. Resp.”).

We have jurisdiction under 35 U.S.C. § 314, which provides that an *inter partes* review may be authorized only if “the information presented in the petition . . . and any [preliminary] response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Pursuant to 35 U.S.C. § 314, the Board does not find a reasonable likelihood that Petitioner would prevail with respect to at least one claim of the ’833 patent and, thus, does not authorize an *inter partes* review to be instituted as to those claims.

#### *A. Related Proceedings*

Petitioner indicates that the ’833 patent is involved in the following co-pending actions: *Netlist, Inc. v. Smart Modular Technologies, Inc.*, U.S. District Court for the Northern District of California, Civil Action No. 3:13-CV-05889-YGR; *Diablo Technologies, Inc. v. Netlist, Inc.*, U.S. District Court for the Northern District of California, Civil Action No. 4:13-CV-03901-YGR; and *Smart Modular Technologies, Inc. v. Netlist, Inc.*, U.S. District Court for the Northern District of California, Civil Action No. 4:13-CV-03916-YGR.). Pet. 59.

#### *B. The ’833 Patent*

The invention in the ’833 patent relates to a specific configuration of hybrid memory systems that addresses non-volatile memory backup, while running the volatile memory subsystem at lower power, and therefore, at lower clock speeds. Ex. 1001, col. 16, ll. 29–34. Specifically, the alleged invention of the ’833 patent includes circuitry for providing a regular high-

speed clock frequency (first clock frequency) during communications between the host and the volatile memory subsystem, and a slower clock frequency during communications between the volatile memory subsystem (using third clock frequency) and the non-volatile memory subsystem (using second clock frequency). *Id.* at col. 21, ll. 5–21. Further, the second and third clock frequencies may be substantially equal. *Id.* at col. 21, ll. 23–24.

*C. Illustrative Claim*

Of the challenged claims, 1 and 5 are independent claims. Claim 1 is illustrative of the claimed subject matter of the '833 patent, and is reproduced below:

1. A method for controlling a memory system operatively coupled to a host system, the memory system including a volatile memory subsystem and a non-volatile memory subsystem, the method comprising:

operating the volatile memory subsystem at a first clock frequency when the memory system is in a first mode of operation in which data is communicated between the volatile memory subsystem and the host system;

operating the non-volatile memory subsystem at a second clock frequency when the memory system is in a second mode of operation in which data is communicated between the volatile memory subsystem and the nonvolatile memory subsystem; and

operating the volatile memory subsystem at a third clock frequency when the memory system is in the second mode of operation, the third clock frequency being less than the first clock frequency.

1. *Prior Art Relied Upon*

Petitioner relies upon the following prior art references:

Fukuzo ("Fukuzo," Ex. 1013)	US 2006/0294295 A1	June 24, 2005
Panabaker ("Panabaker," Ex. 1014)	US 7,716,411 B2	June 7, 2006
Li ("Li," Ex. 1015)	US 6,336,174 B1	August 9, 1999
Spiers ("Spiers," Ex. 1016)	US 2006/0080515 A1	October 12, 2004
Hansen ("Hansen," Ex. 1017)	US 2005/0132250 A1	December 16, 2003
Sun ("Sun," Ex. 1018)	US 7,102,391 B1	July 29, 2004
Komatsuzaki ("Komatsuzaki," Ex. 1019)	US 6,944,042 B2	December 31, 2002

2. *The Asserted Grounds*

Petitioner asserts that the challenged claims are unpatentable based on the following grounds:

Reference[s]	Basis	Claims challenged
Fukuzo	§ 102	1, 2, 6, 8, 11, 12, 15, 18, 22, 24, 27, and 28
Panabaker	§ 102	1–6, 8, 11–13, 15, 17–22, 24, and 27–29
Fukuzo and Li	§ 103	3 and 19
Fukuzo, Li, and Spiers	§ 103	3 and 19
Fukuzo and Hansen	§ 103	7 and 23
Fukuzo, Li, and Hansen	§ 103	7, 9, 10, 23, 25, and 26
Fukuzo and Sun	§ 103	14 and 30
Fukuzo, Li,	§ 103	14 and 30

Reference[s]	Basis	Claims challenged
and Sun		
Fukuzo and Komatsuzaki	§ 103	16
Fukuzo, Li, and Komatsuzaki	§ 103	16
Panabaker and Li	§ 103	1–6, 8, 11, 12, 15, 17–22, 24, 27, and 28
Panabaker and Spiers	§ 103	3 and 19
Panabaker, Li, and Spiers	§ 103	3 and 19
Panabaker and Hansen	§ 103	7, 9, 23, and 25
Panabaker, Li, and Hansen	§ 103	7, 9, 10, 23, 25, and 26
Panabaker and Fukuzo	§ 103	13 and 29
Panabaker, Li, and Fukuzo	§ 103	13 and 29
Panabaker and Sun	§ 103	14 and 30
Panabaker, Li, and Sun	§ 103	14 and 30
Panabaker and Komatsuzaki	§ 103	16
Panabaker, Li, and Komatsuzaki	§ 103	16

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.