

UNITED STATES DISTRICT COURT  
EASTERN DISTRICT OF TEXAS  
MARSHALL DIVISION

NETLIST, INC.

Plaintiff,

v.

SAMSUNG ELECTRONICS CO., LTD.,  
SAMSUNG ELECTRONICS AMERICA, INC.  
and SAMSUNG SEMICONDUCTOR, INC.,

Defendants.

Civil Case No. 2:21cv463-JRG

**JURY TRIAL DEMANDED**

**SAMSUNG'S SUR-REPLY TO NETLIST'S MOTION TO STRIKE  
CERTAIN OPINIONS OF DEFENDANTS' EXPERT JOHN B. HALBERT (Dkt. 207)**



**TABLE OF CONTENTS**

I. Mr. Halbert’s Opinions on JEDEC Customs and Practices Are Proper ..... 1

II. Mr. Halbert’s Opinions on Patent Disclosures Are Relevant and Not Prejudicial ..... 4

III. Mr. Halbert’s Rebuttal Apportionment Opinions Are Reliable..... 5

**TABLE OF AUTHORITIES**

	<b>Page(s)</b>
<b>Cases</b>	
<i>Chrimar Sys., Inc. v. Alcatel-Lucent Enter. USA Inc.</i> No. 6:15-cv-00163, 2017 WL 345991 (E.D. Tex. Jan. 24, 2017) .....	2
<i>Intell. Ventures I LLC v. T-Mobile USA, Inc.</i> , No. 2:17-cv-00577, Dkt. No. 297 (E.D. Tex. Jan. 14, 2019).....	5
<i>U.S. ex rel. Mitchell v. CIT Bank, N.A.</i> , No. 4:14-cv-00833, 2022 WL 1226968 (E.D. Tex. Apr. 26, 2022) .....	4
<i>Packet Intel. LLC v. NetScout Sys., Inc.</i> , No. 2:16-cv-00230, Dkt. No. 228 (E.D. Tex. Sep. 29, 2017) .....	5
<i>Texas Pig Stands, Inc. v. Hard Rock Café Int’l, Inc.</i> , 951 F.2d 684 (5th Cir. 1992) .....	5
<i>Tyco Healthcare Grp., LP v. Applied Med. Res. Corp.</i> , No. 9:06-cv-00151, 2009 WL 5842063 (E.D. Tex. Mar. 30, 2009) .....	3
<i>VirnetX, Inc. v. Cisco Sys., Inc.</i> , 767 F.3d 1308 (Fed. Cir. 2014).....	3
<b>Statutes</b>	
35 U.S.C. § 271.....	3

..

# I. Mr. Halbert's Opinions on JEDEC Customs and Practices Are Proper

Netlist mischaracterizes ¶¶ 49, 55, 57 of Mr. Halbert's opening report to seek their exclusion. Dkt. No. 303 at 3-5. Netlist includes a laundry list of statements that purportedly attack Netlist's motivations and intent, claiming they state "[Netlist] 'misappropriate[d]' JEDEC members' contributions" and that "[Netlist's] behavior was viewed 'dishonorably by JEDEC and its members.'" *Id.* at 3. But two of the three paragraphs that Netlist moves to strike ***do not even mention Netlist***. Dkt. No. 207-3 at ¶¶ 49, 57. When asked at deposition, Mr. Halbert confirmed that he is not engaging in the type of "intemperate allegations" that Netlist accuses him of engaging in. Dkt. No. 303 at 3, 5; Ex. 14 at 68:8-12. That Netlist is forced to take Mr. Halbert's statements out of context speaks volumes as to the strength of this motion.

Instead of offering testimony on Netlist's motivations, Mr. Halbert's report describes JEDEC's customary practices related to patenting and patent disclosures. First, Mr. Halbert describes the normal course of conduct in JEDEC as a uniquely "collaborative environment . . . in which numerous companies propose, refine, and develop technologies for the benefit of the industry at large" while still retaining their ability to "protect their own contributions through patenting." Dkt. No. 207-3 at ¶ 49. Second, Mr. Halbert provides relevant insight into the customs and practices surrounding JEDEC's membership and RAND obligations, as well as industry expectations for the disclosure of potentially essential patents. *Id.* at ¶¶ 55 (opining that "it is highly unusual for JEDEC member companies to come and go from JEDEC" and that "do[ing] so in order to pursue litigation against other JEDEC member companies . . . would be considered inconsistent with JEDEC's policies and ethos."), 57 (discussing the effects "[i]f a member were to subvert the Patent Policy by failing to disclose Potentially Essential Patents of which it is aware"). As Netlist has mischaracterized Mr. Halbert's report, Netlist has not shown

his opinions are irrelevant or improper.<sup>1, 2</sup>

As an initial matter, Netlist does not dispute that Mr. Halbert's opinions are relevant to Samsung's equitable defenses, including waiver, estoppel, inequitable conduct, and laches. Dkt. No. 303 at 3-4. Netlist's motion should be denied for that reason alone. This Court routinely receives expert testimony in weighing equitable issues. For example, in *Chrimar Sys., Inc. v. Alcatel-Lucent Enter. USA Inc.*, the Court faced a defendant's claim that the patentee was equitably "estopped from enforcing the patents-in-suit . . . by failing to disclose the patent family to the IEEE." No. 6:15-cv-00163, 2017 WL 345991, at \*2 (E.D. Tex. Jan. 24, 2017). The Court found "testimony from the parties' IEEE experts [was] necessary for the Court to fully resolve this question," and considered expert opinions from both sides to adjudicate the issue. *Id.* Netlist is not prejudiced by evidence of the industry norms it was expected to follow.

Netlist nevertheless seeks to exclude Mr. Halbert's opinions as irrelevant based on its own about-face in its infringement theories. Netlist's preliminary infringement contentions relied almost exclusively on the JEDEC standards, and Netlist asserted that four of the asserted patents

---

<sup>1</sup> Netlist's argument that Mr. Halbert contradicts the "undisputed factual record" regarding the timing of Netlist's lawsuits against SK hynix is not relevant, as Mr. Halbert does not provide the "intemperate allegations" that Netlist relies on for its motion. Dkt. No. 303 at 3, 5; Dkt. No. 207 at 1; Ex. 14 at 68:8-12.

<sup>2</sup> Netlist is not concerned with the type of opinion Mr. Halbert offers, it is concerned with its own opinions being challenged at trial. Netlist's own expert Mr. Gillingham provides opinions on issues which Netlist claims are improper, although Mr. Gillingham's opinions actually are based only on the self-serving testimony of Netlist's CEO. See Dkt. No. 269-2 at ¶¶ 47-52 (alleging in part that

(citing Dkt. No. 269-13 at 197:16-19, 198:22-199:3)).



# 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.