

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)**



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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] 'misappropriat[e] 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

[REDACTED]

his opinions are irrelevant or improper.^{1,2}

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 [REDACTED]

[REDACTED]

¹ 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.

² 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 [REDACTED]

[REDACTED]

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

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