

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SK HYNIX INC., SK HYNIX AMERICA INC., and
SK HYNIX MEMORY SOLUTIONS INC.,
Petitioner,

v.

NETLIST, INC.,
Patent Owner.

Cases

IPR2017-00561 (Patent 8,001,434 B1)
IPR2017-00562 (Patent 8,359,501 B1)
IPR2017-00577 (Patent 8,516,185 B2)¹

Before BRYAN F. MOORE, MATTHEW CLEMENTS, and
SHEILA F. McSHANE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

ORDER

Conduct of the Proceeding
37 C.F.R. § 42.5

¹ This Order addresses an issue that is identical in all three cases. We, therefore, exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

IPR2017-00561 (Patent 8,001,434 B1)
IPR2017-00562 (Patent 8,359,501 B1)
IPR2017-00577 (Patent 8,516,185 B2)

On April 24, 2018, the Supreme Court held that a decision to institute under 35 U.S.C. § 314 may not institute on less than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 2018 WL 1914661, at *10 (U.S. Apr. 24, 2018). In our Decision on Institution, we determined that Petitioner demonstrated a reasonable likelihood that it would establish that at least one of the challenged claims of each of the challenged patents is unpatentable. IPR2017-00561, Paper 7; IPR2017-00562, Paper 7; IPR2017-00577, Paper 8. We modify our institution decisions to institute on all of the challenged claims and all of the grounds presented in the Petition.

The parties shall confer to discuss the impact, if any, of this Order. If, after conferring, the parties wish to submit briefing not set forth in the Scheduling Order, the parties must, within one week of the date of this Order, request a conference call with the panel to seek authorization for such briefing.

In consideration of the foregoing, it is hereby:

ORDERED that each of our institution decisions is modified to include review of all challenged claims and all grounds presented in the Petition; and

FURTHER ORDERED that Petitioner and Patent Owner shall confer to determine whether they desire any briefing, and, if so, request a conference call with the panel to seek authorization for such briefing within one week of the date of this Order.

IPR2017-00561 (Patent 8,001,434 B1)
IPR2017-00562 (Patent 8,359,501 B1)
IPR2017-00577 (Patent 8,516,185 B2)

For PETITIONER:

Joseph Micallef
Steven Baik
Wonjoo Suh
Theodore Chandler
Ferenc Pazmandi
SIDLEY AUSTIN LLP
jmicallef@sidley.com
sbaik@sidley.com
wsuh@sidley.com
tchandler@sidley.com
fpazmandi@sidley.com

For PATENT OWNER in IPR2017-00561 and IPR2017-00562:

Thomas J. Wimbiscus
Christopher C. Winslade
Scott P. McBride
Ronald H. Spuhler
Wayne H. Bradley
William Meunier
MCANDREWS, HELD & MALLOY, LTD.
twimbiscus@mcandrews-ip.com
cwinslade@mcandrews-ip.com
smcbride@mcandrews-ip.com
rspuhler@mcandrews-ip.com
wbradley@mcandrews-ip.com
wameunier@mintz.com

For PATENT OWNER in IPR2017-00577:

Mehran Arjomand
Erol Basol
William Meunier
MORRISON & FOERSTER LLP
marjomand@mfo.com
ebasol@mfo.com
wameunier@mintz.com