

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.,
Petitioners,

v.

NETLIST, INC.
Patent Owner.

Case IPR2017-00587 (Patent 8,671,243 B2)
Case IPR2017-00692 (Patent 8,874,831 B2)

Before STEPHEN C. SIU, MATTHEW R. CLEMENTS, and
SHEILA F. McSHANE, *Administrative Patent Judges*.

McSHANE, *Administrative Patent Judge*.

ORDER

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

IPR2017-00587 (Patent 8,671,243 B2)

IPR2017-00692 (Patent 8,874,831 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 Decisions on Institution in these proceedings, we determined that Petitioner demonstrated a reasonable likelihood that it would prevail in showing that at least one of the challenged claims of U.S. Patent No. 8,671,243 is unpatentable in IPR2017-00587 and at least one of the challenged claims of U.S. Patent No. 8,874,831 is unpatentable in IPR2017-00692. *See* IPR2017-00587, Paper 7, 38–39; IPR2017-00692, Paper 7, 28. We modify each of our institution decisions to include all of the challenged claims and all of the grounds presented in the respective Petitions. *See* Guidance on the Impact of SAS on AIA Trial Proceedings (April 26, 2018), available at <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial>.

The parties shall confer to discuss the impact, if any, of this Order. If, after conferring, the parties wish to submit further briefing, 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 respective Petition; and

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

IPR2017-00587 (Patent 8,671,243 B2)
IPR2017-00692 (Patent 8,874,831 B2)

PETITIONER:

Joseph A. Micallef
Wonjoo Suh
Sidley Austin LLP
jmicallef@sidley.com
wsuh@sidley.com
Sidley-SKH-IPR@sidley.com

PATENT OWNER:

Thomas J. Wimbiscus
Christopher C. Winslade
Gregory C. Schodde
Scott P. McBride
Ronald H. Spuhler
Wayne H. Bradley
twimbiscus@mcandrews-ip.com
cwinslade@mcandrews-ip.com
gschodde@mcandrews-ip.com
smcbride@mcandrews-ip.com
rspuhler@mcandrews-ip.com
wbradley@mcandrews-ip.com