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14 Attorneys for Plaintiff  
 15 NETLIST, INC.

16 UNITED STATES DISTRICT COURT  
 17 NORTHERN DISTRICT OF CALIFORNIA  
 18 OAKLAND DIVISION

20 GOOGLE INC.,

21 Plaintiff,

22 v.

23 NETLIST, INC.

24 Defendant.

CASE NO. C08 04144 SBA

[Related to civil Action No. C09-05718 SBA]

**DECLARATION OF DANIEL J. TAYLOR  
 IN SUPPORT OF DEFENDANT NETLIST,  
 INC.'S OPPOSITION TO GOOGLE INC'S  
 MOTION TO SHORTEN TIME**

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**DECLARATION OF DANIEL J. TAYLOR**

I, Daniel J. Taylor, declare as follows:

1. I am an attorney admitted to practice in the State of California and before this Court. I am an associate with Lee Tran & Liang APLC, counsel of record for Defendant and Counterclaimant Netlist, Inc. (“Netlist”). I have personal knowledge of the facts set forth herein and, if called as a witness, could and would testify competently thereto under oath. This declaration is made in support of Defendant Netlist Inc.’s Opposition to Google Inc.’s Motion to Shorten Time.

2. On or about August 27, 2010, the United States Patent and Trademark Office issued its first Office Action in *Inter Partes* Reexamination related to U.S. Patent No. 7,289,386 . A true and correct copy of the August 27, 2010 Office Action in *Inter Partes* Reexamination is attached hereto as Exhibit “A”.

I declare under penalty of perjury under the laws of the United States and the State of California that the foregoing is true and correct.

Executed this 1st day of September 2010, at Los Angeles, California

\_\_\_\_\_/s/ Daniel J. Taylor\_\_\_\_\_  
Daniel J. Taylor

# **EXHIBIT A**



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,546	05/11/2010	7289386	19473-0052RX1	8688
20995	7590	08/27/2010	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			PEIKARI, BEHZAD	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			3992	
			MAIL DATE	
			DELIVERY MODE	
			08/27/2010	
			PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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Date: 8-27-10

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000546  
PATENT NO. : 7289386  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

<b>OFFICE ACTION IN INTER PARTES REEXAMINATION</b>	Control No.	Patent Under Reexamination	
	95/000,546	7289386	
	Examiner	Art Unit	
	B. James Peikari	3992	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address. --

Responsive to the communication(s) filed by:

Patent Owner on \_\_\_\_\_

Third Party(ies) on 11 May 2010

**RESPONSE TIMES ARE SET TO EXPIRE AS FOLLOWS:**

*For Patent Owner's Response:*

2 MONTH(S) from the mailing date of this action. 37 CFR 1.945. EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.956.

*For Third Party Requester's Comments on the Patent Owner Response:*

30 DAYS from the date of service of any patent owner's response. 37 CFR 1.947. NO EXTENSIONS OF TIME ARE PERMITTED. 35 U.S.C. 314(b)(2).

**All correspondence** relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

This action is not an Action Closing Prosecution under 37 CFR 1.949, nor is it a Right of Appeal Notice under 37 CFR 1.953.

**PART I. THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

1.  Notice of References Cited by Examiner, PTO-892
2.  Information Disclosure Citation, PTO/SB/08
3.  \_\_\_\_\_

**PART II. SUMMARY OF ACTION:**

- 1a.  Claims 1-12 are subject to reexamination.
- 1b.  Claims 13 are not subject to reexamination.
2.  Claims \_\_\_\_\_ have been canceled.
3.  Claims \_\_\_\_\_ are confirmed. [Unamended patent claims]
4.  Claims \_\_\_\_\_ are patentable. [Amended or new claims]
5.  Claims 1-12 are rejected.
6.  Claims \_\_\_\_\_ are objected to.
7.  The drawings filed on \_\_\_\_\_  are acceptable  are not acceptable.
8.  The drawing correction request filed on \_\_\_\_\_ is:  approved.  disapproved.
9.  Acknowledgment is made of the claim for priority under 35 U.S.C. 119 (a)-(d). The certified copy has:
  - been received.  not been received.  been filed in Application/Control No 95000546.
10.  Other \_\_\_\_\_

<b>Transmittal of Communication to Third Party Requester Inter Partes Reexamination</b>	Control No.	Patent Under Reexamination	
	95/000,546	7289386	
	Examiner	Art Unit	
	B. James Peikari	3992	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address. --

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Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

**All correspondence** relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

## DETAILED ACTION

### *Inter Partes Reexamination*

1. This is an *inter partes* reexamination of U.S. Patent No. 7,289,386 (the '386 patent) requested by a third party requester. Claims 1-12 are subject to reexamination.

### *References*

2. The references discussed herein are as follows:
  - (1) U.S. Patent No. 6,209,074 to Dell ("Dell").
  - (2) U.S. Patent No. 6,414,868 to Wong ("Wong").
  - (3) U.S. Patent No. 4,368,515 to Nielsen ("Nielsen")
  - (4) U.S. Patent Publication No. 2006/0117152 to Amidi ("Amidi").
  - (5) Barr, Michael, "Programmable Logic: What's it to Ya?" Embedded Systems Programming, June 1999, pp. 75-84 ("Barr").

### *Claim Rejections – Relevant Statutes*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

*Summary of Proposed Rejections and Status*

5. The following rejections were proposed by the Request filed May 11, 2010 (note pages 12-21):

- **Issue 1:** Claims 1-5, 7, and 9-12 are alleged to be rendered obvious by Dell under 35 U.S.C. § 103.

The rejection of claims 1-5, 7, 9, 10 and 12 is adopted as proposed.

The rejection of claim 11 is adopted as modified.

- **Issue 2:** Claims 6 and 8 are alleged to be rendered obvious by Dell in view of Barr under 35 U.S.C. § 103.

The rejection of claims 6 and 8 is adopted as proposed.

- **Issue 3:** Claims 1-4, 10 and 12 are alleged to be anticipated by Wong under 35 U.S.C. § 102.

The rejection of claims 1-4, 10 and 12 is adopted as proposed.

- **Issue 4:** Claims 5-8 are alleged to be rendered obvious by Wong in view of Barr under 35 U.S.C. § 103.

The rejection of claims 5-8 is adopted as proposed.

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- **Issue 5:** Claims 1, 10 and 12 are alleged to be anticipated by Nielsen under 35 U.S.C. § 102(b).

The rejection of claims 1, 10 and 12 is adopted as proposed.

- **Issue 6:** Claim 3 is alleged to be rendered obvious by Nielsen under 35 U.S.C. § 103.

The rejection of claim 3 is adopted as proposed.

- **Issue 7:** Claims 5-8 are alleged to be rendered obvious alleged to be rendered obvious by Nielsen in view of Barr under 35 U.S.C. § 103.

The rejection of claims 5-8 is adopted as proposed.

- **Issue 8:** Claims 1-9 and 11-12 are anticipated by Amidi under 35 U.S.C. § 102(b).

The rejection of claims 1-9 and 11-12 is adopted as proposed.

- **Issue 9:** Claim 10 is alleged to be rendered obvious by Amidi under 35 U.S.C. § 103.

The rejection of claim 10 is adopted as modified.

*Claim Rejections – Detailed Explanation*

**Issue 1**

*Claims 1-5, 7, and 9-12 are alleged to be rendered obvious by Dell under 35 U.S.C. § 103.*

6. Claims 1-5, 7, 9, 10 and 12 are rejected under 35 U.S.C. § 103 as being unpatentable over Dell. The proposed rejection of these claims set forth in the Request is **adopted**. See the Request pp. 12-14 and the claim chart of Appendix H, which are hereby incorporated by reference.

7. Claim 11 is rejected under 35 U.S.C. § 103 as being unpatentable over Dell. The proposed rejection of this claim set forth in the Request is **adopted as modified** herein. See the Request pp. 12-14 and the claim chart of Appendix H, which are hereby incorporated by reference.

Claim 11 recites:

“The memory module of claim 1, wherein the set of input control signals comprises two chip-select signals and an address signal and the set of output control signals comprises four chip-select signals.”

With regard to claim 11, the request, Appendix H, page 7, argues:

“Because the input control signal BA0 selects one of two banks it corresponds to the ‘two chip select signals’ of the claim, which are also capable only of selecting from among two ranks. Similarly, because the output control signals BA0 and BA1 select from among four banks, they correspond to the ‘four chip-select signals’ of the claim, which are also capable only of selecting from among four ranks.”

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However, the *one* input control signal BA0 does not explicitly teach the *two* chip-select signals of claim 11. Likewise, the *two* output control signals BA0 and BA1 do not explicitly teach the *four* chip select signals of claim 11.

Nevertheless, it is apparent from the teachings of Dell that the input control signal BA0 functions to select from one of two banks, thus performing the same function as the two chip select signals of claim 11. Likewise, the output control signals BA0 and BA1 select from among four banks, thus performing the same function as the four chip select signals of claim 11. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to separate the input control signal BA0 into two separate signals and the output control signals BA0 and BA1 into two separate signals each, since (1) each control signal of Dell already performs the function of controlling more than one memory bank, (2) separate the signals into distinct lines may provide faster access depending on the location of the memory banks within the architecture of the Dell memory circuit and (3) to make separable was considered an obvious improvement, *Nerwin v. Erlichman* 168 USPQ 177 (1969).

## **Issue 2**

*Claims 6 and 8 are alleged to be rendered obvious by Dell in view of Barr under 35 U.S.C. § 103.*

8. Claims 6 and 8 are rejected under 35 U.S.C. § 103 as being unpatentable over Dell in view of Barr. The proposed rejection of these claims set forth in the Request is **adopted**. See the Request pp. 12-14 and the claim chart of Appendix H, which are hereby incorporated by reference.

**Issue 3**

*Claims 1-4, 10 and 12 are alleged to be anticipated by Wong under 35 U.S.C. § 102.*

9. Claims 1-4, 10 and 12 are rejected under 35 U.S.C. § 102(b) as being anticipated by Wong. The proposed rejection of these claims set forth in the Request is **adopted**. See the Request pp. 14-16 and the claim chart of Appendix I, which are hereby incorporated by reference. See also the discussion of the claim language on pages 8-11 of the Request.

**Issue 4**

*Claims 5-8 are alleged to be rendered obvious by Wong in view of Barr under 35 U.S.C. § 103.*

10. Claims 5-8 are rejected under 35 U.S.C. § 103 as being unpatentable over Wong in view of Barr. The proposed rejection of these claims set forth in the Request is **adopted**. See the Request pp. 14-16 and the claim chart of Appendix I, which are hereby incorporated by reference. See also the discussion of the claim language on pages 8-11 of the Request.

**Issue 5**

*Claims 1, 10 and 12 are alleged to be anticipated by Nielsen under 35 U.S.C. § 102(b).*

11. Claims 1, 10 and 12 are rejected under 35 U.S.C. § 102(b) as being anticipated by Nielsen. The proposed rejection of these claims set forth in the Request is **adopted**. See Request pp. 17-19 and the claim chart of Appendix J, which are hereby incorporated by reference. See also the discussion of the claim language on pages 8-11 of the Request.

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**Issue 6**

*Claim 3 is alleged to be rendered obvious by Nielsen under 35 U.S.C. § 103.*

12. Claim 3 is rejected under 35 U.S.C. § 103 as being unpatentable over Nielsen. The proposed rejection of these claims set forth in the Request is **adopted**. See Request pp. 17-19 and the claim chart of Appendix J, which are hereby incorporated by reference. See also the discussion of the claim language on pages 8-11 of the Request.

**Issue 7**

*Claims 5-8 are alleged to be rendered obvious alleged to be rendered obvious by Nielsen in view of Barr under 35 U.S.C. § 103.*

13. Claims 5-8 are rejected under 35 U.S.C. § 103 as being unpatentable over Nielsen in view of Barr. The proposed rejection of these claims set forth in the Request is **adopted**. See Request pp. 17-19 and the claim chart of Appendix J, which are hereby incorporated by reference. See also the discussion of the claim language on pages 8-11 of the Request.

**Issue 8**

*Claims 1-9 and 11-12 are anticipated by Amidi under 35 U.S.C. § 102(b).*

14. Claims 1-9 and 11-12 are rejected under 35 U.S.C. § 102(b) as being anticipated by Amidi. The proposed rejection of these claims set forth in the Request is **adopted**. See Request pp. 19-21 and the claim chart of Appendix K, which are hereby incorporated by reference.

**Issue 9**

*Claim 10 is alleged to be rendered obvious by Amidi under 35 U.S.C. § 103.*

15. Claim 10 is rejected under 35 U.S.C. § 103 as being unpatentable over Amidi. The proposed rejection of these claims set forth in the Request is **adopted as modified** herein. See Request pp. 19-21 and the claim chart of Appendix K, which are hereby incorporated by reference.

With regard to claim 10, Appendix K, page 9, states:

“Amidi teaches doubling the available number of chip select signals, from two to four.

It would have been obvious to a person of ordinary skill in the art to apply the techniques of Amidi to double the number of chip select signals from one to two, for modules made for computer systems that provide only one chip select signal.”

In addition to the reasons for obviousness recited in the request, it is further noted that changes in proportion (e.g., from 2:4 to 1:2) were considered obvious improvements, *In re Reese*, 129 USPQ 402 (CCPA 1961).

***Response to Submissions by Patent Owner and Requestor***

16. No submissions have been filed by the patent owner.

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17. With regard to the request filed on May 11, 2010, pages 8-11 discuss the scope of the claim language. The examiner has carefully reviewed these pages, as well as the disclosure of the '386 patent, and finds the analysis of the claim terminology to be correct.

The examiner finds the scope of "corresponds" and "corresponding", discussed on these pages, to be particularly relevant to the rejections discussed above.

In determining the scope of the claim terminology, the claims will be given their broadest reasonable scope. The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, [70 USPQ2d 1827] (Fed. Cir. 2004). That determination must "be consistent with the specification, claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990). Note further that "the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005).

Note also MPEP 2111.

### ***Conclusion***

#### **SUBMISSIONS**

In order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patentability, such documents must be submitted in response to

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this Office action. Submissions after the next Office action, which is intended to be an Action Closing Prosecution (ACP), will be governed by 37 CFR 1.116(b) and (d), which will be strictly enforced.

#### EXTENSIONS OF TIME

Extensions of time under 37 CFR 1.136(a) will not be permitted in *inter partes* reexamination proceedings because the provisions of 37 CFR 1.136 apply only to “an applicant” and not to the patent owner in a reexamination proceeding. Additionally, 35 U.S.C. 314(c) requires that *inter partes* reexamination proceedings “will be conducted with special dispatch” (37 CFR 1.937). Patent owner extensions of time in *inter partes* reexamination proceedings are provided for in 37 CFR 1.956. Extensions of time are not available for third party requester comments, because a comment period of 30 days from service of patent owner’s response is set by statute. 35 U.S.C. 314(b) (3).

#### SERVICE OF PAPERS

Any paper filed with the USPTO, i.e., any submission made, by either the Patent Owner or the Third Party Requester must be served on every other party in the reexamination proceeding, including any other third party requester that is part of the proceeding due to merger of the reexamination proceedings. As proof of service, the party submitting the paper to the Office must attach a Certificate of Service to the paper, which sets forth the name and address of the party served and the method of service. Papers filed without the required Certificate of Service may be denied consideration. 37 CFR 1.903; MPEP 2666.06.

AMENDMENT IN REEXAMINATION PROCEEDINGS

Any proposed amendment to the specification and/or claims in this reexamination proceeding must comply with 37 CFR 1.530(d)-(j), must be formally presented pursuant to 37 CFR 1.52(a) and (b), and must contain any fees required by 37 CFR 1.20(c). Amendments in an *inter partes* reexamination proceeding are made in the same manner that amendments in an *ex parte* reexamination are made. MPEP 2666.01. See MPEP 2250 for guidance as to the manner of making amendments in a reexamination proceeding.

NOTIFICATION OF CONCURRENT PROCEEDINGS

The patent owner is reminded of the continuing responsibility under 37 CFR 1.985(a), to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving the patent undergoing reexamination or any related patent throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly inform the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP § 2686 and 2686.04.

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All correspondence relating to this *inter partes* reexamination proceeding should be directed:

By Mail to: Mail Stop *Inter Partes* Reexam  
Attn: Central Reexamination Unit  
Commissioner of Patents  
United States Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900  
Central Reexamination Unit

By hand: Customer Service Window  
Randolph Building  
401 Dulany St.  
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

Signed:

**/B. James Peikari/**

B. James Peikari  
Primary Examiner  
Art Unit 3992

Conferees:

  
JESSICA HARRISON  
SUPERVISORY PATENT EXAMINER

