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Attorneys for Defendant
 NETLIST, INC.

UNITED STATES DISTRICT COURT
 NORTHERN DISTRICT OF CALIFORNIA
 OAKLAND DIVISION

19 GOOGLE INC.,
 20 Plaintiff,
 21 v.
 22 NETLIST, INC.,
 23 Defendant.

Civil Action No. C08-04144 SBA
 [Related to Civil Action No. C09-05718 SBA]
**JOINT STATUS REPORT REGARDING
 REEXAMINATION OF U.S. PATENT NO.
 7,289,386**

1 **JOINT STATUS REPORT**

2 Pursuant to this Court’s September 13, 2010 Order (Dkt. No. 188), Plaintiff and Counter-
3 defendant Google Inc. (“Google”) and Defendant and Counterclaimant Netlist, Inc. (“Netlist”)
4 hereby submit this Joint Status Report to update the Court regarding the status of the *inter partes*
5 reexamination of U.S. Patent No. 7,289,386 (“the ’386 patent”).

6 **I. BRIEF PROCEDURAL HISTORY**

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8 On August 29, 2008 Plaintiff filed a Complaint for Declaratory Relief, seeking
9 declarations of noninfringement and invalidity regarding U.S. Patent No. 7,289,386 (“the ’386
10 patent”). (*See* Dkt. No. 1.)

11 Defendant filed an answer on November 18, 2008 denying Plaintiff’s claims and
12 asserting defenses of waiver, unclean hands and estoppel. (*See* Dkt. No. 10.) Defendant further
13 asserted counterclaims of infringement of the ’386 patent, including inducement and willful
14 infringement. (*See id.*) On December 8, 2009, Plaintiff filed a reply to Defendant’s
15 counterclaims denying Defendant’s claims and asserting defenses of waiver, unclean hands, and
16 estoppel. (*See* Dkt. No. 15.)

17 On August 9, 2010 the United States Patent and Trademark Office (“PTO”) ordered
18 reexamination proceedings on claims 1-12 of the ’386 patent. Plaintiff filed a motion to stay
19 proceedings pending reexamination on August 26, 2010 (*see* Dkt. No. 182), which Defendant did
20 not oppose. (*See* Dkt. No. 186.) Accordingly, the Court entered an Order Granting Plaintiff’s
21 Unopposed Motion to Stay Pending Reexamination on September 13, 2010, administratively
22 closed the matter and requested the parties apprise the Court regarding reexamination proceedings
23 every six months. (*See* Dkt. No. 188.)

24 **II. REEXAMINATION PROCEEDINGS REGARDING U.S. PATENT NO. 7,289,386**

25
26 On October 30, 2007 the PTO issued U.S. Patent No. 7,289,386 titled “Memory Module
27 Decoder” to Bhakta, et al. Plaintiff filed a request for *inter partes* reexamination of claims 1-12
28 of the ’386 patent on May 11, 2010. The PTO assigned this request control No. 95/000,546

1 (“’546 proceeding”) and ordered reexamination of claims 1-12 of the ’386 patent on August 9,
2 2010. The PTO issued a non-final Office action on August 27, 2010 rejecting claims 1-12 of the
3 ’386 patent in the ’546 proceeding. On October 27, 2010 Defendant timely filed, in response to
4 the PTO August 27, 2010 ’546 proceeding non-final Office action, an amendment and response
5 which proposed by amendment new claims 14-30. Defendant neither canceled nor amended
6 claims. On November 26, 2010, comments were timely filed by Plaintiff in the ’546 proceeding,
7 stating that the rejections of claims 1-12 should be maintained and new claims 14-30 should be
8 rejected. To date, no further office actions have been issued in the ’546 proceeding.

9 SMART Modular Technologies (WWH), Inc. (“SMART”) filed a second request for
10 *inter partes* reexamination of claims 1-13 of the ’386 patent on October 20, 2010. The PTO
11 assigned the SMART request control No. 95/000,577 (“’577 proceeding”). The PTO ordered
12 *inter partes* reexamination in the ’577 proceeding regarding claims 1-13 of the ’386 patent on
13 January 18, 2011. To date, no Office action has been issued in the ’577 proceeding.

14 **III. STATUS OF REEXAMINATION PROCEEDINGS**

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16 On March 3, 2011, the PTO *sua sponte* merged the ’546 and ’577 proceedings into a
17 single matter, as both proceedings were pending, had yet to be terminated and involved
18 overlapping claims of the same patent. (*See Ex. 1, Decision, Sua Sponte, To Merge*
19 *Reexamination Proceedings* dated March 3, 2011). Defendant’s proposal of claims 14-30
20 currently applies to the ’546 proceeding only; however the March 3, 2011 Decision to merge the
21 ’546 and ’577 proceedings stated that an Office action requiring an amendment placing the claims
22 in identical form is being issued concurrently with the Decision. The PTO has issued no further
23 Office actions other than those discussed herein.

24 **IV. CONCLUSION**

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26 Counsel for Plaintiff and Defendant conferred regarding this Joint Status Report on
27 March 10, 12 and 14, 2011, and have reviewed and agree to this Joint Status Report.
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1 Respectfully Submitted,

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3 Dated: March 14, 2011

DLA PIPER LLP (US)

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BY: /s/ Sean C. Cunningham

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SEAN C. CUNNINGHAM

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Attorneys for Defendant

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NETLIST, INC.

8 Dated: March 14, 2011

KING & SPALDING LLP

9

BY: /s/ Allison Altersohn

10

ALLISON ALTERSOHN

11

Attorneys for Plaintiff

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GOOGLE INC.

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DECLARATION OF CONSENT

15

16

Pursuant to General Order No. 45, Section X(B) regarding signatures, I attest under

17

penalty of perjury that concurrence in the filing of this document has been obtained from Allison

18

Altersohn.

19

20

Dated: March 14, 2011

DLA PIPER LLP (US)

21

BY: /s/ Sean C. Cunningham

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SEAN C. CUNNINGHAM

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Attorneys for Defendant

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NETLIST, INC.

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