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SMART Modular Technologies, Inc.
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8 **UNITED STATES DISTRICT COURT**
9 **NORTHERN DISTRICT OF CALIFORNIA**
10 **SAN FRANCISCO DIVISION**

11 SMART MODULAR TECHNOLOGIES, INC.,

12 Plaintiff,

13 v.

14 NETLIST, INC.,

15 Defendant.
16

Case No.

**COMPLAINT FOR DECLARATORY
JUDGMENT**

DEMAND FOR JURY TRIAL

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1 For its Complaint against Defendant NETLIST, INC., Plaintiff SMART MODULAR
2 TECHNOLOGIES, INC. alleges as follows:

3 **FACTUAL BACKGROUND**

4 1. On information and belief, Netlist is a Delaware corporation with its principle
5 place of business at 51 Discovery, Suite 150, Irvine, California 92618. Netlist makes, imports,
6 uses, offers to sell, and/or sells within the United States, including the state of California and the
7 judicial district, products, including, but not limited to, computer memory subsystems.

8 2. SMART is a California corporation with its principle place of business at 39870
9 Eureka Drive, Newark, California 94560.

10 **NETLIST'S THREAT OF SUIT AGAINST SMART**

11 3. On August 22, 2013, NETLIST sent SMART a letter stating that "Netlist has
12 concluded that SMART Modular Technologies, Inc., SMART Storage Systems, Inc., SMART
13 Worldwide Holdings, Inc. and SMART Technologies, Inc. (collectively "Defendants") are
14 directly and /or indirectly infringing the following United States patents at least through the
15 making, using, offering for sale and/or selling of the recently announced ULLtraDIMM product:

16 U.S. Patent No. 8,001,434, Memory Board With Self-Testing Capability

17 U.S. Patent No. 8,301,833, Non-Volatile Memory Module

18 U.S. Patent No. 8,359,501, Memory Board With Self-Testing Capability

19 U.S. Patent No. 8,516,185, System and Method Utilizing Distributed Byte-Wise Buffers
20 on a Memory Module

21 U.S. Patent No. 8,516,187, Data Transfer Scheme for Non-Volatile Memory Module"

22 **JURISDICTION AND VENUE**

23 4. This Court has subject matter jurisdiction over this action pursuant to 28 U.S.C.
24 §§ 1331, 1338, 1367, 2201, and 2202.

25 5. This Court has personal jurisdiction over NETLIST. NETLIST maintains its
26 principle place of business in California and transitions business in California. In addition,
27 NETLIST is a plaintiff in this District at least in the pending action *Netlist, Inc. v. Google Inc.*
28 4-09-cv-05718 SBA (CAND).

1 6. Venue is proper in this District pursuant to 28 U.S.C. § 1391.

2 **INTRADISTRICT ASSIGNMENT**

3 7. For purposes of intradistrict assignment pursuant to Local Rule 3-2(c), this
4 Intellectual Property Action is to be assigned on a district-wide basis.

5 **COUNT I**

6 **(Declaratory Judgment of Non-Infringement of U.S. Patent No. 8,001,434)**

7 8. SMART incorporates by reference, as if fully set forth herein, the allegations of
8 the preceding paragraphs of this Complaint.

9 9. Upon information and belief, NETLIST is the owner of the '434 patent.

10 10. NETLIST is asserting the '434 patent against "ULLtraDIMM."

11 11. SMART, contends that it has not infringed and does not infringe, any valid and
12 enforceable claim of the '434 patent.

13 12. An actual and justiciable controversy has thus arisen between SMART and
14 NETLIST concerning the alleged infringement of the '434 patent.

15 **COUNT II**

16 **(Declaratory Judgment of Invalidity of U.S. Patent No. 8,001,434)**

17 13. SMART incorporates by reference, as if fully set forth herein, the allegations of
18 the preceding paragraphs of this Complaint.

19 14. Upon information and belief, NETLIST contends that the '434 patent is valid.

20 15. SMART contends that the claims of the '434 patent are invalid under 35 U.S.C.
21 §§ 101, 102, 103, and/or 112.

22 16. An actual and justiciable controversy has thus arisen between SMART and
23 NETLIST concerning the validity of the '434 patent.

24 **COUNT III**

25 **(Declaratory Judgment of Non-Infringement of U.S. Patent No. 8,301,833)**

26 17. SMART incorporates by reference, as if fully set forth herein, the allegations of
27 the preceding paragraphs of this Complaint.

28 18. Upon information and belief, NETLIST is the owner of the '833 patent.

1 19. NETLIST is asserting the '833 patent against "ULLtraDIMM."

2 20. SMART, contends that it has not infringed and does not infringe, any valid and
3 enforceable claim of the '833 patent.

4 21. An actual and justiciable controversy has thus arisen between SMART and
5 NETLIST concerning the alleged infringement of the '833 patent.

6 **COUNT IV**

7 **(Declaratory Judgment of Invalidity of U.S. Patent No. 8,301,833)**

8 22. SMART incorporates by reference, as if fully set forth herein, the allegations of
9 the preceding paragraphs of this Complaint.

10 23. Upon information and belief, NETLIST contends that the '833 patent is valid.

11 24. SMART contends that the claims of the '833 patent are invalid under 35 U.S.C.
12 §§ 101, 102, 103, and/or 112.

13 25. An actual and justiciable controversy has thus arisen between SMART and
14 NETLIST concerning the validity of the '833 patent.

15 **COUNT V**

16 **(Declaratory Judgment of Non-Infringement of U.S. Patent No. 8,359,501)**

17 26. SMART incorporates by reference, as if fully set forth herein, the allegations of
18 the preceding paragraphs of this Complaint.

19 27. Upon information and belief, NETLIST is the owner of the '434 patent.

20 28. NETLIST is asserting the '501 patent against "ULLtraDIMM".

21 29. SMART contends that it has not infringed and does not infringe, any valid and
22 enforceable claim of the '501 patent.

23 30. An actual and justiciable controversy has thus arisen between SMART and
24 NETLIST concerning the alleged infringement of the '501 patent.

25 **COUNT VI**

26 **(Declaratory Judgment of Invalidity of U.S. Patent No. 8,359,501)**

27 31. SMART incorporates by reference, as if fully set forth herein, the allegations of
28 the preceding paragraphs of this Complaint.

1 32. Upon information and belief, NETLIST contends that the '501 patent is valid.
2 33. SMART contends that the claims of the '501 patent are invalid under 35 U.S.C.
3 §§ 101, 102, 103, and/or 112.
4 34. An actual and justiciable controversy has thus arisen between SMART and
5 NETLIST concerning the validity of the '501 patent.

6 **COUNT VII**

7 **(Declaratory Judgment of Non-Infringement of U.S. Patent No. 8,516,185)**

8 35. SMART incorporates by reference, as if fully set forth herein, the allegations of
9 the preceding paragraphs of this Complaint.

10 36. Upon information and belief, NETLIST is the owner of the '185 patent.

11 37. NETLIST is asserting the '185 patent against "ULLtraDIMM".

12 38. SMART, contends that it has not infringed and does not infringe, any valid and
13 enforceable claim of the '185 patent.

14 39. An actual and justiciable controversy has thus arisen between SMART and
15 NETLIST concerning the alleged infringement of the '185 patent.

16 **COUNT VIII**

17 **(Declaratory Judgment of Invalidity of U.S. Patent No. 8,516,185)**

18 40. SMART incorporates by reference, as if fully set forth herein, the allegations of
19 the preceding paragraphs of this Complaint.

20 41. Upon information and belief, NETLIST contends that the '185 patent is valid.

21 42. SMART contends that the claims of the '185 patent are invalid under 35 U.S.C.
22 §§ 101, 102, 103, and/or 112.

23 43. An actual and justiciable controversy has thus arisen between SMART and
24 NETLIST concerning the validity of the '185 patent.

25 **COUNT IX**

26 **(Declaratory Judgment of Non-Infringement of U.S. Patent No. 8,516,187)**

27 44. SMART incorporates by reference, as if fully set forth herein, the allegations of
28 the preceding paragraphs of this Complaint.

1 45. Upon information and belief, NETLIST is the owner of the '187 patent.

2 46. NETLIST is asserting the '187 patent against "ULLtraDIMM".

3 47. SMART, contends that it has not infringed and does not infringe, any valid and
4 enforceable claim of the '187 patent.

5 48. An actual and justiciable controversy has thus arisen between SMART and
6 NETLIST concerning the alleged infringement of the '187 patent.

7 **COUNT X**

8 **(Declaratory Judgment of Invalidity of U.S. Patent No. 8,516,187)**

9 49. SMART incorporates by reference, as if fully set forth herein, the allegations of
10 the preceding paragraphs of this Complaint.

11 50. Upon information and belief, NETLIST contends that the '187 patent is valid.

12 51. SMART contends that the claims of the '187 patent are invalid under 35 U.S.C.
13 §§ 101, 102, 103, and/or 112.

14 52. An actual and justiciable controversy has thus arisen between SMART and
15 NETLIST concerning the validity of the '187 patent.

16 **DEMAND FOR JURY TRIAL**

17 SMART demands a trial by jury on all issues so triable.


18 **PRAYER FOR RELIEF**

19 **WHEREFORE**, SMART respectfully requests that the Court enter judgment for
20 SMART, and award it the following relief:

- 21 A. declare that SMART has not infringed, and does not infringe, any valid and
22 enforceable claim of the '434, '833, '501, '185, and '187 patents;
- 23 B. declare that the claims of the '434, '833, '501, '185, and '187 patents are invalid;
- 24 C. find this case an exceptional case and award SMART its attorneys' fees and costs
25 under 35 U.S.C. § 285 and all other applicable statutes, rules, and laws; and
- 26 D. grant SMART such other and further relief as the Court deems appropriate and
27 just under the circumstances.
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1 Dated: August 23, 2013

ORRICK, HERRINGTON & SUTCLIFFE LLP

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3 By: 
4 MICHAEL P. HEAFEY
Attorneys for Plaintiff
5 SMART MODULAR TECHNOLOGIES, INC.

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