

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TCL INDUSTRIES HOLDINGS CO. AND HISENSE CO., LTD.

Petitioners

v.

PARKERVISION, INC.

Patent Owner

Case No. IPR2021-00985

Patent No. 7,292,835

**PETITIONERS' MOTION FOR ROUTINE AND/OR ADDITIONAL
DISCOVERY UNDER 37 C.F.R. § 42.51(b)**

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IPR2021-00985

Petitioners' Motion for Routine and/or Additional Discovery

Pursuant to the Board's e-mail to counsel dated March 9, 2022 authorizing this motion, TCL Industries Holdings Co., Ltd. ("TCL") and Hisense Co. Ltd. ("Hisense") (collectively, "Petitioners") moves for an Order requiring Patent Owner ParkerVision, Inc. ("ParkerVision") to produce discovery comprising its Final Infringement Contentions for Patent No. 7,292,835 (the "'835 patent") from the underlying litigations between the parties in the Western District of Texas ("WDTX"). Counsel for Petitioners already has the requested discovery in their possession by virtue of their participation in the underlying litigations, and so granting this motion would not burden ParkerVision in any way. Further, Petitioners offered to file the materials under seal, yet ParkerVision still refuses to allow its Final Infringement Contentions to be seen by the Board.

The motion should be granted for two independent reasons. First, the Final Infringement Contentions are required "routine" discovery under 37 C.F.R. §42.51(b)(1)(iii) because, in its Patent Owner Response (Paper 17), ParkerVision has taken positions that are inconsistent with positions it took in the Final Infringement Contentions. Alternatively, the requested discovery should be

ordered as “additional” discovery under 37 C.F.R. §42.51(b)(2)(i) because it is in the interests of justice.¹

I. PARKER VISION SHOULD BE ORDERED TO PRODUCE ITS FINAL INFRINGEMENT CONTENTIONS AS “ROUTINE” DISCOVERY

ParkerVision’s Patent Owner Response is inconsistent with its previous positions on two claim limitations that could dispose of this IPR. In opposition to Ground 1 of the Petition, ParkerVision offers only two arguments: (1) Hulkko does not disclose a “storage module” (Paper 17 at 60-69) and (2) Hulkko (as modified by Gibson) does not disclose “a cable modem” (*id.* at 69-71). ParkerVision makes

¹ Petitioners did not attach the Final Infringement Contentions to this motion because ParkerVision contends that the materials are “confidential.” ParkerVision contends it paid a third party to do reverse engineering on the accused products, which are publicly available smart TVs containing Wi-Fi chips manufactured by other third parties. The Final Infringement Contentions contain screen shots of circuit diagrams from the reverse engineering ParkerVision commissioned. ParkerVision contends that it has a non-disclosure agreement with the third-party reverse engineering firm requiring the documents to be filed under seal in litigation or in IPR proceedings.

similar arguments with respect to Ground 2. *See id.* at 71-79. ParkerVision's inconsistent positions with respect to these issues are discussed in turn below.

A. ParkerVision's Inconsistent Positions on "Storage Module"

In another IPR involving a related patent (*i.e.*, Patent No. 7,110,444 ("the '444 patent")), the Board construed "storage module" to mean "an element of a system that stores non-negligible amounts of energy from an input EM signal." Paper 17 at 2 (quoting *Intel Corp. v. ParkerVision, Inc.*, IPR2020-01265, Paper 44 (FWD) at 41). There, the Board found that another patent that was incorporated by reference into the '444 patent, *i.e.*, Patent No. 6,061,551 ("the '551 patent"), has an express definition of "storage module." IPR2020-01265, Paper 44 at 14-42. In this IPR (and in the related WDTX litigations involving TCL and Hisense), ParkerVision agrees that the "storage" module terms in the '835 and '444 patents should be given the same construction. *See* Paper 17 at 2 n. 2 ("The January 2022 IPR decision and January/October 2021 District Court claim constructions relate to ParkerVision patents involving similar technology to the '835 patent."); *id.* at 3 n. 4 ("the construction of 'storage module' and 'storage element' should be consistent"); Exs. 1011, 2011-2015 (court papers showing that ParkerVision argued that all "storage" terms have the same meaning across various patents).

In its Patent Owner Response, ParkerVision attempts to further construe the phrase "non-negligible" in the Board's construction, arguing that the amount of

energy on the capacitor must be shown “mathematically” in a complex, three-step calculation that compares the calculated *total* “available energy” to the “energy in a capacitor.” Paper 17 at 62-67. In its Final Infringement contentions in the underlying TCL/Hisense litigations, however, ParkerVision did not disclose any such mathematical calculations, nor did it argue that such calculations are somehow required to show that a capacitor performs the routine function of storing “non-negligible” amounts of energy as it has here. Instead, ParkerVision’s Final Infringement Contentions simply point to a capacitor in a Wi-Fi chip and identify that capacitor as the alleged “storage module.”²

ParkerVision’s newly minted “mathematical calculations” are also inconsistent with, and precluded by, the Federal Circuit’s decision in *ParkerVision, Inc. v. Qualcomm Inc.*, 621 F. App’x 1009 (Fed. Cir. 2015). One of the patents at issue there was the ’551 patent. In the claim construction proceedings preceding the Federal Circuit’s decision, ParkerVision itself argued that “transferring non-negligible amounts of energy” means “transferring energy (i.e., voltage and current

² At a minimum, ParkerVision should be required to submit its Final Infringement Contentions for the Board’s *in camera* review in the event it disputes any of the descriptions provided by Petitioners herein.

over time) in amounts that are distinguishable from noise.” *ParkerVision, Inc. v. Qualcomm Inc.*, No. 3:11-CV-719-J-37TEM, 2013 WL 633077, at *5-*7 (M.D. Fla. Feb. 20, 2013). ParkerVision did not allege that non-negligible energy needed to be mathematically determined. *See id.* Nor did ParkerVision argue that “non-negligible” compares the energy in a capacitor to the *total* “available energy” (as in ParkerVision’s Patent Owner Response here); instead, ParkerVision argued that non-negligible energy is an amount that is merely “distinguishable from noise.” *See id.*

The district court accepted ParkerVision’s proposed construction with minor amendment, holding that “transferring non-negligible amounts of energy” means “transferring energy *in amounts that are distinguishable from noise.*” *ParkerVision, Inc.*, 2013 WL 633077, at *7 (emphasis added). And ParkerVision did not dispute that construction on appeal. *ParkerVision, Inc. v. Qualcomm Inc.*, 621 F. App’x 1009, 1018 (Fed. Cir. 2015) (“That construction is not disputed on appeal.”). ParkerVision’s inventor, Mr. Sorrells—who is also named as the lead inventor of the ’835 patent (*see* Ex. 1001)—“explained at trial that transferring a non-negligible amount of energy into the storage capacitor means ‘that you have to transfer enough energy *to overcome the noise in the system* to be able to meet your specifications.’” 621 F. App’x at 1019 (emphasis added). Then, in another IPR involving U.S. Patent No. 6,370,371, ParkerVision told the PTAB that the Middle

District of Florida's construction of "non-negligible" amounts of energy is correct.

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Preliminary Response, (Sept. 24, 2014) at 23 (“[T]he Court adopted the *exact same* construction that Patent Owner now advances for ‘non-negligible amounts of energy.’”) (ParkerVision’s emphasis).³

Moreover, in the Qualcomm litigation, Mr. Sorrells testified that when a product functions according to its specifications, this “is *proof* that a ‘non-negligible’ amount of energy is transferred to the storage element in those products.” 621 F. App’x at 1019 (emphasis added). “Mr. Sorrells’ testimony thus establishes that to determine whether or not energy in amounts distinguishable from noise has been transferred from the carrier signal, one may look to whether the down-converting circuit functions in practice. If a circuit successfully down-

³ Therein, ParkerVision also argued that “the Specification supports Patent Owner’s construction that ‘a storage module’ means ‘an apparatus that stores non-negligible amounts of energy from the carrier signal.’” *Id.*

converts, *that is proof* that enough energy has been transferred to overcome the noise in the system.” *Id.* (emphasis added).⁴

In keeping with Mr. Sorrells' testimony about how to prove that a capacitor has a “non-negligible” amount of energy, ParkerVision's Final Infringement Contentions against TCL and Hisense identify a capacitor in a Wi-Fi chip as a “storage module.” No mathematical calculations are shown or even mentioned as being needed. The Final Infringement contentions are thus inconsistent with ParkerVision's new mathematical-calculation construction of “non-negligible,” making them highly relevant to the issues before the Board here. “A patent may not, like a ‘nose of wax,’ be twisted one way to avoid anticipation and another to find infringement.” *Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1351 (Fed. Cir. 2001) (quoting *Sterner Lighting, Inc. v. Allied Elec. Supply, Inc.*,

⁴ This testimony precludes ParkerVision's brand new argument that non-negligible amounts of energy must be mathematically calculated, as a percentage of the total available energy that is stored in a capacitor. *See Nestle USA, Inc. v. Steuben Foods, Inc.*, 884 F.3d 1350, 1352 (Fed. Cir. 2008) (“[I]t is the identity of the *issues* that were litigated that determines whether collateral estoppel should apply.”) (original emphasis, internal quotations omitted).

431 F.2d 539, 544 (5th Cir. 1970) (citing *White v. Dunbar*, 119 U.S. 47, 51 (1886)).

B. ParkerVision's Inconsistent Positions on "Cable Modem"

In its Patent Owner Response, ParkerVision argues that the preamble of claim 1 of the '835 patent is limiting and that "what makes a modem a 'cable' modem relates to the type of physical transmission line/cabling over which data is ultimately transmitted." Paper 17 at 49-50. But in the underlying TCL/Hisense litigations, ParkerVision did *not* seek a construction from the WDTX that the preamble is limiting or seek a construction of "cable modem." And ParkerVision's Final Infringement Contentions allege that a Wi-Fi chip—a device that by definition has no physical transmission line or cabling—is a "cable modem."⁵ Thus, ParkerVision's Patent Owner Response as to the meaning of the "cable modem" term is inconsistent with ParkerVision's Final Infringement Contentions.

⁵ Here again, to the extent that ParkerVision wishes to dispute Petitioner's statement that the Final Infringement Contentions allege that a Wi-Fi chip is a "cable modem," then ParkerVision should be required to submit its Final Infringement Contentions for the Board's *in camera* review.

C. The Final Infringement Contentions Are Routine Discovery

As shown above, ParkerVision's Patent Owner Response is inconsistent with ParkerVision's Final Infringement Contentions as to the "storage module" and "cable modem" terms. In its email to the Board of March 9, 2022, ParkerVision did not dispute this. Instead, ParkerVision argued only that Petitioners had "waived" any ability to address ParkerVision's mathematical calculations as to the "storage module" issue (ParkerVision did not address the "cable modem" term). This is wrong of course; a party cannot "waive" a response to an argument that ParkerVision never made in the underlying litigation and raised for the very first time in its Patent Owner Response.⁶ Indeed, that is the very purpose of allowing a Petitioner Reply. Further, ParkerVision can raise any

⁶ This is not the first time ParkerVision radically changed theories. In IPR2021-01265, the Board excluded ParkerVision's "storage module" arguments. IPR2021-01265, Paper 44 at 70 ("... Patent Owner *could have* asserted that Tayloe was distinguishable on this basis, *but did not do so.*") (Board's emphasis). More recently, the Middle District of Florida excluded ParkerVision's expert (*ParkerVision, Inc. v. Qualcomm Inc.*, Case No. 6:14-cv-00687, Dkt. 683 (M.D. Fla. Mar. 9, 2022) (granting motion at Dkt. 491)) and entered judgment in favor of defendant Qualcomm (*id.* at Dkt. 686 (granting motion at Dkt. 494)).

timeliness arguments in its Sur-Reply or by way of a motion to exclude; there is no basis for ParkerVision to shield its Final Infringement Contentions from the Board's review during the discovery period of these proceedings.

Patents are "affected with a public interest." 37 C.F.R. § 1.56(a).

ParkerVision should not be allowed to frustrate the Board's statutory obligation to take "a second look at an earlier administrative grant" of the challenged patent by taking one position in allegedly "confidential" Final Infringement Contentions that it refuses to produce in IPR discovery, while taking an entirely inconsistent position in its IPR papers in an attempt to avoid cancellation. *See Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 279 (2016). Rule 42.51(b)(1)(iii) is specifically designed to prevent such abuses: "a party *must* serve relevant information that is inconsistent with a position advanced by the party during the proceeding." (emphasis added). The Board should grant the motion for this reason alone.

II. ALTERNATIVELY, PARKERVISION SHOULD BE ORDERED TO PRODUCE ITS FINAL INFRINGEMENT CONTENTIONS AS "ADDITIONAL" DISCOVERY

The Board may grant additional discovery where necessary "in the interests of justice." 37 C.F.R. § 42.51(b)(2)(i). This standard is plainly met here. As discussed above, ParkerVision has placed the construction of two claim elements (*i.e.*, "storage module" and "cable modem") at issue in this IPR, as well as the nature of the evidence required to show that such claim elements are met in the

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prior art. And as shown above, ParkerVision's Patent Owner Response is inconsistent with its Final Infringement Contentions on both scores. Therefore, the motion can also be granted under 37 C.F.R. § 42.51(b)(2)(i). *See Bestway (USA), Inc. v. Team Worldwide Corp.*, IPR2018-00859, Paper 67 (April 9, 2019) at 8-9 (ordering production of "confidential expert reports and deposition transcripts" because "[i]nconsistent positions taken by Patent Owner's declarant as to underlying factual inquiries in an obviousness analysis would be useful to Petitioners" and because "Petitioners could not obtain the information from other sources.").

In assessing whether to grant additional discovery, the Board applies a five factor "necessary in the interest of justice" standard. *See Garmin Int'l, Inc. v. Cuzzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6-7 (PTAB Mar. 5, 2013). All five *Garmin* factors support granting Patent Owner's motion.

A. There Is More Than a Possibility or Mere Allegation That the Requested Discovery Will Yield Useful Information.

ParkerVision produced its Final Infringement Contentions in the underlying WDTX litigations, so this is not a fishing expedition for something that may or may not exist. And since these materials are inconsistent with ParkerVision's Patent Owner Response, the information is useful in this IPR. *Bestway (USA), Inc. v. Team Worldwide Corp.*, IPR2018-00859, Paper 67 (April 9, 2019) at 8-9

(ordering production of “confidential expert reports and deposition transcripts”

because “[i]nconsistent positions taken by Patent Owner’s declarant as to

underlying factual inquiries in an obviousness analysis would be useful to

Petitioners” and because “Petitioners could not obtain the information from other

sources.”).

B. Patent Owner Does Not Seek Petitioner’s Litigation Positions or Their Underlying Basis

Petitioners are not trying to discover the underlying basis for ParkerVision’s litigation positions; they seek only to show the inconsistencies between the Patent Owner’s Response and its existing Final Infringement Contentions.

C. Petitioners Cannot Generate Equivalent Information by Other Means

This factor strongly favors Petitioners because ParkerVision will not make its Final Infringement Contentions available unless the Board grants this motion.

Bestway (USA), Inc. v. Team Worldwide Corp., IPR2018-00859, Paper 67 (April 9,

2019) at 8-9 (ordering production of “confidential expert reports and deposition

transcripts” where “Petitioners could not obtain the information from other

sources.”).

D. The Request for ParkerVision's Final Infringement Contentions Is Easily Understandable and Not Overly Burdensome

The fourth and fifth *Garmin* factors also favor Petitioners, which seek only the ability to use in this IPR documents that are already in ParkerVision's immediate possession.

III. CONCLUSION

The Board should order ParkerVision to produce its Final Infringement Contentions from the TCL and Hisense WDTX litigations as "routine" and/or "additional" discovery. If the motion is granted, Petitioners are willing to submit the Final Infringement Contentions as sealed exhibits under a protective order.

Dated: March 23, 2022

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the this paper was served on March 23, 2022, via electronic mail to counsel for Patent Owner:

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