

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

PARKERVISION, INC.,
Patent Owner.

IPR2020-01265
Patent 7,110,444 B1

Before MICHAEL R. ZECHER, BART A. GERSTENBLITH, and
IFTIKHAR AHMED, *Administrative Patent Judges*.

GERSTENBLITH, *Administrative Patent Judge*.

DECISION
Conduct of the Proceeding
37 C.F.R. § 42.5(a)

I. DISCUSSION

A conference call was held on September 24, 2021, between respective counsel for the parties and Judges Zecher, Gerstenblith, and Ahmed in response to a request by Intel Corporation (“Petitioner”) for authorization to file a motion to strike Exhibit 2022 filed by ParkerVision, Inc. (“Patent Owner”) as well as portions of Patent Owner’s Sur-reply (Paper 26) that Petitioner contends raise arguments that are improper for a sur-reply. During the call, the parties raised their respective positions regarding the merits of Petitioner’s request.

With respect to Exhibit 2022, Petitioner filed Objections to Evidence Submitted with Patent Owner’s Sur-reply (Paper 27), arguing, *inter alia*, that the timing of Patent Owner’s filing was improper because 37 C.F.R. § 42.23(b) limits new evidence filed with a sur-reply to deposition transcripts of the cross-examination of any reply witness. *See id.* at 1. During the conference call, we authorized Petitioner to raise its arguments regarding the filing of Exhibit 2022 in a motion to exclude in accordance with the schedule for motions to exclude, oppositions thereto, and replies in support thereof.

With respect to Patent Owner’s Sur-reply, a determination of which arguments may exceed the proper scope for a sur-reply often requires consideration of the entire record. We are capable of making that determination, in most instances, without additional briefing by the parties. Nonetheless, it is helpful when the complaining party is given an opportunity to identify the precise arguments complained of and the opposing party is given an opportunity to respond. Accordingly, although we did not authorize a motion to strike, we authorized Petitioner to identify

the arguments that it contends exceed the scope for a sur-reply brief and we authorized Patent Owner to respond, as set forth in detail below.

As examples of the scope of papers we authorized pertaining to allegedly improper arguments in Patent Owner's Sur-reply, the parties are directed to Papers 35 and 38 from *Netflix, Inc. v. DivX, LLC*, IPR2020-00511. Those papers provide useful examples of how the charts, authorized during our conference and in the Order below, should appear.

In preparing their papers, the parties shall bear in mind the following guidance from the Patent Trial and Appeal Board Consolidated Trial Practice Guide:

Sur-replies should only respond to arguments made in reply briefs, comment on reply declaration testimony, or point to cross-examination testimony. . . . [A] sur-reply may address the institution decision if necessary to respond to the petitioner's reply. This sur-reply practice essentially replaces the previous practice of filing observations on cross-examination testimony.

Generally, a . . . sur-reply may only respond to arguments raised in the preceding brief. 37 C.F.R. § 42.23, except as noted above. "Respond," in the context of 37 C.F.R. § 42.34(b), does not mean proceed in a new direction with a new approach as compared to the positions taken in a prior filing. While . . . sur-replies can help crystalize issues for decision, a . . . sur-reply that raises a new issue or belatedly presents evidence may not be considered.

Patent Trial and Appeal Board Consolidated Trial Practice Guide
(Nov. 2019), 73–74, *available at* <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>.

II. ORDER

It is:

ORDERED that Petitioner may file, as a paper, a document that identifies arguments in Patent Owner's Sur-reply that Petitioner contends exceed the proper scope of a sur-reply. Petitioner's submission shall be in the form of a chart containing no more information than the paper/exhibit number and page/line range, as appropriate, of the material that Petitioner alleges exceed the proper scope of a sur-reply. Other than a brief introductory sentence immediately after the caption identifying the submission as being response to this Order, no explanation, elaboration, or discussion shall be included in the submission. Petitioner's submission is due by October 1, 2021. In addition to filing, Petitioner shall provide an electronic version of its submission to Patent Owner in a format that enables Patent Owner to add material, as discussed in the following paragraph, thereto; and

FURTHER ORDERED that Patent Owner may file, as a paper, a document responding to Petitioner's submission. Patent Owner's filing shall consist of a chart containing the items identified by Petitioner, as explained in the immediately preceding paragraph, and Patent Owner's response to said items in one-to-one correspondence (by row), in a column next to Petitioner's list. Patent Owner may state "none" for any items for which Patent Owner chooses not to provide a response. Other than a brief, introductory sentence immediately after the caption identifying the submission as being responsive to this Order and Petitioner's submission, Patent Owner's response shall not include arguments or explanations. Each listed item in Patent Owner's responsive paper should identify, by

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paper/exhibit number and page/line range, as appropriate, where Patent Owner initially raised the issue and/or the specific argument or evidence to which Patent Owner's Sur-reply is responsive that justifies the inclusion of the material in the Sur-reply. Patent Owner's submission shall be filed by October 8, 2021.

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