

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Intel Corporation
Petitioner

v.

ParkerVision, Inc.
Patent Owner

Case No. IPR2020-01265
U.S. Patent No. 7,110,444

**PETITIONER'S REPLY IN SUPPORT OF MOTION TO EXCLUDE
EVIDENCE**

Patent Owner's ("PO's") opposition turns the facts on their head in an attempt to present an exhibit that is procedurally improper, unfairly prejudicial, and without even a minimal evidentiary foundation.

I. EXHIBIT 2022 IS PROCEDURALLY IMPROPER

Exhibit 2022 is improper "new evidence" that would take the trial "in a new direction with a new approach." TPG 74; 37 C.F.R. § 42.23(b). PO was obligated to advance in its POR all arguments as to why Tayloe does not disclose a storage element but advanced only one—that Tayloe's capacitors are not used in an "energy transfer system" to drive a "low impedance load." (POR, 74.) PO never argued that Tayloe's capacitors do not store non-negligible energy, much less set forth the new 3-step calculations presented in Exhibit 2022.

PO's opposition does not deny PO's new position that Exhibit 2022's 25 pages of calculations are "necessary" to the invalidity analysis. (Sur-Reply, 16.) PO also does not and cannot deny that it never presented these "necessary" calculations in its POR. And PO cannot identify any reason why it could not have set forth the Exhibit 2022 analysis in its POR. That should end the matter.

Instead, PO wrongly attempts to blame Intel for PO's untimely exhibit. *First*, PO asserts that "[d]espite the parties disputing the construction of 'storage element' in the related District Court litigation, Intel failed to propose a construction for the [storage element] term in its Petition." (Opp., 3.) But when

Intel filed the Petition in July 2020, neither party had identified “storage element” as a term to be construed. (Reply, 13-14.) The claim construction dispute arose when PO proposed, *for the first time in its POR*, construing “storage element” as an element “that stores non-negligible amounts of energy.” (POR, 2.) But despite this construction, PO never argued in the POR that Tayloe’s capacitors do not store non-negligible energy, or proposed the 3-step analysis advanced in Exhibit 2022.

Second, PO incorrectly asserts that its POR *did* dispute that Tayloe’s capacitors store non-negligible energy. But each quote PO cites asserts only that Tayloe does not disclose a storage element because Tayloe purportedly does not disclose an energy transfer system with a low impedance load. (POR, 49, 54-70, 72-75.) No quote asserts that the energy stored on Tayloe’s capacitors is negligible. PO also suggests Dr. Steer disputed that Tayloe’s capacitors store non-negligible energy. (Opp., 4.) But Dr. Steer’s declaration at ¶287 (miscited as ¶289) merely repeats PO’s entire proposed “storage element” construction. And the textual emphasis in the declaration—which PO misleadingly omits—shows that his sole basis for distinguishing Tayloe was the “energy transfer system” language, not the “non-negligible energy” language: “[N]one of the capacitors in Tayloe is an ‘element of an *energy transfer system* that stores non-negligible amounts of energy from an input electromagnetic signal.’” (Ex. 2021 ¶287 (emphasis in original).)

Similarly, Dr. Steer’s *complete* deposition answer (again misleadingly

abridged by PO (Opp., 9)) admitted that Tayloe’s capacitors *do* store non-negligible amounts of energy and distinguished those capacitors from the ’444 patent only because they allegedly do not “drive a low impedance load”:

Q: Do the capacitors 72, 74, 76, and 78, disclosed in Tayloe, store non-negligible amounts of energy?

A: Well, *the non-negligible energy that they store* must drive a low impedance load. So in that sense, the capacitors in Tayloe, in his prototype system, do not store the non-negligible energy that is described in the patent *because that non-negligible energy must be able to describe -- must be able to drive a low impedance load.*

(Ex. 1029, 119:9-19 (emphasis added).) Moreover, even setting aside the POR’s failure to argue that Tayloe’s capacitors do not store “non-negligible energy,” nothing in the POR discloses the calculations that PO now deems “necessary.”

PO also fails to distinguish the case law Intel cited. Contrary to PO’s argument (Opp., 8 (citing *Lenovo Holding Co.*)), it does not matter that Exhibit 2022 is a deposition exhibit rather than a declaration. In *Netflix, Inc. v. DivX, LLC*, the Board excluded exhibits newly offered in a sur-reply even though they had been “used in the cross-examination” of petitioner’s expert. No. IPR2020-00511, 2021 WL 3599429, at *22 (P.T.A.B. Aug. 13, 2021). PO argues that *Netflix* is distinguishable because the “deponent indicated at his deposition that he ‘was not familiar with’ the content of the exhibits.” (Opp., 8.) But it is undisputed that Dr. Subramanian never saw Exhibit 2022 before his deposition. And in another IPR, the Board excluded a deposition exhibit newly offered in sur-reply *even though*

petitioner's expert testified he probably had seen it before. Netflix, Inc. v. Divx, LLC, No. IPR2020-00558, 2021 WL 3729361, at *13 (P.T.A.B. Aug. 23, 2021).

PO argues that *Unified Patents* and *Westech* are distinguishable because the PO there “was making for the first time in its Sur-Reply a **completely independent** argument.” (Opp., 7.) But PO’s theory that Tayloe’s capacitors do not store non-negligible energy based on the “necessary” calculations in Exhibit 2022 is a new, independent argument that clearly takes PO’s arguments in a “new direction”—the test that the Board applied in those cases. Moreover, in *In-Depth Geophysical, Inc. v. Conocophillips Co.*, the Board found waiver even though the PO’s new argument in sur-reply was about a claim limitation that the PO **had addressed** in its POR. No. IPR2019-00850, 2020 WL 5261306, at *9 (P.T.A.B. Sept. 3, 2020).

Third, PO argues that Exhibit 2022 is proper because it responds to Dr. Subramanian’s Reply Declaration. But by the time of its Sur-Reply, PO had waived any argument that Tayloe’s capacitors do not store non-negligible energy by not making that argument in its POR.¹ And even if PO was entitled to rebut Dr. Subramanian’s energy calculations, PO was, at most, permitted to do just that—question Dr. Subramanian about those calculations at his deposition or challenge

¹ Dr. Subramanian addressed the non-negligible energy issue in his Reply Declaration because **PO had first proposed that construction in its POR**.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.