

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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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.

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