

IPR2021-00985
U.S. Patent No. 7,292,835
Patent Owner's Opposition

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TCL Industries Holdings Co., Ltd. and Hisense Co., Ltd.,
Petitioners

v.

ParkerVision, Inc.
Patent Owner

U.S. Patent No. 7,292,835

Issue Date: November 6, 2007

Title: WIRELESS AND WIRED CABLE MODEM APPLICATIONS OF
UNIVERSAL FREQUENCY TRANSLATION TECHNOLOGY

Inter Partes Review No. IPR2021-00985

**PATENT OWNER'S OPPOSITION TO PETITIONERS' MOTION FOR
ROUTINE AND/OR ADDITIONAL DISCOVERY**

Table of Contents

	<u>Page</u>
I. Introduction.....	1
II. Petitioners’ belated and improper efforts to bolster its Petition through discovery should be rejected.....	2
III. Petitioners’ request for ParkerVision’s confidential Final Infringement Contentions is not directed to “routine” discovery.	5
A. ParkerVision’s positions on “storage module” are consistent.	5
B. ParkerVision’s positions on “cable modem” are consistent.	8
IV. Petitioners have not met their burden on additional discovery.	10
A. Petitioners have not shown that the FICs will be useful.	10
B. The information Petitioners request could have been sought by other means.....	12

Pursuant to the Board’s March 9, 2022 email, Patent Owner ParkerVision, Inc. (“ParkerVision”) submits this opposition to the motion for routine and/or additional discovery filed by TCL Industries Holdings Co., Ltd. (“TCL”) and Hisense Co. Ltd. (“Hisense”) (collectively, “Petitioners”).

I. Introduction.

Petitioners seek the production of highly confidential Final Infringement Contentions (“FICs”) that ParkerVision served in the parallel district court litigation. But Petitioners’ Motion is merely an attempt to supplement their evidence/arguments under the guise of routine and/or additional discovery.

For the first time in *this* Motion, Petitioners’ present substantive arguments regarding the Texas District Court’s construction of “storage module” as “storing non-negligible amounts of energy.” *See* Paper 18 (“Motion”), 4-7. But as ParkerVision pointed out in its Patent Owner’s Response, the Petition is altogether silent as to whether a capacitor (the alleged “storage module”) in the cited references “stores non-negligible amounts of energy.” Paper 17 (“POR”), 1. In fact, the phrase “non-negligible amounts of energy” does *not* appear anywhere in the Petition. Although Petitioners were aware of the District Court’s construction at the time of filing their Petition, Petitioners *chose* not to address it. Thus, any discussion that Petitioners make of “non-negligible amounts of energy,” including through the reliance on ParkerVision’s FICs, is improper new argument that goes

beyond the theories presented in the Petition. For at least this reason, the Board should deny Petitioners' Motion.

Petitioners' arguments that the FICs should be considered "routine" and/or "additional" discovery also fail. Contrary to Petitioners' assertions, no inconsistencies exist between ParkerVision's arguments in its POR and those presented in the FICs. Furthermore, Petitioners have not shown that such discovery is necessary in the interest of justice.

Accordingly, the Board should deny Petitioners' request.

II. Petitioners' belated and improper efforts to bolster its Petition through discovery should be rejected.

In January 2021, the Texas District Court construed "storage module" as "a module of an energy transfer system that stores non-negligible amounts of energy from an input electromagnetic signal." Ex.-2011, 5.¹ Petitioners filed their Petition in May 2021 – *four months after* the District Court's order construing "storage module," *two months after* ParkerVision served its Preliminary Infringement Contentions in the District Court, and *nine days after* ParkerVision filed its POR in IPR2020-01265. Thus, when filing the Petition, Petitioners were fully aware of the

¹ The parties agree that the January 2021 District Court Claim Construction Order is relevant to the current IPR because it relates to ParkerVision patents involving similar technology to the '835 patent.

District Court’s construction and ParkerVision’s arguments regarding “storage module.” Indeed, the Petition specifically discusses the District Court’s construction of “storage module.” Pet., 34-35.²

Yet, Petitioners failed to address the “*non-negligible amounts of energy*” language in their Petition (despite being aware of this language in the District Court’s construction at the time they filed their Petition, specifically addressing *other* language in the District Court’s claim construction ruling, and ultimately adopting the language in their own constructions in litigation). In fact, the words “non-negligible,” “energy,” or “non-negligible amounts of energy” do *not* appear in the Petition at all. Instead, the *only* argument/theory Petitioners put forth was simply to identify “storage modules” as capacitors in the cited references. *See* Pet., 60, 63, 74-75. Tellingly, the Petition does not even mention—let alone provide *any* *type* of analysis—as to whether a capacitor (the alleged “storage module”) in the cited references “stores non-negligible amounts of energy.”

² And while Petitioners included the cover page of ParkerVision’s Preliminary Infringement Contentions as evidence that their Petition was filed “expeditiously” (*see* Pet., 87,) Petitioners never discuss their relevance and/or significance in connection with the term “storage module.”

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.