

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS INC.,
Petitioner,

v.

PARKERVISION, INC.,
Patent Owner.

IPR2022-00246
Patent 7,292,835 B2

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

GERSTENBLITH, *Administrative Patent Judge*.

DECISION

Granting Institution of *Inter Partes* Review

35 U.S.C. § 314

Granting Motion for Joinder

35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

A. Background

LG Electronics Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting institution of *inter partes* review of claims 1, 12–15, and 17–20 (“the Challenged Claims”) of U.S. Patent No. 7,292,835 B1 (Ex. 1001, “the ’835 patent”). Concurrently with its Petition, Petitioner filed a Motion for Joinder seeking to join *TCL Industries Holdings Co. v. ParkerVision, Inc.*, IPR2021-00985 (the “TCL IPR”). Paper 3 (“Motion for Joinder” or “Motion”).¹

ParkerVision, Inc. (“Patent Owner”) filed a paper in which it waives its Preliminary Response and does not oppose Petitioner’s Motion for Joinder. Paper 9 (Patent Owner’s Waiver of Its Preliminary Response and Statement of Non-Opposition to Motion for Joinder).

An *inter partes* review may be instituted only if “the information presented in the petition . . . and any [preliminary] response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a) (2018). For the reasons given below, we institute *inter partes* review of the Challenged Claims of the ’835 patent. We also grant Petitioner’s Motion for Joinder and join Petitioner to IPR2021-00985.

B. Related Proceedings

The parties identify the following as related matters: *ParkerVision, Inc. v. TCL Industries Holdings Co.*, No. 6:20-cv-00945 (W.D. Tex.);

¹ Petitioner refers to the petitioner entities in IPR2021-00985, TCL Industries Holdings Company and Hisense Company Limited, as “the TCL Petitioners.” Motion 1.

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ParkerVision, Inc. v. Hisense Co., No. 6:20-cv-00870 (W.D. Tex.);
ParkerVision, Inc. v. LG Electronics Inc., No. 6:21-cv-00520 (W.D. Tex.).
Pet. 13; Paper 8 (Patent Owner's Mandatory Notices), 1. Petitioner also
identifies *ParkerVision, Inc. v. TCL Technology Group Corp.*,
No. 5:20-cv-01030 (C.D. Cal.); *ParkerVision, Inc. v. Buffalo Inc.*,
No. 6:20-cv-01009 (W.D. Tex.); and *ParkerVision, Inc. v. ZyXEL
Communications Corp.*, No. 6:20-cv-01010 (W.D. Tex.),² as related matters.
Pet. 13. Additionally, Petitioner challenges several claims of U.S. Patent
No. 7,110,444 B1, owned by Patent Owner, in IPR2022-00245. *Id.*

C. Real Parties in Interest

Petitioner identifies itself and LG Electronics U.S.A., Inc. as real
parties in interest. Pet. 12. Patent Owner identifies itself as the sole real
party in interest. Paper 8, 1.

² The district court granted a joint motion to dismiss with prejudice and this
case is now closed. *See* Ex. 3001 (Docket Entry 25, Order dated Sept. 27,
2001).

D. The Asserted Grounds of Unpatentability and Declaration Evidence

Petitioner challenges the patentability of claims 1, 12–15, and 17–20 of the '835 patent on the following grounds:

Claim(s) Challenged	35 U.S.C. § ³	Reference(s)/Basis
1, 12, 15, 17	103(a)	Hulkko, ⁴ Gibson ⁵
1, 12, 15, 17	103(a)	Hulkko, Gibson, Goldberg, ⁶ Thacker, ⁷ ITU-T J.83b, ⁸ AAPA ⁹
1, 12–15, 17–20	103(a)	Gibson, Schiltz ¹⁰
1, 12–15, 17–20	103(a)	Gibson, Schiltz, Goldberg, Thacker, ITU-T J.83b, AAPA

Pet. 16.

³ The Leahy-Smith America Invents Act (“AIA”) includes revisions to 35 U.S.C. § 103 that became effective on March 16, 2013. Because the '835 patent has an effective filing date before March 16, 2013, we apply the pre-AIA version of the statutory basis for unpatentability.

⁴ U.S. Patent No. 5,734,683, issued Mar. 31, 1998 (Ex. 1004, “Hulkko”).

⁵ U.S. Patent No. 4,682,117, issued July 21, 1987 (Ex. 1005, “Gibson”).

⁶ L. Goldberg, “MCNS/DOCSIS MAC Clears a Path for the Cable-Modem Invasion,” *Electronic Design*; Dec. 1, 1997; 45, 27; Materials Science & Engineering Collection pg. 69 (Ex. 1007, “Goldberg”).

⁷ U.S. Patent No. 6,011,548, issued Jan. 4, 2000 (Ex. 1008, “Thacker”).

⁸ ITU-T J.83 Recommendation (Apr. 1997) (Ex. 1009, “ITU-T J.83b”). Petitioner includes the letter “b” in its references to this exhibit although the title does not include the letter “b.” *See, e.g.*, Pet. 16, 41. For consistency, we refer to the exhibit in the same manner as Petitioner by including the letter “b.”

⁹ Applicant admitted prior art (“AAPA”) refers to the '835 patent, at column 40, lines 17–35, which states, *inter alia*, that “[t]he cable modem receivers, transmitters, and transceivers of the present invention may be implemented using a variety of well[-]known devices” and lists several

In the Petition, Petitioner first sets forth its grounds as though there are two: (1) Hulkko and Gibson, and (2) Gibson and Schiltz. *Id.* Petitioner, however, explains that “[a]s to both grounds, if the Board finds that the preamble of claim 1 is limiting—and thus requires a ‘cable modem’—then Petitioner submits that the [C]hallenged [C]laims are obvious for the reasons above and further in view of publications (e.g., Goldberg and Thacker) describing the then-existing cable modem standards (ITU-T J.83b and DOCSIS) and/or AAPA.” *Id.* Accordingly, the chart above includes the alternative grounds set forth in the Petition.

Additionally, Petitioner supports its challenge with a Declaration of Dean P. Neikirk, Ph.D.¹¹ Ex. 1099.

II. INSTITUTION OF *INTER PARTES* REVIEW

The Petition is substantively identical to the petition in the TCL IPR. *Compare* Pet. with TCL IPR, Paper 1; *see also* Pet. 1 (stating that “[t]he instant Petition is substantively identical to the petition filed by the TCL

examples. *See* Pet. 41–42. “Statements in a challenged patent’s specification may be used . . . in conjunction with one or more prior art patents or printed publications forming ‘the basis’ of the proceeding under § 311.” USPTO Memorandum, Treatment of Statements of the Applicant in the Challenged Patent in Inter Partes Reviews Under § 311 (Aug. 18, 2020), *available at* https://www.uspto.gov/sites/default/files/documents/signed_aapa_guidance_memo.pdf. For example, a permissible use of admitted prior art in an *inter partes* review is to “supply missing claim limitations that were generally known in the art prior to the invention.” *Id.* at 9.

¹⁰ U.S. Patent No. 5,339,459, issued Aug. 16, 1994 (Ex. 1006, “Schiltz”).

¹¹ Dr. Neikirk’s Declaration relies on two declarations first submitted in the TCL IPR and filed in this proceeding as well—a Declaration of Matthew B. Shoemake, Ph.D. (Ex. 1002) and a Declaration of Brenda Ray (Ex. 1010).

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