UNITED STATES DISTRICT COURT
MIDDLE DISTRICT OF FLORIDA
ORLANDO DIVISION

PARKERVISION, INC.,

Plaintiff,

v. **Case No: 6:14-cv-687-PGB-LHP**

QUALCOMM INCORPORATED and QUALCOMM ATHEROS, INC.,

Defendants.
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SEALED ORDER

This cause is before the Court on Defendants' Motion to Strike and Exclude Opinions Regarding Alleged Infringement and Validity Issues. (Docs. 491, 540 (the "**Motion**")). Plaintiff submitted a Response in Opposition. (Doc. 527). The Court heard Oral Argument on January 24, 2022, and upon due consideration, Defendants' Motion is granted.

I. BACKGROUND

Defendants' Motion consists of four parts in which it seeks the following: (1) to exclude a new "impedance translation" infringement theory, a new Tau_{off}/T theory, and a new theory regarding the alleged reference potential; (2) to strike opinions that have been estopped by *ParkerVision I* and by the Federal Circuit's affirmance of the PTAB; (3) to strike pursuant to *Daubert* unreliable opinions due to the lack of testing and simulation; and (4) to strike '372 Patent infringement

opinions. (Doc. 540). Plaintiff has abandoned the '177 Patent and claim 107 of the '372 Patent, rendering moot the dispute over the allegedly new "impedance translation" infringement theory and the reference potential. (Docs. 670, 677, 14:13–17).

II. DISCUSSION

A. Tau_{off}/T

Defendants move the Court to Strike Plaintiff's Tau_{off}/T theory, because the calculation is an infringement theory disclosed for the first time in Plaintiff's expert rebuttal report and because it lacks a sufficient scientific foundation. (Doc. 540, pp. 3–7).

1. Undisclosed Theories

Defendants argue that Plaintiff cannot rely on theories disclosed for the first time in expert reports. Fed. R. Civ. P. 37(c); *Finjan v. Cisco Sys.*, No 17-72, 2020 WL 2322923, at *3 (N.D. Cal. May 11, 2020) ("It is well settled that expert reports may not introduce theories not set forth in contentions." (internal quotations, brackets, citation omitted)). The prejudicial effect of asserting a new infringement theory after discovery has closed is beyond dispute. *See KlausTech v. Google*, No. 10-5899, 2018 WL 5109383, at *8 (N.D. Cal. Sept. 14, 2018). This is because the purpose of infringement contentions is to place Defendants on notice of Plaintiff's infringement theories. *Auburn Univ. v. Int'l Bus. Machs., Corp.*, 864 F. Supp. 2d 1222, 1227 (M.D. Ala. 2012). Plaintiff contends the Tau_{off}/T theory is not an infringement theory and is offered to rebut the Defendants' validity contentions.

(Doc. 677, 30:17–19, 32:23—33:2, 33:4–7). Therefore, Plaintiff does not seek to excuse the late disclosure of new theories. *Outside the Box Innovations, LLC v. Travel Caddy, Inc.*, No. 1:05-CV-02482, 2008 WL 11337316, at *2 (N.D. Ga. Aug. 26, 2008) (party seeking to amend infringement contentions after discovery of new evidence must be diligent). And it is undisputed that the calculation did not appear in Plaintiff's expert's initial report on its infringement contentions. (Doc. 527, p. 3). As a result, the issue of timeliness concerns whether the Tau_{off}/T theory disclosed in the rebuttal report of Plaintiff's expert serves as an infringement theory or simply as a response to Defendants' prior art references.

Defendants' counsel described the Tau_{off}/T calculation at oral argument as taking Tau-off and dividing it by T, then the relative value is used to decide whether something is a voltage sampler or an energy sampler. (Doc. 677, 15:8–11). Defendants argued that "according to ParkerVision . . . if something is an energy sampler . . . it falls within the claim [and infringes], and if something is a voltage sampler . . . it falls outside the claims." (*Id.* 15:11–16). And so, Plaintiff is using "this Tau-off over T theory to tell us what falls within what we've now defined as their receiver claims or what falls outside what we've defined as the receiver claims." (*Id.* 15:17–20).

Plaintiff agrees that the Tau_{off}/T theory was not disclosed in their expert's infringement report, and it does not intend to offer Tau_{off}/T for infringement. (*Id.* 30:16–19, 31:11–13). Rather, Plaintiff contends the theory is offered to distinguish Defendants' prior art references because Tau_{off}/T will be used to show the prior art

does not "show, teach, or disclose sufficient discharged in the capacitor to the load." (*Id.* 33:5–11). This is important because one of the claim limitations "is whether the capacitor discharges energy to a load, and that has to occur between samples." (*Id.* 32:4–6). Plaintiff claims "Tau measures the rate of discharge of the capacitor. If we compare it to the time between samples, then we know how much energy would be discharged compared to other, you know, types of circuits, and so it's directly responsive to arguments about that limitation." (*Id.* 32:23—33:2). Therefore, Tau_{off}/T is offered to prove that Defendants' prior "art fails because it doesn't discharge from the capacitor to the load." (*Id.* 47:7–9).

Defendants assert that Plaintiff is using Tau_{off}/T as an infringement theory and as a validity theory. (*Id.* 19:17–18). This prompted the Court to ask Plaintiff's counsel if he was willing to stipulate Tau_{off}/T will not be used to prove an accused product or device infringes. (*Id.* 31:9–10). Plaintiff provided this response:

> But, Your Honor, just to be clear, to the extent QUALCOMM's expert testifies to the extent the accused products satisfy this limitation, then [the prior art reference] Sevenhans satisfies this limitation. I think it's fair for ParkerVision to be able to use commonly understood principles of circuit components to show, well, in fact, if you do the math, the prior art behaves different from the accused products, and that would be directly responsive to QUALCOMM's expert's arguments on invalidity in that case.

(*Id.* 31:14–21).

Simply put, Plaintiff reserves the right to use the Tau_{off}/T calculation to show the prior art is a voltage sampler that does not teach the invention, including by first applying the calculation to prove the accused product is an energy sampler, which

happens to also prove infringement. Defendants object to the calculation, first disclosed in a rebuttal expert report, from being used to prove an accused product infringes. (*Id.* 54:17–21). The prejudice to allowing a new infringement theory after the close of discovery and the creation of expert reports is obvious.[1]

To the extent Plaintiff's expert would use Tau_{off}/T to offer an opinion on whether an accused product is an energy sampler or a voltage sampler, and thus infringes a patent-in-suit, the theory should have been disclosed in Plaintiff's infringement contentions and initial expert disclosure. It is of little comfort to Defendants that the infringement theory is cloaked in an argument that also attacks the Defendants' validity contention.[2] As discussed in the following section, the Court finds the Tau_{off}/T theory does not satisfy *Daubert* and should be excluded both on the failure to disclose the theory in a timely manner and due to its lack of reliability.

2. Daubert

Federal Rule of Evidence 702 permits "[a] witness who is qualified as an expert by knowledge, skill, experience, training, or education" to testify in the form of an opinion. Rule 702 imposes an obligation on district courts to act as

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[1] Plaintiff submits that its response to Defendants' Interrogatory Number 7, which asks Plaintiff how it distinguishes prior art, provided notice of the Tau_{off}/T theory. (Doc. 677, 33:4–14). The Court disagrees that the general assertion that "the prior art doesn't . . . teach . . . sufficient discharge in the capacitor to the load" provided notice of the Tau_{off}/T theory or how it would be applied to the accused products.

[2] The Court notes that in his rebuttal report Plaintiff's expert, Dr. Allen, calculated the Tau_{off}/T values for prior art circuits, two of the Plaintiff's products, and one of the accused products. (Doc. 542, ¶ 16).

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