

IPR2021-00985
U.S. Patent No. 7,292,835
Motion to Strike

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TCL Industries Holdings Co., Ltd., Hisense Co., Ltd., and
LG Electronics Inc.,
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 MOTION TO STRIKE ARGUMENTS IMPROPERLY
RAISED IN PETITIONERS' REPLY**

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Cases

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138 S.Ct. 1348 (2018)6

Statutes and Rules

37 C.F.R. § 42.23(b)1, 6

On June 14, 2022, the Board held a telephone conference and granted Patent Owner’s leave to file this motion to strike.

I. Introduction.

Petitioners present a *new* theory for the first time in their *Reply* related to the term “storage module.” In particular, in the Petition, Petitioners merely identified capacitors as “storage modules.” In the Reply, however, Petitioners argue an entirely new direction in terms of what makes a capacitor a storage module—it “stores non-negligible amounts of energy.” Petitioners proceeding in a new direction with a new approach compared to the position Petitioners took in their Petition is prohibited by 37 C.F.R. § 42.23(b) and the Consolidated Trial Practice Guidelines (“Consolidated TPG”).

Moreover, Petitioners’ untimely disclosure prejudices Patent Owner; Patent Owner is deprived of its ability to have its expert address Petitioners’ arguments. Accordingly, Patent Owner respectfully requests the Board to strike the arguments Petitioners improperly raised in their Reply.

II. Arguments improperly raised in petitioners’ reply.

Patent Owner seeks to strike Petitioners’ new arguments regarding capacitors in the prior art references. In particular, Patent Owner seeks to strike the following arguments:

Here, the prior art indisputably discloses a capacitor within a circuit that “successfully down-converts” a signal, and “that is proof” that

the capacitor stores non-negligible energy under ParkerVision's original position. Reply, 3.

Although not limited to a capacitor, the Board's construction regarding the claimed function of the storage element—"stor[ing] non-negligible amounts of energy"—is substantively the same as the construction applied by Petitioners in the Petition. Reply, 7.

Moreover, each device that contains the identified "storage module" capacitor "successfully down-converts" a signal, and "that is proof" that such capacitor stores non-negligible energy." Reply, 17-18.

Thus, the first capacitor 30 in Hulko [sic] serves to store or "hold" non-negligible energy that has been sampled from the input EM signal, and then transfers that energy or "charge on the first capacitor" when the third switch is closed. Reply, 20-21

Therefore, because Hulkko's capacitors successfully demodulate the signal "into a base-frequency signal" (i.e., successfully perform down-conversion), "that is proof that the capacitors store non-negligible energy under ParkerVision's prior litigation position. Reply, 21.

The drain of field effect transistor 76 is coupled to "hold capacitor 70," resulting in sufficient non-negligible energy being transferred from the input EM signal and stored on the capacitor 70 in order to "hold" the sampled signal. Reply, 23.

Moreover, capacitor 70...successfully performs down-conversion.... This constitutes additional "proof" according to the lead inventor on the '835 patent that the capacitor stores non-negligible energy and

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