From:	Jason Charkow
To:	Trials
Cc:	Stephanie Mandir; raymort@autinlaw.com; LG-ParkerVision-PTABService; McKeown, Scott; Pepe, Steven; Chun, David S.; Taylor, Scott; Shapiro, Matthew; Ferrario, Matias; Reed, Kristopher; Ron Daignault; Chandran Iyer; TCL_Hisense_ZyXel835IPR; TCL_Hisense444IPR; Mayle, Ted
Subject:	IPR2021-00985: Leave to file motion to strike new arguments
Date:	Wednesday, June 1, 2022 4:02:12 PM
Attachments:	Outlook-A group of.png

Dear Honorable Board:

Patent Owner respectfully seeks leave to file a Motion to Strike new arguments set forth in Petitioners' Reply filed in IPR2021-00985 (U.S. Patent No. 7,292,835). If leave is granted, Patent Owner respectfully proposes filing the motion within ten (10) business days of the Board's authorization.

Patent Owner submits that there is good cause to file the Motion to Strike, because Petitioners' Reply raises a *new* theory regarding the claimed "storage module" limitation and, in particular, how "stor[ing] non-negligible amounts of energy from an input electromagnetic signal" is supposedly met.

In their Petition, Petitioners did not provide any argument/theory that a capacitor in the cited prior art "stores non-negligible amounts of energy from an input electromagnetic signal." In their Reply, however, Petitioners *for the first time raise a new theory* - asserting that "when a device employs a capacitor in order to 'successfully down-convert' a signal, then 'that is proof' that the capacitor stores non-negligible energy." Reply, 11; see also id. at 17, 21.

The Petition was filed in May 2021 – four months after the District Court construed "storage module" to require "stor[ing] non-negligible amounts of energy from an input electromagnetic signal" and nine days after ParkerVision filed its POR in IPR2020-01265, which addresses the related "storage element" term and the District Court's construction. Thus, when filing the Petition, Petitioners were well aware of the District Court's claim construction (and ParkerVision's position) regarding "storage module." Indeed, *the Petition even cites to the District Court's claim construction Order. See* Pet. at 34-35. As such, Petitioners could have addressed the District Court's construction of "storage module," but chose not to do so. Addressing this new theory in a Sur-Reply and during an oral hearing without the benefit of Patent Owner's expert testimony will prejudice Patent Owner. Accordingly, a Motion to Strike is proper.

Patent Owner contacted Petitioners via email last Friday to determine whether they object to Patent Owner's request for leave to file the motion. Petitioners' responded that they oppose Patent Owner's request.

If it would be helpful to the Board, Petitioners and Patent Owner are generally available for a conference call after 4:30 pm EST on Thursday, June 2, 2022.

Very truly yours,
Jason

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