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Paper 30
Date: July 26, 2022

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.

IPR2021-00985 (Patent 7,292,835 B2)[1]
IPR2021-00990 (Patent 7,110,444 B1)[2]

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

GERSTENBLITH, *Administrative Patent Judge*.

ORDER[3]
Denying Patent Owner's Motion to Strike
37 C.F.R. §§ 42.5(a), 42.23(b)

[1] LG Electronics Inc., who filed a petition in IPR2022-00246, is joined as petitioner in IPR2021-00985.
[2] LG Electronics Inc., who filed a petition in IPR2022-00245, is joined as petitioner in IPR2021-00990.
[3] This Order addresses issues that are substantially identical in each of the above-captioned proceedings. We exercise our discretion to issue one Order to be filed in each proceeding. The parties are not authorized to use this style heading in subsequent papers.

I. INTRODUCTION[4]

On June 1, 2022, Patent Owner, ParkerVision, Inc. ("ParkerVision"), submitted an email request for authorization to file a motion to strike arguments set forth in Petitioners' Reply in each of the above-referenced proceedings.[5] Specifically, ParkerVision's email "submits that there is good cause to file the Motion to Strike, because TCL's 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."[6] After receiving authorization in a conference call with the panel held June 14, 2022, ParkerVision filed Motions to Strike (IPR2021-00985, Paper 26 ("'985 Mot."); IPR2021-00990, Paper 21), arguing that TCL is "proceeding in a new direction with a new approach," which "is prohibited by 37 C.F.R. § 42.23(b) and the Consolidated Trial Practice Guidelines." '985 Mot. 1. Petitioners, TCL Industries Holdings Co., Ltd., Hisense Co., Ltd., and LG Electronics Inc. (collectively, "TCL"),

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[4] As noted above, the issues raised in this Order are the substantially identical in each proceeding. Unless otherwise indicated, citations are to documents in IPR2021-00985 for convenience, with the understanding that the arguments and evidence discussed herein also are of record in IPR2021-00990.

[5] IPR2021-00985 ("'985 IPR"), Ex. 3006 (Email from J. Charkow, dated June 1, 2022); IPR2021-00990 ("'990 IPR"), Ex. 3005 (same).

[6] Independent claim 1 of U.S. Patent No. 7,292,835 B2 recites the term "storage module," whereas independent claim 3 of U.S. Patent No. 7,110,444 B1 recites the term "storage element." The parties use these claim terms interchangeably throughout their Motions and Oppositions. Although in some instances we refer to "storage module" or "storage element," the same discussion and analysis applies equally to both.

filed Oppositions to the Motions to Strike. IPR2021-00985, Paper 29 ("'985 Opp."); IPR2021-00990, Paper 24.

II. ANALYSIS

A. Background

In the context of litigating its patents involving down-conversion technology, ParkerVision has asserted several different claim constructions related to the claim terms "storage element" and "storage module." In particular, before the U.S. District Court for the Western District of Texas, ParkerVision proposed that the claim terms "storage element" and "storage module," should be construed as an element or module "of an energy transfer system that stores non-negligible amounts of energy from an input electromagnetic signal for driving a low impedance load." '985 IPR, Ex. 1011 at 5 (Claim Construction Order, *ParkerVision, Inc. v. Intel Corp.*, No. W-20-CV-00108-ADA (W.D. Tex. Jan. 26, 2021)). The district court did not accept ParkerVision's construction, opting instead to construe the terms as elements or modules "of an energy transfer system that stores non-negligible amounts of energy from an input electromagnetic signal." *Id.*

In the subject Petition, TCL noted that the district court did not include the phrase "for driving a low impedance load" in the construction of "storage element" or "storage module," and encouraged us to avoid doing the same. '985 IPR, Pet. 34–35. TCL, however, did not specifically recite or apply the district court's construction of "storage module" in addressing the application of the prior art. *See, e.g.*, *id.* at 60 ("first storage module" in

Ground 1), 75 ("first storage module" in Ground 2).[7] Rather, in each instance, TCL identified a capacitor in the prior art as teaching the claimed "storage module." *See id.* at 60, 63, 75, 78–79. TCL's approach, in the Petition, is consistent with ParkerVision's assertions in its district court complaint asserted against TCL Industries Holdings Co., Ltd. and other TCL entities, in which ParkerVision stated that TCL's accused chips include "a first storage module (e.g., a module having one or more capacitors)." '985 IPR, Ex. 2002, 32 (Complaint for Patent Infringement, *ParkerVision, Inc. v. TCL Indus. Holdings Co.*, No. 6:20-cv-00945 (W.D. Tex. Oct. 12, 2020) (Doc. 1)).

In IPR2020-01265, which involved related ParkerVision technology, ParkerVision proposed a construction for "storage element" that matched that of the district court. *See, e.g.*, *Intel Corp. v. ParkerVision, Inc.*, IPR2020-01265, Paper 44 at 32 (PTAB Jan. 21, 2022) (citing, *inter alia*, ParkerVision's Response in that case). After a detailed analysis, the Board did not agree with ParkerVision's proposed construction; rather, the Board construed the term "storage element" to mean "an element of a system that stores non-negligible amounts of energy from an input EM signal." *Id.* at 41.

B. Principles of Law

The Consolidated Trial Practice Guide explains that a motion to strike is the preferred mechanism "[i]f a party believes that a brief filed by the opposing party raises new issues, is accompanied by belatedly presented

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[7] The same is true for TCL's analysis of "second storage module" in each ground. *See* '985 IPR, Pet. 63 (Ground 1), 78–79 (Ground 2).

evidence, or otherwise exceeds the proper scope of reply or sur-reply." Patent Trial and Appeal Board Consolidated Trial Practice Guide ("Consolidated Trial Practice Guide") at 80 (Nov. 2019).[8] TCL's Reply may only respond to arguments raised in ParkerVision's Response. *See* 37 C.F.R. §42.23(b). In the Consolidated Trial Practice Guide, the Board expounded upon this principle stating, "Petitioner may not submit new evidence or argument in reply that it could have presented earlier, e.g. to make out a prima facie case of unpatentability." Consolidated Trial Practice Guide at 73 (citing *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1077–78 (Fed. Cir. 2015)). The Consolidated Trial Practice Guide further explains that "'[r]espond,' in the context of 37 C.F.R. § 42.23(b), does not mean proceed in a new direction with a new approach as compared to the positions taken in a prior filing," and "[w]hile replies and sur-replies can help crystalize issues for decision, a reply or sur-reply that raises a new issue or belatedly presents evidence may not be considered." *Id.* at 74.

"In most cases, the Board is capable of identifying new issues or belatedly presented evidence when weighing the evidence at the close of trial, and disregarding any new issues or belatedly presented evidence that exceeds the proper scope of reply or sur-reply." Consolidated Trial Practice Guide at 80. The Board has disregarded inappropriately presented argument and evidence in prior cases. *See Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369–70 (Fed. Cir. 2016) (explaining that the Board did not abuse its discretion in refusing to consider reply brief arguments advocating a "new theory" of unpatentability under

[8] *Available at* https://www.uspto.gov/TrialPracticeGuideConsolidated.

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