

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

PARKERVISION, INC.,
Patent Owner.

IPR2020-01265
Patent 7,110,444 B1

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

GERSTENBLITH, *Administrative Patent Judge*.

JUDGMENT

Final Written Decision

Determining Non-Disclaimed Challenged Claim Unpatentable
Granting Petitioner's Request to Exclude Improper Arguments
Raised in Patent Owner's Sur-reply
Granting Petitioner's Motion to Exclude
Denying Petitioner's Motion to Seal
35 U.S.C. § 318(a)

I. INTRODUCTION

A. *Background*

Intel Corporation (“Petitioner”) filed a Petition (Paper 3, “Pet.”) requesting institution of *inter partes* review of claims 1, 3, and 5 of U.S. Patent No. 7,110,444 B1 (Ex. 1001, “the ’444 patent”). ParkerVision, Inc. (“Patent Owner”) filed an Amended Preliminary Response (Paper 9).¹ Applying the standard set forth in 35 U.S.C. § 314(a), we instituted an *inter partes* review as to all claims and grounds set forth in the Petition. Paper 10 (“Inst. Dec.”).

After institution, Patent Owner filed a Patent Owner Response (Paper 18, “PO Resp.”), Petitioner filed a Reply to Patent Owner’s Response (Paper 21, “Pet. Reply”), and Patent Owner filed a Sur-reply (Paper 26, “PO Sur-reply”). Additionally, Petitioner filed a Motion to Exclude Exhibit 2022 (Paper 34, “Mot. Exc.”), Patent Owner filed an Opposition to Petitioner’s Motion to Exclude (Paper 36, “Opp.”), and Petitioner filed a Reply in Support of its Motion to Exclude (Paper 37, “Mot. Reply”). With our prior

¹ Patent Owner filed a timely Preliminary Response on November 23, 2020 (Paper 8), and, a day later, filed the Amended Preliminary Response. The Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response (Paper 4) was entered August 21, 2020. A preliminary response was thus due by November 23, 2020 (November 21st and 22nd fell on a weekend). Patent Owner should have requested authorization from the Board prior to filing its Amended Preliminary Response. Nonetheless, despite Patent Owner’s failure to request authorization, we exercised our discretion under 37 C.F.R. § 42.5(b) to waive, by one day, the timing requirement under 37 C.F.R. § 42.107(b) because (1) Petitioner has not asserted that the additional day resulted in any prejudice to Petitioner and (2) the Amended Preliminary Response appears to be nearly identical to the timely filed Preliminary Response. Paper 10 (“Inst. Dec.”), 2 n.1.

authorization (Paper 31, “Order”), Petitioner filed an Identification of Improper New Evidence and Arguments in [Patent Owner’s] Sur-Reply (Paper 32, “Petitioner’s Identification”) and Patent Owner filed a Response to Petitioner’s Identification (Paper 35, “Patent Owner’s Response to Identification”). Petitioner also filed an unopposed Motion to Seal Exhibit 1029, which is the deposition transcript of Michael Steer, Ph.D. (Paper 22, “Mot. Seal”).

Additionally, Patent Owner filed a Notice of Statutory Disclaimer (Paper 40, “Patent Owner’s Disclaimer Notice”) to which Patent Owner attached a copy of its disclaimer under 37 C.F.R. § 1.321(a), wherein Patent Owner disclaimed claims 1 and 5 of the ’444 patent (Paper 40, Ex. A). Patent Owner’s disclaimer effectively eliminated claims 1 and 5 from the ’444 patent, leaving the patent as if those claims never existed. *See Sanofi-Aventis U.S., LLC v. Dr. Reddy’s Labs., Inc.*, 933 F.3d 1367, 1373 (Fed. Cir. 2019) (noting that disclaiming claims effectively eliminates those claims from the patent as though the disclaimed claims had never existed (internal quotations and citations omitted)); *see also Asetek Danmark A/S v. CoolIT Sys., Inc.*, IPR2020-00747, Paper 42 at 6 (PTAB Sept. 30, 2021) (determining that a statutory disclaimer removed a disclaimed claim from an *inter partes* review proceeding). Thus, claims 1 and 5 are no longer part of this proceeding.

At Petitioner’s request, we held a pre-hearing conference on October 26, 2021, during which we addressed, *inter alia*, Petitioner’s Motion to Exclude and related briefing, Petitioner’s Identification and Patent Owner’s Response to Identification, and Petitioner’s Motion to Seal. Each is addressed in more detail below. An oral hearing was held on November 1,

2021, and a copy of the transcript was entered in the record. Paper 42 (“Tr.”).

We have jurisdiction pursuant to 35 U.S.C. § 6. This Decision is a Final Written Decision under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73 as to the patentability of claim 3, the sole claim remaining in the trial. Petitioner bears the burden of proving unpatentability of the challenged claim.

Dynamic Drinkware, LLC v. Nat’l Graphics, Inc., 800 F.3d 1375, 1378 (Fed. Cir. 2015). To prevail, Petitioner must prove unpatentability by a preponderance of the evidence. See 35 U.S.C. § 316(e) (2018); 37 C.F.R. § 42.1(d) (2019). Having reviewed the arguments and the supporting evidence, we determine that Petitioner has shown, by a preponderance of the evidence, that claim 3 of the ’444 patent is unpatentable.

B. Related Proceedings

Petitioner and Patent Owner identify the following related matter: *ParkerVision, Inc. v. Intel Corp.*, No. 6:20-cv-108-ADA (W.D. Tex.) (“the related litigation”). Pet. 7; Paper 5 (Patent Owner’s Mandatory Notices), 2. Patent Owner also states that the ’444 patent is asserted in *ParkerVision, Inc. v. TCL Technology Group Corp.*, No. 5:20-cv-01030-GW-SHK (C.D. Cal.). Paper 5, 2. In addition, Petitioner filed a petition challenging several claims of U.S. Patent No. 7,539,474 B2, which is related to the ’444 patent, in IPR2020-01302.

C. Real Parties in Interest

Petitioner identifies Intel Corporation as the real party in interest. Pet. 7. Patent Owner identifies ParkerVision, Inc. as the real party in interest. Paper 5, 2.

D. The Asserted Grounds of Unpatentability and Declaration Evidence

Petitioner asserts the following grounds of unpatentability:

Claim(s) Challenged²	35 U.S.C. §³	Reference(s)/Basis
3	103(a)	Tayloe, ⁴ TI Datasheet ⁵
3	103(a)	Tayloe, Kawada ⁶

Pet. 10. Petitioner supports its challenge with two declarations by Vivek Subramanian, Ph.D., one submitted with the Petition (Ex. 1002 (Declaration of Vivek Subramanian, Ph.D.)) and the other submitted with Petitioner's Reply (Ex. 1030 (Reply Declaration of Vivek Subramanian, Ph.D.)), and a Declaration of Maureen M. Honeycutt (Ex. 1019). Patent Owner supports its arguments with a Declaration of Michael Steer, Ph.D. (Ex. 2021).

² Claim 3 is the sole challenged claim remaining in the case following Patent Owner's disclaimer of claims 1 and 5.

³ The Leahy-Smith America Invents Act ("AIA") included revisions to 35 U.S.C. § 103 that became effective on March 16, 2013. Because the '444 patent has an effective filing date before March 16, 2013, we apply the pre-AIA versions of the statutory bases for unpatentability.

⁴ U.S. Patent No. 6,230,000 B1, issued May 8, 2001 (Ex. 1004, "Tayloe").

⁵ SN74CBT3253 Dual 1-of-4 FET Multiplexer/Demultiplexer (rev. ed. May 1998) (Ex. 1005, "TI Datasheet"). Petitioner refers to this exhibit, in at least one instance, as "SN74CBT3253D." Pet. 9. The exhibit itself, however, does not include the letter "D" in the product number. Ex. 1005. Petitioner explains that "the 'D' in the product number refers simply to a packaging option" (Pet. 38 n.5), which is confirmed by the description on the first page stating "Package Options Include Plastic Small-Outline (D)." Ex. 1005, 1. Neither party asserts that the packaging option results in a difference of any significance to the issues before us.

⁶ U.S. Patent No. 4,985,647, issued January 15, 1991 (Ex. 1008, "Kawada").

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