UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TCL Industries Holdings Co., Ltd. and Hisense Co., Ltd.,
Petitioners

v.

ParkerVision, Inc.
Patent Owner

U.S. Patent No. 7,110,444

Issue Date: September 19, 2006
Title: WIRELESS LOCAL AREA NETWORK (WLAN) USING UNIVERSAL FREQUENCY TRANSLATION TECHNOLOGY INCLUDING MULTI-PHASE EMBODIMENTS AND CIRCUIT IMPLEMENTATIONS

Inter Partes Review No. IPR2021-00990

PATENT OWNER'S OPPOSITION TO PETITIONERS' MOTION FOR ROUTINE AND/OR ADDITIONAL DISCOVERY

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Pursuant to the Board's March 9, 2022 email, Patent Owner ParkerVision, Inc. ("ParkerVision") submits this opposition to the motion for routine and/or additional discovery filed by TCL Industries Holdings Co., Ltd. ("TCL") and Hisense Co. Ltd. ("Hisense") (collectively, "Petitioners").

I. Introduction.

Petitioners seek the production of highly confidential Final Infringement Contentions ("FICs") that ParkerVision served in the parallel district court litigation. But Petitioners' Motion is merely an attempt to supplement their evidence/arguments under the guise of routine and/or additional discovery.

For the first time in *this* Motion, Petitioners' present substantive arguments regarding the Texas District Court's construction of "storage element" as "storing non-negligible amounts of energy." *See* Paper 13 ("Motion"), 3-7. But as ParkerVision pointed out in its Patent Owner's Response, the Petition is altogether silent as to whether a capacitor (the alleged "storage element") in the cited references "stores non-negligible amounts of energy." Paper 12 ("POR"), 3. In fact, the phrase "non-negligible amounts of energy" does *not* appear anywhere in the Petition. Although Petitioners were aware of the Texas District Court's construction at the time of filing their Petition, Petitioners *chose* not to address it. Thus, any discussion that Petitioners make of "non-negligible amounts of energy," including through the reliance on ParkerVision's FICs, is improper new argument

that goes beyond the theories presented in the Petition. For at least this reason, the Board should deny Petitioners' Motion.

Petitioners' arguments that the FICs should be considered "routine" and/or "additional" discovery also fail. Contrary to Petitioners' assertions, no inconsistencies exist between ParkerVision's arguments in its POR and those presented in the FICs. Furthermore, Petitioners have not shown that such discovery is necessary in the interest of justice.

Accordingly, the Board should deny Petitioners' request.

II. Petitioners' belated and improper efforts to bolster its Petition through discovery should be rejected.

In January 2021, the Texas District Court construed "storage element" as "an element of an energy transfer system that stores non-negligible amounts of energy from an input electromagnetic signal." Ex.-2017, 5. Petitioners filed their Petition in May 2021 – *four months after* the District Court's order construing "storage element," *two months after* ParkerVision served its Preliminary Infringement Contentions in the District Court, and *nine days after* ParkerVision filed its POR in IPR2020-01265. Thus, when filing the Petition, Petitioners were fully aware of the Texas District Court's construction and ParkerVision's arguments regarding "storage element." Indeed, the Petition even addresses or

adopts the District Court's constructions of other terms and analyzes the claims in view of those constructions. Pet., 15, 18, 54-55, 63.[1]

Yet, Petitioners failed to address the "*non-negligible amounts of energy"* language in their Petition (despite being aware of this language in the District Court's construction at the time they filed their Petition, specifically addressing *other* language in the District Court's claim construction ruling, and ultimately adopting the language in their own constructions in litigation). In fact, the words "non-negligible," "energy," or "non-negligible amounts of energy" do *not* appear in the Petition at all. Instead, the *only* argument/theory Petitioners put forth was simply to identify "storage elements" as capacitors in the cited references. *See* Pet., 58-59, 75-76., 74-75. Tellingly, the Petition does not even mention—let alone provide *any type* of analysis—as to whether a capacitor (the alleged "storage element") in the cited references "stores non-negligible amounts of energy."

Petitioners now attempt to remedy their deliberate omission by substantively addressing the "non-negligible amounts of energy" language in this Motion.

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[1] And while Petitioners included the cover page of ParkerVision's Preliminary Infringement Contentions as evidence that their Petition was filed "expeditiously" (*see* Pet., 80,) Petitioners never discuss their relevance and/or significance in connection with the term "storage element."

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