Paper No. 17
Filed: April 18, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TCL INDUSTRIES HOLDINGS CO., HISENSE CO., LTD.,
and LG ELECTRONICS INC.,

Petitioners

v.

PARKERVISION, INC.

Patent Owner

Case No. IPR2021-00990[1]
Patent No. 7,110,444

PETITIONERS' REPLY IN SUPPORT OF MOTION FOR ROUTINE AND/OR ADDITIONAL DISCOVERY UNDER 37 C.F.R. § 42.51(b)

[1] LG Electronics Inc. who filed a petition in IPR2022-00245, is joined as petitioner in this proceeding.

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The targeted motion for discovery consisting of the Final Infringement Contentions ("FICs") that ParkerVision indisputably possesses should be granted. ParkerVision fails to provide a basis for the Board to rule otherwise.

I. THE ALLEGED "HIGHLY CONFIDENTIAL" NATURE OF THE DISCOVERY IS NOT A REASON TO DENY THE MOTION

ParkerVision alleges that the FICs are "highly confidential" (Opp. at 1)—even though the FICs purport to depict chips used in *Petitioners'* televisions, not any information of ParkerVision's. But even if true, the Board allows documents to be filed under seal. Thus, the questionable "highly confidential" status of the FICs is no reason to deny the motion. *Bestway (USA), Inc. v. Team Worldwide Corp*., IPR2018-00859, Paper 67 (PTAB April 9, 2019) at 8-9 (compelling production of "confidential expert reports and deposition transcripts").

II. PARKERVISION'S "WAIVER" ARGUMENT IS IRRELEVANT AT THIS STAGE, AND THERE WAS NO WAIVER IN ANY EVENT

ParkerVision argues that Petitioners should be disallowed from addressing the storage module energy "calculations" that are featured in the POR, because Petitioners allegedly "waived" any rebuttal to such calculations. (Opp. at 1-5). This argument lacks merit for two reasons.

First, whether there was a waiver (and there was not) is irrelevant to this *discovery* motion, and any issue of waiver is not ripe. ParkerVision will get the last word in its Sur-Reply, and it may file a motion to exclude evidence if it so

chooses after reviewing Petitioner's Reply. 37 C.F.R. §42.64. It is manifestly premature, as part of deciding a discovery motion, to address a *hypothetical* motion to exclude parts of what Patent Owner speculates will be in Petitioners' Reply. "Generally, the Board waits until after the oral hearing, when it reviews the record in its entirety, to decide the merits of any motion to exclude. … [C]onsideration of the objected-to evidnce is often unnecessary to resolve the patentability of the challenged claims, and the motion to exclude is moot." Consolidated Practice Guide at 79-80.

Second, even if ripe, there was no waiver because ParkerVision debuted its energy "calculations" theory *four months after* the Petition was filed. The Petition was filed on ***May 20, 2021***. Before then, in the underlying litigations—as well as in other litigations spanning back years —ParkerVision had never suggested that a capacitor is not a "storage" element unless its energy is calculated and compared to the "total available" energy, rather than merely compared to *noise*, such that the ratio of energies is above some (undefined) threshold. It was not until ***September 14, 2021*** that ParkerVision first disclosed that theory. *See* IPR2020-01265, Paper 26 at 18-25 and Paper 34; Ex. 2016 (IPR2020-01265, Paper 44) at 71-74 (excluding energy "calculations" theory).

Now that ParkerVision has advanced its previously excluded energy "calculations" theory in this IPR, Petitioners "may submit rebuttal evidence in

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