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Paper 18
Date: May 3, 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.

IPR2021-00990[1]
Patent 7,110,444 B1

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

GERSTENBLITH, *Administrative Patent Judge*.

ORDER
Granting Petitioners' Motion for Routine and/or Additional Discovery
37 C.F.R. §§ 42.51(b)(1)(iii), (b)(2)(i)

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

I. INTRODUCTION

With our prior authorization, Petitioners[2] filed a Motion for Routine and/or Additional Discovery Under 37 C.F.R. § 42.51(b). Paper 13 ("Motion" or "Mot."). Patent Owner filed an Opposition to Petitioners' Motion (Paper 15, "Opposition" or "Opp.") and Petitioners filed a Reply (Paper 17, "Reply"). Petitioners' Motion requests an order requiring Patent Owner, ParkerVision, Inc., to produce discovery comprising its Final Infringement Contentions for U.S. Patent No. 7,110,444 B1 ("the '444 patent") from the underlying litigations between the parties in the U.S. District Court for the Western District of Texas. Mot. 1. Petitioners assert that the Motion should be granted for two independent reasons: (1) the Final Infringement Contentions "are required 'routine' discovery under 37 C.F.R. § 42.51(b)(1)(iii)" because Patent Owner's Response in this proceeding allegedly raises positions "that are inconsistent with positions it took in the Final Infringement Contentions"; and (2) the Final Infringement Contentions should be produced as "'additional' discovery under 37 C.F.R. § 42.51(b)(2)(i) because it is in the interests of justice." *Id.* at 1–2.

For the reasons below, Petitioners' Motion for Routine and/or Additional Discovery is *granted*. Specifically, we grant Petitioners' Motion in so far as it requests additional discovery, but we do not reach the alternative basis presented by Petitioners—for routine discovery.

[2] Petitioner LG Electronics Inc. ("LG") was joined as a petitioner in this proceeding after the Motion addressed herein was filed. Paper 16.

II. DISCUSSION

Pursuant to 37 C.F.R. § 42.51(b)(2)(i), "[t]he parties may agree to additional discovery between themselves. Where the parties fail to agree, a party may move for additional discovery. The moving party must show that such additional discovery is in the interests of justice . . . . The Board may specify conditions for such additional discovery." In determining whether a request for additional discovery should be granted under the "interests of justice" standard, we are guided primarily by the factors set forth in *Garmin International, Inc. v. Cuozzo Speed Technologies LLC*, IPR2021-00001, Paper 26 (PTAB Mar. 5, 2013) (Decision on Motion for Additional Discovery) (designated precedential). *See, e.g.*, Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), at 25–28 (*available at* https://www.uspto.gov/TrialPracticeGuideConsolidated).

1. More Than a Possibility and Mere Allegation

Petitioners contend that there is more than a possibility or mere allegation that the requested discovery will yield useful information because Petitioners' counsel already has the requested discovery in their possession due to their participation in the related litigations, Mot. 1, and, therefore, "this is not a fishing expedition for something that may or may not exist," *id.* at 10. Petitioners assert that the discovery will be useful in this proceeding because Petitioners contend Patent Owner raised positions therein that are inconsistent with positions taken in the Patent Owner Response (Paper 12) in this proceeding. *Id.*

Patent Owner contends that "'[u]seful,' in this context, means 'favorable in substantive value to a contention of the party moving for discovery'; it does not encompass evidence that is merely 'relevant' or

'admissible.'" Opp. 8 (quoting *Garmin*, IPR2012-00001, Paper 26 at 6). Patent Owner asserts that "Petitioners admit that there is nothing of substance they seek to uncover in the [Final Infringement Contentions]; instead, Petitioners seek to use the absence of information as proof of [Patent Owner's] alleged inconsistent positions." *Id.* at 8–9 (citing Mot. 7). Patent Owner contends that Petitioners' argument "relates more to the nature of the [Final Infringement Contentions] at a stage in the litigation (when Petitioners have not produced technical documents) rather than any showing of inconsistencies between the information sought and [Patent Owners'] positions in the [Patent Owner Response]." *Id.* at 9. Patent Owner asserts that, because "there are no inconsistencies" between the arguments raised in the Patent Owner Response and those presented in the Final Infringement Contentions, "Petitioners' request will not uncover any 'useful' information." *Id.*

We find that Petitioners establish that there is more than a possibility or mere allegation that the requested discovery will yield useful information. In particular, Patent Owner's Final Infringement Contentions in the related litigations provide an indication of Patent Owner's understanding and application of the claims of the '444 patent. Additionally, whether or not the positions taken by Patent Owner are inconsistent, it is undisputed that the positions are different. Specifically, Patent Owner does not dispute that the positions are different, arguing instead that the Patent Owner Response presents "*one* of several possible calculations" that could be used to determine energy storage. *See, e.g.*, Opp. 6; *see id.* at 6–8 (acknowledging differences). The acknowledged differences provide a sufficient basis for

our finding that there is more than a possibility or mere allegation that the requested discovery will yield useful information.

2. Litigation Positions and Underlying Basis

Petitioners' requested discovery does not seek any information not already in the possession of Petitioners' counsel and does not seek to obtain information regarding Patent Owner's future litigation positions or the underlying basis thereof. Mot. 11.[3] Thus, we find that this factor favors Petitioners' request.

3. Ability to Generate Equivalent Information by Other Means

Petitioners contend that this factor strongly favors their request because Patent Owner will not make its Final Infringement Contentions available unless the Motion is granted. Mot. 11. Patent Owner asserts that, in prior proceedings, it presented the same claim construction positions taken in the Final Infringement Contentions, and, therefore, Petitioners "cannot reasonably maintain that such evidence did not exist or was previously unavailable at the time Petitioners filed their Petition." Opp. 10.

We find that this factor favors Petitioners' request. In particular, we find that Petitioners cannot generate equivalent information by other means because it is not clear that Patent Owner asserts *precisely the same* positions in prior proceedings. Additionally, even if Patent Owner may have proposed similar positions in other proceedings, it is in the interests of justice that the Final Infringement Contentions be provided to Petitioners in this proceeding so that the precise positions taken therein may be assessed clearly and so that

[3] Patent Owner's Opposition does not address this factor. *See generally* Opp.

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