

IPR2021-00990  
U.S. Patent No. 7,110,444  
Motion to Strike

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TCL Industries Holdings Co., Ltd. Hisense Co., Ltd., and  
LG Electronics Inc.,

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

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*Inter Partes* Review No. IPR2021-00990

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**PATENT OWNER'S MOTION TO STRIKE ARGUMENTS IMPROPERLY  
RAISED IN PETITIONERS' REPLY**

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On June 14, 2022, the Board held a telephone conference and granted Patent Owner’s leave to file this motion to strike.

**I. Introduction.**

Petitioners present a *new* theory for the first time in their *Reply* related to the term “storage element.” In particular, in the Petition, Petitioners merely identified capacitors as “storage elements.” In the Reply, however, Petitioners argue an entirely new direction in terms of what makes a capacitor a storage element—it “stores non-negligible amounts of energy.” Petitioners proceeding in a new direction with a new approach compared to the position Petitioners took in their Petition is prohibited by 37 C.F.R. § 42.23(b) and the Consolidated Trial Practice Guidelines (“Consolidated TPG”).

Moreover, Petitioners’ untimely disclosure prejudices Patent Owner; Patent Owner is deprived of its ability to have its expert address Petitioners’ arguments. Accordingly, Patent Owner respectfully requests the Board to strike the arguments Petitioners improperly raised in their Reply.

**II. Arguments improperly raised in petitioners’ reply.**

Patent Owner seeks to strike Petitioners’ new arguments regarding prior art capacitors. In particular, Patent Owner seeks to strike the following arguments:

*Although not limited to a capacitor, the Board’s construction regarding the claimed function of the storage element—“stor[ing] non-negligible amounts of energy”—is substantively the same as the*

*term is applied by Petitioners in the Petition. E.g., Pet. at 20-21 (describing how charge from the “RF input signal  $f_1$ ” “builds up on capacitor 72” and that the “voltage across the capacitor 72 corresponding to this charge constitutes the average value of the RF input signal  $f_1$  during the first quarter of the period of the signal  $f_1$ ”). Reply, 3-4.*

*And if a device contains a capacitor and that device “successfully down-converts” a signal, then “that is proof” that the capacitor stores non-negligible energy. ParkerVision, 621 F. App’x at 1019 (emphasis added); Section II.A.2, supra. Thus, to show that a capacitor is a storage element, Petitioners need not show that it is part of an “energy transfer system,” nor must they perform any mathematical calculations comparing the energy on the capacitor to the “total available energy.” Reply, 12-13.*

*Given that Tayloe’s capacitors perform down-conversion, “that is proof” under the ’444 lead inventor’s own testimony that the capacitors store non-negligible energy. Reply, 16.*

*Given that Lam’s capacitors perform down-conversion, then, as the Middle District of Florida found, and the Federal Circuit affirmed, based on the testimony of the lead inventor of the ’444 patent, “that is proof” that the capacitors store non-negligible energy. Reply, 19.*

### **III. The Board should strike Petitioners’ newly disclosed theory.**

At the heart of the dispute between the parties in this IPR is the term “storage element.” The term is found in *all* the challenged claims of U.S. Patent No. 7,110,444 (“’444 patent”).

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