

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<sup>1</sup>  
Patent No. 7,110,444

---

**JOINT MOTION TO TERMINATE HISENSE AS PETITIONER**

---

<sup>1</sup> LG Electronics Inc. who filed a petition in IPR2022-00245, is joined as petitioner in this proceeding.

Petitioner Hisense Co., Ltd. (“Hisense”) and Patent Owner ParkerVision, Inc. (“ParkerVision”) (collectively, the “Parties”) have reached a settlement as to all the disputes in this proceeding. Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Hisense and ParkerVision jointly move to terminate the present *inter partes* review proceeding as to Hisense. This motion does not pertain to any other Petitioner.

## **I. STATEMENT OF FACTS**

Hisense and ParkerVision have reached an agreement to resolve these Parties’ disputes at issue in this proceeding. The Patent License and Settlement Agreement settles this proceeding. Pursuant to 37 C.F.R. § 42.74(b), the Parties’ Patent License and Settlement Agreement is in writing, and a true and correct copy is being filed as Exhibit 1025. The Patent License and Settlement Agreement is being filed electronically with access to “Board Only.” A “Joint Request to Treat Exhibit 1025 as Business Confidential Information” is being filed concurrently with this Joint Motion to Terminate to treat the Patent License and Settlement Agreement as business confidential information and to keep it separate from the files of the involved patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

## **II. RELIEF REQUESTED**

Termination of this *inter partes* review as to Hisense is respectfully requested, and the Parties submit that such termination is justified. “There are

strong public policy reasons to favor settlement between the parties to a proceeding.” Consolidated Trial Practice Guide 86 (Nov. 2019).

The Board should terminate this proceeding, as these Parties jointly request, for the following reasons:

First, Hisense and ParkerVision have met the statutory requirement that they file a “joint request” to terminate before the Office “has decided the merits of the proceeding.” 35 U.S.C. § 317(a). Under section 317(a), an *inter partes* review shall be terminated upon such joint request “unless the Office has decided the merits of the proceeding before the request for termination is filed.” There are no other preconditions of 35 U.S.C. § 317(a). At the time of this paper, the Board has not “decided the merits of the proceeding.”

Second, Hisense and ParkerVision have reached a settlement as to all the disputes between these Parties in this proceeding. A true copy of the Patent License and Settlement Agreement is filed concurrently herewith. *See Confidential Exhibit 1025.* Hisense and ParkerVision request that the Patent License and Settlement Agreement be treated as business confidential information and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). No other such agreements, written or oral, exist between or among these Parties relating to this proceeding. The Patent License and Settlement Agreement thus satisfies the requirements of 35 U.S.C. § 317(b).

Third, termination with respect to Hisense as Petitioner would save significant further expenditure of resources by these Parties. Termination as requested would also further the purpose of *inter partes* review proceedings to provide an efficient and less costly alternative forum for patent disputes. Further, denying the motion would discourage future settlements, as patent owners in similar situations would have a strong disincentive to settle if they perceived that a petitioner could continue regardless of a settlement.

### III. CONCLUSION

For the foregoing reasons, Hisense and ParkerVision respectfully request termination of this *inter partes* review as to Hisense.

IPR2021-00990  
Patent 7,110,444

Dated: November 9, 2022

Respectfully submitted,

By: /s/ Jason S. Charkow

Jason S. Charkow

Reg. No. 46,418\*

jcharkow@daignaultiyer.com

Chandran B. Iyer

Reg. No. 48,434

cbiyer@daignaultiyer.com

Stephanie R. Mandir

Reg. No. 72,930

smandir@daignaultiyer.com

DAIGNAULT IYER LLP

8618 Westwood Center Drive

Suite 150

Vienna, VA 22182

\*Not admitted in Virginia

*Attorneys for ParkerVision, Inc.*

By: /s/ Matias Ferrario

Matias Ferrario

Reg. No. 51,082

mferrario@kilpatricktownsend.com

Kilpatrick Townsend & Stockton LLP

1001 West Fourth Street

Winston-Salem, NC 27101-2400

Kristopher L. Reed

Reg. No. 58,694

kreed@kilpatricktownsend.com

Edward J. Mayle

Reg. No. 65,444

tmayle@kilpatricktownsend.com

Kilpatrick Townsend & Stockton LLP

1400 Wewatta St. Suite 600

Denver, CO 80202

*Counsel for Petitioner Hisense Co.,  
Ltd.*

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.