

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS INC.,
Petitioner,

v.

PARKERVISION, INC.,
Patent Owner.

IPR2022-00245
Patent 7,110,444 B1

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

GERSTENBLITH, *Administrative Patent Judge*.

DECISION

Granting Institution of *Inter Partes* Review

35 U.S.C. § 314

Granting Motion for Joinder

35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

A. Background

LG Electronics Inc. (“Petitioner”) filed a Petition (Paper 3, “Pet.”) requesting institution of *inter partes* review of claims 2–4 (“the Challenged Claims”) of U.S. Patent No. 7,110,444 B1 (Ex. 1001, “the ’444 patent”). Concurrently with its Petition, Petitioner filed a Motion for Joinder seeking to join *TCL Industries Holdings Co. v. ParkerVision, Inc.*, IPR2021-00990 (the “TCL IPR”). Paper 4 (“Motion for Joinder” or “Motion”).¹

ParkerVision, Inc. (“Patent Owner”) filed a paper in which it waives its Preliminary Response and does not oppose Petitioner’s Motion for Joinder. Paper 8 (Patent Owner’s Waiver of Its Preliminary Response and Statement of Non-Opposition to Motion for Joinder).

An *inter partes* review may be instituted only if “the information presented in the petition . . . and any [preliminary] response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a) (2018). For the reasons given below, we institute *inter partes* review of the Challenged Claims of the ’444 patent. We also grant Petitioner’s Motion for Joinder and join Petitioner to IPR2021-00990.

B. Related Proceedings

The parties identify the following as related matters: *ParkerVision, Inc. v. Intel Corp.*, 6:20-cv-00108 (W.D. Tex.); *ParkerVision, Inc. v. TCL Industries Holdings Co., Ltd. et al.*, No. 6:20-cv-00945 (W.D. Tex.);

¹ Petitioner refers to the petitioner entities in IPR2021-00990, TCL Industries Holdings Company and Hisense Company Limited, as “the TCL Petitioners.” Motion 1.

IPR2022-00245
Patent 7,110,444 B1

ParkerVision, Inc. v. Hisense Co., Ltd. et al., No. 6:20-cv-00870 (W.D. Tex.); *ParkerVision, Inc. v. LG Electronics Inc.*, No. 6:21-cv-00520 (W.D. Tex.); and *Intel Corp. v. ParkerVision, Inc.*, IPR2020-01265. Pet. 5–6; Paper 7 (Patent Owner’s Mandatory Notices), 1. Petitioner also identifies *ParkerVision, Inc. v. Buffalo Inc.*, No. 6:20-cv-01009 (W.D. Tex.), and *ParkerVision, Inc. v. ZyXEL Communications Corp.*, No. 6:20-cv-01010 (W.D. Tex.),² as related matters. Pet. 5. Additionally, Petitioner challenges several claims of U.S. Patent No. 7,292,835 B2, owned by Patent Owner, in IPR2022-00246. *Id.* at 6.

C. Real Parties in Interest

Petitioner identifies itself and LG Electronics U.S.A., Inc. as real parties in interest. Pet. 5. Patent Owner identifies itself as the sole real party in interest. Paper 7, 1.

² The district court granted a joint motion to dismiss with prejudice and this case is now closed. *See* Ex. 3001 (Docket Entry 25, Order dated Sept. 27, 2001).

D. The Asserted Grounds of Unpatentability and Declaration Evidence

Petitioner challenges the patentability of claims 2–4 of the '444 patent on the following grounds:

Claim(s) Challenged	35 U.S.C. § ³	Reference(s)/Basis
2, 3	103(a)	Tayloe, ⁴ TI Datasheet ⁵
2–4	103(a)	Lam, ⁶ Enz, ⁷ Tayloe

Pet. 7.

Additionally, Petitioner supports its challenge with a Declaration of Dean P. Neikirk, Ph.D.⁸ Ex. 1099.

II. INSTITUTION OF *INTER PARTES* REVIEW

The Petition is substantively identical to the petition in the TCL IPR. *Compare* Pet. with TCL IPR, Paper 1; *see also* Pet. 1 (stating that “[t]he instant Petition is substantively identical to the petition filed by the TCL

³ The Leahy-Smith America Invents Act (“AIA”) includes revisions to 35 U.S.C. § 103 that became effective on March 16, 2013. Because the '444 patent has an effective filing date before March 16, 2013, we apply the pre-AIA version of the statutory basis for unpatentability.

⁴ U.S. Patent No. 6,230,000 B1, issued May 8, 2001 (Ex. 1004, “Tayloe”).

⁵ SN74CBT3253 Dual 1-of-4 FET Multiplexer/Demultiplexer (rev. ed. May 1998) (Ex. 1005, “TI Datasheet”).

⁶ U.S. Patent No. 5,937,013, issued Aug. 10, 1999 (Ex. 1006, “Lam”).

⁷ Circuit Techniques for Reducing the Effects of Op-Amp Imperfections: Autozeroing, Correlated Double Sampling, and Chopper Stabilization, *Proceedings of the IEEE*, Vol. 84, No. 11, Nov. 1996 (Ex. 1007, “Enz”).

⁸ Dr. Neikirk’s Declaration relies on two declarations first submitted in the TCL IPR and filed in this proceeding as well—a Declaration of Matthew B. Shoemake, Ph.D. (Ex. 1002) and a Declaration of Maureen H. Honeycutt (Ex. 1009).

Petitioners, challenging the same claims of the '444 patent on the same grounds and relying on substantively identical expert testimony”). For substantially the same reasons discussed in the Institution Decision in the TCL IPR, which we incorporate expressly herein, Petitioner demonstrates a reasonable likelihood of prevailing with respect to at least one of the Challenged Claims of the '444 patent. TCL IPR, Paper 9 (Institution Decision).

Accordingly, we institute *inter partes* review of claims 2–4 of the '444 patent on the asserted grounds of unpatentability set forth in the Petition. At this stage of the proceeding, we have not made a final determination as to the unpatentability of any challenged claim or any underlying factual or legal issue.

III. MOTION FOR JOINDER

“Any request for joinder must be filed . . . no later than one month after the institution date of any *inter partes* review for which joinder is requested.” 37 C.F.R. § 42.122(b) (2021). The Board instituted an *inter partes* review in the TCL IPR on November 22, 2021. TCL IPR, Paper 9. On December 17, 2021, Petitioner filed its Motion for Joinder requesting to join the TCL IPR. Thus, Petitioner’s Motion for Joinder is timely.

Acting under the designation of the Director, we have discretion to determine whether to join a party to an instituted *inter partes* review.

35 U.S.C. § 315(c); 37 C.F.R. § 42.122(a). We may

join as a party to [an instituted] *inter partes* review any person who properly files a petition under section 311 that . . . after receiving a preliminary response under section 313 or the expiration of the time for filing such a response . . . warrants the institution of an *inter partes* review under section 314.

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