

EXHIBIT 32-13

EXHIBIT 12

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Paper 44
Date: January 21, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

PARKERVISION, INC.,
Patent Owner.

IPR2020-01265
Patent 7,110,444 B1

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

GERSTENBLITH, *Administrative Patent Judge*.

JUDGMENT

Final Written Decision

Determining Non-Disclaimed Challenged Claim Unpatentable
Granting Petitioner's Request to Exclude Improper Arguments
Raised in Patent Owner's Sur-reply
Granting Petitioner's Motion to Exclude
Denying Petitioner's Motion to Seal
35 U.S.C. § 318(a)

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I. INTRODUCTION

A. Background

Intel Corporation (“Petitioner”) filed a Petition (Paper 3, “Pet.”) requesting institution of *inter partes* review of claims 1, 3, and 5 of U.S. Patent No. 7,110,444 B1 (Ex. 1001, “the ’444 patent”). ParkerVision, Inc. (“Patent Owner”) filed an Amended Preliminary Response (Paper 9).¹ Applying the standard set forth in 35 U.S.C. § 314(a), we instituted an *inter partes* review as to all claims and grounds set forth in the Petition. Paper 10 (“Inst. Dec.”).

After institution, Patent Owner filed a Patent Owner Response (Paper 18, “PO Resp.”), Petitioner filed a Reply to Patent Owner’s Response (Paper 21, “Pet. Reply”), and Patent Owner filed a Sur-reply (Paper 26, “PO Sur-reply”). Additionally, Petitioner filed a Motion to Exclude Exhibit 2022 (Paper 34, “Mot. Exc.”), Patent Owner filed an Opposition to Petitioner’s Motion to Exclude (Paper 36, “Opp.”), and Petitioner filed a Reply in Support of its Motion to Exclude (Paper 37, “Mot. Reply”). With our prior

¹ Patent Owner filed a timely Preliminary Response on November 23, 2020 (Paper 8), and, a day later, filed the Amended Preliminary Response. The Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response (Paper 4) was entered August 21, 2020. A preliminary response was thus due by November 23, 2020 (November 21st and 22nd fell on a weekend). Patent Owner should have requested authorization from the Board prior to filing its Amended Preliminary Response. Nonetheless, despite Patent Owner’s failure to request authorization, we exercised our discretion under 37 C.F.R. § 42.5(b) to waive, by one day, the timing requirement under 37 C.F.R. § 42.107(b) because (1) Petitioner has not asserted that the additional day resulted in any prejudice to Petitioner and (2) the Amended Preliminary Response appears to be nearly identical to the timely filed Preliminary Response. Paper 10 (“Inst. Dec.”), 2 n.1.

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authorization (Paper 31, “Order”), Petitioner filed an Identification of Improper New Evidence and Arguments in [Patent Owner’s] Sur-Reply (Paper 32, “Petitioner’s Identification”) and Patent Owner filed a Response to Petitioner’s Identification (Paper 35, “Patent Owner’s Response to Identification”). Petitioner also filed an unopposed Motion to Seal Exhibit 1029, which is the deposition transcript of Michael Steer, Ph.D. (Paper 22, “Mot. Seal”).

Additionally, Patent Owner filed a Notice of Statutory Disclaimer (Paper 40, “Patent Owner’s Disclaimer Notice”) to which Patent Owner attached a copy of its disclaimer under 37 C.F.R. § 1.321(a), wherein Patent Owner disclaimed claims 1 and 5 of the ’444 patent (Paper 40, Ex. A). Patent Owner’s disclaimer effectively eliminated claims 1 and 5 from the ’444 patent, leaving the patent as if those claims never existed. *See Sanofi-Aventis U.S., LLC v. Dr. Reddy’s Labs., Inc.*, 933 F.3d 1367, 1373 (Fed. Cir. 2019) (noting that disclaiming claims effectively eliminates those claims from the patent as though the disclaimed claims had never existed (internal quotations and citations omitted)); *see also Asetek Danmark A/S v. CoolIT Sys., Inc.*, IPR2020-00747, Paper 42 at 6 (PTAB Sept. 30, 2021) (determining that a statutory disclaimer removed a disclaimed claim from an *inter partes* review proceeding). Thus, claims 1 and 5 are no longer part of this proceeding.

At Petitioner’s request, we held a pre-hearing conference on October 26, 2021, during which we addressed, *inter alia*, Petitioner’s Motion to Exclude and related briefing, Petitioner’s Identification and Patent Owner’s Response to Identification, and Petitioner’s Motion to Seal. Each is addressed in more detail below. An oral hearing was held on November 1,

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