

EXHIBIT 32-3

EXHIBIT 2

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Paper 35
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.

IPR2020-01302
Patent 7,539,474 B2

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

GERSTENBLITH, *Administrative Patent Judge*.

JUDGMENT

Final Written Decision

Determining No Non-Disclaimed Challenged Claims Unpatentable

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, 4, 7, and 9–12 of U.S. Patent No. 7,539,474 B2 (Ex. 1001, “the ’474 patent”). ParkerVision, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 8, “Prelim. Resp.”). 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 9 (“Inst. Dec.”).

After institution, Patent Owner filed a Patent Owner Response (Paper 16, “PO Resp.”), Petitioner filed a Reply to Patent Owner’s Response (Paper 23, “Pet. Reply”), and Patent Owner filed a Sur-reply (Paper 28, “PO Sur-reply”). Petitioner also filed a Motion to Seal Exhibit 1040, which is the deposition transcript of Michael Steer, Ph.D. from related proceeding IPR2020-01265 (Paper 22, “Mot. Seal”).

Additionally, Patent Owner filed a Notice of Statutory Disclaimer (Paper 32) to which Patent Owner attached a copy of its disclaimer under 37 C.F.R. § 1.321(a), wherein Patent Owner disclaimed claim 12 of the ’474 patent (Paper 32, Ex. A). Patent Owner’s disclaimer effectively eliminated claim 12 from the ’474 patent, leaving the patent as if that claim 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

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disclaimed claim from an *inter partes* review proceeding). Thus, claim 12 is no longer part of this proceeding.

Initially, we granted the parties' requests for an oral hearing. Paper 29 (Order Granting the Parties' Requests for Oral Hearing). Thereafter, we held a pre-hearing conference on October 29, 2021, to discuss "the parties' apparent agreement regarding claim construction and application of that construction to the issues before us." Paper 33 (Order Cancelling Oral Hearing), 2; *see* Pet. Reply 13 (stating that under the parties' agreed-upon claim construction, Petitioner agrees with Patent Owner that the remaining claims are not unpatentable over the asserted art). We inquired whether the parties maintained their requests for an oral hearing, to which counsel for each party confirmed that an oral hearing was no longer necessary. Paper 33, 2. In light of the parties' representations during the pre-hearing conference and with the agreement of the parties, we cancelled the oral hearing.¹ *Id.*

We have jurisdiction pursuant to 35 U.S.C. § 6. This Decision is a Final Written Decision under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73 as to the patentability of claims remaining in the trial. Petitioner bears the burden

¹ At Patent Owner's request, we held a conference call on November 10, 2021, a transcript of which is in the record. Ex. 2031. Patent Owner sought to clarify its position in light of statements made by Petitioner at the pre-hearing conference. *See id.* at 5:9–15 (discussing the reason Patent Owner requested the conference call). Petitioner expressly disagreed with what it considered to be Patent Owner's attempt to supplement the record during the November 10th conference call. *See id.* at 13:20–14:18 (expressing disagreement). The sole purpose of the pre-hearing conference was to determine if an oral hearing was needed in light of the positions set forth in the briefing. The parties' briefs set forth the arguments upon which this Final Written Decision is based.

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