

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION**

PARKERVISION, INC.,

Plaintiff,

v.

REALTEK SEMICONDUCTOR CORP.,

Defendants.

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NO. 6:22-cv-01162-ADA

JURY TRIAL DEMANDED

ORDER ON DISCOVERY DISPUTES

On June 4, 2024, Defendant Realtek Semiconductor Corporation (“Realtek”) presented to the Court discovery disputes regarding Plaintiff ParkerVision, Inc.’s (“ParkerVision”) discovery responses. The parties’ positions, requested relief, and the Court’s Orders are as follows:

1. **ParkerVision’s failure to provide its factual basis for conception, reduction to practice, and diligence in response to Interrogatory Nos. 6 and 7.**

Realtek’s Position

ParkerVision refuses to provide the factual bases that support its claimed earlier priority dates for the asserted claims. Instead, ParkerVision argues that its identification of a large swath of random documents accompanying its infringement contentions is sufficient. It is not, particularly given the differences in each of the dozens of asserted claims.

Realtek is entitled to know ParkerVision’s factual basis for conception, its factual basis for reduction to practice, and its factual basis for diligence for each of the asserted claims. Only ParkerVision can provide context for these documents, and to the extent there are gaps, Realtek is entitled to know whether ParkerVision intends to argue that any missing

limitations are not material to the claim, or if it intends to fill these gaps with witness testimony, and who those witnesses will be.

ParkerVision litigated these patents before and knows the evidence it will rely on to support these earlier priority dates. But rather than disclose what it knows, ParkerVision is withholding this information and preventing Realtek from addressing it in its invalidity report due on July 9. ParkerVision's refusal to disclose is improper and prejudicial.

Requested Relief: ParkerVision must supplement its response to Interrogatory Nos. 6 and 7 within 7 days to include all factual bases it intends to rely on to establish the priority dates for each claim including separately identifying its factual bases for conception, its factual bases for reduction to practice, and its factual bases for diligence, and any witnesses it intends to rely on.

ParkerVision's Position

There is also no dispute as to issue. ParkerVision agrees to supplement its responses to Interrogatory Nos. 6 and 7 by June 21.

ORDER

The Court, having considered both Realtek's and ParkerVision's positions on the discovery dispute, as well as other papers and evidence submitted in support and opposition, hereby Orders that Realtek's requested relief is **DENIED**.

2. **ParkerVision's failure to produce technical, financial, and marketing documents on its practicing products in response to RFP Nos. 10, 11, 13, 14, and 66.**

Realtek's Position

ParkerVision claimed on its website that its PV5870, PVD4840R02, and PVD4941R products practice the asserted patents, yet ParkerVision has failed to produce documents relating to these products.

These documents are directly related to damages. For example, *Georgia-Pacific* Factor 8 focuses on “[t]he established profitability of the product made under the patent; its commercial success; and its current popularity.” Similarly, *Georgia-Pacific* Factor 10 evaluates “[t]he nature of the patented invention; the character of the commercial embodiment of it as owned and produced by the licensor; and the benefits to those who have used the invention.”

Requested Relief: ParkerVision must produce technical, financial, and marketing documents on PV5870, PVD4840R02, and PVD4941R within 14 days.

ParkerVision’s Position

There is no dispute. ParkerVision will produce additional documents regarding practicing products by June 21.

ORDER

The Court, having considered both Realtek’s and ParkerVision’s positions on the discovery dispute, as well as other papers and evidence submitted in support and opposition, hereby Orders that Realtek’s requested relief is **DENIED**.

3. **ParkerVision’s failure to provide charts showing how the marked products practice the patents in response to Interrogatory No. 8.**

Realtek’s Position

ParkerVision will not confirm whether it will provide charts for the marked products. Rather, ParkerVision argues that if it intends to rely on these products for the purpose of conception, it will produce them.

But ParkerVision is not entitled to sandbag Realtek by deciding later that it will rely on these products. Either these products support conception or not. And regardless, if ParkerVision asserts that they practice, Realtek is entitled to know how ParkerVision asserts they practice for non-infringement, invalidity, and damages purposes. *See LifeNet Health v.*

LifeCell Corp., 2014 WL 4152113, *4-*5 (E.D. Va. 2014) (granting accused infringer's motion to compel patentee to provide claim charts mapping the asserted patents).

Requested Relief: ParkerVision must provide charts showing how PV5870, PVD4840R02, and PVD4841R practiced at least one claim of each patent within 14 days in response to Interrogatory No. 8.

ParkerVision's Position

ParkerVision has already produced the documents (the factual basis) that would support an earlier conception date of the asserted patents and reduction to practice.

ParkerVision will agree to supplement its response to Interrogatory No. 8 by June 21.

But despite ParkerVision's agreement to supplement, Realtek is demanding that ParkerVision provide claim charts showing how PV5870, PVD4840R02, and PVD4841R practice at least one claim of each asserted patent. Preparing a claim chart, however, is not fact discovery of a party. Preparing a claim chart that maps claim elements to facts and evidence is something an expert would do and include in an expert report.

Accordingly, in addition to the documents/factual record it already produced, ParkerVision will agree to provide Realtek with the claim charts it seeks if ParkerVision decides to rely on an earlier conception date and reduction to practice for any of the patents-in-suit.

ORDER

The Court, having considered both Realtek's and ParkerVision's positions on the discovery dispute, as well as other papers and evidence submitted in support and opposition, hereby Orders that Realtek's requested relief is **DENIED**.

- ParkerVision's failure to produce documents related to its Milo product and Realtek's RTL8811AU in response to RFP Nos. 10, 11, 13, 14, and 66, or RFP Nos. 9 and 64.**

Realtek's Position

Either ParkerVision's Milo product incorporating the Realtek Wi-Fi chip RTL8811AU practices the asserted patents and should have been marked, or it does not practice the asserted patents and is a non-infringing alternative. Either way, discovery on this product is relevant.

ParkerVision has not produced any documents related to this product, and its failure prejudices Realtek.

Requested Relief: ParkerVision must produce documents related to its Milo product and Realtek's RTL8811AU within 14 days.

ParkerVision's Position

Realtek's inquiry about ParkerVision's Milo product is newly-raised, but in any event, ParkerVision informed Realtek's counsel that it will investigate whether it has any responsive documents and produce them. ParkerVision will complete its investigation and produce any responsive documents, to the extent they exist, by June 21. There is, therefore, no dispute between the parties.

ORDER

The Court, having considered both Realtek's and ParkerVision's positions on the discovery dispute, as well as other papers and evidence submitted in support and opposition, hereby Orders that Realtek's requested relief is **DENIED**.

5. **ParkerVision's failure to produce documents that it produced in the *Intel*, *Hisense*, *LG*, and *TCL* litigations in response to RFP Nos. 47 and 48.**

Realtek's Position

For the last two months, ParkerVision has promised to confirm whether it produced in this case the documents ParkerVision produced in its prior litigations involving the asserted patents.

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