

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

PARKERVISION, INC.,

Plaintiff,

v.

REALTEK SEMICONDUCTOR CORP.,

Defendant.

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Case No. 6:22-cv-01162-ADA

JURY TRIAL DEMANDED

ORDER ON DISCOVERY DISPUTE

On April 19, 2024, Plaintiff ParkerVision, Inc. (“ParkerVision”) presented to the Court discovery disputes regarding Realtek’s response to ParkerVision’s Interrogatory No. 11. The parties’ positions, requested relief, and the Court’s order is, as follows:

ParkerVision’s Position

Rule 11 requires a party to have a good faith belief for its allegations. A party must also have a good faith belief for allegations in interrogatory responses. In its motion to dismiss and interrogatory response, Realtek alleges that ParkerVision failed to mark. But what is the bases for Realtek’s belief?

For months, ParkerVision has tried to obtain *all* of Realtek’s *factual* bases for its allegations/beliefs. Despite repeated meet-and-confers, Realtek failed to provide this information in its interrogatory response and says it will not do so until it reviews ParkerVision’s production. Because Realtek must have a Rule 11 basis for its *current* allegations/beliefs, Realtek does not need ParkerVision’s production to explain all factual bases. The claims of the patents-in-suit

relate to schematic-level details of RF chips. Thus, in order to allege failure to mark, Realtek must have knowledge of ParkerVision's products.

Realtek should (1) know each product name(s) that it *currently* believes should have been marked, (2) for each asserted patent, know at least one claim that it believes covers each product(s), (3) know the factual basis as to why the claim(s) cover each product, and (4) have investigated ParkerVision's products to determine failure to mark. Realtek's arguments about burden misses the point. ***This is discovery*** and ParkerVision is entitled to know all factual bases for Realtek's assertions/beliefs. Who has the burden regarding marking is beside the point.

In June 2023, Realtek filed a motion to dismiss, alleging that "*ParkerVision did not mark its products*, which precludes ParkerVision from recovering any damages on the three expired asserted patents." Dkt. 54 at 3. In January 2024, ParkerVision served Interrogatory No. 11, seeking Realtek's bases for allegations that ParkerVision failed to mark.

In February 2024 (*over eight months* after its motion to dismiss), Realtek responded to Interrogatory No. 11, referring back to its motion to dismiss filings (which provide no details regarding marking) and stating its investigation was ongoing.

In March 2024, Realtek sent ParkerVision a letter stating that ParkerVision failed to mark ParkerVision's Milo Router and direct conversion transmitters/receivers *including, but not limited to*, the PV5870 and PVD5870R.

On April 11-12, 2024, Realtek supplemented its interrogatory response, incorporating the allegations in its letter and identifying Intel's summary judgment papers on marking, third party documents and ParkerVision product announcements. Realtek did not identify any claim of the patents-in-suit that covers any product, any factual basis for its position that the claims cover the patents, or any evidence that ParkerVision did not mark its products.

If Realtek performed a Rule 11 investigation, Realtek would know that:

- (1) ParkerVision marked its PV5870 products with three of the asserted patents;
- (2) this Court granted summary judgment against Intel regarding failure to mark the PV5870 products, and
- (3) the RF chip that ParkerVision used in Milo is the Realtek RTL8811AU chip (information found in the Intel papers that Realtek cites). Thus, Realtek has conceded that Realtek's chip is covered by the patents-in-suit. And ParkerVision should be entitled to know which claim(s) Realtek infringes.

Requested Relief: Order that: “Within three (3) days of this Order, Realtek shall supplement Interrogatory No. 11 and identify (1) all products by name (or in the case of Milo, the chip) that Realtek currently believes should have been marked, (2) for each product/component, whether Realtek asserts that ParkerVision sold, offered for sale, and/or made the product/component in the US, (3) for each product/component, the asserted patent(s) that Realtek asserts should have been marked, (4) for each product/component, any and all claims of the asserted patents that Realtek asserts covers that product/component, (5) for each claim, the detailed factual bases for Realtek's position as to why the claim covers the product/component, and (6) the factual basis for Realtek's position that ParkerVision failed to mark its products (e.g., the identity of a product package or ParkerVision website that is not marked).”

Realtek's Position

ParkerVision's argument is completely contrary to well-established Federal Circuit precedent concerning a failure to mark defense. As such, ParkerVision's overly burdensome and legally incorrect requests should be denied in their entirety. “The *Arctic Cat* burden of production

is a low bar predicated upon **belief, not proof.**” *Solas Oled Ltd. v. Samsung Electronics Co., Ltd.*, 2022 WL 1912873, at *2 (E.D. Tex. May 30, 2022) (emphasis added).

Consistent with district court and Federal Circuit precedent, Realtek served an Arctic Cat notice letter on ParkerVision, alleging that ParkerVision’s Milo Router and its Direct Conversion Quadrature Modulator/Demodulator (models PV5870 and PVD5870R RF I/Q) were not marked in compliance with 35 U.S.C. § 287. Thus, not only has Realtek met its burden of production (a low bar), but also shifted the burden to ParkerVision to prove either: (1) it does not practice the patents; or (2) it marked its products. *See also Arctic Cat Inc. v. Bombardier Recreational Prods. Inc.*, 876 F. 3d 1350, 1368 (Fed. Cir. 2017) (“Once the alleged infringer meets its burden of production, however, the patentee bears the burden to prove the products identified do not practice the patented invention.”).

Noticeably absent from ParkerVision’s position statement is *any* support for its assertion that Realtek must show in its initial burden of production that: which claim(s) of the asserted patents are covered by the products; the factual basis as to why the claim(s) cover each product.

What is required is for Realtek to identify the products that it believes ParkerVision was required to mark, which Realtek undisputedly did, in its *Arctic Cat* letter and its response to ParkerVision’s interrogatory number 11. Ex. 1. *See Solas*, 2022 WL 1912873 at *2 (holding the burden is on [the accused infringer] to timely identify unmarked products it believes practiced the [asserted patent].”); *Arctic Cat*, 876 F.3d at 1368 (holding the alleged infringer bears the initial burden of production to articulate the **products** it believes are unmarked) (emphasis added).

As ParkerVision admits, Realtek both timely identified the products it believes were not marked (early in fact discovery), as well as the specific products. There is nothing more required

of Realtek and ParkerVision cannot point to another case requiring more. Because Realtek has identified three products it believes ParkerVision did not mark, ParkerVision has ample notice before the close of fact discovery to conduct whatever discovery it needs to show it complied with the marking statute. Moreover, had Realtek waited until much later in fact discovery, ParkerVision would likely argue it was prejudiced by a late disclosure of a marking defense, like the plaintiff did in *Solas*. In fact, the Court in *Solas* held this very thing against Samsung. The Court stated “[i]t is not necessary to wait, as Samsung did here, until deposition testimony ostensibly proves that the unmarked products actually practiced the [asserted patent].” *Id.* at *2. Therefore, not only is waiting until further fact discovery provides additional evidence supporting a failure to mark prejudicial, it is not obligatory – as only a “belief” is required. *Id.*

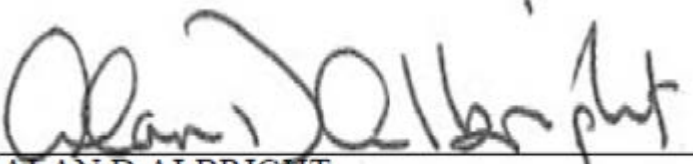
Requested Relief: Order that “ParkerVision’s requested relief is denied.”

ORDER

The Court, having considered both ParkerVision and Realtek’s positions on the discovery dispute, as well as other papers and evidence submitted in support and opposition, hereby **ORDERS**, as follows:

ParkerVision’s requested relief is **DENIED**.

SIGNED on this 2nd day of May, 2024.


ALAN D ALBRIGHT
UNITED STATES DISTRICT JUDGE