

**UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
WACO DIVISION**

PARKERVISION, INC.,

Plaintiff,

v.

REALTEK SEMICONDUCTOR CORP.,

Defendant.

Case No. 6:22-cv-1162-ADA

DISCOVERY ORDER

On April 9, 2024, counsel for Defendant Realtek Semiconductor Corp.’s (“Realtek”) and Plaintiff ParkerVision, Inc. (“ParkerVision”) submitted to the Court a chart summarizing a discovery dispute.

As to the dispute, Realtek requested that ParkerVision produce reverse engineering reports relied upon in its briefing and preliminary and supplemental infringement contentions. ParkerVision requested that the Court deny Realtek’s request.

REALTEK’S POSITION

ParkerVision refuses to produce reverse engineering (“teardown”) reports and related documents that it relied upon to allege infringement of the accused Realtek chips in its Opposition to Realtek’s Motion to Dismiss the Amended Complaint (Dkt. 56 at 13), Preliminary Infringement Contentions (“PICs”), and supplemental PICs.

ParkerVision’s only basis for its refusal is relevance, asserting it will not rely on the teardowns in the future, and instead will rely on Realtek documents and source code in its Final Infringement Contentions. But ParkerVision “cannot avoid disclosure by disavowing any intent

to use the requested information in the future. It already has relied on that information to support its infringement claims by repeatedly citing it throughout the preliminary infringement contentions . . . As such, it is relevant.” *Koninklijke Philips Elecs. N.V. v. ZOLL Med. Corp.*, 2013 WL 812484, *3 (D. Mass. 2013) (quotations and citations omitted).

Although ParkerVision relies *Arigna* to argue that the teardowns should not be produced unless its experts rely on the teardowns, the ultimate outcome of that case proves Realtek’s point. *First*, the Court ultimately granted defendant’s motion to compel Arigna to make available for inspection the Tech Insights reports. *Second*, ParkerVision heavily relies on the teardowns beyond the PICs. On June 8, 2023, Realtek moved to dismiss this action for failure to state a claim (Dkt. 54). In its Opposition to Realtek’s Motion, filed on June 22, 2023 (Dkt. 56 at 13), On June 20, 2023 ParkerVision served its PICs, and these same teardowns were cited and reproduced tens-to-hundreds of times, forming the sole factual basis underlying ParkerVision’s PICs. ParkerVision continued to rely on the same teardowns in its supplemental PICs on July 18, 2023, as the reverse-engineered schematics were again on nearly every page of its 160+ pages of supporting infringement charts, and as recently as March 1, 2024 when it served another supplement. Here, to streamline the case, discovery into the teardowns should be done in fact discovery, not expert discovery (which would inevitably lead to supplements and further delay).

Once discovery formally opened on January 11, 2024, Realtek served two Requests for Production requesting these reports.

Request No. 13 seeks “[a]ll Documents and Things relating to any reverse engineering, inspection, testing, evaluation, teardown, or analysis of any Accused Products, including the source of the schematics identified in ParkerVision’s Reply to Realtek’s Motion to Dismiss (Dkt.

56) at 13,” and *Request No. 14* seeks “[a]ll Documents and Things relating to any reverse engineering, inspection, testing, evaluation, teardown, or analysis of any of Realtek’s products.”

ParkerVision cannot cherry-pick information from its teardown reports. Realtek is entitled to the complete reports, which almost certainly confirm that the accused Realtek chips do not infringe. *See In re Unilin Decor N.V.*, 153 Fed. Appx. 726, 728 (Fed. Cir. Oct. 19, 2005) (finding district court did not abuse discretion in allowing discovery into testing of the alleged infringing product).

PARKERVISION’S POSITION

In effect, Realtek is asking the Court to reverse a ruling Judge Gilliland made earlier in this case—a ruling based on this Court’s decision in *Arigna*. Realtek conveniently neglects to mention in its position statement that Judge Gilliland already heard the issue Realtek now presents. Nevertheless, there is nothing improper about Judge Gilliland’s previous ruling.

On July 19, 2023, Judge Gilliland *considered and ruled on the same very issue Realtek raises now*. *See* July 19, 2023 Transcript of Discovery Hearing (**Sealed**) (Attached).

The dispute this Court referred to Judge Gilliland stemmed from ParkerVision designating its preliminary infringement contentions confidential, because those contentions included confidential information from a third-party engineering firm that ParkerVision retained to perform a schematic extraction of a Realtek chip.

Relevant here, Realtek sought ParkerVision’s pre-suit investigation materials underlying ParkerVision’s preliminary infringement contentions and requested the Court to order ParkerVision to “produce the underlying source documents and to disclose the source of its materials.” 7/19/23 Hrg. Tr. at 4.

After argument, Judge Gilliland ordered: “At this time, one, in keeping with what the Court’s done in the past, the *documents underlying the infringement contentions are not to be produced unless and until those are relied on by experts.*” *Id.* at 12. In doing so, Judge Gilliland considered this Court’s prior ruling in *Arigna Tech. Ltd. v. Samsung Electronics Co. et al.*, Disc. Order, Case No. 6:21-cv-943-ADA (Feb. 23, 2022). In that case, the Court ruled that “Arigna does not need to produce documents underlying its preliminary infringement contentions or disclose the sources of diagrams therein at this time.” *Id.* at 5.

Realtek’s assertion that “the Court ultimately granted defendant’s motion to compel Arigna to make available for inspection the Tech Insights reports”—and the implication that this Court’s changed its mind—is disingenuous. Realtek neglects to mention that Defendant subsequently filed an *unopposed* motion for the reports, which this Court granted. *Arigna Tech. Ltd. v. Apple Inc.*, Case 6:23-cv-00712-ADA, Dkt. 140. Thus, Judge Gilliland’s reliance on the Court’s original order in *Arigna* is still proper.

ParkerVision plans to rely on Realtek’s own documents, source code and schematics, and its expert’s analysis and opinions to establish infringement in this case. Thus, as ParkerVision explained to Realtek’s counsel, unless and until ParkerVision relies on the third-party schematic extractions/reverse engineering report, they are not relevant to any claims or defenses in this case nor will they lead to the discovery of admissible evidence.

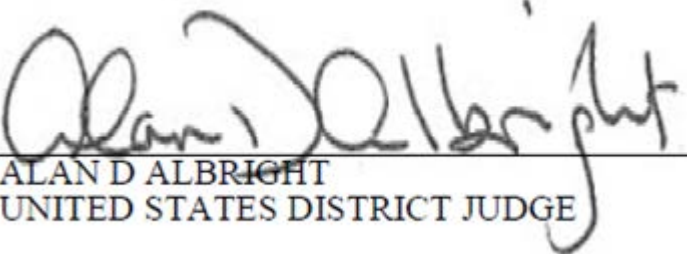
If ParkerVision or its expert decides to rely on the third-party schematic extractions/reverse engineering report, the decision will be made before the close of fact discovery and ParkerVision will produce them during fact discovery. Thus, there will not be any delay as Realtek speculates. But until such time, and as Judge Gilliland ruled previously (based on this Court’s order in *Argina Tech.*), ParkerVision should not be compelled to produce any

underlying documents or other pre-suit investigation materials from its third-party engineering firm that it relied on for its preliminary infringement contentions.

CONCLUSION

The Court, upon consideration of the parties' respective requests, is of the opinion that ParkerVision need not produce documents underlying the infringement contentions unless and until they are relied on by experts. Accordingly, Realtek's request is DENIED.

SIGNED this 2nd day of May, 2024.


ALAN D ALBRIGHT
UNITED STATES DISTRICT JUDGE