

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS INC.,
Petitioner,

v.

PARKERVISION, INC.,
Patent Owner.

IPR2022-00246
Patent 7,292,835 B2

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

GERSTENBLITH, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314
Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

A. *Background*

LG Electronics Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting institution of *inter partes* review of claims 1, 12–15, and 17–20 (“the Challenged Claims”) of U.S. Patent No. 7,292,835 B1 (Ex. 1001, “the ’835 patent”). Concurrently with its Petition, Petitioner filed a Motion for Joinder seeking to join *TCL Industries Holdings Co. v. ParkerVision, Inc.*, IPR2021-00985 (the “TCL IPR”). Paper 3 (“Motion for Joinder” or “Motion”).¹

ParkerVision, Inc. (“Patent Owner”) filed a paper in which it waives its Preliminary Response and does not oppose Petitioner’s Motion for Joinder. Paper 9 (Patent Owner’s Waiver of Its Preliminary Response and Statement of Non-Opposition to Motion for Joinder).

An *inter partes* review may be instituted only if “the information presented in the petition . . . and any [preliminary] response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a) (2018). For the reasons given below, we institute *inter partes* review of the Challenged Claims of the ’835 patent. We also grant Petitioner’s Motion for Joinder and join Petitioner to IPR2021-00985.

B. *Related Proceedings*

The parties identify the following as related matters: *ParkerVision, Inc. v. TCL Industries Holdings Co.*, No. 6:20-cv-00945 (W.D. Tex.);

¹ Petitioner refers to the petitioner entities in IPR2021-00985, TCL Industries Holdings Company and Hisense Company Limited, as “the TCL Petitioners.” Motion 1.

ParkerVision, Inc. v. Hisense Co., No. 6:20-cv-00870 (W.D. Tex.); *ParkerVision, Inc. v. LG Electronics Inc.*, No. 6:21-cv-00520 (W.D. Tex.). Pet. 13; Paper 8 (Patent Owner's Mandatory Notices), 1. Petitioner also identifies *ParkerVision, Inc. v. TCL Technology Group Corp.*, No. 5:20-cv-01030 (C.D. Cal.); *ParkerVision, Inc. v. Buffalo Inc.*, No. 6:20-cv-01009 (W.D. Tex.); and *ParkerVision, Inc. v. ZyXEL Communications Corp.*, No. 6:20-cv-01010 (W.D. Tex.),² as related matters. Pet. 13. Additionally, Petitioner challenges several claims of U.S. Patent No. 7,110,444 B1, owned by Patent Owner, in IPR2022-00245. *Id.*

C. Real Parties in Interest

Petitioner identifies itself and LG Electronics U.S.A., Inc. as real parties in interest. Pet. 12. Patent Owner identifies itself as the sole real party in interest. Paper 8, 1.

² The district court granted a joint motion to dismiss with prejudice and this case is now closed. *See* Ex. 3001 (Docket Entry 25, Order dated Sept. 27, 2001).

D. The Asserted Grounds of Unpatentability and Declaration Evidence

Petitioner challenges the patentability of claims 1, 12–15, and 17–20 of the '835 patent on the following grounds:

Claim(s) Challenged	35 U.S.C. §³	Reference(s)/Basis
1, 12, 15, 17	103(a)	Hulkko, ⁴ Gibson ⁵
1, 12, 15, 17	103(a)	Hulkko, Gibson, Goldberg, ⁶ Thacker, ⁷ ITU-T J.83b, ⁸ AAPA ⁹
1, 12–15, 17–20	103(a)	Gibson, Schiltz ¹⁰
1, 12–15, 17–20	103(a)	Gibson, Schiltz, Goldberg, Thacker, ITU-T J.83b, AAPA

Pet. 16.

³ The Leahy-Smith America Invents Act (“AIA”) includes revisions to 35 U.S.C. § 103 that became effective on March 16, 2013. Because the '835 patent has an effective filing date before March 16, 2013, we apply the pre-AIA version of the statutory basis for unpatentability.

⁴ U.S. Patent No. 5,734,683, issued Mar. 31, 1998 (Ex. 1004, “Hulkko”).

⁵ U.S. Patent No. 4,682,117, issued July 21, 1987 (Ex. 1005, “Gibson”).

⁶ L. Goldberg, “MCNS/DOCSIS MAC Clears a Path for the Cable-Modem Invasion,” *Electronic Design*; Dec. 1, 1997; 45, 27; Materials Science & Engineering Collection pg. 69 (Ex. 1007, “Goldberg”).

⁷ U.S. Patent No. 6,011,548, issued Jan. 4, 2000 (Ex. 1008, “Thacker”).

⁸ ITU-T J.83 Recommendation (Apr. 1997) (Ex. 1009, “ITU-T J.83b”). Petitioner includes the letter “b” in its references to this exhibit although the title does not include the letter “b.” *See, e.g.*, Pet. 16, 41. For consistency, we refer to the exhibit in the same manner as Petitioner by including the letter “b.”

⁹ Applicant admitted prior art (“AAPA”) refers to the '835 patent, at column 40, lines 17–35, which states, *inter alia*, that “[t]he cable modem receivers, transmitters, and transceivers of the present invention may be implemented using a variety of well[-]known devices” and lists several

In the Petition, Petitioner first sets forth its grounds as though there are two: (1) Hulkko and Gibson, and (2) Gibson and Schiltz. *Id.* Petitioner, however, explains that “[a]s to both grounds, if the Board finds that the preamble of claim 1 is limiting—and thus requires a ‘cable modem’—then Petitioner submits that the [C]hallenged [C]laims are obvious for the reasons above and further in view of publications (e.g., Goldberg and Thacker) describing the then-existing cable modem standards (ITU-T J.83b and DOCSIS) and/or AAPA.” *Id.* Accordingly, the chart above includes the alternative grounds set forth in the Petition.

Additionally, Petitioner supports its challenge with a Declaration of Dean P. Neikirk, Ph.D.¹¹ Ex. 1099.

II. INSTITUTION OF *INTER PARTES* REVIEW

The Petition is substantively identical to the petition in the TCL IPR. *Compare* Pet. with TCL IPR, Paper 1; *see also* Pet. 1 (stating that “[t]he instant Petition is substantively identical to the petition filed by the TCL

examples. *See* Pet. 41–42. “Statements in a challenged patent’s specification may be used . . . in conjunction with one or more prior art patents or printed publications forming ‘the basis’ of the proceeding under § 311.” USPTO Memorandum, Treatment of Statements of the Applicant in the Challenged Patent in Inter Partes Reviews Under § 311 (Aug. 18, 2020), *available at* https://www.uspto.gov/sites/default/files/documents/signed_aapa_guidance_memo.pdf. For example, a permissible use of admitted prior art in an *inter partes* review is to “supply missing claim limitations that were generally known in the art prior to the invention.” *Id.* at 9.

¹⁰ U.S. Patent No. 5,339,459, issued Aug. 16, 1994 (Ex. 1006, “Schiltz”).

¹¹ Dr. Neikirk’s Declaration relies on two declarations first submitted in the TCL IPR and filed in this proceeding as well—a Declaration of Matthew B. Shoemake, Ph.D. (Ex. 1002) and a Declaration of Brenda Ray (Ex. 1010).

Petitioners, challenging the same claims of the '835 patent on the same grounds and relying on substantively identical expert testimony"). For substantially the same reasons discussed in the Institution Decision in the TCL IPR, which we incorporate expressly herein, Petitioner demonstrates a reasonable likelihood of prevailing with respect to at least one of the Challenged Claims of the '835 patent. TCL IPR, Paper 14 (Institution Decision).

Accordingly, we institute *inter partes* review of claims 1, 12–15, and 17–20 of the '835 patent on the asserted grounds of unpatentability set forth in the Petition. At this stage of the proceeding, we have not made a final determination as to the unpatentability of any challenged claim or any underlying factual or legal issue.

III. MOTION FOR JOINDER

“Any request for joinder must be filed . . . no later than one month after the institution date of any *inter partes* review for which joinder is requested.” 37 C.F.R. § 42.122(b) (2021). The Board instituted an *inter partes* review in the TCL IPR on November 19, 2021. TCL IPR, Paper 14. On December 17, 2021, Petitioner filed its Motion for Joinder requesting to join the TCL IPR. Thus, Petitioner’s Motion for Joinder is timely.

Acting under the designation of the Director, we have discretion to determine whether to join a party to an instituted *inter partes* review.

35 U.S.C. § 315(c); 37 C.F.R. § 42.122(a). We may

join as a party to [an instituted] *inter partes* review any person who properly files a petition under section 311 that . . . after receiving a preliminary response under section 313 or the expiration of the time for filing such a response . . . warrants the institution of an *inter partes* review under section 314.

35 U.S.C. § 315(c). We have explained that a motion for joinder should: (1) set forth reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact, if any, joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified. *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013).

In its Motion, Petitioner asserts that joinder is appropriate because (1) the Petition “submits identical arguments and the same grounds” as “the existing TCL IPR”; (2) the only differences between the petitions in each proceeding “relate to formalities of a different party filing the petition”; (3) “there are no other changes to the facts, citations, evidence, or invalidity arguments introduced in the TCL Petition”; (4) although Petitioner relies on a different expert witness (Dr. Neikirk), he “reviewed and agreed with the expert declaration supporting” the TCL petition and submitted a declaration that is “substantively identical” to Dr. Shoemake’s declaration submitted in the TCL IPR and “does not include any new or additional opinions”; and (5) Petitioner “will waive its expert declaration and agree to be bound by the declaration(s) and deposition(s) of the TCL Petitioners’ expert.” Motion 4–5.

Additionally, Petitioner represents that “[j]oinder should have no impact on the TCL IPR trial schedule because the . . . Petition presents no new issues or grounds of unpatentability.” Motion 7. Petitioner contends that “[t]here are no new issues for the Board to address, and Patent Owner will not be required to present any additional responses or arguments. Moreover, [Petitioner] will adhere to all deadlines set by the Board’s

Scheduling Order for the TCL IPR.” *Id.* Petitioner represents that, “[a]ssuming the TCL Petitioners[] do not terminate their IPR before their expert is deposited, [Petitioner] agrees to rely entirely on, and be bound by, the expert declaration(s) and deposition(s) in the TCL IPR, and [Petitioner] will waive its own expert declaration.” *Id.* at 8. Thus, Petitioner contends that “joinder of [Petitioner] to the TCL IPR will not affect the Board’s ability to complete its review and final decision within the statutory time limits.” *Id.* at 8.

Regarding briefing and discovery, Petitioner “agrees to a complete and silent ‘understudy’ role and will not raise any issues.” Motion 8. Petitioner sets forth the following conditions to apply to the joined proceeding as long as TCL and Hisense remain active parties:

- (a) All substantive filings will be consolidated, for which the TCL Petitioners will maintain responsibility (*i.e.*, [Petitioner] will rely on the filings of the TCL Petitioners[]), unless a filing solely concerns issues that do not involve the TCL Petitioners (*e.g.*, Mandatory Notices);
- (b) [Petitioner] shall rely on the grounds instituted by the Board in the TCL IPR, and the arguments and discovery introduced by the TCL Petitioners; [Petitioner] shall not be permitted to raise any new grounds not already instituted by the Board in the TCL IPR, or introduce any argument or discovery not already introduced by the TCL Petitioners;
- (c) [Petitioner] shall be bound by any agreement between Patent Owner and the TCL Petitioners concerning discovery and/or depositions; and
- (d) [Petitioner] at deposition shall not request any direct, cross examination or redirect time beyond that permitted for the TCL Petitioners alone under either 37 C.F.R. § 42.53 or any agreement between Patent Owner and the TCL Petitioners. *See Mylan Pharms. Inc. v. Novartis AG*, IPR2015-00268, Paper 17 at 5-6 ([PTAB] Apr. 10, 2015) (finding the same

proposed limitations “are consistent with the ‘understudy’ role that Petitioner agrees to assume, as well as Petitioner’s assertion that its presence would not require introducing any additional arguments, briefing, or discovery.”).

- (e) [Petitioner] agrees to be bound by the expert deposition and declarations of the TCL Petitioners’ expert and [Petitioner] will waive its own expert declaration, unless the TCL Petitioners cease to be active participants in their IPR prior to their expert’s deposition.

Id. at 8–9.

As noted above, Patent Owner indicates that it “does not oppose Petitioner LG Electronics, Inc.’s Motion for Joinder.” Paper 9, 2.

In view of Petitioner’s representations and non-opposition by Patent Owner, Petitioner has persuaded us that joinder is appropriate. We, therefore, *grant* Petitioner’s Motion for Joinder.

IV. CONCLUSION

For the foregoing reasons, Petitioner has demonstrated a reasonable likelihood that it would prevail in showing that at least one claim of the ’835 patent is unpatentable. Additionally, we *grant* Petitioner’s Motion for Joinder and join Petitioner to IPR2021-00985. **In view of the joinder, no further documents shall be filed by the parties in this proceeding.**

V. ORDER

Accordingly, it is:

ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review is instituted as to claims 1, 12–15, and 17–20 of the ’835 patent on each ground set forth in the Petition—(1) Hulkko and Gibson; (2) Hulkko, Gibson, Goldberg, Thacker, ITU-T J.83b, DOCSIS, and/or AAPA;

(3) Gibson and Schiltz; and (4) Gibson, Schiltz, Goldberg, Thacker, ITU-T J.83b, DOCSIS, and/or AAPA;

FURTHER ORDERED that, pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(a), Petitioner's Motion for Joinder (Paper 3) is *granted*, and Petitioner is joined as a petitioner in IPR2021-00985;

FURTHER ORDERED that, in view of the joinder, no further filings shall be made in this proceeding—IPR2022-00246—and **all further filings shall be made only in IPR2021-00985**;

FURTHER ORDERED that the asserted grounds of unpatentability on which the Board instituted *inter partes* review in IPR2021-00985 are unchanged and remain the only instituted grounds;

FURTHER ORDERED that the Scheduling Order in IPR2021-00985, and any modifications thereto, shall govern the schedule of the joined proceeding;

FURTHER ORDERED that in IPR2021-00985, Petitioner will file each paper, except for any paper that does not involve the other party, as a single, consolidated filing with the TCL Petitioners, subject to the page limits set forth in 37 C.F.R. § 42.24, and shall identify such filing as a consolidated filing;

FURTHER ORDERED that for any consolidated filing, if Petitioner wishes to file an additional paper to address points of disagreement with the TCL Petitioners, Petitioner must request authorization from the Board to file a motion for an additional paper or pages;

FURTHER ORDERED that Petitioner shall collectively designate attorneys with the TCL Petitioners to conduct the cross-examination of any witness produced by Patent Owner and the redirect of any witness produced

by the TCL Petitioners and Petitioner, within the timeframes set forth in 37 C.F.R. § 42.53(c) or agreed to by the parties;

FURTHER ORDERED that Petitioner shall collectively designate attorneys with the TCL Petitioners to present at the oral hearing, if requested and scheduled, in a consolidated argument;

FURTHER ORDERED that the case caption in IPR2021-00985 shall be changed to reflect joinder of Petitioner in accordance with the attached example; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2021-00985.

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Example Case Caption for Joined Proceeding

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TCL INDUSTRIES HOLDINGS CO., LTD., HISENSE CO., LTD.,
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Patent Owner.

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¹² LG Electronics Inc., who filed a petition in IPR2022-00246, is joined as petitioner in this proceeding.