

IPR2024-00150
U.S. Patent No. 7,292,835
Patent Owner's Preliminary Response

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDIATEK INC.
Petitioner,

v.

PARKERVISION, INC.
Patent Owner.

U.S. Patent No. 7,292,835
Issue Date: November 6, 2007
Title: WIRELESS AND WIRED CABLE MODEM APPLICATIONS OF
UNIVERSAL FREQUENCY TRANSLATION TECHNOLOGY

Inter Partes Review No. IPR2024-00150

**PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR
INTER PARTES REVIEW OF UNITED STATES PATENT NO. 7,292,835**

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	Complaint, <i>ParkerVision, Inc. v. MediaTek Inc. et al.</i> , Case No. 6:22-cv-01163-ADA (WDTX)
2002	Agreed Scheduling Order, <i>ParkerVision, Inc. v. MediaTek Inc. et al.</i> , Case No. 6:22-cv-01163-ADA (WDTX)
2003	Docket Entry 63, <i>ParkerVision, Inc. v. MediaTek Inc. et al.</i> , Case No. 6:22-cv-01163-ADA (WDTX)
2004	Dani Kass, "Catching Up On Patent Litigation With Judge Albright," LAW360 (Mar. 14, 2023)
2005	<i>Sonrai Memory Ltd. v. Kingston Tech. Co., Inc.</i> , Case No. 6:21-cv-1284-ADA, Order Denying Kingston Tech. Co. and Kingston Tech. Corp.'s Opposed Motion to Stay Pending Resolution of Inter Partes Review, Dkt. 94 (W.D. Tex., Oct. 18, 2022)
2006	Docket Order, <i>Kerr Machine Co. d/b/a Kerr Pumps v. Vulcan Industrial Holdings, LLC</i> , No. 6:20-cv-00200 (W.D. Tex. Aug. 2, 2020)

I. INTRODUCTION

Pursuant to 35 U.S.C. § 313 and 37 C.F.R. § 42.107, ParkerVision Inc. (“ParkerVision”) submits this Preliminary Response (“Response”) and respectfully requests the Board to deny the Petition for *Inter Partes* Review (“Petition”) filed by MediaTek Inc. (“Petitioner”) challenging claims 1-5 of U.S. Patent No. 7,292,835 (“the ’835 patent”).

ParkerVision requests the Board exercise its discretion under 35 U.S.C. § 314(a) to deny institution of the Petition because of the advanced state of parallel litigation pending in the Western District of Texas, No. 6:22-cv-01163-ADA (“the Texas case”). The ’835 patent is one of four patents asserted in a complaint filed ***fifteen months*** ago. (Ex. 2001). In that case, preliminary infringement and invalidity contentions have already been exchanged, a *Markman* hearing was held on January 26, 2024, and trial is set for December 9, 2024 (Exs. 2002, 2003)—approximately ***five months before*** a final written decision would be due if the Board were to institute. Notably, Petitioner raises the same invalidity issues in the district court as contained in its IPR Petition.

Given the current posture and schedule of the underlying Texas case, the factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) weigh in favor of *denying* institution of an IPR. The Judge in the Texas cases, Judge Alan D Albright, will not stay the litigation, even

if the Petition is instituted. The '835 patent is but one of four patents being litigated, and the Court has already set a trial date despite being aware of the filing of Petitioner's IPR petition. The Court and parties have already invested significant resources in litigating the Texas case, and despite what efficiencies Petitioner may urge, the Board's expenditure of resources will hardly make a dent in simplifying the parallel litigation.

Furthermore, MediaTek's obviousness analysis improperly relies on various references not formally identified in any of the grounds of unpatentability, including Thacker, Goldberg, ITU-T J.83, and AAPA. MediaTek's attempt to raise unasserted grounds for invalidity violates the notice requirement of 35 U.S.C. § 312(a)(3). Indeed, if these additional references are necessary to support unpatentability, Petitioner should have identified them in the stated grounds. But MediaTek failed to do so here; accordingly, Grounds I and II should not be instituted.

Based on the Board's precedential decisions discussed below, and for the foregoing reasons, institution of the Petition should be denied.

II. THE BOARD SHOULD EXERCISE ITS DISCRETION AND DENY INSTITUTION UNDER 35 U.S.C. § 314(a) AND 37 C.F.R. § 42.108(b)

ParkerVision sued Petitioner for infringement of the '835 patent in the Western District of Texas more than *fifteen months ago* on November 10, 2022.

(See Ex. 2001). As such, the Texas case is in an advanced stage and a jury trial will occur approximately ***five months before*** this Board issues a final written decision. By the May 2025 deadline for this Board's Final Written decision, Judge Albright will have entered a Claim Construction Order covering terms from the '835 patent, ruled on dispositive motions, and conducted a jury trial. (See Ex. 2002). In fact, as of the filing of this response, the parties have already exchanged preliminary infringement and invalidity contentions, completed claim construction briefing, and had a *Markman* hearing on disputed claim terms.

In the Board's precedential *Fintiv* decision, the Board set forth six factors for determining "whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding." *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020) (precedential). When evaluating these factors, the Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.¹ *Google LLC v. Personalized Media Commc'ns*,

¹ Efficient administration of matters weighs *against* institution in this case. See 35 U.S.C. § 316(b). There is no question that the Board has the discretion to deny institution under 35 U.S.C. § 314(a) and that the facts here fit with denial under the Board's *Fintiv* precedent and related line of decisions.

LLC, IPR2020-00720, Paper 16 at 5 (PTAB Aug. 31, 2020) (citing *Fintiv*, IPR2020-00019, Paper 11 at 5-6). Here, *all* six *Fintiv* factors weigh in favor of *denying* institution. See *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (precedential) (“Institution of an *inter partes* review under these circumstances would not be consistent with ‘an objective of the AIA . . . to provide an effective and efficient alternative to district court litigation.’” (citation omitted)). As such, the Board should exercise its discretion and deny institution here.

A. Factor 1—The District Court Has Not Granted A Stay, And There Is No Evidence That The District Court Will Grant A Stay Even If A Proceeding Is Instituted

Petitioner has not asked for a stay pending *inter partes* review, and there is no evidence that Judge Albright would grant a stay even if an IPR were instituted. To the contrary, Judge Albright has made it clear that he will not stay a case where, as here, the court can resolve the case as quickly as the Board can:

[T]here's no unfairness to either side by not staying a case for the PTAB when I can try the case as quickly as they can resolve it.... And so far, I think that's proven to be true.

(Ex. 2004). Indeed, “Judge Albright almost never stays proceedings to let the PTAB make its decision first.” *Id.* at 2.

The district court has expressly stated that it considers issue simplification “the most important factor” in deciding whether to stay patent litigation²—and here, a stay would not simplify anything. Trial in the district court case against Petitioner is scheduled for December 9, 2024 (Ex. 2002). The Board’s final written decision, on the other hand, would not be expected until **five months after** a jury trial, in late May 2025.

Indeed, Judge Albright’s prior decisions on opposed motions to stay pending IPR indicate that a stay of the Texas case would be denied. In *Multimedia Content Management LLC v. DISH Network LLC*, for example, Judge Albright denied a motion to stay with similar facts to the Texas case. There, (1) the defendant filed IPR petitions ten months after filing of the complaint, (2) the court issued a claim construction ruling before the patent owner filed a Preliminary Response, and (3) a jury trial was set three months before the statutory deadline for the Board to issue a final written decision. *Multimedia Content Mgmt. LLC v. Dish Network Corp.*, No.

² See, e.g., Ex. 2005, *Sonrai Memory Ltd. v. Kingston Tech. Co., Inc.*, No. 6:21-cv-1284-ADA, slip op. at *4-5 (W.D. Tex. Oct. 18, 2022) (denying a stay following IPR institution because issue simplification was the “most important factor” and the Court had already held a *Markman* hearing and “expended significant resources”).

6:18-cv-00207-ADA, 2019 U.S. Dist. LEXIS 198875, at *2 (W.D. Tex. Jan. 10, 2019). In denying defendant's motion to stay, Judge Albright found that a stay would prejudice the plaintiff, ignore the advanced state of the proceedings, and fail to simplify the issues. *Id.* Likewise in *Kerr Machine Co. d/b/a Kerr Pumps v. Vulcan Industrial Holdings, LLC*, 6:20-cv-00200 (W.D. Tex. Aug. 2, 2020), Judge Albright denied a stay noting, "[e]ven if the PTAB institutes, the Court anticipates that the trial date will occur before the PGR's final written decision." (Ex. 2006).

There is no reason to believe that Judge Albright would reach any different result here. Indeed, the uncontroverted facts in the district court litigation demonstrate that a stay will not be granted. In view of this, and again, given Judge Albright's explicit statements on the record, as well as his prior rulings in *e.g.*, *Multimedia* and *Kerr Machine*, it is firmly established that the Court would not grant a stay.

Additionally, even where no stay has been requested, the Board has found factor 1 weighs in favor discretionary denial where (as here), "Petitioner present[ed] no evidence that it has requested a stay [] or that a stay is likely." *Luxshare Precision Industry v. Amphenol Corp.*, IPR2022-00132, Paper 10, at 9 (PTAB May 3, 2022). And such a decision is particularly appropriate where the circumstances show that "a stay ... is unlikely." *Nintendo Co. v. Gamevice, Inc.*, IPR2020-01197, Paper 13, at 11-12 (PTAB Jan. 12, 2021).

For all of these reasons, factor 1 favors discretionary denial.

B. Factor 2—Because The Texas Cases Will Be Tried *Before* The Board's Projected Statutory Deadline For A Final Written Decision, The Board Should Deny Institution

Judge Albright has set trial in the Texas case involving the '835 patent for December 9, 2024. (Ex. 2002). Given that the Board will issue an institution decision by May 26, 2024 (three months after the filing of this Preliminary Response), any final written decision, if instituted, would be entered on or around May 26, 2025. As such, the Texas case will have been tried approximately ***five months before*** the Board's projected statutory deadline for a final written decision.

Factor 2, therefore, favors discretionary denial. *See NetApp, Inc. v. Realtime Data LLC*, IPR2017-01195, Paper 9, at 12-13 (P.T.A.B. Oct. 12, 2017) (denying institution) ("The result would be a significant waste of the Board's resources. There would be no offsetting conservation of the [district court's] judicial resources because any final written decision in this proceeding would not issue until well after the scheduled trial date in the [district court] [l]itigation."); *see also Next Caller, Inc. v. TrustID, Inc.*, IPR2019-00961, Paper 10, at 14-15 (P.T.A.B. Oct. 16, 2019) (denying institution where trial was scheduled to start about three months before expected final written decision); *E-One, Inc. v. Oshkosh Corp.*, IPR2019-00161, Paper 16, at 6 (P.T.A.B. May 15, 2019) (denying institution where trial was scheduled to start one month before expected final written

decision); *Intel Corp. v. VLSI Tech. LLC*, IPR2020-00106, Paper 17, at 8 (P.T.A.B.

May 5, 2020) (denying institution where trial was scheduled to start four to five months before expected final written decision).

C. Factor 3—The Parties And The Court Have Invested Significant Resources In The Texas Cases, Favoring Discretionary Denial

A waiver of service was filed with the district court on December 21, 2022.

MediaTek waited over ten months—until November 15, 2023—to file the Petition.

Because MediaTek did not file the Petition expeditiously, the Court and the parties will have completed litigation by the time the Board issues its final written decision.

Event	Date
Complaint	November 10, 2022
Preliminary infringement contentions served by ParkerVision	June 20, 2023
Preliminary invalidity contentions served by MediaTek	September 18, 2023
MediaTek's preliminary production of technical and financial information	September 18, 2023
Exchange of claim terms for construction	September 26, 2023
Exchange of preliminary claim constructions	October 10, 2023
Exchange of extrinsic evidence	October 17, 2023
Meet and confer to narrow claim construction issues	October 24, 2023
MediaTek filed Opening claim construction brief	October 31, 2023
Petition filed ³	November 15, 2023
ParkerVision filed Responsive claim construction brief	November 21, 2023
MediaTek filed Reply claim construction brief	December 5, 2023
ParkerVision filed Sur-Reply claim construction brief	December 19, 2023
Parties submitted Joint Claim Construction Statement	December 22, 2023

³ The green cells reflect deadlines before the PTAB.

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Fact discovery opened	January 11, 2024
Markman Hearing	January 26, 2024
Deadline for Institution Decision	May 26, 2024
Close of fact discovery	July 2, 2024
Close of expert discovery	September 6, 2024
Dispositive motion deadline	September 24, 2024
Final Pretrial Conference	November 12, 2024
Trial	December 9, 2024
Deadline for Final Written Decision	May 26, 2025

And as this chart makes clear, the parties will be deep in fact discovery before any institution decision issues. Thereafter, the parties will proceed with fact depositions, followed by the exchange of expert reports and expert declarations. Specifically, fact discovery will conclude by July 2, 2024. (*See* Ex. 2002, at 3.) Opening expert reports on validity are due July 9, 2024, and expert discovery will end on September 6, 2024—i.e. eight months before any final written decision here. (*Id.*). Dispositive motions, such as any summary judgment motions regarding the purported invalidity of the '835 patent or Daubert Motions will be filed by September 24, 2024. And trial will occur on December 9, 2024. In sum, the totality of litigation will be completed before this Board issues its final written decision.

MediaTek trivializes the parties' and Court's significant investments of time and resources in the litigation to date by ignoring all the work done and, instead, mischaracterizes the litigation as being in its "preliminary stages." Pet. at 92. But in doing so, Petitioner ignores *Fintiv*, where the Board specifically considered "the level of investment and effort already expended on claim construction and

invalidity contentions in the District Court” in finding factor 3 weighed in favor of discretionary denial. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 14 (PTAB May 13, 2020).

Indeed, the parties have made significant investments in the district court litigation, and that will only continue as the Board considers institution. Notably, the parties have already completed claim construction briefing, served lengthy preliminary infringement/invalidity contentions, and exchanged document production. This Board need look no further than *Fintiv* to see that these types of investments favor discretionary denial. *See Fintiv*, IPR2020-00019, Paper 11 at 10 (“district court claim construction orders may indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial.”); *see also E-One, Inc. v. Oshkosh Corp.*, IPR2019-00161, Paper 16 at 13, 20 (PTAB May 15, 2019) (denying institution where “district court ha[d] already expended substantial resources” by, among other things, “receiv[ing] briefing and hear[ing] oral argument on claim construction, and issu[ing] a claim construction ruling”); *Nine Energy Service Inc. v. MCS Multistage Inc.*, IPR2020-01615, Paper 18 at 10-11 (PTAB Mar. 24 2021) (finding this factor weighed in favor of denying institution despite recognizing “discovery is in the early stages.”).

D. Factor 4—Significant Overlap Between Issues Raised In The Petition And In The Texas Case Supports Denial

The overlap between the issues raised in the instant IPR Petition and in the parallel district court Litigation is substantial. The Petition alleges invalidity of claims asserted in the district court litigation based on common references relied upon in the Texas case.

Grounds I and II of this Petition rely on the Gibson, Schiltz, and Crols references, which Petitioner also cites in the co-pending district court litigation. And as the Board previously noted, “Petitioner’s assertion of additional invalidity contentions in the District Court is not relevant to the question of the degree of overlap for this factor. Further, the fact that Petitioner has not decided whether to pursue the art from this proceeding in its expert discovery or at trial in the District Court is not persuasive.” *Fintiv*, IPR2020-00019, Paper 15, at 14-15. Ultimately, as the Board recognized in *Supercell*, under *Fintiv*, “if the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial” because “concerns of inefficiency and the possibility of conflicting decisions [are] particularly strong.” *Supercell Oy v. Gree, Inc.*, IPR2020-00513, Paper 11 at 13 (PTAB June 24, 2020). That is exactly the case here—there is complete overlap in the references and invalidity grounds in both MediaTek’s Petition and its invalidity arguments in the

Texas case. And with final invalidity contentions not due until after the filing of this Preliminary Response, there is also nothing to stop MediaTek from citing additional prior art in the Texas case.

For the foregoing reasons, factor 4 also supports denial of the Petition.

E. Factor 5—The Petitioner and The Defendant in The Parallel Proceedings Are the Same Party, Supporting Denial

The parties are the same in the Petition and the Texas case. As such, Petitioner must concede that this factor favors denial of institution. *See Fintiv*, IPR2020-00019, Paper 15 at 15 (“Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.”).

F. Factor 6—Other Circumstances That Impact The Board's Exercise Of Discretion Show That Denial Is Appropriate At This Time

There are additional weaknesses with the Petition that favor discretionary denial.⁴ And as explained above, institution of the present proceedings will also

⁴ While this Preliminary Response addresses only the discretionary bases as to why the Board should deny institution, ParkerVision submits that on the merits, Petitioner has not shown that it is likely to prevail as to any of the challenged claims. ParkerVision reserves the right to address, in a Patent Owner Response if

give rise to substantial duplication of efforts. It will not prevent fact discovery, expert discovery, and other disputes that occur in the Texas case, nor obviate dispositive motions, pre-trial motions, or a trial.

For these additional reasons, factor 6 further supports discretionary dismissal.

III. THE PETITION SHOULD BE DENIED BECAUSE PETITIONER FAILS TO ARTICULATE OBVIOUSNESS THEORIES WITH PARTICULARITY

Petitioner relies on numerous “cable modem” references to teach limitations missing in Gibson, Schiltz, and Crols. *See, e.g.*, Pet. at 41, 42, 65, 67 (citing Thacker, Goldberg, ITU-T J.83, and AAPA). Petitioner thus essentially argues obviousness over Gibson and Schiltz or Crols in some combination with one or more of the four “cable modem” references, without specifying which specific combination is asserted with respect to each challenged claim. Such use of prior art without including them in the proposed ground is improper because it makes it impossible to determine the exact basis of Petitioner's challenge. 35 U.S.C. § 312(a)(3) (requiring that a petition identify “*with particularity*, each claim challenged, the grounds on which the challenge to each claim is based, and the

required, issues of claim construction not addressed by Petitioner and the failures of the cited art to teach or render obvious the challenged claims.

evidence that supports the grounds for the challenge to each claim.”) (emphasis added). Petitioner's improper reliance on prior art references does not provide Patent Owner a fair opportunity to address the proposed grounds. This itself is a basis for denying institution.

Indeed, the Board has denied institution where a Petition relied on references not identified in the asserted grounds. For example, in *Edwards Lifesciences Corp. et al. v. Aortic Innovations LLC*, the petitioner asserted one and two-reference obviousness grounds, but cited to an expert declaration that mentioned eight additional references for additional support. *Edwards Lifesciences Corp. et al. v. Aortic Innovations LLC*, No. IPR2023-01325, Paper 12 at 36 (PTAB Feb. 22, 2024). In denying institution, the Board determined that “[t]his format is an improper incorporation-by-reference of argument and evidence that, had Petitioner wanted to pursue some other combination of asserted art beyond [the asserted references], needed to be set forth explicitly in the Petition.” *Id.* The Board explained “it leaves the record unclear and forces Patent Owner, the Board, and the public to guess at what combination(s) are, in fact, being urged.” *Id.*

Like in *Edwards*, the Board should deny institution here because Petitioner has similarly failed to identify its obviousness theory with particularity. *See also Kingbright Elecs. Co. v. Cree Inc.*, No. IPR2015- 00750, Paper 8, at 17-18 (PTAB Aug. 10, 2015) (denying institution of obviousness ground where Petitioner “failed

to identify any specific combination of references” or provide “a specific explanation” of its obviousness theory). In particular, MediaTek’s obviousness analysis throughout each of Grounds I and II cites to various references not formally identified in the stated grounds, including Thacker, Goldberg, ITU-T J.83, and AAPA. MediaTek impermissibly relies on these references as additional support for why one of ordinary skill would have been motivated to modify the modems of Gibson and Schiltz or Crols and use them as cable modems. *See Pet.*, 39. But this is improper. *See also Deere & Co. v. Gramm*, IPR2015-00898, Paper 7 at 20-21 (PTAB Sept. 23, 2015) (relying on a reference not identified in the stated ground is unacceptable for supporting an argument regarding what one of ordinary skill would have been prompted to do).

IV. CONCLUSION

For all of the foregoing reasons, ParkerVision respectfully requests the Board to deny the Petition.

Dated: February 26, 2024

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that this Patent Owner's Preliminary Response complies with the type-volume limitation of 37 C.F.R. § 42.24(b) because it contains 3,351 words, as determined by the word-processing program used to prepare the brief, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a)(1).

Respectfully submitted,

By: /Jason S. Charkow/
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR INTER PARTES REVIEW OF UNITED STATES PATENT NO. 7,292,835**, together with all exhibits filed therewith, was served in its entirety by filing these documents through the PTAB E2E System, as well as by email on the following counsel of record for Petitioner:

PerkinsServiceMediatek-ParkerVisionIPRs@perkinscoie.com

Dated: February 26, 2024

Respectfully Submitted,

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