

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDIATEK INC.,

Petitioner,

v.

PARKERVISION, INC.,

Patent Owner.

Case No. IPR2024-00150

Patent No. 7,292,835

**JOINT MOTION TO TERMINATE PURSUANT TO
35 U.S.C. § 317 AND 37 C.F.R. § 42.74**

EXHIBIT LIST

Ex. 1001	U.S. Patent No. 7,292,835 (“’835 Patent”)
Ex. 1002	Excerpts of ’835 Patent File History
Ex. 1003	Declaration of Lawrence E. Larson, Ph.D. Regarding U.S. Patent No. 7,292,835 (“Larson Decl.”)
Ex. 1004	U.S. Patent No. 4,682,117 (“Gibson”)
Ex. 1005	U.S. Patent No. 5,339,459 (“Schiltz”)
Ex. 1006	J. Crols, <i>A Single-Chip 900 MHz CMOS Receiver Front-End with a High Performance Low-IF Topology</i> , 30 IEEE JOURNAL OF SOLID-STATE CIRCUITS 1483 (Dec. 1995) (“Crols”)
Ex. 1007	L. Goldberg, “MCNS/DOCSIS MAC Clears a Path for the Cable-Modem Invasion,” <i>Electronic Design</i> ; Dec. 1, 1997; 45, 27; Materials Science & Engineering Collection pg. 69 (“Goldberg”)
Ex. 1008	U.S. Patent No. 6,011,548 (“Thacker”)
Ex. 1009	ITU-T J.83 Recommendation (April 1997) (“ITU-T J.83”)
Ex. 1010	Declaration of Brenda Ray
Ex. 1011	Declaration of June Munford
Ex. 1012	Complaint for Patent Infringement, <i>ParkerVision, Inc. v. MediaTek Inc.</i> , No. 6:22-cv-01163 (W.D. Tex. November 10, 2022) (ECF 1).
Ex. 1013	Amended Complaint for Patent Infringement, <i>ParkerVision, Inc. v. MediaTek Inc.</i> , No. 6:22-cv-01163 (W.D. Tex. March 8, 2023) (ECF 16).
Ex. 1014	ParkerVision, Inc.’s Disclosure of Preliminary Infringement Contentions, <i>ParkerVision, Inc. v. MediaTek Inc.</i> , No. 6:22-cv-01163 (W.D. Tex. June 20, 2023).
Ex. 1015	RESERVED

Ex. 1016	Claim Construction Order, <i>ParkerVision, Inc. v. Intel Corp.</i> , No. 6:20-cv-00108 (W.D. Tex. Jan. 26, 2021) (ECF 75).
Ex. 1017	Claim Construction Order, <i>ParkerVision, Inc. v. LG Electronics, Inc.</i> , No. 6:21-cv-00520 (W.D. Tex. June 21, 2022) (ECF 55).
Ex. 1018	Special Master’s Report and Recommendation Regarding Claim Construction, <i>ParkerVision, Inc. v. Hisense Co.</i> , No. 6:20-cv-00870 (W.D. Tex. Aug. 29, 2022) (ECF 72).
Ex. 1019	Agreed Scheduling Order, <i>ParkerVision, Inc. v. MediaTek Inc.</i> , No. 6:22-cv-01163 (W.D. Tex. July 31, 2023) (ECF 44).
Ex. 1020	U.S. District Courts – Federal Court Management Statistics, UNITED STATES COURTS (March 31, 2023), available at https://www.uscourts.gov/sites/default/files/data_tables/fcms_na_disprofile0630.2023.pdf .
Ex. 1021	J. Crols, <i>A 1.5 GHz Highly Linear CMOS Downconversion Mixer</i> , 30 IEEE Journal Of Solid-State Circuits 736 (July 1995).
Ex. 1022	Protective Order
Ex. 1023	U.S. Patent No.6,088,569 (“Bach”)
Ex. 1024	U.S. Patent No. 6,181,716 (“Lide”)
Ex. 1025	<i>Sotera</i> Stipulation Letter dated March 14, 2024
Ex. 1026	Confidential Agreement Regarding Dismissal of ’835 Patent and Termination of IPR

I. STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.5(a), and the Board's authorization via email on August 16, 2024, Petitioner MediaTek Inc. ("Petitioner" or "MediaTek") and Patent Owner, ParkerVision Inc. ("Patent Owner" or "ParkerVision"), jointly move that the Board terminate the above-captioned proceeding as a result of an agreement between Petitioner and Patent Owner with respect to the patent at issue.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), Petitioner and Patent Owner submit concurrently herewith a true and correct copy of the Confidential Agreement Regarding Dismissal of '835 Patent and Termination of IPR ("Confidential Agreement") governing the resolution of the *inter partes* review and underlying litigation with respect to the '835 Patent. (*See* Confidential Ex. 1026). There are no other collateral agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding.

The parties are concurrently filing a joint request that the Confidential Agreement be treated as business confidential information, be kept separate from the file of the involved patents, and be made available only to Federal Government agencies on written request, or to any person on a showing of good cause pursuant to 35 U.S.C. § 42.74(c).

II. ARGUMENT

Good cause exists to terminate this proceeding. “The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” Patent Office Trial Practice Guide (Nov. 2019); *see also* 35 U.S.C. § 317(a) (“An *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed”). Here, the parties respectfully submit that termination is appropriate because they have reached an agreement that resolves all disputes between the parties involving the patent at issue in the above-captioned *inter partes* review and the Board has not issued a final written decision or decided the merits of the proceeding. Moreover, the parties filed a Joint Stipulation for Dismissal in the United States District Court for the Eastern District of Texas on August 15, 2024 in the underlying lawsuit styled *ParkerVision, Inc. v. MediaTek Inc.*, No. 6:22-cv-01163 (W.D. Tex.), and the Court dismissed claims with respect to the ’835 Patent on August 19, 2024.

Accordingly, Petitioner and Patent Owner have complied with the requirements of 35 U.S.C. § 317 and 37 C.F.R. § 42.74, and it is appropriate for the Board to dismiss the above-captioned proceeding.

Dated: August 21, 2024

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CERTIFICATE OF SERVICE

The undersigned certifies that true copies of the JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.74 was served electronically on August 21, 2024 in its entirety on the following counsel of record for Patent Owner:

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