

IPR2024-00796
U.S. Patent No. 7,483,686
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. 7,483,686
Issue Date: January 27, 2009

Title: UNIVERSAL PLATFORM MODULE AND METHODS AND
APPARATUSES RELATING THERETO ENABLED BY UNIVERSAL
FREQUENCY TRANSLATION TECHNOLOGY

Inter Partes Review No. IPR2024-00796

**PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR
INTER PARTES REVIEW OF UNITED STATES PATENT NO. 7,483,686**

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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. 6:23-cv-00375-ADA (WDTX)
2002	Amended Scheduling Order, <i>ParkerVision, Inc. v. MediaTek Inc. et al.</i> , Case No. 6:23-cv-00375-ADA (WDTX)
2003	Dani Kass, "Catching Up On Patent Litigation With Judge Albright," LAW360 (Mar. 14, 2023)
2004	<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)
2005	Agreed Scheduling Order, <i>ParkerVision, Inc. v. MediaTek Inc. et al.</i> , Case No. 6:23-cv-00375-ADA (WDTX)

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” or “MediaTek”) challenging claims 1-20 of U.S. Patent No. 7,483,686 (“the ’686 patent”).

ParkerVision requests the Board to 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. 6:23-cv-00375-ADA (“the Texas case”). The ’686 patent is one of three patents asserted in a complaint filed approximately *fifteen months* ago. (Ex. 2001). In that case, preliminary infringement and invalidity contentions have already been exchanged, a *Markman* hearing was held on June 14, 2024, and trial is set for February 9, 2026 (Exs. 2002, 2005)—just *two months* after 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), which has not been overruled or abrogated by statute or any regulation, weigh in favor of *denying* institution of an IPR. The ’686

patent is but one of three patents being litigated, and the Court has already set a trial date. 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.

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 '686 patent in the Western District of Texas approximately *fifteen months ago* on May 17, 2023. (*See* Ex. 2001). As such, the Texas case is in an advanced stage and a jury trial will occur just *two months* after the Board issues a final written decision. By the November 2025 deadline for this Board's Final Written decision, Judge Albright will have entered a Claim Construction Order covering terms from the '686 patent, and ruled on dispositive motions (*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, are in the midst of discovery, 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, LLC*, IPR2020-00720, Paper 16 at 5 (PTAB Aug. 31, 2020) (citing *Fintiv*, IPR2020-00019, Paper 11 at 5-6). Here, the *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.

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.

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. 2003). 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 February 9, 2026 (Ex. 2002). The Board's final written

² See, e.g., Ex. 2004, *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”).

decision would only be expected *two months* before a jury trial, in late November 2025. As mentioned above, in addition to there being no efficiencies or simplification of issues in the district court that would result from institution, denial of MediaTek's Petition preserves the integrity of the system. In the circumstances here, there should not be two adjudications of validity of the '686 patent. Allowing for two decisions regarding the '686 patent's validity, not to mention two potentially conflicting decisions, actually impugns the integrity of the patent system.

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. 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.*

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*, 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 case will be tried close to 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 '686 patent for February 9, 2026. (Ex. 2002). Given that the Board will issue an institution decision by November 29, 2024 (three months after the filing of this Preliminary Response), any final written decision, if instituted, would be entered on or around

November 29, 2025. As such, the Texas case will be tried just *two months* after the Board's projected statutory deadline for a final written decision.

Because the Board would issue a final written decision in close proximity to the district court trial date, there would be no offsetting conservation of the district court's judicial resources. *See Fintiv*, IPR2020-00019, Paper 15 at 9 ("If the court's trial date is at *or around the same time* as the projected statutory deadline *or even significantly after* the projected statutory deadline, the decision whether to institute *will likely implicate other factors* discussed herein, such as the resources that have been invested in the parallel proceeding.").

Factor 2, therefore, favors discretionary denial, or is at least neutral.

C. Factor 3—The parties and the court have invested significant resources in the Texas case, favoring discretionary denial.

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 all claims asserted in the district court litigation based on common references relied upon in the Texas case.

The grounds of this Petition rely on the Nevo, Avitabile, Young, Estabrook 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 substantial overlap in the references and invalidity grounds in both MediaTek’s Petition and its invalidity arguments 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 proceeding 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.³ And as explained above, institution of the present proceedings will also 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.

³ 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 required, issues of claim construction not addressed by Petitioner and the failures of the cited art to teach or render obvious the challenged claims.

III. CONCLUSION

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

Dated: August 29, 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 2267 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).

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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. 7,4,83,686**, 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:

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