

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TEXAS INSTRUMENTS INCORPORATED,
Petitioner,

v.

PARKERVISION, INC.,
Patent Owner.

IPR2024-00934
Patent 7,496,342 B2

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

ZECHER, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5(a)

I. INTRODUCTION

A conference call in this proceeding was held on September 24, 2024, among counsel for the parties and Judges Zecher, Gerstenblith, and Ahmed. Counsel for Petitioner, Texas Instruments Incorporated (“TI”), requested the conference call to seek authorization to file a preliminary reply to Patent Owner’s Preliminary Response. *See* Ex. 3001. More specifically, TI requested an eight (8) page preliminary reply to address arguments presented by Patent Owner, ParkerVision, Inc. (“ParkerVision”), in its Preliminary Response regarding the following three issues: (1) ParkerVision’s application of the doctrine of inherency when arguing against TI’s circuit simulations of the circuit diagrams taught by prior art references DeMaw and Macnally; (2) ParkerVision’s characterization of DeMaw and Macnally each teaching a sinusoidal local oscillator; and (3) ParkerVision’s characterization of evidence in the Petition which supports the presentation of a single histogram to illustrate the discharge rates of two capacitors. *See id.* ParkerVision opposed TI’s request. *Id.* Neither party arranged for a court reporter.

II. DISCUSSION

During the conference call, TI contended that there is “good cause” to grant its request for authorization to file a preliminary reply because ParkerVision misapplied the doctrine of inherency in its Preliminary Response. TI also argued that its Petition and its declarant, Dr. Ian Galton, rely on circuit simulations of the circuit diagrams taught by DeMaw and Macnally to show the discharging ranges required by dependent claims 19–21, and a person of ordinary skill in the art would have understood that DeMaw and Macnally each teach those ranges based on the circuit

simulations. TI also contended that there is “good cause” to grant its request because it could not have anticipated that ParkerVision would mischaracterize the circuit diagrams of DeMaw and Macnally, let alone the circuit simulations performed by Dr. Galton. TI requested an opportunity to file a preliminary reply to address ParkerVision’s purported mischaracterizations.

In response, ParkerVision contended that TI did not show that there is “good cause” for authorization to file a preliminary reply because doing so would allow TI to make arguments it did not present in the first instance in the Petition. For example, ParkerVision argued that TI relies on the doctrine of inherency instead of the express disclosures of DeMaw and Macnally, but TI’s reliance on inherency fails to bridge the evidentiary gaps in DeMaw and Macnally. ParkerVision further contended that TI’s allegations that it mischaracterized the facts or law is not enough to satisfy the “good cause” standard for preliminary briefing because the Board is more than capable of assessing the arguments and evidence presented at this juncture in this proceeding and rendering an institution decision.

As we explained during the conference call, we determined that TI has not satisfied the “good cause” standard for filing a preliminary reply. *See* 37 C.F.R. § 42.108(c) (“A petitioner may seek leave to file a reply to the preliminary response Any such request must make a showing of good cause.”). Beginning with ParkerVision’s positions on the doctrine of inherency, we are not persuaded that the arguments and evidence presented in TI’s Petition implicate inherency. Turning to the purported mischaracterizations in ParkerVision’s Preliminary Response, we agree with ParkerVision’s arguments because “[i]t may always be the case that a

[p]etitioner is unhappy with how [a] [p]atent [o]wner characterizes the facts and law presented in the Petition,” but this is not enough to establish “good cause” for filing a preliminary reply. *Xactware Sols., Inc. v. Pictometry Int’l Corp.*, IPR2016-00593, Paper 11 at 3 (PTAB July 1, 2016) (Order—Denying Authorization to File a Reply to Patent Owner Preliminary Response). We also agree with ParkerVision that we are fully capable of reviewing the preliminary record and evaluating the parties’ arguments and evidence prior to rendering an institution decision because “identifying and evaluating statements or misstatements of the facts and law are well within [our] purview.” *Id.* at 3. In light of the foregoing, we deny TI’s request for authorization to file a preliminary reply.

III. ORDER

Accordingly, it is hereby ORDERED that TI’s request for authorization to file a preliminary reply is *denied*.

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