

From: [Jason Charkow](#)
To: [Rishi Gupta](#); [Trials](#)
Cc: [PV](#); [IPR12189-0090IP1](#)
Subject: Re: IPR2024-00934 Request to Submit Reply to POPR
Date: Wednesday, September 18, 2024 12:48:33 PM
Attachments: [Outlook-A group of.png](#)

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Dear Honorable Board,

Patent Owner respectfully requests that the Board deny Petitioner's request to file a pre-institution reply to Patent Owner's Preliminary Response (POPR) in IPR2024-00934.

Petitioner's request is nothing more than a backdoor attempt to remedy deficiencies in its Petition and introduce new arguments. Under 37 C.F.R. § 42.108(c), a petitioner must demonstrate good cause to justify filing a reply to a preliminary response. "Good cause may exist in certain situations such as where new evidence comes to light after the filing of a petition or a legal argument of first impression is made by the Patent Owner." *Xactware Sols., Inc. v. Pictometry Int'l Corp.*, IPR2016-00593, Paper 11, 3 (PTAB Jul. 1, 2016). Petitioner, however, has not demonstrated such good cause here. Therefore, ParkerVision respectfully requests the Board to deny Petitioner's request.

Petitioner's request centers on three issues: ParkerVision's alleged (1) misapplication of the law of inherency; (2) mischaracterization of the prior art; and (3) mischaracterization of evidence presented in the Petition. None of these issues meets the standard for good cause. As noted in *Xactware*, "[i]t may always be the case that a Petitioner is unhappy with how Patent Owner characterizes the facts and law presented in the Petition." *Id.* Mere disagreement with the characterization of facts and law is not sufficient to justify a Petitioner Reply.

First, Petitioner alleges that ParkerVision misapplied the law of inherency. Not so. Petitioner is raising alleged deficiencies in ParkerVision's POPR to address inherency for the first time, even including new substantive arguments in its email to the Board. Although Petitioner relied on inherency and performed circuit simulations, Petitioner failed to even acknowledge, much less meet, the strict standard required to prove inherency in its Petition. ParkerVision's POPR pointed out this deficiency and challenged the sufficiency of Petitioner's evidence. Petitioner's attempt to introduce new substantive arguments on inherency at this stage constitutes an improper introduction of new matter, which PTAB rules do not permit.

Second and third, Petitioner claims ParkerVision mischaracterizes the prior art and evidence. But the Board is fully capable of reviewing the record and evaluating the evidence on its own in view of both parties' submissions. Indeed, "[i]dentifying and evaluating statements or misstatements of the facts and law are well within the purview of the Panel of Judges assigned to these proceedings." *Id.* And if Petitioner believes the Board overlooked or misapprehended any arguments or evidence, Petitioner has the option to file a Request for Rehearing pursuant to 37 C.F.R. § 42.71(d).

Because Petitioner has not demonstrated good cause, the Board should deny Petitioner's request to file a Reply.

Respectfully submitted,
Jason



Jason S. Charkow
Partner
Daignault Iyer LLP
914.843.8138
jcharkow@daignaultiyer.com
daignaultiyer.com

From: Rishi Gupta <rgupta@fr.com>
Sent: Wednesday, September 18, 2024 11:49 AM
To: Trials <Trials@USPTO.GOV>
Cc: PV <PVLit@daignaultiyer.com>; IPR12189-0090IP1 <IPR12189-0090IP1@fr.com>
Subject: IPR2024-00934 Request to Submit Reply to POPR

IPR2024-00934
Ex. 3001

Honorable Board,

Petitioner respectfully requests leave to file a pre-institution reply to Patent Owner's Preliminary Response in IPR2024-00934. The proposed content of the reply and bases for good cause are briefly discussed below.

Petitioner requests an 8-page reply to address the following issues:

- Patent Owner has misapplied the law of inherency when arguing against the simulations of the prior art circuitry, which show how the circuits perform over multiple cycles and do not simply show a probability of how the circuits could perform.
 - Good cause exists because Patent Owner's misapplication of inherency was unforeseeable. In addition, the Board would benefit from further briefing to clarify how Patent Owner misapplies the principles of inherency and why their arguments are not applicable to the simulations of the prior art circuitry.
- Patent Owner mischaracterizes the prior art by stating that each reference specifically teaches a sinusoidal local oscillator, where neither DeMaw nor Macnally teaches a sinusoidal local oscillator. Petitioner's reply would assist the Board in understanding where the Petition explains the reasons for using a square-wave local oscillator for simulating the DeMaw and Macnally circuitry.
 - Good cause exists to correct these mischaracterizations of the prior art, and to aid the Board to correctly understand the simulations in view of Patent Owner's mischaracterizations.
- Patent Owner mischaracterizes the evidence presented in the Petition, which supports the presentation of single histograms for discharge of a single capacitor. The reply would point the Board to the Petition's discussions of DeMaw's balanced mixer and Macnally's fully-differential system as well as the Petition's simulated capacitor current-versus-time plots (which show results for both capacitors) as evidence for needing only a single histogram.
 - Good cause exists to correct these mischaracterizations, which may create confusion about the operation of balanced mixer/fully-differential circuitry and the corresponding simulations.

Petitioner does not oppose a sur-reply for Patent Owner of equal length to the reply, if authorized. The parties have conferred by email and Patent Owner indicates that it opposes the request. Should the Board desire a conference call, the parties are mutually available on September 23-24, 2024 in the afternoons. We propose September 23 at 2:00 PM Eastern or September 24 at 2:00 PM Eastern, but we can adjust based on Board availability.

Respectfully Submitted,

Rishi Gupta

Mr. Rishi Gupta :: Of Counsel :: Fish & Richardson P.C.

[+1 \(214\) 437-8731](tel:+12144378731) mobile :: [+1 \(214\) 292-4056](tel:+12142924056) office :: rgupta@fr.com

<https://www.fr.com/team/rishi-gupta/>

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