



Outlook

IPR2024-00934 - Texas Instruments Inc. v. ParkerVision - Requesting Guidance

From Jason Charkow <jcharkow@daignaultiyr.com>

Date Tue 3/4/2025 5:56 PM

To Trials <Trials@USPTO.GOV>

Cc PV <PVLit@daignaultiyr.com>; Josh Griswold <griswold@fr.com>; Konah Duche <kduche@daignaultiyr.com>; Stephanie Mandir <smandir@daignaultiyr.com>; Taylor Lepore <tlepore@daignaultiyr.com>; IPR12189-0092IP1 <IPR12189-0092IP1@fr.com>; PTAB Inbound <PTABInbound@fr.com>; Rishi Gupta <rgupta@fr.com>; Yao Wang <ywang@fr.com>; Rick Bisenius <bisenius@fr.com>

Dear Honorable Board,

The parties require your guidance on an issue that arose on Friday 2/28. The parties request a call with the Board and are available at the following dates/times:

- Wednesday 3/5 - after 2 PM EST
- Thursday 3/6 - 2-3 PM EST

On August 29, 2024, ParkerVision (Patent Owner) filed and served its POPR in which ParkerVision identified deficiencies with circuit simulations prepared by Petitioner's expert, Dr. Galton, in his declaration accompanying the Petition. These simulations provide the basis for TI's invalidity positions and these deficiencies go directly to the heart of the issue in this IPR.

On November 26, 2024, the Board instituted the IPR. The parties agreed to extend the date for the POR until March 6, 2025.

On Friday 2/28, ParkerVision took to the deposition of Dr. Galton. During that deposition, Dr. Galton stated he was aware of a mistake that he made in his simulations. For the first time, Dr. Galton/TI sought to provide corrected simulations at the deposition to correct this mistake. Dr. Galton also referenced undisclosed simulations (not included in his Declaration) that he ran after receiving the POPR and offered to provide these simulations as well. ParkerVision refused to accept any corrected or undisclosed simulations during the deposition because they were not part of the record and ParkerVision had no time to consider them in the middle of the deposition.

On Friday 2/28 night, TI offered to provide corrected simulations to address the mistake by Monday 3/3 as well as a 10-day extension for ParkerVision to file its POR and address these simulations and depose Dr. Galton on the new corrected simulations.

Now, instead of having nine months to have its expert consider TI's simulations as it should have, ParkerVision and its expert are being asked to address the corrected simulations in its POR in 10 days. ParkerVision's expert (who had already prepared his own simulations based on what was in the Petition) is also busy during this time.

Also hanging out there are TI's undisclosed simulations (referenced by Dr. Galton at his deposition) that Dr. Ricketts will never have an opportunity to address.

The late disclosure of the corrected and undisclosed simulations is highly prejudicial to ParkerVision, because ParkerVision and its expert do not have ample time to consider any of these simulations and prepare a response (including simulations to counter TI's simulations). There is also no more time left in the schedule to give ParkerVision the months that it is entitled to review the simulations under the IPR rules.

ParkerVision does not believe that TI's corrected or undisclosed simulations should be allowed, and seeks the Board's guidance.

TI responds that, as Dr. Galton testified during the deposition, the mistake was a typo that resulted in the simulations calling a generic JFET instead of specific JFET model identified in the prior art. Dr. Galton testified that the mistake was discovered "just a few days ago" and it "didn't material change the results." TI has offered to provide ParkerVision the corrected simulations (with the mistake corrected) and opportunity to depose Dr. Galton on the corrected simulations. TI does not seek to file the corrected simulations at this time, but TI does not oppose ParkerVision entering them into the record. TI does not seek to file the additional simulations performed by Dr. Galton since the POPR at this time. And because TI has not received ParkerVision's POR, TI takes no position on whether the additional simulations performed by Dr. Galton since the POPR will be filed in reply to the POR.

Sincerely,
Jason



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