

IPR2024-00934 (U.S. Patent No. 7,496,342)
Patent Owner's Motion to Exclude

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TEXAS INSTRUMENTS INC.,
Petitioner,

v.

PARKERVISION, INC.
Patent Owner

U.S. Patent No. 7,496,342

Inter Partes Review No. IPR2024-00934

PATENT OWNER'S MOTION TO EXCLUDE

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Pursuant to 37 C.F.R. § 42.64(c), the Federal Rules of Evidence ("FRE"), the Scheduling Order (Paper 11), and the Joint Stipulation to Modify Due Dates (Paper 20), Patent Owner ParkerVision, Inc. ("ParkerVision" or "PO") respectfully moves to exclude Exhibits 1042-1043, 1046, 1060 and 2039, Ex. 1 relied upon by Petitioner Texas Instrument Inc. ("TI" or "Petitioner").

I. PO OBJECTED TO EXHIBITS 1042 (2039 EX. 1), 1043, 1046, 1060

PO objected to Exhibits 1042 (identical to 2039, Ex. 1), 1043, 1046, and 1060 in Patent Owner's Objections to Petitioner's Evidence (Paper 33) on July 16, 2025.

II. THE BOARD SHOULD EXCLUDE EXHIBIT 1042 AND PORTIONS OF EXHIBIT 2039 UNDER 37 C.F.R. § 42.23(b), 37 CFR § 42.123, AND FRE 401-402

Exhibits 1042 and 2039, Ex. 1 are the same Second Declaration of Dr. Galton relating to new simulations of prior art conducted to correct errors in the original simulations (Ex. 1003). Petitioner relied upon these exhibits in pages 2, 6, 8-19, 29-30, 32, 36, 38-41 of its Reply. These exhibits should be excluded in its entirety because they are evidence necessary to the *prima facie* case that could have been presented earlier. In addition, at least portions of these exhibits should be excluded under FRE 401-402.

The Petition was supported by Dr. Galton's original declaration (Ex. 1003), which included simulations of prior art necessary to support Petitioner's *prima*

facie case of unpatentability. In the POPR, PO identified errors in Dr. Galton's simulation setup and analysis. During his February 28, 2025 deposition, Dr. Galton admitted his mistakes and offered to provide newly conducted simulations that purportedly corrected errors in the original simulation. Ex. 2036. PO initially declined to accept these untimely and out of scope new simulations. Nevertheless, PO believed (correctly) that Petitioner would (and did) submit these new simulations in its Reply, with no opportunity for PO's expert to address the same. Accordingly, PO contacted the Board for guidance and, during a conference call, the Board indicated that it could not rule whether PO would be granted a sur-reply declaration so that PO's expert could address new simulations. Given the uncertainty surrounding the permissibility of these new simulations, PO requested that Petitioner provide the simulations that Dr. Galton testified about during his deposition. Instead of moving to file these new simulations as supplemental information, Petitioner waited to submit these new simulations with its Reply.

This is improper and untimely.¹ Petitioner was aware of the error in Dr. Galton's simulation before PO filed its POR. Petitioner could have (and should

¹ The Board should exclude, or refuse to consider, Exs. 1042 and 2039, Ex. 1 for the additional reasons discussed in PO's Sur-reply. *See* Sur-reply,

have) requested authorization from the Board to file a motion to submit Dr. Galton's new simulation as supplemental information. *Dexcom, Inc. v. Waveform Technologies, Inc.*, IPR2016-01680, Paper 46, 29-31 (P.T.A.B. Feb. 28, 2018) (granting motion to exclude *prima facie* evidence submitted for the first time with Reply; noting Petitioner's failure to "seek authorization for a motion to submit supplemental information"); 37 CFR § 42.123. This would have allowed the Board to rule on the admissibility of these new evidence prior to PO's filing of the POR. Petitioner's failure to do so already prejudiced PO, and forced PO to choose between: (i) responding to these untimely and out-of-scope evidence in its POR; or (ii) risk not being able to respond to the same with its own expert testimony. Instead, Petitioner waited to submit these new *prima facie* evidence with its Reply, in clear violation of the rules: "Petitioner may not submit new evidence or argument in reply that it could have presented earlier, e.g. to make out a *prima facie* case of unpatentability." CTPG, 73; 37 C.F.R. § 42.23(b). Accordingly, Exhibits 1042 and 2039, Exs. 1-2 should be excluded in its entirety.

Additionally, paragraphs 5-10, 12-13, 15, 153-171, 173-174 of Exhibit 1042 and 2039, Ex. 1 should be excluded under FRE 401-402 because they are not relied upon by Petitioner and thus are irrelevant to any issue in this IPR. *SK Innovation Co., Ltd. v. Celgard, LLC*, IPR2014-00680, Paper 57 at 27 (P.T.A.B. Sept. 25,

2015) (granting motion to exclude “[b]ecause Patent Owner does not explain where it cited [the exhibits] in this proceeding”).

III. THE BOARD SHOULD EXCLUDE EXHIBIT 1043 UNDER FRE 401-402

Exhibit 1043 is irrelevant and thus inadmissible under FRE 401-402. Neither Petitioner nor its expert cites or relies upon Exhibit 1043. Exhibit 1043 is thus irrelevant to any issue in this IPR and should be excluded under FRE 401-402. *SK Innovation*, IPR2014-00680, Paper 57 at 27.

IV. THE BOARD SHOULD EXCLUDE EXHIBIT 1046 UNDER FRE 401-402

Exhibit 1046 is a purported copy of an article titled “Understanding Phase Error and Jitter: Definitions, Implications, Simulations, and Measurement,” dated January 2019. Petitioner’s expert relied upon Exhibit 1046 in paragraphs 136 and 139 of his Third Declaration to show information known to a POSITA at the relevant time of the invention. Ex. 1060, ¶¶ 136, 139.

Exhibit 1046 should be excluded under FRE 401-402 because it is not prior art and thus is irrelevant to the knowledge of a POSITA at the relevant time of the invention. Petitioner’s alleged priority date of April 14, 2000 (Pet., 6, 8-9) predates Exhibit 1046 *by almost 19 years*. Thus, Exhibit 1046 is irrelevant to information known to a POSITA at the relevant time period and should be excluded under FRE 401-402.

V. THE BOARD SHOULD EXCLUDE PORTIONS OF EXHIBIT 1060 UNDER FRE 401-402 AND 702-703

Exhibit 1060 is the Third Declaration of Dr. Ian Galton. In paragraphs 57-58 and 114-15 of Exhibit 1060, Dr. Galton provided histograms to show that certain claim limitations are met. Ex. 1060, ¶¶ 57-58, 114-15. Petitioner relied upon paragraphs 57-58 and 114-15 of Exhibit 1060 in pages 22, 32, and 41 of its Reply.

Paragraphs 57-58 and 114-15 of Exhibit 1060 should be excluded under FRE 702-703 because it is unsupported by reliable facts, data, or methodology. Specifically, Dr. Galton's explanation for how the histograms were created was wholly incomplete and deficient. To show how he generated the histograms, Dr. Galton only provided in paragraphs 57-58 a few short snippets of scripts, the full version of which was not made part of the record. Ex. 1060, ¶¶ 57-58. Moreover, Dr. Galton asserted that his script implemented PO expert's view of "total charge stored." But his script showed discrepancies with PO expert's analysis, and Dr. Galton did not explain the significance of these discrepancies. For the histograms in paragraphs 114-115, Dr. Galton merely referenced back to his opinion in paragraphs 57-58, and thus are equally incomplete and deficient. Accordingly, Dr. Galton's histograms and opinion regarding the same in paragraphs 57-58 and 114-15 are not supported by reliable facts, data, or methodology, and should be excluded under FRE 702-703.

Moreover, paragraphs 32, 139-140, 145-146 of Ex. 1060 should be excluded under FRE 401-402 because they are not relied upon by Petitioner and thus is irrelevant to any issue in this IPR. *SK Innovation*, IPR2014-00680, Paper 57 at 27.

Consequently, paragraphs 32, 57-58, 114-15, 139-140, and 145-46 of Exhibit 1060 should be excluded under FRE 401-402 and 702-703.

VI. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Board exclude Exhibits 1042-1043, 1046, 1060, ¶¶ 32, 57-58, 114-15, 139-140, 145-46, and 2039, Ex.1.

Dated: August 11, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing PATENT OWNER'S
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