

IPR2024-00934 (U.S. Patent No. 7,496,342)
Patent Owner's Reply in Support of 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 REPLY IN SUPPORT OF MOTION TO EXCLUDE

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TI's Opposition (Paper 42, "Opp.") fails to refute PO's Motion to Exclude (Paper 39, "Mot.").

I. EXHIBITS 1042 AND 2039 EX.1 ARE INADMISSIBLE

Dr. Galton's Second Declaration (submitted as Exhibits 1042 and 2039, Ex. 1) is untimely *prima facie* evidence entered into the record without authorization. Mot., 1-4. Nevertheless, TI argues it should not be excluded allegedly because: (1) it was requested by PO and PO addressed it in the POR; (2) it contains prior art analysis responsive of PO's arguments; (3) it does not present new legal theory and is not required for TI's *prima facie* case. None of these arguments holds water.

First, contrary to TI's revisionist history, PO did not consent to the introduction of Galton's Second Declaration into the record. Mot., 1-3. TI's failure to timely and properly request authorization to submit Galton's Second Declaration as supplemental information forced PO to either accept and respond to these untimely *prima facie* evidence in the POR (with no opportunity to oppose its introduction into the record, which the supplemental information briefings would have afforded), or risk not being able to respond with its own expert testimony. *Id.* Faced with this dilemma, PO reluctantly accepted these improper *prima facie* evidence with objections. *Id.* TI now spins this as something that PO requested. Opp., 1-5. But it is plain that TI would have thrust Galton's Second Declaration

into the record one way or another, and to do so on Reply is untimely and improper. TI's reliance on *Rembrandt Diagnostics, LP v. Alere, Inc.*, 76 F.4th 1376 (Fed. Cir. 2023) is misplaced. As *Rembrandt* explained, while "there is no blanket prohibition against the introduction of new evidence during an IPR," the introduction of such post-petition new evidence is predicated upon whether "the evidence is a legitimate reply to evidence introduced by the patent owner." *Rembrandt*, 76 F.4th at 1384. This is not the case here.

Second, Galton's Second Declaration is beyond the scope of permissible Reply evidence. It is a do-over of TI's *prima facie* case that could have—and should have—been submitted at the Petition stage. To the extent petitioners are allowed to submit new evidence to correct mistakes in their *prima facie* case, the proper way to introduce such new *prima facie* evidence is to request authorization for a motion to submit supplemental information. *Dexcom, Inc. v. Waveform Techs, Inc.*, IPR2016-01680, Paper 46, 29-31 (P.T.A.B. Feb. 28, 2018). And not, as TI did here, allude to its existence (without showing what it entails) in a deposition, then submit it as Reply evidence without authorization. As explained above and in PO's motion, the manner and timing of the introduction of Galton's Second Declaration were highly prejudicial to PO.

Third, Galton's Second Declaration is *prima facie* evidence critical to TI's unpatentability Grounds. The Petition relies **extensively** on Galton's original (and flawed) simulation to purportedly show that the claims are obvious. Pet., 13-77. Contrary to TI's assertion, the simulation results in Galton's Second Declaration (spanning 169 pages and longer than Galton's original declaration) is materially distinct from those in Galton's original declaration. POR, 46-48. It does not merely "confirm[] the *prima facie* case" (Opp., 8), it rewrites them. TI contends that Galton's original simulations and/or the DeMaw circuit itself are sufficient to show obviousness of the claims. *Id.*, 11. Given TI failure to timely and properly submit Galton's Second Declaration, TI should be made to stand by Galton's original simulations.

II. EXHIBIT 1046 IS INADMISSIBLE

Exhibit 1054, published almost **19 years** after the priority date, has no probative value to the state of the art at the relevant time period. TI's reliance on *Yeda Research & Dev. Co. v. Mylan Pharms., Inc.*, 906 F.3d 1031 (Fed. Cir. 2018) is misplaced.

In *Yeda*, the Court affirmed the Board's FWD finding that a reference published **three weeks** after the priority date is relevant to the knowledge, motivations, and expectations of a POSITA. *Yeda*, 906 F.3d at 1037, 1041. In so

holding, the Court noted that, despite not qualifying as prior art, the reference relates to a “*study [that] began two years before the priority date*,” and thus is “probative of the fact that those skilled in the art were motivated to investigate” the subject matter of the study. *Id.*, at 1041 (emphasis added). Thus, *Yeda*’s holding is not so broad as to support the admission of references published nowhere close in time to the priority date, without explanation as to how the disclosure therein is probative of the state of the art at a much earlier time.

Here, Exhibit 1054 was published *almost 19 years* after the priority date. Mot., 4. TI expert’s improper reliance on irrelevant evidence does not somehow make it relevant or otherwise admissible. *See* Opp., 13-14 (“Because TI-1046 is ... cited by Dr. Galton to corroborate his explanation ... [it] is therefore relevant.”). TI’s circular argument should be rejected.

III. PORTIONS OF EXHIBIT 1060 ARE INADMISSIBLE

Dr. Galton’s explanation for how he generated the histograms in paragraphs 57-58 and 114-15 of Exhibit 1060 is incomplete. Mot., 5. Petitioner argues that “[t]he snippets in TI-1060 show how Dr. Galton changed the existing Python code to address Dr. Ricketts’s approach to the analysis.” Opp., 14-15. But even assuming, *arguendo*, that the snippets are sufficient to track all modifications made to the Python code, Dr. Galton’s explanation on how the histograms were

generated is nonetheless deficient—the only explanation Dr. Galton provided (in his original declaration relating to the original simulation) was that the histograms were generated “using the transition edges of the LO signal, and the knowledge that the switch opening and closing is dictated by the LO signal amplitude.” Ex. 1003, ¶114; Ex. 1060, ¶58. Without more, it is unclear how and on what bases these histograms were generated. And Petitioner's conclusory assertion that paragraphs 54-59 explained “any discrepancies in PO's expert's analysis” does not make it so. It does not—and cannot—point to how/where it explains away these material discrepancies.

IV. EXHIBIT 1043 AND PORTIONS OF EXHIBITS 1042 (2039 EX. 1) AND 1060 ARE INADMISSIBLE

TI does not dispute that Exhibits 1043, paragraphs 5-10, 12-13, 15, 153-171, 173-174 of Exhibit 1042 (2039, Ex. 1), and paragraphs 32, 139-140 of Exhibit 1060 were not cited in TI's substantive briefings. Opp., 12-13, 14-15. TI's argument that this uncited material is relevant to provide context and background is the same argument that the Board rejected in *SK Innovation* (cited in Mot., 5, 7)—which TI does not even attempt to address, let alone distinguish. *SK Innovation Co., Ltd. v. Celgard, LLC*, IPR2014-00680, Paper 57 at 27 (P.T.A.B. Sept. 25, 2015) (excluding uncited evidence allegedly providing background information).

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Dated: August 19, 2025

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing PATENT OWNER'S
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