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Paper 11
Date: December 19, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NXP USA, INC.,
Petitioner,

v.

PARKERVISION, INC.,
Patent Owner.

IPR2024-01068
Patent 9,118,528 B2

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

GERSTENBLITH, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
*35 U.S.C. § 314*
Granting Conditional Motion for Joinder
*35 U.S.C. § 315(c); 37 C.F.R. § 42.122*

# I. INTRODUCTION

## *A. Background*

NXP USA, Inc. ("Petitioner" or "NXP") filed a Petition (Paper 2, "Pet.") requesting institution of *inter partes* review ("IPR") of claims 1–5, 8, 9, 11–23, 26, 27, and 29–36[1] ("the Challenged Claims") of U.S. Patent No. 9,118,528 B2 (Ex. 1001, "the '528 patent"). Concurrently, with its Petition, Petitioner filed a Conditional Motion for Joinder seeking to join *Texas Instruments Inc. v. ParkerVision, Inc.*, IPR2024-00936 (the "TI IPR"). Paper 3 ("Conditional Motion for Joinder" or "Motion").

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[1] From the context of the analysis and discussion in the Petition, we understand Petitioner to challenge claim 29 and not claim 28 even though, in several places, the Petition either incorrectly includes claim 28 or omits claim 29. We identify several of those instances here in the order presented in the Petition. First, in the chart identifying Petitioner's grounds, Petitioner includes claim 28 but does not include claim 29 in Ground 2A. Pet. 1; *see id.* at 62 (identifying Ground 2A as applying to claim 28 and not claim 29). Additionally, in Petitioner's discussion of Ground 1A, Petitioner includes a heading—"Claims 28, 30, 31, 32" (*id.* at 56 (emphasis omitted))—that identifies claim 28 while excluding claim 29. And, the discussion under that heading refers to "claim 18" (which was previously discussed at pages 46–47 of the Petition under Ground 1A), but attributes claim language to claim 18 ("two (2) percent or greater") that actually is recited in claim 29. *Id.* at 56. To be clear, neither claim 18 nor claim 28 recite that phrase; rather, the phrase is recited in claim 29. *Compare* Ex. 1001, 194:1–7 (claim 18), *with id.* at 195:10–24 (claims 28 and 29). And, in the heading and discussion on pages 89 and 90 of the Petition (Ground 2A), Petitioner incorrectly identifies claim 28 and ties it to the same ("two (2) percent or greater") language of claim 29. Pet. 89–90. Because the discussion in the Petition makes clear that claim 29 is challenged as opposed to claims 18 or 28 in those instances, we have modified the discussion in this Decision accordingly, including in the table listing Petitioner's grounds below.

ParkerVision, Inc. ("Patent Owner") filed a Preliminary Response (Paper 7, "Prelim. Resp.") and does not oppose Petitioner's Conditional Motion for Joinder.

An *inter partes* review may be instituted only if "the information presented in the petition . . . and any [preliminary] response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a) (2018). For the reasons given below, we institute *inter partes* review of the Challenged Claims of the '528 patent. We also grant Petitioner's Conditional Motion for Joinder and join Petitioner to IPR2024-00936.

*B. Related Proceedings*

Petitioner identifies the following pending litigation involving the '528 patent: *ParkerVision, Inc. v. NXP Semiconductors NV*, No. 6:23-cv-00389 (W.D. Tex.); *ParkerVision, Inc. v. Texas Instruments Inc.*, No. 6:23-cv-00384 (W.D. Tex.); *ParkerVision, Inc. v. Realtek Semiconductor Corp.*, 6:23-cv-00374 (W.D. Tex.); *ParkerVision, Inc. v. MediaTek, Inc.*, No. 6:23-cv-00375 (W.D. Tex.); *ParkerVision, Inc. v. LG Electronics, Inc.*, 6:21-cv-00520 (W.D. Tex.); *ParkerVision, Inc. v. Buffalo Inc.*, 6:20-cv-01009 (W.D. Tex.); *ParkerVision, Inc. v. ZyXEL Communications Corp.*, 6:20-cv-01010 (W.D. Tex.); *ParkerVision, Inc. v. TCL Industries Holdings Co.*, 6:20-cv-00945 (W.D. Tex.); *ParkerVision, Inc. v. Hisense Co.*, 6:20-cv-00870 (W.D. Tex.); *ParkerVision, Inc. v. TCL Technology Group Corp.*, 5:20-cv-01030 (C.D. Cal.); *ParkerVision, Inc. v. Intel Corp.*, 6:20-cv-00108 (W.D. Tex.); *ParkerVision, Inc. v. LG Electronics, Inc.*, 2:17-cv-05359 (D.N.J.); *RF Capable Integrated Circuits and Products Containing the Same*, 337-TA-982 (USITC); and *ParkerVision, Inc. v. Apple Inc.*, 3:15-cv-01477 (M.D.

Fla.). Pet. 98–99. Patent Owner identifies the first four cases listed above as being "current[]." Paper 4 (Patent Owner's Mandatory Notices), 1–2.

*C. Real Parties in Interest*

Petitioner identifies NXP USA, Inc.; NXP Semiconductors N.V.; NXP B.V.; and Freescale Semiconductors Holdings V, Inc. as real parties in interest. Pet. 98. Patent Owner identifies ParkerVision, Inc. as a real party in interest. Paper 4, 1.

*D. The Asserted Grounds of Unpatentability and Declaration Evidence*

Petitioner challenges the patentability of claims 1–5, 8, 9, 11–23, 26, 27, and 29–36 of the '528 patent on the following four grounds (Pet. 1):

| Claim(s) Challenged | 35 U.S.C. §[2] | Reference(s)/Basis |
|---|---|---|
| 1, 5, 8, 9, 11–19, 23, 26, 27, 29–36 | 103(a) | Tayloe,[3] TI Datasheet,[4] Macnally[5] |
| 2–4, 20–22 | 103(a) | Tayloe, TI Datasheet, Macnally Cahn[6] |

[2] The Leahy-Smith America Invents Act ("AIA") included revisions to 35 U.S.C. § 103 that became effective on March 16, 2013. Although Petitioner contests whether the '528 patent is entitled to its full priority claim (*see* Pet. 2 (noting that the priority claim includes continuation-in-part applications)), Petitioner assumes the '528 patent is entitled to its full priority claim for purposes of determining whether the asserted references qualify as prior art. Because Petitioner does not present its challenge to the '528 patent's priority for our consideration, we assume for purposes of this Decision that the '528 patent is entitled to its full priority claim and, therefore, we apply the pre-AIA version of the statutory basis for unpatentability. *See* Ex. 1001, code (60) (claiming priority to October 21, 1998).

[3] U.S. Patent No. 6,230,000 B1, issued May 8, 2001 (Ex. 1004, "Tayloe").

[4] Texas Instruments, *SN74CBT3253 Dual 1-of-4 FET Multiplexer/Demultiplexer*, 1–23 (2004) (Ex. 1005, "TI Datasheet").

[5] U.S. Patent No. 7,065,327 B1, issued June 20, 2006 (Ex. 1021, "Macnally"). Petitioner contends that "Macnally is entitled to its provisional filing date, because Macnally and the Macnally-Provisional [Ex. 1022] share virtually identical figures and similar descriptions of those figures." Pet. 21. Petitioner asserts that, although the Macnally-Provisional omits some of disclosure of Macnally—the priority paragraph, summary of the claims, some overview paragraphs, the abstract, and the claims—"columns 5–8, the core of [Macnally's] description, is nearly identical to the provisional." *Id.* Thus, Petitioner contends "[t]he corresponding disclosures in the Macnally-Provisional support[] at least one claim of Macnally (the patent)." *Id.* at 21 (citing Ex. 1003 ¶¶ 112–114). Patent Owner does not contest Petitioner's assertions regarding the effective filing date of Macnally. *See generally* Prelim. Resp.

[6] C. Cahn, *Combined Digital Phase and Amplitude Modulation Communication Systems*, 1960 IEEE/IRE Transactions on Communications Systems, Vol. 8, Issue 3 (Sept.), 150–55 (Ex. 1007, "Cahn").

| Claim(s) Challenged | 35 U.S.C. §[2] | Reference(s)/Basis |
|---|---|---|
| 1, 5, 8, 9, 11–19, 23, 26, 27, 29–36[7] | 103(a) | Razavi,[8] Macnally |
| 2–4, 20–22 | 103(a) | Razavi, Macnally, Cahn |

Pet. 1.

Additionally, Petitioner supports its challenge with a Declaration of Ian Galton, Ph.D. (Ex. 1003), a Declaration of June Ann Munford (Ex. 1014), a Declaration of Rickea McLeod (Ex. 1015), and a Declaration of Maureen Honeycutt (Ex. 1018).

## II. INSTITUTION OF *INTER PARTES* REVIEW

The Petition is substantially identical to the petition in the TI IPR. *Compare* Pet. *with* TI IPR, Paper 2 (petition); *see also* Motion 2 (stating that "NXP's petition challenges the same claims on the same grounds, relies on the same prior art, and includes the exact same substantive arguments as the TI IPR"). Patent Owner raises the same arguments that it presented in the TI IPR. Regarding the first ground, Patent Owner asserts that (1) Petitioner has not shown that one of ordinary skill in the art would have been motivated to combine Tayloe, TI Datasheet, and Macnally (Prelim. Resp. 5–9) and (2) Petitioner fails to provide a sufficient reasonable expectation of success in combining Macnally and Tayloe (*id.* at 9–12). Additionally, Patent Owner contends we should exercise our discretion to deny institution

[7] For the reasons discussed above, we identify claim 29 and not claim 28 in this ground.

[8] B. Razavi, *A 900-MHz CMOS Direct Conversion Receiver*, 1997 Symposium on VLSI Circuits Digest of Technical Papers, 113–14 (Ex. 1017, "Razavi").

"because of the advanced state of parallel litigation pending in the [U.S. District Court for the] Western District of Texas." *Id.* at 2, 18–29 (referring to *ParkerVision, Inc. v. NXP Semiconductors NV*, No. 6:23-cv-00389 (W.D. Tex.)). We address each, starting with discretionary denial.

First, Patent Owner contends that "the factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) [(Order Authorizing Supplemental Briefing on Discretionary Denial)] (precedential), . . . weigh in favor of *denying* institution." Prelim. Resp. 2. Similar to the circumstances in the TI IPR, Petitioner, here, provided Patent Owner a stipulation that states,

> if the Patent Trial and Appeal Board institutes IPR for the '528 patent based on the petition by NXP, and only while any IPR from this petition is pending, NXP will not pursue in Case No. 6-23-cv-00389 the same grounds of invalidity raised in the petition against the claims of the '528 patent, or any grounds of invalidity that reasonably could have been raised in the petition.

Ex. 1041 (e-mail from M. Chibib to J. Charkow, dated June 20, 2024). In contrast to the TI IPR, which did not involve joinder, Patent Owner asserts that "Petitioner also seeks party joinder to the identical TI IPR if the TI IPR is instituted. If Petitioner is joined in that matter, it is unclear whether its stipulation, which is specific to 'this petition,' would effectively bar it from re-raising the same art in the district court case." Prelim. Resp. 27–28 (citation omitted) (citing Petitioner's Motion). In response to Patent Owner's concerns, Petitioner represents, in e-mail correspondence, that, "to resolve any potential ambiguity and to narrow the issues before the Board in these proceedings . . . Petitioner has confirmed to Patent Owner that its prior stipulations will apply if the NXP petitions are granted institution on their own, or if they are instituted and then joined to the Texas Instruments IPRs."

Ex. 3001 (emphasis omitted) (E-mail from K. Crumbley to the Board, dated Nov. 11, 2024).

As set forth in the Director's Memorandum, Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (dated June 21, 2022), at 7, *available at* https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf,

> the [Patent Trial and Appeal Board] will not discretionarily deny institution of an IPR . . . in view of parallel district court litigation where a petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition.

Petitioner's stipulation (Ex. 1041) satisfies the language from the Director's Memorandum quoted above. Additionally, we do not see an issue with ambiguity in Petitioner's stipulation. Specifically, following joinder, this IPR (i.e., IPR2024-01068), which is based on the Petition at issue here (i.e., the Petition filed by NXP), will still be pending even though Petitioner will be joined to IPR2024-00936. Thus, the "IPR from this [P]etition" will be "pending," which satisfies the language of Petitioner's stipulation and precludes the actions stated therein. Further, to the extent there was any potential ambiguity, that ambiguity is resolved by Petitioner's representations in e-mail correspondence (Exhibit 3001), as noted above. Therefore, we need not analyze each *Fintiv* factor to reach the determination that we will not exercise our discretion to deny institution in view of the parallel litigation.

Second, in the TI IPR, we discussed in detail the petitioner's first ground—obviousness over Tayloe, TI Datasheet, and Macnally—but we did

not discuss the second (obviousness over Tayloe, TI Datasheet, Macnally, and Cahn), third (obviousness over Razavi and Macnally), or fourth (obviousness over Razavi, Macnally, and Cahn) grounds extensively because we determined that, at that stage of the proceeding, "the [p]etition shows that there is a reasonable likelihood that [p]etitioner will prevail with respect to [the first] challenge." TI IPR, Paper 9 at 37–38 (citing 35 U.S.C. § 314(a); *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1456 (2018); 37 C.F.R. § 42.108(a)). For substantially the same reasons discussed in the Institution Decision in the TI IPR, which we incorporate expressly herein, Petitioner demonstrates a reasonable likelihood of prevailing with respect to the Challenged Claims of the '528 patent based on the combination of Tayloe, TI Datasheet, and Macnally. TI IPR, Paper 9 (Institution Decision). Additionally, for the same reasons discussed in the Institution Decision in the TI IPR, we do not address extensively the second, third, or fourth grounds raised by Petitioner here, which mirror the second, third, and fourth grounds raised there. *Id.*

## III. CONDITIONAL MOTION FOR JOINDER

"Any request for joinder must be filed . . . no later than one month after the institution date of any *inter partes* review for which joinder is requested." 37 C.F.R. § 42.122(b) (2024). The Board granted institution in the TI IPR on November 26, 2024. TI IPR, Paper 9. On June 20, 2024, Petitioner filed its Conditional Motion for Joinder requesting to join the TI IPR. Thus, Petitioner's Motion is timely.

Acting under the designation of the Director, we have discretion to determine whether to join a party to an instituted *inter partes* review. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(a). We may

> join as a party to [an instituted] inter partes review any person who properly files a petition under section 311 that . . . after receiving a preliminary response under section 313 or the expiration of the time for filing such a response . . . warrants the institution of an inter partes review under section 314.

35 U.S.C. § 315(c). We have explained that a motion for joinder should: (1) set forth reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact, if any, joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified. *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013).

In its Motion, Petitioner asserts that joinder is appropriate because (1) the Petition advances substantively identical grounds and arguments as the existing TI IPR; (2) "joining NXP to the TI IPR is the most practical way to secure the just, speedy, and inexpensive resolution of the challenge to the '528 Patent"; (3) "joinder of NXP to the TI IPR promotes efficiency, by determining the patentability challenges against claims 1–5, 8, 9, 11–23, 26, 27, and 29–36 of the '528 patent in a single proceeding"; and (4) "NXP's Petition challenges the patentability of claims 1–5, 8, 9, 11–23, 26, 27, and 29–36 of the '528 Patent on identical grounds to those in the TI IPR and relies on substantively identical supporting materials, including a declaration by the same expert witness retained by [Texas Instruments Inc. ('TI')] in the TI IPR." Motion 5–7.

Additionally, Petitioner represents that "joinder would have no impact on the trial schedule for the TI IPR. Because both petitions advance identical grounds based on identical arguments and evidence, Patent Owner will not be required to present any additional responses or arguments."

Motion 7. Petitioner also "agrees to adhere to all applicable deadlines set forth in any Scheduling Order issued by the Board in the TI IPR." *Id.* at 8.

Regarding briefing and discovery, Petitioner agrees, so long as TI remains a party to the TI IPR, to take an "understudy" role. Motion 8. Petitioner sets forth the following conditions to apply to the joined proceeding as long as TI remains an active party:

> (a) NXP shall not make any substantive filing and shall be bound by the filings of TI, unless a filing concerns termination and settlement, or issues solely involving NXP;
>
> (b) NXP shall not present any argument or make any presentation at oral argument unless an issue solely involves NXP, or when addressing Board-approved motions that do not affect TI or its respective position;
>
> (c) NXP shall be bound by any past or future agreement between Patent Owner and TI concerning discovery and/or depositions;
>
> (d) NXP shall not receive any direct, cross examination, or redirect time beyond that permitted for TI alone under either 37 C.F.R. § 42.53 or any agreement between Patent Owner and TI; and
>
> (e) NXP shall not seek discovery from Patent Owner separate from TI, except on issues solely involving NXP.

*Id.* at 8–9.

Additionally, Petitioner represents that TI does not oppose the Motion. Motion 5.

In view of Petitioner's representations, Petitioner has persuaded us that joinder is appropriate. We, therefore, *grant* Petitioner's Conditional Motion for Joinder.

## IV. CONCLUSION

For the foregoing reasons, Petitioner has demonstrated a reasonable likelihood that it would prevail in showing that at least one claim of the

’528 patent is unpatentable. At this stage of the proceeding, we have not made a final determination as to the unpatentability of the Challenged Claims or any underlying factual or legal issue.

Additionally, we *grant* Petitioner’s Conditional Motion for Joinder and join Petitioner to IPR2024-00936. **In view of the joinder, no further documents shall be filed by the parties in this proceeding.**

## V. ORDER

Accordingly, it is:

ORDERED that, pursuant to 35 U.S.C. § 314(a), IPR is instituted as to claims 1–5, 8, 9, 11–23, 26, 27, and 29–36 of the ’528 patent on each of the grounds set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(a), Petitioner’s Conditional Motion for Joinder (Paper 3) is *granted*, and Petitioner is joined as a petitioner in IPR2024-00936;

FURTHER ORDERED that, in view of the joinder, no further filings shall be made in this proceeding—IPR2024-01068—and **all further filings shall be made only in IPR2024-00936**;

FURTHER ORDERED that the asserted grounds of unpatentability on which the Board granted institution in IPR2024-00936 are unchanged and remain the only instituted grounds;

FURTHER ORDERED that the Scheduling Order in IPR2024-00936, and any modifications thereto, shall govern the schedule of the joined proceeding;

FURTHER ORDERED that, in IPR2024-00936, Petitioner will file each paper, except for any paper that does not involve the other party, as a single, consolidated filing with TI (petitioner in IPR2024-00936) subject to the page limits set forth in 37 C.F.R. § 42.24, and shall identify such filing as a consolidated filing;

FURTHER ORDERED that for any consolidated filing, if Petitioner wishes to file an additional paper to address points of disagreement with TI, Petitioner must request authorization from the Board to file a motion for an additional paper or pages;

FURTHER ORDERED that Petitioner shall collectively designate attorneys with TI to conduct the cross-examination of any witness produced by Patent Owner and the redirect of any witness produced by TI and Petitioner, within the timeframes set forth in 37 C.F.R. § 42.53(c) or agreed to by the parties;

FURTHER ORDERED that Petitioner shall collectively designate attorneys with TI to present at the oral hearing, if requested and scheduled, in a consolidated argument;

FURTHER ORDERED that the case caption in IPR2024-00936 shall be changed to reflect joinder of Petitioner in accordance with the attached example; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2024-00936.

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*Example Case Caption for Joined Proceeding*

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TEXAS INSTRUMENTS INC.,
and NXP USA, INC.,
Petitioners,

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IPR2024-00936[9]
Patent 9,118,528 B2

[9] NXP USA, Inc., who filed a petition in IPR2024-01068, is joined as petitioner in this proceeding.