

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

PARKERVISION, INC.,
Patent Owner

Case IPR2024-00936¹
Patent 9,118,528

PETITIONER'S MOTION TO EXCLUDE

¹ NXP USA, Inc., who filed a petition in IPR2024-01068, is joined as petitioner in this proceeding.

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Apator Meters ApS v. Kamstrup A/S, 887 F.3d 1293 (Fed. Cir. 2018)

Medichem, S.A. v. Rolabo, S. L., 437 F.3d 1157 (Fed. Cir. 2006)

Medtronic, Inc. v. Teleflex Innovations S.À.R.L., 68 F.4th 1298 (Fed. Cir. 2023)
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I. INTRODUCTION

Pursuant to 37 C.F.R. §42.64 and the Federal Rules of Evidence, Petitioner moves to exclude Exhibits 2010-2014, 2019-2022, 2027, and 2029, and portions of Exhibit 2016. The Board instituted IPR on November 26, 2024 (Paper 9), and PO filed its POR on April 4, 2025 (Paper 21, sealed). With its response, PO filed Exhibits 2010-2014, 2016, 2019-2022, 2027, and 2029 in support of the allegation that PO had conceived and/or actually reduced to practice claims 1, 3, 5, 8-9, 11-18 of the '528 patent prior to the respective filing dates of Tayloe (October 15, 1998) and Macnally (September 10, 1998). Exhibits 2010-2012, 2022, and 2029 are inadmissible hearsay; Exhibits 2010-2014, 2019-2020, 2022, 2027, and 2029 lack authentication; Exhibits 2013-2014, 2019-2020, and 2022 are irrelevant; and certain portions of Mr. Sorrells declaration are also irrelevant. Petitioner timely filed Objections to Evidence on April 10, 2025. PO has not provided supplemental evidence to address the issues presented in this motion.

II. RELEVANT LEGAL STANDARDS

A. Authentication

To satisfy the authentication requirement of Federal Rule of Evidence (“FRE”) 901(a), a proponent of an item of evidence “must produce evidence sufficient to support a finding that the item is what the proponent claims it is.” Exclusion of evidence that has not been properly authenticated is the appropriate remedy. *See, e.g., TRW Automotive U.S. LLC v. Magna Elecs. Inc.*, IPR2014-

01347, Paper 25 at 5–12 (PTAB Jan. 16, 2016) (granting motion to exclude exhibit that was not self-authenticating and was not shown to be authentic); *Riverbed Tech., Inc. v. Realtime Data LLC*, IPR2016-00978, Paper 67 at 39–41 (PTAB Oct. 30, 2017) (“The burden is on Patent Owner to produce evidence sufficient to support a finding that Exhibit 2009 is what the Patent Owner claims it is. Patent Owner has provided no evidence to that effect. Accordingly, Exhibit 2009 shall be excluded from Evidence pursuant to FRE 901, as well as those portions of paragraphs 98–100 in Dr. Zeger’s Declaration (Ex. 2006) that rely expressly on Exhibit 2009.”); *ASM IP Holding B.V. v. Kokusai Elec. Corp.*, IPR2019-00369, Paper 8 at 21 (PTAB June 27, 2019) (“Applying the concept of website printout authentication to *inter partes* review proceedings..., ... the party proffering the evidence must produce some statement or affidavit from someone with knowledge of the website ... for example a web master or someone else with personal knowledge would be sufficient.”) (quotations omitted).

B. Relevance

Evidence is relevant if it has any tendency to make a fact more or less probable than it would be without the evidence and the fact is of consequence in determining the action. FRE 401. Irrelevant evidence is not admissible. FRE 402. Exhibits not cited or relied on in IPRs are irrelevant and should be excluded. *See, e.g., SK Innovation Co., Ltd. v. Celgard, LLC*, IPR2014-00679, Paper 58, at 49

(PTAB Sept. 25, 2015); *Shimano, Inc. v. Globeride, Inc.*, IPR2015-00273, Paper 40, at 26–28 (PTAB June 16, 2016).

C. Hearsay

Hearsay is a statement, other than one made by the declarant while testifying at the trial or hearing, offered in evidence to prove the truth of the matter asserted. FRE 801(c). Hearsay is inadmissible unless a federal statute, the Federal Rules of Evidence, or other rules prescribed by the Supreme Court, provide otherwise. FRE 802. Exclusion of impermissible hearsay is the appropriate remedy. *See, e.g., GAF Materials LLC v. Kirsch Research and Development, LLC*, IPR2021-00192, Paper 45 at 62–65 (PTAB May 24, 2022) (excluding exhibit containing statements made outside the course of the IPR that Patent Owner relied upon for their truth).

With respect to the business records exception of FRE 803(6), a business record is not excluded as hearsay if “(A) the record was made at or near the time by ... someone with knowledge; (B) the record was kept in the course of a regularly conducted activity of a business ...; (C) making the record was a regular practice of that activity; (D) all these conditions are shown by the testimony of a custodian or another qualified witness, or by a certification ...; and (E) the opponent does not show that the source of information or the method of circumstances of preparation indicate a lack of trustworthiness.”

**D. Documentary Evidence for Antedating a Prior Art Reference,
When Supported Only by Uncorroborated Inventor Testimony, is
Unreliable**

Conception and reduction-to-practice are questions of law predicated on factual findings, one of which is the sufficiency of the corroboration. *Apator*, 887 F.3d at 1295-96. The sufficiency of the proffered corroboration is determined by a “rule of reason” analysis, where the “evidence of corroboration **must not depend solely on the inventor.**” *Apator*, 887 F.3d at 1295 (emphasis added). In *Apator*, the Federal Circuit addressed what it considered to be a “catch-22 of corroboration,” where the patent owner asserting the “swear behind” attempted to corroborate the inventor’s testimony with documentation, but said documentation relied on “help” from the inventor’s testimony. *Id.*, at 1296. The Federal Circuit rejected the sufficiency of corroboration where the evidence of corroboration depended solely on inventor testimony. *Id.* at 1296-97.

The Federal Circuit has also explained that corroboration is meant to address credibility concerns and “to prevent fraud” by providing independent confirmation of the inventor’s testimony. *Medichem*, 437 F.3d at 1170. The “corroboration requirement provides an additional safeguard against courts [and others] being deceived by inventors who may be tempted to mischaracterize the events of the past through their testimony.” *Id.* “Even the most credible inventor testimony is *a fortiori* required to be corroborated by independent evidence.” *Medichem*, 437 F.3d

1171. Because an inventor tends to “describe his actions in an unjustifiably self-serving manner,” inventor testimony alone, without more, is not considered credible for the purposes of corroborating documentary evidence purporting to show earlier conception/reduction-to-practice to antedate a prior art reference. *Chen v. Bouchard*, 347 F.3d 1299, 1309 (Fed. Cir. 2003); *see also In re NTP, Inc.*, 654 F.3d 1279, 1291 (Fed. Cir. 2011) (“It would be strange indeed to say that [an inventor], who filed the... affidavit that needs corroborating, can by his own testimony provide that corroboration.”). As a result, such uncorroborated inventor testimony is insufficient to satisfy the strict rules pertaining to authentication of business records under FRE 803(6)(E) and 902(11). Accordingly, business records that are only corroborated by inventor testimony are inadmissible hearsay.

III. ARGUMENTS

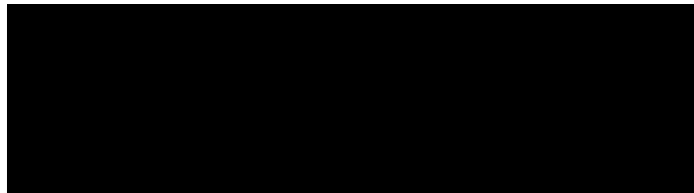
A. Exhibits 2010-2012, 2022, & 2029 Are Inadmissible Hearsay Because They Have Not Been Certified by a Custodian or Another Qualified Witness

Exhibits 2010-2012, 2022, and 2029 are hearsay because PO offers them to prove the truth of the matter asserted—*i.e.*, that PO had conceived and/or actually reduced to practice claims 1, 3, 5, 8-9, 11-18 of the '528 patent prior to the respective filing dates of Tayloe and Macnally. These exhibits are inadmissible because PO has not provided testimony from a custodian or another qualified witness to shown that the factors outlined in FRE 803(6)(A)-(C) are satisfied.

Without such a showing, these exhibits are inadmissible hearsay and should be excluded.

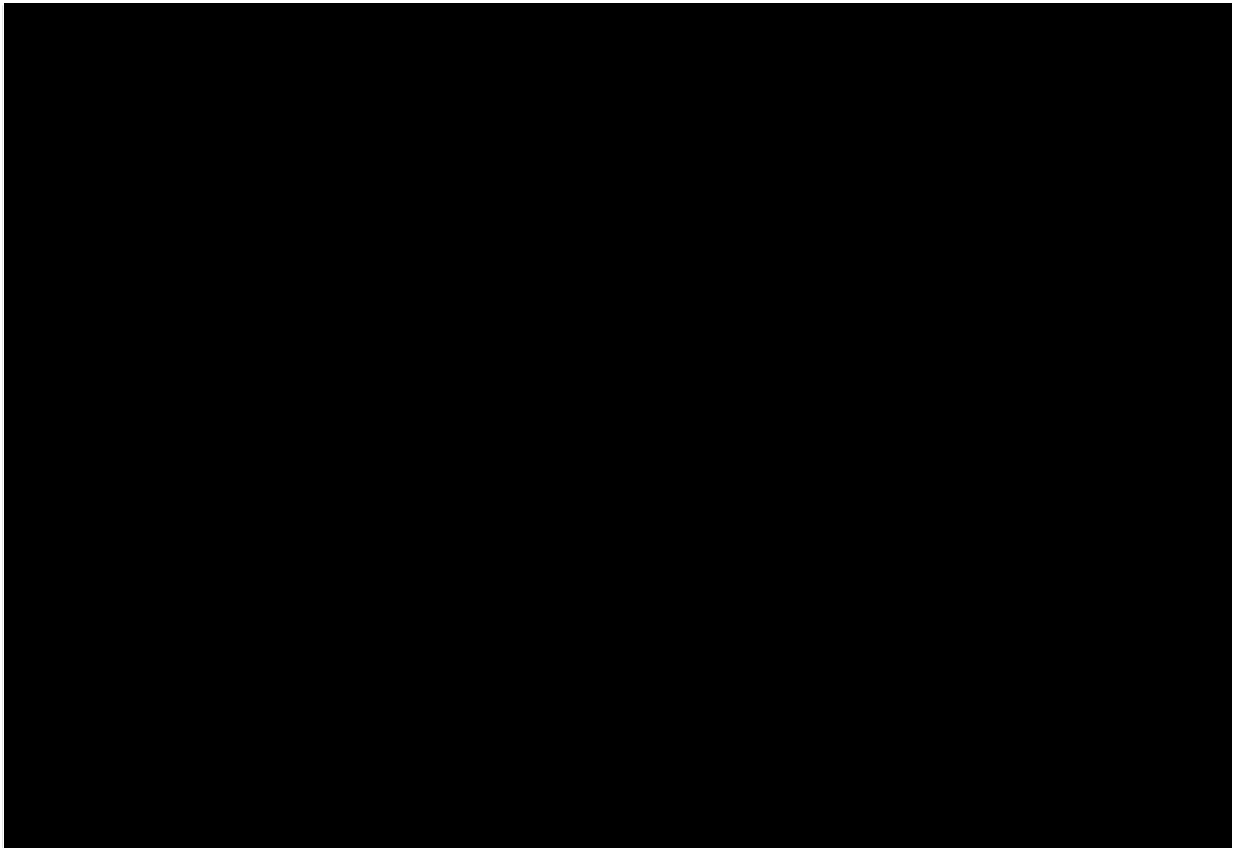
Regarding EX2011, Mr. Sorrells points to “metadata from a Relativity database” to show that “file [REDACTED] was last modified on February 26, 1998.” EX2016, ¶15:

15. As can be seen below in the metadata from a Relativity database, the file [REDACTED] was last modified on February 26, 1998. This date is consistent with the time that the ParkerVision team and I were working on the schematic of the circuit board for the Eddie chip.



Regarding EX2012, Mr. Sorrells points to “the metadata from a Relativity database” to show “that the file was last modified on March 6, 1997.” *Id.*, ¶9:

9. As can be seen (below left) in the properties of the [REDACTED] this file shows that it was last modified on March 6, 1997. As can be seen (below right) in the metadata from a Relativity database, it also shows that the file was last modified on March 6, 1997. This date is consistent with the time that the ParkerVision team and I were working on the layout of the Eddie chip.

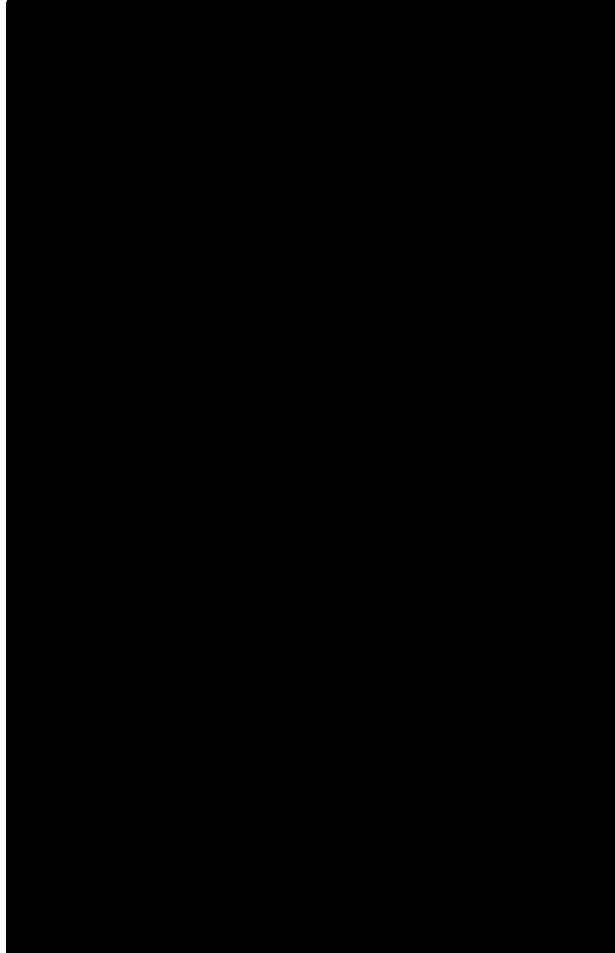


10. As shown above, file explorer also shows a create date of March 6, 1997.

EX2016, ¶9.

Mr. Sorrells also points to EX2029 as a list of files downloaded from a Relativity database with allegedly associated metadata. EX2016, ¶¶29-30:

29. ParkerVision files related to the design, development, testing, and/or evaluation of the Eddie chip and circuit board discussed above are maintained in a Relativity database. The Relativity database shows the metadata including file extension, file name, and last modified date of these files. A search of the database was run. Below is an excerpt from the search.



Mr. Sorrells, however, is not a custodian or a qualified witness to testify as to the storage or maintenance of files on the Relativity database. Mr. Sorrells admitted that he does not know where the Relativity database is stored or who maintains it. TI-1068, 21:5-21. Mr. Sorrells acknowledged that he does not have personal

access to the Relativity database. *Id.*, 22:8-13. Mr. Sorrells acknowledged that he does not know whether the metadata reflected in the database is current. *Id.*, 23:19-24:14. Mr. Sorrells also acknowledged that ParkerVision did not use Relativity in the 1997-1998 timeframe, the period of time the files were allegedly created. *Id.*, 24:15-18. Last, Mr. Sorrells acknowledged that he does not have first-hand knowledge of how the files were added to the Relativity database. *Id.*, 24:19-21.

Because Mr. Sorrells is not a custodian or another qualified witness to attest to the requirements pursuant to FRE 803(6)(A)-(C), Exhibits 2011, 2012, and 2029 are not entitled to the business records hearsay exception, and are thus inadmissible and should be excluded. In the alternative, if the underlying circuit schematics shown in the Exhibits 2011 and 2012 were admissible under a hearsay exception (they are not), the metadata, including the date- and timestamps, associated with Exhibits 2011-2012 are inadmissible hearsay for these same reasons. Likewise, the metadata associated with the filenames in EX2029 are also inadmissible hearsay for these same reasons and should be excluded.

Regarding EX2010 and EX2022, the only testimony provided in support of EX2010 and EX2022 (together, [REDACTED] is from Mr. Sorrells, but Mr. Sorrells was not a custodian or a qualified witness of [REDACTED] under FRE 803(6). First, Mr. Sorrells did not create [REDACTED]. EX2016, ¶¶22-23. Second, Mr. Sorrells testified that he only observed “some” of the testing, without

providing specifics. EX2016, ¶22. For example, Mr. Sorrells declaration does not indicate which tests he observed or on which dates he was present. At best, EX2010 states that Mr. Sorrells was present on April 8, 1998, and that Mr. Sorrells directed configuration and test selection. EX2010, at 5. But there is no evidence from Mr. Sorrells or elsewhere on the record that he was present for the testing on April 27, 1998 that resulted in the Smith chart shown on page 15 of EX2010 (and resubmitted, in part, as EX2042²). Nor is there evidence that Mr. Sorrells was present for the testing that occurred February 23-27, 1998, which are the dates indicated in EX2022.

Without evidence of first-hand knowledge of the testing that occurred on April 27, 1998, PO has not shown that Mr. Sorrells is a qualified witness as to the details of the testing that occurred on that day, the discussion and results of which are reflected on pages 8-16 of EX2010. Likewise, without evidence of first-hand knowledge of the testing that occurred on February 23-27, 1998, PO has not shown that Mr. Sorrells is a qualified witness as to the details of the testing that occurred on those days, the discussion and results of which are reflected on pages 3-39 of EX2022. Thus, pages 8-16 of EX2010 and pages 3-39 of EX2022 are inadmissible

² EX2042 is also inadmissible hearsay for the same reasons as EX2010. It is also inadmissible for lack of completeness under FRE 106.

hearsay and should be excluded.

B. Exhibits 2010-2014, 2019-2022, 2027, & 2029 Lack Authenticity

Exhibits 2010-2014, 2019-2022, 2027, and 2029 are inadmissible pursuant to FRE 901 as lacking the authentication or identification of non-testimonial evidence as a precondition to their admissibility, and PO has offered nothing by way of foundation of genuineness sufficient to support a finding of authenticity by the Board other than the testimony of the inventor, Mr. Sorrells. As discussed briefly above, the testimony of Mr. Sorrells as the inventor of claims 1, 3, 5, 8-9, 11-18 of the '528 patent is insufficient to corroborate documents relied on for the purposes of establishing conception or actual reduction to practice of a system as recited by claims 1, 3, 5, 8-9, 11-18 of the '528 patent. *E.g., Apator*, 887 F.3d at 1295 (describing that, under the “rule of reason,” the “evidence of corroboration must not depend solely on the inventor”). Here, the only corroboration offered by the PO for the authenticity of Exhibits 2010-2014, 2019-2022, 2027, and 2029 is the testimony of the inventor, Mr. Sorrells. Since it has been legally established that inventor testimony is not enough for a trier of fact to find authenticity of the genuineness of these exhibits, they are inadmissible pursuant to FRE 901 and should be excluded.

C. Exhibits 2013-2014, 2019-2020, and 2022 Are Irrelevant

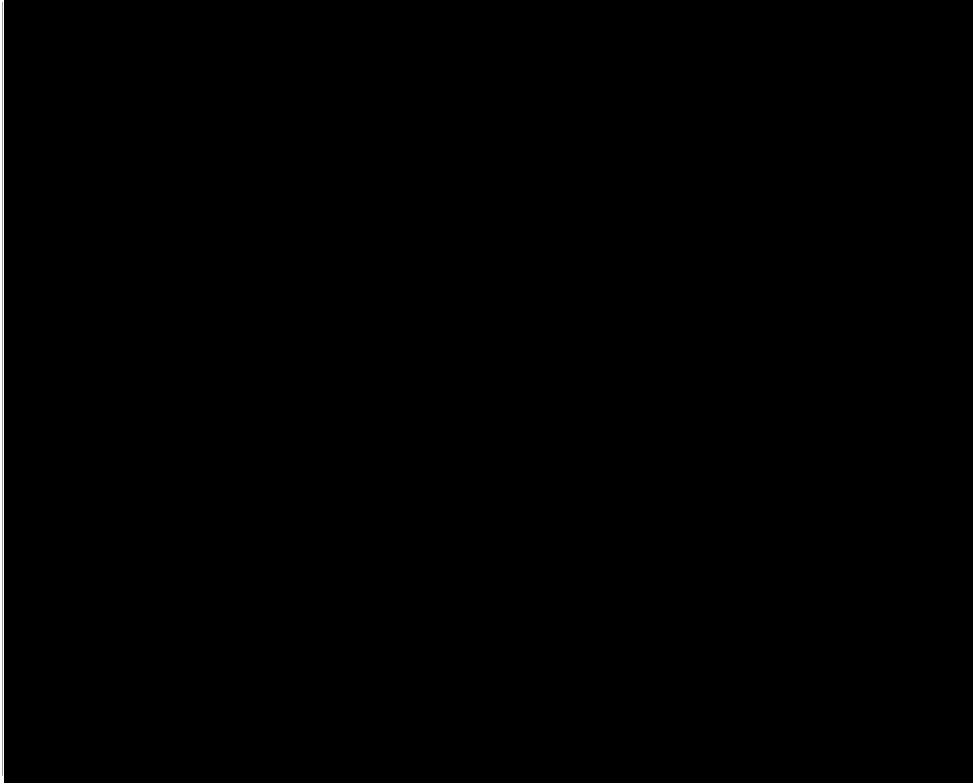
Exhibits 2013 and 2014 are inadmissible as being irrelevant pursuant to FRE

402. In support of his argument that PO conceived and/or actually reduced to practice claims 1, 3, 5, 8-9, 11-18 of the '528 patent prior to the respective filing dates of Tayloe and Macnally, Dr. Ricketts provided a claim chart at EX2015 that allegedly maps various features from the exhibits onto the claims. EX2013 and EX2014 are absent from Dr. Ricketts's claim chart, indicating that did not need these exhibits to reach his conclusions. Because Dr. Ricketts did not use these exhibits, they do not have any tendency to make the allegation of conception or actual reduction to practice of claims 1, 3, 5, 8-9, 11-18 of the '528 patent prior to the respective filing dates of Tayloe and Macnally more or less probable than it would be without the EX2013 and 2014. Additionally, EX2014 was not cited or discussed in the POR (Paper 21, sealed) or the Sur-reply (Paper 39, sealed). The POR cites to but does not discuss Exhibit 2013, and does so purely to summarize Mr. Sorrells's declaration. Paper 21, at 25. Accordingly, EX2013 and EX2014 are irrelevant and should be excluded.

D. Certain Paragraphs of Mr. Sorrells Declaration Should Be Excluded as Irrelevant

Paragraph 9 of EX2016 shows a screen shot of the Properties of file

████████████████████



EX2016, ¶9 (**annotated**)

This screenshot is irrelevant to the question of whether PO reduced claims 1, 3, 5, 8-9, 11-18 of the '528 patent to practice prior to the respective filing dates of Tayloe and Macnally based on the testing of the Eddie circuit. PO has asserted that the Eddie circuit is shown in a file named [REDACTED] which is EX2012. *E.g.*, EX23016, ¶7. Mr. Sorrells does not provide an explanation for what [REDACTED] is, what it contains, or how it relates to the circuit shown in [REDACTED]. Thus, the screenshot of the Properties of [REDACTED] is irrelevant and should be excluded.

IV. CONCLUSION

For the above reasons, Petitioner respectfully requests the exclusion of Exhibits 2010-2014, 2019-2022, 2027, and 2029, and portions of Exhibit 2016 from the evidentiary record in this proceeding.

Respectfully submitted,

Dated August 5, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(1) and 42.6(e)(4)(iii), the undersigned certifies that on August 5, 2025, a complete and entire copy of this Petitioner's Motion to Exclude was provided by email to the Patent Owner by serving the email correspondence address of record as follows:

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