

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.

U.S. Patent No. 9,118,528

Issue Date: August 25, 2015

Title: METHOD AND SYSTEM FOR DOWN-CONVERTING AN
ELECTROMAGNETIC SIGNAL, AND TRANSFORMS FOR
SAME, AND APERTURE RELATIONSHIPS

Inter Partes Review No. IPR2024-00936¹

PATENT OWNER'S REPLY IN SUPPORT OF 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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Petitioners' Opposition ("Opp.") to Motion to Exclude ("Mot.") fails.

I. UNCITED EXHIBITS ARE INADMISSIBLE

Petitioners do not dispute that Exhibits 1048-1049, 1058-1061, 1064, paragraphs 52, 76-80, 91-94, 160, 170-171 of Exhibit 1066, and paragraphs 25-27 of Exhibit 1067 were not cited in Petitioners' briefing. Opp., 7-8, 10-12. Instead, Petitioners argue that uncited exhibits or portions thereof are relevant for context and background. *Id.* This is the same argument that the Board rejected in *SK Innovation*, which Petitioners do not 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).

II. EXHIBIT 1047 IS INADMISSIBLE

Petitioners do not—and cannot—claim that Exhibit 1047 is from anywhere near “the time of the invention,” which is the relevant time period for evidence reflecting the state of the art. Petitioners instead try to shoehorn the irrelevant evidence in as reflecting an “implementation” of the Tayloe reference. But Petitioners plainly cannot substantiate this bold assertion. The most Petitioners could muster is that: (1) Exhibit 1047 states that its author “came up with the idea for the detector ... around 1998”; and (2) Exhibit 1047 allegedly describes circuits “highly similar” to those in the Tayloe reference. Opp., 3-4. Even assuming, *arguendo*, that the author of Exhibit 1047 and the Tayloe reference is the same

person, and the documents both describe the same basic idea, this unsubstantiated speculation is insufficient to establish Exhibit 1047 as ***an implementation*** (and not, *e.g.*, a later-improved iteration) of the Tayloe reference. *Id.* This is the epitome of impermissible hindsight—using a 2006 document to explain a 1998 reference.

Realizing its untenable position, Petitioners attempted to shift the burden of authentication to PO by arguing that PO proffered no evidence “suggesting a different Mr. Tayloe ... authored [Exhibit 1047].” *Id.* Nonetheless, PO has established (and Petitioners does not rebut) that: (1) no record evidence expressly ties Exhibit 1047 to the Tayloe reference; and (2) the circuits in Exhibit 1047 and the Tayloe reference are different. Mot., 2-3. These undisputed facts show that Exhibit 1047 is not ***an implementation*** of the Tayloe reference.

Petitioners' failure to establish a concrete nexus between the Tayloe reference and an unrelated document published 8 years later is fatal to its argument regarding relevance. To the extent Exhibit 1047 does not show an implementation of the Tayloe reference (it does not), there is no argument put forth to even suggest that the state of the art at least ***five and a half years*** after the claimed invention could have any relevance here. Mot., 2.

Petitioners' reliance on *Yeda Research & Dev. Co. v. Mylan Pharms., Inc.*, 906 F.3d 1031 (Fed. Cir. 2018) is misplaced. In *Yeda*, the Court held that a

reference published *three weeks* after the priority date is relevant to the knowledge and motivations 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 of the study. *Id.*, at 1041. *Yeda*'s holding is not so broad as to support the free admission of references published nowhere close in time to the priority date.

Here, Exhibit 1047 was published *at least half a decade after the priority date*. Mot., 2. And despite stating that “the idea for the detector” described therein was conceived “around 1998” (Ex. 1047, 8), Exhibit 1047 does not disclose that the “idea” was known at anytime before the priority date. Nor does Exhibit 1047 delineate between the original “idea” and any improvements made after the priority date. Thus, to the extent Exhibit 1047 is probative of the state of the art, its probative value is substantially outweighed by the prejudice to PO, because it is unclear which (if any) portion of Exhibit 1047 was known before its publication.

III. EXHIBIT 1054 IS INADMISSIBLE

Petitioners' argument that a paper explaining the operation of “modern practical mixer circuits” explains what was referred to in a conventional mixer circuit *twenty years earlier* is preposterous. *See* Opp., 5. *Yeda* does not stand for

the proposition that references published *decades after* the priority date are freely admissible. *See Yeda*, 906 F.3d at 1041. Nor does Petitioners expert's improper reliance on such irrelevant evidence somehow make it relevant. *See Opp.*, 5 ("Because TI-1054 is ... cited by Dr. Galton to corroborate his explanation ... [it] is therefore relevant."). Petitioners' circular argument—which turns the requirement that experts only rely on relevant evidence on its head—should be rejected.

IV. PORTIONS OF EXHIBIT 1066 ARE INADMISSIBLE

As explained above and in PO's Motion, Exhibit 1047 is inadmissible. For the same reasons, Galton's testimony regarding the same in paragraphs 22-25, 27-28, 30 of Exhibit 1066 should also be excluded. To the extent Exhibit 1047 is admitted for state-of-the-art purposes (it should not be), Galton's reliance on Exhibit 1047 to fill the gaps in the Tayloe reference is nonetheless improper and should be excluded. As *Yeda* explained, "non-prior art evidence of what was known 'cannot be applied, independently, as teachings separately combinable' with other prior art," even if it is admissible to indicate the state of the art. *See Yeda*, 906 F.3d at 1041. Nor can Dr. Galton's improper factual opinions on authorship be relevant or admissible.

V. PORTIONS OF EXHIBIT 1067 ARE INADMISSIBLE

Petitioners do not dispute that Exhibit 2011 alone does not provide sufficient information to support Dickens' conclusion regarding the impedance of [REDACTED]

█. Opp., 8-10. Instead, Petitioners argue that other record evidence (*e.g.*, Exs. 2010, 2012-2013, 2015-2016, 2022, 2024) provides “additional information” that supports Dickens’ conclusion. Opp., 9-10. But Petitioners do not specify what and where in the cited evidence provides such “additional information” sufficient to determine the impedance of █. Petitioners’ rephrasing of Dickens’ baseless conclusions, unsupported by record evidence, is of no moment. *Id.*

VI. PORTIONS OF EXHIBITS 2034 AND 2042 ARE INADMISSIBLE

Petitioners’ arguments confirm that Galton’s responses were nonresponsive.

Exhibit 2034: With respect to lines 109:10-113:2, Petitioners’ reference to Galton’s evasive answer that he would need “to go through and read” the reference to fully answer (Opp., 13), does not make Galton’s unresponsive tangent responsive. With respect to lines 179:21-182:19, Petitioners argue that Galton’s answer was a response to an earlier, unrelated question. *Id.*, 13. Likewise, with respect to lines 209:18-211:2, PO counsel’s (unsuccessful) attempt to prompt Galton’s to clarify his nonresponsive answer cannot make it responsive *Id.*, 13-14.

Exhibit 2042: With respect to lines 36:8-37:5, Petitioners suggest that lines 40:5-8 and 41:6-9 are responsive. *Id.*, 14-15. But these portions are not subject to PO’s Motion. Petitioners admit that lines 87:13-88:14 were not responsive to the question asked. *Id.* (“Galton ... supplement[ed] his answer to an earlier question”).

IPR2024-00936 (U.S. Patent No. 9,118,528)
Patent Owner's Reply in Support of Motion to Exclude

Dated: August 19, 2025

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CERTIFICATE OF SERVICE

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