

IPR2025-00325

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

Patent Owner's Brief In Support of Discretionary Denial and Opposition to
Petitioner's Motion for Joinder

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

REALTEK SEMICONDUCTOR CORP.,
Petitioner,

v.

PARKERVISION, INC.
Patent Owner.

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

Inter Partes Review No. IPR2025-00325

**PATENT OWNER'S BRIEF IN SUPPORT OF DISCRETIONARY DENIAL
AND OPPOSITION TO PETITIONER'S MOTION FOR JOINDER**¹

¹ Patent Owner reserves the right to submit a Patent Owner Preliminary Response ("POPR") addressing the merits and does not intend for this Brief to replace its POPR. The deadline for filing the POPR is April 30, 2025. *See* IPR2025-00325, Paper 6.

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	FACTUAL BACKGROUND.....	3
III.	THE <i>FINITIV</i> FACTORS WEIGH AGAINST INSTITUTION	6
A.	Factor 1 – No Stay Has Been Entered In The District Court and There Is No Evidence A Stay Will Be Granted.....	7
B.	Factor 2 – Trial In the District Court Is Currently Expected Before The Statutory Deadline, And Even If Joined to TI’s IPR, The Statutory Deadline Is Likely To Be Extended Beyond District Court Trial.	9
C.	Factor 3 – The Parties Have Invested Significant Resources In The Parallel Proceedings.	10
D.	Factor 4 – The Issues Overlap.....	11
E.	Factor 5 – Both Parties Are Parties In The Parallel Litigation.	14
F.	Factor 6 – The Petition Does Not Present Compelling Evidence of Unpatentability.	14
IV.	ADDITIONAL FACTORS SET FORTH IN THE STEWART MEMO SUPPORT DISCRETIONARY DENIAL	15
A.	Additional Factor 1 – Patent Expiration and Efficient Resource Allocation.	16
B.	Additional Factor 2 – Petitioner’s Gamesmanship and Undue Delay and Gamesmanship.....	16
V.	INSTITUTION SHOULD BE DENIED UNDER <i>GENERAL PLASTIC</i>	20
VI.	CONCLUSION.....	23

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential, designated May 5, 2020).....	<i>passim</i>
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-0019, Paper 15 (PTAB May 13, 2020)	7
<i>Apple v. Uniloc 2017 LLC</i> , IPR2020-00854, Paper 9 (PTAB Oct. 28, 2020).....	1, 21
<i>Code200, UAB et. al. v. Bright Data Ltd.</i> , IPR2021-01502, Paper 13 (PTAB Mar. 14, 2022)	2
<i>Commscope Techs. v. Dali Wireless, Inc.</i> , IPR2022-01242, Paper 23 (PTAB Feb. 27, 2023).....	15
<i>Facebook, Inc. v. Windy City Innovations, LLC</i> , 973 F.3d 132 (Fed. Cir. 2020)	1
<i>General Plastic Indus. Co. v. Canon Kabushiki Kaisha</i> , IPR2016-01357, Paper 19 (PTAB, Sept. 6, 2017).....	2, 3, 20, 21
<i>LG Elecs., Inc. v. Ancora Techs., Inc.</i> , IPR2021-00581, Paper 16 (June 10, 2021).....	3
<i>Luxshare Precision Industry v. Amphenol Corp.</i> , IPR2022-00132, Paper 10 (PTAB May 3, 2022)	8
<i>Micro Motion, Inc. v. Invensys Sys.</i> , IPR2014-01409, Paper 14 (PTAB Feb. 18, 2015).....	20
<i>Multimedia Content Mgmt. LLC v. Dish Network Corp.</i> , No. 6:18-cv-00207-ADA, 2019 U.S. Dist. LEXIS 198875 (W.D. Tex. Jan. 10, 2019).....	8

IPR2025-00325 (U.S. Patent No. 9,118,528)
Patent Owner’s Brief In Support of Discretionary Denial and Opposition to Motion
for Joinder

<i>NHK Spring Co. v. Intri-Plex Techs., Inc.</i> , IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019).....	2, 6
<i>Nintendo Co. v. Gamevice, Inc.</i> , IPR2020-01197, Paper 13 (PTAB Jan. 12, 2021)	9
<i>NXP v. ParkerVision, Inc.</i> , IPR2024-01068 (PTAB June 20, 2024)	4, 5
<i>ParkerVision LLC v. Realtek Semiconductor Corp.</i> , No. 6:22-cv-00162-ADA (W.D. Tex. Nov. 10, 2022)	4
<i>ParkerVision, Inc. v. NXP Semiconductor N.V. et. al.</i> , Case No. 6:23-cv-00389-ADA (W.D. Tex. May 19, 2023).....	4
<i>ParkerVision, LLC v. Realtek Semiconductor Corp.</i> , No. 6:23-cv-00374-ADA, Dkt. 1 (W.D. Tex. May 16, 2023).....	3, 4
<i>ParkerVision, LLC v. Texas Instruments, Incorporated</i> , No. 6:23-cv-00384, Dkt. 1 (W.D. Tex. May 18, 2023).....	4
<i>Proppant Express Investments, LLC, et al., v. Oren Technologies, LLC</i> , IPR2018-00914, Paper 38 (PTAB Mar. 13, 2019) (Precedential, de-designated Jul. 24, 2023)	17, 19
<i>Shenzhen Silver Star Intelligent Tech. Co., Ltd. v. iRobot Corp.</i> , IPR2018-00898, Paper 9 (PTAB Oct. 1, 2018).....	22
<i>Sonrai Memory Ltd. v. Micron Tech., Inc.</i> , 1:23-cv-01407-ADA, 2024 U.S. Dist. LEXIS 231280 (May 29, 2024)	8
<i>T-Mobile USA, Inc., et al., v. Wireless Alliance</i> , IPR2024-00608, Paper 16 (PTAB Sept. 3, 2024).....	9, 10, 11
<i>T-Mobile USA, Inc. v. VoIP-Pal.com, Inc.</i> , IPR2023-00638, Paper 11 (PTAB, July 28, 2023).....	21

IPR2025-00325 (U.S. Patent No. 9,118,528)
Patent Owner’s Brief In Support of Discretionary Denial and Opposition to Motion
for Joinder

Statutes

35 U.S.C. § 314(a)	2
35 U.S.C. § 315(b)	17, 18, 19, 20
35 U.S.C. § 315(c)	2
35 U.S.C. § 316(a)(11).....	10, 21

Other Authorities

37 C.F.R. § 42.122	2
--------------------------	---

PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	Memorandum, Acting Director Coke Morgan Stewart, Interim Processes for PTAB Workload Management, Dated March 26, 2025
2002	Complaint, <i>ParkerVision, Inc. v. Realtek Semiconductor Corp.</i> , Case No. 6:23-cv-00374-ADA (WDTX)
2003	Summons and Proof of Service, <i>ParkerVision, Inc. v. Realtek Semiconductor Corp.</i> , Case No. 6:23-cv-00374-ADA (WDTX)
2004	Dani Kass, "Catching Up on Patent Litigation With Judge Albright," Law360 (Mar. 14, 2023)
2005	First Amended Scheduling Order, <i>ParkerVision, Inc. v. Realtek Semiconductor Corp.</i> , Case No. 6:23-cv-00374-ADA (WDTX)
2006	Order Setting Zoom Markman, <i>ParkerVision, Inc. v. Realtek Semiconductor Corp.</i> , Case No. 6:23-cv-00374-ADA (WDTX)
2007	Order Adopting Report and Recommendation of Special Master Regarding Claim Construction, <i>ParkerVision, Inc. v. Realtek Semiconductor Corp.</i> , Case No. 6:23-cv-00374-ADA (WDTX)
2008	Memorandum, Chief Administrative Patent Judge Scott R. Boalick, Guidance on USPTO's rescission of "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation, Dated March 24, 2025.
2009	Patent Trial and Appeals Board Consolidated Trial Practice Guide, November 2019 ("CTPG")

I. INTRODUCTION

Patent Owner ParkerVision, Inc. (“ParkerVision” or “Patent Owner”) submits this Brief in Support of Patent Owner’s Request for Discretionary Denial and respectfully requests the Board deny institution of Realtek Semiconductor Corp.’s (“Realtek” or “Petitioner”) Petition challenging the patentability of claims 1-5, 8, 9, 11-23, 26, 27, and 29-36 (“Challenged Claims”) of U.S. Patent No. 9,118,528 (the “’528 patent”). ParkerVision submits this paper pursuant to the Acting Director Stewart’s recent guidance on “Interim Processes for PTAB Workload Management,” dated March 26, 2025 (“Stewart Memo”) (Ex. 2001).

ParkerVision also opposes Petitioner’s Motion for Joinder to IPR2024-00936 (Paper 3) (hereinafter, the “TI IPR”) and respectfully requests the Board deny joinder for the reasons set forth herein.

Joinder requires two different decisions. *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 132, 1332 (Fed. Cir. 2020). The Board must first determine “whether the joinder applicant’s petition ‘warrants’ institution under § 314,” then, whether to “exercise . . . discretion to ‘join as a party’ the joinder applicant”). *Id.*; see also, *Apple v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 at 5 (PTAB Oct. 28, 2020) (precedential) (“[B]efore determining whether to join Apple as a party [to the IPR], even though the Petition is a ‘me-too petition,’ we first

determine whether application of the *General Plastic* factors warrants the exercise of discretion to deny the Petition under § 314(a).”)

The Board should exercise discretion pursuant to 35 U.S.C. § 314(a) to deny the Petition. Application of the *Fintiv* factors under §314(a) weighs in favor of denial given the advanced state of the parallel District Court litigation where the *same* validity challenges are being adjudicated. *See NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019) (setting forth six factors for determining whether discretionary denial due to parallel litigation is appropriate) (the “*Fintiv* factors”). In addition to the *Fintiv* factors, institution should be denied as the *General Plastic* factors weigh against institution, and thus also weigh against joinder. *General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB, Sept. 6, 2017) (precedential). Moreover, the additional factors outlined in the Stewart Memo weigh in favor of discretionary denial.

Joinder of a party to an instituted IPR is permitted when warranted if the joining party properly files a petition. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122. The “decision to grant joinder is discretionary.” *Code200, UAB et. al. v. Bright Data Ltd.*, IPR2021-01502, Paper 13 at 8 (PTAB Mar. 14, 2022) (exercising discretion to deny Petitioner's motion for joinder).

Like the *General Plastic* factors, the *Fintiv* factors provide a basis to deny an “understudy” joinder request considering a “holistic view of whether efficiency and integrity of the system are best served” by rejecting it. *See LG Elecs., Inc. v. Ancora Techs., Inc.*, IPR2021-00581, Paper 16 at 7 (June 10, 2021).

Accordingly, institution and joinder should be denied pursuant to the *Fintiv* factors and *General Plastic* factors as both weigh in favor of denial. Moreover, the additional factors outlined in the Stewart Memo, which are detailed herein, weigh in favor of discretionary denial.

Therefore, the Board should exercise its discretion to deny institution and joinder to the TI IPR.

II. FACTUAL BACKGROUND

The '528 patent is common across three parallel district court proceedings, all of which are barreling towards trial. ParkerVision filed patent infringement actions in the Western District of Texas against three separate defendants within a three-day span, each alleging infringement of the '528 patent. The first was filed against Petitioner on May 16, 2023. *ParkerVision, LLC v. Realtek Semiconductor Corp.*,

No. 6:23-cv-00374-ADA, Dkt. 1, (W.D. Tex. May 16, 2023)² (Ex. 2002). Service on Realtek was subsequently effectuated on September 28, 2023. (Ex. 2003); *see also id.* at Dkt. 29. The second was filed against Texas Instruments on May 18, 2023. *ParkerVision, LLC v. Texas Instruments, Incorporated*, No. 6:23-cv-00384, Dkt. 1, (W.D. Tex. May 18, 2023). The third was filed against NXP Semiconductors N.V. *et. al.* (hereinafter, “NXP”) on May 19, 2023. *ParkerVision, Inc. v. NXP Semiconductor N.V. et. al.*, Case No. 6:23-cv-00389-ADA (WDTX).

On May 18, 2024, Texas Instruments, as sole petitioner, timely filed a Petition for *Inter Partes* Review seeking cancellation of the Challenged Claims of the ’528 patent. TI IPR, IPR2024-00936, Paper 2. On June 20, 2024, NXP timely filed, as sole petitioner, its Petition for *Inter Partes* Review challenging the same claims. *NXP v. ParkerVision, Inc.*, IPR2024-01068 (hereinafter, the “NXP IPR”). Rather than challenging on different invalidity grounds, NXP filed a ‘copycat’ or ‘me-too’ petition – that is, it sought institution on the same grounds as in the TI IPR, was substantially similar to the TI IPR, and asserted a passive “understudy”

² A second litigation, asserting different patents but involving the same parties is also ongoing in the Western District of Texas. *See ParkerVision LLC v. Realtek Semiconductor Corp.*, No. 6:22-cv-00162-ADA.

role. NXP concurrently filed a Conditional Motion for Joinder to the TI IPR (IPR2024-00936). *See* NXP IPR, IPR2024-01068, Papers 2, 3.

The Board issued its Decision Granting Institution of *Inter Partes* Review in the TI IPR on November 26, 2024. TI IPR, IPR2024-00936, Paper 9. The Board subsequently issued its Decision Granting Institution and Conditional Motion for Joinder to the TI IPR on December 19, 2024. *See* NXP IPR, IPR2024-01068, Paper 10; *see also* TI IPR, IPR2024-00936, Paper 11 (collectively, the “TI, NXP IPR” proceeding under No. IPR2024-00936).

Realtek failed to file its own IPR petition throughout the running of its own one-year statute of limitations on September 28, 2024, the Board's institution of the TI IPR on November 26, 2024, and the Board's institution and joinder of the NXP IPR on December 19, 2024. It was not until December 24, 2024 that Realtek filed its own copycat.³ Realtek IPR, IPR2025-00325, Paper 1. Realtek concurrently filed a Motion for Joinder to *Inter Partes* Review IPR2024-00936 (the TI IPR). *Id.* at

³ Realtek filed on a USPTO-observed federal holiday. *See* USPTO Operating Status, available at <https://www.uspto.gov/learning-and-resources/operating-status>.

Paper 3. To date, Realtek has failed to arrange the required conference call with the panel and Patent Owner to discuss its joinder motion.⁴

III. THE *FINITIV* FACTORS WEIGH AGAINST INSTITUTION

Due to the advanced state of parallel district court litigation regarding the same issues, the Board has discretion to deny institution here. *See NHK Spring v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential, designated May 8, 2019). The Board has set forth six factors for determining whether discretionary denial is appropriate:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and,
6. other circumstances that impact the Board's exercise of discretion, including the merits.

⁴ *See infra*, Section IV (Practice before the Board calls for Petitioner to arrange a conference with the panel and patent owner within 5 days of joinder motion).

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020)

(precedential, designated May 5, 2020) (“*Fintiv I*”); *Apple Inc. v. Fintiv, Inc.*,

IPR2020-0019, Paper 15 at 7-8 (PTAB May 13, 2020 (decision denying institution

of inter partes review) (“*Fintiv II*”). Further, Acting Director Stewart set forth

additional factors relevant to discretionary denial, such as “the extent of the

petition’s reliance on expert testimony,” “settled expectations of the parties, such

as the length of time the claims have been in force,” and “compelling economic,

public health, or national security interests.” *See* Stewart Memo, at 2 (Ex. 2001).

The *Fintiv* factors and these additional factors from the Stewart Memo weigh

against institution and joinder.

A. Factor 1 – No Stay Has Been Entered In The District Court and There Is No Evidence A Stay Will Be Granted.

Petitioner has not asked for a stay pending *inter partes* review, and there is no evidence that Judge Albright would grant a stay even if an IPR were instituted.

To the contrary, Judge Albright has made it clear that he will not stay a case where, as here, the court can resolve the case as quickly as the Board can:

[T]here’s no unfairness to either side by not staying a case for the PTAB when I can try the case as quickly as they can resolve it....
And so far, I think that’s proven to be true.

(Ex. 2004). Indeed, “Judge Albright almost never stays proceedings to let the

PTAB make its decision first.” *Id.* at 2.

Judge Albright's prior decisions on opposed motions to stay pending IPR indicate that a stay would be denied. The district court action has progressed through fact discovery, with expert discovery and pre-trial tasks upcoming. Any request for a stay would likely be denied as it would ignore, at least, the advanced state of the proceedings. *Multimedia Content Mgmt. LLC v. Dish Network Corp.*, No. 6:18-cv-00207-ADA, 2019 U.S. Dist. LEXIS 198875, at *2 (W.D. Tex. Jan. 10, 2019) (denying defendant's motion to stay and finding that a stay would prejudice the plaintiff, ignore the advanced state of the proceedings, and fail to simplify the issues). Here, with 29 Challenged Claims, the likelihood that the district court issues would be simplified through invalidation of every Challenged Claim is low. *See Sonrai Memory Ltd. v. Micron Tech., Inc.*, 1:23-cv-01407-ADA, 2024 U.S. Dist. LEXIS 231280, at *10 (May 29, 2024) (denying defendant's motion to stay and finding, in part, that a stay would not simplify the issues because defendant cannot show the "PTAB is likely to invalidate every asserted claim.").

The Board has found Factor 1 to favor discretionary denial where (as here), "Petitioner present[ed] no evidence that it has requested a stay [] or that a stay is likely." *Luxshare Precision Industry v. Amphenol Corp.*, IPR2022-00132, Paper 10, at 9 (PTAB May 3, 2022). And such a decision is particularly appropriate

where the circumstances show that “a stay ... is unlikely” as here, in light of the advanced stage of the proceedings and the low likelihood that a stay would simplify the issues. *Nintendo Co. v. Gamevice, Inc.*, IPR2020-01197, Paper 13, at 11-12 (PTAB Jan. 12, 2021). As such, Factor 1 favors discretionary denial.

B. Factor 2 – Trial In the District Court Is Currently Expected Before The Statutory Deadline, And Even If Joined to TI's IPR, The Statutory Deadline Is Likely To Be Extended Beyond District Court Trial.

Factor 2 weighs in favor of discretionary denial when considering the implications of the district court and IPR schedules. “If a district court’s trial date is earlier than the Board’s projected statutory deadline for a final written decision, the Board generally has weighed this fact in favor of exercising discretion to deny institution.” *T-Mobile USA, Inc., et al., v. Wireless Alliance*, IPR2024-00608, Paper 16 (PTAB Sept. 3, 2024) (exercising discretion to deny institution of *inter partes* review). Petitioner filed the present petition on December 24, 2024, and as a stand alone petition, the Board’s final written decision would not be due until at least May 2026, well after the currently scheduled trial date of November 14, 2025. (Ex. 2005).

Even if Realtek’s Petition is joined to TI’s IPR, the Final Written Decision (“FWD”) would not be issued until almost two weeks after trial is scheduled in the district court proceeding. And even if the district court amends the current

scheduling order,⁵ a FWD is not guaranteed before trial due to the likely extension of the FWD. 35 U.S.C. § 316(a)(11) (“The Director may, for good cause shown, extend the 1-year period by not more than 6 months, and may adjust the time periods in this paragraph in the case of joinder under section 315(c)[.]”); *see also* IPR2024-00936. Joining Realtek to TI’s IPR makes the FWD especially vulnerable to a six-month extension, which would place the FWD date at May 26, 2026. This is well after trial is likely to occur in the district court proceeding. In light of the uncertainty of the relative timing of the expected FWD in the event of joinder and the trial date in the district court, this factor is, at best, neutral.

C. Factor 3 – The Parties Have Invested Significant Resources In The Parallel Proceedings.

Factor 3 relates to the “amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv I* at 9. For example, if “the district court has issued substantive orders related to the patent at issue in the petition,” this favors denial. *T-Mobile*, IPR2024-00608, Paper 16 at 9-10. “Claim construction orders” entered by the

⁵ Trial in the second litigation involving ParkerVision and Realtek has been moved to January 12, 2026 due to a Court conflict.

district court “indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial.” *Id.* at 10.

Both the parties and the district court have invested significant resources in the parallel proceedings over nearly 24 months since its filing. Claim construction is already complete, the Markman hearing was held on June 14, 2024 (Ex. 2006), and the Court issued its claim construction order on October 21, 2024. (Ex. 2007). Fact discovery is currently set to close in under 1 month from the date of this brief, expert discovery is set to close by August 11, 2025, and dispositive motions are due by August 29, 2025—all of which are well before November 26, 2025, the earliest FWD in the TI IPR. (Ex. 2005).

Petitioner ignores that the parties and district court have invested significant time and resources in the litigation. This factor favors discretionary denial. *Fintiv I* at 10; *Fintiv II* at 13-14 (finding “the level of investment and effort already expended on claim construction and invalidity contentions” favored denial).

D. Factor 4 – The Issues Overlap.

Factor 4 looks at “whether all or some of the claims challenged in the petition are also at issue in district court,” and whether the “petition includes the same or substantially the same claims, grounds, arguments, and evidence” as the parallel district court case. *Fintiv I* at 12-13.

The overlap between the issues raised in the instant IPR Petition and in the parallel district court litigation is substantial. The Petition alleges invalidity of the same claims asserted in the district court litigation, and bases its grounds on common references as in the district court proceeding.

Grounds 1 and 2 of this Petition rely on the Tayloe, TI Demux Datasheet, and Razavi references, which Petitioner also cites, along with others, in the co-pending district court litigation. As the Board previously noted, “Petitioner’s assertion of additional invalidity contentions in the District Court is not relevant to the question of the degree of overlap for this factor. Further, the fact that Petitioner has not decided whether to pursue the art from this proceeding in its expert discovery or at trial in the District Court is not persuasive.” *Fintiv II* at 14-15. Ultimately, as the Board recognized in *Supercell*, under *Fintiv*, “if the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial” because “concerns of inefficiency and the possibility of conflicting decisions [are] particularly strong.” *Supercell Oy v. Gree, Inc.*, IPR2020-00513, Paper 11 at 13 (PTAB June 24, 2020). That is exactly the case here—there is substantial overlap in the invalidity grounds of the Realtek Petition and the references in its invalidity arguments in the district court proceeding.

Relying on the USPTO Memorandum, *Interim Procedure for Discretionary Denials* (June 21, 2022), Petitioner alleges that it has “eliminated any risk of duplicated effort by voluntarily presenting a *Sotera* stipulation to Patent Owner.” Pet., 88. Not so. First, the June 21, 2022 Memorandum cited by Petitioner has been rescinded. *See* Stewart Memo; *See also* (Ex. 2008). Second, Petitioner stipulates that if the Board “institutes IPR for the ’528 patent *based on the petition by Realtek*, and *only while any IPR from this petition* is pending, Realtek will not pursue in Case No. 6-23-cv-00374 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) (emphasis added). Petitioner does not mention the additional invalidity arguments it is making in the district court proceeding. So, the stipulation is unclear as to its effect on the invalidity arguments that do not expressly overlap. And Petitioner seeks party joinder to the identical TI IPR if the TI IPR is instituted. Paper 3. If Petitioner becomes a joint party in the TI IPR (i.e., from a different petition), 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. For at least these reasons, Petitioner’s stipulation should not be regarded as dispositive.

Thus, Factor 4 also supports denial.

E. Factor 5 – Both Parties Are Parties In The Parallel Litigation.

There is no dispute that ParkerVision and Realtek are the same parties in the district court litigation. As such, Petitioner must concede that this factor favors denial of institution. *See Fintiv II* at 15 (“Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.”)

F. Factor 6 – The Petition Does Not Present Compelling Evidence of Unpatentability.

Factor 6, the merits of the petition, weigh against institution because, as detailed in Patent Owner's Response to the TI Petition on the same grounds, the petition fails to show a reasonable likelihood that Petitioner will prevail on any challenged claim. *See* IPR2024-00936, Paper 22.⁶ Since Petitioner filed the instant “copycat” or “follow on” petition on the same grounds as the TI Petition, discovery has begun in that IPR with depositions of Petitioner's expert, along with additional information that has come to light. The new information, which was not a part of the record during the institution decision of IPR2024-00936 (Paper 9), renders the success of the petition unlikely.

⁶ The Patent Owner Preliminary Response will address the merits of the Petition in further detail.

For example, the Tayloe reference cited by Petitioner is not prior art because ParkerVision conceived and reduced the claimed invention to practice several months before Tayloe. *See* IPR2024-00936, Paper 22. Additionally, as ParkerVision will provide further detail relating to the strength of Realtek's Petition in its Patent Owner Preliminary Response, there is no motivation to combine the cited references as Petitioner has done.

Certainly, the petition does not pass the higher threshold of a "compelling" unpatentability challenge, which requires a determination that Petitioner is "highly likely" to succeed on the merits. *Commscope Techs. v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23, 3-4 *PTAB Feb. 27, 2023). As such, Petitioner fails to demonstrate the challenged claims are invalid. Even if the unpatentability challenge is compelling, the March 24, 2025 Memorandum from Scott R. Boalick, Chief Administrative Patent Judge, titled Guidance on USPTO's rescission of "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation" states "compelling merits alone is not dispositive in making the assessment [for discretionary denial]." (Ex. 2008).

IV. ADDITIONAL FACTORS SET FORTH IN THE STEWART MEMO SUPPORT DISCRETIONARY DENIAL

Beyond the established *Fintiv* factors, the Stewart Memo clarifies that the Director may weigh additional considerations relevant to fairness and efficiency. Several such considerations further support denying institution and joinder here.

A. Additional Factor 1 – Patent Expiration and Efficient Resource Allocation.

The Stewart Memo also explicitly states that factors impacting the efficient use of PTAB resources and overall workload management should be considered. Proceeding with an IPR that will occur post-expiration of the patent at issue, as here (the '528 patent expired October 21, 2018), is an inefficient use of the Board's and the parties' resources.

While the Board has jurisdiction to do so in its discretion, committing substantial Board resources that are admittedly finite in nature to adjudicate the validity of an expired patent is contrary to the goals of PTAB efficiency, especially when the same validity challenges are concurrently proceeding in district court. This is sufficient for discretionary denial.

B. Additional Factor 2 – Petitioner's Gamesmanship and Undue Delay and Gamesmanship.

Several other factors impacting the efficiency of PTAB resources and representing potential abuse of the IPR process also present here.

First, as a threshold matter, Realtek's Petition is time-barred pursuant to 35 U.S.C. § 315(b), absent joinder. "When an otherwise time-barred petitioner requests same party and/or issue joinder, the Board may exercise its discretion to permit joinder, but will do so only where fairness requires it and to avoid undue prejudice to a party. *See* Patent Trial and Appeal Board Consolidated Trial Practice Guide (November 2019) ("CTPG") at 76-77 (citing *Proppant Express Investments, LLC, et al., v. Oren Technologies, LLC*, IPR2018-00914, Paper 38 at 4, 19 (PTAB Mar. 13, 2019) (Precedential, de-designated Jul. 24, 2023). Exercising discretion to permit joinder of an otherwise time-barred petitioner should proceed "only in extremely limited circumstances." *Id.* Such circumstances for the "narrow exercise of discretion to permit such joinder may include . . . certain actions taken by a patent owner in a co-pending litigation such as certain late additions of newly asserted claims[]" and "conduct of the parties and attempts to game the system[.]" *Id.* None of these circumstances are present here.

The Board in *Proppant* explained "[t]he one-year time limitation of § 315(b) is important to ensure 'quiet title to patent owners' and to prevent inter partes review from being 'used as a tool for harassment[.]'" *Proppant*, IPR2018-00914, Paper 38 at 18 (quoting H.R. Rep. No. 112098, pt. 1, at 48 (Jun. 1, 2011). Indeed, the Board noted that widely utilizing discretion to permit joinder of an otherwise

time-barred petitioner “could effectively circumvent the time limitation in § 315(b) in many cases.” *Id*; *see also* TPG at 77 (“The conduct of the parties and attempts to game the system may also be considered”).

Tellingly, consideration of these factors is wholly absent from Realtek's motion. First, Realtek had ample opportunity to file a petition challenging validity of the '528 patent within the permitted statutory timeframe—but chose not to. Even presuming Realtek had no knowledge that Texas Instruments was preparing a petition to challenge the '528 patent, Realtek had actual knowledge of the asserted prior art grounds it relies on since at least May 18, 2024 when Texas Instruments filed its petition – ***more than four months*** in advance of its own one-year statutory deadline. Texas Instruments had no problem timely petitioning this Board with the asserted prior art grounds. NXP had no problem timely petitioning this Board with its “me-too” petition and conditional joinder motion. Yet Realtek, despite its months lead time, was unable to timely file its own copycat petition.

These circumstances alone carry enough weight to deny Realtek's joinder motion, and thus institution. Failing to timely file is not a simple mistake or omission of Realtek, nor was it a result of ParkerVision adding certain late additions of newly asserted claims in any of the co-pending district court litigation involving the '528 patent. Indeed, it is an apparent attempt to “game the system”

with a collateral attack on ParkerVision, relying on Texas Instruments to do its work.

Other attempts to “game the system” are apparent in Petitioner’s conduct, which stymie the Board’s efforts to increase efficiency and reflect potential for abuse of process. For example, Realtek failed to arrange a conference call with the panel, petitioner, and patent owner *within five business days* after filing its petition and joinder motion on December 24, 2024, a USPTO-observed federal holiday. CTPG at 76. Such gamesmanship results in unfairness to not only ParkerVision, but also to the other interested parties, the district court with respect to parallel litigation, and importantly, this Board’s efforts to increase judicial efficiency.

The facts here may seem inconsequential if viewed in isolation, but the facts do not exist in a vacuum, nor should they be viewed in one. Indeed, the facts viewed together, reveal the true theme overarching the instant Motion and Petition - Realtek’s attempt to back-door its way into challenging the validity of the ’528 patent via joinder to avoid the clear time limitation in § 315(b). This is precisely a scenario where the Board’s discretion should be exercised to deny joinder, and thus institution. *Proppant*, IPR2018-00914, Paper 38 at 20 (stating “[b]ecause Petitioner’s own conduct created the need for it to request joinder, this case does not involve one of the limited circumstances in which the Board will exercise its

discretion to allow . . . joinder[]” and “allowing joinder in cases such as this could effectively vitiate the time limitation of § 315(b)”); *see also Micro Motion, Inc. v. Invensys Sys.*, IPR2014-01409, Paper 14 at 15 (PTAB Feb. 18, 2015) (when movant’s separate petition “is admittedly time-barred under 25 U.S.C. § 315(b),” it “weighs against joinder”).

The foregoing factors weigh in favor of discretionary denial.

V. INSTITUTION SHOULD BE DENIED UNDER *GENERAL PLASTIC*

The Board has discretion to deny “follow on” petitions. *General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB, Sept. 6, 2017) (precedential). The Board has listed seven factors for determining whether discretionary denial is appropriate (the “*General Plastic* factors”):

1. whether the same petitioner previously filed a petition directed to the same claims of the patent;
2. whether the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review of the first petition;
4. the length of time that elapsed between the time the petitioner learned of prior art asserted in the second petition and the filing of the second petition;

5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. the finite resources of the Board; and
7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

General Plastic Indus. Co., IPR2016-01357, Paper 19 at 16. Here, *General Plastic* factors 5-7 apply and weigh against joinder.⁷

Factor 5 weighs against joinder because Petitioner did not provide an adequate, or any, explanation for the time elapsed between the Texas Instruments and NXP petitions and the filing of its Petition and directed to the same claims of the same patent. *See also supra*, Section IV.

Notwithstanding Petitioner's understudy role, in the event of a settlement with Texas Instruments, Petitioner would be able to continue the proceeding that would otherwise be terminated. As the Board noted, this possibility is relevant to Factor 6. *See T-Mobile USA, Inc. v. VoIP-Pal.com, Inc.*, IPR2023-00638, Paper 11, at 11-13 (PTAB, July 28, 2023); *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854,

⁷ Factors 1 through 4 relate to successive petitions filed by the same petitioner, so, are not relevant here.

Paper 9 (PTAB Oct. 28, 2020). So, Factor 6 also weighs against institution and joinder.

Factor 7 weighs against institution and joinder because, as stated *supra* at Section IV., Petitioner failed to timely arrange a conference call with the panel, Patent Owner, and the TI IPR petitioner so that the panel can “timely manage the proceedings.” *See* CPTG at 76. Petitioner's failure here adversely impacts the Board's ability to meet the one-year statutory deadline.

Thus, Factors 5 – 7 weigh against institution and joinder. These factors are also relevant to quasi proposed Factor 8:

8. the extent to which the petitioner and any prior petitioner(s) were similarly situated defendants or otherwise realized a similar-in-time hazard regarding the challenged patent.

See Shenzhen Silver Star Intelligent Tech. Co., Ltd. v. iRobot Corp., IPR2018-00898, Paper 9 at 7 (PTAB Oct. 1, 2018) (quoting *Shenzhen Silver Star Intelligent Technology Co., Ltd. v. iRobot Corp.*, IPR2018-00761, Paper 15, 18 (PTAB Sept. 5, 2018) (Saindon, concurring)). Factor 8 is intended to discourage tactical filing of petitions over time by parties facing similar threats during the same time. *Id.* at 13-14.

Likewise, Petitioner here, Texas Instruments, and NXP are co-defendants who faced similar-in-time hazard pertaining to the '528 patent. *See also supra*,

Section I, Section IV. While TI and NXP filed timely petitions, Realtek's petition wasn't filed until after months after its time barred date and after having the benefit of the institution decisions in the TI IPR and NXP IPR. This suggests the Petitioners' attempt to secure tactical advantage. Accordingly, this factor weighs against institution and joinder.

VI. CONCLUSION

For at least the foregoing reasons, Patent Owner respectfully requests that the Board deny institution of the Petition and of Petitioner's Motion for Joinder to IPR2024-00936.

Dated: April 28, 2025

Respectfully submitted,

By: /Jason S. Charkow/

Jason S. Charkow (USPTO Reg. No. 46,418)*

Richard Juang (USPTO Reg. No. 71,478)*

Chandran B. Iyer (USPTO Reg. No. 48,434)

Ronald M Daignault*

jason.s.charkow@gmail.com

richard.juang@gmail.com

cbiyer@daignaultiyer.com

rdaignault@daignaultiyer.com

DAIGNAULT IYER LLP

8229 Boone Boulevard

Suite 450

Vienna, VA 22182

**Not admitted in Virginia*

Attorneys for ParkerVision, Inc.

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that this Opposition to Petitioner's Motion for Joinder complies with the type-volume limitation of 37 C.F.R. § 42.24(b) because it contains 5371 words, as determined by the word-processing program used to prepare the brief, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a)(1).

Respectfully submitted,

By: /Jason S. Charkow/
Jason S. Charkow
USPTO Reg. No. 46,418

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **PATENT OWNER'S BRIEF IN SUPPORT OF DISCRETIONARY DENIAL AND OPPOSITION TO PETITIONER'S MOTION FOR JOINDER**, together with all exhibits filed therewith, was served in its entirety by filing these documents through the PTAB E2E System, as well as by email on the following counsel of record for Petitioner:

Jeffrey Johnson
Parker Hancock
Baker Botts L.L.P.
Jeffrey.johnson@bakerbotts.com
Parker.hancock@bakerbots.com

Steve Baik
White Hat Legal
sbaik@whitehat.legal

A courtesy copy is also being forwarded to Petitioner's Litigation Counsel via electronic mail to:

Jeffrey Johnson
Lisa Nguyen
Grace Wang
Mark Siegmund
Paul Hastings LLP
jeffrey.johnson@bakerbotts.com
lisanguyen@paulhastings.com
gracewang@paulhastings.com
msiegmund@cjsjlaw.com
ph-rltk-pv-ii@paulhastings.com

IPR2025-00325 (U.S. Patent No. 9,118,528)

Patent Owner's Brief In Support of Discretionary Denial and Opposition to Motion
for Joinder

Dated: April 28, 2025

Respectfully Submitted,

By: /Jason S. Charkow/
Jason S. Charkow
USPTO Reg. No. 46,418