

**UNITED STATES DISTRICT COURT
MIDDLE DISTRICT OF FLORIDA
JACKSONVILLE DIVISION**

PARKERVISION, INC.,

Plaintiff,

v.

QUALCOMM INCORPORATED,

Defendant.

QUALCOMM INCORPORATED,

Case No. 3:11-cv-719-J-37TEM

Counterclaim Plaintiff,

v.

PARKERVISION, INC., AND STERNE,
KESSLER, GOLDSTEIN, & FOX PLLC,

Counterclaim Defendants.

**PLAINTIFF PARKERVISION INC.'S MOTION
FOR LEAVE TO FILE ITS FIRST AMENDED COMPLAINT**

Pursuant to Fed. R. Civ. P.15(a), Plaintiff ParkerVision, Inc. ("ParkerVision") respectfully requests leave to file its First Amended Complaint. ParkerVision's proposed First Amended Complaint is attached as Exhibit A.

I. INTRODUCTION

On July 20, 2011, ParkerVision filed a Complaint with the Court alleging that Qualcomm, Inc. ("Qualcomm") infringed and continues to infringe seven patents owned by ParkerVision. *See* Dkt. No. 1. On January 30, 2012, ParkerVision served Qualcomm with its infringement contentions. Among other things, these infringement contentions: (i) disclose the

specific claim terms that Qualcomm infringes; and (ii) identify what, within Qualcomm's products, meets the claim limitations for the asserted claim. In the course of preparing and finalizing these infringement contentions, ParkerVision reassessed the claims of two patents in its original complaint—U.S. Patent Nos. 7,515,896 and 7,822,401—and ultimately decided not to disclose infringement contentions for the claims in those patents. Similarly, ParkerVision reassessed the claims of a patent not listed in its Original Complaint—U.S. Patent No. 6,963,734—and decided to disclose infringement contentions for certain claims in it. Additionally, ParkerVision's infringement contentions disclose the model numbers of Qualcomm's products believed to infringe the asserted claims. In doing so, ParkerVision identified more products than were explicitly identified by model number in its Original Complaint.

The purpose of this motion is simply to bring ParkerVision's complaint in line with the infringement contentions that it has recently served on Qualcomm. As such, ParkerVision seeks to file the attached First Amended Complaint that: (i) substitutes U.S. Patent No. 6,963,734 for U.S. Patent Nos. 7,515,896 and 7,822,401; and (ii) clarifies that the two products identified in its first Original Complaint are merely two examples of Qualcomm's products that contain infringing technology.

II. ARGUMENT

Under Rule 15(a) of the Federal Rules of Civil Procedure, a party may amend its pleading as a matter of course before being served with a responsive pleading or up to twenty-one days after serving the pleading if a responsive pleading is not allowed and the action is not yet on the trial calendar. Fed. R. Civ. P. 15(a)(1). Otherwise, the party must seek leave of court or written consent of the adverse party in order to amend the pleading under Fed. R. Civ. P. 15(a)(2). "The decision whether to grant leave to amend a complaint is within the sole discretion of the district

court.” *Laurie v. Ala. Crim. App.*, 256 F.3d 1266, 1274 (11th Cir. 2001). A timely motion for leave, however, is held to “a very liberal standard,” and leave to amend should be freely given when justice so requires. *See Senger Brothers Nursery, Inc. v. E.I. Dupont De Nemours & Co.*, 184 F.R.D. 674, 678 (M.D. Fla. 1999). In this way, Rule 15(a) defines a court’s discretion and requires a court to provide a “justifying reason” for denying leave. *See Foman v. Davis*, 371 U.S. 178, 182 (1962). “Substantial reasons justifying a denial include ‘undue delay, bad faith, dilatory motive on the part of the movant, . . . undue prejudice to the opposing party by virtue of allowance of the amendment [and] futility of allowance of the amendment.’” *See Laurie*, 256 F.3d at 1274 (citing *Foman*, 371 U.S. at 182).

There is no undue delay, bad faith, or dilatory motive of ParkerVision’s part. Regarding the new patent, Qualcomm received ParkerVision’s infringement contentions for the ’734 patent at the same time that it received ParkerVision’s infringement contentions for the other asserted patents. In other words, Qualcomm received infringement contentions for the ’734 patent as if it had been identified in ParkerVision’s Original Complaint. Regarding the clarification of the infringing products, the Original Complaint already accuses Qualcomm’s products that “contain direct conversion receiver technology.” *See* Dkt. No. 1 at ¶ 11. ParkerVision’s proposed, First Amended Complaint simply makes clear that the two model numbers explicitly listed are just two examples of Qualcomm’s accused products. Also, there is no undue prejudice to Qualcomm in these amendments. Discovery in this case has just begun, and the Court has not yet entered a Case Management Report. If the Court accepts the parties’ proposed trial date, trial would be roughly 18 months away. Finally, these amendments are in no way futile. There was no pleading defect in ParkerVision’s Original Complaint, and ParkerVision’s proposed First

Amended Complaint similarly meets the pleading requirements. In sum, there is no substantial reason for denying ParkerVision's motion for leave.¹

III. CONCLUSION

For the foregoing reasons, ParkerVision respectfully requests that the Court grant its motion and give ParkerVision leave to file its First Amended Complaint.

¹ ParkerVision notes that Rule 15—not Rule 16—controls because ParkerVision is seeking leave before the Court has entered a Case Management Report. ParkerVision notes that it meets the “good cause” standard of Rule 16(b). The patents-in-suit cover very complex technology, and ParkerVision was diligent in ascertaining the claims that Qualcomm's products infringe. Also, Qualcomm received ParkerVision's infringement contentions on the date the parties agreed. In this way, ParkerVision was just as diligent in disclosing its thorough infringement contentions for the '734 patent as it was for the patents identified in ParkerVision's Original Complaint.

February 3, 2012

Respectfully submitted,

McKOOL SMITH, P.C.

/s/ Douglas A. Cawley

Douglas A. Cawley, Lead Attorney

Texas State Bar No. 04035500

E-mail: dcawley@mckoolsmith.com

John Austin Curry

Texas State Bar No. 24059636

E-mail: acurry@mckoolsmith.com

McKool Smith P.C.

300 Crescent Court, Suite 1500

Dallas, Texas 75201

Telephone: (214) 978-4000

Telecopier: (214) 978-4044

T. Gordon White

Texas State Bar No. 21333000

gwhite@mckoolsmith.com

McKool Smith P.C.

300 West Sixth Street, Suite 1700

Austin, Texas 78701

Telephone: (512) 692-8700

Telecopier: (512) 692-8744

SMITH HULSEY & BUSEY

/s/ James A. Bolling

Stephen D. Busey

James A. Bolling

Florida Bar Number 117790

Florida Bar Number 901253

225 Water Street, Suite 1800

Jacksonville, Florida 32202

(904) 359-7700

(904) 359-7708 (facsimile)

jbolling@smithhulsey.com

ATTORNEYS FOR PLAINTIFF

PARKERVISION, INC.

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on this day, February 3, 2012, I electronically filed the foregoing with the Clerk of the Court by using the CM/ECF system which will send a notice of electronic filing to all counsel of record.

/s/ Austin Curry

John Austin Curry

CERTIFICATE OF COUNSEL

I HEREBY CERTIFY that, on January 31, 2012, counsel for ParkerVision conferred with counsel for Qualcomm in a good faith effort to resolve the issue raised by the motion.

ParkerVision specifically requested Qualcomm's definitive position as to whether or not it opposes the relief sought in this motion, but as of the time of filing this motion, Qualcomm has not given its position. As such, ParkerVision must assume that Qualcomm opposes this motion. Pursuant to Local Rule 3.01(g), counsel for ParkerVision will continue to engage counsel for Qualcomm in an effort to resolve this motion. Sterne Kessler Goldstein & Fox PLLC does not oppose this motion.

/s/ Austin Curry

John Austin Curry

EXHIBIT A

**UNITED STATES DISTRICT COURT
MIDDLE DISTRICT OF FLORIDA
JACKSONVILLE DIVISION**

PARKERVISION, INC.,

Plaintiff,

v.

QUALCOMM INCORPORATED,

Defendant.

CASE NO.: 3:11-cv-719-J-37-TEM

QUALCOMM INCORPORATED,

Counterclaim Plaintiff,

PARKERVISION, INC. and
STERNE, KESSLER, GOLDSTEIN & FOX
PLLC,

Counterclaim Defendants.

FIRST AMENDED COMPLAINT FOR PATENT INFRINGEMENT

Plaintiff, ParkerVision, Inc. (“ParkerVision”), sues defendant, QUALCOMM Incorporated (“QUALCOMM”), and alleges:

1. ParkerVision seeks damages and injunctive relief against QUALCOMM for QUALCOMM’S infringement of ParkerVision’s patents (the “Patents-in-Suit”).
2. The Patents-in-Suit are important to ParkerVision because they permit ParkerVision to differentiate its technology from that of its competitors.
3. ParkerVision is a Florida corporation with its principal place of business at 7915 Baymeadows Way, Jacksonville, Florida 32256.

4. QUALCOMM is a Delaware corporation with its principal place of business at 5775 Morehouse Drive, San Diego, California 92121. QUALCOMM conducts business throughout the United States, including the Middle District of Florida.

5. QUALCOMM infringes ParkerVision’s patents throughout the United States, including the Middle District of Florida.

6. This is an action arising under the patent laws of the United States. This Court has jurisdiction over the subject matter of this action pursuant to 28 U.S.C. §§ 1331 and 1338(a).

7. This Court has in personal jurisdiction over QUALCOMM because QUALCOMM is subject to both general and specific jurisdiction in this state and the Middle District of Florida. Moreover, QUALCOMM regularly conducts, engages in or carries on a regular and established business or business venture in this state, and engages in substantial and not isolated activity within this state. QUALCOMM uses devices or systems, or performs methods, that infringe one or more claims of ParkerVision’s patents in Florida, causing injury in Florida.

8. Venue properly lies within this judicial district and division, pursuant to 28 U.S.C. §§ 1391(b) and (c) and 1400(b).

9. ParkerVision is the sole and exclusive owner of all rights, title and interest to the following valid and enforceable Patents-in-Suit:

| U.S. PATENT NO. | DATE ISSUED | TITLE |
|------------------------|--------------------|--|
| 6,061,551 | May 9, 2000 | Method and System for Down-Converting Electromagnetic Signals |
| 6,266,518 | July 24, 2001 | Method and System for Down-Converting Electromagnetic Signals by Sampling and Integrating Over Apertures |

| U.S. PATENT NO. | DATE ISSUED | TITLE |
|------------------------|--------------------|---|
| 6,370,371 | April 9, 2002 | Applications of Universal Frequency Translation |
| 6,963,734 | November 8, 2005 | Differential Frequency Down-Conversion Using Techniques of Universal Frequency Translation Technology |
| 7,496,342 | February 24, 2009 | Down-Converting Electromagnetic Signals, Including Controlled Discharge of Capacitors |
| 7,724,845 | May 25, 2010 | Method and System for Down-Converting and Electromagnetic Signal, and Transforms for Same |

10. ParkerVision owned the Patents-in Suit throughout the period of QUALCOMM's infringement and still owns the Patents-in-Suit. ParkerVision has not granted QUALCOMM a license to practice the Patents-in-Suit in the accused applications.

11. QUALCOMM has utilized and continues to utilize devices, systems or methods that infringe directly, by inducement and/or contributorily, one or more claims of the Patents-in-Suit. QUALCOMM is importing, making, using and/or selling integrated circuits that contain direct conversion receiver technology which infringes on the Patents-in-Suit. QUALCOMM'S infringing circuits include, as examples, the RTR6285 and the QSC6270 integrated circuits found in cellular telephones and mobile devices that are currently being sold in the United States, including the State of Florida.

12. QUALCOMM' acts of infringement have caused damage to ParkerVision, and ParkerVision is entitled to recover compensatory damages sustained as a result of QUALCOMM's wrongful acts. Unless enjoined by this Court, QUALCOMM will continue to infringe the Patents-in-Suit, continuing to damage ParkerVision and causing irreparable harm.

13. QUALCOMM lacks justifiable belief that there is no infringement, or that the infringed claims are invalid, and has acted with objective recklessness in its infringing

activity. QUALCOMM's infringement is therefore willful, and ParkerVision is entitled to an award of exemplary damages, attorneys' fees, and costs in bringing this action.

WHEREFORE, Plaintiff ParkerVision requests that this Court enter such preliminary and final orders and judgments as are necessary to provide ParkerVision with the following requested relief:

- A. a preliminary and then permanent injunction enjoining QUALCOMM from continuing to infringe each of the Patents-in-Suit;
- B. a judgment that QUALCOMM infringes one or more claims of the Patents-in-Suit;
- C. an award of damages against QUALCOMM under 35 U.S.C. § 284 in an amount adequate to compensate ParkerVision for QUALCOMM's infringement, but in no event less than a reasonable royalty for the use made by QUALCOMM of the inventions set forth in the Patents-in-Suit, together with pre-judgment interest;
- D. an award against QUALCOMM for exemplary damages, attorneys' fees, and costs under 35 U.S.C. § 285; and
- E. such other and further relief as this Court deems just and proper.

Jury Trial Request

ParkerVision requests a trial by jury as to all matters so triable.

February 3, 2012

Respectfully submitted,

McKOOL SMITH, P.C.

/s/ Douglas A. Cawley

Douglas A. Cawley, Lead Attorney

Texas State Bar No. 04035500

E-mail: dcawley@mckoolsmith.com

John Austin Curry

Texas State Bar No. 24059636

E-mail: acurry@mckoolsmith.com

McKool Smith P.C.

300 Crescent Court, Suite 1500

Dallas, Texas 75201

Telephone: (214) 978-4000

Telecopier: (214) 978-4044

T. Gordon White

Texas State Bar No. 21333000

gwhite@mckoolsmith.com

McKool Smith P.C.

300 West Sixth Street, Suite 1700

Austin, Texas 78701

Telephone: (512) 692-8700

Telecopier: (512) 692-8744

SMITH HULSEY & BUSEY

/s/ James A. Bolling

Stephen D. Busey

James A. Bolling

Florida Bar Number 117790

Florida Bar Number 901253

225 Water Street, Suite 1800

Jacksonville, Florida 32202

(904) 359-7700

(904) 359-7708 (facsimile)

jbolling@smithhulsey.com

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on this day, February 3, 2012, I electronically filed the foregoing with the Clerk of the Court by using the CM/ECF system which will send a notice of electronic filing to all counsel of record.

/s/ Austin Curry

John Austin Curry

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**ORDER GRANTING PLAINTIFF PARKERVISION INC.'S
MOTION FOR LEAVE TO FILE ITS FIRST AMENDED COMPLAINT**

Pursuant to Fed. R. Civ. P.15(a), Plaintiff ParkerVision Inc. moved the Court for leave to file its First Amended Complaint. Defendant Qualcomm opposed this motion. The Court finds no substantial reason for denying the motion. Accordingly, Plaintiff's First Amended Complaint, attached as Exhibit A of its motion, is hereby deemed to have been filed on the date Plaintiff filed its motion.