## IN THE UNITED STATES DISTRICT COURT FOR THE MIDDLE DISTRICT OF FLORIDA ORLANDO DIVISION

PARKERVISION, INC.

Plaintiff,

v.

QUALCOMM INCORPORATED, QUALCOMM ATHEROS, INC., HTC CORPORATION, HTC AMERICA, INC., SAMSUNG ELECTRONICS CO., LTD., SAMSUNG ELECTRONICS AMERICA, INC., and SAMSUNG TELECOMMUNICATIONS AMERICA, LLC CASE NO.: 6:14-CV-00687-PGB-KRS

Defendants.

# PLAINTIFF'S MEMORANDUM ADDRESSING ELECTION OF CLAIMS AND ACCUSED PRODUCTS

Pursuant to the Court's January 9, 2019 scheduling conference request, Plaintiff ParkerVision, Inc. ("ParkerVision") respectfully submits the following memorandum addressing its election of patents, claims, and Accused Products. *See* Dkt. 281.

## I. INTRODUCTION

Every patent and claim ParkerVision now proposes for election following the lifting of the three year stay jointly requested by the parties (resulting, in large part, from the Qualcomminstigated *Inter Partes Review* (IPR) proceedings) was: (1) asserted in ParkerVision's Amended Complaint; (2) asserted (with claim charts) in ParkerVision's January 2015 Infringement Contentions; (3) asserted (with claim charts) in ParkerVision's June 2015 Supplemental Infringement Contentions; (4) asserted throughout the Markman briefing process; and (5) asserted at the time of the Markman hearing. None of these patents or claims were dismissed or otherwise removed from this case by any Order of the Court. Accordingly, every patent and claim ParkerVision now proposes for election was "live" at the time the Court entered the jointly requested stay pending IPR.

As to the Accused Products ParkerVision proposes for election, those products were atissue at the time of the stay (*i.e.*, they were addressed in ParkerVision's January and June 2015 Infringement Contentions) or are new products released during the pendency of the three year stay. Accordingly, every Accused Product that ParkerVision now proposes for election was either "live" at the time the Court entered the jointly requested stay or was newly-introduced by Qualcomm during the pendency of that stay.

# II. PROPOSED ELECTION OF PATENTS, CLAIMS, AND ACCUSED PRODUCTS

ParkerVision has informed Qualcomm of its intent to elect the following patents and claims:

• '940 Patent (10 claims): 24, 25, 26, 331, 364, 365, 366, 368, 369, 373

- '372 Patent (17 claims): 88, 89, 90, 91, 92, 95, 96, 99, 100, 103, 104, 107, 108, 109, 110, 126, 127<sup>1</sup>
- '907 Patent (7 claims): 1, 2, 10, 13, 14, 15, 23
- '177 Patent (11 claims): 1, 2, 3, 5, 7, 8, 9, 10, 11, 12, 14

As the history of this case shows, ParkerVision has consistently asserted each of these patents and claims against Qualcomm since the beginning of this case. Each of these patents and claims were "live" at the time of the stay, and none were dismissed or otherwise removed from the purview of this case by any Order of the Court.<sup>2</sup>

As for Accused Products, ParkerVision intends to elect the following Accused Products

for each proposed-for-assertion claim of each proposed-for-assertion patent:

- '940 Patent and '372 Patent: The Accused Products at-issue at the time of the stay (*i.e.*, the Accused Products identified in ParkerVision's January and June 2015 Infringement Contentions), as well as new products released during the pendency of the stay.
- '907 Patent and '177 Patent: The *ParkerVision II* Accused Products at-issue at the time of the stay (*i.e.*, those identified in ParkerVision's January and June 2015 Infringement Contentions), as well as new products released during the pendency of the stay.

As the history of this case shows, ParkerVision has consistently accused each of the Accused Products (that were in existence at the time of the stay) of infringing each proposed-for-assertion claim of each proposed-for-assertion patent. None of the Accused Products were dismissed or otherwise removed from the purview of this case by any Order of the Court. Additionally, and as to new products introduced by Qualcomm during the three years this case was stayed, ParkerVision seeks leave to serve supplemental Infringement Contentions addressing the proposed patents, claims, and newly-introduced Accused Products.

<sup>&</sup>lt;sup>1</sup> As stated in correspondence received from Qualcomm's counsel, it does not object to the inclusion of claims 99, 100, 107, 108 and 127 of the '372 Patent. Ex. 1 at 1 (Brigham Email to Budwin, Jan. 16, 2019).

 $<sup>^{2}</sup>$  Attached hereto is a chart detailing the history of each of the proposed-for-assertion claims for each of the proposed-for-assertion patents from the filing of this case. Ex. 2.

## III. SUMMARY OF THE HISTORY OF THE CASE—INCLUDING THE PATENTS AND CLAIMS THAT PARKERVISION NOW PROPOSES FOR ELECTION

On May 2, 2014 ParkerVision filed its original Complaint asserting infringement allegations against Qualcomm related to seven patents, including the '940 and '372 Patents (two of the patents proposed for election now). Dkt. 1 at 2. A First Amended Complaint was filed by ParkerVision on August 21, 2014, asserting infringement allegations against Qualcomm related to four additional patents, including the '907 and '177 Patents (the other two patents proposed for election now). Dkt. 26 at 2.

In accordance with each party's agreement concerning the schedule in this case, Dkt. 84 at 2, and the Court's Case Management and Scheduling Order, Dkt. 92 at 2-3, on January 16, 2015 ParkerVision served Qualcomm with its Initial Disclosure of Asserted Claims and Infringement Contentions, including corresponding claim charts covering each of the '940, '372, '907, and '177 Patents (the four patents proposed for election now) and each claim identified above for each of these four patents. Ex. 3 at 2-3. Every patent and every claim that ParkerVision now proposes for election was included in its January 16, 2015 Infringement Contention Disclosures. *Id.* 

In an effort to streamline the case, on April 16, 2015 ParkerVision—not Qualcomm filed a Motion to Limit the Number of Asserted Patent Claims and Prior Art References for Claim Construction Briefing. Dkt. 112. Qualcomm opposed. Dkt. 127. And this Motion remained pending and unresolved at the time the stay was entered.

On June 9, 2015, and while its Motion to streamline the case was pending, ParkerVision served Qualcomm with Supplemental Infringement Contentions, delivering updated infringement contention claim charts that included, as before, each of the '940, '372, '907, and '177 Patents (the four patents proposed for election now) and each claim identified above for

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each of these four patents. See Ex. 4. Every patent and every claim that ParkerVision now proposes for election was also included in its June 9, 2015 Infringement Contention Disclosures. *Id.* 

ParkerVision filed its Claim Construction Brief on June 15, 2015, which included arguments for the disputed terms associated with the '940, '372, and '177 Patents—the '907 Patent likewise would have been addressed in the Claim Construction briefing, but there were no claim terms in dispute for that patent. Dkt. 148; *see also* Dkt. 124 (Joint Claim Construction Statement identifying "disputed terms"). Qualcomm thereafter filed its responsive brief addressing each of the disputed terms. Dkt. 171. The Court then held its Markman hearing on August 12, 2015. Dkt. 198. At the time of the August 12, 2015 Markman hearing, each of the '940, '372, '907, and '177 Patents, and each of the claims identified above for those patents, remained "live" in this case.

At the August 2015 Markman hearing, the Court also heard argument concerning ParkerVision's pending Motion to Limit Claims and Prior Art Assertions. Ex. 5 (Markman Tr. 214:14-21). Summarizing ParkerVision's stance on its proposal to streamline the case, ParkerVision's counsel stated as follows:

So as I understand it, the proposal is we would identify a *nonlimiting* list of terms to the defendants within, let's say, two weeks. And then within two or three weeks thereafter, they'll come back and say, here's the prior art that we'll focus on. And once we know that issue we can focus on that and then maybe have a follow-on hearing with Your Honor to figure out exactly where things stand?

*Id.* at 231:23 – 232:6 (emphasis added). The Court's responded:

Yes. If the defendants are being unreasonable with their number and they haven't moved at all and they can't justify a reason for that, then I will set limitation. As it stands right now, I don't want to arbitrarily pick numbers. I know judges can do that sometimes, and I don't think that's the right way to go.

*Id.* at 232:7-13. As set forth below, while ParkerVision moved forward with this proposal by proposing a "nonlimiting" set of patents and claims, Qualcomm never meaningfully reciprocated, and the case was stayed before the parties reached any agreement on case narrowing (and before the Court entered any Order ruling on ParkerVision's Motion to Limit Claims and Prior Art Assertions or otherwise entered an Order "setting a limitation" regarding asserted patents, claims, or prior art).

On September 25, 2015, ParkerVision filed a Motion to Sever and Stay the Asserted Receiver Patents and Claims, including the '907 and '177 Patents (but not the '940 and '372 Patents). Dkt. 218. The reason for the request related to the ongoing *ParkerVision I* appeal, and its potential to effect this action. *Id.* at 1-3. Now that the *ParkerVision I* appeal has concluded, ParkerVision's wishes to "unstay" the '907 and '177 Patents and have them addressed as part of this case along with the '940 and '372 Patents.<sup>3</sup>

On October 6, 2015—as discussed at the Markman hearing and while its Motion to streamline the case remained pending—ParkerVision identified in written correspondence its initial "nonlimiting" identification of patents and claims that it then intended to move forward with, subject to Qualcomm's reciprocation in limiting its prior art assertions as discussed at the Markman hearing. Ex. 6. ParkerVision's correspondence proposed a "nonlimiting" identification of claims including:

<sup>&</sup>lt;sup>3</sup> In its Motion, ParkerVision stated that if the non-infringement holding in *ParkerVision I* survived the appeal process (which it did), "then ParkerVision is amenable to dropping its infringement claims with respect to the Receiver Patents and Claims and the subset of Accused Products that were also at issue in *ParkerVision I* (leaving the Samsung transceiver products and new *ParkerVision II* Accused Products to be addressed)." Dkt. 218 at 7. After this representation was made, the Samsung defendants were dismissed from this case. Dkt. 256 (Order dismissing Samsung without prejudice, July 25, 2016). Consistent with this representation, ParkerVision will assert the '177 and '907 Patents only against the *ParkerVision II* Accused Products that were not at issue in *ParkerVision I* (as well as newly-released Qualcomm products that were not at-issue in *ParkerVision I* and that were released by Qualcomm during the pendency of the stay).

- claims 1, 2, 18, 86, 93, 94, and 264 of the '940 Patent (apparatus claims that did not survive IPR, as opposed to the now proposed method claims that survived IPR);
- claims 99, 100, 107, 108, and 127 of the '372 Patent (the IPR as to this patent was not instituted and because these claims were included in this "nonlimiting" identification Qualcomm does not object to the election of these claims);
- claims 1, 10, 13, 14, and 23 of the '907 Patent; and
- claims 1, 5, 7, and 12 of the '177 Patent.

*Id.* at 1. As part of its proposed "nonlimiting" identification of claims, ParkerVision was explicit that:

This election, made in accordance with the Court's discussion during the Claim Construction hearing regarding ParkerVision's Motion to Limit, is made without prejudice, and ParkerVision expressly reserves all rights in the unelected claims, including with respect to assertion against the Defendants [*e.g.*, in the event that the Qualcomm did not uphold its "end of the bargain" by agreeing to limit its prior art assertions].

*See id.* Following its proposed "nonlimiting" October identification and reservation of rights, ParkerVision served Qualcomm with Supplemental Infringement Contentions, adding additional evidence in support of the previously disclosed infringement contention theories, but did so only for the subset of patents and claims identified in this "nonlimiting" election.

On November 9, 2015, Qualcomm responded by conditionally stating that "Defendants note that they do not anticipate using the following [fourteen references] as primary references" and "Defendants note that they do not currently anticipate using [eight other references] subject to review after the Court issues its claim construction decision and ParkerVision serves its expert report." Ex. 7 (Teter Letter to Budwin, Nov. 9, 2015). This proposed reduction represented approximately 2% of the 350 primary references (not to mention the thousands of "live" obviousness combinations) that Qualcomm was asserting in its invalidity contentions. Qualcomm's proposal represented precisely the type of unreasonable reduction in prior art assertions that ParkerVision was concerned about. Given its apprehension about Qualcomm's

good faith in making a meaningful reduction in its prior art assertions—and as the Court recognized in its comment at the Markman hearing (warning the Defendants not to "be[] unreasonable with their number")—is precisely why ParkerVision proposed a *nonlimiting* set of proposed claims and reserved all rights in the continued assertion of any unelected claims if agreement was not reached. No agreement (and no Order from the Court ratifying any such agreement or otherwise ruling on ParkerVision's Motion to streamline the case) was reached before the case was stayed.

On November 23, 2015, ParkerVision made a second proposed "nonlimiting" identification of patents and claims, again subject to the same conditions expressed in its earlier correspondence. Ex. 8 at 1. Relevant to this memorandum, this second proposed identification included a subset of the claims identified in the October election for the '940, '372, '907, and '177 Patents. *Id.* at 1-2. Specifically, ParkerVision's identified claims were claims 1, 2, 18, 94, and 264 of the '940 Patent, claims 99, 100, 107, 108, and 127 of the '372 Patent, claims 1, 10, 13, 14, and 23 of the '907 Patent, and claims 1, 5, 7, and 12 of the '177 Patent. *Id.* Following its November identification, ParkerVision again served Qualcomm with Supplemental Infringement Contentions, adding additional evidence in support of the previously disclosed contention theories, but did so only for the subset of patents and claims identified in this second "nonlimiting" identification.

On December 2, 2015 a third proposed "nonlimiting" identification was made by ParkerVision, again subject to the same conditions and reservations expressed in its earlier correspondence. Ex. 9 at 1. Relevant to the patents at issue in this memorandum, this third "nonlimiting" identification made no changes to the November election. *Id.* 

The following day, on December 3, 2015, the parties filed a Joint Motion to Dismiss Certain Claims and Covenant Not To Sue, formally requesting that the Court dismiss ParkerVision's claims for relief with prejudice for six patents, none of which were the '940, '372, '907, or '177 Patents. Dkt. 228. In the Motion, ParkerVision also provided a covenant not to sue concerning these six patents, but not for the '940, '372, '907, or '177 Patents which were not the subject of this Motion. *Id.* at 2-3. The Court granted this joint Motion on January 5, 2016. Dkt. 246; *see also* Dkt. 248. Needless to say, this Motion did not dismiss any of the patents or claims ParkerVision now proposes for election.

On February 3, 2016, *before* the proposed narrowing process was completed, without meaningful reciprocation from Qualcomm in limiting its prior art assertions, without any Order of the Court ratifying the proposed narrowing or ruling on ParkerVision's Motion to streamline the case, or otherwise preventing ParkerVision from asserting any of the patents and claims now proposed for election, and prior to the receipt of a Markman Order, the parties filed their Joint Motion to Stay the case, which was thereafter granted on the following day. Dkt. 249; Dkt. 250.

#### IV. ARGUMENT

The Court's Case Management and Scheduling Order controls the disclosure and amendment deadlines for Infringement Contentions. Dkt. 92 at 2-3, 7. Under the Federal Rules, a scheduling order can be modified "only for good cause and with the judge's consent." Fed. R. Civ. P. 16(b)(4); *Ecomsystems, Inc. v. Shared Mktg. Servs.*, 2012 U.S. Dist. LEXIS 194157, at \*3 (M.D. Fla. Jan. 25, 2012). Once good cause is shown, leave to modify falls under Rule 15(a), which liberally states "[t]he court should freely give leave when justice so requires." Fed. R. Civ. P. 15(a)(2). As long as there has been no undue delay, bad faith, dilatory motive, or repeated failure to cure deficiencies; as long as allowing the modification would not cause undue prejudice to the opposing party; and as long as the modification is not futile, leave should be

given. Sutor v. Intex Rec. Corp., 2014 U.S. Dist. LEXIS 151887, at \*5-6 (M.D. Fla. Oct. 6, 2014).

## A. ParkerVision Should be Granted Leave to Elect the Four Patents and Forty-Five Claims It Now Seeks to Assert

After a three year stay that was instituted and maintained by joint request of the parties, and predicated-in large part, due to pending IPR proceedings instigated by Qualcomm-ParkerVision should be permitted to effectively "restart" this case with patents and claims that were at-issue from the filing of this case and that remained at-issue through Markman and at the time the stay was entered. Notwithstanding the fact that the patents and claims ParkerVision now proposes for election were "live" throughout this case, Qualcomm seeks to effectively limit ParkerVision only to those patents and claims it proposed for "nonlimiting" election in correspondence between the parties shortly before the stay; correspondence embodying a proposal for *joint* narrowing of the case predicated on meaningful reciprocation from Qualcomm in limiting its prior art assertions. Because this case was stayed—by joint request of the parties before the narrowing process was completed, before Qualcomm upheld its "end of the bargain" by meaningfully narrowing its prior art assertions, *before* the Court issued its Markman Order, and before the Court ruled on ParkerVision's Motion to Limit (or entered any other Order limiting ParkerVision's ability to assert any of the above-identified patents or claims), ParkerVision should be permitted to now elect different claims than those it identified in correspondence years ago.

Indeed, even if ParkerVision had not proceeded with the patents and claims it now proposes for election, the activities at the Patent Office as part of the Qualcomm instigated IPR proceedings would likely provide the requisite "good cause" for asserting entirely new claims and infringement theories in supplemental Infringement Contentions. This Court has previously agreed that leave to amend Infringement Contentions should be granted following activity at the United States Patent and Trademark Office. *Ecomsystems, Inc.*, 2012 U.S. Dist. LEXIS 194157, at \*3 (granting leave to amend Infringement Contentions after reexamination certificates issued). Leave in this case is particularly appropriate, as the patents and claims ParkerVision elects to assert going forward were always "live" claims in the case: they were indisputably asserted up through the Markman hearing and have never been dismissed or withdrawn from the case.

# 1. There is No "Issue Preclusion" or "Estoppel" That Attaches to ParkerVision's Correspondence Proposing a "Nonlimiting" Subset of Claims

Qualcomm will argue that ParkerVision's "nonlimiting" identification of patents and claims in late 2015 as part of a never-completed joint case narrowing proposal is somehow binding and ParkerVision should not now be permitted, following the lifting of the stay, to proceed with claims other than those identified in this "nonlimiting" identification. But, Qualcomm's argument relies on a misrepresentation of the history of this case or a misunderstanding of the controlling authority.

Claim preclusion only arises upon a showing of "(1) a final judgment on the merits in a prior suit involving; (2) the same parties or their privities; and (3) a subsequent suit based on the same cause of action." *Indivior Inc. v. Dr. Reddy's Labs.*, S.A., 2018 U.S. App. LEXIS 32776, at \*26 (Fed. Cir. 2018). Issue preclusion, which "bars subsequent litigation on an issue of law or fact," only arises upon a showing that the "issue of fact or law [was] actually litigated and determined by a final judgment, and the determination [was] essential to the judgement." *Brain Life, LLC v. Electa, Inc.*, 746 F.3d 1045, 1054-55 (Fed. Cir. 2014). Qualcomm cannot meet a burden of showing that either standard applies here. Indeed, it is undisputed that there is no Order of the Court limiting ParkerVision to the subset of claims proposed for election as part of its never completed proposal to narrow the scope of the case.

ParkerVision's correspondence was explicitly clear: "This election, made in accordance with the Court's discussion during the Claim Construction hearing regarding ParkerVision's Motion to Limit, is made without prejudice, and ParkerVision expressly reserves all rights in the unelected claims, including with respect to assertion against the Defendants." Ex. 6 at 1 (emphasis added). Just as the Court recognized during the Markman hearing, Markman Tr. 232:7-10, ParkerVision likewise recognized that Qualcomm might be "unreasonable" with their election of prior art, and as such ParkerVision needed to protect its rights to reassert any unelected claims if, as was the case before the stay was entered, Qualcomm failed to meaningfully reciprocate. Therefore, each time ParkerVision provided Qualcomm with additional proposed supplemental Infringement Contentions-in October, November, and December of 2015-it served those "supplemental" contentions (not "amendments") under the "nonlimiting" conditions set forth in its correspondence and predicated upon a reciprocation by Qualcomm in meaningfully limiting its prior art assertions—a reciprocation that never occurred. See Exs. 10, 11, 12. See Eagle View Techs., Inc. v. Xactware Sols., Inc., 2017 U.S. Dist. LEXIS 195828, at \*7-8 (D.N.J. Nov. 29, 2017) (recognizing the difference between supplements and amendments to Infringement Contentions).

ParkerVision's "nonlimiting" elections and explicit protection of its rights in its unelected claims stands in stark contrast to the patents and claims actually dropped from the case. After the October, November, and December 2015 proposed election letters (and Supplemental Infringement Contentions) at issue had been delivered, but before any agreement was reached between the parties on the scope of the narrowing, ParkerVision and Qualcomm jointly filed a Motion to Dismiss certain patents and claims from the case, which the Court thereafter granted. Dkt. 228; Dkt. 246; Dkt. 248. Not a single patent or claim ParkerVision now proposes to assert

was included in this Joint Motion to Dismiss or in the related covenant not to sue, the dismissal Order that followed, or any other Order of the Court. Dkt. 228; Dkt. 246; Dkt. 248. Contrary to Qualcomm's position, each of the patents and claims ParkerVision now identifies for election were, and still are, very much "live" in the case—*none* were dismissed by any Court Order (or even agreement of the parties regarding their dismissal).

## 2. The Timing of ParkerVision's Initially Proposed Narrowing and the Timing of Its Current Request Demonstrate "Good Cause"

Each patent and claim that ParkerVision now proposes to elect was undisputedly "live" at the time of the Markman hearing as well as when the stay was entered. Furthermore, it is undisputed that as part of the Markman process, the parties have already briefed (or agreed that no briefing was necessary) each patent and claim ParkerVision currently proposes for election.

Furthermore, this case has been stayed for the last three years. Throughout that stay, ParkerVision (jointly with Qualcomm) provided the Court with status report updates concerning the then pending ITC Investigation and IPR proceedings. *See, e.g.*, Dkt. 251; Dkt. 257; Dkt. 264; Dkt. 268; Dkt. 272; Dkt. 275. After the IPR proceedings finally concluded, and appeals were ruled on, ParkerVision began the meet and confer process with Qualcomm to reopen this case, including by identifying its now proposed-for-election patents and claims. *See* Dkt. 268; Dkt. 272; Dkt. 275. Because ParkerVision could not have made its request to reopen this case or identify the patents and claims it currently proposes for election until after IPR proceedings and appeals had concluded, the Court should find that ParkerVision "acted with due diligence and has demonstrated good cause for the requested" relief (*i.e.*, proceeding with the above-identified patents and claims now that the stay has been lifted). *See Ecomsystems, Inc.*, 2012 U.S. Dist. LEXIS 194157, at \*3-4; *see also 02 Micro Int'l, Ltd. v. Monolithic Power Sys.*, 467 F.3d 1355,

1366 (Fed. Cir. 2006) ("We agree with the Northern District of California that 'good cause' requires a showing of diligence.").

#### 3. Due Process Concerns Also Demonstrate "Good Cause"

ParkerVision's proposed election of patents and claims also concerns a substantial issue of due process. It is within the scope of the Court's authority to limit the number of patent claims asserted in this case. See, e.g., In re Katz Interactive Call Processing Patent Litig., 639 F.3d 1303, 1311-13 (Fed. Cir. 2011). However, and as to the patents and claims ParkerVision presently proposes for election, no Order of the Court prevents their assertion. At the Markman hearing, the Court expressed reservations about ordering the parties to further limit their assertions at that time, unless "the defendants [were] being unreasonable with their number [of asserted prior art references] and they haven't moved at all." Markman Tr. at 232:7-13. Before the stay, the parties had not reached any agreement on proposed narrowing, Qualcomm had not reciprocated to ParkerVision's proposed "nonlimiting" election of claims by proposing any meaningful narrowing of its prior art assertions, and the Court had not entered any Order dismissing or otherwise preventing the assertion of the patents and claims that ParkerVision now proposes to elect. But, if the Court were to impose some limitation on ParkerVision's assertion of patents and claims now, the Federal Circuit has recognized that the Court's authority in this regard is tempered by the due process rights of a plaintiff to elect the specific claim(s) that will be asserted at trial, particularly in instances where the claims the plaintiff seeks to assert present "unique issues as to liability or damages." See id. at 1312-13; see also Nuance Communs., Inc. v. ABBYY USA Software House, Inc., 813 F.3d 1368, 1376 (Fed. Cir. 2016).

The claims of the '940 Patent that ParkerVision now proposes for election *do* present "unique issues" of the type identified by the Federal Circuit. ParkerVision seeks to assert claims from the '940 Patent that Qualcomm challenged in IPR proceedings, but survived both the IPR

and the appeal thereof. For these claims, and by statute, Qualcomm is estopped from asserting certain invalidity grounds that it "raised or reasonably could have raised" during the IPR proceedings. 35 U.S.C. § 315(e)(2). As such, the claims of the '940 Patent that survived the IPR proceedings present "unique issues" of liability and damages (a fact that did not exist at the time of the stay or ParkerVision's proposed "nonlimiting" election of certain other claims from the '940 Patent). These claims therefore require consideration and resolution at trial. *See In re Katz Interactive Call Processing Patent Litig.*, 639 F.3d at 1312-13. As the foregoing shows, ParkerVision not only timely reserved its rights in all of the patents and claims it now wishes to proceed with, it is also now timely acting to preserve its due process rights in those claims of the '940 Patent shortly after they survived IPR proceedings and well before any trial in this case. *See Nuance Communs., Inc.*, 813 F.3d at 1376.

#### 4. Qualcomm's "Receiver Patents" Argument Should be Rejected

During the meet and confer process, Qualcomm indicated that it may object to some of the patents and claims ParkerVision now elects because "the receiver patents are objectionable in light of the finality of [*ParkerVision I*]." Ex. 1. If by this statement Qualcomm is contesting that all "receiver patents" (which includes the '907 and '177 Patents but not the '940 and '372 Patents) are not enforceable or otherwise assertable in this action for some as yet unexplained legal reason, ParkerVision adamantly disagrees. If Qualcomm articulates any legal basis as to why ParkerVision may not elect any claims from the '907 and '177 Patents based on *ParkerVision I*, ParkerVision will respond in more specificity at that time.

Nonetheless, there can be no claim preclusion, issue preclusion, or application of the *Kessler* Doctrine in this case for the reasons set forth here. Neither the '907 Patent nor the '177 Patent were asserted in *ParkerVision I*. They are patents that are not in the same family as the patents at-issue in *ParkerVision I*, patents that have unique specifications from the patents at-

issue in *ParkerVision I*, and patents that have unique claims when compared to the patents atissue in *ParkerVision I*. And importantly, neither the '907 Patent nor the '177 Patent contain the so-called "generating" limitation that was the crux of the *ParkerVision I* appeal.<sup>4</sup>

Among other requirements, claim preclusion requires that the same cause of action be asserted in both a first case and a subsequent case. *Indivior Inc. v. Dr. Reddy's Labs., S.A.*, 2018 U.S. App. LEXIS 32776, at \*26-27 (Fed. Cir. 2018); *Citibank, N.A. v. Data Lease Financial Corp.*, 904 F.2d 1498, 1501 (11th Cir. 1990) (requiring "the same cause of action" in both cases). In a patent case, where different patents are asserted in the two cases at issue, there can only be claim preclusion if the challenger (here Qualcomm) can prove that the claims being asserted are "patentably indistinct." *Indivior Inc.*, 2018 U.S. App. LEXIS 32776, at \*26-27; *see also SimpleAir Inc. v. Google LLC*, 884 F.3d 1160, 1167 (Fed. Cir. 2018). There has been no showing by Qualcomm that the claims ParkerVision proposed for election from the '907 and '177 Patents are "patentably indistinct" from the claims at-issue in *ParkerVision I.*<sup>5</sup>

Issue preclusion does not apply here because neither the '907 Patent nor the '177 Patent were "fully, fairly, and actually litigated to finality" in *ParkerVision I*. That case involved altogether different patents (with different claims). *See Brain Life, LLC*, 746 F.3d at 1054-55 (finding no issue preclusion when different claims were litigated from the same patent).

<sup>&</sup>lt;sup>4</sup> The limitation at issue in the majority of the *ParkerVision I* appeal recited "wherein a lower frequency signal is generated from the transferred energy." *See e.g., ParkerVision Inc. v. Qualcomm Inc*, Case No. 14-1612, Dkt. No. 95-2, at 2 (Fed. Cir. 2015) (reciting the "generating limitation" of the '551 receiver patent at issue in that case).

<sup>&</sup>lt;sup>5</sup> Even if claim preclusion did apply (it does not), it would not apply to any new Qualcomm products not litigated in *ParkerVision I*. The Federal Circuit has recognized that infringement assertions against "products created and, most importantly, acts of alleged infringement occurring after entry of the final judgment" of the first case are outside the reach of issue preclusion. *See Brain Life, LLC v. Electa, Inc.*, 746 F.3d 1045, 1054 (Fed. Cir. 2014). This is consistent with ParkerVision's representation (discussed in footnote 3 *supra*), where it committed to proceed with the new *ParkerVision II* Accused Products (including products released during the stay) that were *not* at-issue in *ParkerVision I* for the '907 and '177 Patents.

The *Kessler* Doctrine also does not apply here, because it is only applicable when "all the claims were or could have been asserted" in a first action, and the claims in the two actions have been shown by the challenger (Qualcomm) to be "patentably indistinct"—again, because neither the '907 Patent nor the '177 Patent were asserted in *ParkerVision I*, and because the claims of those patents have not been shown by Qualcomm to be "patentably indistinct" from those in *ParkerVision I*, the *Kessler* Doctrine does not apply. *See id.* at 1058-59 (applying the *Kessler* Doctrine because both the claims and Accused Products in a second action were "essentially the same as the iterations litigated in the first suit."); *see SimpleAir Inc.*, 884 F.3d at 1170.

# 5. There Has Been No Delay or Bad Faith by ParkerVision, There Will Be No Undue Prejudice to Qualcomm, and the Requested Election is Not Futile

This case was stayed for three years by *joint request* of the parties while IPR proceedings instituted *by Qualcomm* ran their course. Now that those Qualcomm-instituted proceedings have ended, and the jointly requested stay has been lifted, ParkerVision's first action was to indicate to Qualcomm (and the Court) its intention to elect the patents and claims identified above. ParkerVision could not have acted any more quickly in proposing this election of patents and claims. Indeed, it proposed this election of patents and claims in written correspondence to Qualcomm on January 4, 2019 (*see* Ex. 13) *before* the stay was lifted by the Court (*see* Dkt. 280). *See Ecomsystems, Inc.*, 2012 U.S. Dist. LEXIS 194157, at \*3-4 (no undue delay when a request to amend Infringement Contentions came after completion of USPTO proceedings).

There is no claim or evidence of bad faith on the part of ParkerVision. But from a policy perspective, refusing ParkerVision's request could have negative effects on the willingness of future litigants to work to narrow their claim assertions during a case or to agree to stays pending IPR proceedings. Parties will be encouraged to keep every patent and claim fully live and asserted, offering no narrowing elections (with or without reservations of rights, and with or

without reliance on the nonlimiting nature of those concessions) until well after the accused infringer has filed its IPRs. This will increase delay and reduce the chances of willing claim narrowing that would benefit both parties and the Court.

Furthermore, there will be no undue prejudice to Qualcomm associated with granting ParkerVision's request. The patents and claims ParkerVision wishes to proceed with were "live" throughout the pendency of the case, including Markman and at the time the parties jointly requested the case be stayed. Qualcomm has not shown that it took any meaningful action in reliance on ParkerVision's proposed nonlimiting narrowing. Indeed, Qualcomm agreed to the jointly proposed stay (without condition related to the claims and patents), actively opposed ParkerVision's attempts to narrow the scope of the case (by opposing its Motion to Limit), and failed to reciprocate by meaningfully narrowing its asserted prior art before the stay was instituted.

The requested relief is not futile. Quite the opposite: Qualcomm asked the Patent Trial and Appeals Board to take away ParkerVision's intellectual property by ruling certain patented claims unpatentable. Qualcomm lost as to the claims ParkerVision now proposes for election from the '940 Patent. Qualcomm must now face the consequences of that IPR loss and should face a trial on the merits for its infringement as to those claims that survived its IPR challenge (and do so without the protection of certain validity arguments it is now estopped from making). *See* 35 U.S.C. § 315(e)(2).

# **B.** ParkerVision Should be Granted Leave to Add Newly Released Products to the Case

This case was stayed in February of 2016. Since then three years have passed, and Qualcomm has released new products such as WTR5975 LTE Transceiver and other new products that may be revealed in discovery. *See e.g.*, <u>https://www.qualcomm.com/products/rf</u>

(last visited on January 22, 2019). Once the full scope of Qualcomm's new product offerings is known, ParkerVision should be granted leave to supplement its previously-served Infringement Contentions to add these newly-released products (for the patents and claims proposed for election).

Good cause exists for granting leave to add these newly-released products. First, it would have been impossible for ParkerVision to supplement its Infringement Contentions to add these products before the stay, and it would have been likewise impossible to add them during the stay. As such, ParkerVision has shown diligence in requesting that these newly-released products be made a part of this case, and that diligence supports a finding of good cause. *See Ecomsystems, Inc.*, 2012 U.S. Dist. LEXIS 194157, at \*3-4; *see also 02 Micro Int'l, Ltd.*, 467 F.3d at 1366. Second, it is important that these products are added to this case, as a jury trial on the merits is an efficient means of disposing of ParkerVision's claims as to these patents and claims. If ParkerVision's request is denied, it will be forced to bring an entirely separate action covering these new products—a more expensive and time consuming option. In sum, permitting ParkerVision to add Qualcomm's newly-released products is the most efficient means of resolving ParkerVision's claims for these patents, both for the parties, and for the Court.

## V. CONCLUSION

For the foregoing reasons, ParkerVision requests that the Court permit ParkerVision to proceed with the patents and claims identified above, and to serve supplemental Infringement Contentions addressing those patents, claims, and Accused Products that should rightfully be atissue now. January 23, 2019

Respectfully submitted,

# McKOOL SMITH, P.C.

<u>/s/ Douglas A. Cawley</u> Douglas A. Cawley, (Trial Counsel, pro hac vice) Texas State Bar No. 04035500 E-mail: dcawley@mckoolsmith.com Richard A. Kamprath (pro hac vice) Texas State Bar No. 24078767 E-mail: rkamprath@mckoolsmith.com McKool Smith P.C. 300 Crescent Court, Suite 1500 Dallas, Texas 75201 Telephone: (214) 978-4000 Facsimile: (214) 978-4044

Joshua W. Budwin (pro hac vice) Texas State Bar No. 24050347 E-mail: jbudwin@mckoolsmith.com Kathy H. Li (pro hac vice) Texas State Bar No. 24070142 E-mail: kli@mckoolsmith.com Leah Buratti (pro hac vice) Texas State Bar No. 24064897 E-mail: lburatti@mckoolsmith.com McKool Smith P.C. 300 West Sixth Street, Suite 1700 Austin, Texas 78701 Telephone: (512) 692-8700 Facsimile: (512) 692-8744

# **SMITH HULSEY & BUSEY**

Stephen D. Busey Florida Bar Number 117790 Email: sbusey@smithhulsey.com Smith Hulsey & Busey 225 Water Street, Suite 1800 Jacksonville, Florida 32202 Telephone: (904) 359-7700 Facsimile (904) 359-7708

# ATTORNEYS FOR PLAINTIFF PARKERVISION, INC.

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# **CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the above and foregoing document has been served on all counsel of record via the Court's ECF system on January 23, 2019.

/s/ Richard A. Kamprath Richard A. Kamprath