

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

PARKERVISION, INC.,

Plaintiff,

v.

Case No. 6:14-cv-00687-PGB-KRS

QUALCOMM INCORPORATED,
QUALCOMM Atheros, INC., HTC
CORPORATION, HTC AMERICA, INC., SAMSUNG
ELECTRONICS CO., LTD., SAMSUNG
ELECTRONICS AMERICA, INC., and SAMSUNG
TELECOMMUNICATIONS AMERICA, LLC,

Defendants.

**DEFENDANTS' RESPONSE IN OPPOSITION TO PARKERVISION'S
MEMORANDUM ADDRESSING CLAIMS AND ACCUSED PRODUCTS**

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I. INTRODUCTION

For seven years, Qualcomm has been forced to defend itself against ParkerVision's multiple attempts to re-litigate the same alleged "energy transfer sampling" invention recorded in ParkerVision's many repetitive patents. None of ParkerVision's lawsuits has succeeded. Unfortunately, ParkerVision's proposed list of asserted claims and products is the latest in a long line of futile "restarts." (Mot. at 10 (ParkerVision arguing it should be permitted to "effectively 'restart' this case").)

When Judge Dalton ruled that Qualcomm did not infringe ParkerVision's alleged "energy transfer sampling" invention, ParkerVision pressed the restart button and pursued this action. When the Federal Circuit twice affirmed Judge Dalton's decision and Qualcomm presented detailed non-infringement and invalidity defenses in this case, ParkerVision pressed the restart button and dropped considerable portions of its case.¹ When that was not enough, ParkerVision pressed the restart button again, filed an ITC action, and stayed this action. When that strategy failed, ParkerVision asked the Jacksonville court to allow it to restart with new theories. With that strategy delayed, ParkerVision has now returned to this Court. The restarting needs to end.

ParkerVision's latest attempt to hit "restart" involves unraveling promises it made to Defendants and this Court about "narrow[ing] the scope of the case" to a manageable number of claims and products. (Brigham Ex. 1 at 1.) This is not an issue of "due process" or the result of a Court-ordered narrowing. Instead, ParkerVision and its counsel strategically and *voluntarily* abandoned most of the now proposed asserted claims months before the stay.

¹ ParkerVision began this case by indiscriminately asserting eleven patents and 186 claims.

ParkerVision knowingly determined that these claims were of minimal worth and chose not to prosecute them.

ParkerVision offers no good cause for seeking to expand this case to add thirty-one claims. ParkerVision seeks to prejudice Defendants, asking Defendants to spend time and money defending against claims that ParkerVision will inevitably drop once trial nears. Because no good cause has been shown, ParkerVision’s motion should be denied.

II. PARKERVISION’S MOTION

This patent case was stayed from February 2016 to January 2019. (Dkts. 250, 280.) Prior to the stay, ParkerVision promised to “crystalize and narrow this case.” (Brigham Ex. 1 at 1-2.) ParkerVision pledged to assert only 19 claims from the ‘940, ‘372, ‘907, and ‘177 patents (*see* “Claims at Time of Stay” below). (Brigham Ex. 1 at 1-2.)

Now, ParkerVision inexplicably wishes to renege on its promise and to materially expand the scope of asserted claims. ParkerVision seeks to add thirty-one claims. The proposed additional claims are identified in red below:

Patents	Claims at Time of Stay	ParkerVision’s Request Now
6,091,940	1, 2, 18, 94, 264	<u>24, 25, 26, 331, 364, 365, 366, 368, 369, 373</u>
7,039,372	99, 100, 107, 108, 127	<u>88, 89, 90, 91, 92, 95, 96,</u> 99, 100, <u>103, 104,</u> 107, 108, <u>109, 110,</u> <u>126,</u> 127
7,865,177	1, 5, 7, 12	1, <u>2, 3,</u> 5, 7, <u>8, 9, 10, 11,</u> 12, <u>14</u>
7,218,907	1, 10, 13, 14, 23	1, <u>2,</u> 10, 13, 14, <u>15,</u> 23
Added Total	19 claims ²	45 claims

² ParkerVision also asserted claims from the ‘116 patent, but those claims have been dismissed. (Dkt. 248.)

Additionally, ParkerVision seeks to add “new products” to the case. (Mot. at 18.)

III. ARGUMENT

A. **No good cause exists for allowing ParkerVision to assert twelve additional claims from the ‘372 patent.**

The Court should deny ParkerVision’s request to “restart” this case by adding twelve additional claims from the ‘372 patent. (Mot. at 3, 10.)

First, ParkerVision failed to diligently pursue the proposed twelve additional ‘372 claims. *E.g.*, *Quinn v. Deutsche Bank Nat. Tr.*, 625 F. App’x 937, 940 (11th Cir. 2015) (“A lack of diligence in pursuing a claim is sufficient to show a lack of good cause.”); *Lord v. Fairway Elec.*, 223 F. Supp. 2d 1270, 1277 (M.D. Fla. 2002) (“A finding of lack of diligence on the part of the party seeking modification ends the good cause inquiry”). In April 2015, during the claim construction process, Defendants informed ParkerVision that claims 88-92 were invalid due to indefiniteness, and thus, Defendants wished to brief the issue to the Court. (Brigham Ex. 2 at 21 (“said reference signal”; indefinite, claim 88).) In response, ParkerVision voluntarily abandoned the claims. (*E.g.*, Dkt. 284-7 at 6 (“ParkerVision dropped ‘372 claims 88-92 during the claim construction process in response to Defendants indefiniteness defenses.”); Brigham Ex. 3 at 3 (“WE’LL AGREE TO ‘DROP’”).) Defendants relied upon ParkerVision’s decision and the parties never presented claim construction or indefiniteness briefing for claim 88.³

In November 2015, ParkerVision confirmed its decision not to pursue certain claims of the ‘372 patent. ParkerVision served infringement contentions that did not chart any of the

³ Claim 88 is an independent claim; claims 89-92 are dependent claims.

proposed additional ‘372 claims. ParkerVision’s November 2015 ‘372 charts only addressed the asserted ‘327 claims (*i.e.*, claims 99, 100, 107, 108, and 127), consistent with both parties’ understanding of the scope of asserted ‘372 claims in the case.⁴

ParkerVision repeatedly confirmed it was only asserting the following five ‘372 claims in written correspondence:

<p>ParkerVision’s Letter, December 2, 2015, Brigham Ex. 1 at 1 (highlighting added)⁵</p> <p>In an effort to further narrow the scope of the case, as proposed in ParkerVision’s Motion to Limit the Number of Asserted Patent Claims and Prior Art References for Claim Construction Briefing [Dkt. 112] and in ParkerVision’s argument before the Court during the Claim Construction hearing on August 12, 2015, ParkerVision provides notice to Defendants of its election of asserted claims. Pursuant to this election, ParkerVision’s elected claims are as follows below.</p> <p style="text-align: center;">***</p> <p>2. <u>U.S. Patent No. 7,039,372</u>: Claims 99, 100, 107, 108, 127</p>

(*See also* Dkt. 284-6 at 2 (Letter, October 6, 2015, “Claims 99, 100, 107, 108, 127”); Dkt. 284-8 at 2 (Letter, November 23, 2015, “Claims 99, 100, 107, 108, 127”).) After this correspondence, Defendants took the depositions of two inventors of the ‘372 patent (Messrs. Bultman and Cook) and did not ask about the abandoned claims.

Now, after the stay, ParkerVision suddenly wishes to assert seventeen claims, including the claims dropped in light of Defendants’ indefiniteness defense (claims 88 through 92). (Mot. at 3 (seeking to assert ‘372 claims “88, 89, 90, 91, 92, 95, 96, 99, 100, 103, 104, 107,

⁴ ParkerVision stated the ‘372 chart also included claim 126 because asserted claim 127 depends from claim 126.

⁵ Contrary to ParkerVision’s argument that its letter identified a “nonlimiting” list of asserted claims, nowhere in ParkerVision’s December 2 letter does the word “nonlimiting” appear. Although ParkerVision’s October 6 letter referred to reserving rights for unidentified “unelected” claims, that reservation of rights language was removed from the December 2 letter. (*Compare* Brigham Ex. 1 with Dkt. 284-6 at 1.)

108, 109, 110, 126, 127”).) ParkerVision’s motion provides no explanation for why it should be allowed to triple the number of asserted ‘372 claims and to include claims it abandoned nine months before the stay. (*Cf.* Brigham Ex. 1 at 2 (ParkerVision promising to “narrow this case”); Dkt. 112 at 1 (ParkerVision arguing that “[f]ocusing this case ‘will reduce the burden on [the] court[] and lower the expense for the parties’”).) ParkerVision did not diligently pursue these claims, first telling Defendants they did not need to brief the indefiniteness issues in certain claims and then making no effort to provide charts for the claims in November 2015. Allowing ParkerVision to assert these additional ‘372 claims will impose additional burden and expense on Defendants and the Court, including preparing new claim construction briefing, holding another hearing, analyzing the sufficiency of any new infringement contentions, reviewing prior art, and more.

Because ParkerVision failed to diligently pursue the proposed twelve additional ‘372 claims, the Court should deny ParkerVision’s request. Alternatively, if the claims are allowed into the case, Defendants should be permitted to file a motion for a finding of indefiniteness of claims 88-92 (since that was the reason ParkerVision originally dropped the claims), Defendants should be awarded fees if they prevail, and all discovery as to the ‘372 patent should be stayed while the motion is pending. *E.g.*, 28 U.S.C. § 1927; 35 U.S.C. § 285.

B. The Court should hold ParkerVision to its strategic decision to pursue only five ‘940 apparatus claims.

ParkerVision’s proposed ‘940 patent claims are not actually an “election,” but a complete replacement. ParkerVision seeks to swap out the “apparatus” claims it selected, with a new set of “method” claims that it strategically abandoned months before the stay. The fact

that all of ParkerVision’s asserted ‘940 apparatus claims were found invalid by the Federal Circuit should help narrow the disputes in the case, not expand them. ParkerVision, however, seeks to proceed as if the Federal Circuit’s decision never happened.

Before the stay, ParkerVision repeatedly confirmed that it wished to “narrow the scope of the case” to asserting only “Claims 1, 2, 18, 22, 23, 86, 93, 94, 264” of the ‘940 patent. (*E.g.*, Dkt. 284-6 at 1; Brigham Ex. 1 at 1.) In response, Defendants agreed not to rely upon eight prior art references. (Dkt. 284-7 at 4-5.) ParkerVision never complained about Defendants’ response. Instead, ParkerVision sent two more letters confirming it only wished to assert five claims from the ‘940 patent.⁶

ParkerVision’s Letter, Brigham Ex. 1 at 1 (highlighting added)⁷

In an effort to further narrow the scope of the case, as proposed in ParkerVision’s Motion to Limit the Number of Asserted Patent Claims and Prior Art References for Claim Construction Briefing [Dkt. 112] and in ParkerVision’s argument before the Court during the Claim Construction hearing on August 12, 2015, ParkerVision provides notice to Defendants of its election of asserted claims. Pursuant to this election, ParkerVision’s elected claims are as follows below.

1. **U.S. Patent No. 6,091,940**: Claims 1, 2, 18, 94, 264

Nowhere in ParkerVision’s letter did it say its identification of ‘940 claims was “non-limiting,” or could be changed depending on the outcome of the *inter partes* review proceedings.

Qualcomm successfully invalidated all five claims. *ParkerVision v. Qualcomm*, 903 F.3d 1354, 1362, 1364 (Fed. Cir. 2018) (“We affirm the Board’s determination that claims 1, 2, 18 ... 94 ... and 264 are unpatentable.”). As a result, ParkerVision wishes to re-do its

⁶ After this correspondence, Qualcomm took the depositions of two inventors of the ‘940 patent (Messrs. Bultman and Cook) and focused on the asserted claims.

⁷ See also Dkt. 284-8 at 2 (“Claims 1, 2, 18, 94, 264.”).

election to replace those five claims with ten other claims:

ParkerVision's Motion (highlighting added)
'940 Patent (10 claims): 24, 25, 26, 331, 364, 365, 366, 368, 369, 373

No good cause exists for allowing ParkerVision to swap out its chosen '940 claims for double the number of asserted '940 claims.⁸ It would be manifestly unjust for ParkerVision to now benefit from its Federal Circuit loss, by allowing it to select certain method claims that escaped on procedural grounds.⁹ This would create perverse incentives for plaintiffs like ParkerVision to make false promises about its asserted claims, because any claims that survived an administrative challenge could be added to expand the case.

Accordingly, the Court should reject ParkerVision's request to add claims 24, 25, 26, 331, 364, 365, 366, 368, 369, and 373 of the '940 patent to the case.

C. ParkerVision's addition of receiver claims is futile.

ParkerVision offers no good cause for doubling the number of asserted receiver patent claims (Mot. at 3 (seeking leave to add nine claims from the '907 and '177 patents)), particularly given the long history of ParkerVision's unsuccessful efforts to allege infringement of its receiver patents. *E.g.*, *ParkerVision v. Qualcomm*, 621 F. App'x 1009, 1013-24 (Fed. Cir. July 31, 2015) ("Dr. Prucnal admitted that the baseband signal in the

⁸ ParkerVision's reliance on *eComSystems* is misplaced. *eComSystems v. Shared Mktg. Servs.*, No. 10-1531, 2012 U.S. Dist. LEXIS 194157, *4-5 (M.D. Fla. Jan. 25, 2012). Unlike the plaintiff in *eComSystems* who "could not have known the content of the reexamination certificate prior to their issuance," ParkerVision knew about the '940 method claims (which remain unchanged) before the Federal Circuit's decision, but chose not to continue to prosecute them. *Id.* (emphasis added).

⁹ *ParkerVision v. Qualcomm*, 903 F.3d at 1363 (finding Qualcomm's original petitions did not sufficiently address whether a person of ordinary skill would have been motivated to *select the inputs* to satisfy the plurality of harmonics element).

accused products has already been created before the signal reaches the identified capacitors”) (emphasis added); *ParkerVision v. Qualcomm*, 627 F. App’x 921, 922-24 (Fed. Cir. Oct. 2, 2015) (“[W]e agree with the district court that no reasonable finder of fact could come to a confident conclusion that the capacitors have a role in generating the baseband”); Staff PHB at 1, Brigham Ex. 4 (“the evidence is expected to show that the accused products do not infringe the asserted claims of the [receiver patents] ’817, ’638, and ’528 patents); ITC Order at 2, Brigham Ex. 5 (ParkerVision admitted it could “no longer proceed with its case-in-chief ... an administrative hearing would not be a justifiable or effective use of anyone’s resources”).

In an effort to distance itself from its past cases, ParkerVision incorrectly asserts that the ‘907 and ‘177 patents are “not in the same family as the patents at-issue in *ParkerVision I*.” (Mot. at 15.) To the contrary, the face of the patents-in-suit plainly shows that each of the receiver patents-in-suit is in the same family as U.S. Patent No. 6,061,551 (the patent the Federal Circuit and Judge Dalton found Qualcomm did not infringe in *ParkerVision I*):

‘907 Patent (highlighting added)	‘177 Patent (highlighting added)
<p style="text-align: center;">Related U.S. Application Data</p> <p>(63) Continuation of application No. 10/394,069, filed on Mar. 24, 2003, which is a continuation of application No. 09/293,342, filed on Apr. 16, 1999, now Pat. No. 6,687,493, which is a continuation-in-part of application No. 09/176,022, filed on Oct. 21, 1998, now Pat. No. 6,061,551.</p>	<p style="text-align: center;">Related U.S. Application Data</p> <p>(60) Division of application No. 09/550,644, filed on Apr. 14, 2000, now Pat. No. 7,515,896, which is a continuation-in-part of application No. 09/521,879, filed on Mar. 9, 2000, now abandoned, and a continuation-in-part of application No. 09/293,342, filed on Apr. 16, 1999, now Pat. No. 6,687,493, which is a continuation-in-part of application No. 09/176,022, filed on Oct. 21, 1998, now Pat. No. 6,061,551.</p>

ParkerVision, 621 F. App’x at 1011. ParkerVision also relies on the filing date of the ‘551 patent as the priority date for the ‘907 and ‘177 patents. (Dkt. 284-3 at 6 (relying on the October 21, 1998 filing date of the ‘551 patent, in this case).) ParkerVision’s assertion that the ‘907 and ‘117 patents have “unique specifications” is sorely mistaken. (Mot. at 15.)

Defendants’ proposal for addressing the impact of *ParkerVision I* remains the same as

it did before the stay. (Dkt. 216.) If any receiver claims remain in this case at the time of expert reports, Defendants request leave to address those claims and the impact of *ParkerVision I* in briefing based on the record.

With respect to the issue at hand – that is, whether to add nine more claims to the case – ParkerVision fails to provide ample justification. **First**, ParkerVision failed to diligently prosecute the proposed additional receiver claims. Prior to the stay, ParkerVision repeatedly promised that it only wished to assert nine claims from the ‘907 and ‘177 patents:

ParkerVision’s Letter, Brigham Ex. 1 at 2 (highlighting added) ¹⁰
For the receiver case, which ParkerVision has proposed be severed and stayed, ParkerVision elects the following 22 claims:
1. U.S. Patent No. 7,218,907 : Claims 1, 10, 13, 14, 23
2. U.S. Patent No. 7,865,177 : Claims 1, 5, 7, 12
3. U.S. Patent No. 8,190,116 : Claims 1, 9, 10, 14, 15, 17, 19, 24, 26, 28, 30, 31, 32

(See also Dkt. 284-6 at 2 (same ‘907 and ‘177 claims); Dkt. 284-8 at 2 (same claims).)

Now, ParkerVision wishes to double the number of asserted receiver patent claims:

ParkerVision’s Motion (highlighting added)
’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

The Court should hold ParkerVision to the assurances it made about the “narrow[ed]” scope of the case prior to the stay. (Brigham Ex. 1.)

Second, ParkerVision’s motion fails to show good cause for asserting the proposed additional receiver patent claims. ParkerVision makes no attempt to explain in specific detail

¹⁰ The ‘116 patent claims were dismissed in January 2016. (Dkt. 248.)

how each of its proposed receiver claims presents unique issues. *Stamps.com v. Endicia*, 437 F. App'x 897, 902-03 (Fed. Cir. 2011) (plaintiff “did not even attempt to make a good cause showing”); *In re Katz Interactive Call Processing Patent Litig.*, 639 F.3d at 1309-12 (Fed. Cir. 2011) (plaintiff bears the burden of showing the additional claims raise “unique issues as to liability or damages”).

Accordingly, the Court should reject ParkerVision’s request to add claims 2 and 15 of the ‘907 patent, and to add claims 2, 3, 8, 9, 10, 11, and 14 of the ‘177 patent.

D. ParkerVision’s tardy request is designed to prejudice Defendants.

ParkerVision erroneously argues that there has been no delay, bad faith, prejudice, and futility. (Mot. at 17-19.) To the contrary, ParkerVision could have identified these additional proposed claims in April, October, November, and December 2015, but chose not to. It strategically chose not to pursue these additional claims, so it could convince Defendants not to rely upon certain prior art references, not to brief certain claim construction issues, and to depose two inventors on only a subset of patent claims. After failing to diligently prosecute these additional claims, ParkerVision suddenly wants to add them to the case to impose additional burden and expense and to multiply the proceedings. For example, Defendants will need to re-depose two inventors (who are third parties), analyze additional prior art, file extra briefs and motions, and try to guess at which of the 45 claims ParkerVision might end up pursuing through expert reports, summary judgment, and any jury trial. ParkerVision has already caused Qualcomm to spend millions of dollars defending itself against ParkerVision’s multiple lawsuits (none of which has succeeded). Qualcomm should be entitled to rely upon the promises ParkerVision made about narrowing the scope of this case to the claims identified

in ParkerVision's December 2015 letter before the stay. (Brigham Ex. 1.)

E. Defendants do not object to a reasonable inclusion of new products.

ParkerVision wishes to expand the scope of accused products to include "WTR5975" and "new products that may be revealed in discovery." (Mot. at 18.) ParkerVision states that once the "scope of Qualcomm's new product offerings is known," ParkerVision wishes to "supplement" its infringement contentions to add "newly-released products." (Mot. at 19.)

As long as the schedule allows for adequate time for discovery, the infringement theories are the same as before, and responsive invalidity contentions are allowed, Qualcomm does not object to the inclusion of products that were introduced after the stay was put in place. To the extent ParkerVision seeks blanket authorization to assert new infringement theories (*i.e.*, how a product allegedly infringes), Defendants object. ParkerVision should not be allowed to serve infringement contentions raising new theories.

IV. CONCLUSION

ParkerVision's motion to expand the scope of this case should be denied. The parties and the Court should focus on the following claims:

U.S. Patent No. 7,039,372: claims 99, 100, 107, 108, 127

U.S. Patent No. 7,865,177: claims 1, 5, 7, 12

U.S. Patent No. 7,218,907: claims 1, 10, 13, 14, 23

Because all of the asserted '940 claims have been found invalid, the '940 claim for relief should be dismissed with prejudice. *ParkerVision*, 903 F.3d at 1362, 1364.

To the extent ParkerVision wishes to accuse newly released products, ParkerVision should be required to serve detailed infringement contentions for each of those

products. No new infringement theories should be allowed, unless good cause is shown.

Dated: February 6, 2019

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the above and forgoing document has been served on all counsel of record via the Court's ECF system on February 6, 2019.

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