

**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

Defendants.

CASE NO.: 6:14-CV-00687-PGB-KRS

**PLAINTIFF PARKERVISION'S CORRECTED REPLY BRIEF
ADDRESSING ELECTION OF CLAIMS AND ACCUSED PRODUCTS**

Plaintiff ParkerVision, Inc. (“ParkerVision”) respectfully submits the following reply addressing Qualcomm’s response to ParkerVision’s recent elections.¹

Prior to the stay entered in this case, ParkerVision unilaterally took the initial steps needed to engage in the iterative process of narrowing the case. D.I. 284, Ex. 6, Ex. 8. But as this Court recognized, both ParkerVision and Qualcomm needed to participate in the narrowing process. *See* Markman Tr. at 232:7-13. Despite ParkerVision’s initial steps towards narrowing the infringement case, Qualcomm never reciprocated by meaningfully narrowing its invalidity case. D.I. 284 at 7. Qualcomm now seeks to hold ParkerVision to a lopsided—and nonlimiting, nonbinding—narrowing process that Qualcomm itself failed to participate in. Although it had more than two months to do so, Qualcomm chose not to hold up its end of the case-narrowing bargain proposed by ParkerVision. Qualcomm should not be permitted to now unfairly reap the benefits of that proposed bargain.

Furthermore, the outcome of the IPR proceedings, specifically that certain claims of the ’372 and ’940 survived the IPRs), warrants permitting ParkerVision to assert those claims that have been re-confirmed valid by the USPTO.

ParkerVision has asserted all of the presently elected claims against Qualcomm since the inception of this litigation, through the claim construction process, and these claims have never been dismissed or withdrawn from the case.

I. PROPOSED ELECTIONS REGARDING THE ’372 PATENT

In its original memorandum, ParkerVision elected the following claims of the ’372 Patent: 88-92, 95-96, 99-100, 103-104, 107-110, 126-127. Qualcomm misleadingly claims that ParkerVision “abandoned” claims 88-92 and relies on selective quotations to the record. Dkt.

¹ Qualcomm’s response does not oppose ParkerVision’s request to add newly released products to the case, and as such that issue is not addressed in this reply brief.

285 at 3. But the record shows that ParkerVision agreed only that “we will agree to ‘drop’ these claims, *if we can reach an acceptable method of dropping claims with the Defendants, including the Defendants’ counterclaims thereon.*” Dkt. 285, Ex. 3 at 3 (emphasis added). As shown by the current dispute, the parties never “reach[ed] an acceptable method of dropping claims with the Defendants. . . .” Qualcomm nonetheless chose not to pursue its indefiniteness arguments related to claim 88. To prevent Qualcomm from attempting to revisit claim construction issues, however, ParkerVision will amend its election to remove claims 88-92; ParkerVision maintains its election as to the other claims. With the withdrawal of claims 88-92, Qualcomm has no argument (and made no argument in its response brief) that any additional claim construction briefing or hearing is necessary, as all of the other claims in ParkerVision’s election were indisputably asserted and live up through claim construction briefing and the related hearing.

Qualcomm further argues that “ParkerVision served infringement contentions that did not chart any of the proposed additional ’372 claims.” Dkt. 285 at 3-4 (emphasis in original). Yet again, Qualcomm’s argument is misleading—ParkerVision’s November 2015 infringement contentions were explicitly “intended to supplement (not replace) [ParkerVision’s] previously-served infringement contentions on June 9, 2015.” Dkt. 284, Ex. 11. As explained in ParkerVision’s opening memorandum, and not contradicted in Qualcomm’s response, ParkerVision’s June 9th infringement contentions included charts for every patent and claim in ParkerVision’s current election.

Qualcomm also complains about ParkerVision’s December 2, 2015 narrowing letter. But that correspondence unambiguously makes the narrowing subject to “ParkerVision’s argument before the Court during the Claim Construction hearing.” Dkt. 284, Ex. 9. ParkerVision’s Claim Construction hearing argument made clear that its elections of claims would be “nonlimiting.”

See Dkt. 284 at 5-6. Indeed, each of ParkerVision's narrowing letters was subject to this same reservation of rights. See *id.* Regarding the depositions of Mr. Bultman and Mr. Cook, both December 2015 depositions that took place *after* the claim construction hearing, and Qualcomm does not identify any prejudice that exists as to these depositions (e.g., Qualcomm identifies no questions that it needs answered from these two witnesses that are specific to the claim election issues at hand).

II. PROPOSED ELECTIONS REGARDING THE '940 PATENT

As to ParkerVision's '940 Patent elections, the prejudice alleged by Qualcomm is contradicted by Qualcomm's own correspondence. Qualcomm claims that "in response" to ParkerVision's narrowing letter, Qualcomm "agreed not to rely upon eight prior art references." Dkt. 284 at 6 (citing Dkt. 284, Ex. 7 at 4-5). However, Qualcomm's own words show otherwise: "ParkerVision's claim reduction for the '940 patent has little impact on the scope of the case" and "ParkerVision has not materially reduced the scope of the '940 case." Dkt. 284, Ex. 7 at 2, 4. Qualcomm's feigned prejudice should be disregarded—any purported narrowing of prior art by Qualcomm was unconnected to ParkerVision's nonlimiting narrowing.

Qualcomm further alleges prejudice by arguing that "[i]t 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." This argument fails to recognize, however, that "the statutory scheme envisions a petitioner pursuing [*inter partes*] review based solely on its own analysis of a patent and the claims it finds objectionable." *Univ. of Va. Patent Found. v. GE*, 2015 U.S. Dist. LEXIS 152559, at *9 (W.D. Va. Nov. 10, 2015). Qualcomm had its opportunity to present its invalidity arguments to the PTAB regarding the claims of the '940 patent and it did so in its three IPR petitions; ParkerVision prevailed as to certain claims. *ParkerVision v. Qualcomm*, 903 F.3d 1354, 1358 (Fed. Cir. 2018); *see id.* at 1363.

At the end of the day, the issue before this Court is whether to permit ParkerVision's current election. Post-IPR, ParkerVision can still assert that claims 24-26, 331, 364-66, 368-69, and 373 are valid, those claims were indisputably asserted through claim construction, and they were further asserted up to the stay. Indeed, every narrowing letter provided to Qualcomm was "nonlimiting," and, unlike certain patents that ParkerVision and Qualcomm formally dismissed, there was no such dismissal as to claims of the '940 Patent. *See* Dkt. 284 at 5-9. Moreover, given the outcome of the IPRs, good cause exists in support of ParkerVision's election and Qualcomm has failed to identify any prejudice associated with that election. ParkerVision's requested relief should therefore be allowed.

III. PROPOSED ELECTIONS REGARDING THE '907 AND '177 PATENTS

Qualcomm's response describes ParkerVision's elections for the '907 and '177 Patents as "futile," but fails to cite anything in support of this assertion. Qualcomm also suggests that it should be granted leave to address "receiver claims" and the impact of *ParkerVision I* on this case. Dkt. 285 at 8-9. If Qualcomm files a motion for summary judgment of noninfringement based on *ParkerVision I* or otherwise offers any substantive arguments, ParkerVision will address such arguments on the merits. Qualcomm's conclusory, unsupported assertion of futility should have no bearing on the election of claims issue now before the Court.

ParkerVision has shown that it diligently asserted the elected claims—again, all elected claims were indisputably carried through claim construction and every narrowing letter from ParkerVision was "nonlimiting" in nature. *See* Dkt. 284 at 5-9.

IV. QUALCOMM HAS NOT IDENTIFIED ANY REAL PREJUDICE

Qualcomm baldly asserts that it 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.” But ParkerVision is not seeking to add new *patents* to the case; the overarching issues and technology has not changed. With respect to the depositions, Qualcomm’s response failed to describe even a single line of inquiry not explored during the already-taken depositions that will need to be explored in a second deposition. Both depositions were taken after the claim construction hearing, so there can be no claim construction related prejudice. And there are three other inventors of the ’940, ’372, and ’907 Patents besides Mr. Cook and Mr. Bultman, and five other inventors for the ’177 Patent. Qualcomm will have the opportunity to take those depositions and ask those inventors any claim-specific questions it may have. There is simply no discovery prejudice concerning inventor depositions.

As to additional prior art, as explained above and stated throughout Qualcomm’s own correspondence, *see* Dkt. 284, Ex. 7, ParkerVision’s claim reduction has had zero impact on Qualcomm’s decisions to drop prior art. Not a single piece of prior art has been identified by Qualcomm as requiring additional analyzing above-and-beyond any work that has already been performed by Qualcomm. ParkerVision is not expanding its election beyond claims that it initially asserted, included in infringement contentions, and carried through the claim construction process. As such, there is no prejudice touching on prior art concerns.

And with respect to Qualcomm’s complaint that it will have to “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,” each of these steps are run-of-the-mill issues that every infringer faces in a patent litigation case. Again, Qualcomm fails to identify any particular extra work associated with ParkerVision’s current election. There is no procedural prejudice unique to the elected claims.

V. CONCLUSION

For the reasons discussed in ParkerVision's opening memorandum and above, ParkerVision requests that the Court permit it to proceed with the following patents and claims:

- '940 Patent (10 claims): 24, 25, 26, 331, 364, 365, 366, 368, 369, 373
- '372 Patent (12 claims): 95, 96, 99, 100, 103, 104, 107, 108, 109, 110, 126, 127
- '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

February 19, 2019

Respectfully submitted,

McKool Smith, P.C.

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***ATTORNEYS FOR PLAINTIFF
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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 February 19, 2019.

/s/ Leah Buratti

Leah Buratti