

**IN THE UNITED STATES DISTRICT COURT
FOR THE MIDDLE DISTRICT OF FLORIDA
JACKSONVILLE DIVISION**

PARKERVISION, INC.,)
)
 Plaintiff,)
)
 v.) Case No. 3:15-cv-01477-J-39MCR
)
 APPLE INC., et al.,)
)
 Defendants.)
 _____)

PARKERVISION’S AND APPLE’S UNOPPOSED MOTION TO STAY

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I. Introduction

Plaintiff ParkerVision, Inc. has two related patent infringement cases pending in the Middle District of Florida: (1) *ParkerVision, Inc. v. Qualcomm et al.*, Case No. 6:14-CV-00687, filed and pending in the Orlando Division (the “Orlando Case”); and (2) this action, *ParkerVision Inc. v. Apple et al.*, Case No. 3:15-cv-01477, in the Jacksonville Division (the “Jacksonville Case”). ParkerVision and Apple request that the Court exercise its discretion to stay this Jacksonville Case (as to all parties) pending a final judgment (including any appeals) or settlement in the related Orlando Case. Defendant Qualcomm Incorporated does not oppose.

The Orlando Case was filed first and its subject matter overlaps considerably with this Jacksonville Case. For example:

- Both are patent infringement cases asserting that Qualcomm’s Radio-Frequency chips infringe certain ParkerVision patents.
- The Orlando Case concerns alleged infringement of two transmitter patents and two receiver patents, while the Jacksonville Case concerns alleged infringement of a single receiver patent related to the receiver patents asserted in Orlando.
- Infringement in both cases is based on Qualcomm chips, and the Qualcomm chips at issue in Orlando include all of the Qualcomm chips accused of infringement in Jacksonville, plus additional chips not at issue in Jacksonville.
- The period of alleged damages in the Orlando Case is greater than (and wholly includes) the period of alleged damages in the Jacksonville Case.
- The Orlando and Jacksonville Cases share numerous issues, including infringement and invalidity issues concerning common claim elements.

Because the first-filed Orlando Case encompasses more patents, more products, and a greater period of damages than the Jacksonville Case, a settlement in the Orlando Case will likely eliminate the need to proceed with the similar Jacksonville Case. In addition, a

resolution in the Orlando Case of some of the common issues between it and the Jacksonville Case could eliminate or reduce the litigation of those issues in Jacksonville.

Therefore, to avoid the waste of the extensive judicial and party resources needed to pursue and try similar patent infringement cases at the same time, the Court should exercise its discretion to stay this Jacksonville Case pending a final judgment or settlement in the Orlando Case and thereby potentially avoid the need for any further work in the Jacksonville Case. To further promote judicial efficiencies and in exchange for Qualcomm not opposing this motion, ParkerVision agrees that during the requested stay ParkerVision (and its surrogates) will not allege patent infringement or file any new lawsuits and/or administrative proceedings (anywhere in the world) related to patent rights against Qualcomm, Apple, or their customers for use of Qualcomm RF chips. So long as ParkerVision complies with this agreement, Qualcomm and Apple agree that they will not file any new lawsuits and/or administrative proceedings (anywhere in the world) against ParkerVision related to patent rights during the duration of the stay. This agreement does not preclude Apple, Qualcomm, or ParkerVision from taking whatever steps necessary, including the filing of lawsuits, administrative proceedings, and claims, to seek, collect, and preserve its rights to recover fees and costs in any previously-filed case. This agreement also does not preclude Qualcomm or ParkerVision from advancing their positions in the Orlando Case (*e.g.*, by filing a new lawsuit and/or administrative proceeding against ParkerVision or Qualcomm involving the patents currently at issue in the Orlando Case), so long as ParkerVision does not file a new lawsuit and/or administrative proceeding against a Qualcomm customer for their use of Qualcomm RF chips or seek to add a Qualcomm customer, including but not limited to Apple, to the Orlando Case.

As part of this agreement, ParkerVision will not seek to add Apple as a party to the Orlando Case. In addition, this agreement does not preclude Apple or ParkerVision from advancing claims or defenses related to any ParkerVision patents asserted in *ParkerVision, Inc. v. Intel Corporation*, WDTX-6-20-cv-00108 (the “Intel Case”) (e.g., by filing a new lawsuit and/or administrative proceeding involving a patent at issue in the Intel Case).

Accordingly, ParkerVision and Apple respectfully request that the Court grant this motion to stay. Qualcomm does not oppose this request and is a signatory to this motion solely to document the agreements above.

II. The Court Has the Power and Discretion To Stay the Jacksonville Case

The Court has broad discretion over its docket, including the power to grant motions to stay. *Lifewatch Servs. v. Medicomp, Inc.*, No. 6:09-cv-1909-Orl-31DAB, 2010 U.S. Dist. LEXIS 36194, at *3 (M.D. Fla. Mar. 16, 2010). The Court may stay proceedings to promote judicial economy, reduce confusion and prejudice, or prevent possibly inconsistent resolutions. *See Clinton v. Jones*, 520 U.S. 681, 706 (1997).

“When deciding a motion to stay, courts consider the following non-exhaustive factors: (1) whether a stay will simplify the issues in question for trial of the case; (2) whether discovery is complete and whether a trial date has been set; and (3) whether the stay would unduly prejudice or present a clear tactical disadvantage to the non-moving party.” *CANVS Corp. v. Nivisys, LLC*, No. 2:14-cv-99-FtM-38DNF, 2014 U.S. Dist. LEXIS 168681, at *4-5 (M.D. Fla. Dec. 5, 2014) (citing *Automatic Mfg. Sys., Inc. v. Primera Tech., Inc.*, No. 6:12-cv-1727, 2013 U.S. Dist. LEXIS 165692 at * 1 (M.D. Fla. Nov. 21, 2013)). However, these factors are non-exhaustive, and a totality of circumstances governs. *Id.* Parties seeking the stay bear the

burden of proving that the stay is appropriate under the circumstances. *Shire Dev. LLC v. Mylan Pharm., Inc.*, No. 8:12-cv-1190-T-36AEP, 2014 U.S. Dist. LEXIS 199047, at *9 (M.D. Fla. July 25, 2014) (citing *U.S. Nutraceuticals, LLC v. Cyanotech Corp.*, No. 5:12-cv-366-Oc-10PRL, 2013 U.S. Dist. LEXIS 163054, at *2 (M.D. Fla. Nov. 15, 2013) (citing *Landis v. N. Am. Co.*, 299 U.S. 248, 255 (1936))).

III. The Court Should Stay the Jacksonville Case To Promote Judicial Economy

A. The Orlando and Jacksonville Cases Overlap Considerably

ParkerVision filed the Orlando Case on May 2, 2014, alleging that Qualcomm and HTC Corporation and HTC America infringe ParkerVision patents by making, using, selling, offering for sale, and/or importing products that feature certain Qualcomm RF chips.¹ ParkerVision filed this Jacksonville Case more than a year-and-a-half later, similarly alleging that Qualcomm and Apple infringe other ParkerVision patents by making, using, selling, offering for sale, and/or importing products that feature certain Qualcomm RF chips.²

The Orlando Case currently is scheduled for trial in December 2020, although that may change in light of the ongoing COVID-19 pandemic's impact on access to technical schematics at-issue in that action, which is presently stayed due to COVID-19 issues.³ This Jacksonville

¹ See *ParkerVision, Inc. v. Qualcomm et al.*, Case No. 6:14-CV-00687, Dkt. No. 1, Compl. (May 2, 2014).

² See *ParkerVision Inc. v. Apple et al.*, Case No. 3:15-cv-01477, Dkt. No. 1, Compl. (Dec. 14, 2015).

³ See *ParkerVision, Inc. v. Qualcomm et al.*, Case No. 6:14-CV-00687, Dkt. No. 309, Amended Case Management and Scheduling Order (Aug. 30, 2019); *id.*, Dkt. Nos. 376 and 377, Joint Motion and Order to Stay by All Plaintiffs (Mar. 17, 2020).

Case also is currently stayed in light of that pandemic and the associated shutdowns, and it is highly unlikely that this case could go to trial until next year.⁴ Neither expert reports nor discovery are completed in the Jacksonville Case. As to fact discovery in Jacksonville, there are two pending motions to compel further 30(b)(6) deposition testimony from Qualcomm and Apple,⁵ and the parties still are negotiating the proper scope (if any) of e-mail discovery (*i.e.* terms and custodians) prior to any actual production of those documents.⁶ As to expert discovery in Jacksonville, the deadlines have been stayed, rebuttal reports have not yet been served, and there have been no expert depositions in the case. The parties were set to submit a joint status report on or before April 24, 2020 with an amended proposed case management and scheduling order.⁷

The first-filed Orlando Case and its subject matter overlap considerably with this Jacksonville Case, including in areas such as: the technology of the asserted patents; the specifications of the asserted patents; the accused Qualcomm products; the asserted damages periods; some claim elements of the claimed subject matter; and the asserted defenses. Thus,

⁴ See *ParkerVision Inc. v. Apple et al.*, Case No. 3:15-cv-01477, Dkt. No. 239, Order Administratively Closing Proceedings (Mar. 20, 2020).

⁵ See *ParkerVision Inc. v. Apple et al.*, Case No. 3:15-cv-01477, Dkt. Nos. 221 (Feb. 12, 2020), 223 (Feb. 12, 2020).

⁶ Defendant Qualcomm also has a pending motion for ParkerVision to comply with the Court's Orders (Dkt. 189) and Defendant Apple has a pending motion to sever and stay (Dkt. 211).

⁷ See *ParkerVision Inc. v. Apple et al.*, Case No. 3:15-cv-01477, Dkt. No. 239, Order Administratively Closing Proceedings (Mar. 20, 2020).

determinations in the Orlando Case on the operation of the accused products which also are at-issue in the Jacksonville Case could result in efficiencies.

For example, in the Orlando Case, ParkerVision currently is asserting two receiver patents (the '907 and '177 patents) and two transmitter patents (the '940 and '372 patents).⁸ The ParkerVision receiver patents asserted in the Orlando Case are related to the '528 Patent asserted in the Jacksonville Case. For example, all three patents claim priority back to U.S. application "Method and System for Down-Converting Electromagnetic Signals," Ser. No. 09/176,022, filed on October 21, 1998, and which is now U.S. Patent No. 6,061,551, and the '528 Patent is a great-grandchild of the '177 Patent.⁹ Moreover, all three patents include much of the same disclosure in their specifications and many of the same figures.

The claims of all three receiver patents read on down-conversion circuits. Many of the requirements of the various claims overlap including the following claim terms: "switch" and "switching device" (claim 1 of the '528 patent and claim 12 of the '907 Patent, respectively), "energy storage device" (claim 1 of the '528 Patent and claims 1 and 13 of the '907 Patent), "differential amplifier" (claim 1 of the '528 Patent and claim 6 of the '177 Patent), "combines" and "combiner module" (claim 1 of the '528 Patent and claims 1 and 5 of the '177 Patent).¹⁰

⁸ See *ParkerVision, Inc. v. Qualcomm et al.*, Case No. 6:14-CV-00687, Dkt. No. 297 at 7 (July 23, 2019).

⁹ See *ParkerVision, Inc. v. Qualcomm et al.*, Case No. 6:14-CV-00687, Dkt. No. 26, Amended Compl., Ex. H ('907 Patent), and Ex. I ('177 Patent) (Aug. 21, 2014); *ParkerVision Inc. v. Apple et al.*, Case No. 3:15-cv-01477, Dkt. No. 1, Compl., Ex. 4 ('528 Patent) (Dec. 14, 2015).

¹⁰ See n.9, *supra*.

Resolving whether those claim terms are present in the accused devices potentially could streamline the Jacksonville Case substantially.

The Jacksonville Case does not concern any Qualcomm RF chips that are not already accused of infringement in the Orlando Case. In the Orlando Case, ParkerVision asserts that eighteen (18) Qualcomm receiver dies¹¹ infringe ParkerVision's patents. These accused Qualcomm chips in Orlando include all of the chips accused in the Jacksonville case, plus at least eleven (11) additional accused dies.

The damages period in the Jacksonville Case is similarly subsumed by that of the Orlando Case. In the Jacksonville Case, the alleged damages period runs from August 25, 2015 through October 21, 2018 (*i.e.*, from the '528 Patent's issue date through its expiration date). Because the patents asserted in the Orlando Case have earlier issue dates, the alleged damages period in the Orlando Case is longer than the Jacksonville Case, running from at least the filing date of that lawsuit, May 2, 2014 through at least October 21, 2018.

The Orlando and Jacksonville Cases also share numerous issues, including infringement and invalidity issues concerning common claim elements, discussed above.

B. Staying The Jacksonville Case Will Promote Judicial Economy

Because the first-filed Orlando Case encompasses more patents, more products, and a greater period of damages than the Jacksonville Case, a settlement in the Orlando Case likely will eliminate the need to proceed with the similar Jacksonville case. Any settlement of the Orlando Case—whether before or after a jury verdict or other judgment—likely would be part

¹¹ Dies are the pieces of silicon that are inserted into different chips.

of a larger global settlement of any and all ParkerVision patent claims against Qualcomm and its products. Thus, any settlement likely would moot and resolve the causes of action presented in the Jacksonville Case.

Similarly, a resolution in the Orlando Case of some of the common issues between it and the Jacksonville case could eliminate or reduce the litigation of those issues in the Jacksonville Case. For example, findings of validity or non-infringement in the Orlando Case could reduce the number of disputed issues in the Jacksonville Case.

Therefore, to avoid the waste of the extensive judicial and party resources needed to pursue and try similar patent infringement cases at the same time, the Court should exercise its discretion to stay this Jacksonville Case pending a final judgment or settlement in the related Orlando Case and thereby potentially avoid the need for any further work in the Jacksonville Case. *See, e.g., Lanard Toys Ltd. v. Toys “R” Us-Delaware, Inc.*, No. 3:15-cv-849-J-34PDB, 2017 U.S. Dist. LEXIS 187073, at *15 (M.D. Fla. Nov. 13, 2017) (granting motion to stay pending resolution of other pending case to increase efficiency, lower litigation costs, and pose less of a risk of inconsistent judgments).

This proposed stay would last until judgment is final and all appeals have been exhausted in the Orlando Case. To further preserve judicial and party resources, if the Jacksonville Case for some reason has not been mooted or otherwise resolved before the lifting of the requested stay, the parties agree that, once the stay is lifted, the Jacksonville Case would resume from its current point in the Case Management Schedule, without reopening or extending any deadlines that have already passed in the litigation. For example, fact discovery would remain closed (subject to the outcome of motions to compel additional fact discovery),

pending motions still would need resolution unless withdrawn, and the next deadline would be the submission of rebuttal expert reports.

IV. Conclusion

For the foregoing reasons, the Court should grant this unopposed motion and stay this action pending a final judgment in the first-filed Orlando Case.

Local Rule 3.01(g) Certification

In accordance with Local Rule 3.01(g), undersigned counsel certifies that prior to filing this motion, counsel for all parties conferred in good faith to resolve or narrow the issues presented in the foregoing motion of ParkerVision and Apple. Counsel for Qualcomm Incorporated advised that Qualcomm does not oppose the motion.

[Signature blocks on following pages]

Dated: April 21, 2020

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CERTIFICATE OF SERVICE

I certify that on April 21, 2020, I electronically filed the foregoing with the Clerk of Court by using the CM/ECF system. I further certify that I mailed the foregoing document and the notice of electronic filing by first-class mail to the following non-CM/ECF participants:
none.

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