

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDIATEK INC.,
Petitioner,

v.

PARKERVISION, INC.,
Patent Owner.

IPR2025-00030
Patent 8,498,593 B2

Before MICHAEL R. ZECHER, BARRY L. GROSSMAN, and
IFTIKHAR AHMED, *Administrative Patent Judges*.

GROSSMAN, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. Background and Summary

MediaTek, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review (“IPR”) of claims 1–20 (the “challenged claims”) of U.S. Patent No. 8,498,593 B2 (Ex. 1001, “the ’593 patent”). ParkerVision, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 8, “Prelim. Resp.”).

We have jurisdiction under 35 U.S.C. § 314. Under § 314, an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). The Board determines whether to institute a trial on behalf of the Director. 37 C.F.R. § 42.4(a).

Petitioner has the burden of proof. *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (“In an IPR, the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.”).

A decision to institute is “a simple yes-or-no institution choice respecting a petition, embracing all challenges included in the petition.” *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018).

For each of the asserted grounds of unpatentability, Petitioner provides a comprehensive argument as to why the challenged claims are not patentable based on the asserted references.

In its 4-page Preliminary Response, Patent Owner asserts only that: (1) the IPR proceeding violates constitutional due process; and (2) instituting the IPR would duplicate ongoing proceedings and cause inefficiencies.

After considering the Petition, the Preliminary Response, and the evidence of record, based on the analysis in this Decision, we determine that Petitioner has demonstrated that there is a reasonable likelihood that at least one of the challenged claims is unpatentable. Accordingly, we institute an *inter partes* review of all challenged claims and on all grounds asserted in the Petition.

B. Real Parties-in-Interest

Petitioner identifies itself, MediaTek USA Inc., MTK Wireless Limited (UK), Gaintech Co. Limited, and MediaTek Investment Singapore Pte. Ltd. as the real parties-in-interest. Pet. 99.

Patent Owner identifies itself as the sole real party-in-interest. Paper 3, 1.

C. Related Matters

The parties indicate that the '593 patent is the subject of the following district court proceeding: *ParkerVision v. MediaTek, Inc.*, No. 6:23-cv-00732 (W.D. Tex. filed October 27, 2023. Pet. 100; Paper 3, 1.

Patent Owner states it “is not aware of any other judicial or administrative matter involving the '593 Patent that would affect, or be affected by, a decision in the requested IPR.” Paper 3, 2.

D. The '593 patent

The '593 patent is titled “Switching Power Supply.” Ex. 1001, code (54). As summarized in the Abstract, the disclosed power supply: can include a switching device and an aperture generator and control module. The switching device can be configured to down-convert an input voltage and pass the down-converted input voltage to an output voltage node. The aperture generator and control module can be configured to control the switching device. In response to a power efficiency of the power supply

exceeding a predetermined threshold, the aperture generator and control module can deactivate the switching device and pass the input voltage to the output voltage node.

Ex. 1001, code (57).

As disclosed in the '593 patent, the efficiency of a power supply directly affects the efficiency of the power amplification system using the power supply. *Id.* at 1:29–31. In mobile or portable battery powered wireless devices, the voltage and current requirements of the radio frequency (RF) transmitter used in the devices are largely determined by the power amplifier technology and system requirements. *Id.* at 1:31–35. Thus, the power supply efficiency not only affects the efficiency of the power modulation and amplification system, but also the efficiency of the mobile device using the power amplification system. *Id.* at 1:36–39.

According to the '593 patent, “[t]here is a need therefore for power supply architectures, design techniques, and operation modes that affect and/or optimize the overall system efficiency of the modulation and power amplification system.” *Id.* at 1:40–43.

The '593 patent discloses and claims embodiments relating to a “power supply,” a “method of controlling a power supply,” and a “system” that “includes an electronic device and a power supply.” *Id.* at 2:12–32. An optional bypass switch architecture can be used as part of the power supply design to further enhance the system efficiency, reduce the system noise floor, and increase the available output current of the power supply. *Id.* at 3:55–59. According to the '593 patent, “[t]hese advantages reduce the amount of circuitry required to support multiple modulation methods and output powers.” *Id.* at 3:59–61.

Figure 4 from the '593 patent, annotated by Petitioner (Pet. 8), is reproduced below.

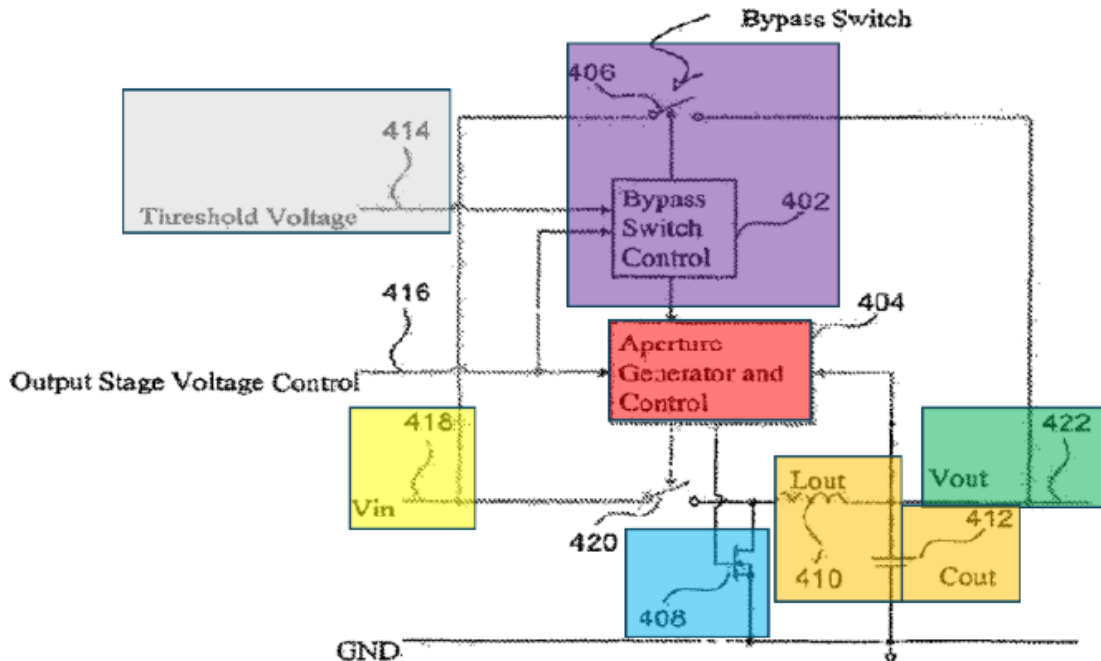


Figure 4, annotated by Petitioner, illustrates “an example step down switching power supply having a bypass switch architecture.” Ex. 1001, 3:5–6. As shown in Figure 4, power supply 400 receives an “input voltage signal” V_{IN} 418 (yellow), an “Output Stage Voltage Control signal” 416, and a “Threshold Voltage signal” 414 (grey). *Id.* at 6:38–40.

Input voltage signal V_{IN} 418 is typically received from a battery and is set according to, among other requirements, the device using the power amplifier. *Id.* at 6:41–43.

“Output Stage Voltage Control signal 416”¹ is received from a control module configured to control the power supply voltage provided to the output stage of the power amplifier. *Id.* at 6:46–48. In the embodiment illustrated in Figure 4, “Output Stage Voltage Control signal 416” controls an “Aperture Generator and Control module 404” (red) of power supply 400.

Power supply 400 operates in two modes: normal mode and bypass mode. *Id.* at 7:9–10.

In normal mode, input voltage signal V_{IN} 418 is received at input switch 420, which is controlled by “Aperture Generator and Control module” 404. *Id.* at 7:11–13. “Aperture Generator and Control module” 404 (red) is configured to control input switch 420 to couple input Voltage signal V_{IN} 418 to the collector/drain of switching transistor 408 (blue). *Id.* at 7:14–16.

In bypass mode, V_{IN} 418 is directly coupled to the power supply output node, which provides power Supply output voltage V_{OUT} 422. *Id.* at 7:46–48. “Bypass Switch Control module” 402 (purple) receives “Threshold Voltage signal” 414 (grey) and “Output Stage Voltage Control signal” 416. *Id.* at 7:50–52. “Threshold Voltage signal” 414 determines at which value of the power supply output voltage power supply 400 switches to bypass mode. *Id.* at 7:52–54. “Output Stage Voltage Control signal” 416 includes information about the target power supply output voltage and thus allows

¹ We have used the capitalization of terms from the '593 patent, which is somewhat inconsistent. For example, the term “input voltage signal” is not capitalized, but the term “Output Stage Voltage Control signal” is capitalized.

Bypass Switch Control module 402 (purple) to determine the value of the power supply output voltage. *Id.* at 7:54–58.

The circuit pathways for normal and bypass mode are annotated by Petitioner (Pet. 10) on Figure 4, reproduced below.

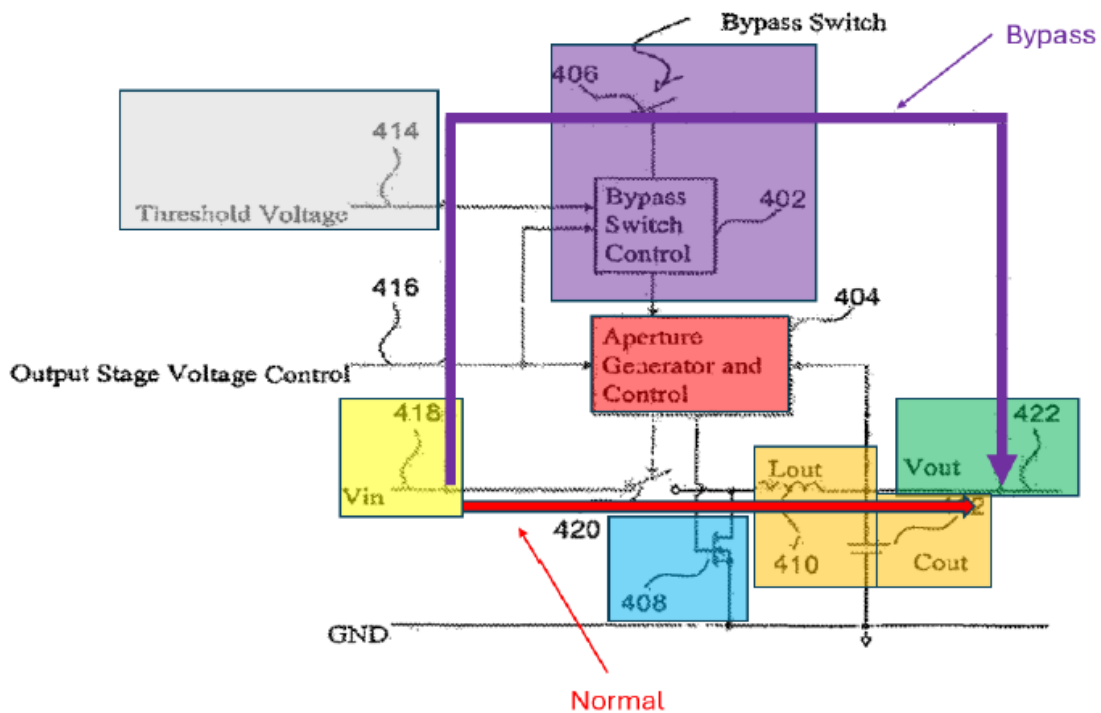


Figure 4, annotated by Petitioner, shows both the normal pathway (red) and bypass pathway (purple).

E. Illustrative Claim

Petitioner challenges claims 1–20. Claims 1, 9, and 15 are independent claims. Independent claim 1 is directed to a “power supply.” Ex. 1001, 11:16–25. Independent claim 9 is directed to a “method for controlling a power supply.” *Id.* at 11:54–12:4. Independent claim 15 is directed to a “system comprising an electronic device and a power supply.” *Id.* at 12:24–38. Except for the inclusion of an “electronic device” coupled to the power supply in claim 15, claims 1 and 15 are identical.

Independent claim 1 is illustrative and is reproduced below with bracketed labels employed by Petitioner to facilitate analysis and discussion. *See, e.g.*, Pet. XV (Listing of Challenged Claims).

1[pre] A power supply comprising:

1[a] a switching device configured to down-convert an input voltage and pass the down-converted input voltage to an output voltage node; and

1[b1] an aperture generator and control module configured to control the switching device,

1[b2] wherein, in response to a power efficiency of the power supply exceeding a predetermined threshold, the aperture generator and control module deactivates the switching device and passes the input voltage to the output voltage node.

Ex. 1001, 11:16–25.

F. Prior Art and Asserted Grounds

Petitioner asserts that one or more of the challenged claims would have been obvious on the following six grounds:

Claim(s) Challenged	35 U.S.C. §²	Reference(s)/Basis
1, 2, 5–7, 9, 11, 12, 15	103	Hau ³ and Yoshida ⁴

² The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 296–07 (2011), took effect on September 16, 2011. The changes to 35 U.S.C. §§ 102 and 103 in the AIA do not apply to any patent application filed before March 16, 2013. Because the application for the patent at issue in this proceeding was filed before March 16, 2013, we refer to the pre-AIA version of the statute. Ex. 1001, codes (21), (22).

³ U.S. Patent No. 7,427,897, filed February 8, 2006, Ex. 1007 (“Hau”).

⁴ U.S. Patent No. 7,061,213, filed July 3, 2003, Ex. 1008 (“Yoshida”).

Claim(s) Challenged	35 U.S.C. §²	Reference(s)/Basis
3, 4, 8, 10, 13, 14, 17–20	103	Hau, Yoshida, and Sahu ⁵
16	103	Hau, Yoshida, and Lejon ⁶
1–5, 9–11, 15, 19, 20	103	Canyon ⁷ and Ranjan ⁸
6–8, 12–14	103	Canyon, Ranjan, and Hau
16–18	103	Canyon, Ranjan, and Lejon

Petitioner also relies on the Declaration testimony of Lawrence E. Larson, Ph.D. *See* Ex. 1003.⁹

II. ANALYSIS

A. *Legal Standards*

Section 103 of the United States Code forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject

⁵ “A High-Efficiency Linear RF Power Amplifier With a Power-Tracking Dynamically Adaptive Buck-Boost Supply,” IEEE Transactions on Microwave Theory and Techniques, Vol. 52, No. 1, January 2004, Ex. 1009, (“Sahu”).

⁶ WO 2007/084033 A1, filed January 23, 2006, Ex. 1013 (“Lejon”).

⁷ U.S. Patent No. 6,646,511, filed Nov. 12, 2002, Ex. 1011, (“Canyon”).

⁸ “Microwave Power Amplifiers with Digitally-Controlled Power Supply Voltage for High Efficiency and High Linearity,” 2000 IEEE MTT-S Digest, Ex. 1012 (“Ranjan”).

⁹ Dr. Larson’s experience in industry and academia is summarized in his testimony and his Curriculum Vitae (Ex. 1003 ¶¶ 5–20; Ex. 1004).

matter and the prior art; (3) the level of ordinary skill in the art; and (4) when available, evidence such as commercial success, long felt but unsolved needs, and failure of others.¹⁰ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966); see *KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”). The Court in *Graham* explained that these factual inquiries promote “uniformity and definiteness,” for “[w]hat is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context.” 383 U.S. at 18.

The U.S. Supreme Court made clear that we apply “an expansive and flexible approach” to the question of obviousness. *KSR*, 550 U.S. at 415. Whether a patent claiming the combination of prior art elements would have been obvious is determined by whether the improvement is more than the predictable use of prior art elements according to their established functions. *Id.* at 417. To support this conclusion, however, it is not enough to show merely that the prior art includes separate references covering each separate limitation in a challenged claim. *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011). Rather, obviousness additionally requires that a person of ordinary skill at the time of the invention “would have selected and combined those prior art elements in the normal course of research and development to yield the claimed invention.” *Id.*

In determining whether there would have been a motivation to combine prior art references to arrive at the claimed invention, it is

¹⁰ On the record before us, at this preliminary stage of this proceeding, Patent Owner does not direct us to any objective evidence of non-obviousness in its Preliminary Response.

insufficient to simply conclude the combination would have been obvious without identifying any reason *why* a person of skill in the art would have made the combination. *Metalcraft of Mayville, Inc. v. Toro Co.*, 848 F.3d 1358, 1366 (Fed. Cir. 2017).

Moreover, in determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 164 (Fed. Cir. 1985) (“It is elementary that the claimed invention must be considered as a whole in deciding the question of obviousness.”); *see also Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1537 (Fed. Cir. 1983) (“[T]he question under 35 U.S.C. § 103 is not whether the differences *themselves* would have been obvious. Consideration of differences, like each of the findings set forth in *Graham*, is but an aid in reaching the ultimate determination of whether the claimed invention *as a whole* would have been obvious.”).

As a factfinder, we also must be aware “of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning.” *KSR*, 550 U.S. at 421.

Applying these general principles, we consider the evidence and arguments presented by the parties.

B. Claim Construction

We construe each claim “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. [§] 282(b).” 37 C.F.R. § 42.100(b) (2021). Under this standard, claim terms are generally given their ordinary and customary meaning, as would have

been understood by a person of ordinary skill in the art at the time of the invention and in the context of the entire patent disclosure. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–14 (Fed. Cir. 2005) (en banc) (“We have frequently stated that the words of a claim ‘are generally given their ordinary and customary meaning.’” (citations omitted)).

Petitioner contends that the following two claim terms require construction: (1) “power efficiency” (independent claims 1, 9, and 22) should be construed as “the output power of the power supply compared to its input power”; and (2) “aperture generator and control module” (independent claims 1 and 15) should not be construed as a means-plus-function term, but rather “refers to a known structure which controls the gain of a down-converting transistor by varying the width (aperture) of control pulses.” Pet. 11–16. Patent Owner does not address Petitioner’s proposed claim constructions. *See generally* Prelim. Resp.

We do not perceive the need to construe any claim terms. Claims must be construed “only to the extent necessary to resolve the controversy.” *AstraZeneca AB v. Mylan Pharms. Inc.*, 19 F.4th 1325, 1345 (Fed. Cir. 2021) (quoting *Vivid Techs., Inc. v. American Science & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999); *see also Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“Because we need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy,’ we need not construe the claim preambles here where the construction is not ‘material to the [obviousness] dispute.’” (citations omitted)).

C. Level of Ordinary Skill in the Art

The level of skill in the art is “a prism or lens” through which we view the prior art and the claimed invention. *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001). “This reference point prevents . . . factfinders from using their own insight or, worse yet, hindsight, to gauge obviousness.” *Id.*

“The *Graham* analysis includes a factual determination of the level of ordinary skill in the art. Without that information, a . . . court cannot properly assess obviousness because the critical question is whether a claimed invention would have been obvious at the time it was made to one with ordinary skill in the art.” *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986); *see also Ruiz v. A.B. Chance*, 234 F.3d 654, 666 (Fed. Cir. 2000) (“The determination of the level of skill in the art is an integral part of the *Graham* analysis.”).

Factors pertinent to a determination of the level of ordinary skill in the art include: (1) educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of workers active in the field. *Env’t Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 696–697 (Fed. Cir. 1983) (citing *Orthopedic Equip. Co. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1381–82 (Fed. Cir. 1983)). Not all such factors may be present in every case, and one or more of these or other factors may predominate in a particular case. *Id.* Moreover, these factors are not exhaustive but are merely a guide to determining the level of ordinary skill in the art. *Daiichi Sankyo Co. v. Apotex, Inc.*, 501 F.3d 1254, 1256 (Fed. Cir. 2007). In determining a level

of ordinary skill, we also may look to the prior art, which may reflect an appropriate skill level. *Okajima*, 261 F.3d at 1355.

Relying on the testimony of Dr. Larson, Petitioner asserts that a person of ordinary skill in the art would have had:

at least a bachelor's degree in electrical engineering or a related subject and two or more years of experience in the field of RF circuit design and/or power supplies for RF circuits, or at least five years of work experience and training in the design and development of RF circuits and/or power supplies for RF circuits. Less work experience may be compensated by a higher level of education, such as a master's degree.

Pet. 11 (citing Ex. 1003 ¶¶ 22–33).

Dr. Larson's Declaration testimony states he considered some of the factors listed above. Ex. 1003 ¶ 21. Dr. Larson testifies that, in his opinion, the level of ordinary skill is as stated by Petitioner. *Id.* ¶ 22.

Patent Owner does not assert a level of ordinary skill, nor does Patent Owner dispute Petitioner's definition of the level of ordinary skill. *See*, Prelim. Resp., *generally*.

For purposes of this Decision, based on the prior art, the sophistication of the disclosed technology in the '593 patent, and Dr. Larson's undisputed testimony, we adopt Petitioner's definition of the level of ordinary skill.¹¹

*D. Patent Owner's Constitutional Due Process
and Discretionary Denial Arguments*

Patent Owner's Preliminary Response does not assert any arguments concerning the merits of Petitioner's asserted grounds of unpatentability.

¹¹ Any determination, no matter how designated in this Decision (except our decision to institute), is preliminary and non-binding.

Instead, Patent Owner asserts only (1) “the IPR proceeding violates constitutional due process” (Prelim. Resp. 1–3), and (2) “instituting the IPR would duplicate ongoing proceedings and cause inefficiencies” (*id.* at 3–4). Patent Owner does not cite any authority or evidence to support these arguments, nor does Patent Owner distinguish these arguments from authority to the contrary.

1. Constitutional Due Process

Patent Owner asserts five reasons why an IPR proceeding is “an unconstitutional mechanism for challenging the validity of existing patents.” Prelim. Resp. 1. Patent Owner cites no authority or evidence to support this argument.

a) Preponderance of the Evidence

Patent Owner asserts IPR proceedings are unconstitutional because they “apply a preponderance of the evidence standard to determine patent validity, which is a lower burden of proof than the clear and convincing evidence standard required in district court.” Prelim. Resp. 1. According to Patent Owner “[t]his discrepancy undermines the presumption of validity afforded to issued patents and makes it easier to invalidate a patent in an administrative forum than in a judicial proceeding.” Patent Owner cites no authority or evidence to support this argument. Moreover, the Supreme Court has held that the decision to grant a patent “is a matter involving public rights—specifically, the grant of a public franchise. *Inter partes* review is simply a reconsideration of that grant, and Congress has permissibly reserved the [U.S. Patent and Trademark Office’s (“USPTO’s” or “PTO’s”)] authority to conduct that reconsideration.” *Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 584 U.S. 325, 334–35 (2018).

b) Article III Court

Patent Owner also argues that IPR proceedings are unconstitutional because “the [Patent Trial and Appeal Board (“PTAB”)] lacks the adjudicative independence of an Article III court.” Prelim. Resp. 2. Patent Owner cites no authority or evidence to support this argument. Indeed, Patent Owner fails to recognize Supreme Court authority to the contrary. In *Oil States*, the Supreme Court held the PTO can conduct *inter partes* reviews “without violating Article III.” *Oil States*, 584 U.S. at 335; *see also, id.* at 336 (“the determination to grant a patent is a “matte[r] involving public rights.’ It need not be adjudicated in Article III court.”); *id.* at 337 (“the public-rights doctrine covers the matter resolved in inter partes review. The Constitution does not prohibit the Board from resolving it outside of an Article III court.”).

Related to this argument, Patent Owner “also submits that IPR proceedings deprive patent owners of their Seventh Amendment right to a jury trial and to have the validity of patents determined in Article III courts in view of the Supreme Court’s recent decision in *SEC v. Jarkesy*, 603 U.S. 109 (2024).” Prelim. Resp. 3. This issue too was addressed by the Supreme Court in *Oil States*. The Supreme Court held:

when Congress properly assigns a matter to adjudication in a non-Article III tribunal, “the Seventh Amendment poses no independent bar to the adjudication of that action by a nonjury factfinder.” *Granfinanciera, S.A. v. Nordberg*, 492 U.S. 33, 53–54 (1989). . . . Thus, our rejection of *Oil States*’ Article III challenge also resolves its Seventh Amendment challenge. Because inter partes review is a matter that Congress can properly assign to the PTO, a jury is not necessary in these proceedings.

Oil States, 584 U.S. at 345. The majority opinion in *Jarkesy* cited *Oil States* without questioning its reasoning, which, in our view, is a clear affirmation of *Oil States*' continued validity.

c) Financial Interest

Patent Owner next argues “the USPTO’s financial interest in IPR proceedings raises serious concerns about impartiality.” Prelim. Resp. 2. Again, Patent Owner cites no authority or evidence to support this argument. The governing statute enacted by Congress requires that “[t]he Director shall establish, by regulation, fees to be paid by the person requesting the [*inter partes*] review, in such amounts as the Director determines to be reasonable, considering the aggregate costs of the review.” 35 U.S.C. § 311(a).

d) Live Witnesses and Cross-Examination

Patent Owner asserts a violation of constitutional due process because “PTAB decisions are reached only on the basis of paper briefs without live witness testimony and live cross-examination.” Prelim. Resp. 2. Patent Owner cites no authority or evidence to support this argument. Indeed, this argument ignores the guidance from the PTO regarding IPR proceedings. As stated in our Consolidated Trial Practice Guide under the heading “Live testimony,” “[c]ross-examination may be ordered to take place in the presence of an administrative patent judge, which may occur at the deposition or oral argument.” Patent Trial and Appeal Board Consolidated Trial Practice Guide, 31 (Nov. 2019), *available at* <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf> (“TPG”). As stated in the TPG, “requests for live testimony will be approached by the Board on a case-by-case basis.” *Id.* at 32. Factors that may be considered

by the Board in determining whether to permit live testimony are set forth in the Board's precedential decision in *K-40 Electronics, LLC v. Escort, Inc.*, IPR2013-00203, Paper 34 at 3 (PTAB May 21, 2014) (Order—Request for Live Testimony) (precedential). In the context of the oral hearing, the TPG states:

The Board receives relatively few requests for presenting live testimony. When requested by a party, and where the panel believes live testimony will be helpful in making a determination, the Office will permit live testimony at the oral hearing. The Board will consider such requests on a case-by-case basis, but does not expect to permit live testimony in every case where there is conflicting testimony.

The format for presenting live testimony is left to the discretion of the panel. . . . The Board may direct questions to any witness who testifies in person at the hearing.

In general, a request for live testimony is more likely to be granted where the Board determines that the demeanor of a witness is critical to evaluating that witness's credibility. A party requesting live testimony should be prepared to explain why and how this consideration applies.

TPG at 85.

e) Non-Appealability of Institution Decisions

Patent Owner also asserts that “the non-appealability of the PTAB's institution decisions exacerbates due process concerns” because, allegedly, “it can significantly alter the patent owner's rights.” Prelim. Resp. 2–3. Patent Owner cites no authority or evidence to support this argument.

Additionally, Patent Owner asserts that “the same PTAB judges who determine institution are then the same PTAB judges to decide the merits.” *Id.* at 3. The U.S. Court of Appeals for the Federal Circuit, however, has held that there no due process violation when the same panel of PTAB

judges decides both the decision on institution and the final written decision. *Ethicon Endo Surgery Inc. v. Covidien LP*, 812 F.3d 1023, 1031 (Fed. Cir. 2016) (“We see no due process concerns combining the functions of initial decision and final disposition on the merits.”). This is consistent with the common practice at the trial level in most Article III courts, where a single judge decides pre-trial motions, including summary judgment and 12(b)(6)¹² motions, and also decides the merits at trial.

f) Conclusion on Constitutional Due Process

Patent Owner has failed to provide evidence, authority, or persuasive argument in support of its constitutional due process arguments. Accordingly, we do not deny the Petition on these grounds.

2. Discretionary Denial

Regarding discretionary denial of the Petition, the entirety of Patent Owner’s argument is:

institution of the present proceeding will unnecessarily duplicate proceedings already ongoing in the district court. The IPR will not eliminate fact discovery, expert discovery, dispositive motions, or trial in the parallel Texas litigation. As such, institution would impose unnecessary costs and inefficiencies on both [Patent Owner] and the judicial system, further weighing against institution.

Prelim. Resp. 3–4. Patent Owner cites no authority or evidence to support this argument.

Institution of an *inter partes* review is discretionary. *See* 35 U.S.C. § 314(a) (authorizing institution of an *inter partes* review under particular circumstances, but not requiring institution under any circumstances);

¹² Fed. R. Civ. P. 12(b)(6) concerns the defense of “failure to state a claim upon which relief can be granted.”

Cuozzo Speed Techs., LLC v. Lee, 579 U.S. 261, 273(2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *Harmonic*, 815 F.3d at 1367 (“[T]he [U.S. Patent and Trademark Office] is permitted, but never compelled, to institute an IPR proceeding.”).

In exercising our discretion, we are guided by the Board’s precedential decisions in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (Order Authorizing Supplemental Briefing on Discretionary Denial) (precedential) (“*Fintiv*”) and *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (Decision Granting Institution) (precedential as to § II.A) (“*Sotera*”).

When determining whether to exercise discretion to deny institution in view of a parallel district court proceeding, we consider the following six factors:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

Fintiv, Paper 11, 5–6. These factors relate to “whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Id.* at 6. In evaluating the *Fintiv* factors, we take “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review,” recognizing that “there is some overlap among these factors” and that “[s]ome facts may be relevant to more than one factor.” *Id.*

In applying *Fintiv*, the Board may consider any evidence that the parties make of record that bears on the proximity of the district court’s trial date, including median time-to-trial statistics for civil actions in the district court in which the parallel litigation resides.

Here, the only evidence of record that relates to the exercise of our discretion to institute a trial is a *Sotera* stipulation letter dated October 18, 2024, from counsel for Petitioner to counsel for Patent Owner stating:

that, if the PTAB institutes an *inter partes* review proceeding (“IPR”) for U.S. Patent No. 8,298,593^[13] on the grounds presented in [Petitioner’s] petition, [Petitioner] will not pursue an invalidity defense in *ParkerVision, Inc. v. MediaTek Inc.*, Case No. 6:23-cv-00732 (W.D. Tex.) that the patent claims subject to the instituted IPR are invalid based on the same grounds as in the petition or any grounds that could have reasonably been raised in the petition.

Ex. 1029.

We also note, as explained below, that we have determined, based on the evidence before us supporting institution, and the lack of any opposing

¹³ Petitioner’s reference to U.S. Patent No. 8,298,593 appears to be a typographical error. Instead, we understand Petitioner to refer to U.S. Patent No. 8,498,593 B2, which is at issue in this IPR.

evidence, that Petitioner is reasonably likely to prevail in proving that the challenged claims are not patentable.

Based on the evidence before us, and considering the *Fintiv* factors as part of a holistic analysis, we are persuaded that the interests of the efficiency and integrity of the patent system would be best served by *not* invoking our discretion under 35 U.S.C. § 314(a) to deny institution.

We now turn to the merits of Petitioner's asserted grounds of unpatentability.

E. Asserted Grounds

We have reviewed Petitioner's six different asserted grounds of unpatentability that collectively challenging claims 1–20 on various combinations of six different references. *See* Section I.F of this Decision identifying the asserted Grounds and references. We have also reviewed Dr. Larson's cited testimony in support of Petitioner's asserted unpatentability. We need not repeat Petitioner's 100-page detailed analysis of the asserted grounds and references, as well as the mapping of the references to the challenged claims.

For example, for independent claim 1, Petitioner maps the cited references against each element and limitation in claim 1. *See* Pet. 23–33. Throughout this mapping of claim 1 against the cited references, Petitioner provides specific citations to the cited references as well as applicable citations to Dr. Larson's testimony. *See, e.g., id.* at 24–26 (for clause 1[a] from claim 1), citing annotated figures from the cited references, specific disclosures from the references, and supporting testimony from Dr. Larson).

Petitioner also explains why a person of ordinary skill would have been motivated to combine the cited references, again citing annotated

figures from the cited references, specific disclosures from the references, and supporting testimony from Dr. Larson. *See, id.* at 21–23.

Based on our review of the evidence and arguments, we determine that Petitioner has established a reasonable likelihood that the cited references disclose all the limitations of the challenged claims, and that Petitioner has established why it would have been obvious to a person of ordinary skill to combine the references, as proposed, with a reasonable expectation of success, for the reasons advocated by Petitioner on all asserted Grounds. *See* Pet. 16–97 (citing Ex. 1003 ¶¶ 96–268).

As stated above, Patent Owner does not address the merits of any of the challenged claims. Thus, there is no contrary evidence rebutting Petitioner’s assertions.

III. CONCLUSION

We have determined that there is a reasonable likelihood that Petitioner will prevail in demonstrating the unpatentability of at least one challenged claim. Accordingly, we institute an *inter partes* review on all challenged claims on each asserted ground. A decision to institute is “a simple yes-or-no institution choice respecting a petition, embracing all challenges included in the petition.” *PGS Geophysical*, 891 F.3d at 1360.

Our review of the Petition under 35 U.S.C. § 314 is not to determine whether an individual asserted fact is indisputable or whether a preponderance of the evidence supports Petitioner. Our review is to determine whether the totality of the information presented in the Petition and Preliminary Response shows that there is a reasonable likelihood that Petitioner would prevail with respect to at least one of the claims challenged

in the Petition. “The ‘reasonable likelihood’ standard is a somewhat flexible standard that allows the Board room to exercise judgment.” TPG at 53.

This is a decision to institute an *inter partes* review under 35 U.S.C. § 314. Our determinations at this stage of the proceeding are preliminary, and based on the evidentiary record developed thus far. This is not a final decision as to the patentability of claims for which *inter partes* review is instituted. Any final decision will be based on the record as fully developed during trial, including all arguments and evidence in the Patent Owner’s Response,¹⁴ or submitted otherwise during trial, as permitted by our rules.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review is instituted as to claims 1–20 of the ’593 patent on each ground set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of the ’593 patent shall commence on the entry date of this Decision, and notice is hereby given of the institution of a trial.

¹⁴ See *In re Nuvasive, Inc.*, 842 F.3d 1376, 1381 (Fed. Cir. 2016) (explaining that a patent owner waives an issue presented in its preliminary response if it fails to renew the issue in its response after trial is instituted).

IPR2025-00030
Patent 8,498,593 B2

FOR PETITIONER:

Jessica C. Kaiser
Evan Day
Kyle R. Canavera
PERKINS COIE LLP
kaiser-ptab@perkinscoie.com
day-ptab@perkinscoie.com
canavera-ptab@perkinscoie.com

PATENT OWNER:

Jason S. Charkow
Richard Juang
Chandran B. Iyer
DAIGNAULT IYER LLP
jason.s.charkow@gmail.com
richard.juang@gmail.com
cbiyer@daignaultiyer.com