

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

PARKERVISION, INC.,

Plaintiff,

v.

Case No: 6:14-cv-687-Orl-40LRH

QUALCOMM INCORPORATED,
QUALCOMM ATHEROS, INC., HTC
CORPORATION and HTC AMERICA,
INC.,

Defendants.

_____ /

ORDER

This cause is before the Court on the Parties' Joint Status Report, Motion to Lift Stay, and Proposed Fifth Amended Scheduling Order (Doc. 382 (the "**Motion**")). Upon due consideration, the Motion to Lift the Stay is granted, and the proposed Fifth Amended Scheduling Order is modified as set forth herein.

I. BACKGROUND

This patent infringement litigation is complex, and the procedural history is complicated by a prior trial between the parties before another district judge, IPR proceedings, and rulings by the Federal Circuit. All of these difficulties were compounded by the COVID-19 pandemic, which resulted in a temporary stay. The Case Management Scheduling Order has been repeatedly amended. (Docs. 92, 96, 143, 239, 274, 309, 311, 313). The parties advise the Court that they are equipped, with some reservations¹, to

¹ Qualcomm submits that the pandemic and attendant restrictions concerning social distancing prevent relevant witnesses and in-house counsel from returning to their respective offices until September 8, 2020, necessitating additional time to

proceed with discovery and have proposed a Fifth Amended Scheduling Order. However, there are substantial disagreements concerning obligations and deadlines, which the Court will now resolve.

II. DISCUSSION

A. Representative Products Agreement

For the first time, Plaintiff requests the Case Management Scheduling Order (“**CMSO**”) be amended to require the parties to enter into a representative products agreement by June 29, 2020. (Doc. 382, p. 2). ParkerVision asserts that they asked Qualcomm to use the intervening weeks since the case was stayed to consider a representative products agreement. (*Id.* at p. 3). Qualcomm objects to entering into a representative product agreement because there are 10 years and multiple generations’ worth of products potentially at issue, and because ParkerVision’s final infringement contentions are not due until July 1, 2020. (*Id.* at p. 13). Additionally, fact discovery does not close until September 15, 2020, and expert reports are due—depending on the Court’s ruling—between September and December 2020. (*Id.*).

Qualcomm further argues that “[d]epending on the level of specificity in . . . [ParkerVision’s] contentions, the relevance of certain differences [between its products] may not even be known until after ParkerVision submits its expert reports.” (*Id.* at p. 14). Qualcomm underscores their commonsense argument by reminding the Court of its Order denying summary judgment which found, in part, that Qualcomm failed to carry their “burden of proving there is no material difference between the accused products in

complete pre-trial tasks. (Doc. 382, p. 11). However, Qualcomm fails to articulate *how* teleworking impedes their ability to participate in discovery.

ParkerVision I and the accused products at issue now.” (Doc. 348, p. 18). This means that there are differences between the products involved in those two cases and, presumably, across product lines.

Qualcomm is correct that nothing would stop ParkerVision from examining the allegedly infringing products, offering expert testimony that a product is representative of the other infringing products, and proceeding with their proof accordingly. Qualcomm may present evidence, including expert testimony, to contest ParkerVision’s assertion that the products are in fact representative of a larger group. Stated more directly, Qualcomm is under no obligation to stipulate that certain products are representative of other products, nor are they required to explain why they decline to so stipulate.²

The Court will not order Qualcomm to enter into a representative products agreement or explain why agreement is not possible. This ruling does not prevent ParkerVision from identifying representative products for potential use at trial.

B. Narrowing Asserted Claims and Prior Art References

ParkerVision offers to narrow their asserted claims to a total of 20 by September 9, 2020, and moves the Court to order Qualcomm to limit their prior art references and combinations to 20, with each section 103 combination being counted as a reference. (*Id.* at p. 2). The Court notes there are four patents at issue: ‘940 (10 claims), ‘372 (12 claims), ‘907 (7 claims), and ‘177 (11 claims). (Doc. 381, p. 4). The parties stipulated to the construction of five claims, leaving the Court to construe 10 claims. (*Id.* at pp. 9–10). The Court’s claim construction Order was entered on April 29, 2020. (*Id.*).

² An order forcing Qualcomm to disclose their theory as to why certain accused products are not representative may implicate attorney-client or work-product privileged communications and impermissibly shifts the burden of proof.

Previously, Plaintiff filed a motion to limit claims and prior art references on April 6, 2015 (Doc. 112), and Defendant responded on May 4, 2015 (Doc. 127). The Court addressed this issue following the first claim construction hearing on August 12, 2015. (Doc. 211). Qualcomm objected to limiting prior art references in 2015, because ParkerVision had not responded to their invalidity contentions, arguing:

ParkerVision seeks to impose those limitations [on prior art references] while keeping Defendants in the dark, requiring Defendants to select the prior art before ParkerVision provides any substantive response [to the invalidity contentions].

(Doc. 127, p. 3). Qualcomm characterized ParkerVision's failure to respond to invalidity contentions as unreasonable in that "ParkerVision has been aware of much of the art and Qualcomm's arguments since *ParkerVision I.*" (*Id.*). During oral argument, Qualcomm conceded that once ParkerVision reduced their asserted claims, it would be possible to limit the prior art. (Doc. 211; 228:18–20).³

ParkerVision offers to reduce their asserted claims from 40 to 20, making the election two months after it served amended infringement contentions. After five years of litigation, an IPR proceeding, three final written decisions of the U.S. Patent Trial and Appeal Board ("**PTAB**"), and an appeal to the Federal Circuit, Qualcomm claims that narrowing the prior art references is "premature." (Doc. 382, p. 16). Defendant argues they are entitled to "develop their record to defend themselves, including by working with

³ As of April 16, 2015, Qualcomm had identified "over 350 individual references of prior art patents, patent applications, patent publications, prior art publications, prior sales, and inventions against the patents-in-suit together with an unlimited combination of these individual references pushing the total number of prior art assertions to well over 1,000." (Doc. 112, p. 8). At that time, ParkerVision had 11 patent-in-suit with 186 claims. (*Id.* at p. 1).

experts to decide which prior art references and combinations to use.” (*Id.*). Defendant’s protest rings hollow. Qualcomm had ample opportunity to identify prior art references to challenge the four patents-in-suit and would have performed this work to prepare for the IPR. Judicial economy compels the Court to finally place limitations on the scope of the claims and defenses.

This raises the question of whether the Court has the authority to limit the number of claims and prior art references asserted by the parties. A survey of case law answers this question in the affirmative. *See, e.g., Joao Bock Transaction Sys., LLC v. Fid. Nat’l Info. Servs.*, No. 3:13-cv-223, 2014 U.S. Dist. LEXIS 189675, at *3–5 (M.D. Fla. Oct. 30, 2014) (limiting the plaintiff to no more than 25 claims in two patents); *Masimo Corp. v. Philips Elecs. N. Am. Corp.*, No. 1-09-cv-00080, 2013 U.S. Dist. LEXIS 8716, at *16–28 (D. Del. Jan. 23, 2013) (requiring the defendant to identify no more than 40 prior art references when the plaintiff reduced its asserted claims to 30); *see also Rambus Inc. v. Micron Tech. Inc.*, No. 5-06-cv-00244, 2008 U.S. Dist. LEXIS 76217, at *28 (N.D. Cal. Aug. 27, 2008) (“It is hard for the court to imagine a legitimate basis for asserting more than two allegedly anticipating references and two or three obviousness combinations per claim.”).

Accordingly, the Court sets the following deadlines:

On or before September 9, 2020, ParkerVision shall narrow its asserted claims to no more than 20. On or before September 23, 2020, Qualcomm shall narrow its asserted prior art, with each section 103 combination being one reference, to 30 total references. This Order may be modified upon a showing of good cause and lack of prejudice to the non-moving party.

C. Expert Reports

The Court orders the following schedule for expert reports:

Opening expert reports: October 9, 2020

Rebuttal expert reports: November 9, 2020

Expert discovery closes: November 27, 2020

D. Dispositive and *Daubert* Motions

The Court orders the following schedule:

Dispositive and *Daubert* Motions: December 18, 2020

Responses to Dispositive and *Daubert*: January 4, 2021

Reply to Dispositive and *Daubert*: January 18, 2021

E. Meet and Confer

Meet and confer to prepare the joint final pretrial statement: February 4, 2021

F. Joint Final Pretrial Statement

Joint final pretrial statement (including a single set of jointly proposed Jury Instructions and Verdict Form), Voir Dire Questions, Witness Lists, Exhibit Lists with Objections on Approved Form, and Deposition Designations: February 18, 2021

G. All Other Motions

All other motions, including Motions *in limine* (limited to a single motion not to exceed 25 pages without prior leave of Court) and Objections to Deposition Designations and Counter-Designations on approved form: March 4, 2021

H. Final Pretrial Conference

Final pretrial conference: April 14, 2021

I. Trial Term

Trial term: May 3, 2021

III. CONCLUSION

For these reasons, the Motion to Lift Stay is **Granted**. Plaintiff's Motion to require the Defendant to enter into a representative product(s) agreement or, alternatively, to explain why an agreement is not feasible is **Denied**. The Case Management Scheduling Order is modified as set forth herein.

DONE AND ORDERED in Orlando, Florida on June 3, 2020.



PAUL G. BYRON
UNITED STATES DISTRICT JUDGE

Copies furnished to:

Counsel of Record
Unrepresented Parties