UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SIRIUS XM RADIO INC.,
Petitioner,

v.

FRAUNHOFER-GESELLSCHAFT ZUR FÖRDERUNG DER ANGEWANDTEN FORSCHUNG E.V.,
Patent Owner.

IPR2018-00681
Patent 7,061,997 B1

PATENT OWNER'S RESPONSE TO PETITIONER'S SUPPLEMENTAL BRIEF REGARDING REQUEST FOR REHEARING

Mail Stop "PATENT BOARD"
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

TABLE OF CONTENTS

Page

DOCKET ALARM

Find authenticated court documents without watermarks at docketalarm.com.

TABLE OF AUTHORITIES

Page(s)

Cases

Statutes

Other Authorities

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

Patent Owner Fraunhofer hereby responds to the supplemental brief filed by Petitioner in support of its request for rehearing of the Board's decision denying institution in this case. *See* Paper No. 19 ("Supp. Br."); Paper No. 13 ("Reh'g Req."); Paper No. 12 ("Decision").

Petitioner's supplemental brief fails to present any basis for reversing the Board's non-institution decision. Although Petitioner asserts that the Board's recent precedential opinions in *Proppant* and *Adello* now require a different result, hose cases presented strikingly different facts involving prompt correction of genuine mistakes. Here, by contrast, Petitioner has demonstrated a clear lack of diligence and a protracted refusal to correct its disclosures indicative of gamesmanship, bad faith, and attempted circumvention of the rules. And its recent unauthorized amendment is over a year too late. Because Petitioner's supplemental brief fails to demonstrate any error in the Board's decision—much less an "abuse of discretion" that could possibly warrant rehearing—Petitioner's request for rehearing should be denied.

I. THE BOARD CORRECTLY DENIED PETITIONER'S UNTIMELY AND IMPROPER REQUEST TO AMEND ITS RPI DISCLOSURES

A. The Board's Decision Was Not Based On Jurisdictional Grounds

Petitioner begins by pointing to statements in *Adello* and *Proppant* to the effect that the Board has discretion to permit correction of RPI defects in appropriate circumstances because such defects are "not jurisdictional." Supp. Br. at 2-3. But the Board's decision in this case never said otherwise; indeed, the decision expressly

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

recognized that RPI correction is ***possible*** as a discretionary action under 37 C.F.R. § 42.5. *See* Decision at 7. In exercising its discretion here, the Board simply concluded (correctly) that Petitioner had failed to establish that amendment was warranted on the facts presented. This approach was fully consistent with both new and old precedent. *See, e.g.*, *Adello* at 5 (amendment of RPI may be proper as "exercise of discretion" under § 42.5); *Lumentum Holdings, Inc. v. Capella Photonics, Inc.*, Case IPR2015-00739, Paper No. 38 at 7 (Mar. 4, 2016) (same).

B. This Case Bears No Resemblance To *Adello* And *Proppant*, Where The Petitioners Diligently Sought To Correct Good-Faith Mistakes

Petitioner further argues that amendment should be permitted here for the same reasons as in *Adello* and *Proppant*. Yet this argument ignores the controlling facts in those decisions that distinguish this case in multiple material respects.

For example, in *Adello*, the petitioners listed several RPIs in the original petition (including "Amneal Pharmaceuticals, Inc.") but inadvertently failed to disclose another related RPI named "Amneal Pharmaceuticals LLC." *Adello* at 2-3. When the patent owner raised this issue, the petitioners "promptly investigated the issue, and agreed that [the missing RPI] should have been listed." *Id.* at 2. The petitioners then diligently sought leave to file—and actually filed—a motion to correct their mandatory notices. *Id.* at 2, 5. In that motion, the petitioners "expressly represent[ed]" that the omission was "accidental." *Id.* at 5. The Board found this credible as the petitioners were represented by "different counsel" in the parallel

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.