

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SIRIUS XM RADIO INC.,  
Petitioner,

v.

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

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Case IPR2018-00681  
Patent No. 7,061,997

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**PETITIONER'S REQUEST FOR REHEARING**

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## I. INTRODUCTION

On September 6, 2018, the Board denied institution of *inter partes* review of U.S. Patent No. 7,061,997 (“the ‘997 Patent”), finding that “Petitioner has not satisfied its burden of establishing that Holdings has been properly omitted as an RPI in this proceeding.” Paper 12 (the “Decision”).<sup>1</sup> Petitioner respectfully requests that the Board grant this Request for Rehearing (the “Request”) and consider the merits of the Petition for several reasons.

*First*, the Board misapprehended the Federal Circuit’s decision in *Applications in Internet Time, LLC, v. RPX Corp.*, 897 F.3d 1336 (Fed. Cir. 2018) (“*RPX*”) by ignoring the two critical questions that lie at the heart of the RPI inquiry. Had the Board conducted the full inquiry outlined by the Federal Circuit, Holdings would not be considered an RPI.

*Second*, the Board ignored the PTAB’s precedential decision in *Lumentum Holdings, Inc. v. Capella Photonics, Inc.*, IPR2015-00739, Paper 38 (Mar. 4, 2016), which explains that 35 U.S.C. § 312(a) is *not jurisdictional* and makes an error under § 312(a) rectifiable. Rather than follow this precedential opinion, the Board incorrectly relied on decisions that pre-date and are inconsistent with

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<sup>1</sup> The Board did not address whether Liberty Media Corp. is an RPI. However, the arguments presented herein with respect to Holdings apply to Liberty as well.

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