

McPhie, David

From: Caplan, Jonathan S. <JCaplan@KRAMERLEVIN.com>
Sent: Wednesday, June 20, 2018 11:12 AM
To: Trials@uspto.gov
Cc: KL Sirius XM IPR Team; McPhie, David; Vakili, Kamran; Yorks, Ben
Subject: IPR2018-00681 and IPR2018-00682

Your Honors,

Petitioner respectfully requests a call with the Board to address the issues identified below relating to IPR2018-00681 and IPR2018-00682. Counsel for Petitioner and Patent Owner have met and conferred and counsel for both parties are available for the requested call on Thursday, June 21 between 1pm and 5pm EST this week and can provide additional dates for a call next week.

IPR2018-00681 – Petitioner requests permission to submit a reply to Patent Owner’s Preliminary Response to address the following:

1. Patent Owner incorrectly asserts that Sirius XM was required to identify Sirius XM Holdings and Liberty Media as real parties in interest. Sirius XM will explain through case law and company information that neither Sirius XM Holdings nor Liberty Media is a real party interest. In addition, Sirius XM will explain that, in circumstances such as these, the PTAB routinely grants requests to amend RPI disclosures without affecting the filing date accorded to the petition.
2. Patent Owner presents a legally erroneous proposal for the construction of the preamble of the ‘997 Patent. Sirius XM will explain the correct view of the law to be applied for the construction.

IPR2018-00682 – Petitioner requests permission to submit a reply to Patent Owner’s Preliminary Response to address the following:

1. Patent Owner incorrectly asserts that Sirius XM was required to identify Sirius XM Holdings and Liberty Media as real parties in interest. Sirius XM will explain through case law and company information that neither Sirius XM Holdings nor Liberty Media is a real party interest. In addition, Sirius XM will explain that, in circumstances such as these, the PTAB routinely grants requests to amend RPI disclosures without affecting the filing date accorded to the petition.
2. Patent Owner presents an erroneous view of Federal Circuit case law relating to applicant’s concessions during prosecution. Sirius XM will explain the correct view of Federal Circuit case law applicable to applicant’s actions during prosecution.

Patent Owner has indicated that it (1) opposes the requests set forth above, and (2) in the alternative seeks leave to submit a sur-reply. Petitioner opposes Patent Owner’s requested sur-reply.

Respectfully,

Jonathan S. Caplan
Lead Counsel for Petitioner

Jonathan S. Caplan

Partner, Co-Chair, Intellectual Property

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