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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IPR2018-00682
Patent 6,931,084 B1

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

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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, those 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

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

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