

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.

Case IPR2018-00689
Patent No. 6,993,084

PETITIONER'S REQUEST FOR REHEARING

TABLE OF CONTENTS

	<u>Page</u>
I. Introduction.....	1
II. Legal Standard.....	2
III. The Board Should Grant Petitioner's Request	2
A. The Board Misapprehended Federal Circuit Law	2
B. The Board Ignored The PTAB's Precedential <i>Lumentum</i> Decision.....	7
C. Good Cause Exists to Amend Petitioner's RPI Designations.....	9
1. Good Cause Exists When There Is No Attempt to Circumvent the AIA's Time Bar and Estoppel Rules	10
2. Good Cause Exists When There Is No Prejudice	12
3. Good Cause Exists Because Petitioner Made Good Faith Arguments That Holdings Is Not An RPI.....	13
4. The Board Erred in Finding No Good Cause for Petitioner Not Updating Its RPI Designations.....	14
D. The Interests of Justice Would be Served by Permitting Amendment of the RPI Designations.....	15
IV. Relief Requested.....	15

TABLE OF AUTHORITIES

	<u>Page(s)</u>
Federal Cases	
<i>Applications in Internet Time, LLC, v. RPX Corp.</i> , 897 F.3d 1336 (Fed. Cir. 2018)	<i>passim</i>
<i>Daifuku Co., Ltd., et al. v. Murata Machinery, Ltd.</i> , IPR2015-01538, Paper 11 (PTAB Jan. 19, 2016)	6
<i>Global Tel*Link Corp. v. Securus Techs., Inc.</i> , IPR2015-01225, Paper 44 (PTAB Dec. 14, 2016)	6
<i>Lumentum Holdings, Inc. v. Capella Photonics, Inc.</i> , IPR2015-00739, Paper 38 (PTAB Mar. 4, 2016)	<i>passim</i>
<i>Merck Sharp & Dohme Corp. v. Mayne Pharma Int'l PTY Ltd.</i> , IPR2016-01186, Paper 70 (PTAB Dec. 13, 2017)	11, 15
<i>Microsoft Corp. v. DataTern, Inc.</i> , 755 F. 3d 899 (Fed. Cir. 2014)	5
<i>Mobile Tech, Inc. v. Sennco Sol'ns, Inc.</i> , IPR2017-02199, Paper 9 (PTAB Apr. 10, 2018)	7
<i>Puzhen Life USA, LLC v. Esip Series 2, LLC</i> , IPR2017-02197, Paper 13 (PTAB Apr. 11, 2018)	7
<i>Reflectix, Inc. v. Promethean Tech</i> , IPR2015-00039, Paper 18 (PTAB Apr. 24, 2015)	13
<i>Rubicon Comms., LP, v. Lego</i> , IPR2016-01187, Paper 40 (PTAB Dec. 16, 2016)	11, 13, 15
<i>Star Fruits S.N.C. v. U.S.</i> , 393 F. 3d 1277 (Fed. Cir. 2005)	3, 9
<i>Wi-Fi One, LLC, v. Broadcom Corp</i> , 878 F.3d 1364 (Fed. Cir. 2018)	8, 9
<i>ZOLL Lifecor Corp. v. Philips Elecs. N. Am. Corp.</i> , Case IPR2013-00606, Paper 13 (PTAB Mar. 20, 2014)	8, 9

Federal Statutes

35 U.S.C. § 312(a)1, 7, 9
35 U.S.C. § 315(b)5, 9, 10

Rules

Fed. R. Civ. P. 7.112

Regulations

37 C.F.R. § 42.1(b)12
37 C.F.R. § 42.1114, 15
37 C.F.R. § 42.71(c).....2
37 C.F.R. § 42.71(d)2
37 C.F.R. § 42.71(d)(2).....2

I. INTRODUCTION

On September 21, 2018, the Board denied institution of *inter partes* review of U.S. Patent No. 6,993,084 (“the ‘3084 Patent”), finding that “Petitioner has not satisfied its burden of establishing that Holdings has been properly omitted as an RPI in this proceeding.” Paper 11 (the “Decision”).¹ 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

¹ 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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