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.

IPR2018-00690 (Patent 6,314,289 B1)

PATENT OWNER'S RESPONSE TO PETITIONER'S REQUEST FOR REHEARING

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I. INTRODUCTION

Patent Owner Fraunhofer opposes Petitioner's request for rehearing of the Board's decision denying institution in this case. *See* Paper No. 17 ("Reh'g Req."); Paper No. 16 ("Decision"). Pursuant to the Board's Order (Paper No. 20), Patent Owner is filing this same opposition to the rehearing requests in related cases.

Petitioner's request for rehearing should be denied as it does not come close to meeting the heavy burden required to justify reconsideration of the Board's well-reasoned Decision. Petitioner instead mischaracterizes the law, attempts to reweigh the facts, and repeatedly relies on new arguments that it failed to raise earlier despite the opportunity to do so. None of this is a proper basis for granting rehearing. Nor are Petitioner's failed RPI arguments rescued by the recent non-precedential decision in *Google LLC v. Seven Networks LLC*, Case IPR2018-01117, Paper No. 20 (Nov. 19, 2018). The *Google* case simply applied a typical RPI analysis to a different set of facts to obtain a different result. Because Petitioner fails to identify any error in the Board's Decision—much less an "abuse of discretion" that could possibly warrant rehearing—Petitioner's rehearing request should be denied.

II. THE RECENT *GOOGLE* DECISION DOES NOT IMPACT THE BOARD'S DENIAL OF INSTITUTION HERE

The Board's Order suggested that Patent Owner address: (1) "whether the *Google* panel's framework for determining whether a party is an RPI is correct," and (2) "whether Sirius XM Holdings meets the RPI criteria set forth in that decision."

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As shown below, the *Google* framework fully confirms that Holdings is an RPI.

A. The *Google* Case Correctly Sets Forth A Flexible, Fact-Based Framework For Identifying RPIs

The *Google* case sets forth a typical—and generally correct—articulation of legal principles applicable to the RPI inquiry. The case first notes that "the petitioner bears the burden of persuasion to demonstrate that it has identified all of the RPIs," and that this burden never "shift[s]" to the patent owner. *Id.* at 5-6. The RPI analysis itself is described as a "highly fact-dependent question" to be decided on a "case-by-case basis." *Id.* at 8. A variety of potentially relevant factors are mentioned, including whether the entity "exercised or could have exercised control over a party's participation in a proceeding," the entity's "relationship with the petitioner," the entity's "relationship to the petition," "the nature of the entity filing the petition," whether the petition was filed at the "behest" of another, and whether the entity "possessed effective control from a practical standpoint." *Id.* at 8-9.

The *Google* case emphasizes that there is "no bright-line test" governing the outcome of the RPI analysis. *Id.* at 8-9. For example, the existence of a parent-subsidiary relationship supports but does not by itself prove the existence of an RPI. *Id.* at 11, 13. Moreover, although cases exist in which a disinterested party may be directed to file a petition as proxy for the one true RPI, the statute also contemplates situations where there are ***multiple*** interested RPIs. *Id.* at 6 (requiring identification of "all of the RPIs [plural]"); *see also AIT, LLC, v. RPX Corp.*, 897 F.3d 1336, 1347,

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