

From: [Redjaian, Babak](#)
To: "Trials"
Cc: [Caplan, Jonathan S.](#); [Baghdassarian, Mark](#); [Hedvat, Shannon H.](#); [McPhie, David](#); [Yorks, Ben](#); [Vakili, Kamran](#); [Price, Jeffrey H.](#); [Redjaian, Babak](#)
Subject: [EXTERNAL] RE: IPR2018-00681, -00682, -00689, -00690 - Supplemental Authority
Date: Friday, February 08, 2019 1:40:07 PM

Your Honors,

Petitioner SXM's request below is improper and should be denied. It the latest of a string of repeated attempts by SXM to make additional submissions to the Board on the RPI issue, even though the Board already stated weeks ago that "[n]o additional briefing is authorized at this time." See 1/16/2018 email from Andrew Kellogg. Thus, SXM's submission of substantive arguments in the email brief below directly violates the Board's instructions in this case.

In any event, the new arguments in Petitioner's email should be rejected on the merits. The Board's decision denying institution in this case is entirely consistent with the non-precedential *ZTE* decision. The Board in *ZTE* applied existing law and exercised its discretion to permit amendment because the petitioner there (unlike SXM) proved that this was in the interest of justice based on a different set of facts. For example, the petitioner in *ZTE* had already indirectly identified the missing RPI in its original petition, and had further shown diligence by immediately filing an updated mandatory notice as soon as the omission was raised. None of those facts are present here.

Respectfully submitted,

Babak Redjaian
Counsel for Patent Owner

From: Price, Jeffrey H. <JPrice@KRAMERLEVIN.com>
Sent: Thursday, February 7, 2019 2:00 PM
To: 'Trials' <Trials@USPTO.GOV>
Cc: Caplan, Jonathan S. <JCaplan@KRAMERLEVIN.com>; Baghdassarian, Mark <MBaghdassarian@KRAMERLEVIN.com>; ~Hedvat, Shannon <shedvat@kramerlevin.com>; McPhie, David <DMcPhie@irell.com>; Yorks, Ben <BYorks@irell.com>; Redjaian, Babak <BRedjaian@irell.com>; Vakili, Kamran <KVakili@irell.com>
Subject: IPR2018-00681, -00682, -00689, -00690 - Supplemental Authority

Your Honors,

Petitioner, Sirius XM Radio, Inc., writes to notify the panel of supplemental authority bearing on Petitioner's outstanding Requests for Rehearing in the above-identified cases.

The attached decision, *ZTE (USA) Inc. v. Fundamental Innovation Systems Int'l LLC*, IPR2018-00425, Paper 34 (February 6, 2019), provides further legal support for Petitioner's request that, in the event the Board considers Petitioner's original identification of real parties in interest to be inadequate, the Board permit Petitioner to amend its Mandatory Notices to identify additional real parties in interest without changing the Petitions' filing dates.

This new decision fully supports Petitioner's aforementioned request first made in its Reply to Patent Owner's Preliminary Responses and repeated in each of its Requests for Rehearing. See, e.g., IPR2018-00681, Paper 9 at 3-4 and Paper 13 at 7-15. In particular, after the Board found that the petitioner had failed to identify all real parties in interest, the Board concluded that "[o]n the whole, we find it in the interest of justice to allow Petitioner to update its mandatory notices, while maintaining the proceeding's original filing date. Doing so furthers the purpose of 35 U.S.C. § 312(a)(2) and avoids significant prejudice to Petitioner (i.e., dismissal of its Petition), without undue prejudice to Patent Owner." ZTE at 8.

Petitioner does not believe any briefing regarding this supplemental authority is necessary. However, should the Board seek briefing on this authority, Petitioner would be happy to provide such a submission. Patent Owner's counsel, copied on this communication, indicated that they object.

Best regards,
Jeff Price
Counsel for Petitioner, Sirius SM Radio, Inc.

Jeffrey H. Price

Associate

Kramer Levin Naftalis & Frankel LLP
1177 Avenue of the Americas, New York, New York 10036
T 212.715.7502 F 212.715.8302
jprice@kramerlevin.com

[Bio](#)

This communication (including any attachments) is intended solely for the recipient(s) named above and may contain information that is confidential, privileged or legally protected. Any unauthorized use or dissemination of this communication is strictly prohibited. If you have received this communication in error, please immediately notify the sender by return e-mail message and delete all copies of the original communication. Thank you for your cooperation.

PLEASE NOTE: This message, including any attachments, may include privileged, confidential and/or inside information. Any distribution or use of this communication by anyone other than the intended recipient(s) is strictly prohibited and may be unlawful. If you are not the intended recipient, please notify the sender by replying to this message and then delete it from your system. Thank you.