

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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Case IPR2018-00690  
Patent No. 6,314,289

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**PETITIONER'S SUPPLEMENTAL AUTHORITY BRIEF IN SUPPORT OF  
ITS REQUEST FOR REHEARING**

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Petitioner Sirius XM Radio Inc. (“SXM” or “Petitioner”) respectfully submits this brief setting forth the reasons that two recently designated precedential decisions support SXM’s pending Request for Rehearing – specifically, *Proppant Express Investments, LLC v. Oren Technologies, LLC*, Case IPR2017-01917 (PTAB Feb. 13, 2019) (Paper 86) (“*Proppant*”) and *Adello Biologics LLC v. Amgen Inc.*, Case PGR2019-00001 (PTAB Feb. 14, 2019) (Paper 11) (“*Adello*”).

## **I. BACKGROUND**

On September 6, 2018, the Board denied institution of the Petition because it found that Sirius XM Holdings Inc. (“Holdings”) should have been named a real party-in-interest (“RPI”) and that Petitioner had not shown good cause to permit a modification to the RPI designations without changing the Petition’s filing date. Paper 16 (the “Institution Decision”).<sup>1</sup> On October 5, 2018, SXM filed a Request for Rehearing (Paper 17, “Request”) setting forth reasons why the Institution Decision should be reconsidered, including the fact that the Board overlooked the good cause for allowing SXM to amend its disclosures to designate Holdings as an RPI without impacting the Petition’s filing date. Request at 12-15. Subsequently, SXM informed the Board of newly issued decisions supporting SXM’s position

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<sup>1</sup> The Institution Decision did not address whether Liberty Media Corp. (“Liberty”) is an RPI, but the arguments presented here apply to both Holdings and Liberty.

that Holdings should not be considered an RPI, and SXM's requests to modify its RPI designations in the event that the Board continued to disagree with SXM. Exs. 1021-1024. After the Board designated the *Proppant* and *Adello* decisions precedential, the panel permitted SXM to submit this brief, which demonstrates that SXM should be permitted to amend its RPI disclosures without impacting the Petition's filing date and have its Petition decided on the merits.

## **II. SXM SHOULD BE PERMITTED TO AMEND ITS RPI DISCLOSURES**

### **A. The Board's Recent Precedential Decisions Confirm That SXM's Request To Amend Its RPI Disclosures Is Not Time Barred**

The Board recently confirmed in *Proppant* (at 7) and *Adello* (at 3) that the requirements under 35 U.S.C. § 312(a) are not jurisdictional, making any alleged error or omission rectifiable without impacting the filing date of the Petition. More specifically, *Proppant* explained that “the Board may, under 35 U.S.C. § 312(a), accept updated mandatory notices as long as the petition would not have been time-barred under 35 U.S.C. § 315(b) if it had included the real party in interest.” *Proppant* at 7; *see also Adello* at 3-4. These decisions are consistent with SXM's arguments throughout this proceeding based on *Lumentum* (precedential) and other decisions. *See Request* at 1-2, 7-9; *see also Paper 13* (“Reply”) at 5.

In *Proppant* and *Adello*, the Board emphasized that where “none of the now named real parties in interest was subject to the § 315(b) time bar, *i.e.*, none of

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