

From: [Trials](#)
To: [Caplan, Jonathan S.](#); [Redjaian, Babak](#); [Trials](#)
Cc: [Baghdassarian, Mark](#); [Hedvat, Shannon H.](#); [Price, Jeffrey H.](#); [McPhie, David](#); [Yorks, Ben](#); [Vakili, Kamran](#)
Subject: [EXTERNAL] RE: IPR2018-00681, -00682, -00689, -00690 - Supplemental Authority
Date: Thursday, April 25, 2019 3:39:39 PM

Counsel,

The panel will issue an order addressing this matter soon.

Regards,

Andrew Kellogg,
Supervisory Paralegal
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
Direct: 571-272-5366

From: Caplan, Jonathan S. <JCaplan@KRAMERLEVIN.com>
Sent: Monday, April 22, 2019 4:19 PM
To: Redjaian, Babak <BRedjaian@irell.com>; Trials <Trials@USPTO.GOV>
Cc: Baghdassarian, Mark <MBaghdassarian@KRAMERLEVIN.com>; Hedvat, Shannon H. <SHedvat@KRAMERLEVIN.com>; Price, Jeffrey H. <JPrice@KRAMERLEVIN.com>; McPhie, David <DMcPhie@irell.com>; Yorks, Ben <BYorks@irell.com>; Vakili, Kamran <KVakili@irell.com>; Caplan, Jonathan S. <JCaplan@KRAMERLEVIN.com>
Subject: RE: IPR2018-00681, -00682, -00689, -00690 - Supplemental Authority

Your Honors,

Petitioner requests that the Board ignore Patent Owner's overly argumentative and misleading email.

The Board has not entered any order in the above referenced cases foreclosing further requests to submit supplemental authority. The email from Andrew Kellogg referred to in Patent Owner's email is attached for reference. Given that there are now precedential cases directly bearing on an issue in these pending cases, there should be no question that Petitioner's request to supply supplemental authority is proper.

As the record shows, Petitioner did not make any substantive arguments in its email to the Board. On the other hand, Patent Owner's response is replete with arguments that should be ignored. Considering Patent Owner's arguments without the benefit of Petitioner's views on how these precedential opinions align with the facts of these cases unfairly prejudices Petitioner. To the extent that the Board is willing to consider Patent Owner's arguments, Petitioner requests the opportunity to file a five page paper responsive to those arguments.

Respectfully submitted,

Jonathan Caplan
Lead Counsel for Petitioner, Sirius XM Radio Inc.

Jonathan S. Caplan
Partner and Co-chair, Intellectual Property

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From: Redjaian, Babak [<mailto:BRedjaian@irell.com>]
Sent: Monday, April 22, 2019 1:50 PM
To: trials@uspto.gov
Cc: Baghdassarian, Mark; Hedvat, Shannon H.; Price, Jeffrey H.; McPhie, David; Yorks, Ben; Vakili, Kamran; Redjaian, Babak; Caplan, Jonathan S.
Subject: [EXTERNAL] RE: IPR2018-00681, -00682, -00689, -00690 - Supplemental Authority

Your Honors,

Petitioner SXM's request below is improper and should be denied. It is 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 months 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 substantive arguments in Petitioner's email are incorrect and the cited case law is inapposite. *Adello* involved the inadvertent omission of an RPI that the petitioner immediately moved to correct once it was raised to its attention. In *Proppant*, the Board raised sua sponte whether a third party should be considered an RPI based on new Federal Circuit precedent, and in response the petitioner immediately moved to correct. By contrast, in this case, SXM Holdings was a clear RPI under previous and current precedent, yet the Petitioner SXM made a deliberate decision to withhold disclosure of this RPI in an attempt to game the estoppel rules. Moreover, when Patent Owner raised the omission, Petitioner did not diligently file a motion to correct or even seek leave to file a motion to correct, but rather persisted in its original (meritless) position. Then after it lost on this issue, Petitioner filed a request for rehearing with untimely arguments seeking to correct its disclosures. Thus, there is significant evidence in this case of improper circumvention, gamesmanship, and bad faith, which is not present in the newly cited PTAB case law.

To the extent that Petitioner is granted leave to submit additional briefing or the Board feels that

additional analysis of these cases would be helpful, Patent Owner is willing to submit an additional formal response.

Respectfully submitted,

Babak Redjaian
Counsel for Patent Owner

From: Caplan, Jonathan S. <JCaplan@KRAMERLEVIN.com>

Sent: Monday, April 22, 2019 9:23 AM

To: trials@uspto.gov

Cc: Baghdassarian, Mark <MBaghdassarian@KRAMERLEVIN.com>; ~Hedvat, Shannon <shedvat@kramerlevin.com>; Price, Jeffrey H. <JPrice@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 Board recently designated as precedential two decisions that provide 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 as set forth in Petitioner's Replies to Patent Owner's Preliminary Responses and pending Requests for Rehearing, in each of the above-referenced actions. *See, e.g.*, IPR2018-00681, Paper 9 at 3-4 and Paper 13 at 7-15.

These precedential decisions are *Proppant Express Investments, LLC v. Oren Technologies, LLC*, IPR2017-01917, Paper 86 (entered February 13, 2019, designated April 16, 2019) and *Adello Biologics LLC v. Amgen Inc.*, PGR2019-00001, Paper 11 (entered February 14, 2019, designated April 16, 2019).

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.

Respectfully submitted,
Jonathan Caplan
Lead Counsel for Petitioner, Sirius XM Radio Inc.

Jonathan S. Caplan

Partner and Co-chair, Intellectual Property

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