

20-2319

**United States Court of Appeals
for the Federal Circuit**

Sirius XM Radio Inc.,
Appellant,

v.

Fraunhofer-Gesellschaft Zur Forderung Der Angewandten Forschung E.V.,
Appellee.

Appeal from the United States Patent and Trademark Office,
Patent Trial and Appeal Board in No. IPR2018-00690

**SIRIUS XM RADIO INC.'S COMBINED PETITION
FOR PANEL REHEARING AND REHEARING *EN BANC***

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CERTIFICATE OF INTEREST

Counsel for Appellant Sirius XM Radio Inc. certifies the following:

1. The full name of every party represented by us is:

Sirius XM Radio Inc.

2. The name of the real party in interest represented by us is:

Sirius XM Holdings Inc.

3. All parent corporations and any other publicly held companies that own 10 percent or more of the stock of the party:

Liberty Media Corporation and Sirius XM Holdings Inc.

4. The names of all law firms and the partners or associates that appeared for Sirius XM Radio Inc. before the Patent Trial and Appeal Board or are expected to appear in this court (and who have not or will not enter an appearance in this case) are:

None.

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal:

Fraunhofer-Gesellschaft Zur Forderung der angewandten Forschung E.V. v. Sirius XM Radio Inc., Case No. 1:17-cv-00184 (D. Del.)

6. Provide any information required under Fed. R. App. P. 26.1(b):

None.

Dated: October 7, 2021

/s/ Mark A. Baghdassarian
Mark A. Baghdassarian

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STATEMENT OF COUNSEL – FEDERAL CIRCUIT RULE 35(B)(2)

Based on my professional judgment, I believe the panel decision is contrary to the following decision(s) of the Supreme Court of the United States or the precedent(s) of this court, most notably *Ericsson Inc. v. Intellectual Ventures I LLC*, 901 F.3d 1374 (Fed. Cir. 2018) as well as the following: *Graham v. John Deere Co.*, 383 U.S. 1 (1966); *Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330 (Fed. Cir. 2020); *Apple Inc. v. Samsung Elecs. Co.*, 839 F.3d 1034 (Fed. Cir. 2016) (en banc); *Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359 (Fed. Cir. 2015); and *Randall Mfg. v. Rea*, 733 F.3d 1355 (Fed. Cir. 2013).

Dated: October 7, 2021

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INTRODUCTION AND STATEMENT OF THE CASE

This case represents a stark departure from *Graham v. John Deere Co.*, 383 U.S. 1 (1966), still the bedrock of modern obviousness law, which requires a finder of fact to determine “the scope and content of the prior art” and ascertain “differences between the prior art and the claims at issue.” *Graham*, 383 U.S. at 17. The Patent Trial and Appeal Board (“Board”) did neither in its Final Written Decision in Case No. IPR2018-00690, and the panel affirmed the Board’s clear error without opinion. Specifically, the Board reversibly erred because it refused to consider undisputed evidence regarding the state of the art *presented in SXM’s Petition* (including admissions within the ’289 Patent itself) and, therefore, failed to perform these two fundamental duties.

This Court recently vacated a Final Written Decision for this very mistake, but the panel here did not follow that precedent. More particularly, in *Ericsson Inc. v. Intellectual Ventures I LLC*, 901 F.3d 1374 (Fed. Cir. 2018), this Court confirmed that it was reversible error for the Board to disregard “admissions within the . . . patent itself” and “arguments raised in [the] Petition,” including arguments that particular techniques were “well-known to a POSA at the time the . . . Patent was filed.” *Ericsson*, 901 F.3d at 1380. The evidence the Board disregarded in this case likewise consisted of admissions from the patent and arguments raised in the Petition. Indeed, the very first page of the Petition explicitly characterized the relevant

limitations as “well-known techniques for reducing channel fading” and the Board expressly recognized the state of the art in its Institution Decision. Appx94; Appx472–473 (“Dr. Lyon also relies on the teachings of Yi to show that implementing code diversity in a transmission architecture that achieves time and space diversity was within the level of ordinary skill in the art, and would have been constructed without undue experimentation.”). But when it came to its Final Written Decision, the Board ignored the same state of the art and arguments presented in the Petition. Here, the panel’s Rule 36 affirmance is contrary to the Court’s precedent in *Ericsson* and a bevy of other cases, and SXM therefore respectfully requests that the Court grant rehearing, vacate the Board’s Final Written Decision, and remand the case for a proper obviousness determination that faithfully applies all of the *Graham* factors.

**POINTS OF LAW OR FACT OVERLOOKED
OR MISAPPREHENDED BY THE PANEL**

Pursuant to Federal Circuit Rules 35(e)(1)(F) and 40(a)(5), SXM provides this statement of points of law or fact that were overlooked or misapprehended by the court in its panel decision.

1. The panel misapprehended the effect of this Court's opinion in *Ericsson Inc. v. Intellectual Ventures I LLC*, 901 F.3d 1374 (Fed. Cir. 2018). In *Ericsson*, the Court determined that the Board commits reversible error when its obviousness analysis disregards evidence and argument presented in the Petition establishing that certain claim limitations were well-known in the art.

2. The panel overlooked the fact that SXM's Petition presented evidence and argument demonstrating the claim limitations relevant to this appeal were well-known in the art and only utilized its Reply Brief to point out where the Petition discussed the evidence corresponding to each of the relevant claim limitations.

3. The panel overlooked the fact that Fraunhofer never disputed that the evidence presented in the Petition, including admissions in the challenged patent itself, taught the relevant claim limitations or that those claim limitations were well-known in the art.

ARGUMENT

I. The Court Should Grant Rehearing Because The Panel’s Decision Is Contrary to This Court’s *Ericsson* Decision

The Court should grant rehearing because the panel’s Rule 36 Affirmance of the Final Written Decision is contrary to the Court’s precedent in *Ericsson Inc. v. Intellectual Ventures I LLC*, 901 F.3d 1374 (Fed. Cir. 2018).

A. The Board’s Error Here Is The Same as this Court Found in *Ericsson*

In *Ericsson*, the Board refused to consider whether the state of the art presented in a petition—including admissions in the challenged patent itself—established that certain claim limitations were well-known in the art after determining that one of the listed references of a ground (Reed) did not satisfy the limitation. *Id.* at 1379. On appeal, this Court held that the Board abused its discretion because it was required to, but did not, consider obviousness of the challenged claims in view of both “the admissions within the [challenged patent and] the arguments raised in Ericsson’s petition.” *Id.* at 1380.

Here, the Board committed the same error when it refused to consider whether the undisputed evidence presented in the Petition, including the applicant admitted prior art (“AAPA”), established that key limitations were well-known in the art after a reference (*Campanella*)(Appx1253–1275) identified for an enumerated ground was found not to be prior art. For reference, a claim chart for Independent Claim 2

is reproduced below with explanations as to how the Petition argued that the AAPA and *Yi* establish that all of the limitations also mapped to *Campanella*—were well-known in the art (underlined for easy identification and referred to as the Satellite Transmission Limitations):

2. An apparatus for transmitting information, comprising:	<i>Chen</i> teaches this limitation. Appx117–118.
a bitstream source for providing a bitstream representing the information;	<i>Chen</i> teaches this limitation. Appx118.
a redundancy adding encoder for generating an encoded bitstream based on the bitstream provided by the bitstream source wherein the encoder is arranged to output, for a first number of input bits, a second number of output bits, the second number of output bits having at least twice as many output bits as the first number of input bits, and wherein the second number of output bits includes two portions of output bits, each portion of output bits individually allowing the retrieval of information represented by the first number of input bits, and the first portion of output bits being coded based on the bitstream in a different way with respect to the second portion of output bits;	<i>Chen</i> teaches these limitations. Appx119–125.
a partitioner for partitioning the second number of output bits into the two portions of output bits; and	<i>Chen</i> teaches this limitation. Appx125–126.
means for transmitting the output bits of the first portion via a first channel and the output bits of the second portion via a second channel,	<i>Chen</i> teaches this limitation. Appx126–127.

<p><u>the second channel being spatially different from the first channel;</u></p> <p><u>the means for transmitting including a first transmitter and a second transmitter spaced apart from the first transmitter;</u></p> <p><u>the first channel being defined by the first transmitter and the receiver; and</u></p> <p><u>the second channel being defined by the second transmitter and the receiver such that space diversity is obtained.</u></p> <p>Appx78.</p>	<p>The Petition argued that <i>Campanella</i> teaches these limitations. Appx132–133 (“Campanella uses two satellites to spatially separate two channels.”).</p> <p>The Petition also argued that the <u>AAPA</u> teaches these limitations. Appx100 (citing Appx71 at FIG. 7, Appx72 at 2:15–32) (“Like the APA, the ‘289 Patent employs two channels, including delay elements placed on different sides of the two radio links, to combat fading of the signal that might last up to several seconds. <i>See, e.g.</i>, Figure 7; 2:15–32.”).</p> <p>The Petition also argued that <u>Yi</u> also teaches these limitations. Appx99 (citing Appx1283 at 1:41–49) (“One way to create spatially diverse channels is to use multiple transmitters spaced apart from each other. Each channel experiences different, independent fading from the others. <i>See Yi</i>, 1:41–49 (describing DAB systems that ‘mitigate the problems of multipath fading and foliage attenuation by employing two geosynchronous satellites’).”).</p>
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In addition to the explicit citations to the AAPA and *Yi*, which establish that the Satellite Transmission Limitations of Independent Claim 2 were well-known in

the art, the very first page of the Petition established SXM's position that sending data over two space and time diverse channels was well-known in the art:

The '289 Patent is generally directed to digital audio broadcasting ("DAB") transmitters and receivers widely used in satellite communications. Each independent claim requires sending or receiving data over two communications channels in order to obtain *time and space diversity*, which are *well-known techniques* for reducing channel fading. The data sent over each channel is derived from a bitstream, representing digital, video or audio information.

Appx94 (emphasis added). In fact, the Petition also pointed out that *Chen* explicitly states that its "invention could also be implemented in systems which utilize time diversity, space diversity, polarization diversity, as well as other types of diversity techniques." Appx116 (citing Appx1244 at 3:27–30).

Finally, leaving no doubt about the Petition's presentation of argument showing that the state of art that satisfied the Satellite Transmission Limitations, the Board's Institution Decision firmly establishes that the Petition argued that *Yi* (one of the state of the art references presented in the Petition) established that it was well-known in the art to send and receive data over two separate communications channels to achieve space and time diversity (which is what the Satellite Transmission Limitations enable):

Dr. Lyon also relies on the teachings of *Yi* to show that implementing code diversity in a transmission architecture that achieves time and space diversity was within the level of ordinary skill in the art, and would have been

constructed without undue experimentation. Ex. 1002 ¶ 92 (citing [Ex. 1006], 1:31–36, 2:27–35, 6:14–19, 6:66–72). We are persuaded that Dr. Lyon’s testimony is sufficiently supported by the record.

Appx472–473 (citing Appx965–966 at ¶ 92; Appx1283 at 1:31–36, 2:27–35, Appx1285 at 6:14–19, 6:66–72). It was clear error for the Board to ignore what the prior art undisputedly shows—specifically, sending signals over two space and time diverse communications channels was well-known in the art. The panel overlooked that error by not applying this Court’s precedent in *Ericsson*.

B. This Case is Indistinguishable from *Ericsson*

In *Ericsson*, the Board found that the Reed reference¹ did not teach a particular type of interleaving required by the claims. *Ericsson*, 901 F.3d at 1379. Following this determination, the Board found the challenged claims patentable under the theory that “the issue is not whether the general concept of interleaving was known in the prior art,” conceding that “it was.” *Id.* Once the Board determined that Reed could not be relied on as teaching the particular type of interleaving required by the claims it ended its analysis. *Id.*

On appeal, this Court explained the Board’s decision to disregard the scope and content of the prior art presented in the petition—particularly admissions in the

¹ Reed was the only reference asserted in the petition as allegedly teaching this claim element.

patent itself—constituted reversible error. *Id.* at 1380 (“Given the acknowledgment in the patent that interleaving was known in the art, Ericsson was entitled to argue on reply that the distinction in the specific type of interleaving between Reed and the [challenged patent] would have been insubstantial to a person of skill in the art.”); *see also id.* (“The Petition characterizes the description of interleaving in the [challenged patent] as ‘simply a recitation of a textbook block interleaving technique well-known to a POSA at the time the . . . Patent was filed.’”).

The Board committed the same error here because it declined to consider evidence (including the AAPA) presented in the Petition establishing that space and time diverse communications systems were well-known in the art. By failing even to consider the arguments and evidence presented in the Petition, the Board simply did not determine “the scope and content of the prior art” or the “differences between the prior art and the claims at issue.” *Id.* at 1379. The Board’s Rule 36 Affirmance of the Final Written Decision is, therefore, directly contrary to the Court’s decision in *Ericsson*.

C. Fraunhofer’s Arguments Attempting to Distinguish *Ericsson* Are Facially Meritless

Unable to distinguish *Ericsson*, Fraunhofer attempted to limit its holding to cases “where the parties and Board had all applied one legal standard for claim construction before institution, but then applied a different standard afterwards.” Resp. Br. at 56 (citation omitted). Fraunhofer misses the point. *Ericsson* states that

the Board’s adoption of a different claim construction after institution without permitting petitioner to reply “exacerbated” the Board’s error, not that it was the source of the error. *Ericsson*, 901 F.3d at 1380. The Board’s error in *Ericsson* is the same error it committed here, namely that it did not properly determine the scope and content of the prior art or ascertain the differences between the prior art and the claimed invention. *See id.* at 1379–80.

Nevertheless, as in *Ericsson*, the “changed circumstances” here “exacerbated” the Board’s error in refusing to evaluate the state of the art. *Id.* at 1380. Specifically, because Fraunhofer did not raise the issue of *Campanella*’s prior-art status until its Patent Owner’s Response (Appx533–539), the Board’s refusal to consider SXM’s Reply—which simply pointed the Board to where the prior art cumulative to *Campanella* was presented in the Petition (Appx604–606)—exacerbated its initial error. Indeed, this Court has found that a petitioner *should* utilize its Reply to provide “specific guidance” as to where the argument was made in the Petition—SXM did exactly that here. *See* § I.B, *supra*; *see also MModal LLC v. Nuance Commc’ns, Inc.*, 846 F. App’x 900, 906 (Fed. Cir. 2021).

Fraunhofer also tried to characterize *Ericsson* as an outlier—it is not. Instead, the decision is support by a more recent decision of this Court. For example, in *Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330 (Fed. Cir. 2020), this Court found that the Board erred in disregarding the skilled artisan’s knowledge because

“the inquiry into whether any ‘differences’ between the invention and the prior art would have rendered the invention obvious to a skilled artisan *necessarily depends* on such artisan’s knowledge.” *Philips*, 948 F.3d at 1337 (citation omitted). The *Philips* Court continued on to affirm that the Board was correct to rely on expert evidence, corroborated by a reference that was not one of the references making up the ground, that a particular claim limitation “was not only in the prior art, but also within the general knowledge of a skilled artisan.” *Id.* at 1338.

Finally, Fraunhofer argued that SXM never made the argument that the AAPA, Yi and other prior art satisfied the Satellite Transmission Limitation. This is clearly contradicted by the record. As shown above, Section I.A, the table demonstrates all the portions of the Petition where SXM showed how the state of the art satisfied these limitations. That SXM presented the argument in its Petition is further confirmed by the Board relying on that very art in its Institution Decision. If SXM had not made the argument based on this state of the art, the Board would not have come to its conclusion in the Institution Decision. For these reasons, the panel overlooked the teachings of *Ericsson*.

II. The Panel’s Decision is Contrary to this Court’s Other Precedent that Apply the *Graham* Factors

The Panel’s decision is contrary to other precedent from this Court holding that it is reversible error for the Board to disregard the state of the art under the *Graham* factors regarding the AAPA, Yi, and Chen, discussed in Section I.A above,

for its analysis under § 103. *Graham*, 383 U.S. at 17 (“Under [§] 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.”).

This Court has confirmed that it is reversible error for the Board not to determine the “scope and content of the prior art” and ascertain the “differences between the prior art and the claims at issue.” *See Apple Inc. v. Samsung Elecs. Co.*, 839 F.3d 1034, 1047–48 (Fed. Cir. 2016) (en banc) (citing *Graham*, 383 U.S. at 17-18) (explaining that “it is error to reach a conclusion of obviousness until all of those [*Graham*] factors are considered”). Indeed, this Court has explained that the background knowledge of a POSITA is not optional, but instead “is part of the store of public knowledge that *must be consulted*” under § 103. *See Randall Mfg. v. Rea*, 733 F.3d 1355, 1362-63 (Fed. Cir. 2013) (“As *KSR* established, the knowledge of such an artisan is part of the store of public knowledge that *must be consulted* when considering whether a claimed invention would have been obvious.”) (emphasis added)); *see also Lone Star Silicon Innovations LLC v. Iancu*, 809 F. App’x 773, 777 (Fed. Cir. 2020) (“[T]he statutory definition of obviousness expressly depends on what would have been known to a person having ordinary skill in the art.”) (citation omitted).

Following these principles, the Court vacated a Board decision where the Board failed explicitly to consider a document included in a petition as an exhibit to an expert declaration. *See Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1365 (Fed. Cir. 2015) (finding that “the Board erred” if it declined to consider an exhibit “even as evidence of the background understanding of skilled artisans as of January 2010, simply because the brochure had not been identified at the petition stage as one of the pieces of prior art defining a combination for obviousness.”). Because the exhibit was discussed in establishing the state of the art in the Petition and supporting declarations, this Court found that the exhibit “*had to be considered* by the Board even though it was not one of the three pieces of prior art presented as the basis for obviousness.” *Id.* (emphasis added). Similarly, in *Randall*, the Court found that the Board reversibly erred “[b]y narrowly focusing on the four prior-art references cited by the Examiner and ignoring the additional record evidence *Randall* cited to demonstrate the knowledge and perspective of one of ordinary skill in the art.” 733 F.3d at 1362.

The panel’s affirmance of the Board’s decision that disregarded the state of the art presented in the Petition overlooked this same fundamental error. Like in *Ariosa*, the Board improperly disregarded evidence and arguments presented in the Petition “simply because [the references] had not been identified at the petition stage as one of the pieces of prior art defining a combination for obviousness.” *Ariosa*,

805 F.3d at 1365. Because this evidence undisputedly established that it was well-known to send signals over two space and time diverse communications channels, the Board failed to perform its duty to faithfully apply the *Graham* factors.

The panel's Rule 36 Affirmance was therefore contrary to this Court's opinions in *Ariosa*, *Randall*, and *Philips* because it blessed the Board's decision to ignore "evidence of the background understanding of skilled artisans . . . simply because the [reference] had not been identified at the petition stage as one of the pieces of prior art defining a combination for obviousness." *Id.*

III. This Court's Precedent Is Clear That Reliance on a Subset of References from an Enumerated Ground is Not a New Ground

This Court and its predecessor have long held that relying on fewer than all of the references of a ground does *not* transform that ground into a new one. *In re Bush*, 296 F.2d 491, 496 (C.C.P.A. 1961) ("[T]he answer specified a rejection on Whitney in view of Harth and if the board found it unnecessary to rely on Harth in sustaining that rejection, as it appears to have done, ***that does not amount to rejection on a new ground.***") (emphasis added). Indeed, the court "looks on this form of argument as sophistry and regards it with disfavor." *Id.* The holding of *In re Bush* is not a musty old rule no longer in favor and relegated to history, but one that the USPTO endorses and deems informative to this day. *Ex Parte Righi*, No. 2007-0590, 2007 WL 5211674, at *14 n.3 (informative) (P.T.A.B. July 25, 2007) (citing *Bush*, 296 F.2d at 496) ("The Board may rely on less than all of the references applied by the

Examiner in an obviousness rationale without designating it as a new ground of rejection.”).

Fraunhofer struggles to distinguish these cases, casually writing them off as “arising in the context of *ex parte* examination.” Resp. Br. at 48. But Fraunhofer fails to explain how any differences between IPRs and *ex parte* examinations require this Court to jettison its sixty-year-old rule that reliance on a subset of references in an obviousness combination does not constitute a new ground.²

The Supreme Court’s decision in *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018) does not compel a break from this longstanding precedent, as Fraunhofer suggests. Resp. Br. at 48. In particular, the Board could not be accused of “depart[ing] from the petition and institut[ing] a different *inter partes* review of [its] own design” if it evaluates the patentability of the claims based on the arguments, evidence and citations presented in the petition. *Id.* (quoting *SAS*, 138 S.Ct. at 1356). Such an overbroad view of *SAS* would bring it in conflict with this Court’s decisions, including for example, *Lone Star* in which this Court found that relying on references for the state of the art beyond those listed in the enumerated ground does render a ground “new.” *Lone Star*, 809 F. App’x at 777 (finding that it is error to “focus[]

² Notably, this Court confirmed that case law arising out of a reexamination *is* applicable to IPR proceedings. For example, the *Philips* case relies on the Court’s decision in *Randall*, 733 F.3d at 1362-63, which arose out of a reexamination. *Philips*, 948 F.3d 1337.

entirely on the listed references” when considering whether a new ground has been presented).

Respectfully submitted,

Dated: October 7, 2021

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Date	Description
9/7/2021	Dkt. 31 – Judgment in <i>Sirius XM Radio Inc. v. Fraunhofer-Gesellschaft Zur Forderung Der Angewandten Forschueng E.V.</i> , No. 20-2319 (Fed. Cir. 2021)

NOTE: This disposition is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

SIRIUS XM RADIO INC.,
Appellant

v.

**FRAUNHOFER-GESELLSCHAFT ZUR
FORDERUNG DER ANGEWANDTEN FORSCHUNG
E.V.,**
Appellee

2020-2319

Appeal from the United States Patent and Trademark
Office, Patent Trial and Appeal Board in No. IPR2018-
00690.

JUDGMENT

MARK BAGHDASSARIAN, Kramer Levin Naftalis &
Frankel LLP, New York, NY, argued for appellant. Also
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THIS CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

PER CURIAM (LOURIE, LINN, and DYK, *Circuit Judges*).

AFFIRMED. See Fed. Cir. R. 36.

ENTERED BY ORDER OF THE COURT

September 7, 2021
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

CERTIFICATE OF COMPLIANCE WITH RULE 32(B)

1. This brief complies with the type-volume limitation of Fed. R. App. P. 35(b) because this brief contains 3,624 words, exclusive of the certificate of interest, table of contents, table of citations, addendum, statement of counsel for a petition for rehearing and this certificate of compliance as exempted by Fed. R. App. P. 32(f) and Fed. Cir. R. 32(b).

2. This brief complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. P. 32(a)(6) because this brief has been prepared in a proportionally spaced typeface using Microsoft Word 2010 in Times New Roman 14 point font.

Respectfully submitted,

Dated: October 7, 2021

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