

McPhie, David

From: Hedvat, Shannon H. <SHedvat@KRAMERLEVIN.com>
Sent: Friday, July 13, 2018 6:51 AM
To: Redjaian, Babak; Yorks, Ben; McPhie, David; #FraunhoferIPRs [Int]
Cc: Caplan, Jonathan S.; Baghdassarian, Mark; Price, Jeffrey H.
Subject: IPR2018-00689 and IPR2018-00690

Follow Up Flag: FollowUp
Flag Status: Completed

Counsel,

Sirius XM intends to request the opportunity to file a reply to Patent Owner's Preliminary Responses in IPR Nos. 2018-00689 and 2018-00690 on the issues identified below. Please let us know if Patent Owner consents.

IPR2018-00689

1. Patent Owner incorrectly asserts that Sirius XM was required to identify Sirius XM Holdings and Liberty Media as real parties in interest. Sirius XM will explain through case law and company information that neither Sirius XM Holdings nor Liberty Media is a real party interest.

IPR2018-00690

1. Patent Owner incorrectly asserts that Sirius XM was required to identify Sirius XM Holdings and Liberty Media as real parties in interest. Sirius XM will explain through case law and company information that neither Sirius XM Holdings nor Liberty Media is a real party interest.
2. Patent Owner incorrectly asserts that the prior art reference Smallcomb does not qualify as prior art. Sirius XM will explain that Smallcomb is entitled to the date of its provisional application thus rendering it prior art to the challenged patent.
3. Patent Owner presents a legally erroneous request that Sirius XM be prohibited from relying upon its expert declaration in support of its obviousness grounds. Sirius XM will explain that there is no basis for Patent Owner's request.
4. Patent Owner ignores the Board's explicit instruction, in an e-mail dated June 22, that Patent Owner may not argue any response to Sirius XM's Opposition to Patent Owner's Motion to Dismiss (Paper 9) "in its Patent Owner Response" should "the Board decide[] to institute." Sirius XM will explain and request that Patent Owner's arguments in its Preliminary Response addressing the Motion to Dismiss are incorrect and should be disregarded.

Please provide your response by 5pm EST today and provide times that you are available for a call with the Board on Monday and Tuesday next week. We are available for a meet and confer on Monday or Tuesday if you would like to discuss before we submit our request to the Board.

Regards,
Shannon

Shannon H. Hedvat

Associate

Kramer Levin Naftalis & Frankel LLP

1177 Avenue of the Americas, New York, New York 10036

T 212.715.9185 M 973.809.4768 F 212.715.8385

shedvat@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.