

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SIRIUS XM RADIO INC.,
Petitioner,

v.

FRAUNHOFER-GESELLSCHAFT ZUR FORDERUNG DER
ANGEWANDTEN E.V.,
Patent Owner.

Case IPR2018-00690
Patent 6,314,289 B1

Before JEFFREY S. SMITH, STACEY G. WHITE, and
MICHELLE N. WORMMEESTER, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION
Conduct of the Proceeding
37 C.F.R. § 42.5

On February 21, 2020, Patent Owner contacted the Board by e-mail requesting authorization to file a motion to strike Petitioner's Reply in this proceeding, because, according to Patent Owner, Petitioner's Reply includes improper arguments. Patent Owner also requested to increase the word count for its Sur-Reply to 8,000 words in order to address the allegedly improper arguments.

The panel does not authorize the filing of a Motion to Strike. As explained in the Board's Trial Practice Guide, "[i]n most cases, the Board is capable of identifying new issues or belatedly presented evidence when weighing the evidence at the close of trial, and disregarding any new issues or belatedly presented evidence that exceeds the proper scope of reply or sur-reply." *See* Consolidated Trial Practice Guide 80 (November 2019), available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>. The Trial Practice Guide instructs that "striking the entirety or a portion of a party's brief is an exceptional remedy that the Board expects will be granted rarely." *Id.* We decline at this time to exclude the reply submissions.

The panel also does not authorize Patent Owner to increase the word count for its Sur-Reply to address the allegedly improper arguments. Instead, Patent Owner may file, as an appendix to its Sur-Reply, a list identifying, by page and line number, those arguments and evidence in the Reply that Patent Owner asserts go beyond the proper scope of a reply. Patent Owner's list may not exceed three pages, and will not be included in the word count of the Sur-Reply. Patent Owner's list shall not contain any argument.

If such a list is filed, Petitioner may file a responsive list identifying, by page and line number, where each reply argument identified in Patent Owner's list is supported by a theory of unpatentability expressed in the Petition and/or is responsive to an argument raised in the Patent Owner Response. Petitioner's list

may not exceed three pages, excluding the cover page, signature block, and certificate of service. Petitioner's list must be filed within five business days of the filing of Patent Owner's Sur-Reply. Petitioner's list shall not contain any argument.

The propriety or impropriety of the identified portions of the reply will be addressed, if necessary, in our Final Written Decision. To the extent the panel determines that any item identified by Patent Owner warrants additional briefing, an Order will be issued, providing such instruction to the parties.

Furthermore, although at this time we do not deem it necessary to resolve this issue prior to the Final Written Decision or via formal briefing, should either party request a hearing, the parties may address this issue during oral argument.

In view of the foregoing, it is hereby:

ORDERED that Patent Owner is authorized to file, as an appendix to its Sur-Reply, a list identifying by page and line number each instance of improper argument or evidence submitted in Petitioner's Reply, such list not to exceed three pages;

FURTHER ORDERED that if Patent Owner files the above authorized appendix to its Sur-Reply then Petitioner is authorized to file, within five business days of the filing of Patent Owner's Sur-Reply, a responsive list identifying, by page and line number, where each reply argument identified in Patent Owner's list is supported by a theory of unpatentability expressed in the Petition and/or is responsive to an argument raised in the Patent Owner Response, such list not to exceed three pages; and

FURTHER ORDERED that neither list shall contain any argument.

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