

**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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**PATENT OWNER SUR-REPLY**

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Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

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<i>Metalcraft of Mayville, Inc. v. The Toro Co.</i> , 848 F.3d 1358 (Fed. Cir. 2017) .....	21
<i>Murphy v. Smith</i> , 138 S. Ct. 784 (2018).....	4
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<i>Sanitec Indus. v. Micro-Waste Corp.</i> , No. CIV.A. H-04-3066, 2006 WL 3455000 (S.D. Tex. Nov. 28, 2006), <i>aff'd sub nom.</i> 296 F. App'x 44 (Fed. Cir. 2008).....	6
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<b>Other Authorities</b>	
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**EXHIBIT LIST**

<b>Fraunhofer Ex.</b>	<b>Exhibit Description</b>
2001	Executed Summons to Sirius XM Radio Inc., attaching Complaint for Patent Infringement, Dated February 22, 2017
2002	Fraunhofer Complaint for Patent Infringement against Defendant Sirius XM Radio Inc., Filed February 22, 2017
2003	PTAB E2E Search Result for AIA Review Number: IPR2016-00690, <a href="https://ptab.uspto.gov/#/login">https://ptab.uspto.gov/#/login</a> (search "AIA Review #" for "IPR2016-00690") (retrieved June 6, 2018)
2004	PTAB E2E Search Result for AIA Review Number: IPR2016-00690, <a href="https://ptab.uspto.gov/#/login">https://ptab.uspto.gov/#/login</a> (search "AIA Review #" for "IPR2016-00690") (retrieved April 18, 2018)
2005	Sirius XM Holdings Inc., SEC Form 10-K for the year ended December 31, 2017, Filed January 31, 2018
2006	Sirius XM Holdings Inc., SEC Form 8-K, November 14, 2013
2007	Pandora Media, Inc., SEC Schedule 13D, September 22, 2017
2008	Pandora Media, Inc., SEC Joint Filing Agreement (Exhibit A) to Schedule 13D, September 22, 2017
2009	Sirius XM Holdings Inc., SEC Form 8-K, January 11, 2018
2010	Sirius XM Holdings Inc., Exhibit 10.1 to SEC Form 8-K, January 10, 2018 (Meyer Employment Agreement)
2011	Sirius XM Holdings Inc., SEC Form 8-K, January 14, 2014
2012	Sirius XM Holdings Inc., Exhibit 10.1 to SEC Form 8-K, January 10, 2014 (Donnelly Employment Agreement)
2013	Sirius XM Holdings Inc., SEC Form 10-K for the year ended December 31, 2016, Filed February 2, 2017

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