

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SIRIUS XM RADIO INC.,
Petitioner,

v.

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

Case IPR2018-00690
Patent No. 6,314,289

APPENDIX TO THE PATENT OWNER SUR-REPLY

Mail Stop “PATENT BOARD”
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

In accordance with the Board’s February 25, 2020 Order (Paper 39), Patent Owner submits the following appendix to the Patent Owner Sur-Reply, identifying “arguments and evidence in the [Petitioner’s] Reply that ... go beyond the proper scope of reply”:

1. Reply from page 6, line 12 to page 8, line 13, including:
 - a. Section II.B (“The Challenged Claims are Unpatentable Over Chen Alone”); and
 - b. Ex. 1025 [Lyon Reply Dec.] ¶ 17 and accompanying table (pp. 10-12).
2. Reply from page 9, line 1 to page 12, line 5, including:
 - a. Section III.A.1 (“Campanella Is Prior Art Under 102(e) As Of The Filing of U.S. Patent Application”).
3. Reply from page 12, line 6 to page 20, line 24, including:
 - a. Section III.A.2 (“Campanella is § 102(e) Prior Art as of the Filing of the ‘591 Provisional”);
 - b. Section III.A.3 (“The Campanella Claims are Supported by the ‘591 Provisional”);
 - c. Section III.A.4 (“The Cited Portions of Campanella are Carried Over from the ‘591 Provisional”);

- d. Ex. 1025 [Lyon Reply Dec.] ¶¶ 18-34 and accompanying tables (pp. 12-38); and
 - e. Ex. 1026 [Campanella provisional].
4. Reply at page 20, line 25 to page 26, line 3, including:
- a. Section III.B (“Smallcomb is Prior Art”);
 - b. Ex. 1025 [Lyon Reply Dec.] ¶¶ 35-108 and accompanying tables (pp. 39-90); and
 - c. Ex. 1027 [Smallcomb provisional].

Date: April 2, 2020

Respectfully submitted,

/Ben J. Yorks/

Ben J. Yorks (Reg. No. 33,609)

Babak Redjaian (Reg. No. 42,096)

David McPhie (Reg. No. 56,412)

Kamran Vakili (Reg. No. 64,825)

Irell & Manella LLP

1800 Avenue of the Stars, Suite 900

Los Angeles, CA 90067

Tel: (310) 277-1010

Fax: (310) 203-7199

Email: FraunhoferIPRs@irell.com

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that on April 2, 2020, a copy of the foregoing document **APPENDIX TO THE PATENT OWNER SUR-REPLY** was served, by electronic mail, as agreed to by the parties, upon the following:

KRAMER LEVIN NAFTALIS & FRANKEL LLP

Jonathan Caplan (Reg. No. 38,094)
jcaplan@kramerlevin.com

Mark Baghdassarian (*pro hac vice*)
mbaghdassarian@kramerlevin.com

Jeffrey H. Price (Reg. 69,141)
jprice@kramerlevin.com

Shannon Hedvat (Reg. No. 68,417)
shedvat@kramerlevin.com

By: /Susan M. Langworthy/
Susan M. Langworthy