

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*.

ORDER  
Conduct of the Proceeding  
*37 C.F.R. § 42.5*

On April 8, 2020, Petitioner contacted the Board by e-mail requesting authorization to file a motion to strike portions of Patent Owner's Sur-Reply in this proceeding, because, according to Petitioner, Patent Owner's Sur-Reply is accompanied by new evidence that was not previously submitted as evidence in this proceeding. In the same e-mail, Petitioner requested that the Board disregard Patent Owner's Appendix to the Sur-Reply, which was filed on April 2, 2020, one day after the Sur-Reply due date of April 1, 2020.

The panel does not authorize the requested 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 sur-reply submissions.

The issue of whether the identified portions of the Sur-Reply are proper will be addressed, if necessary, in our Final Written Decision. Also, the issue of whether the Appendix to the Sur-Reply was timely filed will be addressed, if necessary, in our Final Written Decision. To the extent the panel determines that one or both of these issues warrant 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 these issues prior to the Final Written Decision or via formal briefing, should either party want a hearing on these issues, the parties may address these issues during oral argument.

IPR2018-00690  
Patent 6,314,289 B1

In view of the foregoing, it is hereby:

ORDERED that Petitioner is not authorized to file a motion to strike.

For PETITIONER:

Jonathan Caplan  
Shannon Hedvat  
Jeffrey Price  
KRAMER LEVIN NAFTALIS & FRANKEL LLP  
jcaplan@kramerlevin.com  
shedvat@kramerlevin.com  
jprice@kramerlevin.com

For PATENT OWNER:

Ben Yorks  
Babak Redjaian  
David McPhie  
Kamran Vakili  
IRELL & MANELLA LLP  
byorks@irell.com  
bredjaian@irell.com  
dmcphie@irell.com  
kvakili@irell.com