

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOSHIBA CORPORATION,
Petitioner,

v.

OPTICAL DEVICES, LLC,
Patent Owner.

Case IPR2014-01439 (Patent RE42,913 E)
Case IPR2014-01441¹ (Patent RE43,681 E)
Case IPR2014-01443 (Patent RE40,927 E)
Case IPR2014-01445 (Patent 7,839,729 B2)
Case IPR2014-01446 (Patent 7,196,979 B2)
Case IPR2014-01447 (Patent 8,416,651 B2)²

Before ERICA A. FRANKLIN, GLENN J. PERRY, and JAMES B. ARPIN,
Administrative Patent Judges.

PERRY, *Administrative Patent Judge.*

ORDER

Conduct of the Proceedings – Oral Argument
37 C.F.R. §§ 42.5, 42.70

¹ Case IPR2014-01442 has been consolidated with Case IPR2014-01441.

² The parties are not authorized to use a multiple case caption. They must file individual papers in each case to which they pertain.

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Petitioner requested oral argument pursuant to 37 C.F.R. § 42.70. Paper 32³. The request is *granted*.

Date and Time

Oral argument for these proceedings will be conducted on January 12 and 13, 2016. IPR2014-01439, IPR2014-01441, and IPR2014-01443 will be heard on January 12, 2016. IPR2014-01445, IPR2014-01446, and IPR2014-01447 will be heard on January 13, 2016. On each day of argument (three cases), each party will have ninety (90) minutes of total argument time, to be allotted among the three cases argued that day, as they wish. However, each party should briefly describe their presentation plan before they begin argument, including which motions will be argued. It is not required that each party address all outstanding motions, but, for clarity of the record, each party must identify, for each paper an exhibit discussed, both the paper or exhibit by number and the case in which it was filed.

Petitioner bears the ultimate burden of proof that the claims at issue are unpatentable. Therefore, Petitioner will proceed first to present its case with regard to the claims for which we instituted trial. Petitioner may reserve rebuttal time to respond to Patent Owner's arguments regarding the challenged claims and to Patent Owner's arguments regarding either or both motions, *if* Patent Owner presents arguments regarding any outstanding motion during its allotted time. If Patent Owner does not present arguments during its allotted time regarding its outstanding motion(s), Petitioner may

³ For convenience we cite only to paper numbers in Case IPR2014-01439.

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not present arguments during its rebuttal time regarding Patent Owner's motions. Thereafter, Patent Owner will respond to Petitioner's case, including any outstanding motion(s) argued by Petitioner. Patent Owner may reserve rebuttal time *only* to respond to Petitioner's rebuttal arguments concerning Patent Owner's argued motion(s).

Open to Public

There is a strong public policy interest in making all information presented in these proceedings public, as the review determines the patentability of claims in an issued patent and, thus, affects the rights of the public. This policy is reflected in part, for example, in 35 U.S.C. § 316(a)(1), which provides that the file of any *inter partes* review be made available to the public, except that any petition or document filed with the intent that it be sealed shall, if accompanied by a motion to seal, be treated as sealed pending the outcome of the ruling on the motion. Accordingly, we exercise our discretion to make the oral hearing publically available via in-person attendance.

Oral argument will commence at 10:00 AM Eastern Time, on January 12 and 13, 2016, on the ninth floor of Madison Building East, 600 Dulany Street, Alexandria, Virginia, and the oral argument will be open to the public for in-person attendance. In person attendance will be accommodated on a first come first serve basis.

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Reporter

The Board will provide a court reporter for the hearing, and the reporter's transcript will constitute the official record of the hearing.

Demonstratives

Demonstratives are aids in support of oral argument and are not evidence in the review. They will not become part of the official record of this review other than as mentioned in the transcript of oral argument. If demonstratives are to be used during oral argument, they must be served seven (7) business days before oral argument and otherwise in accordance with 37 C.F.R. § 42.70(b). Copies should also be sent by email (not filed via PRPS) to the Board. ***The parties shall not file any demonstrative exhibits in any of these cases.*** Hard copies of the demonstratives should be provided to the panel and to the court reporter at argument. The parties are directed to *St. Jude Medical, Cardiology Division, Inc. v. The Board of Regents of the University of Michigan*, Case IPR2013-00041, slip op. at 2–5 (PTAB Jan. 27, 2014) (Paper 65), and *CBS Interactive Inc. v. Helferich Patent Licensing, LLC*, IPR2013-00033, slip op. at 2–5 (PTAB Oct. 23, 2013) (Paper 118), regarding the appropriate content of demonstrative exhibits. The parties are reminded that the presenter must identify clearly and specifically each demonstrative exhibit (e.g., by slide or screen number) referenced during the hearing to ensure the clarity and accuracy of the reporter's transcript.

Any issue regarding demonstrative exhibits should be resolved at least two (2) business days prior to the hearing by way of a joint telephone

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conference call to the Board. The parties are responsible for requesting such a conference sufficiently in advance of the hearing to accommodate this requirement. Any objection to demonstrative exhibits that is not timely presented will be considered waived.

Special Needs and Audio Visual Equipment

Questions regarding special needs and/or specific audio-visual equipment should be directed to the Board at (571) 272-9797. **Requests for special needs and/or audio-visual equipment must be made five (5) days in advance of the earlier hearing date. The request is to be sent directly to Trials@uspto.gov. If the request is not received timely, the equipment may not be available on the day of the hearing or accommodations for the special need may not be possible.**

Panel Presence

Judges Franklin and Perry will be present in hearing room. Judge Arpin (Denver) will appear by video link. We ask that Counsel using a demonstrative clearly identify it before speaking about it. If a demonstrative is not made available to the Board in the manner indicated above, that demonstrative may not be available to each of the judges during the hearing and may not be considered. Further, images projected, using audio visual equipment in Alexandria, will *not* be visible to Judge Arpin in Denver. Because of limitations on the audio transmission systems in our hearing rooms, the presenter may speak *only* when standing at the hearing room podium.

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