

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FPUSA, LLC,
Petitioner,

v.

M-I LLC,
Patent Owner.

Case IPR2016-00213 (Patent 9,004,288 B2)
Case IPR2016-00295 (Patent 9,074,440 B2)

Before JAMES A. TARTAL, CARL M. DEFRANCO, and
TIMOTHY J. GOODSON, *Administrative Patent Judges*.

GOODSON, *Administrative Patent Judge*.

ORDER
Trial Hearing
37 C.F.R. § 42.70

IPR2016-00213 (Patent 9,004,288 B2)
IPR2016-00295 (Patent 9,074,440 B2)

Patent Owner requests an oral hearing pursuant to 37 C.F.R. § 42.70(a). IPR2016-00213, Paper 39; IPR2016-00295, Paper 31. Patent Owner's requests are *granted*. Although the cases captioned above are not consolidated, the hearings will be held together and one transcript will be provided for both cases.

The Scheduling Order in these cases set Due Date 7 as March 1, 2017. IPR2016-00213, Paper 15, 6; IPR2016-00295, Paper 10, 6. However, in an email to the Board dated February 10, 2017, Patent Owner requested postponement of the hearing in view of its pending motion to terminate these proceedings, which Patent Owner argues may eliminate the need for a hearing on the merits. *See* IPR2016-00213, Paper 42; IPR2016-00295, Paper 34. Patent Owner's email indicated that Petitioner joins in the request to postpone the hearing. Consistent with the parties' joint postponement request, the hearing will commence at 1:00 PM ET, on **April 24, 2017**, on the ninth floor of Madison Building East, 600 Dulany Street, Alexandria, Virginia. If either party has a conflict with this date it must notify the Board within three business days of entry of this Order. Petitioner is allotted 60 minutes of total argument time for both cases. Likewise, Patent Owner is allotted 60 minutes of total argument time for both cases.

Petitioner bears the ultimate burden of proof that the claims at issue in these reviews are unpatentable. Therefore, at the hearing, Petitioner will proceed first to present arguments with regard to the challenged claims and grounds on which basis we instituted trial in these proceedings. Petitioner may reserve a portion of its argument time for rebuttal after Patent Owner has responded to Petitioner's initial presentation. Thereafter, Patent Owner will argue its opposition to Petitioner's case, having available to it the entirety of its allotted argument time.

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To the extent Petitioner reserves rebuttal time, Petitioner then may make use of its rebuttal time responding to Patent Owner.

Under 37 C.F.R. § 42.70(b), demonstrative exhibits must be served at least *five business days* before the hearing. The parties also shall provide a courtesy copy of any demonstrative exhibits to the Board at least *five business days* prior to the hearing by emailing them to Trials@uspto.gov. The parties shall not file any demonstrative exhibits in these proceedings without prior authorization from the Board. The parties are directed to *St. Jude Medical, Cardiology Division, Inc. v. The Board of Regents of the University of Michigan*, IPR2013-00041 (PTAB Jan. 27, 2014) (Paper 65), for guidance regarding the appropriate content of demonstrative exhibits. The parties shall meet and confer to discuss any objections to demonstrative exhibits at least *three business days* before the hearing. If any issues regarding demonstratives remain unresolved after the parties meet and confer, the parties shall file jointly a one-page list of objections to the demonstrative exhibits at least *two business days* before the hearing. For each objection, the list must identify with particularity the demonstratives subject to the objection and include a short, one-sentence statement explaining the objection. We will consider the objections and schedule a conference call if necessary. Otherwise, we will reserve ruling on the objections until the hearing or after the hearing. Any objection to demonstrative exhibits not presented timely will be considered waived. We take this opportunity to remind the parties that the demonstrative exhibits presented in these cases are not evidence and are intended only to assist the parties in presenting their oral argument to the panel.

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One or more members of the panel hearing this case will attend the hearing remotely via a videoconferencing device and will not be able to view the projection screen in the hearing room. Consequently, the presenter should identify clearly and specifically each demonstrative exhibit (e.g., by slide or screen number) or page of the record referenced during the hearing.

We expect lead counsel for each party to be present in person at the hearing. Lead or backup counsel, however, may present the party's argument. If either party anticipates that its lead counsel will not be attending the hearing, that party should initiate a joint telephone conference with the other party and the panel no later than *two business days* prior to the hearing to discuss the matter.

We will provide a court reporter for the hearing and the reporter's transcript will constitute the official record of the hearing. Each party shall provide a hard copy of their demonstratives to the court reporter at the hearing. Requests for audio-visual equipment will not be honored unless presented in a separate communication directed to Trials@uspto.gov not less than *five days* before the hearing.

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