

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC. AND TELEFONAKTIEBOLAGET
LM ERICSSON, AND
AT&T MOBILITY, LLC
Petitioners

v.

INTELLECTUAL VENTURES I LLC,
Patent Owner

Case IPR2016-01169
Case IPR2017-00681
Patent 5,960,032

Before KRISTEN L. DROESCH, BRIAN J. McNAMARA, and
DAVID C. McKONE, *Administrative Patent Judges*.

McNAMARA, *Administrative Patent Judge*.

ORDER
Trial Hearing
37C.F.R. § 42.70

Based on a petition filed by Ericsson Inc. and Telefonaktiebolaget LM Ericsson, a trial in IPR2016-001169 was instituted on December 14, 2016. (Paper 9, “Decision to Institute”). A contemporaneously entered Scheduling Order set the date for oral hearing to September 11, 2017, if hearing is requested by the parties and granted by the Board. Paper 10 (“Scheduling Order”). On March 16, 2017, based on a petition filed by AT&T Mobility LLC we entered an order instituting *inter partes* review in IPR2017-00681 and joining that proceeding to IPR2016-01169. Paper 18. The Scheduling Order was not changed by the joinder. Ericsson Inc. and Telefonaktiebolaget LM Ericsson and AT&T Mobility (“Petitioner”) and Intellectual Ventures I LLC (“Patent Owner”) have requested oral hearing pursuant to 37 C.F.R. § 42.70. The request is GRANTED.

Each party will have 45 minutes of total argument time. Petitioner bears the ultimate burden of proof that the claims at issue in this review are unpatentable. Therefore, at oral hearing Petitioner will proceed first to present its case with regard to the challenged claims on which basis we instituted trial. Thereafter, Patent Owner will argue its opposition to Petitioner’s case. Petitioner may use any time Petitioner reserved to rebut to Patent Owner’s opposition. No other argument will be heard.

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) and 35 U.S. C. § 326(a)(1) which provide that the file of any *inter partes* review or post grant 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. There are no motions to seal in the present proceeding. Accordingly, the Board exercises its discretion to make the oral hearing publically available via in-person attendance.

The hearing will commence at 1:30 PM, on September 11, 2017, on the ninth floor of Madison Building East, 600 Dulany Street, Alexandria, Virginia. In-person attendance will be accommodated on a first come first serve basis.

The Board will provide a court reporter for the hearing and the reporter's transcript will constitute the official record of the hearing. Any demonstrative exhibits must be served seven business days before the hearing. 37 C.F.R. § 42.70(b). Demonstrative exhibits are not evidence and may not introduce new evidence or arguments. Instead, demonstrative exhibits should cite to evidence in the record. The parties are directed to *St. Jude Medical, Cardiology Division, Inc. v. The Board of Regents of the University of Michigan*, Case No. IPR2013-00041 (PTAB Jan. 27, 2014) (Paper 65), and *CBS Interactive Inc. v. Helferich Patent Licensing, LLC*, IPR2013-00033, Paper 118 (Oct. 23, 2013), regarding the appropriate content of demonstrative exhibits. Any issue regarding demonstrative exhibits should be resolved at least three days prior to the hearing by way of a joint telephone 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. Demonstratives should be filed at the Board no later than two days before the hearing. A

hard copy of the demonstratives should be provided to the court reporter at the hearing.

Questions regarding specific audio-visual equipment should be directed to the Board at (571) 272-9797. **Requests for audio-visual equipment are to be made 5 days in advance of the hearing date. The request is to be sent to Trials@uspto.gov. If the request is not received timely, the equipment may not be available on the day of the hearing.** 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. The parties also should note that at least one member of the panel will be attending the hearings electronically from a remote location and that if a demonstrative is not filed or otherwise made fully available or visible to the judge presiding over the hearing remotely, that demonstrative will not be considered. If the parties have questions as to whether demonstrative exhibits would be sufficiently visible and available to all of the judges, the parties are invited to contact the Board at 571-272-9797.

The Board expects lead counsel for Petitioner and Patent Owner to be present in person at the oral hearing. However, lead or backup counsel may present the party's argument. If either party anticipates that its lead counsel will not be attending the oral argument, the parties should initiate a joint telephone conference with the Board no later than two business days prior to the oral hearing to discuss the matter.

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Patent 5,960,032

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