

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALERE INC.,
Petitioner,

v.

REMBRANDT DIAGNOSTICS, LP,
Patent Owner.

IPR2016-01502
Patent 6,548,019 B1

Before CHRISTOPHER L. CRUMBLEY, JON B. TORNQUIST, and
KIMBERLY McGRAW, *Administrative Patent Judges*.

TORNQUIST, *Administrative Patent Judge*.

ORDER
Trial Hearing
37 C.F.R. § 42.70

This case was remanded from the United States Court of Appeals for the Federal Circuit for us to consider grounds of unpatentability asserted in the Petition but not addressed in our Final Written Decision (Paper 39). In accordance with our Remand Scheduling Order (Paper 44), Petitioner now requests an oral hearing pursuant to 37 C.F.R. § 42.70. Paper 50. Upon consideration, Petitioner's request for oral hearing is *granted*.

Oral argument will commence at **1:00 PM (ET) on Monday, June 22, 2020, by video**. Each party will have one (1) hour, total, to present its arguments. *See* Office Consolidated Trial Practice Guide (November 2019), 81, *available at* <https://www.uspto.gov/TrialPracticeGuide> Consolidated; *see also* 84 Fed. Reg. 64,280 (Nov. 21, 2019) (“The Board expects to ordinarily provide for an hour of argument per side for a single proceeding, but a party may request more or less time depending on the circumstances of the case.”). Petitioner will first present its case regarding the challenged claims and Petitioner may reserve rebuttal time (of no more than half its total argument time) to respond to Patent Owner's arguments presented at the hearing. Thereafter, Patent Owner may respond to Petitioner's argument and may reserve time to present sur-rebuttal arguments. *See* Office Consolidated Trial Practice Guide, November 2019 Edition, 83. No live testimony from any witness will be taken at the oral argument.

The parties are directed to contact the Board at least ten (10) days in advance of the hearing if there are any concerns about disclosing confidential information. The Board will provide a court reporter for the hearing, and the reporter's transcript will constitute the official record of the hearing.

If at any time during the proceeding, you encounter technical or other difficulties that fundamentally undermine your ability to adequately represent your client, please let the panel know immediately, and adjustments will be made.¹

To facilitate planning, each party must contact PTAB Hearings at (571) 272-9797 five business days prior to the oral hearing date to receive video set-up information. As a reminder, all arrangements and the expenses involved with appearing by video, such as the selection of the facility to be used from which a party will attend by video, must be borne by that party. If a video connection cannot be established, the parties will be provided with dial-in connection information, and the oral hearing will be conducted telephonically.

If one or both parties would prefer to participate in the oral hearing telephonically, they should notify PTAB Hearings at the above telephone number five business days prior to the hearing to receive dial-in connection information.

At least seven (7) business days prior to the hearing, each party shall serve on the other party any demonstrative exhibit(s) it intends to use during the hearing. *See* 37 C.F.R. § 42.70(b). At least five (5) business days before the hearing, the parties shall provide the demonstrative exhibits to the Board by emailing them to PTABHearings@uspto.gov. The parties shall not file any demonstrative exhibits in this case, without prior authorization from the Board.

¹ For example, if a party is experiencing poor video quality, the Board may provide alternate dial-in information.

Demonstrative exhibits used at the oral hearing are aids to oral argument and not evidence, and should be clearly marked as such. For example, each slide may be marked with the words “DEMONSTRATIVE EXHIBIT – NOT EVIDENCE” in the footer. *See* Office Consolidated Trial Practice Guide, November 2019 Edition, 84. Demonstrative exhibits cannot be used to advance arguments or introduce evidence not previously presented in the record. *See Dell Inc. v. Accelaron, LLC*, 884 F.3d 1364, 1369 (Fed. Cir. 2018) (noting that the “Board was obligated to dismiss [the petitioner’s] untimely argument . . . raised for the first time during oral argument”). Instead, demonstrative exhibits must cite to evidence in the record.

The parties should attempt to work out any objections to demonstratives prior to involving the Board. Should either party disagree with the propriety of any of the opposing parties’ demonstratives, the party may send, two (2) business days prior to the hearing, an email to Trials@uspto.gov limited to identifying the opposing parties’ slide(s) objected to and a brief sentence as to the general basis of the objection. No further argument is permitted in that email. The Board will then take the objections under advisement, and if the content is inappropriate, it will not be considered. Any objection to demonstrative exhibits that is not timely presented will be considered waived. The Board asks the parties to confine demonstrative exhibit objections to those identifying egregious violations that are prejudicial to the administration of justice. 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. In

general, if the content on a slide cannot be readily associated with an argument made, or evidence referenced, in a substantive paper, it is inappropriate. The best practice is to indicate on each slide where support may be found in a substantive paper and/or an exhibit of record in this proceeding.

The parties are reminded that each 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. Each member of the panel will be attending the hearing electronically from a remote location. If a demonstrative exhibit is not emailed to the Board or otherwise made fully available or visible to all judges at the hearing, that demonstrative exhibit 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 generally expects lead counsel for each party to be present by video at the oral hearing. Any counsel of record may present the party's argument as long as that counsel is present by video.

Any special requests for audio-visual equipment should be directed to PTABHearings@uspto.gov. A party may also indicate any special requests related to appearing at a video oral hearing, such as a request to accommodate visual or hearing impairments, and indicate how the PTAB may accommodate the special request. Any special requests must be presented in a separate communication not less than five (5) days before the hearing.

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