

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

PAPST LICENSING GMBH & CO. KG,
Patent Owner.

Case IPR2016-01839 (Patent 6,470,399 B1)
Case IPR2016-01842 (Patent 9,189,437 B2)
Case IPR2016-01863 (Patent 8,504,746 B2)
Case IPR2016-01864 (Patent 6,470,399 B1)¹

Before JONI Y. CHANG, JAMES B. ARPIN, and MIRIAM L. QUINN,
Administrative Patent Judges.

QUINN, *Administrative Patent Judge.*

ORDER
Oral Hearing
37 C.F.R. § 42.70

¹ This Order addresses the same issues for the above-identified cases. We, therefore, exercise our discretion to issue one order to be filed in each case.

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In each of the above-identified proceedings, we instituted *inter partes* review (Paper 10²) and issued a Scheduling Order (Paper 11), which sets an oral hearing date for January 16, 2018,³ if oral hearing is requested by either party and granted by the Board. Pursuant to 37 C.F.R. § 42.70, the parties requested an oral hearing in each case. Papers 20 and 22. The requests are *granted*.

The consolidated hearing for IPR2016-01842, IPR2016-01863, and IPR2016-01864 will commence at 10:00 AM Eastern Time, on January 16, 2018. Each party will have forty five (45) minutes of total time to present arguments for these proceedings. As to IPR2016-01839, the hearing will commence following a break after the morning hearings session, and each party will have thirty (30) minutes of total time to present arguments.

These hearings will be conducted at the **USPTO Headquarters, Ninth Floor of Madison Building East, 600 Dulany Street, Alexandria, Virginia, 22314.**⁴ The hearings will be open to the public for in-person attendance that will be accommodated on a first-come, first-serve basis.

For each oral hearing, because Petitioner bears the ultimate burden of proof that the challenged claims are unpatentable, Petitioner will proceed first to present its case as to the challenged claims and instituted grounds of

² Citations refer to IPR2016-01842, as representative, unless otherwise noted.

³ In IPR2016-01839, we issued a Revised Scheduling Order resetting the oral argument date to January 16, 2018 for efficiency. IPR2016-01839, Paper 24.

⁴ See <https://www.uspto.gov/about-us/uspto-locations/alexandria-virginia-headquarters> for additional information.

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unpatentability in the proceedings, and may reserve a small portion of its time for rebuttal. Thereafter, Patent Owner will respond to Petitioner's case. After that, Petitioner may use the rest of its time for its rebuttal, responding to Patent Owner's specific arguments presented at the oral hearing. No live testimony from any witness will be taken at the oral argument.

Under 37 C.F.R. § 42.70(b), demonstrative exhibits must be served at least seven business days prior to the hearing. The parties shall confer regarding any objections to demonstrative exhibits, and file demonstrative exhibits with the Board, as a separate exhibit in accordance with 37 C.F.R. § 42.63, at least five business days prior to the hearing.

Demonstrative exhibits are not evidence, but merely visual aids for use at the oral hearing. For any issue regarding the proposed demonstrative exhibits that cannot be resolved after conferring with the opposing party, the parties may file jointly a one-page list of objections at least five business days prior to the hearing. The list should identify with particularity which demonstrative exhibits are subject to objection and include a short statement (no more than one concise sentence) of the reason for each objection. No argument or further explanation is permitted.

We will consider the objections and schedule a conference call, if necessary, to discuss them. Otherwise, we may strike demonstratives that we find objectionable or reserve ruling on the objections until the hearing or after the hearing. Any objection to demonstrative exhibits that is not presented timely will be considered waived. Each party also shall provide a hard copy of its demonstrative exhibits to the court reporter at the hearing.

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The parties are reminded that the presenter must identify clearly and specifically each demonstrative exhibit (e.g., by slide or screen number and by content) referenced during each hearing to ensure the clarity and accuracy of the reporter's transcript. Further, because a consolidated hearing will be conducted for IPR2016-01842, IPR2016-01839, IPR2016-01863, and IPR2016-01864, if an argument and/or evidence applies only to a particular proceeding or proceedings, the presenter must identify the proceeding or proceedings, to which that argument and/or evidence applies. The parties also should note that Judge Miriam Quinn (Dallas) and Judge James Arpin (Denver) will be attending each hearing electronically and will only have access to the courtesy copy of the demonstratives provided in advance, as referenced above. 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 Judges Quinn and Arpin. Because of limitations on the audio transmission systems in our hearing rooms, the presenter may speak only when standing at the hearing room podium. 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 each party to be present at oral hearing, although any backup counsel may make the actual presentation, in whole or in part. If lead counsel for either party is unable to attend the oral argument, the Board should be notified via a joint telephone conference call

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no later than five business days prior to the oral hearing to discuss the matter.

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

Requests for audio-visual equipment or special accommodations at the hearing are to be made five days in advance of the hearing date. The requests must be sent to *Trials@uspto.gov*. If the requests are not received timely, equipment or accommodations may not be available on the day of the hearing.

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