

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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LSI CORPORATION and AVAGO TECHNOLOGIES U.S., INC.,  
Petitioner,

v.

REGENTS OF THE UNIVERSITY OF MINNESOTA,  
Patent Owner.

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Case IPR2017-01068  
Patent 5,859,601 B2

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Before JENNIFER S. BISK, ROBERT J. WEINSCHENK, and  
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*.

ORDER  
Granting Request for Oral Argument  
*37 C.F.R. § 42.70*

Both parties requested oral argument in this *inter partes* review trial pursuant to 37 C.F.R. § 42.70. Papers 52, 53. Patent Owner requests one hour of total argument time, 30 minutes per side. Paper 52, 1. Petitioner requests “at least 60 minutes to address all issues in this matter.” Paper 53, 1. Upon consideration, the request for oral argument is granted, and each party shall have 60 minutes of argument time.

Oral arguments will commence at 1:00 pm Eastern time on January 19, 2021, by video. The parties are directed to contact the Board at least 10 days in advance of the argument if there are any concerns about disclosing confidential information. The Board will provide a court reporter for the argument, and the reporter’s transcript will constitute the official record of the argument.

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.

To facilitate planning, each party must contact PTAB Hearings at [PTABHearings@uspto.gov](mailto:PTABHearings@uspto.gov) at least five business days prior to the oral argument 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 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 argument will be conducted telephonically.

If one or both parties would prefer to participate in the oral argument telephonically, they shall notify PTAB Hearings at the above email address

at least five business days prior to the argument to receive dial-in connection information.

Petitioner, bears the ultimate burden of proof that the claims at issue in the *inter partes* reviews are unpatentable. Therefore, Petitioner will open the argument by presenting argument regarding the pending grounds of unpatentability. Patent Owner will then have the opportunity to respond to Petitioner's arguments. If desired, Petitioner may reserve rebuttal time, not to exceed half the total time allotted. Petitioner is cautioned that rebuttal time may only be used to respond to issues raised during Patent Owner's argument. If requested, the Board may permit Patent Owner to present a short sur-rebuttal argument to address any issues raised during Petitioner's rebuttal.

Demonstrative exhibits shall be served on opposing counsel pursuant to 37 C.F.R. § 42.70(b). In addition, we request the parties file exhibits with the Board no later than five business days before the argument. Upon filing, a copy of the demonstrative exhibits should also be emailed to PTABHearings@uspto.gov so that they may be provided to the court reporter prior to the video hearing. All pages of demonstrative exhibits should be clearly marked with the legend "DEMONSTRATIVE EXHIBIT—NOT EVIDENCE." The parties are directed to *St. Jude Medical, Cardiology Division, Inc. v. The Board of Regents of the University of Michigan*, IPR2013-00041, Paper 65 (PTAB Jan. 27, 2014), for guidance regarding the appropriate content of demonstrative exhibits.

The Board expects that the parties will meet and confer in good faith to resolve any objections to demonstrative exhibits, but if such objections cannot be resolved the parties may file any objections to demonstratives with

the Board at least two business days before the argument. The objections should identify with particularity which portions of the demonstrative exhibits are subject to objection and include a one-sentence statement of the basis for each objection. No argument or further explanation is permitted. The Board will consider any objections and schedule a conference call if deemed necessary. Otherwise, the Board will reserve ruling on the objections. Any objection to demonstrative exhibits that is not timely presented will be considered waived.

The Board generally expects lead counsel for each party to be present by video at the oral argument. Any counsel of record that is present by video may present the party's argument. In addition, the Board has established the "Legal Experience and Advancement Program," or "LEAP," to encourage advocates with less legal experience to argue before the Board to develop their skills. The Board defines a LEAP practitioner as a patent agent or attorney having three or fewer substantive oral arguments in any federal tribunal, including PTAB, *and* seven or fewer years of experience as a licensed attorney or agent.<sup>1</sup>

The parties are encouraged to participate in the Board's LEAP program. Either party may request that a qualifying LEAP practitioner participate in the program and conduct at least a portion of the party's oral argument. The Board will grant up to fifteen minutes of additional argument

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<sup>1</sup> Whether an argument is "substantive" for purposes of determining whether an advocate qualifies as a LEAP practitioner will be made on a case-by-case basis with considerations to include, for example, the amount of time that the practitioner argued, the circumstances of the argument, and whether the argument concerned the merits or ancillary issues.

time to that party, depending on the length of the proceeding and the PTAB's hearing schedule. A party should submit a request, no later than at least five business days before the oral hearing, by email to the Board at [PTABHearings@uspto.gov](mailto:PTABHearings@uspto.gov).<sup>2</sup>

The LEAP practitioner may conduct the entire oral argument or may share time with other counsel, provided that the LEAP practitioner is offered a meaningful and substantive opportunity to argue before the Board. The party has the discretion as to the type and quantity of oral argument that will be conducted by the LEAP practitioner.<sup>3</sup> Moreover, whether the LEAP practitioner conducts the argument in whole or in part, the Board will permit more experienced counsel to provide some assistance to the LEAP practitioner, if necessary, during oral argument, and to clarify any statements on the record before the conclusion of the oral argument. Importantly, the Board does not draw any inference about the importance of a particular issue or issues, or the merits of the party's arguments regarding that issue, from the party's decision to have (or not to have) a LEAP practitioner argue.

In instances where an advocate does not meet the LEAP eligibility requirements, either due to the years of experience as a licensed attorney/patent agent or the number of "substantive" oral hearing arguments,

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<sup>2</sup> Additionally, a LEAP Verification Form shall be submitted by the LEAP practitioner, confirming eligibility for the program. A combined LEAP Practitioner Request for Oral Hearing Participation and Verification Form is available on the LEAP website, [www.uspto.gov/leap](http://www.uspto.gov/leap).

<sup>3</sup> Examples of the issues that a LEAP practitioner may argue include claim construction argument(s), motion(s) to exclude evidence, or patentability argument(s) including, e.g., analyses of prior art or objective indicia of non-obviousness.

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