

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BMW OF NORTH AMERICA, LLC AND BAYERISCHE MOTOREN
WERKE AKTIENGESELLSCHAFT,
Petitioner,

v.

THEODORE & ASSOCIATES, LLC,
Patent Owner.

Cases IPR2017-01379 and IPR2017-01380¹
Patent 9,045,163 B2

Before MITCHELL G. WEATHERLY, FRANCES L. IPPOLITO, and
SEAN P. O'HANLON, *Administrative Patent Judges*.

WEATHERLY, *Administrative Patent Judge*.

ORDER
Oral Hearing
37 C.F.R. § 42.70

Inter partes reviews IPR2017-01379 and IPR2017-01380 were
instituted on November 21, 2017. Paper 9, IPR2017-01379; Paper 8,
IPR2017-01380. Scheduling Orders were issued on the same day, which set

¹ This caption refers to two related cases, and the parties are not authorized
to use this caption to file papers in either of the referenced proceedings.

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the date for oral hearing to August 15, 2018, if hearing were requested by the parties and granted by the Board. Paper 10, IPR2017-01379; Paper 9, IPR2017-01380. Both parties have requested oral hearing pursuant to 37 C.F.R. § 42.70. Papers 25, 26, IPR2017-01379; Papers 24, 25, IPR2017-01380. Petitioner's and Patent Owner's requests for oral hearing are *granted*.

The hearing will commence at 1:00 p.m., on August 15, 2018, on the ninth floor of Madison Building East, 600 Dulany Street, Alexandria, Virginia. The Board will provide a court reporter for the hearing and the reporter's transcript will constitute the official record of the hearing. The hearing will be open to the public for in-person attendance that will be accommodated on a first-come, first-served basis.

Each party will have one hour to present arguments. Petitioner bears the ultimate burden of proof that Patent Owner's claims at issue in this review are unpatentable. Petitioner will open the hearing by presenting its case regarding the patentability of any claim at issue in the proceedings. Patent Owner will then respond to Petitioner's argument. Petitioner may reserve time to respond to arguments presented by Patent Owner.

Demonstrative exhibits in this proceeding are not evidence and are intended only to assist the parties in presenting their oral argument to the panel. Under 37 C.F.R. § 42.70(b), demonstrative exhibits shall be served on opposing counsel at least seven (7) business days before the oral hearing, and filed as an exhibit no later than the time of the oral hearing. The parties also shall provide a courtesy copy of any demonstrative exhibits to the Board at least three (3) business days prior to the oral hearing by emailing the exhibits to Trials@uspto.gov. The parties are directed to *St. Jude*

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Medical, Cardiology Division, Inc. v. The Board of Regents of the University of Michigan, IPR2013-00041 (PTAB January 27, 2015) (Paper 65), for guidance regarding the appropriate content of demonstrative exhibits, which must include citations to the record.

If either party objects to demonstrative exhibits, the parties shall meet and confer in good faith to resolve any such objections. A party may file a paper addressing any unresolved objections to demonstrative exhibits with the Board no later than three (3) business days before the oral hearing. The paper shall include a single sentence per objection stating the basis for that objection and be accompanied by a copy of the allegedly objectionable demonstrative exhibit that identifies the objectionable portion of the exhibit with particularity. No further argument or explanation is permitted. We will consider the objections and, if we deem it necessary, we will further address the objections in a conference call or at the oral hearing. Otherwise, we will reserve ruling on the objections until after the oral hearing.

Requests for audio-visual equipment are to be made no later than five (5) days in advance of the hearing date via email to Trials@uspto.gov. If the request is not received timely, the equipment may not be available on the day of the hearing.

We expect lead counsel for each party 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 panel no later than two (2) business days prior to the oral hearing to discuss the matter.

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