

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DONGHEE AMERICA, INC. and DONGHEE ALABAMA, LLC,
Petitioner,

v.

PLASTIC OMNIUM ADVANCED INNOVATION AND RESEARCH,
Patent Owner.

Case IPR2017-01605
Patent 7,166,253 B2

Before MITCHELL G. WEATHERLY, CHRISTOPHER M. KAISER, and
ROBERT L. KINDER, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

ORDER
Trial Hearing
37 C.F.R. § 42.70

Donghee America, Inc. and Donghee Alabama, LLC (“Petitioner”) and Plastic Omnium Advanced Innovation and Research (“Patent Owner”) each request oral hearing pursuant to 37 C.F.R. § 42.70. Paper 35; Paper 37. This Order resolves those requests.

We note at the outset that each of the requests for oral hearing is untimely. The scheduling order governing this proceeding set August 10, 2018, as Due Date 4, the deadline for requesting oral hearing. Paper 11, 5, 7. Despite this, neither request was filed until August 21, 2018, making those requests untimely.

The parties presumably consider their requests timely because they stipulated to a change in the deadline to request oral hearing. Paper 35, 1 (“Pursuant to . . . the Parties’ July 24, 2018 Joint Notice of Stipulation to Revise Schedule . . . [Patent Owner] respectfully request[s] oral argument”); Paper 37, 1 (“Petitioners . . . hereby request oral argument pursuant to . . . the Joint Notice of Stipulation to Revise Schedule”). The parties did in fact stipulate to a change in Due Date 4 from August 10 to August 21. Paper 32, 1. And the scheduling order does give the parties the authority to stipulate to changes in certain due dates, including Due Date 4. Paper 11, 3 (“The parties may stipulate to different dates for DUE DATES 1 through 5”). But the scheduling order places an important limitation on the parties’ authority to change Due Date 4: “Any stipulated extension of DUE DATE 4 *shall not modify the deadline set forth in this Order by which a party must request oral argument.*” *Id.* at 3–4 (emphasis added). Accordingly, the deadline to request oral argument remains August 10, 2018. The parties’ requests for oral hearing filed on August 21, 2018, are therefore untimely.

A way out of this dilemma may be found in Rule 42.5(c)(3). Although neither party bothered to invoke this rule, it provides us with the independent power to decide “that consideration [of a late filing] on the merits would be in the interests of justice.” 37 C.F.R. § 42.5(c)(3). This provision helps to ensure that our rules are “construed to secure the just . . . resolution of every proceeding.” *Id.* § 42.1(b). Here, both parties wish to have an oral hearing, which suggests that, at a minimum, neither party would be prejudiced by our holding a hearing based on the untimely hearing requests. We also believe that the opportunity for the parties to crystallize their arguments and respond to questions from the panel would be useful in resolving this proceeding on the merits. Because Petitioner, Patent Owner, and the Board all would prefer to hold an oral hearing, the interests of justice strongly favor holding the hearing.

Consistent with the discussion above, we grant the parties’ requests for oral hearing. Oral argument shall commence at 1:00 pm Eastern Time on September 12, 2018, on the 9th floor of Madison Building East, 600 Dulany Street, Alexandria, Virginia.

Each side requests 30 minutes of argument time. Paper 35, 2; Paper 37, 1. Petitioner and Patent Owner each shall have 30 minutes of total time to present arguments. The hearing will proceed as follows. Petitioner will open the hearing by presenting its case regarding the challenged claims and the proposed substitute claims. Patent Owner then will respond to Petitioner’s presentation. Petitioner may reserve rebuttal time (of no more than half its total argument time) to reply to Patent Owner’s arguments. Patent Owner may reserve sur-rebuttal time (of no more than half its total argument time) to respond to Petitioner’s rebuttal.

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.

The parties shall serve on opposing counsel demonstrative exhibits no later than September 5, 2018. The parties also shall provide the demonstrative exhibits to the Board at least three business days prior to the hearing by emailing them to Trials@uspto.gov. The parties shall not file any demonstrative exhibits in this proceeding without prior authorization from the Board. A hard copy of the demonstrative exhibits should be provided to the court reporter at the hearing.

We remind the parties that demonstrative exhibits are not evidence, but are intended to assist the parties in presenting their oral arguments to the Board. We also remind the parties that demonstrative exhibits are not a mechanism for making arguments not previously addressed in the papers. The parties are directed to *St. Jude Medical, Cardiology Division, Inc. v. The Board of Regents of the University of Michigan*, Case IPR2013-00041 (PTAB Jan. 27, 2014) (Paper 65), for guidance regarding the appropriate content of demonstrative exhibits, which must include citations to the record.

To the extent that the parties object to the propriety of any demonstrative exhibits, we expect the parties will meet and confer in good faith to resolve any objections to demonstrative exhibits. If such objections cannot be resolved, the parties may file objections to demonstratives with the Board at least two business days before the hearing. The objections should identify with particularity the portions of each demonstrative exhibit

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subject to objection, include a copy of the objected-to portions, and include a one-sentence statement of the reason for each objection. No further argument or explanation is permitted. We will consider any objections and schedule a conference call if deemed necessary. Otherwise, we will reserve ruling on the objections. Any objection to demonstrative exhibits that is not timely presented will be considered waived.

At least one member of the panel will be attending the hearing electronically from a remote location and may not be able to view the projection screen in the hearing room. In particular, documents presented on the Elmo projector are not visible to remote judges, so please plan accordingly. If a demonstrative exhibit is not made available or visible to the judge(s) presiding over the hearing remotely, that demonstrative will not be considered. 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 and for the benefit of the judge(s) presiding over the hearing remotely. Because of limitations of the audio transmission systems in our hearing rooms, the presenter may speak only when standing at the hearing room lectern.

No live witness testimony shall be taken at the oral argument. The Board expects lead counsel for each party to be present in person at the oral hearing. However, any counsel of record may present the party's argument. If either party expects 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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