

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

SPRING VENTURES, LTD.,
Patent Owner.

Case IPR2017-01653
Patent 8,661,094 B2

Before MICHAEL R. ZECHER, MINN CHUNG, and SCOTT E. BAIN,
Administrative Patent Judges.

BAIN, *Administrative Patent Judge.*

ORDER

Oral Argument

35 U.S.C. § 316(a)(10) and 37 C.F.R. § 42.70

On January 16, 2018, we instituted an *inter partes* review only as to claims 1–13, 15, and 16 of U.S. Patent No. 8,661,094 B2 (“the ’094 patent) based on all the grounds of unpatentability (“grounds”) presented in the Petition. Paper 11. Subsequently, following the U.S. Supreme Court’s decision in *SAS Institute Inc. v. Iancu*, 138 S.Ct. 1348 (2018), we modified our institution decision to include all of the challenged claims (i.e., claims 1–16) based on all the grounds presented in the Petition. Paper 16. The parties request oral argument for this proceeding, pursuant to 37 C.F.R. § 42.70(a). Papers 44, 45. The parties’ requests are *granted*.

The parties both propose that each side have one hour to present its arguments. Papers 44, 45. We have reviewed the issues that the parties intend to address, and we agree that each party should be accorded one hour to present oral arguments.

Petitioner bears the ultimate burden of proof that claims 1–16 of the ’094 patent are unpatentable based on the grounds instituted in this proceeding. 35 U.S.C. § 316(e) (“[T]he petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.”). The burden of persuasion ordinary lies with Petitioner to demonstrate that proposed, substitute claims 17–20 are unpatentable based on the entirety of the record. *See Western Digital Corp. v. Spex Technologies, Inc.*, Case IPR2018-00082 (PTAB Apr. 25, 2018) (Paper 13) (informative). Consequently, Petitioner will proceed first to present its case as to the unpatentability of claims 1–16 of the ’094 patent and the grounds instituted, as well as the unpatentability of proposed, substitute claims 17–20. Petitioner may reserve rebuttal time. Absent special circumstances, Petitioner will not be permitted to reserve for rebuttal more than half the total time it has been

allotted for argument. Thereafter, Patent Owner will respond to Petitioner's case. Petitioner then will make use of its rebuttal time to respond to Patent Owner's case.

The hearing will commence at 1:00 PM Eastern Time on Thursday, October 18, 2018, and it will be open to the public for in-person attendance on the ninth floor of Madison Building East, 600 Dulany Street, Alexandria, Virginia (Hearing Room B). In-person attendance will be accommodated on a first-come, first-served basis. The Board will provide a court reporter for the hearing, and the reporter's transcript will constitute the official record of the hearing.

Pursuant to 37 C.F.R. § 42.70(b), demonstrative exhibits must be served no later than seven (7) business days before the hearing date, and filed with the Board no later than the time of the hearing. **Demonstrative exhibits are not evidence, but merely a visual aid for use at the hearing.** Demonstrative exhibits shall not introduce new arguments or evidence. The parties must initiate a conference call with us at least three (3) business days prior to the hearing date to resolve any dispute over the propriety of each party's demonstrative exhibits. Regardless of whether the propriety of any demonstrative exhibit is disputed by either party, we consider demonstrative exhibits only to the extent (1) that they elucidate the parties' arguments presented during the hearing; and (2) that they include only arguments and/or evidence already of record in these proceedings. For further guidance on what constitutes an appropriate demonstrative exhibit, the parties are directed to *CBS Interactive Inc. v. Helferich Patent Licensing, LLC*, Case IPR2013-00033 (PTAB Oct. 23, 2013) (Paper 118).

We remind the parties 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. The parties also should note that one member of the panel will be attending the

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hearing electronically from a remote location. If the parties have questions as to whether demonstrative exhibits would be sufficiently visible and available to each of the Administrative Patent Judges presiding over the hearing, the parties are invited to contact the Board at 571-272-9797.

The Board expects lead counsel for each party to be present at the hearing; however, any backup counsel may make the actual presentation, in whole or in part. *See Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,758 (Aug. 14, 2012). If lead counsel for either party is unable to attend the hearing, the parties shall request a joint telephone conference call no later than two (2) business days prior to the hearing date to discuss the matter.

Requests for special accommodations or audio-visual equipment are to be made at least five (5) business days in advance of the hearing date. Such requests must be sent to Trials@uspto.gov. If the requests are not received timely, requested accommodations and/or equipment may not be available on the day of the hearing.

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