

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EXOCAD GMBH AND EXOCAD AMERICA, INC.,
Petitioner,

v.

3SHAPE A/S,
Patent Owner.

Case IPR2018-00788
Patent 9,336,336 B2

Before SALLY C. MEDLEY, IRVIN E. BRANCH, and
FRANCES L. IPPOLITO, *Administrative Patent Judges*.

BRANCH, *Administrative Patent Judge*.

ORDER
Oral Hearing
37 C.F.R. § 42.70

Date and Time of Hearing

Inter Partes Review in IPR2018-00788 was instituted on October 3,
2018. Paper 11. A Scheduling Order set the oral hearing date to June 24,

2019, if hearing is requested by the parties and granted by the Board. *See* Papers 12, 14. Petitioner and Patent Owner have both requested an oral hearing pursuant to 37 C.F.R. § 42.70. *See* Papers 34, 35. Petitioner requests “one hour of argument per side.” Paper 34. Patent Owner also requests “one hour of argument per side.” Paper 35.

The Parties’ requests are GRANTED according to the terms set forth in this Order. The oral hearing will commence at 1 PM Eastern Time on Monday, June 24, 2019, in Hearing Room A on the ninth floor of Madison Building East, 600 Dulany Street, Alexandria, Virginia.

Allotted Argument Time

Each party will have sixty (60) minutes of total argument time to present its arguments in the above-captioned proceeding. Petitioner bears the ultimate burden of proof that the claims at issue in these reviews are unpatentable. Therefore, at oral hearing Petitioner will proceed first to present its case on Petitioner’s challenges to patentability and on any of Petitioner’s pending motions, such as Motions to Exclude. Petitioner may reserve some (but not more than half) of its allotted argument time for rebuttal to respond to Patent Owner’s arguments.

After Petitioner’s initial presentation, Patent Owner will argue its opposition to Petitioner’s case and present argument on any of Patent Owner’s pending motions. Thereafter, Petitioner may use any reserved time to respond to Patent Owner’s presentation. Patent Owner may reserve some (but no more than half) of its allotted argument time for use in sur-rebuttal if it so chooses, and may use its reserved time for sur-rebuttal to respond to

Petitioner's arguments.¹ The parties are reminded that arguments made during rebuttal and sur-rebuttal periods must be responsive to arguments the opposing party made in its immediately preceding presentation. The parties also are reminded that during the hearing, the parties "may only present arguments relied upon in the papers previously submitted." Trial Practice Guide August 2018 Update, p. 23.

Patent Owner filed a Motion to Exclude Evidence. Paper 36. Thus, the oral hearing may pertain to the subject of evidence exclusion. Patent Owner did not file a Motion to Amend Claims. Thus, the oral hearing will not pertain to claim amendments. Also, new arguments not previously presented in the parties' substantive papers in this proceeding shall not be raised at oral hearing.

Confidentiality

There is a strong public policy interest in making all information presented in these proceedings public, as the review determines the patentability of claims in an issued patent and thus, affects the rights of the public. This policy is reflected in part, for example, in 35 U.S.C. § 316(a)(1) and 35 U.S.C. § 326(a)(1) which provide that the file of any *inter partes* review or post grant review be made available to the public, except that any petition or document filed with the intent that it be sealed shall, if

¹ See Trial Practice Guide August 2018 Update, p. 20, available at www.uspto.gov/sites/default/files/documents/2018_Revised_Trial_Practice_Guide.pdf (providing that the "Board may also permit patent owners the opportunity to present a brief sur-rebuttal if requested").

accompanied by a motion to seal, be treated as sealed pending the outcome of the ruling on the motion.

At this time, the parties are advised that the Board exercises its discretion to make the oral hearing publically available via in-person attendance. In-person attendance will be accommodated on a first-come, first-served basis. Please be advised, available seating is limited. The Board will provide a court reporter, and the reporter's transcript shall constitute the official record of the trial hearing.

Demonstrative Exhibits

Under 37 C.F.R. § 42.70(b), demonstrative exhibits must be served on opposing counsel at least *seven (7) business days* before the hearing.

37 C.F.R. § 42.70(b). The parties also shall file a courtesy copy of the demonstratives as an exhibit to the Board at least *three (3) business days* prior to the hearing (or five business (5) days prior to a pre-hearing conference if one is scheduled) by emailing them to Trials@uspto.gov. In addition, the parties shall file any demonstrative exhibits in these proceedings within two (2) days of the hearing. Demonstrative exhibits are visual aids to oral argument and not evidence and are intended only to assist the parties in presenting their oral argument to the panel. The parties are directed to *St. Jude Medical, Cardiology Division, Inc. v. The Board of Regents of the University of Michigan*, IPR2013-00041 (PTAB Jan. 27, 2014) (Paper 65) for guidance regarding the appropriate content of demonstrative exhibits. Demonstrative exhibits may not be used to advance arguments or introduce evidence not previously presented in the record. *See Dell Inc. v. Accelaron, LLC*, 884 F.3d 1364, 1369 (Fed. Cir. 2018) (noting that the “Board was obligated to dismiss [the petitioner’s] untimely

argument . . . raised for the first time during oral argument”). Instead, demonstrative exhibits should cite to the briefs and evidence in the record.

The parties shall meet and confer to discuss any objections to demonstrative exhibits. If any issues regarding demonstratives remain unresolved after the parties meet and confer, the parties shall file jointly (by email to Trials@uspto.gov) a one-page list of objections to the demonstrative exhibits at least three (3) business days before the hearing if no pre-hearing conference is requested, or three (3) business days before a pre-hearing conference if one is scheduled. For each objection, the list must identify with particularity the demonstratives subject to the objection and include a short, one-sentence statement explaining the objection. The panel will consider the objections and may schedule a conference call if deemed necessary. Otherwise, the panel will reserve ruling on the objections. Any objection to demonstrative exhibits not presented timely will be considered waived.

During the oral hearing, the 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 to assist Judges Ippolito and Branch, who will join the hearing remotely. Judges Ippolito and Branch will be unable to view images projected in the hearing room. Similarly, to ensure presenters may be heard by Judges Ippolito and Branch, the parties are reminded to speak only when standing at the hearing room podium and toward the attached microphone. The parties should note that if a demonstrative is not filed or otherwise made fully available or visible to the judges presiding over the hearing remotely, that demonstrative will not be considered. If the parties

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