

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MALLINCKRODT PHARMACEUTICALS IRELAND LIMITED,
Petitioner,

v.

BIOVIE, INC.,
Patent Owner.

Case IPR2018-00974
Patent 9,655,945 B2

Before MICHELLE N. ANKENBRAND, *Acting Vice Chief Administrative Patent Judge*, ERICA A. FRANKLIN, and KRISTI L. R. SAWERT, *Administrative Patent Judges*.

SAWERT, *Administrative Patent Judge*.

ORDER
Oral Hearing
37 C.F.R. § 42.70

Petitioner and Patent Owner have each requested an oral hearing for the above-captioned proceeding pursuant to 37 C.F.R. § 42.70. Paper 24 (Petitioner); Paper 23 (Patent Owner). The requests are *granted*. Oral arguments will commence at 1:00 PM Eastern Time on Monday, August 12, 2019, on the ninth floor of Madison Building East, 600 Dulany Street, Alexandria, Virginia.

Each side will have sixty (60) minutes to present arguments. Petitioner bears the ultimate burden of proof that the claims at issue in this review are unpatentable. Petitioner will open the hearing by presenting its case regarding the challenged claims for which the Board instituted trial. Patent Owner will then respond to Petitioner's arguments. Thereafter, to the extent that Petitioner reserves time, Petitioner will then have an opportunity to rebut Patent Owner's presentation. Lastly, to the extent that Patent Owner reserves time, Patent Owner may use any time it has reserved for sur-rebuttal to respond to Petitioner's arguments made during reply.

The hearing will be open to the public for in-person attendance that will be accommodated on a first-come, first-served basis. The Board will provide a court reporter, and the transcript shall constitute the official record of the hearing.

Under 37 C.F.R. § 42.70(b), demonstrative exhibits must be served at least seven (7) business days before the hearing. The parties also shall provide the demonstrative exhibits to the Board at least *two* business days prior to the hearing by emailing them to Trials@uspto.gov. Despite the requirement in § 42.70(b) for parties to file demonstratives, the parties shall *not* file any demonstrative exhibits in this case without prior authorization

from the Board. A hard copy of the demonstratives should be provided to the court reporter at the hearing.

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), 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 hearing. The objections should identify with particularity which portions of the demonstrative exhibits are subject to objection, include a copy of the objected-to portions, and include a one-sentence statement of the reason 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 parties should be prepared for the possibility that at least one member of the panel may attend the hearing electronically from a remote location and may not be able to view the projection screen in the hearing room. Any demonstrative exhibit that cannot be made available or visible to the judge(s) presiding remotely should not be presented during the hearing. Counsel 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.

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 as long as that counsel is present in person. 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 (2) business days prior to the oral hearing to discuss the matter.

A party may request remote video attendance for one or more of its other attendees to view the hearing from any USPTO location. The available locations include the Texas Regional Office in Dallas, Texas; the Rocky Mountain Regional Office in Denver, Colorado; the Elijah J. McCoy Midwest Regional Office in Detroit, Michigan; and the Silicon Valley Office in San Jose, CA. To request remote video viewing, a party must send an email message to Trials@uspto.gov ten business days prior to the hearing, indicating the requested location and the number planning to view the hearing from the remote location. The Board will notify the parties if the request for video viewing is granted. Note that it may not be possible to grant the request due to the availability of resources.

Any special requests for audio-visual equipment should be directed to Trials@uspto.gov. A party may also indicate any special requests related to appearing at an in-person oral hearing, such as a request to accommodate physical needs that limit mobility or visual or hearing impairments, and indicate how the PTAB may accommodate the special request. Any special requests must be presented in a separate communication not less than five (5) days before the hearing.

It is:

ORDERED that the parties' requests for oral hearings are *granted* subject to the conditions set forth in this Order; and

FURTHER ORDERED that oral hearings, conducted pursuant to the procedures outlined above, shall commence at 1:00 PM Eastern Time on Monday, August 12, 2019.

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