

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

COREPHOTONICS LTD.,
Patent Owner.

Case IPR2018-01133, Patent 9,538,152 B2,
Case IPR2018-01140, Patent 9,402,032 B2
Case IPR2018-01146, Patent 9,568,712 B2¹

Before MARC S. HOFF, BRYAN MOORE, AND MONICA
ULLAGADDI, Administrative Patent Judges.

ULLAGADDI, *Administrative Patent Judge.*

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

¹ This Order applies to each of the listed cases. We exercise our discretion to issue one Order to be docketed in each case. The parties may not use this style caption for any subsequent papers without prior Board authorization.

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On December 4, 2018, we instituted *inter partes* review in IPR2018-01133 and IPR2018-01140 and contemporaneously issued Scheduling Orders setting the date for oral arguments in these proceedings to September 3, 2019. IPR2018-0133, Papers 8, 9; IPR2018-01140, Papers 9, 10. On December 7, 2018, we instituted *inter partes* review in IPR2018-01146 and issued a Scheduling Order setting the date for oral argument to September 3, 2019 as well. IPR2018-01146, Papers 8, 9.

On August 23, 2019, we reset the date for oral arguments to October 8, 2019 via email communication to the parties. Patent Owner and Petitioner filed requests for oral argument pursuant to 37 C.F.R. § 42.70(a). IPR2018-01133, Papers 26, 27; IPR2018-01140, Papers 25, 26; IPR2018-01146, Paper 25.

Petitioner requests that the hearings for IPR2018-01146 and IPR2018-01140 be consolidated. IPR2018-01146, Paper 25, 2. More particularly, Petitioner requests 45 minutes per side to present combined arguments for IPR2018-01146 and IPR2018-01140. *Id.* Petitioner further indicates that it

[A]lso expects to argue IPR2018-01133 (involving the same parties as the present proceeding); however, as there are no apparent common issues with the present proceeding, consolidation of the three proceedings is not indicated. Petitioner's Request for Oral Argument in IPR2018-01133 seeks 45 minutes of additional time, separate from this request, to argue that case.

Id.

Patent Owner requests 45 minutes per side for IPR2018-01140 and 45 minutes per side for IPR2018-01146. IPR2018-01140, Paper 26. Patent Owner expresses its belief that "consolidation is inadvisable, because the

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grounds for institution in IPR2018-01140 and IPR2018-01146 involve different prior art and substantially different arguments.” *Id.* Patent Owner also requests 45 minutes per side in IPR2018-01133. IPR2018-01133, Paper 27.

Petitioner’s and Patent Owner’s requests for oral hearing are granted and arguments will not be consolidated as to any of IPR2018-01133, IPR2018-01140, and IPR2018-01146. **Oral argument will commence at 9:30 AM Eastern Time, on October 8, 2019, and will be conducted at the USPTO Headquarters, Ninth Floor of Madison Building East, 600 Dulany Street, Alexandria, Virginia, 22314. Each side will receive 2 hours and 15 minutes of presentation time, including any rebuttal time, with 45 minutes allocated to presenting arguments in IPR2018-01140, 45 minutes allocated to presenting arguments in IPR2018-01146, and 45 minutes allocated to presenting arguments in IPR2018-01133.**

The hearing will be open to the public for in-person attendance, which 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.

Petitioner will open the hearing by presenting its case regarding the challenged claims. Patent Owner then will respond to Petitioner’s presentation. Petitioner may reserve rebuttal time (of no more than half their total presentation time) to reply to Patent Owner’s arguments. Patent Owner may reserve sur-rebuttal time (of no more than half its total presentation time) to respond to Petitioner’s rebuttal. *See Trial Practice Guide Update*, 20 (Aug. 2018), available at <https://go.usa.gov/xU7GP>.

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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. A hard copy of the demonstratives, if used, should be provided to the court reporter at the hearing. Also, Petitioner and Patent Owner are reminded that, at the oral argument, they "may rely upon evidence that has been previously submitted in the proceeding and may only present argument relied upon in the papers previously submitted." Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). "No new evidence or arguments may be presented at the oral argument." *Id.* Petitioner and Patent Owner are directed to refrain from disclosing any confidential information during the hearing or including any confidential information in a demonstrative exhibit.

A pre-hearing conference call will be held upon request. The request must be made no later than **September 24, 2019**. Prior to making such a request, Petitioner and Patent Owner shall meet and confer and, when possible, send a joint request to the Board with an agreed upon set of limited issues for discussion. A request for a pre-hearing conference may be made by email to Trials@uspto.gov, and shall include a list of issues to be discussed during the call and proposed times for the call, which should be no later than three (3) business days prior to the hearing. If either Petitioner or Patent Owner has any concerns about disclosing confidential information, they must contact the Board at least three (3) business days before the hearing to request a conference call to discuss the matter.

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Under 37 C.F.R. § 42.70(b), demonstrative exhibits must be served on the opposing party or parties seven (7) business days prior to the hearing. Demonstrative exhibits used at the hearing are aids to oral argument and not evidence, and should be clearly marked as such. For example, each slide of a demonstrative exhibit may be marked with the words “DEMONSTRATIVE EXHIBIT – NOT EVIDENCE” in the footer. *Trial Practice Guide Update*, 21.

The Board expects that Petitioner and Patent Owner will meet and confer in good faith to resolve any objections to demonstrative exhibits, but if such objections cannot be resolved, Petitioner and Patent Owner are directed to request a conference call with the Board no later than three (3) business days prior to the hearing to resolve any dispute over the propriety of demonstrative exhibits. Petitioner and Patent Owner are responsible for requesting such a conference sufficiently in advance of the hearing to accommodate this requirement. Any objection to demonstrative exhibits that is not presented timely will be considered waived. The Board asks Petitioner and Patent Owner to confine demonstrative exhibit objections to those identifying egregious violations that are prejudicial to the administration of justice. Petitioner and Patent Owner may refer to *CBS Interactive Inc. v. Helferich Patent Licensing, LLC*, IPR2013-00033 (PTAB October 23, 2013) (Paper 118), and *St. Jude Medical, Cardiology Div., Inc. v. The Board of Regents of the University of Michigan*, IPR2013-00041 (PTAB Jan. 27, 2014) (Paper 65) regarding the appropriate content of demonstrative exhibits. Petitioner and Patent Owner are directed to *file* their

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