

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASKELADDEN LLC,
Petitioner,

v.

LEIGH M. ROTHSCHILD,
Patent Owner.

IPR2019-00855 and IPR2019-00856
Patent 8,799,088 B2

Before MITCHELL G. WEATHERLY, JOHN P. PINKERTON, and
JAMES A. WORTH, *Administrative Patent Judges*.

WEATHERLY, *Administrative Patent Judge*.

ORDER
Oral Hearing
37 C.F.R. § 42.70

HEARING AND ATTENDANCE

Inter partes review in IPR2019-00855 and IPR2019-00856 was
instituted on November 21, 2019. Paper 8.¹ A Scheduling Order was issued

¹ Citations to paper numbers are the same for both IPR2019-00855 and
IPR2019-00856.

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the same day, which set the date for oral hearing in the proceeding as August 20, 2020, if a hearing were requested by the parties and granted by the Board. Paper 9. Petitioner has requested oral hearing pursuant to 37 C.F.R. § 42.70. Paper 16. Petitioner's request for oral hearing is *granted*.

The hearing will commence at 1:00 p.m. Eastern Time, on August 20, 2020. The hearing will be conducted via video conference. To facilitate planning, each party must contact PTAB Hearings at PTABHearings@uspto.gov five business days prior to the oral hearing date to receive video set-up information. As a reminder, all arrangements and the expenses involved with appearing by video, such as the selection of the facility to be used from which a party will attend by video, must be borne by that party. If a video connection cannot be established, the parties will be provided with dial-in connection information, and the oral hearing will be conducted telephonically.

If one or both parties would prefer to participate in the oral hearing telephonically, they should notify PTAB Hearings at the above email address five business days prior to the hearing to receive dial-in connection information.

Each party will have forty-five (45) minutes to present arguments. Each party may allocate their time for primary and rebuttal arguments with a maximum of ten (10) minutes reserved for rebuttal. Petitioner will present its primary argument first regarding the patentability of all claims at issue in each proceeding. Patent Owner will respond with its primary argument in response to Petitioner's primary argument. Petitioner will present its rebuttal argument, limited to responding to Patent Owner's responsive

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primary argument. Patent Owner will present its rebuttal, limited to responding to Petitioner's rebuttal argument.

The parties are directed to contact the Board at least 10 days in advance of the hearing if there are any concerns about disclosing confidential information. The Board will provide a court reporter for the hearing, and the reporter's transcript will constitute the official record of the hearing. The Board generally expects lead counsel for each party to be present by video at the oral hearing. Any counsel of record may present the party's argument as long as that counsel is present by video.

Any special requests for audio-visual equipment should be directed to PTABHearings@uspto.gov. A party may also indicate any special requests related to appearing at a video oral hearing, such as a request to accommodate 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.

The panel will have access to all papers filed with the Board, including demonstratives. During the oral hearing, the parties are advised to identify clearly and specifically each demonstrative referenced (e.g., by slide or screen number) to ensure the clarity and accuracy of the court reporter's transcript. In addition, the parties are advised to identify themselves each time they speak. Furthermore, the remote nature of the oral hearing may also result in an audio lag, and so the parties are advised to observe a pause prior to speaking, so as to avoid speaking over others.

DEMONSTRATIVE EXHIBITS

Under 37 C.F.R. § 42.70(b), demonstrative exhibits shall be served on the opposing party at least five (5) business days before the oral hearing, and filed as an exhibit no later than the time of the oral hearing. The parties also shall provide a courtesy copy of any demonstrative exhibits to the Board at least three (3) business days prior to the oral hearing by emailing the exhibits to PTABHearings@uspto.gov. Demonstrative exhibits in this proceeding are not evidence and are intended only to assist the parties in presenting their oral argument to the panel, and should be clearly marked as such. For example, each slide may be marked with the words “DEMONSTRATIVE EXHIBIT – NOT EVIDENCE” in the footer. *See Dell Inc. v. Acceleron, 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”). The parties are directed to *St. Jude Medical, Cardiology Division, Inc. v. The Board of Regents of the University of Michigan*, IPR2013-00041 (PTAB January 27, 2015) (Paper 65), for guidance regarding the appropriate content of demonstrative exhibits, which must include citations to the record.

If either party objects to demonstrative exhibits, the parties shall meet and confer in good faith to resolve any such objections. A party may file a paper addressing any unresolved objections to demonstrative exhibits with the Board no later than three (3) business days before the oral hearing. The paper shall include a single sentence per objection stating the basis for that objection and be accompanied by a copy of the allegedly objectionable demonstrative exhibit that identifies the objectionable portion of the exhibit with particularity. No further argument or explanation is permitted. We will

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consider the objections and, if we deem it necessary, we will further address the objections in a conference call or at the oral hearing. Otherwise, we will reserve ruling on the objections until after the oral hearing.

The parties are also reminded that the presenter must clearly and specifically identify 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 Board requests such identification for all exhibits discussed during oral argument in the interest of providing a clear record.

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