

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
Canceling Oral Hearing
37 C.F.R. §§ 42.5, 42.70

On August 10, 2020, we entered an Order setting the oral hearing in these proceedings for August 20, 2020. Paper 17.¹ Based on communications received via e-mail from both parties on August 13, 2020,

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

we became aware that Petitioner wished to withdraw its request for oral argument and have the issues presented in the proceedings decided on the written record. The e-mails also revealed that Patent Owner, Mr. Rothschild (appearing *pro se*), still wished to have an oral hearing despite not having requested one previously. Accordingly, the panel set a teleconference with the parties and instructed the parties to be prepared to discuss (1) what they believe to be the proper scope of argument they are permitted to present at an oral hearing and (2) whether and by when either party should be permitted to file additional substantive papers in the proceeding as a substitute for a hearing.

The teleconference was conducted on August 17, 2020. During the call, Petitioner reiterated its desire to have the proceeding decided on the written record, and Patent Owner reiterated his desire to be heard at oral argument. Patent Owner did not file a request for oral hearing or file any papers in the proceeding after filing its Motion to Amend on the jointly modified DUE DATE 1 of February 21, 2020. The Motion to Amend was filed eight days after its original due date pursuant to a stipulated extension of DUE DATE 1. Paper 10. Accordingly, by filing a joint stipulation to extend the first two deadlines in the Scheduling Order, both parties demonstrated that they were fully aware of the deadlines set forth in the Scheduling Order.

Mr. Rothschild, nevertheless indicated that he now sought authorization to file a Reply in support of his Motion to Amend, which was originally due June 18, 2020. Paper 9. Petitioner would be entitled to file a Sur-reply responding to such a Reply approximately three weeks later on July 9, 2020. When asked about his failure to file any papers after DUE

DATE 1 or seeking any further extensions of time for filing such papers, Mr. Rothschild provided no explanation other than being inexperienced and busy with multiple matters. After deliberation, the panel decided that it would not authorize additional written submissions because (1) Mr. Rothschild's request was two months after the original deadline for filing a Reply and he had not provided sufficient cause to extend the deadline and (2) of the difficulty in setting a briefing and discovery schedule that would fairly permit both parties to file briefs and complete discovery within the time remaining before a final written decision is due by statute.

Oral argument is limited to issues "raised in a paper." 37 C.F.R. § 42.70(a). Accordingly, the panel explained that the scope of oral argument would be defined and limited by the parties' existing written submissions. Based on the substantive limitations set for oral hearing under our Rules, Mr. Rothschild indicated that he saw no utility in presenting oral argument and withdrew his prior opposition to Petitioner's request for permission to withdraw its request for oral hearing. The panel authorized Petitioner to file a notice withdrawing its request for oral hearing, which it indicated would be filed by August 18. Petitioner has filed this notice. Paper 18. The panel informed both parties that the hearing would be canceled and that the issues in these proceedings would be decided on the written record.

For the foregoing reasons, it is

ORDERED that the hearing previously set for August 20, 2020, in IPR2019-00855 and IPR2019-00856 is *canceled*; and

FURTHER ORDERED that the issues presented by the parties in these proceedings will be decided upon the panel's consideration of the written record.

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

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