

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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DROPBOX, INC.,  
Petitioners,

v.

WHITSERVE LLC,  
Patent Owner.

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Case IPR2019-01019  
Patent 8,812,437 B2

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Before KALYAN K. DESHPANDE, MICHELLE N. WORMMEESTER,  
and SCOTT RAEVSKY, *Administrative Patent Judges*.

RAEVSKY, *Administrative Patent Judge*.

ORDER  
*Oral Argument*  
37 C.F.R. § 42.70

Petitioner and Patent Owner both request oral argument. Paper 21; Paper 22. Patent Owner requested thirty minutes per side for oral argument (Paper 21), and Petitioner requested sixty minutes per side (Paper 22). The Parties' requests are *granted* as detailed below.

### **Oral Argument**

Oral arguments will commence at **1:00 PM Eastern Time on July 30, 2020**, by video. 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.

If at any time during the proceeding, you encounter technical or other difficulties that fundamentally undermine your ability to adequately represent your client, please let the panel know immediately, and adjustments will be made.<sup>1</sup>

To facilitate planning, each party must contact PTAB Hearings at (571) 272-9797 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

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<sup>1</sup> For example, if a party is experiencing poor video quality, the Board may provide alternate dial-in information.

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 telephone number five business days prior to the hearing to receive dial-in connection information.

Each party will have **sixty minutes** of total argument time. At oral hearing, Petitioner will open the hearing by presenting its arguments. Thereafter, Patent Owner may argue its opposition to Petitioner's arguments. Petitioner may reserve time for rebuttal and Patent Owner may reserve time for sur-rebuttal. Petitioner bears the ultimate burden of proof that the claims at issue in these reviews are unpatentable.

### **Demonstrative Exhibits**

Under 37 C.F.R. § 42.70(b), demonstrative exhibits must be served at least seven business days before the hearing. The Board further requests that such exhibits be filed at least three business days before the hearing to facilitate the panel's preparation. The demonstratives should be emailed to [PTABHearings@uspto.gov](mailto:PTABHearings@uspto.gov), and the Board will provide the demonstratives to the court reporter prior to the hearing.

The Board reminds the parties that demonstrative exhibits are intended to assist the parties in presenting their oral arguments and are 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. The Board also reminds the parties that demonstrative exhibits are not a

mechanism for making arguments or introducing evidence not previously presented in the record. The parties are directed to *St. Jude Medical, Cardiology Division, Inc. v. The Board of Regents of the University of Michigan*, IPR2013-00041, Paper 65 (PTAB Jan. 27, 2014), for guidance 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. If, however, the parties are unable to resolve their disagreement, either party may file objections to the demonstratives with the Board at least three business days before the hearing. Any objection to demonstrative exhibits that is not timely presented will be considered waived. The objections should identify with particularity which demonstratives are subject to objection, and include a short (one sentence or less) statement of the reason for each objection. No argument or further explanation is permitted. The Board will consider the objections and schedule a conference if deemed necessary. Otherwise, the Board will reserve ruling on the objections until after the oral argument.

### **Pre-Hearing Conference**

Either party may request a pre-hearing conference be held no later than three business days before the hearing. Consolidated Trial Practice Guide, 82, available at [www.uspto.gov/sites/default/files/documents/tpgnov.pdf](http://www.uspto.gov/sites/default/files/documents/tpgnov.pdf)? MURL=. The prehearing conference is not required, and absent a request, no call will be held.

Prior to making a request, the parties should meet and confer and send a joint request to the Board with an agreed-upon set of limited issues for

discussion in the pre-hearing conference. Issues appropriate for discussion in a pre-hearing conference may include objections to demonstratives, pending motions, allocation of argument time, and any other issue that may affect the ability of a party to present its arguments at the hearing.

To request a pre-hearing conference, a joint email request should be sent to [Trials@uspto.gov](mailto:Trials@uspto.gov), including several dates and times of availability for both parties. If the parties are unable to agree on the issues to be addressed at the pre-hearing conference, the joint request shall specify which issues are disputed and provide a brief statement (not to exceed one sentence) of the opposing party's objection.

The panel may, at its discretion, indicate certain issues during the pre-hearing conference that it wishes parties to emphasize at the oral hearing. Although the parties and the panel may discuss issues for the oral hearing at the pre-hearing conference, the issues discussed at the pre-hearing conference do not limit the scope of the oral hearing. Instead, the parties remain free to address at the oral hearing any issue properly raised during the trial, and the panel may ask questions on issues other than those identified at the pre-hearing conference.

### **Counsel Attendance at Oral 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.

A party may indicate any special requests related to appearing at a video oral hearing, such as a request to accommodate visual or hearing

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