

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORD MOTOR CO.,
Petitioner,

v.

MASSACHUSETTS INSTITUTE OF TECHNOLOGY,
Patent Owner.

IPR2019-01399 (Patent 9,810,166 B2)
IPR2019-01401 (Patent 9,255,519 B2)
IPR2019-01402 (Patent 10,138,826 B2)

Before KEN B. BARRETT, LYNNE H. BROWNE, and
JAMES J. MAYBERRY, *Administrative Patent Judges*.

PER CURIAM

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

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I. ORAL ARGUMENT

The Scheduling Order for IPR2019-01399, IPR2019-01401, and IPR2019-01402 provided that an oral argument would be conducted on November 19, 2020, if requested by the parties and granted by the Board. Paper 11.¹ Petitioner and Patent Owner requested a single, consolidated oral argument for these three proceedings. Paper 25; Paper 26. The requests for oral argument are *granted* subject to the conditions set forth in this Order.

A. Time and Format

Oral arguments will commence at **9:00 AM Eastern Time on November 19, 2020**, by video. The Board will provide a court reporter for the hearing, and the reporter's transcript will constitute the official record of the hearing.

As requested by the parties, Petitioner will have a total of 90 minutes to present argument in these proceedings, and Patent Owner will have a total of 90 minutes to respond. Paper 25; Paper 26. Petitioner will open the hearing by presenting its case regarding the challenged claims for which the Board instituted trial in these proceedings. Thereafter, Patent Owner will respond to Petitioner's arguments. Petitioner may reserve rebuttal time to respond to arguments presented by Patent Owner. In accordance with the Consolidated Trial Practice Guide² ("CTPG"), issued in November 2019, Patent Owner may reserve time for sur-rebuttal.

¹ We cite to papers in IPR2019-01399 in this Order only. Similar papers are provided in IPR2019-01401 and IPR2019-01402.

² Available at <https://www.uspto.gov/about-us/news-updates/consolidated-trial-practice-guide-november-2019>.

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The parties may request a pre-hearing conference in advance of the hearing. *See* CTPG 82. “The purpose of the pre-hearing conference is to afford the parties the opportunity to preview (but not argue) the issues to be discussed at the oral hearing, and to seek the Board’s guidance as to particular issues that the panel would like addressed by the parties.” *Id.* If either party desires a pre-hearing conference, the parties should jointly contact the Board at Trials@uspto.gov at least seven (7) business days before the hearing date to request a conference call for that purpose. The request may be made by e-mail and shall include a list of issues to be discussed.

B. Demonstratives

Demonstrative exhibits shall be served on opposing counsel at least seven (7) business days before the hearing date. Notwithstanding 37 C.F.R. § 42.70(b), the parties are requested to file its demonstrative exhibits with the Board no later than three (3) business days of the hearing.³

Demonstrative exhibits are not a mechanism for making new arguments. Demonstrative exhibits also are not evidence, and will not be relied upon as evidence. Rather, demonstrative exhibits are visual aids to a party’s oral presentation regarding arguments and evidence previously presented and discussed in the papers. Accordingly, demonstrative exhibits shall be clearly marked with the words “DEMONSTRATIVE EXHIBIT – NOT EVIDENCE” in the footer. *See Dell Inc. v. Acceleron, LLC*, 884 F.3d

³ The parties may stipulate to an alternative schedule for serving and filing demonstrative exhibits, and request that the Board modify the schedule for filing and serving demonstrative exhibits at least seven (7) business days before the hearing date.

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1364, 1369 (Fed. Cir. 2018) (holding that the Board is obligated under its own regulations to dismiss untimely argument “raised for the first time during oral argument”); 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.”); *see also St. Jude Med., Cardiology Div., Inc. v. The Bd. of Regents of the Univ. of Mich.*, IPR2013-00041, Paper 65, 2–3 (PTAB Jan. 27, 2014) (explaining that “new” evidence includes evidence already of record but not previously discussed in any paper of record).

Furthermore, because of the strict prohibition against the presentation of new evidence or arguments at a hearing, it is strongly recommended that each demonstrative include a citation to the record, which allows the Board to easily ascertain whether a given demonstrative contains “new” argument or evidence or, instead, contains only that which is developed in the existing record.

Due to the nature of the Board’s consideration of demonstrative exhibits and the opportunity afforded for the parties to reach an agreement without involving the Board, the Board does not anticipate receiving objections to such exhibits. Nevertheless, to the extent that a party objects to the propriety of any demonstrative exhibit, the parties shall meet and confer in good faith to resolve any objections to demonstrative exhibits prior to filing them with the Board. If such objections cannot be resolved, the parties may file any objections to demonstratives with the Board no later than the time of the hearing. The objections shall identify with particularity which portions of the demonstrative exhibits are subject to objection (and should

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include a copy of the objected-to portions) and include a one (1) sentence statement of the reason for each objection. No argument or further explanation is permitted. The Board will consider any objections, and reserve ruling on the objections.⁴ Any objection to demonstrative exhibits that is not timely presented will be considered waived.

C. Presenting Counsel

The Board generally expects lead counsel for each party to be present by video at the hearing. Any counsel of record may present the party's argument as long as that counsel is present by video.

D. Video Hearing Details

If at any time during the hearing, counsel encounters technical or other difficulties that fundamentally undermine counsel's ability to adequately represent its client, please let the panel know immediately, and adjustments will be made.⁵

To facilitate planning, each party must contact the Board at PTABHearings@uspto.gov at least five (5) business days prior to the 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 hearing will be conducted telephonically.

⁴ If time permits, the Board may schedule a conference call with the parties to discuss any filed objections.

⁵ For example, if a party is experiencing poor video quality, the Board may provide alternate dial-in information.

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