

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENOME & COMPANY,
Petitioner,

v.

THE UNIVERSITY OF CHICAGO,
Patent Owner.

Case PGR2019-00002
Patent 9,855,302 B2

Before SHERIDAN K. SNEDDEN, SUSAN L.C. MITCHELL, and
JOHN E. SCHNEIDER, *Administrative Patent Judges*.

SCHNEIDER, *Administrative Patent Judge*.

ORDER
Oral Hearing
37 C.F.R. § 42.70

Petitioner and Patent Owner both request an oral hearing pursuant to 37 C.F.R. § 42.70. Papers 27 and 28. The requests are *granted* to the extent set forth below and subject to the following conditions.

Oral arguments will commence at 1:00 PM Eastern time on January 15, 2020, at the USPTO Headquarters on the ninth floor of Madison Building East, 600 Dulany Street, Alexandria, Virginia. The hearing will be open to the public for in-person attendance that will be accommodated on a first-come, first-served basis. 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. To facilitate planning, each party must send an email message to PTABHearings@uspto.gov five days prior to the hearing if the number planning to attend the hearing in-person for its side (attorneys and others) exceeds five people.

Petitioner and Patent Owner both request sixty minutes for argument. Papers 27 and 28. Accordingly, the Board determines that each party shall be allotted sixty (60) minutes of total time to present argument. Petitioner bears the ultimate burden of proof that the patent claims at issue are unpatentable. Therefore, Petitioner will open the hearing by presenting its case regarding the challenged claims for which we instituted trial. Petitioner may reserve some of its argument time for rebuttal. Absent special circumstances, a petitioner will not be permitted to reserve for rebuttal more than half the total time allotted for argument. Thereafter, Patent Owner will respond to Petitioner's presentation and present its argument regarding its

motion to amend. Patent Owner also may reserve some of its argument time for a brief sur-rebuttal.

The Board’s August 2018 Trial Practice Guide Update (“TPGU”) provides an opportunity for the parties to request a pre-hearing conference. *See* TPGU 19 (“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.”). If either party desires a pre-hearing conference, the parties should jointly contact the Board by January 8, 2020 to request a conference call for that purpose.

Demonstrative exhibits used at the final 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. Demonstrative exhibits must not include new evidence and each must include citations to the record sufficient to establish that the exhibit contains no new argument or evidence not already of record in the proceeding(s) in which it is offered. The parties are directed to serve demonstrative exhibits on opposing counsel at least seven (7) days before the hearing date. Please also provide a courtesy copy of any demonstrative exhibits to the Board at least seven (7) days prior to the hearing by emailing them to PTABHearings@uspto.gov. Notwithstanding 37 C.F.R. § 42.70(b), the parties shall not file any demonstrative exhibits in the record of this proceeding without prior authorization from the Board.

The Board expects that the parties will meet and confer in good faith to resolve any objections to demonstrative exhibits, but if such objections

cannot be resolved, the parties may file any objections to demonstrative exhibits with the Board at least four (4) 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 call if deemed necessary. Otherwise, the Board will reserve ruling on the objections until the 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, 2014) (Paper 65), for guidance regarding the appropriate content of demonstrative exhibits.

One member of the panel will attend the hearing electronically from a remote location and will not be able to view the projection screen in the hearing room. If a demonstrative exhibit is not made available prior to the hearing so that a judge appearing remotely has access to the demonstrative, that demonstrative may not be presented at the hearing. Counsel must identify clearly and specifically each demonstrative exhibit (e.g., by slide or page 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.

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

A party may also request remote video attendance for one or more of its other attendees to view the hearing from any USPTO location. To request remote video viewing, a party must send an email message to PTABHearings@uspto.gov ten business days prior to the hearing, indicating the requested location and the number planning to view the hearing from the remote location. The Board will notify the parties if the request for video viewing is granted. Note that it may not be possible to grant the request due to the availability of resources.

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 an in-person oral hearing, such as a request to accommodate physical needs that limit mobility or 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

It is ORDERED that the parties' requests for oral hearing (Papers 27 and 28) are granted subject to the conditions set forth in this Order; and

FURTHER ORDERED that oral hearing, conducted pursuant to the procedures outlined above, shall commence at 1:00 PM Eastern Time on January 15, 2020.

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