

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GRÜNENTHAL GMBH,
Petitioner,

v.

ANTECIP BIOVENTURES II LLC,
Patent Owner.

Case PGR2019-00003
Patent 9,867,839 B2

Before TONI R. SCHEINER, GRACE KARAFFA OBERMANN, and
SHERIDAN K. SNEDDEN, Administrative Patent Judges.

SNEDDEN, Administrative Patent Judge.

ORDER
Granting Requests for Oral Argument
37 C.F.R. § 42.70

I. ORAL ARGUMENT GUIDE

The Scheduling Order for this case sets the date for oral hearing as February 4, 2020, if a hearing is requested and granted by the Board. Paper 8. Both parties requested oral hearing pursuant to 37 C.F.R. § 42.70. Papers 17 and 18. The requests for oral hearing are *granted*.

A. Time and Format

Oral arguments will commence at **10 A.M. Eastern Time on February 4, 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 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 prior to the hearing if the number planning to attend the hearing in-person for its side (attorneys and others) exceeds five (5) people.

Petitioner will have a combined sixty (60) minutes to present argument in this case and Patent Owner will have sixty (60) minutes to respond. Petitioner bears the ultimate burden of proof that Patent Owner's claims at issue are unpatentable. Therefore, Petitioner will open the hearing by presenting its case regarding the challenged claims for which the Board instituted trial. After Petitioner's presentation, Patent Owner will respond to Petitioner's argument. Petitioner may reserve rebuttal time to respond to arguments presented by Patent Owner. In accordance with the Board's

August 2018 Trial Practice Guide Update (“TPGU”), Patent Owner may reserve time for sur-rebuttal.

The Trial Practice Guide Update provides an opportunity for the parties to request a pre-hearing conference in advance of the hearing. *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 before the hearing to request a conference call for that purpose.

B. Demonstratives

As set forth in 37 C.F.R. § 42.70(b), demonstrative exhibits shall be served on opposing counsel at least seven (7) business days before the hearing. Additionally, in place of filing date provided in § 42.70(b), the parties *shall* file demonstrative exhibits no later than one (1) business day before the hearing to allow the panel sufficient time to review the materials.

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 should be clearly marked with the words “DEMONSTRATIVE EXHIBIT – NOT EVIDENCE” in the footer. *See Dell Inc. v. Accelaron, LLC*, 884 F.3d 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.

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48,756, 48,768 (Aug. 14, 2012) (“No new evidence or arguments may be presented at the oral argument.”); *see also*, *St. Jude Medical, Cardiology Division, Inc. v. The Board of Regents of the University of Michigan*, IPR2013-00041, Paper 65, 2–3 (PTAB January 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 oral hearing, it is 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 panel’s consideration of demonstrative exhibits, the panel does not anticipate that objections to such exhibits are likely to be sustained. Nevertheless, to the extent that a party objects to the propriety of any demonstrative exhibit, we expect that the parties will meet and confer in good faith to resolve any objections to demonstrative exhibits. If such objections cannot be resolved, the parties may file any objections to demonstratives with the Board at least one (1) business day before the hearing. The objections should identify with particularity which portions of the demonstrative exhibits are subject to objection (and should include a copy of the objected-to portions) and include a one-sentence statement of the reason for each objection. No argument or further explanation is permitted. We will consider any objections and schedule a conference call if deemed necessary. Otherwise, we will reserve ruling on the objections. Any objection to demonstrative exhibits that is not timely presented will be considered waived.

Finally, the parties are reminded that each presenter must identify clearly and specifically each demonstrative exhibit (e.g., by slide or screen number) referenced during the hearing to ensure the clarity and accuracy of the court reporter's transcript and for the benefit of any judge(s) who may be participating electronically.

C. Presenting Counsel

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

D. Audio/Visual Equipment Requests

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 two (2) days before the hearing.

II. ORDER

Accordingly, it is

ORDERED that oral argument for this proceeding shall commence at **10 A.M. Eastern Time on February 4, 2020**, on the ninth floor of Madison Building East, 600 Dulany Street, Alexandria, Virginia, and proceed in the manner set forth herein.

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