

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNITED SERVICES AUTOMOBILE ASSOCIATION,
Petitioner,

v.

NADER ASGHARI-KAMRANI and KAMRAN ASGHARI-KAMRANI,
Patent Owner.

Cases CBM2016-00063 and CBM2016-00064
Patent 8,266,432 B2¹

Before JONI Y. CHANG, JUSTIN T. ARBES, and
FRANCES L. IPPOLITO, *Administrative Patent Judges*.

CHANG, *Administrative Patent Judge*.

ORDER
Oral Hearing
37 C.F.R. § 42.70

¹ This Order addresses the same issues in the above-identified covered business method patent review (“CBM”) proceedings. Therefore, we exercise our discretion to issue one Order to be entered in both cases.

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We instituted covered business method patent reviews (Paper 14²) in the above-referenced proceedings and issued a consolidated Scheduling Order (Paper 15), which sets the date for oral hearing to May 15, 2017, if oral hearing is requested by either party and granted by the Board. Pursuant to 37 C.F.R. § 42.70, Petitioner requests an oral hearing. Paper 34. The request is *granted*.

The hearing will commence at **1:30 PM Eastern Time, on May 15, 2017**, and will be conducted at the **USPTO Headquarters, Ninth Floor of Madison Building East, 600 Dulany Street, Alexandria, Virginia, 22314**.³ The hearing will be open to the public for in-person attendance that will be accommodated on a first-come, first-serve basis.

Each party will have sixty (60) minutes of total time to present arguments for both proceedings. Because Petitioner bears the ultimate burden of proof that the challenged claims are unpatentable, Petitioner will proceed first to present its case as to the challenged claims and instituted grounds of unpatentability in both proceedings, and may reserve a small portion of its time for rebuttal. Thereafter, Patent Owner will respond to Petitioner's case. After that, Petitioner will use the rest of its time for its rebuttal, responding to Patent Owner's specific arguments presented at the

² Citations refer to CBM2016-00063, as representative, unless otherwise noted.

³ See <https://www.uspto.gov/about-us/uspto-locations/alexandria-virginia-headquarters> for additional information.

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oral hearing. No live testimony from any witness will be taken at the oral argument.

Under 37 C.F.R. § 42.70(b), demonstrative exhibits must be served at least seven business days prior to the hearing. The parties shall confer with each other regarding any objections to demonstrative exhibits, and file demonstrative exhibits with the Board, as a separate exhibit in accordance with 37 C.F.R. § 42.63, at least five business days prior to the hearing.

Demonstrative exhibits are not evidence, but merely a visual aid at the oral hearing. For any issue that cannot be resolved after conferring with the opposing party, the parties may file jointly a one-page list of objections at least five business days prior to the hearing. The list should identify with particularity which demonstrative exhibits are subject to objection and include a short statement (no more than one sentence) of the reason for each objection. No argument or further explanation is permitted.

We will consider the objections and schedule a conference call if necessary. Otherwise, we will reserve ruling on the objections until the hearing or after the hearing. Any objection to demonstrative exhibits that is not presented timely will be considered waived. Each party also shall provide a hard copy of its demonstrative exhibits to the court reporter at the hearing.

The parties are directed to *St. Jude Medical, Cardiology Division, Inc. v. The Board of Regents of the University of Michigan*, Case IPR2013-00041 (PTAB Jan. 27, 2014) (Paper 65), for guidance regarding the appropriate content of demonstrative exhibits. *See also CBS Interactive Inc. v. Helferich*

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Patent Licensing, LLC, Case IPR2013-00033 (PTAB Oct. 23, 2013) (Paper 118) (The Board has the discretion to limit the parties' demonstratives to pages in the record should there be no easy resolution to objections over demonstratives.).

The parties are reminded that the 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 reporter's transcript. The parties also should note that one panel member, Judge Ippolito, will be attending the hearing electronically and will only have access to the courtesy copy of the demonstratives provided in advance, as referenced above. If a demonstrative is not made available to the Board in the manner indicated above, that demonstrative may not be available to each of the judges during the hearing and may not be considered. Further, images projected, using audio visual equipment in Alexandria, will not be visible to Judge Ippolito. Because of limitations on the audio transmission systems in our hearing rooms, the presenter may speak only when standing at the hearing room podium. If the parties have questions as to whether demonstrative exhibits would be sufficiently visible and available to all of the judges, the parties are invited to contact the Board at (571) 272-9797.

The Board expects lead counsel for each party to be present at oral hearing, although any backup counsel may make the actual presentation, in whole or in part. If lead counsel for either party is unable to attend the oral argument, the Board should be notified via a joint telephone conference call

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no later than five business days prior to the oral hearing to discuss the matter.

The Board will provide a court reporter for the hearing, and the reporter's transcript will constitute the official record of the hearing. The hearing transcript will be entered in the record of these proceedings.

Requests for audio-visual equipment at the hearing are to be made five days in advance of the hearing date. The requests must be sent to *Trials@uspto.gov*. If the requests are not received timely, equipment may not be available on the day of the hearing.

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