

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CANON INC., CANON U.S.A., INC.,
CANON FINANCIAL SERVICES, INC., FUJIFILM CORPORATION,
FUJIFILM HOLDINGS AMERICA CORPORATION,
FUJIFILM NORTH AMERICA CORPORATION, JVC KENWOOD
CORPORATION, JVCKENWOOD USA CORPORATION,
NIKON CORPORATION, NIKON INC., OLYMPUS CORPORATION,
OLYMPUS AMERICA INC., PANASONIC CORPORATION,
PANASONIC CORPORATION OF NORTH AMERICA,
SAMSUNG ELECTRONICS CO., LTD., and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

PAPST LICENSING GMBH & CO. KG,
Patent Owner.

Cases IPR2016-01199, IPR2016-01212, IPR2016-01214, IPR2016-01216,
and IPR2016-01225 (Patent 8,966,144),
IPR2016-01200, IPR2016-01211, and IPR2016-01213 (Patent 8,504,746)¹

Before JONI Y. CHANG, JENNIFER S. BISK, and
MIRIAM L. QUINN, *Administrative Patent Judges*.

CHANG, *Administrative Patent Judge*.

ORDER
Oral Hearing
37 C.F.R. § 42.70

¹ This Order addresses the same issues for the above-identified cases. We, therefore, exercise our discretion to issue one order to be filed in each case.

IPR2016-01199, IPR2016-01212, IPR2016-01214, IPR2016-01216, and IPR2016-01225 (Patent 8,966,144), IPR2016-01200, IPR2016-01211, and IPR2016-01213 (Patent 8,504,746)

In each of the above-identified proceedings, we instituted *inter partes* review (Paper 8²) and issued a Scheduling Order (Paper 9), which sets an oral hearing date, if oral hearing is requested by either party and granted by the Board. In particular, the oral hearing date for cases involving U.S. Patent No. 8,966,144 is September 13, 2017, and the oral hearing date for cases involving U.S. Patent No. 8,504,746 is September 14, 2017. Pursuant to 37 C.F.R. § 42.70, the parties jointly requested an oral hearing in each case. Paper 15. The requests are *granted*.

In addition to requesting an oral hearing, the parties jointly propose to group the cases by the same primary prior art references, for efficiency. *Id.* at 3. Specifically, as to the oral hearing on September 13, 2017, the parties propose: (1) argument on IPR2016-01211, IPR2016-01212, and IPR2016-01216, involving Kawaguchi (Ex. 1206, filed in IPR2016-01211), for one hour per party; and (2) argument on IPR2016-01225 involving McNeill (Ex. 1301, filed in IPR2016-01225), for 30 minutes per party. *Id.* With respect to the oral hearing on September 14, 2017, the parties propose: (1) argument on IPR2016-01199 and IPR2016-01200, involving Aytac (Ex. 1004, filed in IPR2016-01199), for 45 minutes per party; and (2) argument on IPR2016-01213 and IPR2016-01214, involving Yamamoto (Ex. 1401, filed in IPR2016-01214), for 45 minutes per party. *Id.*

In view of the circumstances before us, we agree with the parties, and accept their proposal.

² Citations refer to IPR2016-01199, as representative, unless otherwise noted.

IPR2016-01199, IPR2016-01212, IPR2016-01214, IPR2016-01216, and IPR2016-01225 (Patent 8,966,144), IPR2016-01200, IPR2016-01211, and IPR2016-01213 (Patent 8,504,746)

The consolidated hearing for IPR IPR2016-01211, IPR2016-01212, IPR2016-01216, and IPR2016-01225 will commence at 10:00 AM Eastern Time, on September 13, 2017. Each party will have ninety (90) minutes of total time to present arguments for these proceedings.

The consolidated hearing for IPR2016-01199, IPR2016-01200, IPR2016-01213, and IPR2016-01214 will commence at 10:00 AM Eastern Time, on September 14, 2017. Each party will have ninety (90) minutes of total time to present arguments for these proceedings.

Both hearings will be conducted at the **USPTO Headquarters, Ninth Floor of Madison Building East, 600 Dulany Street, Alexandria, Virginia, 22314.**³ The hearings will be open to the public for in-person attendance that will be accommodated on a first-come first-serve basis.

For each oral hearing, 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 the proceedings, and may reserve a small portion of its time for rebuttal. Thereafter, Patent Owner will respond to Petitioner's case. After that, Petitioner may use the rest of its time for its rebuttal, responding to Patent Owner's specific arguments presented at the 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

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

IPR2016-01199, IPR2016-01212, IPR2016-01214, IPR2016-01216, and IPR2016-01225 (Patent 8,966,144), IPR2016-01200, IPR2016-01211, and IPR2016-01213 (Patent 8,504,746)

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 reminded that the presenter must identify clearly and specifically each demonstrative exhibit (e.g., by slide or screen number) referenced during each hearing to ensure the clarity and accuracy of the reporter's transcript. The parties also should note that Judge Miriam Quinn will be attending each 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

IPR2016-01199, IPR2016-01212, IPR2016-01214, IPR2016-01216, and IPR2016-01225 (Patent 8,966,144), IPR2016-01200, IPR2016-01211, and IPR2016-01213 (Patent 8,504,746)

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

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