

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DIGITAL CHECK CORP. d/b/a ST IMAGING,
Petitioner,

v.

E-IMAGEDATA CORP.,
Patent Owner.

Cases¹

IPR2017-00177 (Patent 8,537,279 B2)

IPR2017-00178 (Patent 9,179,019 B2)

Before KEN B. BARRETT, JENNIFER MEYER CHAGNON, and
MELISSA A. HAAPALA, *Administrative Patent Judges*.

HAAPALA, *Administrative Patent Judge*.

ORDER

Request for Oral Argument

37 C.F.R. § 42.70

¹ This Decision applies to each of the listed cases. The parties are not authorized to use a multiple case caption.

The date set for oral hearing for these proceedings is February 7, 2018, if hearing is requested by either party and granted by the Board. Paper 7.² Petitioner requests oral hearing and does not express a preference for the hearing location. Paper 16. The request for oral hearing for these proceedings is *granted*.

A combined hearing will be held for the above-captioned cases. The hearing will commence at 2 PM Eastern Time on February 7, 2018, on the ninth floor of Madison Building East, 600 Dulany Street, Alexandria, Virginia.

Each side will have 45 minutes, total, to present its arguments for both cases. Petitioner bears the ultimate burden of proof that Patent Owner's claims at issue in this review are unpatentable. Accordingly, 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 time to respond to Patent Owner's arguments. Patent Owner may not reserve time.

The Board will provide a court reporter for the hearing and the reporter's transcript will constitute the official record of the hearing. At least one member of the panel may attend the oral argument remotely by use of two-way audio-visual communication equipment. The hearing will be open to the public for in-person attendance that will be accommodated on a first-come, first-served basis. If the parties have any concern about disclosing confidential information, they are requested to contact the Board at least 10 days in advance of the hearing to discuss the matter.

² Our decision refer to the papers entered in IPR2017-00177. Similar papers were entered in IPR2017-00178.

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The parties are reminded that, under 37 C.F.R. § 42.53(f)(7), a proponent of deposition testimony must file such testimony as an exhibit. The Board will not consider any deposition testimony that has not been so filed.

The parties are further reminded that, under 37 C.F.R. § 42.70(b), demonstrative exhibits must be served at least seven (7) business days before the hearing date. The parties also shall provide a courtesy copy of any demonstrative exhibits to the Board at least five business days prior to the hearing by emailing them to Trials@uspto.gov. Notwithstanding 37 C.F.R. § 42.70(b), the parties shall *not* file any demonstrative exhibits in this proceeding without prior authorization from the Board. *See* 37 C.F.R. § 42.5(b).

The parties must meet and confer to discuss and resolve any objections to demonstrative exhibits. Any party with unresolved objections must file such objections with the Board at least two (2) business days before the hearing. The objections should identify with particularity which demonstrative exhibits 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 if deemed necessary. Otherwise, the Board will reserve ruling on the objections until after the oral argument. Any objection to demonstrative exhibits that is not timely presented will be considered waived.

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, 2015) (Paper 65), for guidance regarding the appropriate content of demonstrative exhibits. Demonstrative exhibits are not evidence

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and may not introduce new evidence or arguments. Instead, demonstrative exhibits should cite to evidence in the record. 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 Board 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. If either party expects that its lead counsel will not be attending the oral argument, the parties should initiate a joint telephone conference with the Board no later than two (2) business days prior to the oral hearing to discuss the matter.

Any special requests for audio-visual equipment should be directed to Trials@uspto.gov. Requests for special equipment will not be honored unless presented in a separate communication not less than five (5) days before the hearing directed to the above email address.

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