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Paper 36
Entered: February 16, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner,

v.

VALENCELL, INC.
Patent Owner.

Case IPR2017-00315 Patent 8,929,965 B2
Case IPR2017-00317 Patent 8,989,830 B2
Case IPR2017-00318 Patent 8,886,269 B2
Case IPR2017-00319 Patent 8,923,941 B2
Case IPR2017-00321 Patent 8,923,941 B2[1,2]

Before BRIAN J. McNAMARA, JAMES B. ARPIN, and SHEILA F. McSHANE, *Administrative Patent Judges.*

McSHANE, *Administrative Patent Judge.*

ORDER
Trial Hearing
37 C.F.R. § 42.70

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[1] This Order applies to each of the listed cases. We exercise our discretion to issue one Order to be docketed in each case. The parties are not authorized to use a multiple case caption.

[2] *Fitbit, Inc. v. Valencell, Inc.* cases have been joined to the instant cases. Specifically, Case IPR2017-01552 has been joined with Case IPR2017-00315; Case IPR2017-01553 has been joined with Case IPR2017-00317; Case IPR2017-01554 has been joined with Case IPR2017-00318; Case IPR2017-01555 has been joined with Case IPR2017-00319; and Case IPR2017-01556 has been joined with Case IPR2017-00321.

DISCUSSION

An *inter partes* review was instituted in each of the above-captioned proceedings. Paper 9.[3] Petitioner and Patent Owner requested an oral hearing in each of the proceedings pursuant to 37 C.F.R. § 42.70(a). Papers 34, 35. Petitioner requested twenty (20) minutes for oral argument per side per proceeding. Paper 35, 2. Petitioner also requested that the parties address Cases IPR2017-00317/-00318 and Cases IPR2017-00319/-00321, respectively, in consolidated hearings in light of similarities in the patents, asserted prior art, and commonality of arguments and that the court reporter produce a single transcript for each consolidated hearing. *Id*. at 1–2.

Patent Owner requested a call to discuss the oral hearings, which was conducted on February 15, 2017, during which Patent Owner agreed with addressing Cases IPR2017-00317/-00318 and Cases IPR2017-00319/-00321 in consolidated hearings. However, Patent Owner requested additional time for the hearings. Patent Owner requested thirty (30) minutes per side per proceeding, arguing that Cases IPR2017-00317/-00318, in particular, required additional hearing time because these cases involve some differing prior art and have pending motions to amend. Petitioner opposed the request for additional time, arguing that each of the cases has significant issue overlap, and the Board has the discretion to extend oral hearing time if it becomes necessary at the time of the hearings.

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[3] We refer to the papers and exhibits filed in Case IPR2017-00315 as representative.

IPR2017-00315 (Patent 8,929,965 B2)
IPR2017-00317 (Patent 8,989,830 B2)
IPR2017-00318 (Patent 8,886,269 B2)
IPR2017-00319 (Patent 8,923,941 B2)
IPR2017-00321 (Patent 8,923,941 B2)

We have reviewed the issues that the parties have addressed in the papers for each proceeding, and agree with the parties that it is more efficient to address Cases IPR2017-00317/-00318 and Cases IPR2017-00319/-00321 in consolidated hearings. Each party will be permitted twenty (20) minutes of oral argument per side per proceeding in Cases IPR2017-00315, IPR2017-00319, and IPR2017-00321, and thirty (30) minutes of oral argument per side per proceeding will be permitted in the Cases IPR2017-00317 and IPR2017-00318 cases. The hearings will commence at 11:00 AM Eastern Time, on Tuesday, February 27, 2018, and will proceed in this order:

11:00 AM-11:40 AM	IPR2017-00315
11:45 AM-1:05 PM	IPR2017-00319/-00321
1:05 PM-2:00 PM	Lunch
2:00 PM-4:00 PM	IPR2017-00317/-00318

For each hearing, Petitioner will first present its case(s) as to the challenged claims and grounds with respect to which we instituted trials and may also address the motion(s) to amend. Petitioner may reserve rebuttal time. Petitioner may address the patentability of substitute claims, presented in a motion to amend (if applicable) in their initial presentation, and not only in rebuttal after Patent Owner raises its motion to amend in its presentation. Thereafter, Patent Owners will argue its opposition to Petitioner's case(s) and its motion(s) to amend. Petitioner then may use any time it reserved to rebut Patent Owner's opposition.

IPR2017-00315 (Patent 8,929,965 B2)
IPR2017-00317 (Patent 8,989,830 B2)
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IPR2017-00319 (Patent 8,923,941 B2)
IPR2017-00321 (Patent 8,923,941 B2)

The oral hearing will be open to the public for in-person attendance, on the ninth floor of Madison Building East, 600 Dulany Street, Alexandria, Virginia. Currently, the hearing is scheduled to be held in Hearing Room A. Space in the hearing room is limited, and any attendees beyond three per party (including any attorneys who may be appearing) will be accommodated on a first-come, first-served basis.

At least four (4) business days prior to the oral arguments, each party shall serve on the other party any demonstrative exhibit(s) it intends to use during the oral arguments and file the demonstrative exhibit(s) before the time of the oral arguments. *See* 37 C.F.R. § 42.70(b). The parties also shall provide the demonstrative exhibits to the Board at least four (4) business days prior to the oral arguments by e-mailing them to Trials@uspto.gov. **Demonstrative exhibits are not evidence, but merely a visual aid at the oral arguments. Demonstrative exhibits may not introduce new evidence or raise new arguments, but instead should cite to evidence in the record.** 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) and *CBS Interactive Inc. v. Helferich Patent Licensing, LLC*, IPR2013-00033, (PTAB Oct. 23, 2013) (Paper 118), for guidance regarding the appropriate content of demonstrative exhibits.

The parties shall confer and attempt to resolve any objections to demonstratives prior to involving the Board.

For any issue regarding the proposed demonstrative exhibits that cannot be resolved after conferring with the opposing party, the parties may file jointly a one-page list of objections at least two (2) business days prior to the date of the hearing. Any such list should identify with particularity which demonstrative exhibit(s) is (are) subject to objection and include a short statement (no more than one concise 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, to discuss them. Otherwise, we may strike demonstrative exhibits that we find objectionable or reserve ruling on the objections until the hearing or after the hearing. Any objection to a demonstrative exhibit that is not presented in a timely-filed list will be considered waived. Regardless of any objections raised by the parties, the Board may expunge any demonstrative exhibits that it finds excessive in number or content.

To aid in the preparation of an accurate transcript, each party shall provide paper copies of its demonstratives to the court reporter on the day of the oral arguments. Such paper copies shall not become part of the record of this proceeding. The parties are reminded that each presenter must identify clearly and specifically each demonstrative exhibit (e.g., by slide or screen number), paper, or exhibit referenced during the oral arguments to ensure the clarity and accuracy of the reporter's transcript.

Judge James Arpin (Denver) will be attending each hearing electronically and will only have access to the demonstratives exhibits provided in advance in the manner described above. If a demonstrative

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