

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KVK-TECH, INC.,
Petitioner,

v.

SHIRE PLC,
Patent Owner.

Case IPR2018-00290 (Patent 8,846,100 B2)
Case IPR2018-00293 (Patent 9,173,857 B2)¹

Before RAMA G. ELLURU, SHERIDAN K. SNEDDEN, and
DEVON ZASTROW NEWMAN, *Administrative Patent Judges*.

ELLURU, *Administrative Patent Judge*.

ORDER
Oral Hearing
37 C.F.R. § 42.70

¹ This Order addresses issues that are the same in the above-identified proceedings. We exercise our discretion to issue one Order, entered in each proceeding. The parties, however, are not authorized to use this joint heading and filing style in their papers.

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Patent Owner and Petitioner have each filed requests for oral hearing in the above-captioned proceedings, pursuant to 37 C.F.R. § 42.70.

IPR2018-00290, Papers 44, 45.² In its request, Patent Owner proposes that each party be allocated ninety (90) minutes to present its argument in each of the above-captioned proceedings. Paper 44, 1. In its request, Petitioner proposes that each party be allocated sixty (60) minutes to present argument in each of the above-captioned proceedings. Paper 45, 2. By e-mail dated March 20, 2019, Petitioner indicated that although Patent Owner initially requested 90 minutes for oral argument, Patent Owner agrees to 60 minutes of oral argument for each side. We grant the requests for oral argument according to the terms set forth in this Order.

The oral hearings for the above-captioned proceedings will be combined, and the combined oral hearing will commence at 10:00 AM Eastern Time on Thursday, April 4, 2019, in Hearing Room B on the ninth floor of Madison Building East, 600 Dulany Street, Alexandria, Virginia.³

Each party will have sixty (60) minutes total time to present its arguments in the above-captioned proceedings. Petitioner bears the ultimate burden of proof that the claims at issue in these reviews are unpatentable. Therefore, at oral argument, Petitioner will proceed first to present its case regarding the challenged patent claims and the grounds on which the Board instituted trial. Petitioner may reserve some (but not more than half) of its allotted time for rebuttal to respond to Patent Owner's arguments. After

² For convenience, we cite to papers in IPR2018-00290. Similar papers were filed in IPR2018-00293 (Papers 42 and 43).

³ Scheduling Orders in IPR2018-00290 (Paper 16) and IPR2018-00293 (Paper 14) set April 4, 2019, as the date for oral arguments.

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Petitioner's initial presentation, Patent Owner will be given an opportunity to respond. Thereafter, Petitioner may use any reserved time to respond to Patent Owner's presentation. Lastly, Patent Owner may reserve no more than half of its allotted time for sur-rebuttal and may use its reserved time for sur-rebuttal to respond to Petitioner's arguments.

Both parties filed Motions to Exclude Evidence. Papers 43, 46.⁴ Thus, the oral hearing may pertain to the subject of evidence exclusion. Patent Owner did not file a Motion to Amend Claims. Thus, the oral hearing will not pertain to claim amendments. New arguments not previously presented in the parties' substantive papers in these proceeding shall not be raised at oral hearing.

The hearing will be open to the public for in-person attendance that will be accommodated on a first-come, first-served basis. Please be advised, available seating is limited. The Board will provide a court reporter, and the reporter's transcript shall constitute the official record of the trial hearing.

The parties shall serve any demonstrative exhibits on opposing counsel at least seven business days before the hearing. The parties shall also provide a courtesy copy of any demonstrative exhibits to the Board no later than three business days before the hearing, or five business days prior to a pre-hearing conference if one is scheduled by emailing them to Trials@uspto.gov. In addition, the parties shall file any demonstrative exhibits in these proceedings within two days of the hearing. Demonstrative exhibits are visual aids to oral argument and not evidence and are intended only to assist the parties in presenting their oral argument to the panel. The

⁴ Motions to Exclude Evidence were also filed in IPR2018-00293.

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parties are directed to *St. Jude Medical, Cardiology Division, Inc. v. The Board of Regents of the University of Michigan*, IPR2013-00041 (PTAB Jan. 27, 2014) (Paper 65) for guidance regarding the appropriate content of demonstrative exhibits. Demonstrative exhibits may not be used to advance arguments or introduce evidence not previously presented in the record. *See Dell Inc. v. Accelaron, LLC*, 884 F.3d 1364, 1369 (Fed. Cir. 2018) (noting that the “Board was obligated to dismiss [the petitioner’s] untimely argument . . . raised for the first time during oral argument”). Instead, demonstrative exhibits should cite to the briefs and evidence in the record. The parties shall confer with each other regarding any objections to demonstrative exhibits. For any issue that cannot be resolved after conferring, the parties may each send by email to Trials@uspto.gov a one-page list of objections at least two business days before the hearing if no pre-hearing conference is requested or two business days before a pre-hearing conference if one is scheduled. The list should identify with particularity which demonstrative exhibits are subject to objection and include a short statement of the reason for each objection and the reason the other party opposes the objection. No argument or further explanation is permitted. The Board will consider the objections and, if no pre-hearing conference is requested, may schedule a telephone conference if deemed necessary. Any objection to demonstrative exhibits that is not timely presented may be considered waived.

The parties are reminded that, at the oral hearing, 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, and to assist Judge Newman who will

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join the hearing remotely. Judge Newman will be unable to view images projected in the hearing room. Similarly, to ensure presenters may be heard by Judge Newman, the parties are reminded to speak only when standing at the hearing room podium and toward the attached microphone. No live testimony from any witness will be taken at the oral argument. The Board expects lead counsel for each party to be present in person at the oral hearing. Any counsel of record, however, may present the party's argument. If either party anticipates 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 business days prior to the oral hearing to discuss the matter.

The parties may request the use of audio-visual equipment during the oral hearing. Such requests should be directed to Trials@uspto.gov at least five business days in advance of the hearing date. If the request is not received timely, the equipment may not be available on the day of the hearing.

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