

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SEOUL SEMICONDUCTOR CO., LTD.,
SEOUL SEMICONDUCTOR, INC. and
EVERLIGHT ELECTRONICS CO., LTD.
Petitioner,

v.

DOCUMENT SECURITY SYSTEMS, INC.,
Patent Owner.

Case IPR2018-00522¹
Patent 7,524,087 B1

Before SALLY C. MEDLEY and BRENT M. DOUGAL, *Administrative
Patent Judges.*

DOUGAL, *Administrative Patent Judge.*

ORDER
Oral Hearing
37 C.F.R. § 42.70

¹ Everlight Electronics Co., Ltd., who filed a Petition in IPR2018-01226, has been joined as a petitioner in this proceeding.

Petitioner and Patent Owner each filed a request for oral hearing in the above captioned proceeding, pursuant to 37 C.F.R. §42.70. Papers 23, 25. Petitioner and Patent Owner both request thirty (30) minutes per side for each side to present its argument. Paper 27, 1; Paper 26, 1. The requests are granted according to the terms set forth in this Order.

The oral hearings will commence at 1:00 PM Eastern Time on Thursday, April 4, 2019, in Hearing Room D on the ninth floor of Madison Building East, 600 Dulany Street, Alexandria, Virginia. Each party will have thirty (30) minutes total time to present its argument.

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.

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 argument time to respond to arguments presented by the Patent Owner. After Petitioner's initial presentation, Patent Owner will be given an opportunity to respond, and also may reserve some of its argument time for sur-rebuttal. Thereafter, Petitioner may use any reserved time to reply to Patent Owner's presentation, and finally, Patent Owner may present a brief sur-rebuttal if it has reserved time.

New arguments not previously presented in the parties' substantive papers in these proceeding shall not be raised at oral hearing.

Live Testimony

Requests for live testimony will be given due consideration. A party requesting live testimony should explain why and how this consideration applies, for example where an inventor is attempting to antedate a reference by establishing a prior reduction to practice. *See K-40 Electronics, LLC v. Escort, Inc.*, IPR2013-00203 (PTAB May 21, 2014) (Paper 34). Other factors may include the importance of the issue that is the subject of the testimony. The Board is more likely to grant oral testimony critical to issues that are case-dispositive. *Id.* at 2.

Official Record

The Board will provide a court reporter, and the reporter's transcript shall constitute the official record of the oral hearing.

Demonstrative Exhibits

Demonstrative exhibits used at the final hearing are aids to oral argument and not evidence, and should be clearly marked as such. Each slide of a demonstrative exhibit should be marked with the words "DEMONSTRATIVE EXHIBIT – NOT EVIDENCE" in a footer. Demonstrative exhibits cannot 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"). Demonstrative exhibits should cite to evidence in the record.

The parties shall serve any demonstrative exhibits on opposing counsel at least five business days before the hearing or at least five business days before the pre-hearing conference if one is scheduled. In addition, the

parties shall file any demonstrative exhibits in these proceedings within two days of the hearing.

The 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. The parties are encouraged to resolve objections to demonstrative exhibits by conferring prior to submitting the exhibits to the Board. Objections to demonstratives should be carefully considered and framed, as the Board has not found that such objections are helpful in many cases. Any unresolved issue regarding demonstrative exhibits should be addressed during a pre-hearing conference. Any objection to demonstrative exhibits that is not timely presented will 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 Moore and Judge Dougal, who will join the hearing remotely. Judge Moore and Judge Dougal will be unable to view images projected in the hearing room. Similarly, to ensure presenters may be heard by Judge Moore and Judge Dougal, the parties are reminded to speak only when standing at the hearing room podium and toward the attached microphone.

Pre-Hearing Conference

Per the recent update to the Office Patent Trial Practice Guide, either party may request a pre-hearing conference. Office Patent Trial Practice Guide, August 2018 Update, 83 Fed. Reg. 39,989 (Aug. 13, 2018) (found at

the following link to the USPTO website: <https://go.usa.gov/xU7GP>). Requests for a pre-hearing conference must be made by March 22, 2019. To request such a conference, an email should be sent to Trials@uspto.gov including several dates and times of availability for one or both parties, as appropriate, that are generally no later than three business days prior to the oral hearing. Please refer to the Guide for more information on the pre-hearing conference.

If the parties are unable to agree on the issues to be addressed at the pre-hearing conference, the joint request shall specify which issues are disputed and provide a brief statement (not to exceed one sentence) of the opposing party's objection.

The panel may, at its discretion, indicate certain issues during the pre-hearing conference that it wishes the parties to emphasize at the oral hearing. Although the parties and the panel may discuss issues for the oral hearing at the pre-hearing conference, the issues discussed at the pre-hearing conference do not limit the scope of the oral hearing. Instead, the parties remain free to address at the oral hearing any issue properly raised during the trial, and the panel may ask questions on issues other than those identified at the pre-hearing conference. The parties may also discuss objections to demonstrative exhibits at the pre-hearing conference, but the panel may reserve ruling on such objections until a later time.

Attendance of Counsel

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

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.