

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SIRIUS XM RADIO INC.
Petitioner,

v.

FRAUNHOFER-GESELLSCHAFT ZUR FÖRDERUNG DER
ANGEWANDTEN FORSCHUNG E.V.,
Patent Owner.

IPR2018-00690
Patent 6,314,289 B1

Before JEFFREY S. SMITH, STACEY G. WHITE, and
MICHELLE N. WORMMEESTER, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

ORDER
Trial Hearing
37 C.F.R. § 42.70

We instituted a trial for the instant proceeding on August 19, 2019. Paper 29. Patent Owner and Petitioner each requested an oral hearing pursuant to 37 C.F.R. § 42.70. Papers 44, 45. Upon consideration, the requests for oral hearing are *granted*.

Oral arguments will commence at **2:00 PM (EST) on May 19, 2020, by video**. The parties are directed to contact the Board at least 10 days in advance of the hearing if there are any concerns about disclosing confidential information. The Board will provide a court reporter for the hearing, and the reporter's transcript will constitute the official record of the hearing.

If at any time during the proceeding, you encounter technical or other difficulties that fundamentally undermine your ability to adequately represent your client, please let the panel know immediately, and adjustments will be made.¹

To facilitate planning, each party must contact PTAB Hearings at (571) 272-9797 five business days prior to the oral hearing date to receive video set-up information. As a reminder, all arrangements and the expenses involved with appearing by video, such as the selection of the facility to be used from which a party will attend by video, must be borne by that party. If a video connection cannot be established, the parties will be provided with dial-in connection information, and the oral hearing will be conducted telephonically.

If one or both parties would prefer to participate in the oral hearing telephonically, they should notify PTAB Hearings at the above telephone

¹ For example, if a party is experiencing poor video quality, the Board may provide alternate dial-in information.

number five business days prior to the hearing to receive dial-in connection information.

Each party will have one (1) hour, total, to present its arguments. *See* Office Consolidated Trial Practice Guide, November 2019 Edition, 81, *available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated>; *see also* 84 Fed. Reg. 64,280 (Nov. 21, 2019) (“The Board expects to ordinarily provide for an hour of argument per side for a single proceeding, but a party may request more or less time depending on the circumstances of the case.”). Petitioner will first present its case regarding the challenged claims for which the Board instituted trial. Thereafter, Patent Owner may respond to Petitioner’s argument. Petitioner may reserve rebuttal time (of no more than half its total argument time) to respond to Patent Owner’s arguments presented at the hearing. Thereafter, Patent Owner may reserve rebuttal time (of no more than half its total argument time) to respond to Petitioner’s arguments. *See* Office Consolidated Trial Practice Guide, November 2019 Edition, 83. No live testimony from any witness will be taken at the oral argument.

At least seven (7) business days prior to the hearing, each party shall serve on the other party any demonstrative exhibit(s) it intends to use during the hearing. *See* 37 C.F.R. § 42.70(b). At least five (5) business days before the hearing, the parties shall provide the demonstrative exhibits to the Board by emailing them to PTABHearings@uspto.gov. The parties shall not file any demonstrative exhibits in this case without prior authorization from the Board.

Demonstrative exhibits used at the oral hearing are aids to oral argument and not evidence, and should be clearly marked as such. For

example, each slide may be marked with the words “DEMONSTRATIVE EXHIBIT – NOT EVIDENCE” in the footer. *See* Office Consolidated Trial Practice Guide, November 2019 Edition, 84. 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”). Instead, demonstrative exhibits must cite to evidence in the record.

The parties should attempt to work out any objections to demonstratives prior to involving the Board. Should either party disagree with the propriety of any of the opposing parties’ demonstratives, the party may send, contemporaneously with their own slides two (2) business days prior to the hearing, an email to Trials@uspto.gov including a paper limited to identifying the opposing parties’ slide(s) objected to and a brief sentence as to the general basis of the objection. No further argument is permitted in that paper. The Board will then take the objections under advisement, and if the content is inappropriate, it will not be considered. Any objection to demonstrative exhibits that is not timely presented will be considered waived. The Board asks the parties to confine demonstrative exhibit objections to those identifying egregious violations that are prejudicial to the administration of justice. 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), for guidance regarding the appropriate content of demonstrative exhibits. In general, if the content on a slide cannot be readily associated with an

argument made, or evidence referenced, in a substantive paper, it is inappropriate. The best practice is to indicate on each slide where support may be found in a substantive paper and/or an exhibit of record in this proceeding.

The parties are reminded that each 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. As noted above, at least one member of the panel may be attending the hearing electronically from a remote location. If a demonstrative exhibit is not emailed to the Board or otherwise made fully available or visible to all judges at the hearing, that demonstrative exhibit will not be considered. 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.

Either party may request a pre-hearing conference. *See* Office Consolidated Trial Practice Guide, November 2019 Edition, 80. Requests for a pre-hearing conference must be made by May 5, 2020. 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 (3) business days prior to the oral hearing. Please refer to the Guide for more information on the pre-hearing conference.

The Board generally expects lead counsel for each party to be present by video at the oral hearing. Any counsel of record may present the party's argument as long as that counsel is present by video.

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