

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
Petitioner,

v.

BIOGEN MA INC,
Patent Owner.

IPR2018-01403¹
Patent No. 8,399,514 B2

Before SHERIDAN K. SNEDDEN, JENNIFER MEYER CHAGNON, and
JACQUELINE T. HARLOW, *Administrative Patent Judges*.

SNEDDEN, *Administrative Patent Judge*.

ORDER
Granting Requests for Oral Argument
37 C.F.R. § 42.70

¹ IPR2019-00789 has been joined with this proceeding.

Oral hearing in this case is set for November 13, 2019, if a hearing is requested by the parties and granted by the Board. Paper 13. Both parties have requested oral hearing pursuant to 37 C.F.R. § 42.70. Papers 65 and 66. The parties' requests for oral hearing are *granted*.

A. Time and Format

The hearing will commence at **1:00 PM Eastern Time on November 13, 2019**. The hearing will be open to the public, for in-person attendance, on the ninth floor of Madison Building East, 600 Dulany Street, Alexandria, Virginia. In-person attendance will be accommodated on a first come, first served basis. The Board will provide a court reporter for the hearing and the reporter's transcript will constitute the official record of the hearing.

Petitioner will have a combined 60 minutes to present argument in this case and Patent Owner will have 60 minutes to respond. Petitioner bears the ultimate burden of proof that Patent Owner's claims at issue are unpatentable. Therefore, Petitioner will open the hearing by presenting their 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 rebuttal time to respond to arguments presented by Patent Owner. In accordance with the Board's August 2018 Trial Practice Guide Update ("TPGU"), Patent Owner may reserve up to 5 minutes of time for sur-rebuttal.

The Trial Practice Guide Update provides an opportunity for the parties to request a pre-hearing conference. *See* TPGU 19 ("The purpose of the pre-hearing conference is to afford the parties the opportunity to preview (but not argue) the issues to be discussed at the oral hearing, and to seek the Board's guidance as to particular issues that the panel would like addressed

by the parties.”). If either party desires a pre-hearing conference, the parties should jointly contact the Board at least seven business days before the hearing to request a conference call for that purpose.

B. Demonstratives

As set forth in 37 C.F.R. § 42.70(b), demonstrative exhibits shall be served on opposing counsel at least seven business days before the hearing. However, in regard to filing demonstrative exhibits, and in contrast to what is expressly stated in § 42.70(b), the parties shall file the demonstrative exhibits no later than two business days before the hearing, to allow the panel sufficient time to review the materials.

The panel reminds the parties that demonstrative exhibits are not evidence, but are intended to assist the parties in presenting their oral arguments to the Board. Demonstrative exhibits should be clearly marked as such. For example, each slide may be marked with the words “DEMONSTRATIVE EXHIBIT – NOT EVIDENCE” in the footer. The panel will distinguish evidence in the record from argument appearing in demonstrative exhibits, and all arguments must be supported by evidence already of record. The panel also reminds the parties that demonstrative exhibits are not a mechanism for making arguments not previously addressed in the Papers. The panel will not consider arguments or evidence appearing only in demonstrative exhibits.

Due to the nature of the panel’s consideration of demonstrative exhibits, the panel does not anticipate that objections to such exhibits would likely be sustained. Nevertheless, to the extent that the parties object to the propriety of any demonstrative exhibit, we expect that the parties will meet and confer in good faith to resolve any objections to demonstrative exhibits.

If such objections cannot be resolved, the parties may file any objections to demonstratives with the Board at least two business days before the hearing. The objections should identify with particularity which portions of the demonstrative exhibits are subject to objection, include a copy of the objected-to portions, and include a one-sentence statement of the reason for each objection. No argument or further explanation is permitted. We will consider any objections and schedule a conference call if deemed necessary. Otherwise, we will reserve ruling on the objections. Any objection to demonstrative exhibits that is not timely presented will be considered waived.

Finally, 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 and for the benefit of any judge(s) who may be participating electronically from USPTO Regional Offices.

C. Lead Counsel

The Board expects lead counsel for each party to be present at the oral hearing, although any backup counsel may present the party's argument. If either lead counsel is unable to be present at the hearing, the Board shall be advised by email no later than two (2) business days prior to the oral hearing, and such lead counsel shall be available for a conference call if necessary.

D. Remote Video Attendance Request

A party may request remote video attendance for one or more of its other attendees to view the hearing from any USPTO location. The

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available locations include the Texas Regional Office in Dallas, Texas; the Rocky Mountain Regional Office in Denver, Colorado; the Elijah J. McCoy Midwest Regional Office in Detroit, Michigan; and the Silicon Valley Office in San Jose, CA. To request remote video viewing, a party must send an email message to Trials@uspto.gov five business days prior to the hearing, indicating the requested location and the number planning to view the hearing from the remote location. The Board will notify the parties if the request for video viewing is granted. Note that it may not be possible to grant the request due to the availability of resources.

E. Audio/Visual Equipment Requests

Questions regarding specific audio-visual equipment should be directed to the Board at (571) 272-9797. **Requests for audio-visual equipment are to be made 5 days in advance of the hearing date. The request is to be sent to Trials@uspto.gov. If the request is not received timely, the equipment may not be available on the day of the hearing.**

Accordingly, it is

ORDERED that oral argument for this proceeding shall commence at **1:00 PM Eastern Time on November 13, 2019**, on the ninth floor of Madison Building East, 600 Dulany Street, Alexandria, Virginia, and proceed in the manner set forth herein.

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