

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JUBILANT DRAXIMAGE INC.,
Petitioner,

v.

BRACCO DIAGNOSTICS INC.,
Patent Owner.

IPR2018-01448 (Patent 9,299,468 B2)
IPR2018-01449 (Patent 9,299,467 B2)
IPR2018-01450 (Patent 9,299,468 B2)¹

Before HYUN J. JUNG, GEORGE R. HOSKINS, and
RICHARD H. MARSCHALL, *Administrative Patent Judges*.

JUNG, *Administrative Patent Judge*.

ORDER
Oral Hearing
37 C.F.R. § 42.70

¹ The parties are not authorized to use a caption identifying multiple proceedings.

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We instituted *inter partes* reviews in IPR2018-01448, IPR2018-01449, and IPR2018-01450 on February 8, 2019. Paper 7² (“Decision to Institute”). A second Scheduling Order issued in each proceeding set the date for oral hearing to October 29, 2019, if hearing is requested by the parties and granted by the Board. Paper 20 (“ORDER Changing Due Dates 6 and 7”). The parties requested oral argument pursuant to 37 C.F.R. § 42.70 in the above-captioned proceedings. Papers 22, 23. The parties’ requests are *granted* 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 1 PM Eastern Time on Tuesday, October 29, 2019, in Hearing Room B on the ninth floor of Madison Building East, 600 Dulany Street, Alexandria, Virginia 22314.

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

Patent Owner proposes that each party be allocated one hour of total argument time to present its arguments in the above-captioned proceedings. Paper 23, 1. Petitioner similarly proposes that each party be allocated one hour of total argument time to present its arguments in the above-captioned proceedings. Paper 22, 1. We allocate each party one (1) hour of total

² For convenience, we cite to papers in IPR2018-01448. For each of the papers discussed herein, similar papers were filed in IPR2018-01449 and IPR2018-01450.

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argument time to present its arguments in the above-captioned proceedings. The parties may use their one hour to present their arguments as they see fit. If the panel requires a lengthy examination of a party's argument, the panel may extend argument time. If the panel extends argument time for one party, the panel will extend argument time for the other party by an equal amount.

Petitioner bears the ultimate burden of proof that the claims at issue in these reviews are unpatentable. Therefore, at oral hearing, Petitioner will proceed first to present its arguments with regard to the challenged claims and grounds on which basis we instituted trial in the above-captioned proceedings. Petitioner may reserve some (but not more than half) of its allotted argument time for rebuttal to respond to Patent Owner's arguments.

After Petitioner's initial presentation, Patent Owner will argue its opposition to Petitioner's case. Thereafter, Petitioner may use any reserved time to respond to Patent Owner's presentation. Patent Owner may reserve some (but no more than half) of its allotted argument time for use in sur-rebuttal if it so chooses, and may use its reserved time for sur-rebuttal to respond to Petitioner's arguments.³ The parties are reminded that arguments made during rebuttal and sur-rebuttal periods must be responsive to arguments the opposing party made in its immediately preceding presentation. The parties are also reminded that during the hearing, the

³ See Trial Practice Guide August 2018 Update, p. 20, *available at* www.uspto.gov/sites/default/files/documents/2018_Revised_Trial_Practice_Guide.pdf (providing that the "Board may also permit patent owners the opportunity to present a brief sur-rebuttal if requested").

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parties “may only present arguments relied upon in the papers previously submitted.” Trial Practice Guide August 2018 Update, p. 23.

Under 37 C.F.R. § 42.70(b), each party’s demonstrative exhibits must be served on opposing counsel at least *seven (7) business days* before the hearing. 37 C.F.R. § 42.70(b). The parties also shall file a courtesy copy of the demonstratives as an exhibit to the Board at least *three (3) business days* prior to the hearing by emailing them to Trials@uspto.gov. In addition, the parties shall file any demonstrative exhibits in above-captioned proceedings *within two (2) days of the hearing*. Each party shall provide a hard copy of its demonstratives to the court reporter at the hearing. The parties are reminded that 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. Each slide may be marked with the words “DEMONSTRATIVE EXHIBIT – NOT EVIDENCE” in the footer. The parties are directed to *St. Jude Medical, Cardiology Division, Inc. v. The Board of Regents of the University of Michigan*, IPR2013-00041, Paper 65 (PTAB Jan. 27, 2014) (Order) 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.

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The parties shall meet and confer to discuss any objections to demonstrative exhibits. If any issues regarding demonstratives remain unresolved after the parties meet and confer, the parties shall file jointly (by email to Trials@uspto.gov) a one-page list of objections to the demonstrative exhibits at least *three (3) business days* before the hearing if no pre-hearing conference is requested. For each objection, the list must identify with particularity the demonstratives subject to the objection and include a short, one-sentence statement explaining the objection. The panel will consider the objections and may schedule a conference call if deemed necessary. Otherwise, rulings on the objections will be reserved until the hearing or after the hearing. Any objection to demonstrative exhibits not presented timely will be considered waived.

During 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 Hoskins, who will join the hearing remotely. Judge Hoskins will be unable to view images projected in the hearing room. Similarly, to ensure presenters may be heard by Judge Hoskins, the parties are reminded to speak only when standing at the hearing room podium and toward the attached microphone. The parties should note that if a demonstrative is not filed or otherwise made fully available or visible to the judge presiding over the hearing remotely, that demonstrative 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.

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