

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CANON U.S.A., INC., GOPRO, INC.,
GARMIN INTERNATIONAL, INC., AND GARMIN USA, INC.,
Petitioners,

v.

CELLSPIN SOFT, INC.,
Patent Owner.

Case IPR2019-00127¹
Patent 9,258,698 B2

Before, GREGG I. ANDERSON, DANIEL J. GALLIGAN, and
STACY B. MARGOLIES, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

ORDER
Trial Hearing
37 C.F.R. § 42.70

¹ GoPro, Inc., Garmin International, Inc. and Garmin USA, Inc. were joined as parties to this proceeding. Paper 27.

Petitioner Canon U.S.A., Inc. (Canon) and Cellspin Soft, Inc. (“Patent Owner”) have requested an Oral Hearing in the above captioned matters. Papers 31 (Canon) and 32 (Patent Owner). The requests are granted.

Allotted Argument Time

Oral arguments in will commence at 1:00 pm ET on January 28, 2020, at the USPTO Headquarters on the ninth floor of Madison Building East, 600 Dulany Street, Alexandria, Virginia. The hearing will be open to the public for in-person attendance that will be accommodated on a first-come, first-served basis. 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. To facilitate planning, each party must send an email message to PTABHearings@uspto.gov five days prior to the hearing if the number planning to attend the hearing in-person for its side (attorneys and others) exceeds five people.

Petitioner Canon and Patent Owner each request sixty (60) minutes of total argument time. Paper 31, 1; Paper 32, 2. **Canon and Patent Owner each will have sixty (60) minutes total argument time for this case and only this case.** Petitioner bears the ultimate burden of proof that the claims at issue in this review are unpatentable. Therefore, at oral hearing Canon will proceed first to present its case on challenges to patentability and any pending motions of Canon. Thereafter, Patent Owner will argue its opposition to Canon’s case and motions, as well as its pending motions. Canon then may use any time Canon reserved to rebut Patent Owner’s

opposition and oppose Patent Owner's motions. Finally, Patent Owner may request an opportunity to present a brief sur-rebuttal.

Requests for 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.

Confidentiality

There is a strong public policy interest in making all information presented in these proceedings public, as the review determines the patentability of claims in an issued patent and thus affects the rights of the public. This policy is reflected in part, for example, in 35 U.S.C. § 316(a)(1) and 35 U.S. C. § 326(a)(1) which provide that the file of any *inter partes* review or post grant review be made available to the public.

At this time, the parties are advised that the Board exercises its discretion to make the oral hearing publically available via in-person attendance. In-person attendance will be accommodated on a first come first serve basis.

Request for Pre-hearing Conference

A pre-hearing conference to occur no later than three business days before the hearing will be held at either party's request. The purpose of a pre-hearing conference is to afford the parties the opportunity to preview

(but not argue) issues to be discussed at the oral hearing, and to seek the Board's guidance as to particular issues that the panel would like the parties to address at oral argument. The parties may also discuss with the Board any pending motions to strike, request an early decision on the admissibility of a limited number of exhibits subject to a motion to exclude, and discuss any unresolved issues with demonstrative exhibits. The Board may rule on objections and disputed exhibits during the pre-hearing conference, or after the pre-hearing conference and before the oral hearing. The Board may also defer ruling until the oral hearing or thereafter.

Prior to requesting a pre-hearing conference, the parties should meet and confer and, when possible, send a joint request to the Board with an agreed upon set of limited issues for discussion. A request for a pre-hearing conference may be made by e-mail and shall include a list of issues to be discussed, including but not limited to, identification of a limited number of objections for early resolution.

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.

During the 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. The parties also should note that at least one member of the panel for each proceeding will be attending the hearings electronically from a remote location and 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.

Any demonstrative exhibits must be served seven business days before the hearing. 37 C.F.R. § 42.70(b). 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.

Demonstratives should be filed at the Board no later than two days before the hearing. A hard copy of the demonstratives should be provided to the court reporter at the hearing.

Equipment Requests

Hearing rooms are equipped with projectors for PowerPoint presentations. A party should advise the Board as soon as possible before an

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