

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GUEST TEK INTERACTIVE ENTERTAINMENT LTD.,
Petitioner,

v.

NOMADIX, INC.,
Patent Owner.

IPR2019-00211 (Patent 7,953,857 B2)
IPR2019-00253 (Patent 8,626,922 B2)¹

Before SALLY C. MEDLEY, DANIEL J. GALLIGAN, and
JASON W. MELVIN, *Administrative Patent Judges*.

MELVIN, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding and Trial Hearing
35 U.S.C. §§ 42.5, 42.70

¹ This Order is being entered in each of the above-identified proceedings. The proceedings have not been consolidated and the parties are not authorized to use a consolidated caption.

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Petitioner and Patent Owner filed requests for oral argument in these cases pursuant to 37 C.F.R. § 42.70. Papers 25, 27.² Subsequently, on January 29, 2020, a conference call was held involving counsel for the respective parties and Judges Medley, Galligan, and Melvin. The purpose of the conference call was to discuss Patent Owner's opposed request to extend the remaining DUE DATES.

Patent Owner requests an extension of time because of a recent ruling by the United States District Court for the Central District of California granting Patent Owner's motion for summary judgment. The court determined that Petitioner's filing of the petitions in these proceedings was a violation of a license agreement between the parties. Ex. 3002, 7. According to Patent Owner, a judgment will soon follow and injunctive relief is expected. Patent Owner argues that continuing to the scheduled February 25, 2020, oral argument would be inefficient and costly. Petitioner argues that it is speculative that injunctive relief will be granted. Petitioner also argues that it plans to appeal the district court's decision to the Federal Circuit and that it would be prejudiced by any stay or extension of time.

A request for an extension of time must be supported by a showing of good cause. 37 C.F.R. § 42.5(c)(2). Patent Owner fails to show good cause why the remaining DUE DATES should be extended. The reasons Patent Owner provides, such that "a judgment will soon follow" and "injunctive relief is expected" are speculative. Moreover, even if such events materialize, Petitioner represents that it will appeal such decisions to the Federal Circuit. Patent Owner fails to persuade us why these proceedings,

² Papers cited appear in the record for IPR2019-00211. Corresponding papers appear in the record for IPR2019-00253.

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which are near the end, cannot proceed in parallel with the district court proceeding, followed by any appeal to the Federal Circuit. Accordingly, we deny Patent Owner's request to extend the remaining DUE DATES.

In its request for oral argument, Patent Owner requests sixty minutes of total argument time between the two proceedings. Paper 27, 2. Petitioner does not request a specific time but also proposes a combined hearing for the two proceedings. Paper 25, 2. Having considered the parties' submissions, the parties' requests for oral argument are granted.

The oral argument will commence at 1:00 pm Eastern Time on Tuesday, February 25, 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 ten 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.

Each party will have sixty minutes of total argument time. Petitioner will open the hearing by presenting its cases regarding the challenged claims. Patent Owner will then respond to Petitioner's presentation. Petitioner may reserve rebuttal time of no more than half its total argument time to reply to Patent Owner's arguments. Patent Owner may reserve sur-rebuttal time of no more than half its total argument time to respond to

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Petitioner's rebuttal. See *Trial Practice Guide Update 20* (August 2018), <https://go.usa.gov/xU7GP>. Consult the *November 2019 Consolidated Trial Practice Guide* (available at <https://go.usa.gov/xdj8z>) for information on requests for live testimony.

A pre-hearing conference call will be held at either party's request. The request must be made no later than February 14, 2020. Prior to making such a request, the parties shall 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 email to Trials@uspto.gov and shall include a list of issues to be discussed during the call and proposed times for the call, which should be no later than three business days prior to the oral hearing.

At least one member of the panel will be attending the hearing electronically from a remote location and will not be able to view the projection screen in the hearing room. Thus, if a demonstrative exhibit is not made available in advance or visible to the judge(s) presiding over the hearing remotely, that demonstrative exhibit will not be allowed. 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 the judge(s) presiding over the hearing remotely. A hard copy of the demonstratives, if filed, should be provided to the court reporter at the hearing. Also, the parties are reminded that, at the oral argument, they "may rely upon evidence that has been previously submitted in the proceeding and may only present arguments relied upon in the papers previously submitted." *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,768 (Aug. 14,

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2012). “No new evidence or arguments may be presented at the oral argument.” *Id.*

Under 37 C.F.R. § 42.70(b), demonstrative exhibits, if any, must be served seven business days before the hearing. Demonstrative exhibits used at the final hearing are aids to oral argument and not evidence, and should be clearly marked as such. For example, each slide of a demonstrative exhibit may be marked with the words “DEMONSTRATIVE EXHIBIT – NOT EVIDENCE” in the footer. *Trial Practice Guide Update*, 21.

The Board expects that the parties will meet and confer in good faith to resolve any objections to demonstrative exhibits, but if such objections cannot be resolved, the parties may raise any dispute over the propriety of each party’s demonstrative exhibits during the pre-hearing conference call, if requested as set forth above. Any objection to demonstrative exhibits that is not presented timely 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 may refer to *St. Jude Medical, Cardiology Div., Inc. v. The Board of Regents of the University of Michigan*, IPR2013-00041, Paper 65 (PTAB Jan. 27, 2014), regarding the appropriate content of demonstrative exhibits. The parties are directed to file their demonstrative exhibits, marked as noted above, in the record at least three business days prior to the hearing.

The Board generally 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 as long as that counsel is present in person. If either party anticipates that its lead counsel will not be attending the oral argument in person, the parties should initiate a joint telephone conference with the

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